

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

Part XI Affairs in General

Contents

Chapter 1 General

11101	Qualification as Examiner	- 1 -
11102	Provisions Pertinent to Job Duties etc. of Directors, Examination Supervisors, Examiners and Assistant Examiners	- 3 -
11103	Maintenance of Confidentiality by Examiners	- 7 -
11104	Provisions on Examination	- 8 -
11105	Designation and Change of Assignment of Examiners	- 11 -
11106	Examination of Case of another Art Unit	- 12 -
11107	Designation of Examiner for a Case Remanded to Examination	- 13 -
11108	Designation of an Examiner in Reconsideration by Examiners before Appeal Proceedings	- 14 -
11109	Reception of Patent Application and Assignment Change	- 15 -

Chapter 2 Examination Related Affairs

11201	Accelerated Examination	- 1 -
11202	Examination Prior to Laying-Open of Application	- 2 -
11203	Preferential Examination	- 4 -
11204	Examiner's Memorandum	- 7 -
11205	With regard to Notice of Ex-Officio Revocation, etc.	- 8 -

Chapter 3 Reference Information

11301	Patent Application Technical Trend Survey	- 1 -
11302	Standard Technology Collection	- 2 -
11303	Formality Check Manual	- 3 -
11304	Appeal pursuant to the Administrative Appeal Law	- 10 -

Chapter 1 General

11101 Qualification as Examiner

Qualification as examiner is prescribed in Article 4 of the Patent Act Enforcement Order under the provision of Article 47(2) of the Patent Act.

Patent Act

(Examination by the examiner)

Article 47 The JPO Commissioner must cause an examiner to perform examination of a patent application.

2 Qualification as examiner shall be stipulated in a cabinet order.

Patent Act Enforcement Order

(Qualification as examiner)

Article 4 A person who is qualified to be an examiner shall be an official: who is at the second grade or higher in the service of the Administrative Service Salary Schedule Table No. 1 of Article 6(1)(1)(a) of the Act on Remuneration of Officials in the Regular Service (Act No. 95 of 1950) (hereinafter, just referred to as "the Administrative Service Salary Schedule Table No. 1"), or to whom the Professional Administrative Service Salary Schedule Table of Article 6(1)(2) of the Act (hereinafter, simply referred to as "Professional Administrative Service Salary Schedule Table") or the Designated Service Salary Schedule Table of Article 6(1)(11) of the Act (hereinafter, simply referred to as "Designated Service Salary Schedule Table") is applied; and, at the same time, falls under any of the following items and has completed a predetermined training course in the National Center for Industrial Property Information and Training (INPIT).

- 1 A person who has engaged in the examination affairs for four years or more at the Japan Patent Office
- 2 A person who has engaged in the industry administration or science and technology affairs (including research; hereinafter, referred to as "the affairs of industry administration etc.") for a total of five years or more including three years or more of engaging in the examination affairs at the Japan Patent Office

- 3 A person who has engaged in the affairs of industry administration etc. for a total of six years or more including two years or more of engaging in the examination affairs at the Japan Patent Office
- 4 A person who has engaged in the affairs of industry administration etc. for a total of eight years or more, and is recognized as having an academic background being equal to or surpassing the level of a person cited in the preceding three items

11102 Provisions Pertinent to Job Duties etc. of Directors, Examination Supervisors, Examiners and Assistant Examiners

Order for Organization of Ministry of Economy, Trade and Industry (abstract) (Jun. 7, 2000 Cabinet order No. 254)

(Affairs under the jurisdiction of First Examination department)

Article 138 First Examination department shall be responsible for following affairs.

- 1 Affairs pertinent to examination of an invention and establishment of a Report of Utility Model Technical Opinion, concerning harvesting and processing of agricultural, forestry and marine products, construction, nuclear power, measurement, office supplies and commodities (an international search and an international preliminary examination pursuant to the provision of the Act on the International Applications under the Patent Cooperation Treaty (Act No. 30 of 1978) are also included; and the same shall apply to the Articles from the next items (and from the next Article) to Article 141).
- 2 Affairs pertinent to examination of an invention and establishment of a Report of Utility Model Technical Opinion, which are not belong to the responsibility of the other departments.
- 3 Affairs pertinent to examination of design.

(Affairs under the jurisdiction of Second Examination Department)

Article 139 Second Examination Department is responsible for affairs pertinent to examination of an invention and establishment of a Report of Utility Model Technical Opinion related to machines (except for affairs belonging to responsibility of other departments).

(Affairs under the jurisdiction of Third Examination Department)

Article 140 Third Examination Department is responsible for affairs pertinent to examination of an invention and establishment of a Report of Utility Model Technical Opinion concerning chemistry.

(Affairs under the jurisdiction of Fourth Examination Department)

Article 141 Fourth Examination Department is responsible for affairs pertinent to examination of an invention and establishment of a Report of Utility Model Technical Opinion concerning electric and communication.

(The number of divisions and the like of the Japan Patent Office)

Article 143 The number of divisions and offices, which are almost equivalent to divisions, to be established in the departments cited in each of the following item pursuant to the Cabinet order under Article 7(6) of the National Government Organization Act shall be the number specified in each of the items.

(Abbreviated)

2 The number of posts almost equivalent to Directors belonging to the departments cited in the following items provided in the cabinet order under Article 21quinquies of the National Government Organization Act shall be the number specified in each item concerned.

1	Examination Affairs Department	4
2	First Examination Department	8
3	Second Examination Department	7
4	Third Examination Department	7
5	Fourth Examination Department	7
6	Trial and Appeal Department	129

**Rule for Organization of the Ministry of Economy, Trade and Industry (abstract)
(Jan. 6, 2001 Ordinance of the Ministry of Economy, Trade and Industry No. 1)**

(Divisions and the like placed in First Examination Department)

Article 318 The following two divisions and eight Directors are placed in the First Examination Department.

