

Prosecution through Office Action of Patent Applications

- Application Procedures -

**Japan Patent Office
Asia-Pacific Industrial Property Center, JIII**

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I . Overview

1. An Outline of Patent Prosecution

Patent prosecution means procedures taken by an applicant of a patent application with the Examination Department or Appeal Board Department of the Patent Office during the period from filing of the application to decision of grant or rejection. Here we focus on patent prosecution at the Examination Department, explaining procedures relating to formality, procedures for making voluntary amendments, procedures for submitting statements relating to priority-based examination, procedures for responding to notice of reasons for refusal, procedures for dividing an application and other various procedures to be taken during the period from filing of an application to decision of grant or rejection.

Those procedures need to be taken in the Japanese language and in writing using prescribed formats though, most of such documents may be submitted online via the Internet as a result of digitalization of operations within the Patent Office. Care should be taken that some prosecution procedures may be taken only during a prescribed period of time and that any prosecution procedure taken after such a period will be dismissed.

The most important and most common prosecution procedures are those relating to notice of reasons for refusal. A notice of reasons for refusal states the reasons and relevant law provisions based on which the application should be rejected. (Article 49 of the Patent Law) Accordingly, reply to such a notice must be decided based on correct understanding of alleged incompleteness of, for instance, description of claim or specification of invention with respect to which the notice of reasons for refusal is issued, and on whether or not the reasons for refusal are appropriate in light of relevant law provisions and the given reasons. Based on the decision, the applicant will take measures such as submitting an opinion letter and/or amendment, filing a divisional application, or making no response.

In the case where the applicant resides outside Japan, prosecution procedures recited above need to be taken by a patent agent who has an address or resides in Japan and acts on behalf of the applicant with respect to the patent. (Article 8 of Patent Law) Hence, foreign applicants dealing with patent prosecution need to regularly make efforts to ensure good communication with their patent agents and correctly understand recognition of an invention and the Patent Law so that appropriate measures will be taken by the agents.

2. Measures relating to Law Amendments

Since Basic Law on Intellectual Property was adopted in 2002, the Japanese Patent Law has been amended almost every year based on the Intellectual Property Promotion Initiatives of each year. Recent amendments include introduction of obligation to disclose prior art documents (September 2002); abolition of the opposition system and revision of the invalidation action system (January 2004); amendment on requirements for unity of invention (January 2004); revision of patent-related fees (April 2004); amendments relating to the utility model system centered on extension of effective period (April 2005); and establishment of the Intellectual Property High Court (April 2005). In April 2007, moreover, law amendments causing significant changes to patent prosecution will become effective, including amendments relaxing requirements for divisional applications allowing filing of a divisional application after grant of patent, prohibition of amendments changing the subject matter to another invention having different technical features, and extension of deadlines for filing Japanese translation.

In any case, an applicant or its agent should closely follow those law amendments and related development by, for instance, regularly checking the website of the Patent Office to appropriately comply with the new practice and procedures based on the law amendments.

3. Instructions based on Administrative Appeal Law

From April 1, 2005 onwards, any notice of decision issued during examination or examination before the Appeal Board stipulates, at the very end of the notice, where and when and against whom any complaint against the decision may be filed. Any complaint against a decision should be processed in reference to the instructions.

4. Bibliographies

In each of the specifics below, the “Examination Standards” compiled by the Japan Patent Office, especially the chapter “How to Carry Out Examination” in the Examination Standards “Examination Handbook” and other various guidelines are referred to. Should you have any inquiry or question after reading this report, access the website of the Patent Office to directly refer to those materials to help your understanding.

II. Procedures Taken at the Patent Office

1. Patent Prosecution Process

Appendix 1 shows the process chart of patenting procedures. As described above, prosecution procedures will be required in response to various actions indicated in the process chart of Appendix 1.

2. Examination Process at Examination Department

Process of examination conducted by an examiner and potential actions taken toward an applicant are shown in the process chart of Appendix 2. When responding to an action taken by an examiner, the applicant needs to well understand the examination process shown in Appendix 2 and what is indicated in the action.

(1) Understanding and Recognition of Claimed Invention

Examination starts with recognition of the invention and the scope of the described claim(s) of the patent application. The examiner first closely reads the specification to completely understand what the invention is and then recognizes the scope of the claim(s) of the invention based on the claim description.

(2) Identification of Focus of Examination (Examination on Requirements for unity of Invention and Requirements relating to Description)

Upon recognition of the invention, requirements for unity of invention are examined (Article 37). At the same time, examination is carried out on requirements for description of specification and claim(s) (Article 36) to identify the invention with respect to which prior art search should be conducted. Any claim not meeting the requirements for unity of invention or significantly unclear claim description preventing identification of subject invention will be excluded from substantive examination.

(3) Prior Art Search (Search on Requirements of Novelty/Inventiveness)

Prior art search is conducted with respect to the claimed invention identified as the subject matter for examination to see if it meets the requirements of novelty and inventiveness (Articles 29, 29bis and 39). If the applicant discloses prior art information in the specification or if prior art references are cited in the search report produced by a search organization (including a foreign patent office), examination must be conducted with respect to such references.

(4) Examination on Requirements of Novelty/Inventiveness

Based on the result of prior art search, the claimed invention identified as the subject matter of examination in (2) is examined with respect to its novelty and inventiveness.

(5) Notice of Reasons for Refusal

If, as a result of examination, any reason for refusal is found, a notice of reasons for refusal is issued (Article 50). Such a notice must stipulate the examiner's decision with respect to each claim.

(6) Treatment of Opinion Letter/Amendment

In the event amendments are requested by the applicant, the examiner makes sure that such amendments will not add new matter in light of the original specification, claims and drawings. Then the examiner fully examines what is described in the opinion letter and amendments to decide whether or not relevant reasons for refusal have been overcome.

Even if relevant reasons for refusal are overcome, the examiner may issue a renewed notice of reasons for refusal after considering whether it should be "the final notice of reasons for refusal" if new reasons for refusal are found.

(7) Decision

If no reasons for refusal are found, a decision of grant will be issued (Article 51).

