

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

Part VI Special Application

Contents

Chapter 1	Division of Patent Application (Patent Act Article 44).....	1 -
6101	Examination Procedures Regarding Determination of Substantive Requirements.....	1 -
6102	Points to note in Examination of Grandchild Application.....	8 -
6103	Proviso of Patent Act Article 44(2).....	10 -
6104	Request to Applicant for Submission of Explanatory Documents in Filing Divisional Application.....	11 -
6105	History of Revisions of Patent Act Article 44	12 -
6106	Time Period in which Divisional Application can be Filed for Original Application for which Certified Copy of Decision of Refusal was Transmitted on or before March 31, 2009.....	13 -
6107	Time Period in which Divisional Application can be Filed for Original Application whose Filing Date (Retrospective Date) is on or before March 31, 2007.....	14 -
6108	Relationship between Time Requirements and Substantive Requirements of Divisional Application after Transmittal of Certified Copy of Decision of Refusal of Original Application and Date on which Original Application was Filed and Date on which Certified Copy of Decision of Refusal of Original Application has been Transmitted.....	15 -
6109	Operation Regarding Determination on Substantive Requirements for Division of Application	17 -
6110	Handling of Cases where Reason for Refusal Notified for Other Application is Not Appropriate	19 -
6111	Examples of Cases where Reasons for Refusal of Application Concerned are Determined as being Identical to Reasons for Refusal according to Notice of Reasons for Refusal against Other Patent Application.....	20 -
6112	Points to note in Determining that Applicant could have been aware of Content of Notice of Reasons for Refusal against Other Patent Application when Notice under Article 50bis is to be made.....	21 -
6113	Points to note in Drafting Notice under Article 50bis	24 -

6199	Others	- 28 -
Chapter 2	Conversion of Application (Patent Act Article 46)	- 1 -
6201	Proviso of Article 44(2)	- 1 -
6202	Restriction on Time Period in which Converted Application may be filed for Application for Design Registration for which Certified Copy of Initial Decision of Refusal was Transmitted on or before March 31, 2009.....	- 2 -
6203	Restriction on Time Period in which Converted Application may be filed for Application for Design Registration whose Filing Date (Retrospective Date) is on or before September 30, 2001	- 3 -
Chapter 3	Patent Application Based on Utility Model Registration (Patent Act Article 46bis)	- 1 -
6301	Proviso of Patent Act Article 46bis (2).....	- 1 -
Chapter 4	Reference filing (Patent Act Article 38ter)	- 2 -
6401	Description, etc. as originally filed in the reference filing	- 2 -

Chapter 1 Division of Patent Application (Patent Act Article 44)

6101 Examination Procedures Regarding Determination of Substantive Requirements

In the examination of a divisional application, the time of filing of the application has to be ascertained as the basis for determining novelty, inventive step, etc.

Also, the time of filing of the divisional application is determined by whether or not the substantive requirements are satisfied, and this determination may vary depending on the amendments. For example, a substantive requirement that was satisfied prior to the amendment may be no more satisfied as a result of the amendment. Conversely, any substantive requirement that was not satisfied prior to the amendment may be satisfied as a result of the amendment.

Accordingly, with regard to the divisional application, the examiner determines whether or not the substantive requirements are satisfied not only at the time of the first round of examination but also at the time of the examination in the case where an amendment has been made in response to the notice of reasons for refusal.

The examiner conducts the examination as follows in accordance with the timing at which the determination regarding the substantive requirements is to be made. The typical example of the examination procedures of the determination regarding the substantive requirements is illustrated in the following figure.

(1) Examination in a case where an amendment has been made in the first round of examination and at the time of the response to the first notice of reasons for refusal

If a written statement or the like has been submitted by the applicant for explanation of the fact that the substantive requirements are satisfied, the examiner should sufficiently consider the content of the statement.

If an amendment has been made to the description, etc., the examiner should accept the amendment and make determination regarding the substantive requirements on the basis of the description as amended, etc.

The examiner should proceed with the examination deeming the divisional application as being filed at the time of filing identified by this determination.

(Explanation)

If an amendment, which may be unlawful, has been made to the description, etc., the

examiner shall perform an examination based on the description, etc. after the amendment as long as it is not dismissed (Refer to 4. (2) of "Part IV Chapter 1 Requirements for Amendments," 2.1.2 of "Part I Chapter 2 Section 4 Handling of Written Opinion, Written Amendment, etc.," and 5. of "Part I Chapter 2 Section 6 Decision of Dismissal Amendment" of the Examination Guidelines for Patent and Utility Model). Cases are thus to be handled as mentioned above.

(2) Examination in a case where an amendment has been made at the time of the response to the final notice of reasons for refusal

If an amendment has been made to the description, etc., the examiner deems the divisional application as being filed at the time of filing determined in the examination prior to this amendment and then determines whether or not the amendment introduces a new matter.

If the amendment introduces a new matter, the examiner renders a decision to dismiss the amendment.

On the other hand, if the amendment does not introduce any new matter, the examiner makes determination regarding the substantive requirements on the basis of the description as amended, etc. The examiner should proceed with the examination deeming the divisional application as being filed at the time of filing identified by this determination.

For the general procedures in the case where an amendment has been made in response to the final notice of reasons for refusal, refer to "Part I Chapter 2 Section 6 Decision of Dismissal Amendment" of the Examination Guidelines for Patent and Utility Model.

(Explanation)

The examiner cannot identify which description, etc. should be relied upon to conduct the examination without determining whether or not the amendment should be dismissed. However, if, in the examination at the time of and after the final notice of reasons for refusal, determination is made regarding Article 17bis (4) to (6), any of which is not a ground for invalidation, prior to the determination regarding the substantive requirements, the consequence may be too harsh for the applicant.