Coordination Division

Design Division

(Job duty of Directors)

Article 320bis Among the Directors, six Directors take charge of, under the order, affairs pertinent to examination and establishment of a Report of Utility Model Technical Opinion of an invention concerning the affairs under the jurisdiction of the First Examination department, and the other two take charge of, under the order, affairs pertinent to examination of a design.

(Directors)

Article 321 In the Second Examination Department, seven Directors shall be placed.

- 2 The Directors take charge of, under the order, affairs pertinent to examination and establishment of a Report of Utility Model Technical Opinion of an invention concerning affairs under the jurisdiction of the Second Examination Department.

(Directors)

Article 322 In the Third Examination Department, seven Directors shall be placed.

- 2 The Directors take charge of, under the order, affairs pertinent to examination and establishment of a Report of Utility Model Technical Opinion of an invention concerning affairs under the jurisdiction of the Third Examination Department.

(Directors)

Article 323 In the Fourth Examination Department, seven Directors shall be placed.

- 2 The Directors take charge of, under the order, affairs pertinent to examination and establishment of a Report of Utility Model Technical Opinion of an invention concerning affairs under the jurisdiction of the Fourth Examination Department.

(Examiners and assistant examiners)

Article 325 In the General Administration Department, Examination Affairs Department, First Examination Department, Second Examination Department, Third Examination Department and Fourth Examination Department, examiners and assistant examiners shall be placed.

- 2 The examiners process, under the order, affairs pertinent to examination of applications for patent, design registration and trademark registration, international search and international preliminary examination and establishment of a Report of Utility Model Technical Opinion.
- 3 The assistant examiners, under the order, assist examiners and process affairs pertinent to examination of applications for patent, design registration and trademark registration, international search and international preliminary examination and establishment of a Report of Utility Model Technical Opinion.

(Examination supervisor)

Article 327 In Examination Affairs Department, one examination supervisor shall be placed, in First Examination Department four examination supervisors, in Second Examination Department three examination supervisors, in Third Examination Department three examination supervisors, and in Fourth Examination Department two examination supervisors.

- 2 (Abbreviated)
- 3 Among the examination supervisors placed in First Examination Department, three examination supervisors shall give help, under the order, for affairs pertinent to examination and establishment of a Report of Utility Model Technical Opinion of an invention among affairs for which the Directors are responsible and the other one shall give help, under the order, for affairs pertinent to examination of a design among affairs for which the Directors are responsible.
- 4 The examination supervisors placed in Second Examination Department, Third Examination Department and Fourth Examination Department shall give help, under the order, for affairs pertinent to examination and establishment of a Report of Utility Model Technical Opinion of an invention among affairs for which the Directors are responsible.

11103 Maintenance of Confidentiality by Examiners

1. In the National Public Service Act, there is a prescription relating to the obligation of secrecy by government officials. In addition, regarding maintenance of confidentiality pertinent to an invention of a pending patent application, the following prescriptions exist in the Patent Act. Therefore, examiners need to give attention those in particular.
2. Regarding patent applications for which registration of establishment of a patent right or laying open of application has been made, it is permissible to disclose the contents etc. of the patent applications unless otherwise falling under secrets provided for in the National Public Service Act. However, regarding a patent application other than those, not only the secrecy about the contents of that patent application, but also existence or nonexistence of the patent application as well as existence or nonexistence of a disposition need to be kept.

Article 100(1) of the National Public Service Act

Officials shall not divulge any secret that may have come to their knowledge in the course of their duties. This shall also be applied after he/she has left his/her position.

Article 200 of the Patent Act

A present or former official of the Japan Patent Office who has divulged or appropriated any secret relating to an invention claimed in a pending patent application that has become known to him/her in the course of performing his/her duties shall be punished by imprisonment with work for a term not exceeding one year or a fine not exceeding 500,000 yen.

11104 Provisions on Examination

Provisions on examination are defined by the Patent Act, Regulations under the Patent Act and the like. When citing ones closely related to daily examinations in particular among those, they are as follows.

1. Common provisions

Article 47(1) of the Patent Act

The JPO Commissioner shall cause an examiner to conduct examination of a patent application.

Article 48 of the Patent Act

The prescriptions of Article 139(1)-(5) and (7) shall apply mutatis mutandis to examiners.

(Reference)

Article 139 of the Patent Act

Where an administrative judge falls under any of the following items, he/she shall be excluded from performing his/her duties.

- 1 Where the administrative judge or its spouse or ex- spouse is or was a party concerned, intervenor or opponent of the case.
- 2 Where the administrative judge is or was a blood relative within the fourth degree of kinship, a relative by affinity within the third degree of kinship or a relative living together of a party concerned, intervenor or opponent of the case.
- 3 Where the administrative judge is a guardian, supervisor, curator, supervisor of curator, assistant or supervisor of assistant of a party concerned, intervenor or opponent of the case.
- 4 Where the administrative judge has become a witness or expert witness about the case.
- 5 Where the administrative judge is or was an agent of a party concerned, intervenor or opponent with respect to the case.
- 6 (abbreviated)
- 7 Where the administrative judge has a direct proprietary interest about the case.

Article 48bis of the Patent Act

The examination of a patent application shall be initiated after the filing of a request for examination.

Article 48sexies of the Patent Act

Where it is recognized that a person other than the applicant is working the invention claimed in a patent application as a business after the laying open of the application, the JPO Commissioner may, where deemed necessary, cause the examiner to examine the patent application in preference to other patent applications.

Article 54(1) of the Patent Act

Where it is recognized as necessary in an examination, its procedure may be suspended until a decision or trial decision against an opposition to the grant of a patent becomes final and conclusive, or a litigation procedure is completed.

Article 54(2) of the Patent Act

Where an action is instituted or a motion for a provisional seizure order or a provisional disposition order is filed, if it is considered necessary, the court may suspend the court proceedings until the examiner's decision becomes final and conclusive.