If the examiner decides that the notice of reasons for refusal sent to the applicant have not been overcome even with opinion letter and amendments, a decision of rejection as well as dismissal of amendments, if necessary, will be issued (Article 49).

The decision of rejection must stipulate all the reasons for refusal that have not been overcome, clearly indicating which reasons for refusal relate to which of the claims.

(8) Pre-Appeal Board Examination

If an amendment is requested simultaneously with appeal against decision of rejection, the application will be subject to examination by the original examination (Article 162).

During this pre-appeal board examination, the examiner will consider whether the latest amendment meets the limitation on amendments set forth in Article 17bis(3), (4) and (5) and decide whether the grounds for decision of rejection are overcome.

If, as a result of the consideration, the examiner finds that the grounds for the original decision of rejection are overcome and that there is no other reason for refusal, the examiner will retract the decision of rejection and issue a decision of grant. If the examiner finds that decision of

grant should not be given, pre-appeal board examination will be terminated with a written report of pre-appeal board examination and the case will be referred to the Appeal Board.

An applicant will be given the chance of amendment and decision of grant with respect to minor incompleteness of description which may be overcome through interview suggesting that the applicant make amendments.

III. Prosecution (Formality)

1. Order of Formality Amendment and Response Thereto

(1) Order of Formality Amendment

With respect to procedures not meeting prescribed requirements, the Commissioner of the Patent Office may order to make amendments within a prescribed period of time (Article 17(3) of Patent Law). This rule applies to, for instance, applications not meeting the formality requirements set forth in Patent Law or Patent Law Implementing Rules, or applications with respect to which necessary fees are not partially or fully paid.

(2) Appeal against Administrative Disposition

Anyone who does not agree with a disposition made by an administrative agency may file an appeal (Article 4 of Administrative Appeal Law). No appeal, however, may be filed based on Administrative Appeal Law against a decision of rejection or a board decision of rejection, dismissal of request for Appeal Board procedures or re-examination and other dispositions of the Patent Office which are provided in Patent Law as non-appealable dispositions. Also, no appeal may be filed based on Administrative Appeal Law against order of amendment, notice of reasons for refusal, notice not allowing to backdate filing date and some other orders since they are not administrative dispositions which directly affect right or interest of the applicant. Dispositions of the Patent Office appealable under Administrative Appeal Law include dismissal (Articles 13, 18 and 18bis of Patent Law and Article 7 of Special Law), and any such appeal will be filed against the Commissioner of the Patent Office and considered by the Formality Examination Standards Group.

(3) Reply

If no reply is filed in response to such an order relating to formality, procedures relating to the formality order will be dismissed, which eventually results in dismissal of the relevant patent application (Article 18 of Patent Law). Appropriate measures need to be taken even with respect to a

defect in formality as failure to amend such defect will result in dismissal of application. A reply needs to be filed within a prescribed time period which may be extended by a few months if a request for extension of time period is filed.

Since Japanese Patent Law doesn't allow any procedures taken after prescribed time periods, such as the period for requesting examination and the period for filing an opinion letter, an applicant must strictly meet the deadlines. Care should especially be taken not to misunderstand the due date as each period is described in such ways as thirty (30) days, three (3) months and three (3) years.

IV. Prosecution (Examination Practice)

1. Notice of Reasons for Refusal and Response Thereto

(1) What is a Notice of Reasons for Refusal?

Patent Law provides that an application which is found to contain reasons for refusal with respect to the application or claimed invention will not immediately be subject to decision of rejection and that rather a notice of reasons for refusal will be issued to inform the applicant of the reasons for refusal and to give the applicant the opportunity to refute through opinion letter or amendment. This document is a notice of reasons for refusal. Reasons for refusing an application are fully enumerated in Article 49 of the Patent Law, and more than one reason for refusal may be indicated in a notice of reasons for refusal.

Lack of novelty/inventiveness, which constitutes one of the reasons for refusal, will be indicated with respect to each claim, while a response to a notice of reasons for refusal may take the form of the filing of a divisional application or converted application (as a utility model application or a design application), or filing no response, in addition to refutation through opinion letter and/or amendments as described above.

With the increasing number of applications backlogged, examination of an application will not be started immediately after request for examination, and the first action from the examiner will generally be issued about two (2) years after the request for examination.

Applications of which patentability needs to be decided promptly, such as an application relating to an implemented invention or an application relating to a dispute, may be given priority based on the expedited examination system or the priority examination system. Hence it is recommended that applications meeting such prescribed requirements use such a system.

Considering the purpose of an expedited examination system, an applicant requesting expedited examination should not extend, without legitimate reasons, the time period for replying to a notice for reasons for refusal.

A notice of reasons for refusal is issued not only during the initial examination but also during appeal board examination, in which case a response similar to the ones made during the initial examination is expected.

(2) Types of Notice of Reasons for Refusal (Non-Final and Final Notice of Reasons for Refusal)

For technical reasons, there are two (2) types of notice of reasons for refusal: the notice of reasons for refusal originally issued to the applicant (Article 17bis(1)(i), hereinafter referred to as the “non-final notice of reasons for refusal”) and the final notice of reasons for refusal issued to the applicant when the applicant has received more than one notice of reasons for refusal. (Article 17bis(1)(iii), hereinafter referred to as the “final notice of reasons for refusal”)

As discussed later, amendments in response to the non-final notice of reasons for refusal may be accepted as long as they are within the scope of the description of the original specification (Article 17bis(3)), while amendments in response to the final notice of reasons for refusal will be subject to additional limitations (Article 17bis(4) and (5)).

(i) “Non-Final Notice of Reasons for Refusal”

The notice of reasons for refusal issued for the first time is the non-final notice of reasons for refusal. Even if more than one notice of reasons for refusal is issued, a notice of reasons for refusal which is issued to anything other than amendments filed in response to a previous notice of reasons for refusal will be deemed as a “non-final notice of reasons for refusal.”

(ii) “Final Notice of Reasons for Refusal”

The “final notice of reasons for refusal” means only such notice of reasons for refusal that is issued in relation to amendments filed in response to the “non-final notice of reasons for refusal.”

