

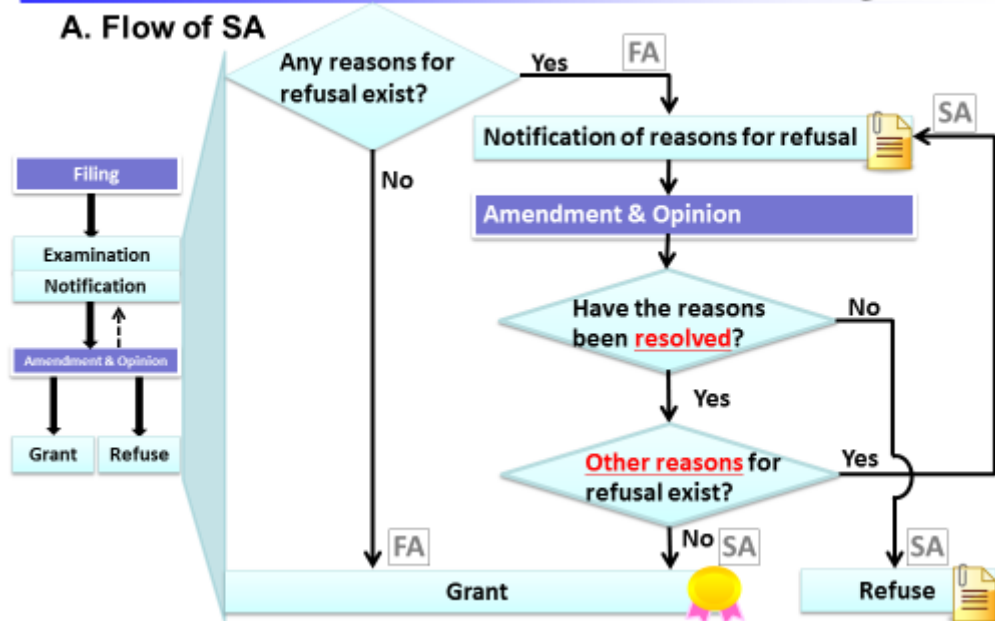
- I. Overview
- II. First Action (FA)
- III. Second Action (SA)

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Next, let me explain the Second Action.

III. Second Action (SA)



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This is the flow of the SA.

This slide shows not only SA itself, but also the relationship between SA and FA.

If the present application doesn't have any reasons for refusal, the application is granted directly.

If the present application has reasons for refusal, a patent examiner drafts a notification in this regard and sends it to the applicant as an FA.

After the FA, the applicant usually submits an amendment and an opinion. Often, the claims of the application are amended.

After the amendment, the examiner must judge whether or not the reasons stated in the FA have been resolved.

If not, the examiner refuses the application.

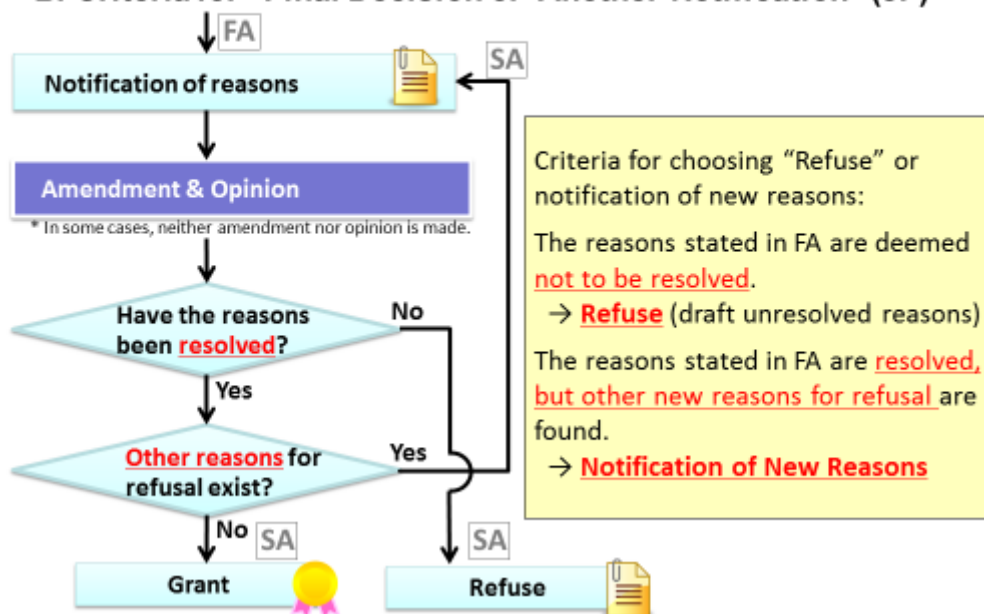
If yes, the examiner must judge whether or not other reasons for refusal exist.