Specifically, suppose that an amendment made in response to the notice of reasons for refusal raised based on the determination that the divisional application does not satisfy the substantive requirements, and that this amendment complies with the provisions of Article 17bis (4) to (6) when it is determined on the basis of the time of filing of the original

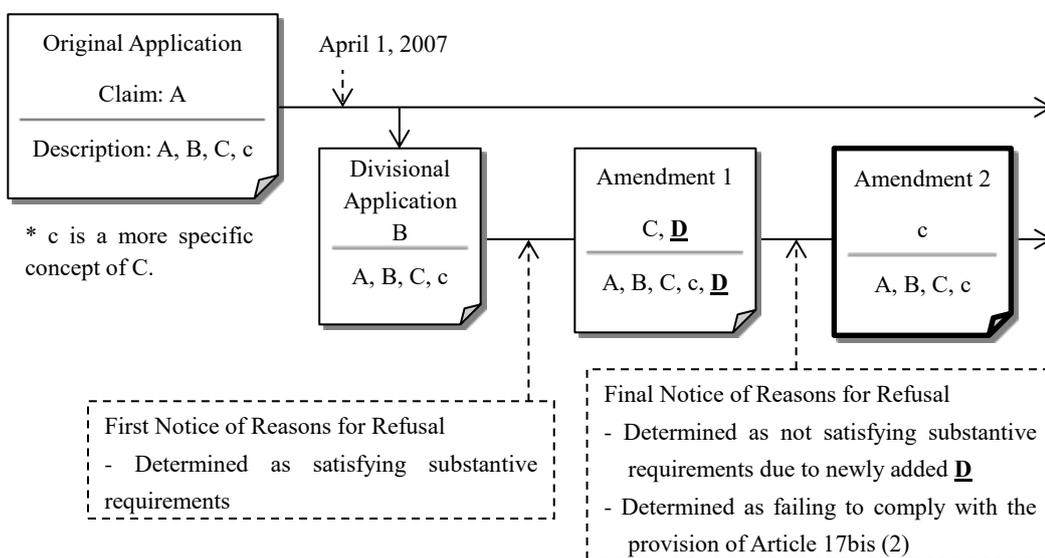
application but fails to comply with these provisions when it is determined at the time of actual filing of the divisional application (such an amendment can occur due to transitional measures upon revision of the Act, etc.). If determination regarding these provisions are made for this amendment prior to making determination regarding the substantive requirements, then this amendment, which was originally made to comply with the substantive requirements, may be dismissed. This consequence is too harsh for the applicant.

Accordingly, such a case is thus to be handled as mentioned above so as to avoid such a consequence.

Example 1: Case where the filing date of the original application is prior to April 1, 2007 but the filing date of the divisional application is after April 1, 2007

In the case where the examination has proceeded as illustrated in the following figure, the examiner, in the examination after the amendment 2, determines whether or not any new matter has been added by the amendment 2. In this case, the amendment 2 is determined as not introducing a new matter, and then the examiner makes determination as to the substantive requirements. In this case, it is determined that the substantive requirements are satisfied, and thus the examination proceeds with the divisional application deemed as being filed at the time of filing of the original application (i.e., the provision of Article 17bis (4) is not applied to the divisional application) including the assessment as to whether or not the amendment has been made for purposes as provided for in Article 17bis (5).

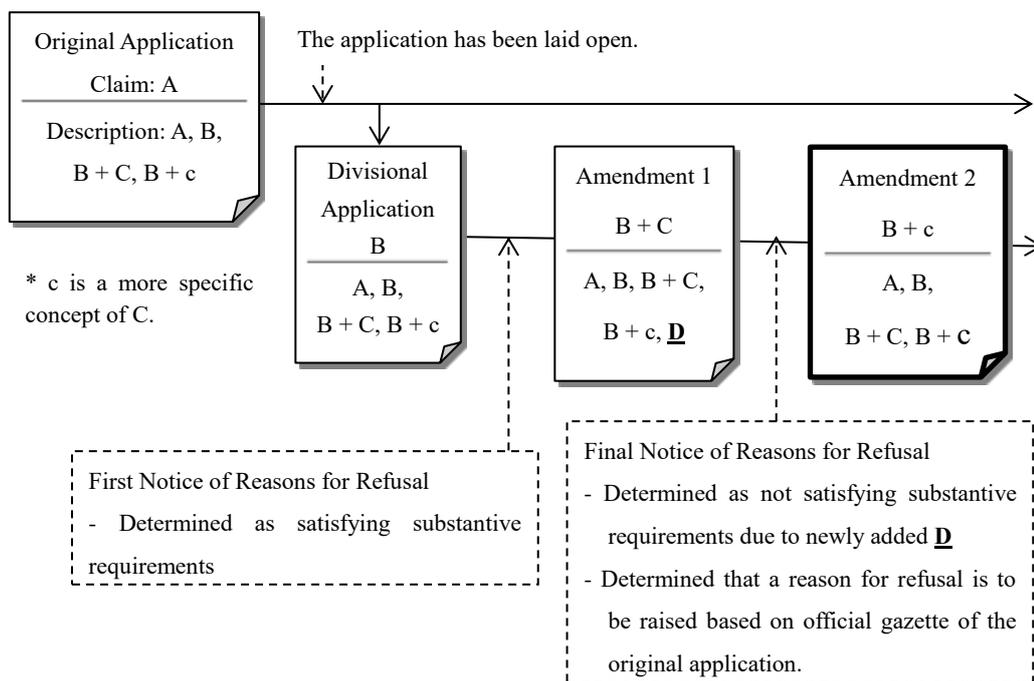
If determination as to the provisions of Article 17bis (4) to (6) has been made prior to the determination as to the substantive requirements, it is possible that the amendment 2 is dismissed as not complying with the provision of Article 17bis (4) as applied to applications filed on or after April 1, 2007 in a case as illustrated in the following figure.



Example 2: Case where the publication of the original application exists

In the case where the examination has proceeded as illustrated in the following figure, the examiner, in the examination after the amendment 2, determines whether or not any new matter has been added by the amendment 2. In this case, the amendment 2 is determined as not introducing a new matter, and then the examiner makes determination as to the substantive requirements. In this case, it is determined that the substantive requirements are satisfied, and thus the examination proceeds with the divisional application deemed as being filed at the time of filing of the original application (i.e., the publication of the original application being deemed as not constituting the prior art) including the assessment as to the provisions of Article 17bis (4) to (6).

If determination as to the provisions of Article 17bis (4) to (6) has been made prior to the determination as to the substantive requirements, it is possible that the amendment 2 is dismissed as not complying with the provision of Article 17bis(6) in a case as illustrated in the following figure.