Article 5(1) of the Patent Act

Where the JPO Commissioner, a chief administrative judge or an examiner has designated a period during which the procedure is to be undertaken under the provision of this Act, the said official may extend that period upon request or ex officio.

Article 160(2) of the Patent Act

A determination in cases where an appeal decision of the preceding paragraph of [where an examiner's decision is rescinded in an appeal against an examiner's decision of refusal, an appeal decision to order a further examination to be carried out] has been made constrains the examiner about that case.

2. Provisions pertinent to intermediate actions such as amendment, a notice of reasons for refusal

Patent Act Article 17 (amendment of proceedings), Article 17bis (amendment of description, claim or drawing attached to the application), Article 48septies (a notice of statement of information concerning inventions known to the

public through publication), Article 50 (a notice of reasons for refusal), Article 50bis (a notice to the effect that the reasons for refusal stated therein are the same as those stated in the previous notice), Article 53 (declining of amendment), Article 126(7) (requirements for independent patent), Article 194 (submission etc. of documents)

Regulations under the Patent Act Article 33 (statement matters of a decision of declining of amendment)

3. Provisions pertinent to examiner's decision

Patent Act Article 49 (decision of refusal), Article 51 (decision to grant a patent), Article 52 (formal requirements for examination)

Regulations under the Patent Act Article 35 (statement matters of an examiner's decision)

4. Provisions pertinent to reconsideration by examiners before appeal proceedings

Patent Act Article 162, Article 163, Article 164

Regulations under the Patent Act Article 50quindecies(3) (application mutatis mutandis of the provisions on examination and the like)

11105 Designation and Change of Assignment of Examiners

1. Director-General, First Examination Department, Director-General, Second Examination Department, Director-General, Third Examination Department or Director-General, Fourth Examination Department designates an examiner to be in charge of examination for each patent application depending on their jurisdiction, respectively. Meanwhile, if needed, the examiner shall be designated by the Director-Generals in consultation with each other.
2. However, usually, from the viewpoint of efficiency of affairs, a Director in charge designates, by order of a Director-General in charge, duty officers for each class sign by a terminal device.
3. Regarding a patent application about which it is found that assignment according to usual designation is inadequate for special reasons, a Director in charge may change that assignment by order of a Director-General in charge.
4. Where a predetermined assignment becomes necessary to be changed for reasons of such as a personnel change (promotions, retirements, position changes etc.) of examiners and assistant examiners, organizational changes, revision of classes and the like, a Director in charge shall designate, by order of a Director-General in charge, a new duty officer by a terminal device.

11106 Examination of Case of another Art Unit

1. A Director/Office Director may, if it is found necessary by reasons of a business amount or progress of processing, cause, upon consultation with interested Directors and Office Directors, a case under the jurisdiction of another Art Unit to be examined by an examiner who is familiar with that technical field (smart examiner¹), by order of a Director-General in charge.
2. Progress of the case processed by the above-mentioned examination shall be managed by the manager of the original Art Unit in charge of the said case, and Quality Control shall be also conducted under the said Art Unit.

3. Indication of a contact name to the applicant shall be made in the following manner.

An affiliation shall be stated to the extent of a Director unit name when processing a case of another Art Unit in a same Director unit, and to the extent of a department name when processing a case of an Art Unit belonging to another Director unit in an identical department.

Concerning a contact telephone number and the like, the pilot number of the Art Unit in charge of the case processed by the above-mentioned examination shall be stated, and, the manager of the said Art Unit shall prepare for smooth response to an inquiry, if any, from the applicant and the like about the case of the smart examiner.

¹ Examiner in charge of a plurality of Art Units : SMART (Skillful in Multiple ARTs) examiner

11107 Designation of Examiner for a Case Remanded to Examination

Regarding a case to which, in an appeal against an examiner's decision of refusal, an appeal decision to the effect of "canceling the original decision, and ordering a further examination to be carried out" has been made, and which was remanded to examination, the case shall be examined by a duty officer of the said classification just like examination of a usual patent application.

Meanwhile, in this case, even if the examiner in charge is the examiner who made the original decision, the examiner shall not be excluded (refer to Article 48).

11108 Designation of an Examiner in Reconsideration by Examiners before Appeal Proceedings

Regarding a demand for appeal/trial subject to reconsideration by examiners before appeal proceedings, the JPO Commissioner shall cause an examiner to conduct examination of that demand (Article 162).

In that case, a tentative file wrapper shall be transmitted to a Director who has jurisdiction over examination of an industry field to which the invention of the patent application concerning the said demand belongs, and the said Director shall designate, in principle, the examiner who made the original decision or the assistant examiner who assisted the examiner relating to the said examiner's decision as a duty officer. In this regard, however, if the said duty officer is unable to perform examination of the demand in question, the Director designates, by order of a Director-General in charge, a duty officer who is considered to be appropriate.

11109 Reception of Patent Application and Assignment Change

1. Reception of patent application

Where documents of a patent application for which a request for examination has been received, the duty officer shall examine the contents of the patent application, and determine whether the invention claimed in the patent application belongs to classification items for which he/she is responsible. Then, when it does not belong to the classification items of his/her responsibility, the duty officer shall turn over it to a new duty officer certainly. The new duty officer shall perform the procedure of changing the individual assignment by a terminal promptly.

2. Change of assignment that comes with change of assigned classification

In the case where, after reception of a patent application for which a request for examination has been made, an error of the assigned classification was found, or where, during the examination, the assigned classification became inadequate as a result of the claims or other statement matters having been amended, a change of an assigned classification accrues. In many cases, a change of an assigned classification involves assignment change.

The new duty officer performs proceedings of the individual assignment change by a terminal.