If not, the examiner grants a patent. If yes, the examiner again drafts a notification of the reasons for refusal as an SA.

In the next sheet, we can see more details of SA.

III. Second Action (SA)

B. Criteria for “Final Decision or Another Notification” (JP)



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This shows the details and judge criteria for the SA.

After the FA, the applicant sometimes doesn't reply, either with an amendment or an opinion. In this case, it is likely that the examiner will refuse the application.

The applicant usually submits an amendment and an opinion. The examiner fully considers the contents thereof, and considers the next action.

When the reasons stated in the FA are deemed not to have been resolved, the examiner refuses the application and drafts unresolved reasons to the applicant.

Sometimes the amendment is not good enough to resolve the reasons stated in the FA.

In such a case, examiners can refuse the application on the same grounds.

When the reasons stated in the FA are resolved, but other new reasons for refusal are found, the examiner drafts a notification again as an SA.

Sometimes, the examiner finds other new reasons for refusal for an amended claim. In this case, the examiner drafts a notification again.

When the reasons stated in the FA are resolved, and no other reason exists, the examiner grants a patent.

In the next chapter, we will look at samples of amendments.

III. Second Action (SA)

C. Examples of “Refuse” or “Notification of New Reasons”

- | |
|---|
| <ul style="list-style-type: none">• <u>Amended part</u> of a claim <u>is mentioned in the prior art document cited in FA</u>• Addition of a <u>well-known art</u> to a claim• Addition of a <u>commonly used art</u> to a claim<ul style="list-style-type: none">→ The reasons are deemed <u>not to be resolved</u>→ Refuse |
| <ul style="list-style-type: none">• Against the amended claim, <u>a new prior art document is found</u> other than the well-known art and the commonly used art• <u>Amendment made</u> the claim or description <u>unclear</u>• <u>Amendment added a new matter</u> to the claim or description<ul style="list-style-type: none">→ The reasons stated in FA are <u>resolved, but other new reasons for refusal</u> are found→ Notification of New Reasons for Refusal |

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This is an example showing types of amendments and actions that examiners take in this regard.

The square above shows cases of refusal, and the square below shows an SA (i.e., another notification case).

Now, let's look at the details in each case.

First, the following indicates cases for which a decision of refusal is made because the reason for refusal stated in the FA has not been resolved:

- Cases where the amended part of a claim is mentioned in the prior art document cited in the FA,
- Cases where the addition of a well-known art to a claim is made in the amendment
- Cases where the addition of a commonly used art to a claim is made in the amendment

Next, the following are cases in which the notification of reason for refusal is sent in the SA:

- Cases where the amendment resulted in the claim or description becoming unclear
- Cases where the amendment added a new matter to the claim of description
- Cases where a new prior art document is found against the amended claim