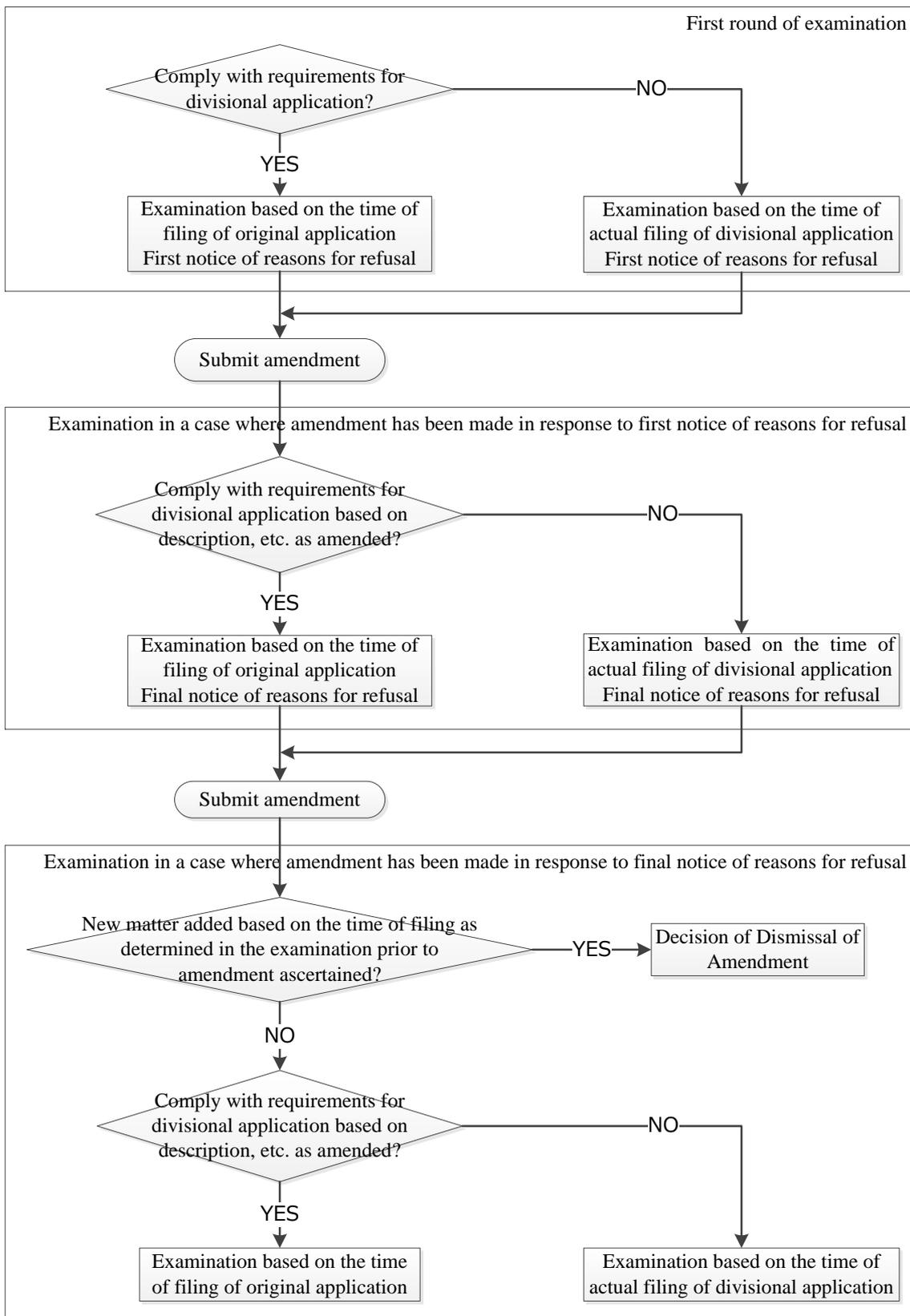
(3) Reconsideration by Examiner before Appeal proceedings

The examiner conducts the examination basically in accordance with the above item (2). However, it should be noted that, the examiner is not allowed to make a decision to dismiss the amendment, even when the amendment fails to meet the

requirements therefor, except for a case where a decision to grant a patent is to be made.

For the general procedures of the reconsideration by examiner before appeal proceedings, refer to "Part I Chapter 2 Section 7 Reconsideration by Examiners before Appeal Proceedings" of the Examination Guidelines for Patent and Utility Model.

Figure: Typical Example of Examination Procedure in Determining the Substantive Requirements



6102 Points to note in Examination of Grandchild Application

Examination guidelines "Part VI Chapter 1 Section 1 Requirements for Division of Patent Application," 5.1 (Excerpt)

The applicant may file a divisional application ("child application") from an original application ("parent application") and further file a divisional application ("grandchild application") from a child application.

In this case, if all of the conditions set forth in (i) to (iii) below are satisfied, the examiner shall, when examining the grandchild application, deem it to have been filed at the same time as the parent application.

- (i) The child application meets all the requirements for division in relation to the parent application.
- (ii) The grandchild application meets all the requirements for division in relation to the child application.
- (iii) The grandchild application meets all the substantive requirements for division in relation to the parent application. (Note)

(Note) "Description, etc., as they stand immediately prior to the division of the original application" as an element of Requirement 3 set forth in 2.2 refers, in this case, to "description, etc., of the parent application as they stand immediately prior to the division of the child application from the parent application."

(1) The examiner needs to determine whether or not the grandchild application can be deemed as being filed at the time of filing of the parent application every time the examination of the grandchild application is conducted regardless of whether or not any amendments have been made to the description, etc. of the grandchild application. This is because whether or not the above requirement "(i) The child application meets all the requirements for division as to the parent application." is satisfied may vary as a result of an amendment made to the child application, etc. even when any amendment was not made to the description, etc. of the grandchild application, and understandably the time of filing of the grandchild application may also vary.

(2) If it has already been established in the course of the procedures for the child application that the child application does not satisfy the requirements for divisional application with respect to the parent application, then the examiner deems the grandchild application as being filed at the actual time of filing of the child

application on condition that the grandchild application satisfies the requirements for divisional application with respect to the child application, but conducts the examination without deeming the grandchild application being filed at the time of filing of the parent application. In this case, since the grandchild application fails to satisfy the substantive requirements, the examiner notifies the applicant of the fact that the substantive requirements are not satisfied along with the reason therefor in accordance with the section 4.1 of "Part VI Chapter 1 Section 1 Requirements for Division of Patent Application" of the Examination Guidelines for Patent and Utility Model.