Whether or not a second or later notice of reasons for refusal constitutes the final notice of reasons for refusal will be decided not in light of the number of notices issued, but in light of the substantiality of the notice. If, for instance, the first notice of reasons for refusal appears inappropriate as major references to prior art cited in this notice of reasons for refusal have been replaced, a second or later notice of reasons for refusal may be deemed as the first notice of reasons for refusal.

A non-final notice of reasons for refusal does not bear a marking of the “Non-Final Notice of Reasons for Refusal,” but definitely does in the case of the final notice of reasons for refusal. In other terms, even a second or later notice of reasons for refusal will all be deemed as the “non-final notice of reasons for refusal” unless they bear the clear marking of the “Final Notice of Reasons for Refusal.”

(3) Types of Law Provisions on Reasons for Refusal

If a patent application falls within any of the following items <1> through <13>, a notice of reasons for refusal will be issued to reject the application:

- <1> Amendments beyond the scope of the original specification or drawings (new matter)
→ Article 17bis (3) of the Patent Law
- <2> Lack of requirements for invention/lack of industrial applicability
→ Article 29 principal text of the Patent Law
- <3> Lack of novelty → Article 29(1) of the Patent Law
- <4> Lack of inventiveness → Article 29(2) of the Patent Law
- <5> Invention identical to prior application (first and second applications)
→ Articles 29bis and 39 of the Patent Law
- <6> Non-compliance with requirements on description of specification and claims
→ Articles 36(4)(1) and 36(6) of the Patent Law
- <7> Non-compliance with requirements for unity of invention → Article 37 of the Patent Law
- <8> Non-compliance with requirements of disclosing prior art information
→ Article 36(4)(ii) of the Patent Law
- <9> Application in foreign language beyond the scope of original foreign-language application (new matter to original application) → Article 49(6) of the Patent Law
- <10> Contravenes public order and morals → Article 32 of the Patent Law
- <11> Non-compliance with requirements for joint application → Article 38 of the Patent Law
- <12> Application filed by non-legitimate applicant (usurped application) Article 49(7) of the Patent Law
- <13> Application filed by a foreigner → Article 25 of the Patent Law

(4) Examples of Notice of Reasons for Refusal

A sample notice of reasons for refusal is shown on the next page.

The footnote states as follows:

Note (1) Reference to Relevant Law Provisions

Law provisions relevant to the application are listed here.

The examiner is expected to stipulate all the reasons for refusal of the applicable in the notice of reasons for refusal. In this sample case, there are two (2) law provisions relevant to the reasons for refusal.

Note (2) Period for Filing Opinion Letter/Amendments

Here the period during which an opinion letter, if any, must be filed is indicated. If the applicant intends to file amendments together with the opinion letter, the amendments must be filed within the same period applied to the opinion letter.

The period is sixty (60) days for a Japanese applicant, and three (3) months for a foreign applicant. This period may be extended upon request.

Note (3) Reasons

Relevant law provisions that apply, subject claims, and the examiner's comments (remarks referring to particular points, specifying grounds for decision on inventiveness, and identifying unclear parts of the specification).

Note (4) List of Cited References

Prior art references or application number and other information of prior applications which constitute grounds for rejection as lack of novelty and/or inventiveness are indicated.

Note (5) Result of Prior Art Search

Prior art information contained in this space are those which may be referred to by the applicant when making amendments or which will show to a third party the technical standards. The technical field searched by the examiner is also shown in the form of International Patent Classification (IPC).

Note (6) Contact Number of the Examiner

The applicant may request an interview or other accommodations using this information if what is indicated in the notice of reasons for refusal is not clear or if it seems more efficient to meet and directly explain to the examiner the technology relating to the claimed invention.

Notice of Reasons for Refusal

Application No.	Heisei 12 Application No. *****
Date of Notice	MM DD, Heisei 18
Examiner	Taro Tokkyo **** 2G00
Patent Attorney	Mr. **** (et al.)
Applicable Law	Articles 29(2) and 37

Note 1

This application is refused for the reasons set forth below. Opinions to this decision may be filed within sixty (60) days of the mailing date of this notice.

Note 2

Reasons

Note 3

A. This application does not meet requirements set forth in Article 37 of the Patent Law in respect to:

Invention described in claims 2-10 is not deemed as "machine, apparatus, equipment or other article directly used" as set forth in Article 37(4) of the Patent Law.

Since this application does not comply with Article 37 of the Patent Law, invention relating to claims other than claim 1 has not been examined with respect to requirements other than those set forth in Article 37 of the Patent Law.

B. Invention relating to the following claim of the present application is not patentable pursuant to Article 29(2) of the Patent Law as it could have been easily invented by a person with ordinary skill in the art prior to the filing date of the present invention based on the inventions disclosed in the following publications distributed in and outside Japan prior to the filing date of present application.

Note: See list of cited references

- Claim 1
- Cited references 1 and 2
- Remarks

As cited reference 1 describes.....neutron detector, no difficulty is found in using it to probe known fuel assembly. Use of fiber optic cables is also known as described in cited reference 2.

No reasons for refusal have been found so far with respect to invention relating to claims other than the claims indicated in this Notice of Reasons for Refusal. Should other reasons for refusal be found, a separate Notice of Reasons for Refusal will be issued.

Note 4

List of Cited References

1. Patent Application Kokai No. S63-163187
2. Patent Application Kokai No. H09-236669

Note 5

Result of Prior Art Search

- Searched Field IPC Ver.7 G21C17/06, G01T3/00-06
- Prior Art References Patent Application Kokai No. H05-107388
Patent Application Kokai No. H06-160585

The references found in the prior art search do not constitute reasons for refusal.

Note 6

Any inquiry with respect to this Notice of Reasons for Refusal or request of interview relating to this case may be made to the following address:

First Patent Examination Department, Nanophysics (Energy line application) Examiner, Taro Tokkyo

TEL 03-3581-1101 (ext. ****), FAX 03-3592-****

(5) Response to Notice of Reasons for Refusal

As indicated above, there are many reasons for refusal, and response thereto should be made on a case-by-case basis. In general, such efforts as scrutinizing the law provisions the and examiner's comments indicated in the notice of reasons for refusal, filing an opinion letter or amendments, and requesting an interview with the examiner, must be made accurately.

