

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

Part I Outline of Examination

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Chapter 1 Principles of the Examination and Flow of Examination

1101 Timing of Application of the Examination Guidelines and the Reasons for Refusal, etc. relating to the Examination Guidelines

Timing of Application of the Examination Guidelines and the Examination Handbook is indicated in Table 1. And reasons for refusal and the reasons for dismissal of the amendment relating to the Examination Guidelines is indicated in Table. 2.

Table 1: Timing of Application of the Examination Guidelines and the Examination Handbook

| Act | 1990 Act | 1993 Act | 1994 Act | 1999 Act | 2002 Act | 2003 Act | 2004 Act | 2006 Act | 2008 Act | 2011 Act | 2015 Act | 2018 Act | |
|---|---|---|---|---|--|---|--|---|--|--|--|---|------------------------------------|
| Effective date | From Dec. 1, 1990 | From Jan. 1, 1994 | From Jul. 1, 1995 | From Jan. 1, 2000 | From Sep. 1, 2002 | From Jan. 1, 2004 | From Apr. 1, 2005 | From Apr. 1, 2007 | From Apr. 1, 2009 | From Apr. 1, 2012 | From Apr. 1, 2016 | From June 9, 2018 | |
| Point of law revision | * Introduction of abstract | * Improvement of scope of amendments * Introduction of utility model registration system | * Introduction of system of application accompanied by foreign language documents * Easing of description requirements for description | * Article 29 (being publicly known or publicly worked in foreign country, being made available to public through electrical communication lines) * Revision of patent term extension registration system | * Introduction of system of disclosure of information on prior art documents * Clarification to the effect that "a product" includes a computer program * Separation of scope of claims from registration system (from Jul. 1, 2003) | * Requirement of unity of invention | * Introduction of system of patent application based on utility model registration * Enlargement of allowable range of correction to utility model registration | * Prohibition of amendment changing special technical feature of invention * Easing of timing restriction for divisional applications * Prevention of abuse of divisional application system * Extension of period for submission of translations of foreign language document application | * Extension of period for filing request for appeal against examiner's decision of refusal | * Revision of provision concerning exceptions to loss of novelty of invention * Revision of provision concerning usurped application as prior application | * Introduction of system of reference filing | * Revision of provision concerning exceptions to loss of novelty of invention | |
| Outline of Examination | Part I Outline of Examination (*) Statements on the Examination Guidelines after Part II shall be according to the following Timing of Application. | | | | | | | | | | | | |
| Description and Claims | Part II Chapter 1 Requirements for Description | | | | | | | | | | | | |
| | | | | | | Part II Chapter 1 Section 3 Requirements for Disclosure of Information on Prior Art Documents | | | | | | | |
| | Part II Chapter 2 Requirements for Claims | | | | | | | | | | | | |
| | Former Examination Guidelines Part I Chapter 2 Requirements of Unity of Application | | | | | | Part II Chapter 3 Unity of Invention | | | | | | |
| Patentability | Part III Patentability | | | | | | | | | | | | |
| Amendments of Description, Claims or Drawings | Former Examination Guidelines Part III Amendments of Description, etc. | | Part IV Amendments of Description, Claims or Drawings | | | | | | | | | | |
| | | | | | | | | | Part IV Chapter 3 Amendment Changing Special Technical Feature of Invention | | | | |
| Priority | Part V Priority | | | | | | | | | | | | |
| Special Application | Examination Guidelines for Each Industry Division of Application (Revised) | | Part VI Chapter 1 Division of Patent Application | | | | | | | | | | |
| | | | | | | | | | Part VI Chapter 1 Section 2 Notice under Article 50bis | | | | |
| | Part VI Chapter 2 Conversion of Application | | | | | | | | | | | | |
| | | | | | | | | | | | Part VI Chapter 3 Patent Application Based on Utility Model Registration | | Part VI Chapter 4 Reference filing |
| Foreign Language Written Application | | | Part VII Foreign Language Written Application | | | | | | | | | | |
| International Patent Application | | | Part VIII International Patent Application | | | | | | | | | | |
| Extension of Patent Term | Part IX Extension of Patent Term | | | | | | | | | | | | |
| Utility Model | (Substantially the same guidelines as those for patent applications) | | Part X Utility Model | | | | | | | | | | |
| Application examples of the specific technical fields | Examination Handbook Annex B Chapter 1 Computer software related Inventions | | | | | | | | | | | | |
| | | | | Portions related to "storage medium" claims, "2.1 Eligibility for Patent" (applications filed on or after Apr. 1, 1997) | | | | | | | | | |
| | | | | Portions related to "program" claims (applications filed on or after Jan. 10, 2001) | | | | | | | | | |
| | Examination Handbook Annex B Chapter 2 Biological Inventions | | | | | | | | | | | | |
| | Examination Handbook Annex B Chapter 3 Medicinal Inventions | | | | | | | | | | | | |

The "Examination Guidelines for Patent and Utility Model" is in principle applicable to applications filed on or after July 1, 1995. However, the portions added or modified as a result of subsequent revision made to the Act, changes to examination practice, and the like may only be applicable to a limited range of patent applications. In addition, subsequent revisions and changes may be associated with clarification of the previous interpretations and practices, revised provision and changed practices will also serve as reference information in interpretation of handling of applications filed prior to the Act 1994 entering into force.

Table 2: Timing of Application of the reasons for refusal and the reason for dismissal of the amendment relating to the Examination Guidelines

| Act | | 1990 Act | 1993 Act | 1994 Act | 1998 Act | 1999 Act | 2002 Act | 2003 Act | 2004 Act | 2006 Act | 2011 Act | |
|---------------------------------------|---|---|--|--|---|---|---|--|--|---|---|--|
| Effective date | | From Dec. 1, 1990 | From Jan. 1, 1994 | From Jul. 1, 1995 | From Jan. 1, 1999 | From Jan. 1, 2000 | From Sep. 1, 2002 | From Jan. 1, 2004 | From Apr. 1, 2005 | From Apr. 1, 2007 | From Apr. 1, 2012 | |
| Reason for refusal | Requirements for Description | Enablement Requirement | Article 36(4) | | | | Article 36(4)(i) (*9) | | | | | |
| | | Ministerial Ordinance Requirement | | | | | | | | | | |
| | | Requirements for Disclosure of Information on Prior Art Documents | | | | | Article 36(4)(ii) (*9) | | | | | |
| | Description Requirements of Claims | Support Requirement | Article 36(5)(i), (6) | | Article 36(6)(i) (*4) | | | | | | | |
| | | Clarity Requirement | Article 36(5)(ii), (6) | | Article 36(6)(ii) (*4) | | | | | | | |
| | | Conciseness Requirement | | | Article 36(6)(iii) (*4) | | | | | | | |
| | | Ministerial Ordinance Requirement on Statement of Claims | Article 36(5)(iii), (6) | | Article 36(6)(iv) (*4) | | | | | | | |
| | Unity of Invention | Article 37 | | | | (*10) | | | | | | |
| | Eligibility for Patent and Industrial Applicability | Article 29(1) main paragraph | | | | | | | | | | |
| | Novelty | Article 29(1) | | | | (*8) | | | | | | |
| Inventive Step | Article 29(2) | | | | (*8) | | | | | | | |
| Secret Prior Art | Article 29bis | | (*1) | | | | | | | | | |
| Prior Application | Article 39(1)-(4) | | | | (*7) | | | (*11) | | (*13) | | |
| Category of Unpatentable Invention | Article 32 | | | | (*5) | | | | | | | |
| Reason for dismissal of the amendment | Amendment Adding New Matter | | | Article 17(2) (including Article 17bis(2)) (*2) | | Article 17bis(3) (*6) | | | | | | |
| | Amendment Changing Special Technical Feature of Invention | | | | | Article 17bis(4) (*12) | | | | | | |
| | Amendment for other than the Prescribed Purposes | Deletion of a claim | | | Article 17bis(3)(i) (*3) | | Article 17bis(4)(i) | | Article 17bis(5)(i) (*12) | | | |
| | | Restriction in a limited way of the claims | | | Article 17bis(3)(ii) (*3) | | Article 17bis(4)(ii) | | Article 17bis(5)(ii) (*12) | | | |
| | | Correction of errors | | | Article 17bis(3)(iii) (*3) | | Article 17bis(4)(iii) | | Article 17bis(5)(iii) (*12) | | | |
| | | Clarification of an ambiguous statement | | | Article 17bis(3)(iv) (*3) | | Article 17bis(4)(iv) | | Article 17bis(5)(iv) (*12) | | | |
| | Requirement of independent patentability | | | Article 17bis(4), Article 126(3) (*3) | | Article 17bis(5), Article 126(5) | | Article 17bis(6), Article 126(7) (*12) | | | | |
| Reason for refusal | Foreign Language Written Application | New Matter beyond the Original Text | | | | | Article 17bis(3) (*6) | | | | | |
| | | New Matter beyond Translation | | | | | Article 49(v) (*6) | | | | | |
| Points of law revision | | Introduction of abstract | (*1) Application for utility model registration for which Utility Model Gazette has been issued serves as the basis for the prior-art effect as a result of abolition of publication of examined application and publication of unexamined application for utility model registration system. (*2) Improvement of scope of amendments (new matter) (*3) Incorporation of system of first notice of reasons for refusal and final notice of reasons for refusal | (*4) Easing of description requirements for description (*5) Reducing and decreasing of subject of unpatentable ground (atomic nucleus transformation material) (retroactively applied) (*6) Incorporation of system of foreign language application | (*7) Application waived and application for which examiner's decision of refusal became final and binding no more serve as prior application in the meaning of § 39(5). | (*8) Addition to the ground of refusal of novelty, of the inventions which have been publicly known or publicly worked in foreign country, and which have been made available to public through electrical communication lines. | (*9) Introduction of system of disclosure of information of prior art documents | (*10) Revision of unity of invention | (*11) Article 39(4) was revised in response to introduction of system of patent application based on utility model registration, so that application can be filed for invention identical with device of utility model registration. | (*12) Incorporation of system prohibiting amendment changing special technical feature of invention | (*13) Article 39(6) is deleted, so that usurped application also serves as prior application. | |

Chapter 2 Procedures of Examination

1201 Prior Art Searches by Registered Search Organizations

1. Overview

The "prior art searches by registered search organizations" is an investigation work aimed at making the registered search organizations preliminarily investigate a part of prior art searches to be conducted by the examiner to speed up the examination.

This investigation work is based on provision of Article 36 of the Act on the Special Provisions to the Procedure, etc. concerning Industrial Property Rights (Act No. 30 of 1990), and the registered search organizations that can work this investigation work must be registered for each investigation work section (sections 1-39) (provided in Article 56 of Regulations under the same act) on the basis of the provision of Article 37 of the same act.

2. Scope of prior art searches by registered search organizations

The scope of prior art searches by the registered search organizations, in many cases, covers foreign patent documents, as well as domestic patent documents. In some fields, non-patent literatures may be also investigated by using STN etc.

3. Report for prior art searches by registered search organizations

The prior art searches by the registered search organizations are reported by a direct interview between the searcher and the examiner, and by receiving oral explanation about application concerned technical contents, retrieval policy, retrieval results, and technical contents of shown documents.

In addition, "online dialogue" for an interview via a Web conference system or a television conference system has been available.

4. Security management for retrieval report

Retrieval reports which have been already delivered can be in public perusal by Japan Platform for Patent Information (J-PlatPat).

Since the retrieval report remains unpublished information until it becomes in public perusal by J-PlatPat, the examiner needs to manage it appropriately within the JPO to prevent leaks.

5. Estimation by examiner

The examiner estimates the results of the prior art searches by the registered search organizations by using an estimation form.

Estimation results are fed back to each registered search organization.

1202 Submission of information to Patent Applications

The submission of information by third parties to patent application, provided in Article 13bis of the Regulations under the Patent Act, enables provision of information about that the invention claimed in the patent application has no novelty nor inventive step, and the like, to the patent application pending in the Patent Office. Hereinafter, practical operations of the submission of information to patent application, provided in Article 13bis of the Regulations under the Patent Act, are described.

After granting a patent, the submission of information under Article 13ter of the Regulations under the Patent Act is possible. In addition, also to the application for a utility model registration and a utility model registration, the submission of information under Article 22 of the Regulations under the Utility Model Act and Article 22bis of the Regulations under the Utility Model Act is possible.

(Reference) Japan Patent Office Web site "About the Submission of Information by Third Parties"

http://www.jpo.go.jp/seido/s_tokkyo/tt1210-037_sanko2.htm

1. Information provider

Anyone can submit information.

Entry of a name, etc. in a column of [Provider] can be omitted. In this case, "omitted" should be stated in columns of [Address or Residential Address] and [Name] (Refer to Form 20 Note 5 of Regulations under the Patent Act).

2. Subject of submission of information

The submission of information under Article 13bis of the Regulations under the Patent Act can be conducted only to the patent application pending in the Patent Office. For patent applications not pending in the Patent Office (For example, patent applications for which decision of refusal has become final, patent applications that have been abandoned, dismissed, or declined, or patent applications for which establishment of patent right has been registered), submission of information under Article 13bis of the Regulations under the Patent Act cannot be conducted. Presence or absence of a request for examination is not regarded.