The cases where it has been established that the child application fails to satisfy the requirements for divisional application with respect to the parent application may, for example, include the following cases (i) and (ii).

- (i) Case where it has been determined that the child application fails to satisfy the requirements for divisional application with respect to the parent application, and the decision of refusal against the child application is made final and binding based on that determination;
- (ii) Case where it has been determined that the child application fails to satisfy the requirements for divisional application with respect to the parent application, and the decision to grant a patent for the child application is made final and binding based on that determination (except for a case where it has been determined in an appeal/trial decision or a court decision that the requirements for divisional application are satisfied).

6103 Proviso of Patent Act Article 44(2)

The proviso of Patent Act Article 44(2) is provided to eliminate inconsistencies caused by deeming that a divisional application is filed simultaneously with the original application. In the following cases, accordingly, the time of filing of the divisional application shall be the actual time of filing the divisional application.

- (i) Where a divisional application falls under Patent Act Article 29bis or as "another application for a patent" or under Utility Model Act Article 3bis or as "an application for a patent."
- (ii) Where the applicant is to submit a written statement to JPO Commissioner for requesting the application of the provision of Patent Act Article 30(2) for his divisional application, or where the applicant is to submit a document that proves that the claimed invention of his divisional application falling into any of Article 29(1) is an invention eligible for application of the provision of Article 30(2).

Also in the case of submitting the translations of a foreign language document and of a foreign language abstract for a divisional application in a foreign language that was divided from a patent application filed on or before March 31, 2007, the time of filing of the divisional application shall be the actual time of filing of the divisional application.

6104 Request to Applicant for Submission of Explanatory Documents in Filing Divisional Application

When filing a divisional application, the applicant is required to explain in a written statement that the divisional application meets the substantive requirements for division and that the claimed inventions of the divisional application are not identical to the claimed inventions of the original application or of other divisional applications, etc., as well as required to clearly indicate in the written statement the portions changed from the description, claims or drawings of the original application immediately prior to being divided, which were made in the divisional application, by means such as underlining the changed portions after transcribing the description, claims or drawings of the divisional application.

(Explanation)

The applicant is conversant with the statements in the description, claims, or drawings of the original application that were changed in the divisional application, matters described in the description, claims, or drawings of the original application from which the claimed inventions of the divisional application were derived, and the difference between the claimed inventions of the divisional application and the claimed inventions of the original application or other divisional applications, etc. Such information is quite helpful in promptly and precisely determining whether or not a divisional application meets the substantive requirements for division and the requirements for patentability. As such, in dividing an application, the applicant is requested to sufficiently explain such information in a written document.

6105 History of Revisions of Patent Act Article 44

Filing Date	Jan. 1, 1994 to June 30, 1995	July 1, 1995 to Dec. 31, 1998	Jan. 1, 1999 to June 30, 2003	July 1, 2003 to Mar. 31, 2007	Apr. 1, 2007 to Mar. 31, 2012		After Apr. 1, 2012
					The date on which a certified copy of the examiner's initial decision to the effect that the application is to be refused has been served is on or before Mar. 31, 2009	The date on which a certified copy of the examiner's initial decision to the effect that the application is to be refused has been served is on or after Apr. 1, 2009	
(1)	An applicant for a patent may extract part of a patent application comprising two or more inventions as one or more new patent applications only at the time for or within the time limit by which the description or drawings attached to the request may be amended.	An applicant for a patent may extract part of a patent application comprising two or more inventions as one or more new patent applications only within the time limit by which the description or drawings attached to the request may be amended.	An applicant for a patent may extract part of a patent application comprising two or more inventions as one or more new patent applications only within the time limit by which the description, scope of claims, or drawings attached to the request may be amended.	An applicant for a patent may extract part of a patent application containing two or more inventions as one or more new patent applications only within the following time limits: (i) within the allowable time limit for amendments of the description, scope of claims, or drawings attached to the application; (ii) within 30 days from the date on which a certified copy of the examiner's decision to the effect that a patent is to be granted (excluding the examiner's decision to the effect that a patent is to be granted under Article 51 as applied mutatis mutandis under Article 163(3) and the examiner's decision to the effect that a patent is to be granted with regard to a patent application that has been subject to examination as provided in Article 160 (1)) has been served; (iii) within 30 days from the date on which a certified copy of the examiner's initial decision to the effect that the application is to be refused has been served.	An applicant for a patent may extract part of a patent application containing two or more inventions as one or more new patent applications only within the following time limits: (i) at the time for or within the allowable time limit for amendments of the description, scope of claims, or drawings attached to the application; (ii) within 30 days from the date on which a certified copy of the examiner's decision to the effect that a patent is to be granted (excluding the examiner's decision to the effect that a patent is to be granted under Article 51 as applied mutatis mutandis under Article 163(3) and the examiner's decision to the effect that a patent is to be granted with regard to a patent application that has been subject to examination as provided in Article 160 (1)) has been served; (iii) within 3 months from the date on which a certified copy of the examiner's initial decision to the effect that the application is to be refused has been served.		
(2)	In the case referred to in the preceding paragraph, the new patent application shall be deemed to have been filed at the time of filing of the original application. However, this shall not apply to the provisions where the new application is either another patent application as stipulated in Article 29bis of this Act or a patent application stipulated in Article 3bis of the Utility Model Act, and of Articles 30(4), 41(4), 40(1), and 40(2).	In the case referred to in the preceding paragraph, the new patent application shall be deemed to have been filed at the time of filing of the original application. However, this shall not apply to the provisions where the new application is either another patent application as stipulated in Article 29bis of this Act or a patent application stipulated in Article 3bis of the Utility Model Act, and of Articles 30(4), 36bis(2), 41(4), 43(1), and 43(2) (including its application mutatis mutandis under paragraph (3) of the preceding Article).	In the case referred to in the preceding paragraph, the new patent application shall be deemed to have been filed at the time of filing of the original application. However, this shall not apply to the provisions where the new application is either another patent application as stipulated in Article 29bis of this Act or a patent application stipulated in Article 3bis of the Utility Model Act, and of Articles 30(4), 36bis(2), 41(4), and 43(1) (including its application mutatis mutandis under paragraph (3) of the preceding Article).	In the case referred to in the preceding paragraph, the new patent application shall be deemed to have been filed at the time of filing of the original application. However, this shall not apply to the provisions where the new application is either another patent application as stipulated in Article 29bis of this Act or a patent application stipulated in Article 3bis of the Utility Model Act, and of Articles 30(4), 41(4) and 43(1) (including its application mutatis mutandis under paragraph (3) of the preceding Article).			In the case referred to in the preceding paragraph, the new patent application shall be deemed to have been filed at the time of filing of the original application. However, this shall not apply to the provisions where the new application is either another patent application as stipulated in Article 29bis of this Act or a patent application stipulated in Article 3bis of the Utility Model Act, and of Article 30(3).
(3),(4)	(Omitted)						
(5)					Where the period as provided in Article 108(1) is extended under Article 4 or Article 108(3), the 30-days period as stipulated in paragraph (1)(ii) shall be deemed to have been extended only for that period as extended.		
(6)					Where the period as stipulated in Article 121(1) is extended under Article 4, the 30-days period as stipulated in paragraph (1)(iii) shall be deemed to have been extended only for the period as extended.	Where the period as stipulated in Article 121(1) is extended under Article 4, the 3-months period as stipulated in paragraph (1)(iii) shall be deemed to have been extended only for the period as extended.	