Chapter 2 Examination Related Affairs

11201 Accelerated Examination

1. An accelerated examination system makes, in response to a request by explanation of circumstance from the applicant, an examination be conducted earlier compared with the ordinary cases under certain requirements. The system started its operation from February, 1986. After that, a series of operational revisions have been made up to the present, such as clarification of the definition of a working related application that is one of the requirements for a request, expansion of the application range to applications by SMEs and universities and the like and foreign related applications, and alleviation in investigation for prior art when requested by SMEs and universities and the like.

* For details of the accelerated examination, refer to "Accelerated Examination and Accelerated Appeal Examination Guidelines"

(http://www.jpo.go.jp/torikumi/t_torikumi/souki/pdf/v3souki/guideline.pdf)

2. In a case where "a written explanation of the need for the accelerated examination" is submitted, the Director/Office Director selects whether the accelerated examination should be applied or not. For an application that becomes a subject of the accelerated examination as a result of the selection, the examiner in charge starts the examination early in priority to ordinary applications.

11202 Examination Prior to Laying-Open of Application

When there exists a reason for refusal at a time point of examining an application prior to laying-open of the application, the reason for refusal is usually notified. However, in a case where there is found an unpublished application that will be a prior application of Article 29bis of the Patent Act when the unpublished application is laid open later, a notice of the reasons for refusal shall be issued after the laying-open of the unpublished application that will be the prior application. When waiting for laying-open of the unpublished application, the examiner shall give the applicant a notice in the examiner's name to the effect that the examination is remained on hold. Regarding a written notice given to the applicant, refer to the following description examples.

<Description Example 1>

NOTICE

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

As a result of investigation for prior art documents related to the above patent application, there is found an unpublished application that will be a prior application of Article 29bis of the Patent Act when laid open later. Therefore, it is informed that the examination is currently remained on hold, for your information.

In addition, we will notify you of reasons of refusal again after the laying-open of the unpublished application (scheduled on around YEAR, MONTH).

For inquiries or a request for interviews about this notification:

Examination Department of X XX Division The name of examiner
TEL :03-3581-1101 ext.xxxx
FAX :03-xxxx-xxxx

<Description Example 2>

NOTICE

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

As a result of investigation for prior art documents related to the above patent application, there is found an application that is a foreign language patent application of Article 184quater(1) of Patent Act and that will be a prior application of Article 29bis of the Patent Act when translation of the description pursuant to Article 184quater(1) of the Patent Act and translation of the claims under the same paragraph or Article 184(2) of the Patent Act is submitted later (refer to the following). Therefore, it is informed that the examination is currently remained on hold, for your information.

In addition, we will notify you of reasons of refusal again after the translation is submitted.

NOTE

Refer to the International Publication No. 20XX/XXXXXX (especially, refer to Page X).

For inquiries or a request for interviews about this notification:

Examination Department of X XX Division The name of examiner

TEL :03-3581-1101 ext.xxxx

FAX :03-xxxx-xxxx

11203 Preferential Examination

1. Requirements for the preferential examination

For the preferential examination (Article 48sixties), it is required that the following four requirements be satisfied.

- (1) For the patent application, examination of application is requested.
- (2) The patent application is after the laying open of the application and before the decision to grant a patent.
- (3) A third party is working the invention claimed in the patent application as a business after the laying open of the application and before the decision to grant a patent.

(Explanation)

- a. The "invention claimed in the patent application" means each claimed invention stated in the claims.
 - b. Whether there is a fact of working the invention is judged on the basis of the following materials.
 - (i). A written explanation and necessary drawings attached to the explanation of circumstances concerning the preferential examination (by a form prescribed in Article 31ter of Enforcement Regulations under the Patent Act), the written explanation and necessary drawings describing a product or method related to the working of the third party,
 - (ii) A copy of a letter of warning
 - (iii) An object such as commercial goods, a catalog, a specimen, a photograph
 - (iv) A document that proves the fact that the third party is working
- (4) The examination needs to be conducted urgently

(Explanation)

Whether or not the examination needs to be conducted urgently is judged taking the following matters into consideration comprehensively in view of the purport of removing harmful effects (Note) accompanying the system of laying-open of (unexamined) application to seek a smooth operation.

- a. The relationship between the third party (a person of working) and the patent applicant when the third party has a business relationship, a human relationship, or a capital relationship with the patent applicant
- b. The way of working, such as producing, using, selling, and its quantity or its amount of money

- c. The location and time of working
- d. Progression of negotiation between the patent applicant and the third party conducted with respect to the working, and its results
- e. Influence on the patent applicant due to working by the third party when the submitter of the explanation of circumstances is the patent applicant
- f. Influence on the third party due to warning and the like of the patent applicant when the submitter of the explanation of circumstances is the third party

(Note) The harmful effects accompanying the system of laying-open of (unexamined) application might occur in the following cases, for example.

- (i) Cases where, when a period from the laying-open of an (unexamined) patent application to examination of the application is large, the patent applicant is unexpectedly influenced due to working by a third party during that period, and the influence cannot be compensated by a compensation payment.
- (ii) Cases where, in spite of obvious failing to meet the requirements for patentability of the invention claimed in the patent application, a third party who is working receives warning under Article 65 of Patent Act from the patent applicant

2. Main cases where no preferential examination is needed

- (1) Cases of working under a grant of working and the like
- (2) Cases where, when the submitter of the explanation of circumstances is a third party, a document describing a reason why the invention claimed in the patent application does not meet the requirements for patentability and a document that supports the reason such as a publication are not submitted
- (3) Cases where an intent to abuse the system of the preferential examination is recognized

For example,

- (i) Cases recognized as a conflict by collusion
- (ii) Cases where the claims is described excessively widely compared with the statement of "the detailed description of the invention" to include the technology of the working of a third party

3. Selection of necessity of preferential examination

- (1) Judgment on whether or not the requirements of the preferential examination are satisfied is conducted in a case where the explanation of circumstances is submitted.
- (2) Whether or not preferential examination is conducted is judged by a selection conference.

The selection conference is configured by a Supervisory Director, an Office Director, and if required, an examiner in charge, of the patent application, and the Supervisory Director presides proceedings of the conference.