3. Information that can be submitted

(1) Information that a patent shall not be granted for the claimed invention of the subject

application according to the provisions of respective items of Article 29(1) of the Patent Act (Novelty) (including information related to a distributed publication or information that were made publicly available through an electric telecommunication line, and information based on a publicly known invention or an official invention)

- (2) Information that a patent shall not be granted for the claimed invention of the subject application according to Article 29(2) of the Patent Act (Inventive step)
- (3) Information that a patent shall not be granted for the claimed invention of the subject application according to the provision of Article 29bis of the Patent Act (Secret prior art)
- (4) Information that a patent shall not be granted for the claimed invention of the subject application according to the provisions of Article 39(1) to (4) of the Patent Act (Prior application)
- (5) Information that the claimed invention of the subject application is not an invention of the main paragraph in Article 29(1) of the Patent Act or an industrially applicable invention
- (6) Information that the subject application does not satisfy the description requirements provided in Article 36(4) or (6) of the Patent Act (excluding information related to Article 36(6)(iv) of the same Act)
- (7) Information that the amendments of description, claims or drawings, attached to the request of the subject application do not satisfy the requirements provided in Article 17bis(3) of the Patent Act (including new matter) (not including information related to the new matter beyond the translation text in applications in foreign language and foreign language patent applications, etc. (including international applications recognized as patent applications and written by foreign language. The same shall apply hereinafter.))
- (8) Information that matters stated in description, claims or drawings attached to a request for application in foreign language are not within a range of matters stated in the original language text (including new matter as to the original text)
- (9) Information that matters stated in description, claims or drawings attached to a request for foreign language patent application, etc. are not within a range of matters

stated in description, claims or drawings on the international filing date, etc. (including the constructive international filing date) (foreign language patent application, etc. including new matter as to the original text)

(Points to Note) The submission of information cannot be conducted with respect to the reasons for refusal under Article 17bis(4) of the Patent Act (Amendment that Changes a Special Technical Feature of an Invention), Article 25 (Enjoyment of Foreign applicant's rights), Article 32 (Unpatentable Ground), Article 36(6)(iv) (Ministerial ordinance requirement for claims), Article 37 (Unity of invention), Article 38 (Joint application), Article 49(iii) (Violation of Treaty), Article 49(vii) (Usurped Application), and to new matter beyond the translation text under Article 17bis(iii) related to applications in foreign language and foreign language patent applications, etc. (including a case where the wording of a phrase is changed with Article 184duodecies(2) and a case where mutatis mutandis is applied with Article 184vicies(6)).

4. Materials that can be submitted

The information provider can submit "documents" for the purpose of certifying that the information that he/she intends to submit is right. The "documents" that can be submitted include publications, a copy of descriptions, claims of the patent or utility models registration or drawings, attached to a request for a patent application or an application for a utility model registration, and certificate such as experimental report. Objects not applicable to the "document", such as a videotape recording an operation of a device, cannot be submitted.

Cases where "documents" other than publications, a copy of descriptions, claims or drawings of the patent or utility model registration, attached to a request for a patent application or an application for a utility model registration, are submitted are described below.

(1) Cases where information that the claimed invention of the subject application is an invention that was made publicly available through an electric telecommunication line is provided, and contents of electronic technical information on the Internet and the like, indicating that the invention was made publicly available through an electric telecommunication line prior to the filing are printed out and submitted

In this case, the submitted printout of information is required to include an address where the information is acquired and contact info for inquiries related to the information together with contents of the information, indication of a published date of the information. At that time, it is preferred that certificate by a person having

authority or responsibility for its publication, preservation, and the like is attached with respect to the information. (See 3.1.2 in "Part III Chapter 2 Section 3 Procedure of Determining Novelty and Inventive Step" of "Examination Guidelines")

- (2) Cases where information that the claimed invention of the subject application is the publicly known invention is provided, and a manuscript for a lecture or the like showing that the invention is explained in a lecture or an explanatory meeting or the like prior to the filing is submitted
- (3) Cases where information that the claimed invention of the subject application is the publicly worked invention is provided, and a document that states a mechanical apparatus, system, and the like related to the invention worked in a situation that is or may be publicly known prior to the filing is submitted
- (4) Cases where information that no detailed description of the invention is stated so that a person skilled in the art can work the claimed invention of the subject application, and an experimental report or the like for explaining it is submitted
- (5) Cases where information that matters described in description, claims or drawings attached to a request of the subject application are not in a range of matters described in an original language text (including new matter as to the original text), and for the purpose of explaining it, certificate that describes proper translation of the corresponding part and, if needed, a copy of a technical term dictionary or the like for clarifying that the description of description, claims or drawings is mistranslated is submitted
- (6) Cases where, when the subject application includes description for specifying a product by an action, a function, characteristics, or properties, information that claims of the subject application goes against Article 36(6)(ii) because the action, characteristics, and the like are not commonly used by a person skilled in the art, and its definition or its test/measurement process cannot be understood by a person skilled in the art, or that the claimed invention is an invention disclosed in a publication distributed prior to the filing, and an experimental report or the like is submitted for the purpose of explaining it

5. Dealing with the submitted information

The examiner confirms the contents of the provided information basically, and

utilizes it effectively in examination.

6. Dealing with a case where the submitted material is a document other than a copy of descriptions, claims or drawing of a patent or utility model registration attached to a request for a patent application or an application for utility models registration, or publications

Only when existence of a fact to be certificated by the submitted document is convinced without an examination of evidence (an examination of a witness, an inspection, an examination of a party concerned, an expert testimony and a documentary evidence) for the provided information and the submitted material, the document is adopted to examine the presence or absence of the reasons for refusal. In a case where it is recognized that there are the reasons of refusal, the examiner notifies the reasons of refusal.

In a case where the applicant opposes to the existence of the fact by means of a written opinion and the like to a notice of reasons for refusal, and where it is recognized that an examination of evidence is required for judging that decision of refusal is just due to the reasons for refusal on the ground of the fact found on the basis of the submitted document, the examiner does not make decision of refusal on the ground of the reasons for refusal.

(Explanation)

According to the Patent Act, because there is no provision of examination of evidence in examination of patent application, it is interpreted that the examination of evidence cannot be conducted in examination of patent application. Accordingly, even in a case where examination of patent application is conducted on the basis of the provided information and submitted material in the submission of information by third parties, the examiner does not make examination of evidence. Therefore, in a case where conviction about the existence of the fact to be certificated by the submitted material cannot be formed unless the examination of evidence for the submitted material is conducted, and therefore, conviction that there are the reasons for refusal cannot be formed, the examiner cannot adopt the submitted material to issue a notice of reasons for refusal.

On the other hand, the examination of application takes a principle of examination of evidence by *ex officio*, and existence or non-existence of the reasons for refusal is *ex-officio* investigation matters. Therefore, in a case where information is submitted, the examiner is required to make examination within a range of *ex-officio* detection that is normally conducted in the examination of patent applications. Accordingly, in a case where conviction that there are reasons of refusal can be formed without examination of evidence on the basis of the provided

information and the submitted material, it is proper that the examiner issues a notice of reasons for refusal based on above matter, from a view point of stable grant of right.

Here, even in a case where a notice of reasons for refusal based on the submission of information is issued, similar to a case of the ordinary notice of reasons for refusal, the examiner is required to examine again whether or not the decision of refusal is proper on the basis of the reasons for refusal in consideration of subsequent counterargument of the applicant. In a case where it is recognized that conviction formation by examination of evidence is required for proper decision of refusal as a result of the consideration of the counterargument of the applicant, and the like, conducting the decision of refusal without examination of evidence is not proper. However, because the examination of evidence cannot be conducted in examination of the patent application, in the final analysis, the examiner cannot make the decision of refusal in the above case.

It goes without saying that the examination similar to the examination of evidence within a range of ex officio detection normally conducted in the examination of patent applications, such as inquiry to the National Diet Library about reception date of the publications, and inquiries to government and municipal offices about truth or falsehood of official documents, and the like, can be conducted.

7. Feedback to information provider

The examiner feeds back a utilization situation of the provided information at the information provider's wish (a wish of feedback is stated in a column of [Reasons for Submission] of an information statement).

The Examiner describes required matters in the following Form for preparing feedback about submission of information, and signs the name of the Examiner, and then, submits it to the Coordination Division. The Coordination Division scans an image as an internal document, and then, mails it in sealed covers.

(Points to Note at Entry)

- (1) An address and a name of the information provider (or of a representative if exists) are described in a destination column.
- (2) In a case where an address and a name are omitted and an identification number is stated in the information statement, the address and the name are looked up from the identification number and entered. In this case, the address and the name can be confirmed by inputting the identification number from "Work Common Menu"→"Inquiry Work"→"Requester Registration Inquiry".

Form for Preparing Feedback about Submission of Information

To:

↵

Notice to Submission of Information

Date Created: ↵

↵

Examiner (Signature) Author Code

↵

Thank you for your submission of information to Japanese Patent Application
No. (JP - A) . As a result of consideration, the provided
information is utilized for examination.

↵

Remarks

↵

↵

↵

↵

(* The above "utilized for examination" means that the information is
utilized when the examiner prepares a notice of reasons for refusal, a
decision of dismissal of amendment, reconsideration reports made to the JPO
Commissioner in the procedure of reconsideration by examiners before
appeal proceedings, etc.

↵

8. Notification to the applicant

The patent applicant is notified of the fact that information is submitted.

9. Public perusal of the submitted information

The submitted information is made available for public perusal. Information
submitted to an electronic application and that is suitable for being transformed into
electronic data is submitted for public perusal as an electronized document.

10. Opportunities of clarification, interview, and the like for the information provider,
related to the information

Since the information provider is not a party concerned in examination of the

patent application, it is not recognized that the examiner and the information provider contact each other by an interview and the like for the purpose of clarification related to the information, explanation about propriety of patent for the subject application, and the like. In addition, the information submitter cannot be a person whom the examiner demands submission of the document and the like, according to Article 194(1) of the Patent Act.

11. Dealing with information that becomes available for examiner after final decision

Even for information submitted before the registration of establishment of patent right, the examiner does not take into account information that becomes available for the examiner after the decision to grant a patent. In addition, even for information submitted before decision of refusal is fixed, the examiner does not take into account the submission of information that becomes available for the examiner after decision of refusal (However, this rule does not apply to a case of pendency to reconsideration by examiners before appeal proceedings after the information becomes available for the examiner).

1203 Examination When Utilizing the Search Result, etc. of Foreign Patent Office and Registered Search Organizations

When utilizing the search result or examination result of foreign patent office or the search result of registered search organizations (hereinafter referred to as the "search result, etc. of foreign patent office or registered search organizations"), if determining, based on the examiner's knowledge and experience, that the examiner can make examination appropriately and effectively according to the search result, etc. of foreign patent office or registered search organizations, the examiner is not required to make prior art search. When making prior art search additionally, the examiner is required to exclude the scope of the search made by the foreign patent office or registered search organizations from the scope of search, unless it is highly possible that more significant prior art documents would be found within the scope of the search made by the foreign patent office or registered search organizations.

1204 Record of Search Results of Prior Art Documents

1. Technical field(s) to be searched

When a reason for refusal is to be notified after first prior art search, the technical field(s) to be searched (stated in accordance with the international patent classification, etc.) should be stated in the "Record of the search results of prior art documents" section.

(See 3.2 in "Part I Chapter 2 Section 2 Prior Art Search and Determination of Novelty, Inventive step, etc." of the Examination Guidelines)

- (1) The "Technical Field(s) to be searched" is generally stated in accordance with the International Patent Classification (IPC).
- (2) Where the prior art has been searched in the course of the examination, the relevant "Technical Field(s) to be searched" should be stated even when any cited document or prior art document to be stated was not found.
- (3) Where commercial database was used and information considered to be useful for the applicant, etc. has been found, the name of the commercial database is to be stated (e.g., CA (STN)).
- (4) IPC codes do not need to be stated for technical fields for which search is conducted using only international universal commercial database and it is difficult to state the "Technical Field(s) to be searched" using the IPC codes.

2. Prior art document(s)

When there is prior art that does not constitute the reasons for refusal but is considered to be useful for amendment by an applicant, etc., information on the documents can also be stated in the record.(See 3.2 in "Part I Chapter 2 Section 2 Prior Art Search and Determination of Novelty, Inventive step, etc." of the Examination Guidelines)

3. Request for applicant (this is only stated when the following conditions are satisfied.)

When any document satisfying both of the following conditions (1) and (2) has been found as a result of the prior art search and any reason for refusal under Article 29(1)(iii) or 29(2) of the Patent Act is to be notified on the basis of this document, the request for the applicant is to be stated (Note 1 and 2).

- (1) The document is made public prior to filing of the patent application concerned and the document is created by the same applicant or the invention of the document is invented by the same inventor as those of the application concerned (Note 3 and 4); and
- (2) Novelty or inventive step of at least one claim of the invention concerned can be denied solely relying upon the single document (i.e., a document that corresponds to X-category document of an international search report under the Patent Cooperation Treaty).

(Note 1) This request is not to be made when a notice of reason for refusal under Article 29(2) of the Patent Act is to be rendered on the basis of combination of documents, or when a notice of reason for refusal under Article 39 is to be rendered.

(Note 2) This request is to be made even when this document is disclosed as prior art document in the description.

(Note 3) This includes a case where some of the applicants or inventors are the same as those of the application concerned. The request does not need to be made where the bibliographical information associated with the applicant(s) and/or the inventor(s) does not match between the document and the application concerned.

(Note 4) This includes information made publicly available through an electric telecommunication line.

Notice of Reason for Refusal

Application Number JP XXXX-XXXXXX
 Drafting Date (YY/MM/DD)
 Examiner in Charge (examiner's name) XXXX XX
 Patent Attorney (attorney's name)
 Article(s) Applied Article 29(1)

This application should be refused for the following reasons. If having any opinion on the refusal, the applicant may submit the written opinion within sixty (60) days from the sending of the notice.

Reason

(Novelty) The invention(s) defined in the following claim(s) of this application is/are disclosed in the publication(s) listed below, which was/were distributed in Japan or in a foreign country, or made available to the public through electric telecommunication line prior to filing of this application, and thus unpatentable under Article 29(1)(iii) of the Patent Act.

Notes (Regarding cited documents etc., see the list thereof shown below.)