*Paragraph (7) is omitted.

6106 Time Period in which Divisional Application can be Filed for Original Application for which Certified Copy of Decision of Refusal was Transmitted on or before March 31, 2009

Examination guidelines "Part VI Chapter 1 Section 1 Requirements for Division of Application," 2.1.2 (Excerpt)

A patent application may be divided at any of the timings set forth in (i) to (iii) below.

- (i) During the time period in which amendments to the description, claims, or drawings (In this chapter, hereinafter, referred to as "description, etc.") are allowed (Article 44(1)(i)) (Note 1)
- (ii) Within 30 days from transmittal of a certified copy of a decision to grant a patent (Note 2) (Article 44(1)(ii)) (Notes 3 to 5)
- (iii) Within three months from transmittal of a certified copy of the non-final decision of refusal (Note 6) (Article 44(1)(iii)) (Notes 4 and 5)

With regard to the above item (i), among the time periods in which amendments may be made as stated in the section 2. of "Part IV Chapter 1 Requirements for Amendments" of the Examination Guidelines for Patent and Utility Model, the item (v) "At the same time when a request is made for an appeal against an examiner's decision of refusal" should be read as "within 30 days from the date on which a request is made for an appeal against an examiner's decision of refusal."

Also, the "three months" stated in the above item (iii) should be read as "30 days."

6107 Time Period in which Divisional Application can be Filed for Original Application whose Filing Date (Retrospective Date) is on or before March 31, 2007

Examination guidelines "Part VI Chapter 1 Section 1 Requirements for Division of Patent Application," 2.1.2 (Excerpt)

A patent application may be divided at any of the timings set forth in (i) to (iii) below.

- (i) During the time period in which amendments to the description, claims, or drawings (In this chapter, hereinafter, referred to as "description, etc.") are allowed (Article 44(1)(i)) (Note 1)
- (ii) Within 30 days from transmittal of a certified copy of a decision to grant a patent (Note 2) (Article 44(1)(ii)) (Notes 3 to 5)
- (iii) Within three months from transmittal of a certified copy of the non-final decision of refusal (Note 6) (Article 44(1)(iii)) (Notes 4 and 5)

A division of patent application can only be filed in the above time period (i) for original applications whose filing dates (or retrospective dates) are on or before March 31, 2007.

6108 Relationship between Time Requirements and Substantive Requirements of Divisional Application after Transmittal of Certified Copy of Decision of Refusal of Original Application and Date on which Original Application was Filed and Date on which Certified Copy of Decision of Refusal of Original Application has been Transmitted

The time and substantive requirements for a divisional application differ according to the filing date of the original application and the date on which a certified copy of the decision of refusal of the original application has been transmitted. The time and substantive requirements for a divisional application are described below where the description is limited to the divisional applications after the transmittal of the certified copy of the decision of refusal of the original applications.

	Application of Patent Act before 2008 revision (Patent application whose date of transmittal of the certified copy of the decision of refusal is on or before March 31, 2009)	Application of Patent Act as revised in 2008 (Patent application whose date of transmittal of the certified copy of the decision of refusal is on or after April 1, 2009)
Application of Patent Act before 2006 revision (Patent application whose filing date is on or before March 31, 2007)	<p>Case 1</p>	<p>Case 3</p>
Application of Patent Act as revised in 2006 (Patent application whose filing date is on or after April 1, 2007)	<p>Case 2</p>	<p>Case 4</p>

Substantive Requirement A: Where division of patent application is made within the

time limit for amendments

- (i) The claimed inventions of the divisional application does not constitute all of the inventions described in the description, claims or drawings of the original application immediately prior to being divided
- (ii) Matters described in the description, claims or drawings of the divisional application are within the scope of matters described in the description, claims or drawings of the original application as of the filing.

Substantive Requirement B: Where division of patent application is made within the time limit amendments cannot be made

In addition to (i) and (ii) above, the following requirement (iii) arises.

- (iii) Matters described in the description, claims or drawings of the divisional application are within the scope of matters described in the description, claims or drawings of the original application immediately prior to being divided.

6109 Operation Regarding Determination on Substantive Requirements for Division of Application

1. Patent application divided from the original application whose date of transmittal of the certified copy of the decision of refusal is on or after April 1, 2009

In the case where the filing date of the original application is on or after April 1, 2007, a certified copy of the decision of refusal of the original application has been transmitted on or after April 1, 2009, and the application is divided after the copy of the decision of refusal of the original application has been transmitted, the substantive requirements vary depending on whether or not a request for an appeal against an examiner's decision of refusal of the original application was made simultaneously with the division of application (refer to Examination handbook 6108 [Case 4](#)).