(i) Response to Non-Final Notice of Reasons for Refusal

[Basic Principles]

The non-final notice of reasons for refusal does not bear the marking of "Non-Final Notice of Reasons for Refusal." Since the final notice of reasons for refusal always bears the marking of the "Final Notice of Reasons for Refusal," other notices of reasons for refusal not bearing the marking may be assumed to be a non-final notice of reasons for refusal.

As described above, the non-final notice of reasons for refusal usually stipulates the reasons for refusing the application. Moreover, when a publication is cited, the relevant part is cited and why the claimed invention is not deemed as novel or inventive is indicated as comments of the examiner. Hence, the applicant needs to scrutinize the law provisions and examiner's comments indicated in the notice of reasons for refusal, and accurately prepare an opinion letter and/or amendments.

Moreover, an applicant may meet or call the examiner to clarify unclear parts of the notice of reasons for refusal or to directly explain to the examiner any complicated technology. However, as amendments are made at the responsibility of the applicant, the examiner should not be excessively questioned.

[Composition of an Opinion Letter]

When the applicant does not agree with the reasons for refusal or believes that the reasons for refusal may be overcome by amendments, an opinion letter needs to be prepared. It is desirable that an opinion letter be composed of items which correspond to the law provisions indicated in the notice of reasons for refusal. To prove inventiveness, an applicant may also submit a document supporting the significant effect of the claimed invention and argue inventiveness of the claimed invention in the opinion letter, while care should be taken that no argument beyond the description of the present specification will be accepted.

[Composition of Amendment(s)]

When composing amendments to overcome reasons for refusal, the applicant first needs to

know that different limitations are applied to amendments in response to the Non-Final Notice of Reasons for Refusal than to those in response to the Final Notice of Reasons for Refusal. Amendments in response to the Non-Final Notice of Reasons for Refusal must be within the scope of disclosure made by the original specification with no addition of a new matter. Hence the applicant should clearly indicate in the opinion letter which part of the original specification the amendments are made in regard to. It has also become a common practice to underline the amended part in the amendment.

(ii) Response to the Final Notice of Reasons for Refusal

[Basic Principles]

As described above, the “Final Notice of Reasons for Refusal” means in principle the notice of reasons for refusal required with respect to amendments made in response to the “Non-Final Notice of Reasons for Refusal.” In that case, the notice of reasons for refusal must clearly bear the marking “Final Notice of Reasons for Refusal.” The major difference between the Final Notice of Reasons for Refusal and the Non-Final Notice of Reasons for Refusal is that more strict limitations are applied to amendments relating to the Final Notice of Reasons for Refusal.

[Composition of an Opinion Letter]

An opinion letter will be composed basically in the same manner as the one in response to the Non-Final Notice of Reasons for Refusal, while the applicant may argue in the opinion letter that, for instance, the notice of reasons for refusal should be treated as a “Non-Final Notice of Reasons for Refusal” and not the “Final Notice of Reasons for Refusal” as marked because it cites a new publication.

[Composition of Amendment(s)]

To overcome the Final Notice of Reasons for Refusal, amendments must be within the scope of disclosure made by the original specification, and amendments to claims must be limited only to those aimed at eliminating a claim, narrowing the scope of claims, correcting typing errors and clarifying ambiguous descriptions. Moreover, amendments aimed at narrowing the scope of claims must be such that the amended claimed invention as of the filing date is independently patentable.

(Requirements of Independent Patent)

If amendments to the Final Notice of Reasons for Refusal do not fall within the scope of the disclosure made by the original application, i.e., adding a new matter, the amendments will be

rejected. And a complaint against this refusal of amendments may not be filed independently, but as a part of an appeal against a decision of rejection.

2. Decision of Rejection and Response Thereto

(1) What is Decision of Rejection?

If reasons for refusal are not overcome with an opinion letter and amendments, a decision of rejection will be issued. (Article 49(1) principal text, Patent Law) If relevant amendments need to be rejected, the decision of rejection will be issued together with the decision of rejecting amendments.

According to “How to Conduct Examination” issued by the Patent Office, information that an examiner needs to include in a decision of rejection are:

- <1> indication of all the claims which have not overcome the reasons for refusal;
- <2> decision on applicant’s argument and amendments; and
- <3> indication of all the reasons for refusal which have not been overcome

(2) Example of a Decision of Rejection

A sample decision of rejection is shown on the next page.

In the sample case, a decision of rejection is issued because the reasons for refusal based on Article 29(1)(3) of the Patent Law (reason 1: novelty); Article 29bis of the Patent Law (reason 2; inventiveness) and Article 37 (reason 3: unity of invention) have not been overcome.

At the bottom of the notice instructs are “Instructions under Administrative Appeal Law” as we discussed above; what procedures are available to the applicant who does not agree with the decision. (See Note 1 on the next page)

Decision of Rejection

Application No. Application No. 2002-*****
Date of Decision August 8, Heisei 18
Examiner **** * 2G00
Title of Invention: Laser Irradiation System
Applicant Kabushiki Kaisha **
Patent Attorney ***** (two others)

This application is rejected based on (Reason 1), (Reason 2) and (Reason 3) stipulated in the notice of reasons for refusal dated May 9, 2006.

The examiner has considered the opinion letter and amendments but has not found grounds for reversing the reasons for refusal.

Remarks

(Reason 1)

The optical fiber guiding device added to claim 1 by amendments ... had already been disclosed by publication 1.

Hence, invention relating to claim 1 is the one described in publication 1 and thus is not patentable pursuant to Article 29(1)(iii) of the Patent Law.

(Reason 2)

Making a structure described in claim 1 based on technologies disclosed in publications 1 and 2 ... could have been easy for a person with ordinary skill.