- Claim 1
- Cited Document 1
- Remark

<List of Cited Documents, etc.>

1. JP SXX-XXXXXXA

<Record of the search results of prior art documents>

- Technical field(s) to be searched IPC B43K 8/00 to 8/24
 Database Name
- Prior art document(s) JP HXX-XXXXXX
 (The point "B" stated in paragraph xxxx, line xx of the description in the detailed description of the invention of this application is stated in page xx, column xx, line xx of this document.)

· Request to Applicant
 The cited document 1 is made public prior to filing of this application, whose applicant or inventor also appears as the applicant or inventor of the cited document, and this cited document alone and without combination with any other document(s) provides the basis for denying novelty or inventive step of at least one claim of this application.

Appropriate evaluation of the claimed invention in advance based on such a document will contribute to appropriate creation of claims by Applicant and lead to prompt and precise examination. It is requested that such a document known to Applicant be disclosed in the description at the time of filing of the application or the request for examination and that appropriate evaluation be made as to whether or not the invention for which a patent is sought has patentability in view of such a document.

This record of the result of prior art search is not a component of the reason(s) for refusal.

For any question or interview request regarding this notice of reason for refusal, please contact:
 Examination Department of X XX Division The name of examiner
 Tel: 03-3581-1101 ext. xxxx
 Fax: 03-xxxx-xxxx

1205 Patent Application to be Refused

A patent application shall be refused where it falls under any one of the following (Article 49) (See Table. 2 in 1101 of this Examination Handbook, concerning the List of reasons for refusal related to the Examination Guidelines).

[Reasons according to Article 49(i)]

1. Amendment adding new matter

This is a case where the amendment of the description, claims or drawings originally attached to the application does not comply with requirement as provided for in Article 17bis (3) of the Patent Act.

(This is applicable to applications filed on or after July 1, 1995. It should be noted that Article 17 (2) of the Act as revised in 1993 (including the cases where it is applied mutatis mutandis pursuant to Article 17bis (2)) is applied to applications filed from January 1, 1994 to June 30, 1995.)

2. Amendment changing special technical feature of an invention

This is a case where the amendment made to the claims does not comply with the requirements as provided for in Article 17bis (4) of the Patent Act.

(This is applicable to applications filed on or after April 1, 2007.)

[Reasons according to Article 49(ii)]

3. Enjoyment of rights by foreign nationals

This is a case where the applicant is a foreign national not domiciled or resident (or, in the case of a juridical person, with a business office) in Japan and may not enjoy a patent right under provisions of Article 25 of the Patent Act.

4. Eligibility for Patent

This is a case where the claimed invention is not an invention as defined in the first sentence of Article 29(1) of the Patent Act.

5. Industrial Applicability

This is a case where the claimed invention is not an industrially applicable

invention as defined in the first sentence of Article 29(1) of the Patent Act.

6. Novelty

This is a case where the claimed invention is not an invention that has novelty as provided for in each of the items of Article 29(1) of the Patent Act.

(With regard to applications filed on or after January 1, 2000, a reason for refusal is also raised against an invention publicly known in a foreign country (item (i)), publicly worked in a foreign country (item (ii)), or made publicly available through an electric telecommunication line (item (iii)).)

7. Inventive step

This is a case where the claimed invention is an invention that does not have an inventive step under Article 29(2) of the Patent Act.

8. Secret prior art

This is a case where the claimed invention is an unpatentable invention under the provisions of Article 29bis.

(With regard to applications filed on or after July 1, 1995, the range of matters stated in the foreign language document has the prior-art effect under this article with respect to a foreign language written application. Likewise, the range of matters stated in the description, etc. of the international application as of the international filing date has the prior-art effect under this article with respect to a patent application in foreign language under the Patent Cooperation Treaty (only those for which translations of the description and claims are submitted).

9. Unpatentable ground

This is a case where the claimed invention falls under Article 32.

10. Joint application

This is a case where the right to obtain a patent is jointly owned but the patent application is not filed by all the joint owners (Article 38).

11. Prior application

(1) Between patent applications filed on different dates

This is a case where two or more patent applications claiming identical inventions have been filed on different dates (including a case where they are filed by the same applicant) and the patent application concerned is not the one that has been filed on the earliest date (Article 39(1)) shall be not entitled to obtain a patent for the invention claimed.

(2) Between patent applications filed on the same date

This is a case where two or more patent applications claiming identical inventions have been filed on the same date (including a case where they are filed by the same applicant) and no agreement is reached by consultations or consultations are unable to be held by the applicants (Article 39(2)).

(3) Patent application and application for utility model registration filed on different dates

This is a case where an invention claimed in a patent application and a device claimed in an application for utility model registration are identical and the patent applications and the utility model registration are filed on different dates (including a case where they are filed by the same applicant), and the patent application is filed after the application for utility model registration (Article 39(3)).

(4) Patent application and application for utility model registration filed on the same date

This is a case where an invention claimed in a patent application and a device claimed in an application for utility model registration filed on the same date are identical (including a case where they are filed by the same applicant) and no agreement is reached by consultations or consultations are unable to be held by the applicants (Article 39(4)).

(Where examination is conducted for an application filed on or after January 1, 1999, applications waived and applications for which the examiner's decision or trial decision to the effect that a patent application is to be refused, in addition to applications withdrawn or dismissed, are deemed never to have been filed in the application of the first-to-file rule, and thus these applications are not treated as prior applications. However, as an exception to this rule, the following applications are treated as the prior application in the application of the first-to-file rule (in

other words, they retain the status of prior application): applications for which the examiner's decision or trial decision to the effect that the patent application is to be refused has become final and binding because of the failure to reach an agreement for applications of the same invention on the same date (Article 39(5))

Also, with regard to applications filed on or after April 1, 2012, a usurped patent application also has the status of a prior application under the first-to-file rule.)

[Reason according to Article 49(iii)]

12. Violation of treaty

This is a case where the claimed invention is not patentable under the provisions of any relevant treaty.

[Reasons according to Article 49(iv)]

13. Description requirement

This is a case where the patent application does not comply with the requirements for claims and description, etc. as provided for in Article 36(4)(i) or Article 36(6).

14. Unity of invention

This is a case where the patent application does not comply with the requirement under Article 37 of the Patent Act.

(With regard to applications filed on or after January 1, 2004, the provision of the unity of invention has been revised to be in line with the unity of invention under the Patent Cooperation Treaty.)

[Reason according to Article 49(v)]

15. Requirements for disclosure of information on prior art documents

This is a case where the notice under Article 48septies has been given but the patent application yet fails to comply with the requirement under Article 36(4)(ii) in spite of an amendment made to the description or submission of a written opinion.

[Reason according to Article 49(vi)]

16. New matters to beyond translation

This is a case where the patent application is a foreign language written application and the matters stated in the description, etc. originally attached to the application is not within the scope of matters stated in the foreign language documents.

This also applies to a case where the claimed invention is a patent application in foreign language, etc. and the matters stated in the description, etc. originally attached to the written application for the patent application do not remain within the scope of matters stated in the description, etc. of the international application as of the international filing date (184octodecies).

[Reason according to Article 49(vii)]

17. Usurped patent application

This is a case where the applicant for the patent does not have the right to obtain a patent for the invention.

See the Examination Guidelines, etc. for applicability of the above laws and regulations (See Table. 1 in 1101 of this Examination Handbook, concerning the timing of the application of the Examination Guidelines).

1206 Specification of the Claim in which the Reasons for Refusal Have Not Been Found

In cases where the examiner issues the notice of reasons for refusal concerning the application including the claim in which the reasons for refusal have not been found, the examiner specifies the claim in which the reasons for refusal have not been found, in the following manner.

1. Basic ideas

The specification of the claim in which the reasons for refusal have not been found is made, in order to express more clearly, the intention of the examiner for such claims and to make it easy for the applicant to treat (especially, treatment by means of deletion of those other than such claims) the notice of reasons for refusal.

In accordance with above purpose, in cases where, if the claim is only stated in claims, the examiner has not found the reasons for refusal at this point, such claim is considered as "the claim in which the reasons for refusal have not been found." That is, in cases where the reasons for refusal at the point can be resolved only by the amendment deleting that other than such claim, the examiner specifies the claim as "the claim in which the reasons for refusal have not been found."

2. Methods for describing the additional remark

The following example of sentence (beforehand described in examples of general sentences of Articles) is prepared in examples of general sentences of the peripheral systems for examination of patent and utility model. In () of "Claim ()" of the following example of sentence, the examiner adds number of claim in which the reasons for refusal have not been found.

If not describing the additional remark pertaining to the claim in which the reasons for refusal have not been found, the examiner deletes this example of sentence.

(Example of sentence)

<The claim in which the reasons for refusal have not been found>

Concerning the invention pertaining to Claim (), at this point, the reasons for refusal have not been found. In cases where the reasons for refusal are newly found, the reasons for refusal will be notified.

3. Examples

[Case 1] (Cases where there is lack of inventive step in part of claims)

There are two claims. The lack of inventive step has been found in Claim 1, but the other reasons for refusal have not been found in Claim 1.

[Handling of the additional remark]

It falls under the cases where, if Claim 2 is only stated in claims, the reasons for refusal have not been found. Therefore, the examiner specifies Claim 2 as the claim in which the reasons for refusal have not been found.

[Case 2] (In case of violation on enablement requirements)

There are two claims. Enablement requirements are violated, but the other reasons for refusal have not been found.

[Handling of the additional remark]

If there is violation on enablement requirements concerning all claimed inventions (in this case, Claim 1 and Claim 2), regardless of whether either claim is independently stated, it falls under the cases where the reasons for refusal due to violation on enablement requirements exist. Therefore, the examiner does not specify the claim in which the reasons for refusal have not been found.

On the other hand, when the invention pertaining to Claim 1, for example, does not satisfy the enablement requirements, but the invention pertaining to Claim 2 satisfies the enablement requirements, it falls under the cases where, if Claim 2 is only stated in claims, the reasons for refusal have not been found. Therefore, the examiner specifies Claim 2 as the claim in which the reasons for refusal have not been found.

[Case 3] (Cases where new matters have been added)

There are two claims. New matters have been added to the description.

[Handling of the additional remark]

Since the reasons for refusal due to the addition of new matters beyond the description exist, regardless of whether either claim is independently stated in the claims, the examiner does not specify the claim in which the reasons for refusal have not been found.

Furthermore, when new matters have been only added to Claim 1 and new matters have not been added to Claim 2 and to the description, it falls under the cases where, if Claim 2 is only stated in claims, the reasons for refusal have not been found. Therefore, the examiner specifies Claim 2 as the claim in which the reasons for refusal have not been found.

[Case 4] (Cases where there is lack of unity and also there is lack of inventive step in part of claims)

There are three claims. The lack of unity exists between Claim 1, 2 and Claim 3. The reasons for refusal due to the lack of inventive step have been found in Claim 1. [Handling of the additional remark]

It falls under the cases where, if Claim 2 is only stated in claims, the reasons for refusal have not been found. Therefore, the examiner specifies Claim 2 as the claim in which the reasons for refusal have not been found.

Furthermore, the examiner states, in the statements of the reasons for refusal due to the lack of unity, the matter to the effect that Claim 3 has not been examined on novelty, etc. due to the lack of unity.

4. Points to note

(1) The additional remark is described in both the non-final notice of reasons for refusal and the final notice of reasons for refusal.

In view of the purpose of this policy of expressing clearly the intention of the examiner to the applicant or agent and making it easy for them to treat the notice of reasons for refusal, the examiner specifies, according to above manner, the claim in which the reasons for refusal have not been found in both the non-final notice of reasons for refusal and the final notice of reasons for refusal.

(2) Characteristics of the additional remark for specifying the claim in which the reasons for refusal have not been found

Examination Departments uniformly state, in the notice of reasons for refusal, the additional remark for specifying the claim in which the reasons for refusal have not been found, but such remark is not the reason for refusal and also does not constitute the matter to be stated which has legal effect.

When examining the cases with inconsistency between the claims specified in the additional remark and the statements of the reasons for refusal, the examiner takes appropriate measures for each individual case, in consideration of the statements of the notice of reasons for refusal or the applicant's assertion in the written opinion or the like.

When comprehensively determining on the applicant's assertion in the written opinion, etc., if it is clear that the applicant recognizes the correctness of the statements of the main text of the notice of reasons for refusal, the examiner proceeds with examination according to the statements of the main text of the notice of reasons for refusal. On the other hand, if it is not clear whether the applicant recognizes the correctness of the statements of the main text of the notice of reasons for refusal, the examiner takes appropriate measures, including re-issuance of the same effect of the notice of reasons for refusal, so as not to make a surprise attack on the applicant

concerning the reasons for refusal or the decision of refusal.

(3) Cases including the reasons for refusal which cannot be determined on a claim basis

To be specific, in cases where the reasons for refusal (Note) due to the errors in all the description or the addition of new matters or the like exist which cannot be determined on a claim basis, the examiner does not specify the claim in which the reasons for refusal have not been found.

(Note) See 4. in "Part I Chapter 2 Section 3 Notice of Reasons for Refusal" of the Examination Guidelines

(4) Points to note, concerning the claims in a form of citation

Concerning the claims in a form of citation, the examiner also determines whether the claims constitute the claim in which the reasons for refusal have not been found, according to "1. Basic ideas."

To be specific, it should be noted that, in cases where the reasons for refusal due to violation on clarity or due to the addition of new matters exist in the invention pertaining to the claims in an independent form, the similar reasons for refusal often exist in the claims in a form of citation.