With regard to the case where a request for an appeal against an examiner's decision of refusal of the original application was made on the same date as division of an application, there is the following description in "5.2 If an application is divided on the same day when an appeal against the examiner's decision of refusal is filed " of "Part VI Chapter 1 Section 1 Requirements for Division of Patent Application" of the Examination Guidelines for Patent and Utility Model.

" If division takes place on the same day when an appeal against the examiner's decision of refusal of the original application is filed, then the examiner shall examine the substantive requirements for division as if such division took place at exactly the same time as the filing of such appeal (during the time period in which amendments are allowed) (see 2.2), unless it is obvious that such division has not taken place simultaneously with the filing of such appeal."

Regarding this point, the requirement will be operated as follows.

Where a divisional application is submitted on the same date on which the request for trial for the original application was made, the substantive requirements for division of application shall be assessed deeming that the divisional application was filed within the allowable time limit for amendments.

2. Patent application divided from the original application whose date of transmittal of the certified copy of the decision of refusal is on or before March 31, 2009

In the case where the original application was filed on or after April 1, 2007, a certified copy of decision of refusal of the original application has been transmitted on or before March 31, 2009, and the application is divided after the certified copy of the decision of refusal of the original application has been transmitted, the substantive requirements vary depending on whether or not the application was divided after a request for an appeal against an examiner's decision of refusal of the original application being made (refer to Examination handbook 6108 Case 2).

Regarding the case where a request for an appeal against an examiner's decision of refusal of the original application was made on the same date as the division of an application, the following description in "5.2 If an application is divided on the same day when an appeal against the examiner's decision of refusal is filed ", i.e., " unless it is obvious that such division has not taken place simultaneously with the filing of such appeal." of "Part VI Chapter 1 Section 1 Requirements for Division of Patent Application" should be read reads as "unless it is obvious that such division has taken place before the filing of such appeal."

Regarding this point, the requirement will be operated as follows.

Where a divisional application is submitted on the same date on which the request for trial for the original application was made, the substantive requirements for division of the application shall be assessed deeming that the divisional application was filed within the allowable time limit for amendments without making a determination on which procedure was made first.

3. Points to Note

The foregoing operation is applicable when the substantive requirements for a divisional application are assessed, and it is not deemed that the divisional application was simultaneously made with the request for trial just because the divisional application and the written request for trial were submitted on the same date.

6110 Handling of Cases where Reason for Refusal Notified for Other Application is Not Appropriate

A notice under Article 50bis is only issued for reasons for refusal having appropriate content among those notified in the other patent application in view of the purport of this article. Accordingly, any reason for refusal that has been determined as not appropriate in the course of the examination of the other patent application is excluded from reasons that may be included in the notice under Article 50bis. The examiner is not allowed to issue the notice under Article 50bis even when that reason for refusal is to be notified in the course of the examination of the present application.

A reason for refusal that has been determined as not being appropriate in the course of the examination of the other patent application refers, for example, to a reason for refusal which was notified in the examination of the other patent application but has been overcome as a result of any argument presented by written opinion, etc. to the effect that the reason at issue is not appropriate.

6111 Examples of Cases where Reasons for Refusal of Application Concerned are Determined as being Identical to Reasons for Refusal according to Notice of Reasons for Refusal against Other Patent Application

Example 1:

On the assumption that an invention claimed in the application concerned is the invention that was amended in response to the notice of reasons for refusal including lack of inventive step against the other patent application, if the invention claimed in the application concerned is unable to bring about a new effect because it is made merely by adding well-known or commonly used technique to the invention claimed in the other patent application, and is therefore found to be unable to overcome the lack of inventive step, the reason for refusal of the application concerned arising from the lack of inventive step based on the same reference document is the same as that stated in the notice given to the other patent application.

However, on the assumption that an invention claimed in the application concerned is the invention that was amended in response to the notice of reasons for refusal including the lack of inventive step against the other patent application, if the invention claimed in the application concerned is made by adding any matters that do not fall under the scope of well-known or commonly used techniques to the invention claimed in the other patent application and thus it is made necessary to notify an additional reason for refusal of the lack of inventive step by citing another reference, the reason for refusal of the application concerned arising from the lack of inventive step cannot be deemed to be the same as the reason for refusal arising from the lack of inventive step stated in the notice given to the other patent application.

Example 2:

On the assumption that the description of an application concerned is the description of the other patent application that was amended in response to the notice of reasons for refusal including non-compliance with the enablement requirement, if the description of the application concerned is still found to be unable to overcome the reason for refusal of non-compliance with the enablement requirement because it contains the working example that caused the non-compliance with the enablement requirement, the reason for refusal of the application concerned of the non-compliance with the enablement requirement is the same as the reason stated in the notice given to the other patent application.

6112 Points to note in Determining that Applicant could have been aware of Content of Notice of Reasons for Refusal against Other Patent Application when Notice under Article 50bis is to be made

When the notice under Article 50bis is to be made, the examiner determines whether or not the applicant of the application concerned could have been aware of the content of the notice of reasons for refusal against the other patent application prior to filing of the request for examination of the application concerned as follows.

1. Case where the applicants of the application concerned are at least in part the same as the applicants of the other patent application at the time of notification of the reason(s) for refusal against the other patent application

(1) If a request for examination of the application concerned is made on and after the next business day of the dispatch date of the notice of reasons for refusal against the other patent application, then the applicant of the application concerned could have been aware of the content of the notice of reasons for refusal against the other patent application prior to filing of the request for examination of the application concerned.

(Explanation)

The applicant or agent of the patent application can inspect the notice of reasons for refusal during the dispatch date of the notice of reasons for refusal against the patent application regardless of whether or not the patent application is laid open by submitting a request for inspection to the Patent Office.

Accordingly, if the applicants of the application concerned are at least in part the same as the applicants of the other patent application, the applicant of the application concerned could have been aware of the content of the notice of reasons for refusal against the other patent application on and after the next business day of the dispatch date of the notice of reasons for refusal against the other patent application.

(2) Even in the case where the request for examination of the application concerned was made prior to the next business day of the dispatch date of this notice of reasons for refusal against the other patent application, if it is clear that the time at which the notice of reasons for refusal against the other patent application arrived or the time at which the notice of reasons for refusal against the other patent application was made available for inspection by the applicant of the application concerned is prior to the time at which

the request for examination of the application concerned was made, then the applicant of the application concerned could have been aware of the content of the notice of reasons for refusal against the other patent application prior to filing the request for examination of the application concerned.