- (3) Judgment on whether or not the requirements of preferential examination are satisfied is basically conducted on the basis of description contents of the explanation of circumstances and documents or objects attached to it. No opportunities for submitting additional materials for clarification are given to the submitter of the explanation of circumstances.

4. Cases where no selection conference is required to be held

In a case where the Supervisory Director judges that the application supposedly satisfies the requirements for the preferential examination from contents and the like of the explanation of circumstances for the preferential examination, if it is a case where the expected time for initiating the examination of the application is early enough to a level be recognized as one unnecessary to disturb the order of the examination, the examination shall be initiated early without being submitted to the selection conference.

5. Propriety of appeal

The submission of the explanation of circumstances is confined to an act facilitating exercise of the authority of the JPO Commissioner, and whether the preferential examination is conducted or not is depending on discretion of the JPO Commissioner.

Therefore, even in a case where the preferential examination is not conducted for the submission of the explanation of circumstances, no appeal shall be available.

11204 Examiner's Memorandum

The "Examiner's Memorandum" in the Peripheral System for Patent and Utility Model Examination is used to state the "Data of Ex-Officio Correction Made to Title of Invention" (see 2002 in "Part II Description and Claims" of this Examination Handbook).

(Note) An "examiner's memorandum" is regarded as one of the documents concerning a patent prescribed in Article 186, and accordingly is an object of inspection under Article 186.

(Reference)

- (i) Image data of Notification of Non-Selection as Application Eligible for Accelerated Examination is also stored in the "Examiner's Memorandum."
- (ii) When stating a result of comparison of the claimed invention with the prior art at the time of the decision to grant a patent, the examiner shall use the "Patent Memorandum" (see 1212 in "Part I Chapter 2 Procedures of Examinations" of this Examination Handbook).

11205 With regard to Notice of Ex-Officio Revocation, etc.

Dispositions, etc. such as the decision to grant a patent, decision of refusal, and decision to dismiss the amendment, and notice of reason for refusal must not contain errors.

However, when it is found that the disposition, etc. contains an error that needs to be corrected, the examiner can correct the error by either one of "the notice of ex-officio revocation," "the notice of invalidation," "the notice of ex-officio correction," and "the notice of erroneous transmission." These notices are hereinafter simply referred to as the "notice of ex-officio revocation, etc."

If any error is found in the statements or contents of a disposition, etc. taken by the examiner, the examiner determines upon consultation with management whether a notice of ex-officio revocation, etc. is to be given or not in accordance with any of the following 1 to 4.

1. Case where notice of invalidation is to be given

In a case where the application concerned was waived, withdrawn, etc. prior to a taken disposition and thus the disposition should not have been taken, or where any change or the like has been made to the applicant and agent (hereinafter referred to as "the applicant, etc.") prior to a disposition and as a result the disposition has been made for a wrong subject of disposition, the examiner shall make a notice of invalidation to notify that the disposition in question is null and void.

2. Case where notice of ex-officio Correction is to be given

In a case where the statement of a disposition, etc. contains an obvious error for which the correct statement can be assumed, such as a case where the title of the inventions was modified by an amendment but the decision to grant a patent has been rendered with indication of the title of the invention prior to the amendment, the examiner shall make a notice of ex-officio correction in order to correct the disposition, etc. .

In view of the fact that a notice of reason for refusal is not a final disposition, the examiner should request the applicant, etc. to make an appropriate response such as making a response to the notice of reason for refusal assuming that a correct reason of

refusal has been notified, and give the notice of ex-officio correction only when the applicant, etc. does not consent to such a request.

3. Case where notice of erroneous transmission is to be given

The examiner shall make a notice of erroneous transmission to notify a recipient of the fact of erroneous transmission in the case of simple mistake of the destination of service or delivery. Since online procedures are now utilized in most cases, this case is very rare.

4. Case where notice of ex-officio revocation is to be given

Where any error, which does not necessitate the above notice of invalidation, notice of ex-officio correction, and notice of erroneous transmission, needs to be corrected, the disposition, etc. containing such an error may be revoked by a notice of ex-officio revocation.

However, revocation of an already made disposition, etc. may adversely affect the stability of the legal status of parties concerned including the applicant and licensee and increase the burden of monitoring of third parties. In addition, the current patent system provides the procedures of appeals and trials for determining the appropriateness of a disposition. Accordingly, whether or not a disposition, etc. containing an error should be revoked by a notice of ex-officio revocation is to be determined in accordance with any of the following points (1) to (3).

(1) Notice of Ex-Officio Revocation Revoking Decision to Grant Patent

The examiner shall give a notice of ex-officio revocation for revoking a decision to grant a patent only when a serious mistake is found therein and in principle the applicant gives a consent to the revocation. Such serious mistake includes a case where the disposition was made while the submission of a written amendment was overlooked and a case where the disposition was made for an erroneous case confused with the correct case due to a mistake in identification of the application numbers.

The notice of ex-officio revocation is not to be given on the ground that another reason for refusal has been found. Also, a notice of ex-officio revocation is not to be given for the purpose of offering the opportunity of divisional applications or amendments in response to a request by the applicant, etc.

(2) Notice of Ex-Officio Revocation Revoking Decision of Refusal or Decision to Dismiss Amendment

The examiner shall give a notice of ex-officio revocation for revoking a decision of refusal or a decision to dismiss the amendment only when a serious mistake is found therein such as a case where the disposition was made while the submission of a written amendment was overlooked or a case where the disposition was made for an erroneous case confused with the correct case due to a mistake in identification of the application numbers.

The notice of ex-officio revocation is not to be given on the ground that the determination regarding the inventive step, etc. has been changed. Also, a notice of ex-officio revocation is not to be given for the purpose of offering the opportunity of divisional applications or amendments in response to a request by the applicant, etc.