Moreover, invention relating to amended claims 2-4, 12 and 13 could have been easily conceived by a person skilled in the art due to reasons stipulated in previous notice of reasons for refusal.

Hence, invention relating to claims 1-4, 12 and 13 is not patentable pursuant to Article 29(2) of the Patent Law because it could have been easily made by a person with ordinary skill in the art based on the invention disclosed by publications 1-6,

(Reason 3)

Matters described in claim 1 ... are not identical to the major part of the essential elements of claimed invention and thus do not meet the requirements of Article 37(1) and (2) of the Patent Law.

It is also obvious that each invention as indicated above does not meet requirement set forth in Article 37 and other provisions of the Patent Law.

Note 1

Within thirty (30) days (or 90 days in the case of a foreigner) after the service of certified copy of this decision, appeal against this decision may be filed with the Board of Appeal against the Commissioner of the Patent Office. (Article 121(1) of Patent Law) (Indication based on Article 46bis of Administrative Appeal Law)

Action to reverse this decision may be filed only as an action to reverse the Board Decision which is delivered in response to appeal against this decision. (Article 178(6) of Patent Law)

(3) Response to Decision of Rejection

Law provisions which constitute the grounds for a decision of rejection, the rejected claims and the examiner's comments should be scrutinized and considered. A decision of grant is likely to be issued if there are claims not cited in the decision of rejection and if amendments to limit the scope of the patent to such claims are filed simultaneously with the appeal with the Appeal Board.

An applicant who does not agree with the decision of rejection may appeal to the Appeal Board, as instructed at the end of the decision of rejection, within thirty (30) days (or 90 days in the case of a foreign applicant) after service of the certified copy of the decision. (Article 121(1) of the Patent Law)

(i) Composition of Reasons for Appeal

To lodge an appeal, a written brief containing the purpose and reasons for the appeal needs to be filed. The applicant, however, can simply state that reasons will be supplemented and file "Reasons for Appeal" in the form of an amendment within thirty (30) days after the date of appeal because an additional thirty (30) days are given with respect to the reasons for appeal.

The reasons for appeal need to state in detail why the rejected invention should be patented and why the rejection of amendments, if applicable, was inappropriate.

(ii) Composition of Amendment

Amendments filed simultaneously with the appeal will be subject to limitations as strict as those which apply to amendments in response to the Final Notice of Reasons for Refusal.

Moreover, amendments filed simultaneously with the appeal will in principle be examined again by the original examiner who issued the decision of rejection under the Pre-Appeal Board Examination System which was introduced to expedite patenting procedures. Hence appropriate amendments at the time of filing the appeal is likely to result in prompt decision of grant.

Since, in principle, no opportunity for amendments is given during the Appeal Board procedures unless there are legitimate reasons, the applicant should consider that the amendment at the time of the appeal is the last chance for amendments and make elaborated and appropriate amendments to overcome the reasons for decision of rejection. Recent statistics show that about fifty percent (50%) of decisions of rejection are reversed and a decision of grant is issued during the Pre-Appeal Board Examination process, and thus it is desirable that amendments are composed so as to win a decision of grant during the Pre-Appeal Board Examination process.

3. Decision of Grant and Response Thereto

(1) What is a Decision of Grant?

The examiner will issue a decision of grant if no reason for refusal is found with respect to a patent application or if the reason for refusal is successfully overcome by responding to the notice of reasons for refusal. (Article 51)

(2) Response to a Decision of Grant

Within thirty (30) days after service of a decision of grant, the applicant needs to pay the amount equivalent to annuities for three (3) years to have the patent right registered. The patent right becomes effective upon registration. (Article 66 of the Patent Law)

A patent remains effective for twenty (20) years after the filing date.

(3) Future Law Amendment

An amendment to the law to allow filing of a divisional application during a limited period of time after the grant of patent is currently under way. After this amendment becomes effective, a divisional application may be filed based on the original application which was patented without notice of reasons for refusal, allowing broader protection. Thus, concerned parties should pay close attention to future law amendments.

4. Response by Divisional Application

(1) What is a Divisional Application?

An applicant of a patent may divide part of his/her patent application containing two or more inventions into one, two, or more new patent applications only within the time period when amending of specifications and drawings attached to the application is allowed. The new patent applications are called divisional applications and deemed to have been filed on the filing date of the original application.

A divisional application may be filed during the following time period:

<1> from the filing date until the time immediately prior to the service of certified copy of decision of grant (except for the time period after the first notice of reasons for refusal is issued) (Article 17bis(1))

<2> the time period designated by the examiner (or the board examiner once the case is

brought to the Appeal Board) in the notice of reasons for refusal (Article 17bis(1)(i) and (ii))

<3> within thirty (30) days after the appeal is lodged pursuant to Article 121(1) (Article 17bis(1)(iii))

(2) Utilization of Divisional Application System

A divisional application is most typically filed after an application becomes subject to notice of reasons for refusal based on non-compliance with the requirement of unity under Article 37 of the Patent Law.

Divisional applications may also be filed during the period listed above if more than one invention is contained in a specification.

In addition, since amendment of claims in response to the Final Notice of Reasons for Refusal and at the time of appeal is limited to those aimed at deletion of a claim or narrowing of claims, a divisional application may be filed with respect to an invention contained in the specification which the applicant wishes to have patented.

Divisional applications should also be actively considered once amendments to the current law which allows divisional applications after decision of grant becomes effective.

V. Commentary on Individual Law Provisions for Rejection and How to Deal with Them (Specifics)

Here we discuss in detail the main law provisions which constitute the grounds for refusal, as recited in <1> to <13> in IV. 1 (3) above, and points to be noted by applicants in responding to those refusals.

1. Prohibition of Addition of New Matter

(1) Overview

“Scope of description of specification as originally filed” means not only “matters stipulated in the original specification” but also “matters obvious from the description of the original specification” even without clear indication.

(2) How to Deal With It

As discussed above, since not only “matters stipulated in the original specification,” but also “matters obvious from the description of the original specification” will avoid to be deemed as new matter, the applicant should make every effort to overcome reasons for refusal by arguing, through

submission of known or famous literature for instance, that the amendment which the examiner deemed as an addition of a new matter is obvious in the technical field from the description of the original specification or is equivalent to that already described in the specification.