In this case, the examiner identifies the date on which the request for examination of the application concerned was made, the date on which the notice of reasons for refusal of the other patent application arrived, or the date on which the notice of reasons for refusal against the other patent application was made available for inspection in the "Remark" field for the notice under Article 50bis.

2. Case where the applicant of the application concerned is different from the applicant of the other patent application at the time of notification of the reason(s) for refusal against the other patent application

(1) If the request for examination of the application was made for the application concerned on and after the next business day of the day on which the other patent application to which the notice of reasons for refusal was made was laid open or the dispatch date of this notice of reasons for refusal, whichever is the latest, then the applicant of the application concerned could have become aware of the content of the notice of reasons for refusal for the other patent application prior to the filing of the request for examination of the application concerned.

(Explanation)

Any person who is not the applicant or the agent of the patent application is allowed to inspect the notice of reasons for refusal during the day of the date of publication of the patent application or the dispatch date of the notice of reasons for refusal for the patent application, whichever is the latest.

Accordingly, if the applicant of the application concerned is different from the applicant of the other patent application, the applicant of the application concerned could have become aware of the content of the notice of reasons for refusal against the other patent application on and after the next business day of the day on which the other patent application was laid open or the dispatch date of the notice of reasons for refusal for the other patent application, whichever is the latest.

(2) Even in the case where the request for examination of the application concerned was made prior to the next business day of the day on which the other patent application to

which the notice of reasons for refusal was made was laid open or the dispatch date of this notice of reasons for refusal, whichever is the latest, if it is clear that the time at which the notice of reasons for refusal against the other patent application was made available for inspection by the applicant of the application concerned is prior to the time at which the request for examination of the application concerned was made, then the applicant of the application concerned could have been aware of the content of the notice of reasons for refusal against the other patent application prior to filing the request for examination of the application concerned.

In this case, the examiner identifies the date on which the request for examination of the application concerned was made and the date on which the notice of reasons for refusal against the other patent application was made available for inspection in the "Remark" field for the notice under Article 50bis.

6113 Points to note in Drafting Notice under Article 50bis

Examination guidelines "Part VI Chapter 1 Section 2 "Notice under Article 50bis," 3.2
(Excerpt)

When giving the Article 50bis notification, the examiner shall include therein information that helps identify such reasons for refusal stated in a notice of reasons for refusal of another patent application as the examiner has found are identical.

1. Matters to be Stated in Drafting the Notice of Article 50bis

(1) When the notice under Article 50bis is to be issued, the examiner should state, in the notice, the application number of other patent application whose reasons for refusal have been determined as being identical to the reasons for refusal for the present application and also state the drafting date of the notice of reasons for refusal containing the above determination. In cases where more than one reason for refusal is included in the notice of reasons for refusal for the other patent application, the examiner should also state, in addition to the statement of the application number and the drafting date, the information (including the numbering of the reasons for refusal, the claim treated as the subject of reasons for refusal, etc.) identifying the reasons for refusal of the other patent application which have been determined as being identical with those of the present application. Also, the examiner should state, in the remark, the reasons why the examiner has determined that the concrete content of the reasons for refusal pertaining to the notice of reasons for refusal given to the other patent application is substantially identical with the content of the notice given to the present application.

(2) However, in cases where the reasons for refusal of other patent application and those of the present application are identical at a glance, the examiner can omit the statements in above (1) of the reasons why the examiner has determined that the reasons for refusal of other patent application are substantially identical to those of the present application.

2. Example of Drafting

"The reasons for refusal pertaining to this notice of reasons for refusal are, in the following points, identical to the reasons for refusal pertaining to the notice of reasons for refusal which has been issued, as of the date of Heisei X year X month X day, in the

Japanese Patent Application No. XXXX - XXXXXX filed on the same date of the present application. Therefore, the amendment of the claims to this notice of reasons for refusal is required to satisfy the requirements as set forth in Article 17bis (5) and (6) of the same Act.

Note

The reasons for refusal of the present application

- The reasons for refusal XX (Note)
- Claim X

The reasons for refusal of the Japanese Patent Application No. XXXX - XXXXXX

- The reasons for refusal XX (Note)
- Claim X

Remark

....."

(Note) In cases where the reasons for refusal cannot be identified only by the number indicating the reasons for refusal, the examiner should additionally state the necessary information including supporting provisions or cited document, etc. for identifying the reasons for refusal.

[Reference]

Notice of Reasons for Refusal	
Number of patent application	Japanese Patent Application No. XXXX-XXXXXX
Drafting date	Heisei XX year X month X day
The examiner of the JPO	XX XX XXXX XX
The agent of the applicant	XX XX
Article applied	Article 29(2), Article XX
<<<<The Notice of Reasons for Refusal including the Notice of Article 50bis of the Patent Act>>>>	
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.	
Reasons	
1. (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.

2. ...

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

● Reason 1

- Claim 1
- Cited Document, etc. 1,2
- Remark

.....

● Reason 2

<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.

<List of the cited document, etc.>

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

<The notice of Article 50bis of the Patent Act>

The reasons for refusal pertaining to this notice of reasons for refusal are, in the following points, identical to the reasons for refusal pertaining to the notice of reasons for refusal which has been issued, as of the date of Heisei X year X month X day, in the Japanese Patent Application No. XXXX-XXXXXXX filed on the same date of the present application. Therefore, the amendment of the claims to this notice of reasons for refusal is required to satisfy the requirements as set forth in Article 17bis (5) and (6) of the same Act.

Note

The reasons for refusal of the present application

- The reasons for refusal 1
- Claim 1

The reasons for refusal of the Japanese Patent Application No. XXXX-XXXXXXX

- The reasons for refusal 2

- Claim 2

Remark

.....

<The record of prior art searches results>

- The field of search IPC B43K 8/00 ~ 8/24
 The name of DB
- The prior art document JP HXX-XXXXXXA
 (Among the detailed explanation of the present invention,
 the matter of "B" stated in paragraph XXXX, Xth row of
 the description is stated in page X, field X, Xth row of the
 document.)

The record of prior art searches results does not constitute the reasons for refusal.