5. Example of the Additional Remark in the Notice for Reasons for Refusal

See

| |
|----------------|
| Attached Sheet |
|----------------|

Notice of Reason for Refusal

Application Number JP XXXX-XXXXXXX
 Drafting Date (YY/MM/DD)
 Examiner in Charge (examiner's name) XXXX XX
 Patent Attorney (attorney's name)
 Article(s) Applied Article 29(1)

This application should be refused for the following reasons. If having any opinion on the refusal, the applicant may submit the written opinion within sixty (60) days from the sending of the notice.

Reason

(Inventive step) Since the following claimed invention in this application has been easily invented by a person skilled in the art to which the invention belongs before filing, based on the invention stated in the following publications issued in Japan or a foreign country or based on the invention made available to the public through electronic communication network before filing, the following claimed invention is not patented under Article 29(2) of the Patent Act.

Note (See list of the cited document, etc., concerning the cited document, etc.)

- Claim 1, 4
 - Cited Document 1, 2
 - Remark
- *****

The examiner specifies, by using the example of sentence, the claim in which the reasons for refusal have not been found.

<The claim in which the reasons for refusal have not been found>
 Concerning the inventions pertaining to Claim (2, 3, 5-7), at this point, the reasons for refusal have not been found. In cases where the reasons for refusal are newly found, the reasons for refusal will be notified.

<List of the cited document, etc.>

1. JP SXX-XXXXXXXA
2. JP HXX-XXXXXXXA

<Record of the result of prior art searches>

· Technical field(s) to be searched IPC B43K 8/00 to 8/24
 Database Name
 · Prior art document(s) JP HXX-XXXXXXX
 (The point "B" stated in paragraph xxxx, line xx of the description in the detailed description of the invention of this application is stated in page xx, column xx, line xx of this document.)
 · The prior art document JP HXX-XXXXXXX
 (The point "B" stated in paragraph xxxx, line xx of the description in the detailed description of the invention of this application is stated in page xx, column xx, line xx of this document.)

This record of the result of prior art search is not a component of the reason(s) for refusal.

For any question or interview request regarding this notice of reason for refusal, please contact:
 Examination Department of X XX Division The name of examiner
 Tel: 03-3581-1101 ext. xxxx
 Fax: 03-xxxx-xxxx

1207 Matters to Be Stated in the Publications, etc. Which is Cited in the Reasons for Refusal of the Patent Application

In cases where the examiner cites publications, etc. in the reasons for refusal of the patent application, a manner of statements concerning publications, etc. is as follows.

1. Publication of national patent application, utility model application, etc.¹ (Examples of statements)

(1) Case of the description of the patented invention or publication of registered utility model (issued before the year of 1956)

A. The description of Japanese Patent No. XXXXXXXX

B. Publication of Registered Utility Model No. XXXXXXXX

(2) Case of publication of registered utility model based on the new act of utility model which came into force on the date of 1 January, 1994

Publication of Registered Utility Model No. 3XXXXXXX

(3) Case of gazette containing the patent or utility model of the application of the decision to grant a patent or decision of registration which has made on or after the date of 1 January, 1996

A. Japanese Patent No. XXXXXXXX

B. Publication of Utility Model Registration No. XXXXXXXX

(4) Case of publication of examined patent application or utility model application (Publication of examined application)

A. Publication of Examined Patent Application S No. XX - XXXXXXXX

B. Publication of Examined Utility Model Application S No. XX - XXXXXXXX

C. Publication of Examined Patent Application H No. XX - XXXXXXXX

D. Publication of Examined Utility Model Application H No. XX - XXXXXXXX

However, in case of Publication of Examined Utility Application in 1922 and 1923

E. Publication of Examined Utility Model Application No. XXXXXXXX (Year of 1922)

F. Publication of Examined Utility Model Application No. XXXXXXXX (Year of 1923)

¹ Since all publications (including Publications of Registered Utility Model that have been issued on or after the date of 5 January, 2006 and Publications of Registered Design that have been issued on or after the date of 5 January, 2007) including patent, utility model, etc. issued on or after the date of 1 April, 2015 are issued by using internet, when citing such publications in the reasons for refusal, etc., the term “publication” is not used for such publications (the terms “citation,” “cited document,” etc. are used).

In case of Publication of Examined Utility Model during the period of Taisyuu after the year of 1924,

G. Publication of Examined Utility Model Application No. XXXXXX in Taisyuu XX

(5) Case of publication of unexamined patent application or unexamined utility model application

A. JP SXX - XXXXXXXA

B. JP HXX - XXXXXXXA

C. JP 20XX - XXXXXXXA

D. JP SXX - XXXXXXXU (*)

E. JP HXX - XXXXXXXU (*)

F. JP 20XX - XXXXXXXU (*)

* Points to Note

Even if it is sufficient to cite only Publication of Unexamined Utility Model Applications, it is requested to cite full text of the description, including microfilm and CD-ROM, to the examiner's best ability (See below (7)), so that, afterward, the examiner is not required to notify the reasons of refusal again.

(6) In case of published Japanese translations of PCT international publication for patent application or utility model application

A. National Publication of International Patent Application S No. XX - XXXXXX

B. National Publication of International Patent Application H No. XX - XXXXXX

C. National Publication of International Patent Application No. 20XX - XXXXXX

D. National Publication of International Utility Model Application S No. XX - XXXXXX

E. National Publication of International Utility Model Application H No. XX - XXXXXX

F. National Publication of International Utility Model Application No. 20XX - XXXXXX

(7) Case of the description, etc. in full text of Japanese utility model applications based on the former act of utility model on or before the date of 31 December, 1993

<Issued on or before the date of 7 January, 1993>

Microfilm that records the contents of the description and drawings attached to the request of Japanese Utility Model Application H No. 02 - XXXXXX (JP H 03 - XXXXXXXU) (issued by Japanese Patent Office on the date of Xday Xmonth, 1991), or

Microfilm of Japanese Utility Model Application H No. 02 - XXXXXX (JP H03 - XXXXXXXU)

<Issued on or after the date of 8 January, 1993>

CD-ROM that stores the contents of the description and drawings originally attached to the request of Japanese Utility Model application H No. 05 - XXXXXX (JP H06 - XXXXXXU) (issued by Japanese Patent Office on the date of Xday Xmonth, 1994), or

CD-ROM of Japanese Utility Model Application H No. 05 - XXXXXX (JP H06 - XXXXXXU)

<Issued on or after the date of 8 January, 2004>

JP 2004 - XXXXXXU

(8) Case of design bulletin

Publication of Design Registration No. XXXXXXXX

2. The Description and the Abstract of the Description, etc., of the Patent Applications of Foreign and International Organizations (Examples of Statements)

(1) The International Bureau of the World Intellectual Property Organization

| The expression when citing in the reasons for refusal of the patent application | Types of documents |
|--|--------------------|
| International Publication No. WOXX/XXXXXX | (WO, A1) |
| International Publication No. WO20XX/XXXXXX ² | (WO, A2) |
| The Search Report of International Publication No. WOXX/XXXXXX The Search Report of International Publication No. WO20XX/XXXXXX | (WO, A3) |
| International Publication No. WOXX/XXXXXX(A4) International Publication No. WO20XX/XXXXXX(A4) | (WO, A4) |
| International Publication No. WOXX/XXXXXX(A8) International Publication No. WO20XX/XXXXXX(A8) | (WO, A8) |
| International Publication No. WOXX/XXXXXX(A9) International Publication No. WO20XX/XXXXXX(A9) | (WO, A9) |

(2) USA

| The expression when citing in the reasons for refusal of the patent application | Types of documents |
|---|--------------------|
| The description of US Publication of Unexamined Patent | (US, A1) |

² Since the international publications issued on or after the date of 1 April, 2006 have been issued by using internet, when citing such publications in the reasons for refusal, etc., the term “publication” is not used for such publications (the terms such as “citation,” “cited document” are used).

| | |
|--|---------------------------|
| Application No. 20XX/XXXXXX | |
| The description of US Patent No. XXXXXXXX | (US, A) (US, B1) (US, B2) |
| The description of US Reissued Patented Invention No. XXXXXXXX | (US, E) |
| The description of US Defense Application No. XXXXXXXX | (US, I4) |
| The description of US Plant Patented Invention No. XXXXXXXX | (US, P) |
| The description of US Design Patented Invention No. XXXXXXXX | (US, S) |

(3) European Patent Office

| | |
|---|--------------------|
| The expression when citing in the reasons for refusal of the patent application | Types of documents |
| The description of EP Publication of Unexamined Patent Application No. XXXXXXXX | (EP, A1) (EP, A2) |
| The Search Report of EP Publication of Unexamined Patent Application No. XXXXXXXX | (EP, A3) |
| The description of EP Patent No. XXXXXXXX | (EP, B1) |

(4) Germany³

| | |
|--|--------------------|
| The expression when citing in the reasons for refusal of the patent application | Types of documents |
| The description of DE Publication of Unexamined Patent Application No. XXXXXXXX | (DE, A) |
| The description of DE Publication of Unexamined Patent Application No. XXXXXXXXXXXXX | (DE, A1) |
| The description of DE Publication of Examined Patent Application No. XXXXXXXX | (DE, B) |
| The description of DE Patent No. XXXXXXXX | (DE, B) |
| The description of DE Utility Model No. XXXXXXXX | (DE, B) |
| The description of DE Publication of Examined Patent Application No. XXXXXXXX | (DE, B1) (DE, B2) |

³ In Germany, the “description of publication of unexamined application” is expressed by “Offenlegungsschrift,” the “description of publication of examined application” is expressed by “Auslegeschrift,” the “description of patent application” is expressed by “Patentschrift,” and the “description of utility model application” is expressed by “Gebrauchsmuster.”

| | |
|--|--|
| The description of DE Patented Invention No. XXXXXXXX ⁴ | (DE, C1) (DE, C2) (DE, C3) (DE, B3) |
| The description of DE Publication of Unexamined Utility Model Application No. XXXXXXXX | (DE, U) |
| The description of DE Utility Model No. XXXXXXXXXXXXX | (DE, U1) |
| The description of DD Economic Patent No. XXXXXX | (DD, A1) |

(5) Great Britain

| | |
|---|--------------------|
| The expression when citing in the reasons for refusal of the patent application | Types of documents |
| The description of GB Publication of Unexamined Patent Application No. XXXXXXXX *The number is not less than 2000001 | (GB, A) |
| The description of GB Publication of Examined Patent Application No. XXXXXXXX *The number is not more than 1605224 | (GB, A) |
| The description of GB Patent No. XXXXXXXX | (GB, B) |
| The description of GB Patent Amendment No. XXXXXXXX | (GB, C) |

(6) France

| | |
|---|--------------------------|
| The expression when citing in the reasons for refusal of the patent application | Types of documents |
| The description of FR Publication of Unexamined Patent Application No. XXXXXXXX | (FR, A1) |
| The description of FR Additional Publication of Unexamined Patent Application No. XXXXXXXX | (FR, A2) |
| The description of FR Publication of Unexamined Utility Model Certificate No. XXXXXXXX | (FR, A3) |
| The description of FR Additional Publication of Unexamined Utility Model Application No. XXXXXXXX | (FR, A4) |
| The description of FR Patented Invention No. | (FR, A) (FR, A5) (FR, B) |

⁴ When stating the “description of DE Patented Invention No. XXXXXXXX,” with regard to B3, it is necessary to list the number part in twelve (12) digits (in case of the digits less than twelve (12), make twelve digits by supplementing “0”), and with regard to C1 through C3, it is necessary to list the number part in eight (8) or less digits (same as the statements of publications).

| | |
|--|-------------------|
| XXXXXXXXXX | (FR, B1) |
| The description of FR Additional Patented Invention No. XXXXXXXXX | (FR, B2) |
| The description of FR Utility Model Certificate Patented Invention No. XXXXXXXXX | (FR, A7) (FR, B3) |
| The description of FR Additional Utility Model Certificate Patent No. XXXXXXXXX | (FR, B4) |
| The description of FR Pharmaceutical Special Patent No. XXXX | (FR, M) |

(7) China

| | |
|---|--------------------|
| The expression when citing in the reasons for refusal of the patent application | Types of documents |
| The description of CN Publication of Unexamined Patent Application No. XXXXXXXX | (CN, A) |
| The description of CN Patent No. 1XXXXXX *The number has first letter of "1" and is 7 or 9 digits | (CN, B) (CN, C) |
| The description of CN Utility Model No. XXXXXXXX *The number is 7 or less digits, or has first letter of "2" and is 9 digits | (CN, Y) |
| The description of CN Utility Model No. 2XXXXXXXXXX *The number has first letter of "2" and is 9 digits | (CN, U) |
| The description of CN Publication of Examined Patent Application No. XXXXXXXX *The number is 7 or less digits, or has first letter of "8" and is 8 digits | (CN, B) |
| The description of CN Publication of Examined Utility Model Application No. XXXXXXXX *The number is 7 or less digits, or has first letter of "8" and is 8 digits | (CN, U) |

(8) The Republic of Korea

| | |
|---|--------------------|
| The expression when citing in the reasons for refusal of the patent application | Types of documents |
| KR Publication of Unexamined Disclosed Patent Application No. 10-XXXX-XXXXXXXX | (KR, A) |

| | |
|--|----------|
| KR Publication of Unexamined Disclosed Patent Application No. XXXX-XXXXXXX | (KR, A) |
| KR Publication of Patent No. 10-XXXX-XXXXXXX | (KR, B1) |
| KR Publication of Registered Patent No. 10-XXXXXXX | (KR, B1) |
| KR Publication of Patent No. XXXX-XXXXXXX | (KR, B1) |
| KR Publication of Registered Patent No. XXXXXXXX | (KR, B1) |
| KR Publication of Unexamined Disclosed Utility Model Application No. 20-XXXX-XXXXXXX | (KR, U) |
| KR Publication of Unexamined Disclosed Utility Model Application No. XXXX-XXXXXXX | (KR, U) |
| KR Publication of Utility Model No. 20-XXXX-XXXXXXX | (KR, Y1) |
| KR Publication of Registered Utility Model No. 20-XXXXXXX | (KR, Y1) |
| KR Publication of Utility Model No. XXXX-XXXXXXX | (KR, Y1) |
| KR Publication of Registered Utility Model No. XXXXXXXX | (KR, Y1) |