An “Excluded Claim,” which means to exclude only the part contained in the pre-amended claims from matters described in the claims, will also be allowed if the “Excluded Claim” after exclusion falls within the scope of the original specification.

2. Requirements for Invention and Industrial Applicability (Principal text of Article 29(1))

(1) Overview

Requirements for “invention which is applicable to the industry” as set forth in the principal text of Article 29(1) are usually construed as meaning both requirements for “invention” and requirements for “invention which is applicable to the industry” (so called “industrial applicability”). Hence, failure to meet both of the requirements will result in non-compliance with the principal text of Article 29(1) of the Patent Law.

(i) Requirements for Invention

According to Article 2(1) of the Patent Law, an invention is an “advanced creation of a technical idea using the law of nature.” A creation not recognized as an “invention” under this definition will be rejected as lacking in requirements for invention. Listed below are those not deemed as an “invention” under Article 2(1) of the Patent Law. One of the recent trends is that there is an increasing number of applications directed to invention relating to computer software programs (invention of which implementation requires software programs), business models and video games, and those applications are often rejected as not meeting the requirements for “invention” set forth in Article 2(1) of the Patent Law.

Even with respect to an invention relating to computer software programs, the requirements for an invention are deemed met if information processing in the software programs is tangibly implemented using hardware resources (ex: operation method such as CPU or storage method such as memory), i.e., if a special information processing system (machine) or its operation method satisfying the purpose of use is established by operating or processing information meeting the purpose of use with a specific method in which software programs and hardware resources collaborate with each other. On the contrary, requirements for an invention will not be met if

information processing in software programs is not actually implemented using hardware resources, and such creation will not be deemed as “creation of technical idea using the law of nature.”

[Categories of Creation not Deemed as Invention]

- <1> the law of nature itself (ex: law of conservation of energy; law of universal gravitation)
- <2> a mere discovery (ex: discovery of natural product or natural phenomenon)
- <3> something contravening the law of nature (ex: perpetual motion)
- <4> something not using the law of nature (ex: economic laws; artificial arrangement or mathematical law)
- <5> something other than a technical idea (ex: skill; mere aesthetic creation; computer programs themselves)

(ii) Industrial Applicability

Things that do not fall within “invention applicable to the industry” may be categorized as follows:

[Categories of Creation Not Deemed as Industrially Applicable Invention]

- <1> Methods of human surgical operation, treatment or diagnosis (ex: bona fide medical practice)

Although medical devices and drugs have industrial applicability as an object, methods of human surgical operation using medical devices (such as a scalpel) and treating a person with drugs constitute “methods of human surgical operation, treatment or diagnosis” which do not have industrial applicability, for which the application will be subject to notice of reasons for refusal.

Meanwhile, operation within a medical device does not fall within “the methods of human surgical operation, treatment or diagnosis.” Method of treating what is taken from the human body (such as blood, urine, skin, hair, cell and tissue) or a method of collecting various data by analyzing such matters do not fall within “the methods of human surgical operation, treatment or diagnosis.” Provided, however, a method of using what is collected from a person on the premise that it will be used for the same person (such as hemodiafiltration) will be deemed as a “method of human surgical operation, treatment or diagnosis.”

Means of operation, treatment or diagnosis which are aimed at use with animals in general will be treated as “the methods of human surgical operation, treatment or diagnosis” unless it becomes clear that that the methods are not directed at human beings:

- <2> Invention which cannot be commercially used (ex: means of smoking)

<3> Invention which cannot be implemented for practical reasons (ex: means of covering the earth with ultraviolet absorption film to protect it from the sun's rays)

(2) How to Deal With It

<1> Invention relating to Software Programs

The following reasons for refusal may be indicated with respect to an invention relating to software programs such as business models:

[Case 1]

“Claimed invention is not deemed as invention which is a creation of a technical idea using the law of nature because the information processing system of the software programs is not tangibly implemented using hardware resources.”

[Case 2]

“Claimed invention is not deemed as invention which is a creation of a technical idea using the law of nature because it merely defines artificial arrangements.”

If these types of reasons for refusal are issued, the applicant still has the chance of overcoming the reasons for refusal by appropriately amending his/her claim description because requirements for invention may be met if information processing in the software programs is tangibly implemented using hardware resources.

See Chapter 1 “Inventions relating to Computer Software Programs” in Section VII of Examination Standards for details.

<2> Medical Practice

Since a claimed invention deemed as the methods of human surgical operation, treatment or diagnosis will be found as lacking in industrial applicability, the reasons for refusal may be overcome if the applicant clarifies by amendments that the claimed invention is not directed to human beings.

See Chapter 1 “Industrially Applicable Invention” in Section II of Examination Standards for details.

3. Lack of Novelty (Article 29(1))

(1) Overview

If the claimed invention is not structurally different from a known invention, a

publicly-implemented invention or an invention described in a publication, Article 29(1) of the Patent Law will be applied. Here a known invention, a publicly-implemented invention, or an invention described in a publication includes an invention which can be conceived of in light of common knowledge in the art. The publicity or the well-known nature is decided not only domestically but also on a worldwide basis.

We now discuss how novelty is found with respect to an invention having a special description.

[Parameter Invention]

A so-called parameter invention, which is an invention having a claim description defining a certain object by its function and features, sometimes gives difficulty in comparing with the cited invention. In such a case, the examiner does not compare the claimed invention in detail with the cited references to find the similarity and difference but issues notice of reasons for refusal as lacking in novelty if the examiner has a reasonable prima facie suspicion that both inventions are identical and there is no difference in other parts.

[Product-by-Process Invention]

A so-called product-by-process invention or an invention in which the product is defined by its production process sometimes poses significant difficulty in finding what structure the product itself has. In such a case, as in the case of a parameter invention, the examiner does not compare the claimed invention in detail with the cited references to find the similarity and difference but issues a notice of reasons for refusal as lacking in novelty if the examiner has a reasonable prima facie suspicion that both inventions are identical and there is no difference in other parts.