A notice of ex-officio revocation for revoking a decision of refusal or a decision to dismiss the amendment is not to be made after expiration of the period for filing a request for appeal against an examiner's decision of refusal without filing of the request for appeal, or after filing of a request for an appeal against an examiner's decision of refusal.

(3) Notice of Ex-Officio Revocation Revoking Notice for Reason for Refusal

A notice for reason for refusal is not a final disposition. In view of this, even when a serious mistake is found therein, such as a case where the disposition was made while the submission of a written amendment was overlooked or a case where the disposition was made for an erroneous case confused with the correct case due to error in identification of the application numbers, the examiner should request the applicant, etc. to make an appropriate response such as mentioning the existence of the error in a written opinion, and continue the examination with the approval by the applicant, etc. The notice of ex-officio revocation is to be made only when the applicant, etc. does not consent to such a request.

The notice of ex-officio revocation is not to be given on the ground that the determination regarding the reason for refusal has been modified based on a newly found prior document.

Chapter 3 Reference Information

11301 Patent Application Technical Trend Survey

1. Outline of the patent application technical trend survey

The Japan Patent Office carries out the patent application technical trend survey for fields in which the development of technologies is expected, or fields to which social attention is being paid. In the survey, application trends and correlations between technologies are investigated and analyzed using domestic or overseas patent information, in light of the research and developmental trends, market trends, and the like. The results of the investigation are published as reference information for formulating research and developmental strategy and intellectual property strategy in businesses etc. and for policy making in the government. The results are also utilized as basic articles for establishment of the flexible examination system, the revision of FI and F terms, and the revision of IPC.

2. The patent application technical trend survey has been conducted since fiscal year 1999. The reports having been generated in the past are being distributed as examination articles in each examination search office and examination office relating to the examination departments.

3. A portion of the search results of the patent application technical trend surveys which have been conducted before now is available for browsing as PDF data on the Japan Patent Office homepage.

The homepage address is <http://www.jpo.go.jp/shiryu/gidou-houkoku.htm>.

11302 Standard Technology Collection

1. Outline of the standard technology collection

In the Japan Patent Office, standard technologies are specified, and technologies and the like which are stated in non-patent literature such as literature, manuals, catalogs, Web pages, and the like in which standard technologies are accurately expressed are collected, in order to summarize the standard technologies collection.

The standard technology collection is a collection of information in which standard technologies that are difficult to determine only from patent documents are accurately expressed (for example, representative drawings), so as to contribute to effective examination in each technical field as an examination article for examiners.

2. The preparation of the standard technology collection was performed from fiscal 2000 to fiscal 2006. What has been prepared is being distributed as an examination article in examination offices relating to the examination departments.

3. The prepared standard technology collection is available for browsing from the Japan Patent Office homepage.

The homepage address is

http://www.jpo.go.jp/shiryousonota/hyoujun_gijutsu.htm.

11303 Formality Check Manual

In the Formality Check Manual

(http://www.jpo.go.jp/shiryoku/kijun/kijun2/binran_mokuji.htm), items to be a good reference for substantive examination of a patent and utility model are included. Those are extracted below.

01. Party concerned	
01.23	Legal capacity to hold rights based on the principle of reciprocity
01.50	About Mutual representation of multiple parties in the case
01.60	Handling of legal capacity to hold rights of stateless persons
01.61	Handling in cases where an area to which a notification of Article 16bis(1) of the Paris Convention (Lisbon revised convention) or a declaration or notification of Article 24(1) of the Paris Convention (Stockholm revised convention) was made becomes an independent nation
01.62	Handling in cases where a business establishment in the course of liquidation files an application
01.90	About National Property Act and nationally-owned patent right etc.
01.91	About proceedings of each minister of government offices for an application, a demand for appeal/trial etc.
02. Representation	
02.20	Procedures about appointment of an Agent of minors etc.
02.21	Interpretation and handling of the provision on nontermination of power of attorney under Article 11 of the Patent Act
02.22	Handling, in cases where an action to appoint an agent has been entrusted to anyone else, as to the status of the agent appointed based on that entrustment
02.23	Handling in cases where, when jointly undertaking procedures, only a part of persons among the persons jointly undertaking the procedures have an agent
02.24	About notification of appointment of power of attorney etc.
02.25	Handling in cases where an agent by entrustment dies
02.26	About status of a subagent in cases where an agent by entrustment dies
02.27	Handling in cases where a patent administrator dies or resigns
02.28	Handling in cases where a subagent appoints a subagent further
02.29	Handling of authority of representation relating to priority claim based on a patent application etc.

	(patent/utility model)
02.90	Handling in cases where, in an application by the State, a designated agent is changed
02.91	About omission of documents that stating authority of representation in a patent application by the State
03. Time when submission of a document becomes effective	
03.10	Handling in cases where the communication date stamp of a document or an item with a time period submitted by mail or correspondence delivery is unclear
04. Period	
04.04	About relief after expiration of a period due to reasons beyond the control of the applicant
04.05	About relief after expiration of a period with due care
04.09	List of major periods
04.10	Handling of legal period and designation period
04.11	About interpretation of period as to procedure such as patent application, request for trial provided in Article 3(2) of the Patent Act
04.12	About period calculation in cases where period is extended
05. Suspension / Termination	
05.10	Handling in cases where decision etc. of commencement of reorganization proceedings under the Corporate Reorganization Act is made
05.11	Handling of procedures carried out in the course of suspension or termination
05.12	Handling in cases where the applicant dies
06. Transmittal	
06.10	Handling in cases where, after notification of change in applicant, a copy of a notice of reasons for refusal or examiner's decision has been dispatched to the former holder
07. Fees / Annual fee / Registration fee	
07.03	Handling of refund request of fees for a request for examination (patent)
07.14	About fees for request for examination and demand for appeal/trial (patent)
07.15	Handling as to refund of fees paid by mistake or in excess etc. or refund of annual/registration fees
07.30	Handling of request for reduction/exemption or deferment of the payment of fees etc. (patent/utility model/trademark)
07.31	Regarding certificates to be attached, under prescriptions of Patent Act and/or