(9) Switzerland

| | |
|--|-----------------------------------|
| The expression when citing in the reasons for refusal of the patent application | Types of documents |
| The description of CH Patented Invention No. XXXXXXXXX | (CH, A) (CH, A5) (CH, B) (CH, B5) |
| The description of CH Publication of Unexamined Patent Application No. XXXXXXXXX | (CH, A3) |
| The description of CH Publication of Examined Patent Application No. XXXXXXXXX | (CH, A4) |

(10) Taiwan

| | |
|---|--------------------|
| The expression when citing in the reasons for refusal of the patent application | Types of documents |
| TW Publication of Unexamined Patent Application No. XXXXXXXXXX | (TW, A) |
| TW Patent Publication No. XXXXXXXXXX | (TW, B) |

(11) Australia

| | |
|--|--------------------|
| The expression when citing in the reasons for refusal of | Types of documents |
|--|--------------------|

| | |
|---|------------------|
| the patent application | |
| The description of AU Publication of Unexamined Patent Application No. XXXXXXXXXXXX | (AU, A) (AU, A1) |
| The description of AU Publication of Examined Patent Application No. XXXXXXXXXXXX | (AU, B2) |

(12) Canada

| | |
|--|--------------------|
| The expression when citing in the reasons for refusal of the patent application | Types of documents |
| The description of CA Publication of Unexamined Patent Application No. XXXXXXXXX | (CA, A1) |
| The description of CA Patented Invention No. XXXXXXXXX | (CA, C) |

(13) The Netherland

| | |
|--|--------------------|
| The expression when citing in the reasons for refusal of the patent application | Types of documents |
| The description of NL Publication of Unexamined Patent Application No. XXXXXXXXX | (NL, A) |
| The description of NL Patented Invention No. XXXXXXXXX | (NL, C) |

(14) Austria

| | |
|---|--------------------|
| The expression when citing in the reasons for refusal of the patent application | Types of documents |
| The description of AT Patented Invention No. XXXXXXXXX | (AT, B) |
| The description of AT Utility Model No. XXXXXXXXX | (AT, U1) |

(15) Denmark

| | |
|---|--------------------|
| The expression when citing in the reasons for refusal of the patent application | Types of documents |
| The description of DK Patented Invention No. XXXXXXXXX | (DK, B1) |

(16) Sweden

| | |
|--|--------------------|
| The expression when citing in the reasons for refusal of | Types of documents |
|--|--------------------|

| | |
|---|----------|
| the patent application | |
| The description of SE Publication of Unexamined Patent Application No. XXXXXXXX | (SE, A) |
| The description of SE Patented Invention No. XXXXXXXX | (SE, C2) |

(17) Finland

| | |
|---|--------------------|
| The expression when citing in the reasons for refusal of the patent application | Types of documents |
| The description of FI Patented Invention No. XXXXXXXX | (FI, B) |

(18) The Czech Republic

| | |
|---|--------------------|
| The expression when citing in the reasons for refusal of the patent application | Types of documents |
| The description of CZ Patented Invention No. XXXXXXXX | (CZ, B6) |

(19) Russia (former Soviet Union)

| | |
|---|--------------------|
| The expression when citing in the reasons for refusal of the patent application | Types of documents |
| The description of SU Patented Invention No. XXXXXXXX | (SU, A) |
| The description of RU Publication of Unexamined Patent Application No. XXXXXXXX | (RU, A) |

(20) Belgium

| | |
|---|--------------------|
| The expression when citing in the reasons for refusal of the patent application | Types of documents |
| The description of BE Patented Invention No. XXXXXX | (BE, A) |

(21) Spain

| | |
|--|--------------------|
| The expression when citing in the reasons for refusal of the patent application | Types of documents |
| The description of ES Patent for Invention No. XXXXXXXX *The number is 6 digits, or has first letter of "8" and | (ES, A1) |

| | |
|--|----------|
| is 7 digits | |
| The description of ES Patent for Invention No. XXXXXXXX | (ES, A6) |
| The description of ES Publication of Unexamined Patent Application No. XXXXXXXX *The number is 7 digits and has search report | (ES, A1) |

(22) Poland

| | |
|---|--------------------|
| The expression when citing in the reasons for refusal of the patent application | Types of documents |
| The description of PL Patented Invention No. XXXXXXXX | (PL, B1) |

3. Journal of technical disclosure of JIII (the Japan Institute of Invention and Innovation) (Examples of statements)

- (1) Journal of Technical Disclosure of JIII No. XX-XXXXXX
- (2) Journal of Technical Disclosure of JIII No. 20XX-XXXXXX

4. Serial publication, Irregular publication and Catalogue

- (1) Be stated in the order of the name of author, the name of article (the title of article), the name of publication, the country of publication, the name of publisher, the publishing date, the number of volume, the number of issue and the number of pages.
- (2) The name of author and the name of article can be, if not necessary, omitted.
- (3) The name of article (if not stated, the name of publication) is stated in corner brackets or double quotations.
- (4) The name of publication is, in principle, stated without using abbreviated name.
- (5) The name of publisher can be omitted, if there is no fear of misunderstanding.
- (6) The publishing date is stated by Japanese name of an era or Christian era that is stated in a publication. Month and day are, if necessary, stated. In addition, if the publishing date is unknown, the publishing date may be substituted by the receipt date, but the matter to that effect should be clearly stated.
- (7) In cases where the number of volume can be substituted by the publishing date, the number of volume can be omitted.
- (8) Pages are stated by adding "p." prior to the number. Total pages are, in principle, stated, and if total pages are not stated, the pages of an issue are stated. When citing multiple pages, if such multiple pages are successively listed, insert a

hyphen between first page and final page, and if such multiple pages are discontinuously listed, insert a comma between them.

- (9) The country of publication is stated in brackets. In addition, in cases of the publication issued in Japan, the country of publication is omitted.
- (10) The publication in a foreign language is stated in an original language.

(Examples of statements)

- (1) INOUE, "New Movement of Optical Materials - infrared ray transmitting material-", Journal of SPSJ, The Spectroscopical Society of Japan, August, 1996, Volume 45, Issue 4, p.197-202
- (2) TATEMICHII Jyunichi, Other Seven Authors, "Ion Doping System", The Nissin electric review, Nissin Electric Co., Ltd., 7 December, 1994, Volume 39, Issue 3, p.52-58
(Note) Since there is no total page in the book, it is essential that Issue 3 should be listed.
- (3) Electronics, Ohmsha, 1968, Volume 40, Issue 3 p. 500- 501, 530
- (4) The Journal of Chemical Physics, (US), 1961, Vol. 34, No. 12, p. 313-315
- (5) Nucleonics, (US), Mc Graw-Hill Book Company, April 1964, Vol. 22, No. 4, p. 76-78, 101
- (6) "Liniaic", Japan Atomic Energy Research Institute, the JPO Industrial Property Library, received on 3 February, 1963, p. 2

5. Books

- (1) Be stated in the order of the name of author (or the name of editor), the name of publication, the number of edition, the number of volume, the country of publication, the name of publisher, the publishing date, and the number of pages.
- (2) In case of the translation, be stated in the order of the name of original author (or the name of original editor), the name of translator, and the name of publication.
- (3) In case of series such as lectures or complete works, the name of lectures or complete works and the number of volume of series are stated prior to the name of publication.
- (4) The name of publication is stated in corner brackets or double quotations without abbreviation.
- (5) If not stated in a book, the number of edition is not stated.
- (6) A manner of statements in case of using the publishing date, the number of pages, the country of publication and an original language is equivalent to the case of periodical.

(Examples of statements)

- (1) MURAOKA Youichi, "Lectures of University on Computer Science (Volume 11) Computer Architecture", Second edition, Modern Science Co., Ltd., November 1985, p. 123-127
- (2) J. W. Mellor, "A Comprehensive Treatise on Inorganic and Theoretical Chemistry", Vol. , (US), Longmans Green and Co., 1931, p. 341

6. DERWENT abstract journal (issued on or after the date of 11 June, 1980)

Be stated in the order of the name of abstract journal, the number of volume and issue, of abstract journal, the publishing date of abstract journal, the country of publication of abstract journal and the name of publisher of abstract journal, the classification of abstract journal (the classification of DERWENT), state-codes of abstract journal and the document number, the name of cited publication.

The name of abstract journal is as follows.

- (1) The classification of DERWENT A~M (chemical field): Basic Abstracts Journal
- (2) The classification of DERWENT P~X (non-chemical field): World Patents Abstracts Journal

7. Electronic technical information⁵

The electronic technical information retrieved from internet, etc. is cited in such a form as equivalent to 3210 in "Part III Chapter2 Novelty and Inventive Step" of this Examination Handbook, and state the bibliographic items of the ascertained electronic technical information in the following order, in the form of citation which shall be according to WIPO Standard ST.14 (Note).

- (1) The name of author
- (2) The title
- (3) The relevant part

Specified by page, field, row, item number, chart number, and the index of database or the first word and last word.

- (4) Types of media [online]
- (5) The date of publication (the date of issuance), the name of publisher (the name of issuer), the place of publication (the place of issuance)

⁵ The term "publication" is not used for the electronic technical information disclosed by using internet (the terms such as "citation," "cited document" are used) when citing, in the reasons for refusal, etc.

(6) Retrieving date

State in parentheses, the date when electronic technical information has been retrieved from electronic media.

(7) Source and address of information

State the source and address or the accession number (Accession no.), of electronic technical information

(8) In cases where the name of author, the title, the name of publisher (the name of issuer), the place of publication (the place of issuance), etc. are disclosed in the electronic technical information in a foreign language, state the name of them in an original language.

(Example of statements)

SHINSAKI Jun, Other Three Authors, "Movement of Novel Art", [online], 1 April, 1998, the Patent Society, [retrieved on 30 July, 1999], internet

<URL: <http://tokkyo.shinsakijun.com/information/newtech.html>>

(Note) WIPO Standard ST.14 (WIPO Standard ST. 14)

(http://www.wipo.int/standards/en/part_03_standards.html)

8. Document Produced by a Standards Defining Organization (SDO)¹

If citing the document produced by a Standards Defining Organization (SDO), state the ascertained bibliographic items of the document produced by the SDO in the following order.

- (1) The name of author
- (2) The title of SOD
- (3) The name of SDO and the unique standard reference number of SDO²
- (4) The date of publication
- (5) International Standard Serial Number (ISSN)
- (6) The relevant part

If citing the document produced by the SDO retrieved from internet, etc. , state the information in addition to above information of “7. Electronic technical information”

¹ A general term for various technical documents including the formulated standards, proposed standards to be adopted and the contributions submitted by the members in the process of formulating the technical standard.

² As for the name of the SDO, list the full name or the well-known acronym of the SDO. If available, the name of the relevant conference or working group is also listed. As for the unique standard reference number, list the unique identification number to identify the document used by the SDO, including the id, the version, etc. They are not needed to be comma-delimited.

(refer to the following example of statements).

(Example of statements)

NTT DOCOMO, Power-control mechanisms for dual connectivity [online],
3GPP TSG-RAN WG1#77 R1-142264, 2014.05.10,
[Retrieving date 2017.03.22], internet
<URL:http://www.3gpp.org/ftp/tsg_ran/WG1_RL1/TSGR1_77/Docs/R1-142264.zip>, p.1-8

1208 Handling in Cases Where a Plurality of Written Amendments etc. were Submitted

1. Where a plurality of amendments are made before the first examination or in designated period in the non-final notice of reasons for refusal

When amendments are made a plurality of times regarding the description etc. before the first examination or in a designated period in the non-final notice of reasons for refusal, the content of a newer amendment is reflected on the description etc.

Accordingly, when a plurality of amendments is made regarding the same portion of the description etc., the content of an amendment finally made on the portion is reflected on the description etc.

2. Where a plurality of amendments is made in designated period in the final notice of reasons for refusal

When amendments are made a plurality of times regarding the description etc. in a designated period in the final notice of reasons for refusal, the content of an amendment satisfying the requirements of Article 17bis(3) to (6) and having a newer content of an amendment is reflected on the description etc.

Accordingly, when a plurality of amendments is made regarding the same portion of the description etc., the content of an amendment satisfying the requirements of Article 17bis(3) to (6) and the content of an amendment finally made on the portion is reflected on the description etc.

When a plurality of amendments is made in a response period to the final notice of reasons for refusal, the Examiner determines whether each amendment should be rejected in accordance with the order on which the amendments are made.

The Examiner determines as follows when it is determined whether the second or later amendment satisfies the requirements of Article 17bis(3) to (6).

(1) Regarding Article 17bis(3), it is determined whether an amendment regarding the description etc. is one adding a new matter using the originally attached description etc. as a standard.

(2) Regarding Article 17bis(4), it is determined whether an amendment made regarding the claims is an amendment that changes a Special Technical Feature of an invention depending on whether the claimed invention after the amendment satisfies the

requirements of unity of invention with all the inventions on which a determination as to whether a patent cannot be granted is made in the notices of reasons for refusal issued so far (Note).

(Note) "The inventions on which a determination as to whether a patent cannot be granted is made in the notices of reasons for refusal" mean the invention on which an examination regarding novelty (Article 29(1)), an inventive step (Article 29(2)), secret prior art (Article 29bis) and earlier application (Article 39) is made.

(3) Regarding Article 17bis(5) and (6), using the description etc. legitimately amended just before the second or later amendment as a standard, whether an amendment made regarding the claims applies to any purpose of each item of Article 17bis(5) is determined, and if the amendment aims at Article 17bis(5)(ii) (restriction in a limited way of the scope of the claims), whether it satisfies the requirement of Article 17bis(6) (requirements for independent patentability) is determined.