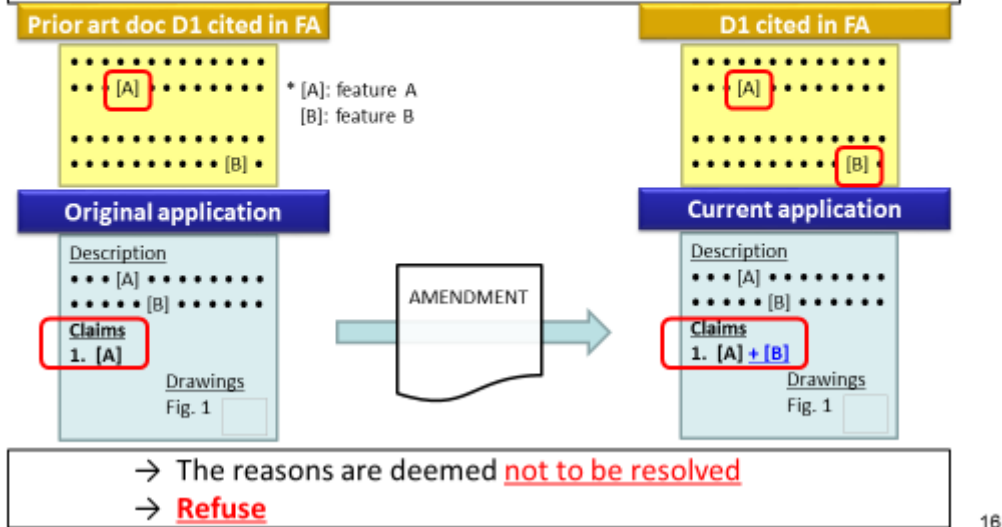
In these cases, the reason for refusal stated in the FA has been resolved, but other new reasons for refusal are found and the notification of reason for refusal is therefore sent in an SA.

We will look at examples of these cases beginning with the next slide.

III. Second Action (SA)

D. Examples of “Refuse” 1/2

- Amended part of a claim is mentioned in the prior art document cited in FA



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This picture shows an example where an amended part of a claim is mentioned in the prior art document cited in the FA.

The claim filed in an FA is shown on the left, and the amended claim is shown on the right.

The claim 1 filed in the FA includes feature A.

The examiner sent a notification of reason for refusal to the applicant against this claim based on D1, in which feature A is disclosed.

The applicant filed an amended claim 1 which includes feature A and B in response to this FA.

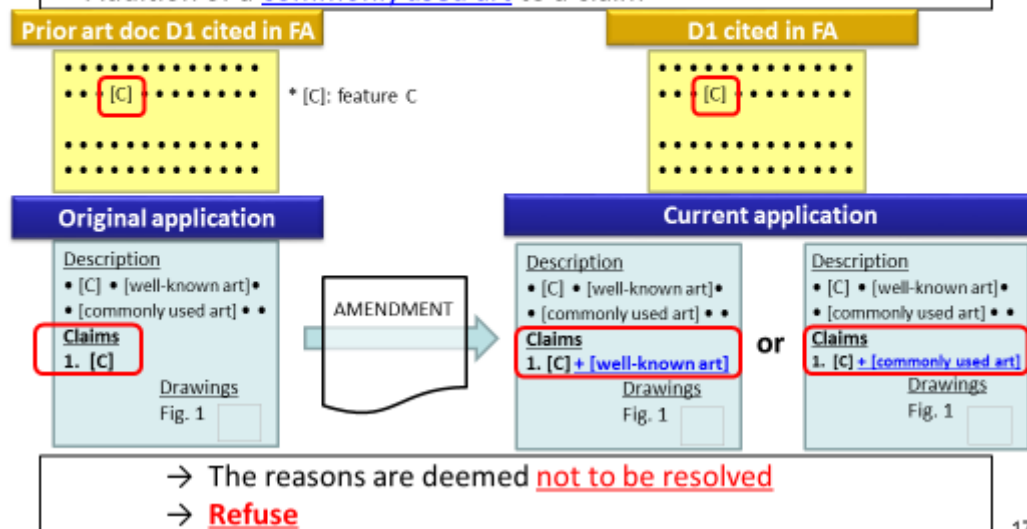
Feature B, which has been added to the claim in the amendment, is the feature disclosed in D1, which is the document the examiner cited in the FA.