	Utility Model Act, to a written request for receiving reduction/exemption of fees for an examination request or a request for utility model technical opinion, or reduction/exemption or deferment of patent annual fees or registration fees (patent/utility model)
07.32	About reduction/exemption of fees etc. or reduction/exemption or deferment of patent annual fees or registration fees under the provision of Patent Act or Utility Model Act (patent/utility model)
07.33	About reduction of fees etc. under the provision of the Act Promoting Technology from Universities to Industry (patent)
07.35	About reduction of fees etc. targeting researchers of universities etc. and universities etc. under the provision of the Act for Enhancing Industrial Technology (patent)
07.36	About reduction of fees etc. targeting test/research Incorporated Administrative Agencies etc. under the provision of the Act for Enhancing Industrial Technology (patent)
07.37	About reduction of fees etc., under the provision of Act for Enhancing Industrial Technology, targeting a person who establishes a public research organization (patent)
07.38	About reduction of fees etc., under the provision of the Act for Enhancing Industrial Technology, targeting test/research Local Incorporated Administrative Agencies (patent)
07.39	About reduction of fees etc. targeting R&D-oriented SMEs etc. under the provision of the Act for Enhancing Industrial Technology (patent)
07.40	About reduction of fees etc. under the provision of SME Manufacturing Enhancement Act (patent)
07.41	About reduction of fees etc. under the provision of the Act Promoting Japan as an Asian Business Center (patent)
07.42	About reduction of fees etc. under the provision of Act on Special Measures for the Reconstruction and Revitalization of Fukushima (patent/trademark)
07.43	About reduction of fees etc. under the provision of Act Enacting the Industry Competitiveness Enhancement (patent)
07.45	About reduction of fees etc. under the provision of Regional Future Investment Promotion Act (patent/trademark)
11. Method for indicating a person conducting procedures	
11.21	Seal and signature

11.51	Handling in cases where indication of applicants etc. in a joint application or a joint appeal/trial is Party X "and (several) others"
11.52	About indication method and determination of the sameness of the domicile or residence in an application, a demand for appeal/trial etc.
11.53	Handling of separators and hyphens in a domicile or residence, full name or entity name in an application, demand for appeal/trial etc.
11.54	About indication of nationality and address of Taiwan
11.55	Regarding an application, demand for appeal/trial and registration request by an imprisoned criminal
11.56	Handling of seal after the sameness of a person conducting procedures has been certified by a seal registration certificate
11.58	Handling in cases where, in indication of a full name or entity name in an application, demand for appeal/trial etc., only the phonetic resulting from the way of reading a foreign language is different
13. Submission of a certificate and omission of documents to be submitted	
13.20	About statement of a domestic legal entity name in a certificate etc. stated in a foreign language
13.23	Handling of a certificate on which an identification label is stuck instead of setting the seal on it
13.30	Handling of return of a certificate in cases where a request for return of a certificate is made
15. Acceptance and dismissal	
15.20	Handling of dismissal of a procedure with regard to an unlawful application document etc.
16. Violation of formality/Dismissal	
16.06	Handling of dismissal etc. of a payment document of annual (registration) fees for the registration of establishment
16.07	Handling of dismissal etc. of a payment document of annual (registration) fees after the registration of establishment
21. Application	
21.50	About amendment of an inventor etc. (patent/utility model/design)
21.51	About statement of the address of an inventor etc. (patent/utility model/design)
21.52	About correction of the indication of an applicant
21.53	Handling of an application with an unclear full name or entity name of an

	applicant
21.54	About amendment of an applicant in cases where a private business has filed an application under the name of a trade name etc.
21.61	Handling of the certification of filing date (patent)
21.62	Patent application by a method for claiming to refer an earlier patent application (patent)
23. Description (patent/utility model)	
23.20	About amendment of procedures pertinent to the description, the scope of claims or drawings (patent/utility model)
23.21	Handling in cases where, on the occasion of an application filed on Jul. 1, 2003 or later, the description prepared by a method before the revision is attached to an application (patent/utility model)
23.22	About supplement of lacking parts of the specification or drawings (supplement of the lack) (patent)
24. Drawings (patent/utility model)	
24.10	Handling of "explanation about drawings" filled out in a drawing (patent/utility model)
24.11	Handling of photographs attached to an application etc. instead of drawings (patent/utility model)
28. Priority/Exceptions to lack of novelty, etc.	
28.01	Procedures of a priority claim under the Paris Convention or a priority claim recognized under the Paris Convention
28.02	Handling of withdrawal/waiver of a priority claim under Paris Convention etc.
28.10	Handling of procedures of priority claim based on a regular domestic application pursuant to Article 4A(2) of the Paris Convention
28.11	Handling pertinent to indication concerning priority claim
28.12	Handling of amendment of a written priority claim under the provision of Article 17quarter of the Patent Act or Article 2bis(1) of the Utility Model Act (patent/utility model)
28.21	Handling pertinent to elapse of the time due to the delay of an office work that issues a priority certificate
28.41	Handling of priority claim based on a patent application etc. having formal irregularities (patent/utility model)
31. Special applications (division / conversion / amendment dismissal)	
31.32	Handling in cases where, about a patent application for which a decision of