1209 Handling in Cases Where There are Errors in the Notice of Reasons for Refusal

Errors are handled as follows in cases where errors have been found in the notice of reasons for refusal which the examiner sent.

1. Cases where errors have been found before the expiration of the prescribed period of the notice of reasons for refusal

The examiner continues the examination upon the agreement, by inviting the applicant or agent (hereinafter referred to as "the applicant, etc.") to respond after interpreting the errors in a correct manner or to point out, in the written opinion, the matter to the effect that the reasons for refusal are not appropriate. Only when the agreement of the applicant, etc. has not been obtained, the examiner issues the notice of correction by ex officio or the notice of dismissal by ex officio (See 2. or 4.(3) in 11205 of "Part XI Chapter 2 Examination Related Affairs" of this Examination Handbook).

2. Cases where errors have been found after the expiration of the prescribed period of the notice of reasons for refusal.

The examiner issues the notice of reasons for refusal again, regardless of whether the written opinion has been submitted.

However, in the following cases, the examiner is not required to issue the notice of reasons for refusal again.

(1) Cases where the applicant, etc. determines the matters as the errors of statements, and submits the written opinion after interpreting the errors in a correct manner

(2) Cases where the applicant, etc. does not respond to the errors (including the cases where the written opinion has been submitted), and also the errors are slight errors such as mere misuse or omission or the like that hardly affect the reasons which the examiner intends.

When making the decision of refusal in the cases of above (1) and (2), it is preferable to add the clarification of the errors as the remark in the margin of the decision of refusal.

(Explanation)

In cases where there are errors in the notice of reasons for refusal, it does not mean that the examiner has issued the correct reasons for refusal to the applicants, etc., and thus the examiner is required to issue the notice of reasons for refusal again. However, similarly as the cases of above (1) and (2), in cases where it is recognized that the correct reasons for refusal have been already

delivered to the applicant, etc., re-issuance of the notice substantially means issuance of the same notice of reasons for refusal, and thus the errors are handled as described in this paragraph.

1210 Points to which Attention Should be Paid when Drafting Decision to Grant a Patent

1. Consultation Prescribed in Article 39(2) and (4) of the Patent Act

Where the result of the consultation is reported⁶, and the application of one applicant as selected is decided to grant a patent, the "Memorandum of agreeing consultation" shall be opened from a window of "Decision to grant a patent/Decision to registration Setting" and the following (1) and (2) shall be entered. (Note)

(1) Name or appellation and domicile or residence of the applicant except one patent applicant as selected by the consultation

(2) Name and domicile or residence of the inventor or the designer of the invention or the device of the application of the applicant mentioned in the above-mentioned

(1) Where the patent applicants are also the same, the (1) and (2) shall be entered.

(Note) Article 29 of the Regulations under the Patent Act prescribes that agreement on the consultation must be described in the Patent Gazette.

2. Exceptions to loss of novelty of invention prescribed in Article 30

(1) Cases where the application of exceptions to loss of novelty of invention is recognized

Where to apply the provision of the exception to loss of novelty of invention is recognized to decide to grant a patent concerning the patent application, the "Memorandum of Article 30 of the Patent Act" in the window of "Decision to grant a patent/Decision to registration Setting" is opened and a fact which is not regarded as a reason for loss of novelty concerning the invention of the patent application is entered therein.

In addition, in the entering, concerning the application for which the decision to grant a patent is made, it shall be confirmed whether Article 30 of the Patent Act revised on 2011 is applied or Article 30 of the Patent Act prior to the revision is applied⁷, since

⁶ Where the result of the consultation is not reported, even if the reasons for refusal under the provision of Article 39(2) or (4) of the Patent Act are overcome by the procedures such as the amendment of the Claims or the withdrawal of the application, it is not necessary to prepare the "Memorandum of agreeing consultation".

⁷ Refer to "3232 Patent Applications to which Article 30 of the Patent Act as amended in 2018 is Applicable" or "Operational Guidelines for Applicants to Seek the Application of Exceptions to Loss of Novelty of Invention, corresponding to the Patent Act Article 30 revised in 2011". Guidance for an applicant for obtaining the application of the provision of the exception to lack of novelty of invention, corresponding to the revised Law on 2011" (http://www.jpo.go.jp/tetuzuki_e/t_tokkyo_e/pdf/e_paa30/e_tebiki.pdf).

the content of each item of Article 30 of the Patent Act revised on 2011, and an appropriate item from items 1 to 3 shall be selected.

Example of stating a case for which Article 30 of the Patent Act revised on 2011 is applied

- (1) Applied Article 30(1) of the Patent Act, presented in writing on xxx page published by xxx, Journal of xx, vol. xx, No. xx (xx, xx, xxxx)
- (2) Applied Article 30(2) of the Patent Act, presented on xxth meeting of xx corporate juridical person held at xx university on xx, xx, xxxx

The point about the above is described in the Patent Gazette.

(Explanation)

If such a measurement is not made to clarify that the above-mentioned fact is not regarded as the reason for loss of novelty concerning the application, a third party who does not know this may file a trial for patent invalidation upon citing the above-mentioned fact. Therefore, it shall be treated as mentioned in the main sentence for preventing to file such a trial for patent invalidation.

(2) Cases where the application of exceptions to loss of novelty of invention is not recognized

a When the examiner makes decision to grant a patent for the patent application without recognizing the application of exceptions to loss of novelty, if the examiner does not indicate even once, in the notice of reasons for refusal or decision of refusal, the reasons why the application of exceptions to loss of novelty is not recognized, the examiner issues the notice (with prescribed period) under the name of the examiner, in advance, concerning the matter to the effect that the examiner makes decision to grant a patent for the patent application without recognizing the application of exceptions to loss of novelty and the reasons why the application of exceptions to loss of novelty is not recognized. The examiner makes decision to grant a patent after the period of one month (in case of residents of Japan) or three months (in case of overseas residents) without entering anything in "Memorandum of Article 30 of the Patent Act" in the window of "Decision to grant a patent/Decision to registration Setting." During this period, if the applicant asserts, in the written statement, etc. that the application of exceptions to loss of novelty of invention should be recognized, the examiner makes decision to grant a patent after determining again whether exceptions to loss of novelty of invention should be applied in consideration of the assertion.

Example of statements of above notice

| Notice | |
|---|----------------|
| Application Number | JP XXXX-XXXXXX |
| Drafting Date | (YY/MM/DD) |
| Examiner in Charge | XX XX XXXX XX |
| Patent Attorney | XX XX |
| <p>If the applicant has any opinion on the following matter, please submit the written statement within XX days from the sending date of this notice.</p> | |
| Note | |
| <p>With regard to the invention for which the applicant seeks the application of the provision of Article 30 (X) of the Patent Act, such provision cannot be applied for the following reason.</p> <p>Since the reasons for refusal have not been found in the application at this point, the examiner makes decision to grant a patent without recognizing the application of such provision, after the period of one month (three months in case of overseas residents) from the sending date of this notice, provided that if the reasons for refusal are newly found, the reasons for refusal will be notified.</p> <p>the invention to which the provision is not applicable the invention disclosed on X page of XX Society Journal Volume X Issue X, X publishing (Heisei XX year X month X day)</p> <p>Reason (For example, state the reasons why the examiner has determined that the application did not satisfy 2.1 "(Requirement 2) The invention was disclosed resulting from an action of the right holder, and the right holder filed a patent application" of the Examination Guidelines "Part III Chapter 2 Section 5 Exceptions to Loss of Novelty of Invention")</p> <p>For the application of such provision, the applicant is expected to assert the "fact of successions or the like of the right to obtain a patent" in the written statement, to the extent that the examiner can understand the fact that invention was disclosed resulting from an action of the right holder, and the right holder filed a patent application.</p> | |
| <p>-----</p> <p>If the applicant has a question or an expectation for interview concerning the contents of the notice, please contact us at the following number.</p> <p>Examination Department of X XX Division The Name of examiner TEL. 03 - 3581 - 1101 extension FAX. 03 - -</p> | |

b When the examiner makes decision to grant a patent for the patent application without recognizing the application of exceptions to loss of novelty, if the examiner has indicated, in the notice of reasons for refusal or decision of refusal, the reasons why the application of exceptions to loss of novelty was not recognized, the examiner immediately makes decision to grant a patent without entering anything in "Memorandum of Article 30 of the Patent Act" in the window of "Decision to grant a

patent/Decision to registration Setting."

3. Deposition of microorganism

Where there is an accession number provided for the deposition of the microorganism, its accession organization and accession number are entered in the "microorganism deposition" in the window of "Decision to grant a patent/Decision to registration Setting."

4. Handling a case in which the name of invention or the name and the like of the applicant is long

Number of characters which can be displayed in the column of the name of invention and the columns of the applicant and the representative is limited. When the written draft is confirmed and where the descriptions in their columns are truncated (where the number of character exceeds the limitation), an "Enter remark column" in the window of "Decision to grant a patent/Decision to registration Setting" is opened and "Name of invention to be continued: xxxx" is stated therein to state a truncated portion, or "Name of invention: xxxxxxxxxx" is stated therein to state all of the name of invention and the like (in this case, since the truncated portion is kept as an internal data, the button of "Alteration" shall not be pushed to edit a column of "Name of invention/device").

5. Handling a case in which the retroactive effect of the filing date is not recognized

(1) Setting the filing date (retroactive date)

Where the retroactive effect of the filing date (the retroactive date) is not recognized concerning the special application (Note), a "Kinds of application" is selected from the window of "Decision to grant a patent/Decision to registration Setting" to set the filing date (retroactive date) in the "Kinds of application".

Where the retroactive effect of the filing date is only recognized in its part (for example, a case in which while the retroactive effect of the filing date for the child application concerning the grandchild application is recognized, the retroactive effect of the filing date for the parent application is not recognized), a "retroactive effect of the filing date is partially recognized" is selected to enter the filing date for which the retroactive effect is recognized, and where the whole retroactive effect of the filing date is not recognized (where the filing date is the actual filing date of the special application), a "whole retroactive effect of the filing date is not recognized" is selected

to set the filing date (the retroactive date).

(Note) The special application means a divisional application, a converted application or a patent application based on the utility model registration.

(2) Notice to the applicant

When the examiner makes decision to grant a patent for the patent application without recognizing the retroactive effect of the filing date, if the examiner does not indicate even once, in the notice of reasons for refusal or the like, the reasons why the retroactive effect of the filing date is not recognized, the examiner issues the notice (with prescribed period) under the name of the examiner, in advance, concerning the matter to the effect that the examiner makes decision to grant a patent for the patent application without recognizing the retroactive effect of the filing date and the reasons why the retroactive effect of the filing date is not recognized. The examiner makes decision to grant a patent after the period of one month (in case of residents of Japan) or three months (in case of overseas residents). During this period, if the applicant asserts, in the written statement, etc. that the retroactive effect of the filing date should be recognized, the examiner makes decision to grant a patent after determining again whether the retroactive effect of the filing date should be recognized in consideration of the assertion.

Example of statements of above notice

| | | Notice | |
|---|--|----------------|---------|
| Application Number | | JP XXXX-XXXXXX | |
| Drafting Date | | (YY/MM/DD) | |
| Examiner in Charge | | XX XX | XXXX XX |
| Patent Attorney | | XX XX | |
| <p>If the applicant has any opinion on the following matter, please submit the written statement within XX days from the sending date of this notice.</p> | | | |
| <p>Note</p> | | | |
| <p>Since the retroactive effect of the filing date is not recognized in the application for the following reason, the application is deemed to have been filed on Heisei XX year X month X day.</p> | | | |
| <p>Since the reasons for refusal have not been found at this point, the examiner makes decision to grant a patent without recognizing the retroactive effect of the filing date after the period of one month (three months in case of overseas residents) from the sending date of the notice, provided that if the reasons for refusal are newly found, the reasons for refusal will be notified.</p> | | | |
| <p>Reason</p> | | | |
| <p>....(For example, state the reasons why the examiner has determined that the requirements for divisional application were not recognized.)</p> | | | |
| <hr/> <p>If the applicant has a question or an expectation for interview concerning the contents of the</p> | | | |

notice, please contact us at the following number.
Examination Department of X XX Division The Name of examiner
TEL. 03 - 3581 - 1101 extension
FAX. 03 - -

6. Number of claim

Where the number of claim displayed on the window of "Decision to grant a patent/Decision to registration Setting" is different from the actual number of claim, the examiner amends such a number (especially, a case of reconsideration by examiners before appeal proceedings).

7. Handling a case in which a filing date of a “reference filing” is regarded as a day of submission of the description and the drawings

(1) Setting the filing date

Where the examiner makes decision to grant a patent for the reference filing regarding the day of submission of the description and the drawings as a filing date, the examiner makes a contact with Examination Standards Office (Note) upon making the decision to grant the patent. Then, the examiner confirms that a filing date displayed on the window of “Application” of “Basic matters” on application master screen is set to the day of submission of the description and the drawings and makes decision to grant a patent. When the examiner prepares a draft of decision to grant a patent, the examiner opens the window of “Remark input” on “Decision to grant a patent/Decision to registration Setting” screen and inputs statement that “the filing date is set to Heisei year/month/day on which the description and the drawings were submitted”. Further, the examiner briefly inputs statement that the patent application referencing previous application is granted regarding the day of submission of the description and the drawings as a filing date and a reason why the day of submission of the description and the drawings is regarded as a filing date.

(Note) The examiner is not required to make a contact with the Examination Guideline Section when the examiner notifies reasons for refusal or refusal.