(2) How to Deal With It

Notice of reasons for refusal based on lack of novelty is often overcome by adding or limiting elements or “Excluded Claim.” Generally speaking, however, no notice of reasons for refusal is based only on lack of novelty. Rather, lack of inventiveness (Article 29(2)) often accompanies as the reasons for refusal. In such a case, appropriate amendments need to be drafted based on meticulous reading of the cited publications and the examiner’s comments with good understanding of the examiner’s intention.

In the case of a parameter invention with respect to which notice of reasons for refusal is issued based on a reasonable prima facie suspicion, it is desirable that the applicant submits such

arguments and explanation that will convince a person with ordinary skill in the art by, for instance, stipulating the technical meaning of the parameter and clarifying difference from the cited publication.

In the case of a product-by-process invention, starting material and production process should be clearly explained to show that the product is different from the one disclosed in the cited reference.

In the case of an invention limited by numerical values, the applicant should try to overcome the reasons for refusal by, for instance, amending the scope of numerical values within the scope of the original specification since novelty may be rejected based only on a partial overlap of the scope of numerical values with a cited reference.

4. Lack of Inventiveness (Article 29(2))

(1) Overview

Whether or not an invention has inventiveness is the most troubling and difficult question in finding patentability of an invention.

Since the examiner bears the burden of proof in issuing reasons for refusal based on novelty and inventiveness, the examiner needs to logically explain why he/she decided that the claimed invention lacks inventiveness. This “reasoning” is determined from various and wide ranging of views.

Here are some examples of the reasoning:

(i) Selection/design changes of optimal material, mere collection

Inventiveness is not found in the selection of optimal material from known materials, optimization of scope of numerical values, substitution of equivalent matter and design change for technical application to solve a problem since they are the result of ordinary creativity.

Inventiveness will also not be found in a combination of unrelated structures as it is deemed as a mere collection.

(ii) Potential Motivation

When there are two or more cited inventions of which a technical field is related to both, which share a common technical problem to solve, and which share operations and function, potential motivation to relate those inventions are found and inventiveness of claimed invention will

not be found if it stems from those cited references. This principle will not apply when there is disincentive to relate or combine.

(iii) Advantageous Effect Compared with Cited Invention

Even if the claimed invention has an advantageous effect when compared with cited references, inventiveness will not be found if the effect is anticipated based on the technical level. On the contrary, an outstanding invention which cannot be conceived of from the technical level will be deemed to have inventiveness.

If the cited invention is of broader concept and the claimed invention is of lower concept, and if the claimed invention meets requirements of novelty, the claimed invention is a so-called selective invention. For a selective invention to be deemed to have inventiveness, it needs to have a significant effect which cannot be anticipated based on the conventional technical level.

Moreover, while an invention limited by numerical values is usually deemed to have no inventiveness as optimization of scope of numerical values is considered to be the ordinary expression of creativity, inventiveness may be found if the scope of numerical values has a significant effect, or if the numerical limitation has so-called critical meanings.

(2) How to Deal With It

(i) Basic Response

Since notice of reasons for refusal based on lack of inventiveness has various patterns of reasoning as discussed above, and may vary in many aspects depending on the technical field and each case, it is quite difficult to generalize a response to a notice of reasons for refusal based on lack of novelty.

What is important is that the applicant as a person with ordinary skill in the art has good knowledge of the technical level in the relevant technical field, compares with the cited inventions and decides whether or not the reasoning is appropriate.

Notice of reasons for refusal based on lack of inventiveness rarely cites only one reference and often reasons that the claimed invention is a mere combination of or a mere adoption of the key cited invention and inventions disclosed in other references (including peripheral technology). Hence the applicant should appropriately argue that such reasoning as easy combination and easy adoption is inappropriate and explain, for instance, that there is distinctness in the combination and that there is a difference in the technical field and problem. The applicant should also make efforts to

overcome reasons for refusal by drafting amendments that will overcome an alleged lack of inventiveness.

(ii) Composition of Opinion Letter

Care should be taken that it is not allowed to argue or explain in an opinion letter something beyond the description of the original specification. Extra care should be taken when arguing a significant effect not disclosed in the cited references that a new allegation not disclosed in the original application is usually not accepted, including, for instance, submission of experiment certificates. Hence, the applicant should argue within the scope of description of the original specification or within the scope of common knowledge in the art.

(iii) Composition of Amendment

Care should be taken also when drafting an amendment so that it will not add a new matter and it will be within the scope of description of the original specification or within the scope of common knowledge in the art. Alleged lack of inventiveness may not be overcome by adding unproved numerical limitations or numerical scope of which critical meaning is not disclosed in the original application to underline the difference from the cited references because such an addition might instead be deemed as an addition of a new matter.

5. Invention Identical to Prior Application (Article 29bis)

(1) Overview

An invention which is identical to an invention disclosed in the original specification of an application filed prior to the subject application and subsequently published cannot be patented and will be rejected under this law provision as it does not disclose a new invention.

(2) How to Deal With It

Basically the same response as the response to reasons for refusal based on lack of novelty may be taken.

If the cited prior application claims priority and its filing date in Japan is later than the filing date of the present application, the cited invention disclosed in the original application should be described in the application based on which the priority is claimed. Thus the applicant needs to obtain at the Patent Office the specification of the application which constitutes the basis for priority claim (which is deemed as abandoned) to scrutinize the specification.

6. First and Second Applications (Article 39)

(1) Overview

This law provision aims to prevent so-called double-patenting, or more than one owner for a single invention.

If there is no difference in structure between two inventions, they are identical inventions. Even if there is difference in structure, the two inventions will be deemed identical if the difference is the result of addition, elimination or substitution of peripheral technology or common technology and cause no new effect, or if the difference is the result that the structure of the first invention, which constitutes the subordinate conception, is merely expressed as the superordinate conception.