If the applicant has a question or an expectation for interview concerning the contents of the notice of reasons for refusal, please contact us at the following number.
Examination [Chinese numerals] Department [Examination room] Name [The name of examiner or assistant examiner]

TEL. 03 - 3581 - 1101 extension

FAX. 03 - -

6199 Others

Concerning matters in the left columns of the following table below, refer to Reference in the columns on the right.

	Refer to:
Points to note in drafting a decision to grant a patent when it has been determined that the substantive requirements are not satisfied.	5. in "1210 Points to which Attention Should be Paid when Drafting Decision to Grant a Patent" in "Part I Chapter 2 Procedures of Examination"
Points to note in drafting a decision of refusal when it has been determined that the substantive requirements are not satisfied.	3. in "1213 Points to Which Attention Should be Paid When Drafting Decision of Refusal" in "Part I Chapter 2 Procedures of Examination"
Request for submission of explanatory documents necessary for determining whether or not the claimed invention of the divisional application is the same as the claimed invention of the original application after the division of application.	1.(4) in "1218 Cases Where the Examiner Requests to Submit the Documents or Other Materials under the Provision of Article 194(1)" in "Part I Chapter 2 Procedures of Examination"

Chapter 2 Conversion of Application (Patent Act Article 46)

6201 Proviso of Article 44(2)

A converted application which meets the requirements stated in the section 2. of "Chapter 2 Conversion of Application" of the Examination Guidelines for Patent and Utility Model is in principle deemed to have been filed at the time of filing of the original application. However, it is dealt as being filed at the actual time of filing in the following cases (Article 44(2) as applied mutatis mutandis under Article 46(6) of the Patent Act).

- (i) Application as the "other patent application" stipulated in the Patent Act Article 29bis or "Patent Application" stipulated in the Utility Model Act Article 3bis
- (ii) Application of the provision of Article 30(3) of the Patent Act (Refer to Examination handbook 6103.)

6202 Restriction on Time Period in which Converted Application may be filed for Application for Design Registration for which Certified Copy of Initial Decision of Refusal was Transmitted on or before March 31, 2009

Examination guidelines "Part VI Chapter 2 Conversion of Application," 5.1 (Excerpt)

An application may be converted at any time except at the timings set forth in (i) to (iii) below.

- (i) After a design right is established and registered
- (ii) After three months (Note 2) from the date of transmittal of a certified copy of the first decision of refusal of the design registration application (Note 1)
- (iii) After three years (Note 3) from the date of filing of the design registration application (except within three months (Note 2) from the date of transmittal of a certified copy of the first decision of refusal (Note 1))

The "three months" in the above items (ii) and (iii) shall be read as "30 days."

6203 Restriction on Time Period in which Converted Application may be filed for Application for Design Registration whose Filing Date (Retrospective Date) is on or before September 30, 2001

Examination guidelines "Part VI Chapter 2 Conversion of Application," 5.1 (Excerpt)

An application may be converted at any time except at the timings set forth in (i) to (iii) below.

- (i) After a design right is established and registered
- (ii) After three months (Note 2) from the date of transmittal of a certified copy of the first decision of refusal of the design registration application (Note 1)
- (iii) After three years (Note 3) from the date of filing of the design registration application (except within three months (Note 2) from the date of transmittal of a certified copy of the first decision of refusal (Note 1))

The "three years" in the above item (iii) shall be read as "seven years."

Chapter 3 Patent Application Based on Utility Model Registration
(Patent Act Article 46bis)

6301 Proviso of Patent Act Article 46bis (2)

A patent application based on utility model registration which meets the requirements for patent application based on utility model registration as stated in the section 2. of "Chapter 3 Patent Application Based on Utility Model Registration" of the Examination Guidelines for Patent and Utility Model is in principle deemed to have been filed at the time of filing of the application for utility model registration (Article 46bis(2) of the Patent Act). However, in the following cases, the application is dealt as being filed at the actual time of filing (the proviso of Article 46bis (2) of the same Act).

- (i) Application as the "other patent application" as stipulated in the Patent Act Article 29bis or "Patent Application" as stipulated in the Utility Model Act Article 3bis.
- (ii) Application of the provisions of Article 30(3) of the same Act, the proviso of Article 36bis (2), and Article 48ter (2) of the same Act.

Chapter 4 Reference filing (Patent Act Article 38ter)

6401 Description, etc. as originally filed in the reference filing

1. Case where claims were attached to the request of the reference filing

(1) Case where a day of submission of the request was admitted as a filing date

Generally, the description and the drawings as initially submitted (Note), and claims attached to the request (see, the following (points to be noted) for exceptions)

(Note) This indicates the description and the drawings submitted together with a document for submitting the description, etc. within four months from the day of submission of the request. The same shall apply hereafter. Incidentally, it is not allowed to let the document for submitting the description, etc. include claims.

(Points to be noted)

After the examiner admits the day of submission of the description and the drawings as a filing date, if the examiner admits again the day of submission of the request as a filing date because the description or the drawings was amended (was amended to delete the matters which do not remain in the matters stated in the description, etc. of the earlier patent application), the description, etc. as originally filed shall be as follows.

The description and the drawings as initially submitted (only the matters stated in the description, etc. of the earlier patent application), and claims attached to the request

(2) Case where the day of submission of the description and the drawings was admitted as a filing date

The description and the drawings as initially submitted, and claims attached to the request

2. Case where claims were not attached to the request of the reference filing (Note)

(1) Case where the day of submission of the request was admitted as a filing date

Generally, the description and the drawings which were initially submitted (see, the following (points to be noted) for exceptions)

(Points to be noted)

After the examiner admits the day of submission of the description and the drawings as a filing date, if the examiner admits again the day of submission of the request as a filing date because the description or the drawings was amended (was amended to delete the matters which do not remain in the matters stated in the description, etc. of the earlier patent application), the description, etc. as originally filed shall be as follows.

- The description and the drawings as initially submitted (only the matters stated in the description, etc. of the earlier patent application)

(2) Case where the day of submission of the description and the drawings was admitted as a filing date

The description and the drawings as initially submitted

(Note) In a case where claims were not attached to the request of the reference filing, claims shall not be included in the description, etc. as originally filed. This is because, in a case where the claims were not attached to the request of the reference filing, the claims shall be added by amending the application in the written amendment.