In this case, therefore, the reason for refusal based on D1—the reason for which was notified to the applicant in the FA—has not been resolved, and the examiner therefore makes a decision of refusal.

III. Second Action (SA)

D. Examples of “Refuse” 2/2

- Addition of a well-known art to a claim
- Addition of a commonly used art to a claim



---(Slide 17)---

This picture shows an example of an “addition of the well-known art or commonly used art to a claim.”

The claim filed in the FA is shown on the left, and the amended claim is shown on the right.

The claim 1 filed in the FA includes feature C.

The examiner sent a notification of reason for refusal to the applicant against this claim based on D1, where feature C is disclosed.

The applicant made an amendment in response to this FA.

Please look at the amended claim on the left.

In this case, the well-known art has been added to the element of the invention C in the amendment.

Also, please look at the amended claim on the right.

In this case, the commonly used art has been added to the feature C in the amendment.

On the other hand, the feature C has already been disclosed in D1.

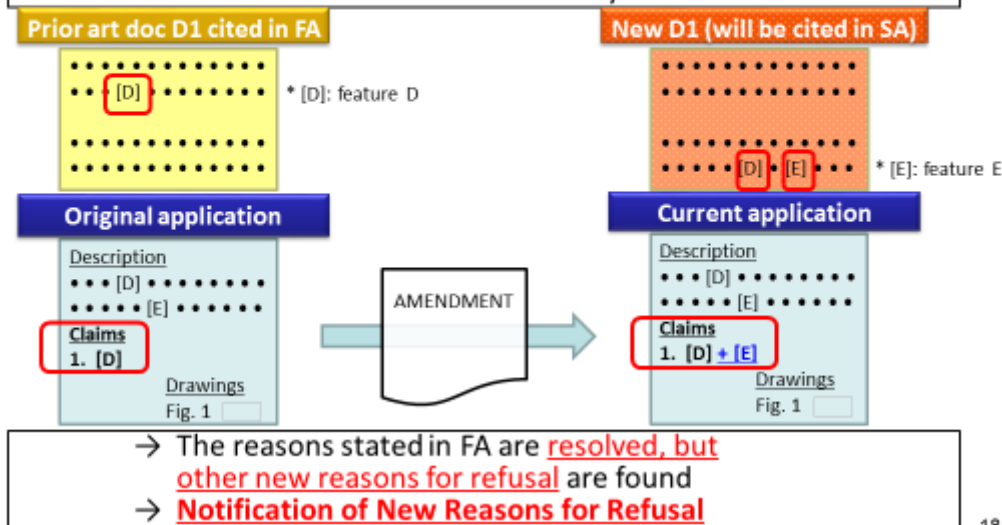
This means that a person skilled in the art can easily achieve the claimed invention in this application by applying the well-known or commonly-used art to feature C, which is disclosed in D1.

Therefore, the reason for refusal that was notified to the applicant in the FA has not been resolved, and the examiner consequently makes a decision of refusal.

III. Second Action (SA)

E. Examples of “Notification of New Reasons for Refusal” 1/2

- Against the amended claim, a new prior art document is found other than the well-known art and the commonly used art



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This picture shows an example where “a new prior art document is found”.

The claim filed in the FA is shown on the left, and the amended claim is shown on the right.

The claim 1 filed in the FA includes feature D.

The examiner sent a notification of reason for refusal to the applicant against this claim based on D1 in which the feature D is disclosed.

And the applicant filed an amended claim which includes features D and E in response to this FA.

In this case, the reason for refusal based on D1 in which the feature D is disclosed has been resolved.

On the other hand, the examiner conducted a new prior art search and found a new D1 in which the features D and E are disclosed.