(2) Notice to the applicant

When the examiner makes decision to grant a patent for the reference filing regarding the day of submission of the description and the drawings as a filing date, if the examiner does not indicate even once, in the notice of reasons for refusal or the like, the reasons why the examiner regards the day of submission of the description and the

drawings as a filing date, the examiner issues the notice (with prescribed period) under the name of the examiner, in advance, concerning the matter to the effect that the examiner makes decision to grant a patent regarding the day of submission of the description and the drawings as a filing date and the reason why the examiner regards the day of submission of the description and the drawings as a filing date. Then, the examiner makes decision to grant a patent after the period of one month (in case of residents of Japan) or three months (in case of overseas residents). During this period, if the applicant asserts, in the written statement, etc., that the filing date should be set to the day of filing the application, the examiner makes decision to grant a patent after determining again the filing date of the patent for the reference filing in consideration of the assertion.

Example of statements of above notice

| | | |
|--------------------|----------------|---------|
| | Notice | |
| Application Number | JP XXXX-XXXXXX | |
| Drafting Date | (YY/MM/DD) | |
| Examiner in Charge | XX XX | XXXX XX |
| Patent Attorney | XX XX | |

If the applicant has any opinion on the following matter, please submit the written statement within XX days from the sending date of this notice.

Note

The present application is regarded, for the reasons as set forth below, that the matters stated in the description and the drawings do not remain in the matters stated in the description, claims, or drawing(s) attached to the application of the earlier patent application (in the case where the said earlier patent application is a foreign-language-written-application, foreign- language-documents; in the case where the said earlier patent application is filed in a foreign country, documents which are submitted at the time of filing the application and correspond to the description, claims or drawing(s)). Therefore, the said patent application shall be deemed to have been filed on Heisei XX year X month X day on which the description and the drawings were filed (Article 38-3 (4)).

Since the reasons for refusal have not been found in the application at this point, the examiner makes decision to grant a patent regarding that the present application was filed when the description and the drawings were submitted, after the period of one month (three months in case of overseas residents) from the sending date of this notice, provided that if the reasons for refusal are newly found, the reasons for refusal will be notified.

Reason

.... (For example, state the reasons why the examiner has determined that the matters stated in the description and the drawings do not remain in the matters stated in the description, claims, or drawing(s) attached to the application of the earlier patent application.)

If the applicant has a question or an expectation for interview concerning the contents of the notice, please contact us at the following number.

Examination Department of X XX Division The Name of examiner
 TEL. 03 - 3581 - 1101 extension
 FAX. 03 - -

1211 Service of Certified Copy of Decision to Grant a Patent and Fixation of Decision to Grant a Patent

Where a Decision to grant a patent is determined, the JPO Commissioner shall serve its copy to the patent applicant (Article 52(2) of the Patent Act).

The Decision to grant a patent is fixed at a time in which the copy of the Decision is served.

1212 Memorandum of Patent

1. Positioning of the Memorandum of Patent

The Memorandum of Patent is of describing a result of comparing and determining the claimed invention and the prior art, and is a document with regard to patents prescribed in Article 186 of the Patent Act. Accordingly, the Memorandum of Patent is to be inspected. In addition, the Memorandum of Patent which is prepared in or after July 2003 is available to inspect on Japan Platform for Patent Information (J-PlatPat).

2. A case for which the Memorandum of Patent is prepared

The Memorandum of Patent shall be prepared in a case in which the examiner determines to be necessary for securing the objectivity and transparency of the determination or contributing to the submission of information and the like after determining a decision to grant a patent by a third party. In the case of preparing it, the point of the invention is briefly stated in comparison with the prior art.

3. content of the Memorandum of Patent

The Memorandum of Patent shall be briefly and clearly stated concerning the result of comparing and determining the claimed invention and the prior art according to the following general natures, so as to be able to determine that the case for which a decision to grant a patent is made has novelty, inventive step and the like:

(1) Where it is clear to have novelty and inventive step by clearly indicating a matter specifying the invention of the claimed invention which is not in the prior art, it shall be stated such as "xxx is not stated nor suggested in the reference".

(2) Where the matter specifying the invention which is different from the prior art appears to be mere design modification and the like, and where it cannot be easily recognized to have inventive step by only and clearly indicating the matter specifying the invention which is not present in the prior art, a basis to have inventive step such as advantageous effect shall be stated. For example, it shall be stated as follows:

- (i) xxx is not stated in the reference, while the claimed invention exerts a prominent effect of xxx thereby.
- (ii) [Matter specifying the invention which is not present in the reference] xxx.

[Advantageous effect] xxx.

(iii) xxx is not stated in the reference, and such a point is not easily conceivable even for a skilled in the art from xxx.

(3) In the claim in which the result of comparing and determining with the prior art are stated, the claims which have the same reason are collectively stated.

[Example of stating]

(Example 1) The reference does not state nor suggest that "in consideration of the performance of the driving pulse motor, the control in the sub-scanning direction at the time of varying power is performed by changing the motor speed at the time of zooming in, and by being constant in the motor speed and by drawing between the lines at the time of zooming out".

(Example 2) The reference does not state, in the method of manufacturing the semiconductor light emission element, insertion of a buffer layer, that is, "forming, on the first semiconductor layer comprising InGa_N, a second semiconductor layer comprising AlN or InGa_N grown at a lower temperature than those in the first semiconductor layer, and further forming a third semiconductor layer comprising InGa_N at a higher temperature than those in the second semiconductor layer", while the claimed invention exerts a prominent effect that "it can be laminated with reducing the grid distortion of the InGa_N layer" thereby.

(Example 3) [Matter specifying the invention which is not present in the reference]

In the melting treatment method of asbestos containing waste, the compound X is added to melt.

[Advantageous effect]

The melting temperature is lowered and it is easily vitrified at the time of solidification.

4. Submission of an opinion of applicant in response to the Memorandum of Patent

The applicant may submit a written petition in response to the Memorandum of Patent, and the written petition is to be inspected.

Since the written petition will be submitted after determining the Decision to grant a patent, the examiner does not consider its content.

(Explanation)

Since the view made by the examiner which is indicated in the Memorandum of Patent is available for inspection to the third party, it is proper that the opinion submitted from the applicant in response thereto should also be made available for inspection to the third party.

1213 Points to Which Attention Should be Paid When Drafting Decision of Refusal

1. Handling a case in which the name of invention or the name of applicant and the like is long

There is a limit to a number of characters that can be displayed in the column for the title of invention and the column of the applicant and the representative. Where the descriptions in these columns are truncated (where the number of characters exceeds the maximum number) when a written draft is confirmed, "Title of invention to be continued: xxxxxxxx" and the like is stated in the last part of the remarks column of the body sentence of the written draft to state the truncated portion, or "Title of invention: xxxxxxxx" and the like is stated to state the entire title of the invention and the like.

2. Note when the decision of refusal based on Article 39 of the Patent Act is drafted

2.1 Prior application

(1) "(1) Where the applicant of the claimed application is different from the applicant of another application " of "4.4.1 Where another application is an prior application" of Examination Guidelines for Patent and Utility Model "Part III Chapter 4 Prior Application"

After waiting for the earlier application to become final, such a statement is made in the remarks column when drafting the Decision of refusal.

(Example of sentence)

The application of Patent Application No. xxxx-xxxxxx was registered as Patent No. xxxxxxxx

(2) "(2) Where an applicant of the application concerned and the applicant of the other application are identical with each other " of "4.4.1 Where another application is an prior application" of Examination Guidelines for Patent and Utility Model "Part III Chapter 4 Prior Application "

Even if the prior application does not become final, the Decision of refusal is made.

2.2 Co-pending applications filed on the same date

(1) Where the reason for refusal is that no agreement has been reached by consultations or consultations are unable to be held, the decision of refusal is not readily made even though no written opinion and the like are submitted. It is confirmed whether or not all of the other applications are withdrawn, waived or the like, and the Decision of refusal will be made, except in the case where all of the applications are withdrawn, waived, and the like.

(2) Where no agreement is reached by consultations, such a statement is stated in the remark column of the Decision of refusal.

(Example of sentence)

Since the patent applicant of the present application has not been reported according to the gist described in the invitation dated xx, xx, xxxx, it is deemed that no agreement with the applicant of the Patent (Utility Model) application No. xxxx-xxxxxx has been reached by consultations.

3. Handling a case in which the retroactive effect of the filing date is not recognized

Concerning the special application (Note 1) which was filed in or after April 1, 2007, of which the filing date for which the retroactive effect is recognized is prior to April 1, 2007 by recognizing the retroactive effect of the filing date, where the retroactive effect of the filing date is not recognized (Note 2), "Setting of Retroactive effect of the filing date" in a window of "Setting of Decision of refusal" is selected to set the filing date (retroactive date) in the window of "Setting of Retroactive effect of the filing date".

Where the retroactive effect of the filing date is partially recognized (for example, while the retroactive effect of the filing date concerning the grandchild application is recognized as the filing date of the child application, where the retroactive effect until the filing date of the parent application is not recognized and the like), the "retroactive effect of the filing date is partially recognized" is selected to input the filing date for which the retroactive effect is recognized. Where none of the retroactive effect of the filing date is recognized (a case in which the actual filing date of the special application is recognized), the filing date (retroactive date) is set by selecting the "none of the retroactive effect of the filing date is recognized".

(Note 1) A special application means a divisional application, a converted application or a patent application based on utility model registration.

(Note 2) A case in which the retroactive effect of the filing date is not recognized means a case in

which the Decision of refusal is made in a situation that the retroactive effect of the filing date is partially or wholly not recognized, by pointing out an indication that the retroactive effect of the filing date is partially or wholly not recognized in the notice of reasons for refusal(See 4.1 in “Part VI Chapter 1 Section 1 Requirements for Division of Patent application”, 3. in “Part VI Chapter 2 Conversion of Application” and “Part VI Chapter 3 Patent Application Based on Utility Model Registration” of the Examination Guidelines). Except in this case, the filing date is treated to be retroactive.

1214 Final Conclusion of Decision of Refusal

Final conclusion of the Decision of refusal means a state that the Decision of refusal could not be cancelled by a statement of dissatisfaction prescribed in the Patent Act. The case in which the Decision of refusal becomes final and conclusive is item (i) or (ii) below:

- (i) A case in which no request for appeals against an examiner's decision of refusal has been filed after 3 months have passed (Note) (where the applicant is an overseas resident, a 1-month extension is granted by JPO commissioner ex officio) in principle from the date of the dispatch of the copy of such a Decision; and
(Note) See Trial and Appeal Manual 61-03 for further details.
- (ii) A case in which, where such a request for a trial and appeal is filed, the Trial Decision that the request of the trial and appeal is not established or the request of the trial and appeal is dismissed becomes final and conclusive, or the Decision to dismiss the written request becomes final and conclusive.

1215 Handling in Cases Where the Amendment of Claims after the Final Notice of Reasons for Refusal is Considered to Aiming at Two or More Matters Listed in Items of Article 17bis(5) of the Patent Act

When the amendments of the description, etc. made after issuing final notice of reasons for refusal satisfy the requirement of Article 17bis (3) and (4), if it is determined that the amendments of claims aim to two or more matters listed in the items of Article 17bis (5), the examiner handles the amendments as follows.

1. Where purposes of amendments of a plurality of claims or a plurality of parts of a claim are respectively different

In cases where an amendment related to at least one part or more aims at restriction in a limited way of claims and the claimed invention cannot be granted a patent independently, the examiner rejects the amendment. (See 3.2 in "Part I Chapter 2 Section 6 Decision of Dismissal of Amendments" of the Examination Guidelines)

Example 1: When an amendment of the claimed invention of Claim 1 aims at correction of a clerical error and an amendment of the claimed invention of Claim 2 aims at restriction in a limited way of claims, and moreover, the claimed invention of amended Claim 2 cannot be granted a patent independently, the examiner rejects the amendments.

2. Handling in a case where one amendment of certain claim can be said as made aiming at two or more items listed in Article 17bis (5)

In a case where, with regard to one amendment of certain claim, the applicant asserts one purpose and the amendments are considered to have been made for the purpose, the examiner proceeds with examination, assuming as the amendments have been made for the purpose.

For the reasons or the like that the applicant does not assert the purpose of the amendments, that the applicant asserts multiple purposes, or that the applicant asserts the purpose of the amendments but the amendments are not considered to have been made for such purpose, in cases where it cannot be specified that the amendments aim at any of two or more items listed in Article 17bis (5), the examiner handles the amendments as follows.

In cases where it is considered that one amendment of certain claim have been

made for the purposes only of two or more matters of deletion of a claim, correction of errors or clarification of an ambiguous description for any purpose, the examiner proceeds with examination based on the description, etc. after the amendments, without dismissing the amendments.

In cases where it is considered that one amendment of certain claim have been made for the purpose of restriction of claims or for the purpose of other matters, the examiner determines, among above purpose, whether there is a purpose that if the amendments are made for such purpose, it is considered that the decision of refusal should not be made.

If there is a purpose that it is considered that the decision of refusal should not be made for, the examiner proceeds with examination, assuming as the amendments have been made for the purpose.

Regardless of whether the amendments aim at restriction of claims in a limited way or other purposes, if it is consequently considered that the decision of refusal should be made, the examiner proceeds with examination, assuming as the amendments have been made for the purpose of restriction of claims in a limited way.

In cases where it is considered that the amendments of claims aim at above two or more matters of the items listed in Article 17bis (5), if it cannot be specified that the amendments aim at any of above two or more items, the examiner can invite the applicant to submit the document in which the applicant explains that the amendments aim at any of the items listed in Article 17bis (5) As a result, in cases where it can be determined that the amendments aim at any of the items, the examiner proceeds with examination, assuming as the amendments have been made for the purpose.