	refusal was made, an application has been converted together with a demand for an appeal against an examiner's decision of refusal (patent/utility model/design)
43. Amendment	
43.20	Handling in cases where amendment performed by the applicant in response to an invitation to amend by the JPO Commissioner is dismissed as changing the gist by determination of the examiner (patent/utility model/trademark)
43.21	Handling of a written amendment submitted in advance of arrival of a notification of a dismissal of the application
43.22	Handling in cases where, about an application for which formal deficiencies have not been amended, a spontaneous written amendment etc. unrelated to the object of the invitation to amend is submitted
43.24	Handling of written amendments in cases where, when amendment has been ordered about two or more matters, amendment is carried out by a plurality of written amendments
43.25	Handling of a written amendment that identifies portions to be amended by citing public Gazettes (patent)
43.26	Amendment of the share stated in an application
45. Change of persons	
45.20	Handling of a notification of change of applicant
45.21	Handling in cases where some of applicants among joint applicants have waived their shares
45.23	Handling of, in cases where several rounds of assignments have been made, a notification of change of applicant furnished by final successor or assigner
45.25	Handling of a notification of change of applicant to which a written declaratory judgment is attached
48. Withdrawal of application and waiver of application	
48.20	Handling pertinent to procedures of withdrawal and waiver of an application made when formal inadequacies of an application from the view point of formality is not resolved
54. Official Gazettes	
54.50	Handling when there are inaccuracies in published matters of a Patent Gazette etc.
54.51	Handling of Official Gazettes in cases where, before laying open of an application or utility model registration, the application is withdrawn, waived

	or dismissed, or where decision of refusal has become final and conclusive (patent/utility model/trademark)
58. Inspection and certification	
58.20	Inspection etc. of documents, models and specimens
85. Demand for trial	
85.20	Handling of a demand for trial for an application, in which the right to obtain a patent is jointly owned, the demand being made by the "representative" among co-owners
126. Method of amendment procedures	
126.01	Preparation example of a written amendment concerning amendment of the description etc. attached to an application filed on Jul. 1, 2003 or later (patent/utility model)
126.02	Preparation example of a written amendment relating to amendment of the description attached to an application filed on Jan. 1, 2009 or later (patent/utility model)
126.10	Preparation example of a written amendment concerning amendment of an application etc.
126.20	Preparation example of a written amendment concerning amendment of the description attached to the application filed on Jun. 30, 2003 or before (patent/utility model)
126.30	Preparation example of a written amendment concerning amendment of patent/utility model drawings (patent/utility model)
126.40	Preparation example of a written amendment concerning an amendment of document for certifying power of attorney or other materials
126.50	Preparation example of a written amendment concerning amendment of "offering to the effect that the procedure has been made"
126.60	Preparation example of a written amendment concerning amendment of fees
126.70	Preparation example of a written amendment in cases where amendment of an inventor or correction of the indication of an applicant is conducted using an electronic information processing system
126.80	Handling of correction etc. that makes, in cases where there is an indication of an identification number in the field of Applicant in the application, the full name (entity name) of the said field and the full name (entity name) associated with the identification number be matched

11304 Appeal pursuant to the Administrative Appeal Law


A person who is dissatisfied with disposition of an administrative agency may enter an appeal pursuant to the Administrative Appeal Law (Article 2 of the Administrative Appeal Law).

In this regard, however, among dispositions in the Japan Patent Office, concerning: an examiner's decision; a rescission decision or an appeal/trial decision; a decision to decline a written opposition to the grant of a patent, a written request for appeal/trial or retrial or a written request for correction under Article 120quinquies(2) of the Patent Act or Article 134bis(1) of the Patent Act; and dispositions against which it is considered that an appeal is not allowed under the provision of the Patent Act, an appeal pursuant to the Administrative Appeal Law is not allowed (Article 195quarter of the Patent Act).

In addition, an invitation to correct, a notice of reasons for refusal, a notice and the like to the effect that retroaction of an application date is not allowed are not administrative measures in a point that those do not exert influence on the right or profits directly, and, therefore, it is understood that no appeal pursuant to the Administrative Appeal Law may be filed against those.

As disposition in Japan Patent Office to be a subject of the Administrative Appeal Law, there is a disposition of dismissal (Article 13(4), 18, 18bis(1), 133(3), 133bis(1), 184quinquies(3) of the Patent Act and Article 7(3) of the Act on the Special Provisions to the Procedures, etc. concerning Industrial Property Rights) and the like, and appeal against these dispositions is claimed to the JPO Commissioner, and examination of that appeal is conducted by General Coordination Division.

Article 195 quarter of the Patent Act (limitations of an appeal pursuant to the Administrative Appeal Law)

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| <p>(1) Decision to grant a patent (Article 51)</p> | → | <p>Opposition to the grant of a patent
(Article 113),
Trials for patent invalidation
(Article 123)</p> |
| <p>(2) Decision of refusal (Article 49)</p> | → | <p>Appeals against an examiner's decision of refusal
(Article 121)</p> |
| <p>(3) Decision of rescission (Article 114(2))</p> <p>(4) Appeal/trial decision (Article 157)</p> <p>(5) Decision to decline a written opposition to the grant of a patent
(Article 120octies(1) → Article 133(3))</p> <p>(6) Decision to decline a written demand for appeal/trial (Article 133(3))</p> <p>(7) Decision to decline a written request for correction pursuant to Article 120quinquies(2)
(Article 120octies(1) → Article 133(3)/Article 133bis(1))</p> <p>(8) Decision to decline a written request for correction pursuant to Article 134bis(1)
(Article 133(3)/Article 133bis(1))</p> <p>(9) Decision to decline a written request for retrial
(Article 174(2)-(4) → Article 133(3))</p> |  | <p>Litigation
(Article 178)</p> |

Disposition against which it is considered that appeal is not allowed under the provision of the Patent Act

- (1) Decision to decline amendment (Article 53(3))
- (2) Decision to decline a demand for judgment (Article 71(4))
- (3) About the amount of remuneration decided by a ruling (Article 91bis)
- (4) Decision to the effect that a patent be maintained against an opposition to the grant

- of the patent concerned (Article 114(5))
- (5) Decision of permission for amendment of reason of demand for trial for invalidation
(Article 131bis(4))
- (6) Decision as to claim of exclusion or refusal of an administrative judge
(Article 143(3))
- (7) Decision on a request for intervention in a trial for invalidation and the like
(Article 149(5))