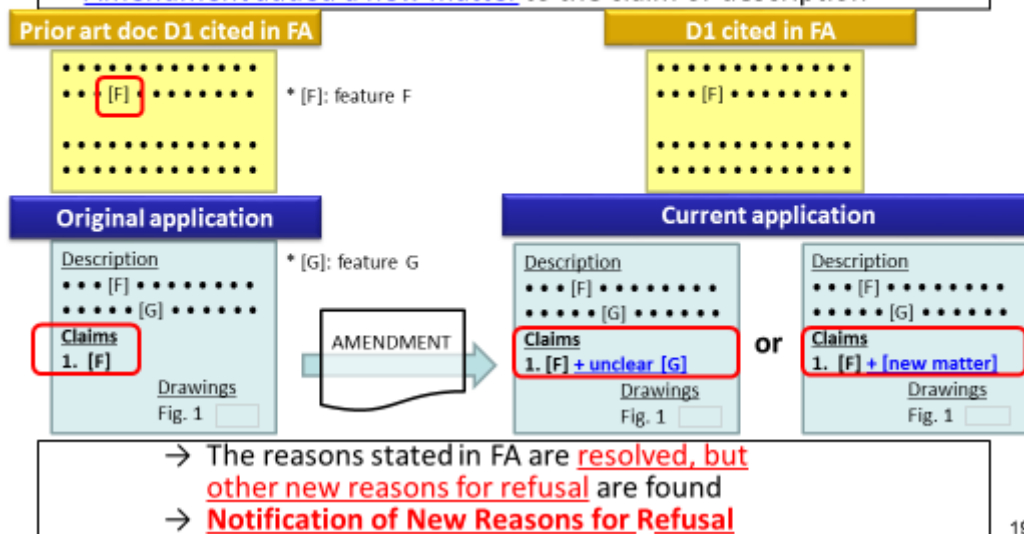
That means that the reason for refusal in the FA was resolved, but the examiner found a new reason for refusal.

In cases like these, the examiner makes the Second Action wherein he or she again sends a notification to the applicant of a new reason for refusal based on a new D1.

III. Second Action (SA)

E. Examples of “Notification of New Reasons for Refusal” 2/2

- Amendment made the claim or description unclear
- Amendment added a new matter to the claim or description



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This picture shows an example of an “Unclear Amendment and Amendment adding new matter”.

The claim filed in the FA is shown on the left, and the amended claim is shown on the right.

The claim 1 filed in the FA includes feature F.

The examiner sent a notification of reason for refusal to the applicant against this claim based on D1 in which the feature F is disclosed.

And the applicant made an amendment in response to this FA.

Please look at the amended claim on the left.

In this case, the applicant filed an amended claim which includes features F and G.

However, feature G which has been added in the amendment is not clear.

In this case, the reason for refusal based on D1 in which the feature F is disclosed has been resolved.

However, the examiner found a new reason for refusal regarding the clarity requirement since the feature G which has been added in the amendment is not clear.

Next, please look at the amended claim on the right.

In this case, the applicant made an amendment but also added new matter in the amendment.

In this case, the reason for refusal based on D1 in which the feature F is disclosed has been resolved.

For the reason that a new matter has been added in the amendment, however, the examiner found a new reason for refusal, which is the “addition of new matter”.

In both of these two cases, the reason for refusal in the FA has been resolved, but the examiner found a new reason for refusal.

In cases like these, the examiner makes the second action wherein he or she again sends a notification of a new reason for refusal to the applicant.

III. Second Action (SA)



F. Points to consider

- Opportunity for amendment
The applicant's opportunity for amendment may not be unreasonably limited.
- Suggestion of amendment
In a notice of reasons for refusal, the examiner may suggest an amendment, which enables applicants to easily respond and thus contributes to prompt and precise examination.
- Communication
When it is considered to contribute to prompt and precise examination, examiners could communicate with the applicant through an interview, by telephone, or by facsimile.

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Lastly, these are the points to consider at the stage of the SA.

- The applicant's opportunity for amendment may not be unreasonably limited.
- The examiner may suggest an amendment in a notice of reasons for refusal, which enables applicants to easily respond—thereby contributing to prompt and precise examinations.
- Examiners can consider communicating with the applicant through an interview, by telephone, or by facsimile when this would contribute to a prompt and precise examination.