Example 2: In claims before the amendments, claim 1 and Claim 2 (that is dependent claim of Claim 1) are stated. Thus, in cases where the amendments are made in such a manner as Claim 2 before the amendments is only stated, it is considered that the amendments aim at deletion of Claim 1 or aim at restriction of claims in such a manner as Claim 1 is restricted by constitution of Claim 2 after deleting Claim 2.

In that case, when, in previous notice of reasons for refusal, the examiner issues such notice before the amendments due to lack of novelty and lack of inventive step in Claim 1 and due to lack of inventive step in Claim 2, but the reasons for refusal due to lack of inventive step cannot be maintained for the invention after the amendments (Claim 2 before the amendments) after referring to written opinion, etc. and the reasons for refusal due to lack of

inventive step that is caused by novel prior art is found, if assuming as the amendments aim at restriction of claims, the invention after the amendments is independently patentable. Therefore, the examiner makes decision of refusal due to lack of novelty and lack of inventive step in Claim 1 before the amendments, with dismissing the amendments.

However, if assuming the amendments have been made for the purpose of deletion of claim, the reasons for refusal cannot be maintained which have been previously issued. Therefore, the examiner newly issues the notice of reasons for refusal due to lack of inventive step.

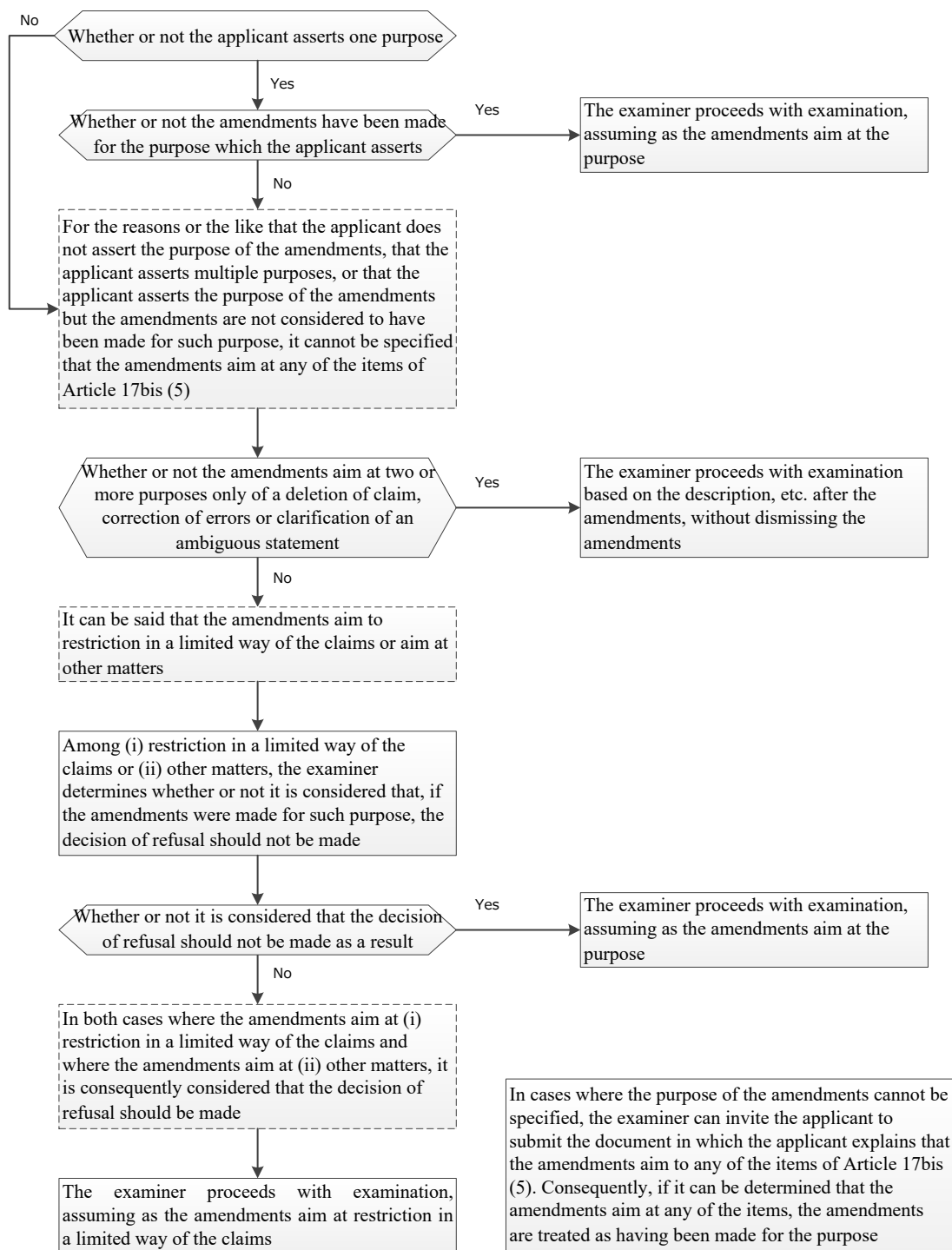
In that case and where it cannot be specified that the amendments aim at any of two or more items listed in Article 17bis (5) for the reasons or the like that the applicant does not assert the purpose of the amendments, that the applicant asserts multiple purposes, or that the applicant asserts the purpose of the amendments but the amendments are not considered to have been made for such purpose, the examiner proceeds with examination, assuming as the amendments have been made for the purpose of deletion of claim.

In addition, in cases where it is considered that, in the previous notice of reasons for refusal, the notice due to lack of inventive step has been issued for both of claim 1 and 2 before the amendments, and the reasons for refusal due to lack of inventive step can be maintained after the amendments, if assuming the amendments aim at restriction of claims in a limited way, the invention after the amendments is not independently patentable. Therefore, the examiner makes decision of refusal after dismissing the amendments. Moreover, if also assuming as the amendments aim at deletion of claim, the reasons for refusal due to lack of inventive step have not been resolved. Therefore, the examiner makes decision of refusal.

In this way, for any purpose, in cases where the examiner consequently makes decision of refusal and where it cannot be specified that the amendments aim at any of two or more items listed in Article 17bis (5) for the reasons or the like that the applicant does not assert the purpose of the amendments, that the applicant asserts multiple purposes, or that the applicant asserts the purpose of the amendments but the amendments are not considered to have been made for such purpose, the examiner proceeds with examination, assuming as the amendments aim at restriction of claims in a limited way.

FIG: Handling in a case where the amendments of certain claim are determined as aiming at two or more matters listed in each item of Article 17bis(5) (See 2.)

(*The amendments shall satisfy the requirements of Article 17bis (3) and (4)



1216 Points to Which Attention Should be Paid When Drafting Decision of Dismissal of Amendment

1. Handling a case in which the name of invention or the name of applicant and the like is long

The number of letters that can be indicated in the columns of the title of invention, applicant, agent, etc. is limited. When the draft is checked and the statements of these columns are ended in the middle thereof (the maximum number of letters has been exceeded), a remarks column is added to the last portion or the like of the "Reason" column in the body of the draft and a statement such as "Remark: Continuation of the title of the invention is: OΔ..." is to be indicated so as to state the unintentionally truncated portion, or a statement such as "Remark: Title of Invention: XXOΔ..." is to be indicated so as to state the complete title of the invention, etc.

2. Decision to Dismiss Amendment against Written Amendment Changing Title of Invention

When a decision to dismiss the amendment is to be made against a written amendment that changes the title of the invention, the title of the invention prior to the amendment is to be stated in the decision to dismiss the amendment without stating the title of the invention as amended by the written amendment.

(Explanation)

The above rule of handling is to be complied with as a decision to dismiss the amendment is made against the entire amendments included in the written amendment.

1217 Interview, etc.

The "interview" means an interview for communication between the examiner and the representative and the like (basically the applicant himself in a case where no representative is nominated. However, only in a case where the applicant is a legal entity and a case where an intellectual property member and the like of the legal entity can deal with it responsibly, the intellectual property member and the like is possible.) with respect to the examination of the patent application and includes technical explanation for facilitating understanding of technology of the examiner. The "interview" includes an on-site interview for which the examiner makes a business trip to near the location of the applicant, etc., and a video interview using an Internet connection.

In addition, "a contact by a telephone, a facsimile, or the like" for the above communication is handled as one corresponding to the above "interview".

* For details of the interview, etc., refer to "Interview Guideline [Patent Examination]".

(http://www.jpo.go.jp/shiryoku/kijun/kijun2/mensetu_guide_index.htm)

1218 Cases Where the Examiner Requests to Submit the Documents or Other Materials under the Provision of Article 194(1)

According to the provision of Article 194(1) of the Patent Act, the examiner may request a party concerned to submit documents or other materials necessary for the examination (hereinafter, referred to as "documents, etc."). According to this provision, for example, in the following cases, it is determined that the examiner may request the applicant and the like to submit a model, a specimen or the like, in addition to the document of the reference and the like as references to clarify the content of the invention .

1. Examples of documents, etc. which may be requested to submit

(1) Where, in a case of identifying the claimed invention, it is difficult to understand the invention for reasons that the technical content of the invention is hard to understand, the length of the description or the number of claims is excessive, the examiner may request the applicant and the like to submit, for example, a document explaining a relationship of which matter specifying the invention stated in the claims corresponds to what portion in each example is, a document briefly explaining the gist of the invention, a chart indicating the relationships between claims, and the like.

(Explanation)

Where the content of the invention cannot be understood or can be hardly understood from the description, the claims, and the drawings, it is general practice to notify the reason for refusal. However, where the claimed invention of the patent application relates to a special expertise technique that makes it difficult to understand the invention, or it can be determined that the length of the description or the number of claims is excessive to require a long time to understand the invention, while there is apparently no deficiency in the description, the claims, and the drawings and it can be recognized to be inappropriate to treat with a procedure including notice of reasons for refusal, it can be recognized to be necessary on the treatment of the examination to take the above-mentioned measures other than the notice of reasons for refusal exceptionally in order to promote understanding of the invention. Accordingly, it shall be handled as the main sentence.

(2) Where there is a point that is difficult to understand in the assertion of the written opinion in response to the notification of reason for refusal, and it can be recognized that this point has a great effect on the examination, the examiner may request the

applicant and the like to submit a document further clearly explaining the assertion in the written opinion.

- (3) Where it is impossible to confirm the action and effect stated in the description without reference to the model, the specimen, the test report and the like (hereinafter, referred to as "specimen, etc."), and where submission of such specimen make it possible to confirmed the clearness and sufficiency of the content of the description or the drawings at the time of filing the application, the examiner may request the applicant and the like to submit the specimen, etc.

A test report and the like include published literature of an academic journal, a written expert opinion, and the like, and these documents are often desirably prepared by a third party.

- (4) Where it cannot be easily understood whether or not a divisional application complies with the substantial requirements for the division, or where it is necessary to take quite a long time for determining whether or not the claimed invention of the divisional application is not the same as the claimed invention of the original application or the claimed invention of another divisional application, the examiner may request the applicant and the like to submit a document explaining what portion in the description, etc. of the original application is changed, what matter stated in the originally-filed description, the claims, or the drawings of the original application serves as the basis for the claimed invention of the divisional application, that the claimed invention of the divisional application is not the same as the claimed invention of the original application or the claimed invention of another divisional application, and the like.

- (5) Where it cannot be easily understood whether or not the matters stated in the description or the drawings of a reference filing is within the matter stated in the description, etc. of an earlier patent application, the examiner may request the applicant and the like to submit a document explaining which matters stated in the description, the claims, or the drawings of the earlier patent application serves as the basis for the matters stated in the description or the drawings of the reference filing, and the like.

- (6) Where it cannot be easily understood that the amendment of the description, etc. is within the matter stated in the originally-filed description, etc., the examiner may request the applicant and the like to submit a document explaining any basis of the

amendment. In addition, where it is unclear whether or not the amendment of the claims in response to the final notification of reason for refusal or at the time of requesting an appeals against an examiner's decision of refusal is made for any purposes of the items of Article 17bis(5) of the Patent Act, the examiner may also request the applicant and the like to submit a document explaining that the amendment complies with any of the purposes.

- (7) Where the grounds of correction of incorrect translation is not sufficiently stated in the statement of correction of incorrect translation when the statement of correction of incorrect translation is submitted to amend the description, etc., the examiner may request the applicant and the like to submit a document explaining the ground of correction of incorrect translation.

2. Notification Requesting Submission of the Documents, etc.

- (1) For the notification, the "Notification (other) under Article 194" of Notification by Examiner (with time limit) is used in a case other than the above 1.(4), and the "Notification (written explanation relating to divisional application) under Article 194" of the Notification by Examiner (with time limit) is used in a case of the above 1.(4).

- (2) The designated time limit where the submission of the documents, etc. prescribed in the above 1. is requested shall be the same as the designated time limit for submitting the written opinion. Where it can be determined that preparing the specimen, etc. will require a long time, the examiner can designate a time limit different from the above time limit, depending on the circumstances. (See 04.09 and 04.10 in "Formality Check Manual")

- (3) The notification specifically states what documents, etc. the applicant and the like should submit, as shown in the following example sentence.

(Example of sentence)

A document explaining the correspondence between each matter for specifying the invention stated in claim 1 of this application and which portion of the example.

- (4) Concerning the document whose submission is requested mentioned in the above 1.(4), the notification shall request the applicant to prepare the document according to

the example for description of the written petition (*) requesting submission of a document for filing a divisional application.

(*) Japan Patent Office Homepage "Request to the applicant relating to document for explanation upon filing a divisional application (June 29, 2009)"
http://www.jpo.go.jp/tetuzuki/t_tokkyo/shinsa/bunkatu_yousei.htm

3. Borrowing of specimen, etc.

Where the model or the specimen which is submitted is borrowed, a "Borrowing of material" is selected from a "Select to start work" in a window of "Select examiner work" on the peripheral system of examination of Patent and Utility Model.