(2) How to Deal With It

Basically the same response as the response to reasons for refusal based on lack of novelty may be taken. Since, however, the reasons for refusal are that the claimed invention is identical to invention described in the prior invention, the reasons for refusal may be overcome by amending claims to delete identity to the first invention

7. Incomplete Description of Specification (Article 36(4) or (6))

(1) Overview

While non-compliance with Article 36 of the Patent Law is sometimes referred to individually as reasons for refusal, it is often indicated together with other reasons for refusal such as non-compliance with Article 29 of the Patent Law (novelty/inventiveness). According to statistics, about a third of the notices of reasons for refusal are based on incomplete description of specification.

There are mainly three types of reasons for refusal relating to incomplete description of specification.

(i) Non-compliance with Enablement Requirement (Article 36(4) of the Patent Law)

Article 36(4)(i) of the Patent Law provides that claimed invention must be described clearly and completely so that a person with ordinary skill in the art, or an ordinary person, can enable the invention.

According to Article 24bis of the Patent Law (Implementing Rules), moreover, description

required by the ordinance of the Ministry of Economy, Trade and Industry under Article 36(4)(i) of the Patent Law must state the problem the claimed invention intends to solve, the means of solving the problem, and other matters necessary for a person skilled in the art to understand the meaning of the claimed invention.

This provision means that the claimed invention must be described in detail so that a person with ordinary skill in the art (a so-called skilled person) can enable the claimed invention based on the specification and drawings using his/her common knowledge in the art and his/her ordinary technical skill for R&D activities in the relevant technical field (including analysis of literature, experimentation, analysis, production, etc.).

Hence if a skilled person cannot understand how to enable the claimed invention with the specification and drawings and his/her technical knowledge at the time of disclosure and filing date (for instance, the person needs to do an excessive amount of trial and error or conduct complicated and advanced experiments to find how to enable the claimed invention), the claimed invention will be deemed as not describing the invention well enough to allow a skilled person to enable the invention.

(ii) Non-compliance with Support Requirements (Article 36(6)(i) of the Patent Law)

Each of the claims must describe everything that is deemed necessary to identify the invention for which the patent is sought. (Article 36(5) of the Patent Law) However, seeking protection by describing a patent claim beyond the disclosure of the specification contradicts the purposes of the patent system. Article 36(6)(i) provides this prohibition.

In other words, it provides so-called support requirements which require that the “claimed invention (claims) must be supported by a detailed description of the invention.” European Patent Law also has this provision on support requirements, while it also corresponds to description requirements under the US Patent Law.

During the examination practice, whether or not support requirements are met is decided based on consideration of whether the claimed invention is broader than the scope of description in the detailed explanation of the invention which is described to enable a skilled person to solve the problem identified in the specification. That is to say, if the claimed invention is found as broader than the scope of description which is described to enable a skilled person to solve the problem, the claimed invention will be deemed as not substantively corresponding to the description of detailed

explanation of the invention, and thus contravening Article 36(6)(i).

(iii) Non-Compliance with Clarity (Article 36(6)(ii))

With respect to claim description, Article 36(6)(ii) requires that “the invention for which a patent is sought to be clear.”

Based on this provision, a claim description will be subject to decision on the requirements of novelty/inventiveness, and based on that decision the technical scope of the claimed invention will be defined. Hence, the claimed invention must be clearly grasped from the claim description.

This provision which requires an invention to be clearly described is important in securing the function of patent claims.

(2) How to Deal With It

(i) Enablement Requirement (Article 36(4) of the Patent Law)

Unless it is based on the examiner’s misunderstanding, the applicant should appropriately submit amendments in response to the examiner’s remarks while taking care that the amendments will not add a new matter. If a skilled person should be able to enable, even without a direct description in the specification, the claimed invention with using common knowledge in the art, the applicant should argue as such in the opinion letter.

Since, in the case of a foreign application, the specification is often deemed as incomplete due to incomplete translation, the applicant should appropriately amend and argue in opinion letter and amendment by, for instance, correctly understanding the original specification or requesting opinions and/or references from the inventor.

(ii) Non-Compliance to Support Requirements (Article 36(6)(i) of the Patent Law)

This type of reason for refusal is often issued to claims stipulating superordinate concept or numerical scope, i.e., when the examiner finds that the claims go far beyond the scope of the subject of the invention disclosed by a limited number of embodiments in the detailed explanation of invention.

For the reasons for refusal, if, in light of the common knowledge in the art, expansion or generalization to such extent is considered possible, the applicant should argue the reasons in the opinion letter. Otherwise, the applicant has no choice but to amend the claim to correspond to the scope of disclosure of the invention. The applicant may also submit an opinion letter with experiment data to argue the appropriateness of the original scope of claims, in which case care

should be taken so that the argument based on additional data will not be deemed as an addition of a new invention.

While the applicant can sometimes overcome reasons for refusal based on lack of novelty and inventiveness by amendment of claims to contain numerical limitations, care should be taken that such numerical limitations may be deemed as an addition of a new matter or non-compliance with support requirements if the technical meaning of the numerical limitations are not described in the detailed explanation of invention.

(iii) Non-Compliance with Clarity (Article 36(6)(ii) of the Patent Law)

This type of reason for refusal is issued based on various reasons from simple miswriting and use of inappropriate terms to incomplete description such as special parameters.

With respect to simple miswriting and use of inappropriate terms, the applicant should submit an amendment while taking care not to constitute the addition of a new matter. In the case of special parameters, the applicant should overcome reasons for refusal by arguing in the opinion letter that the technical meaning of the parameter belongs to common knowledge in the art or it could be understood from known references.

8. Foreign-Language Application and Special Reasons for Foreign-Language Application

(1) Overview

[New Matter to Original Text]

As the addition of a new matter is prohibited in the case of a normal Japanese application, foreign-language applications and PCT foreign-language applications are also subject to prohibition of submission of translation containing matters not described in the specification of a foreign-language application of the filing date, or specification as of international filing date, or submission of specification, claims or drawings adding new matters to the original text. In the foreign-language application and the PCT foreign-language application, the following cases will be rejected and could constitute reasons for invalidation due to the addition of a new matter as in the case with the normal Japanese-language application, and

(i) if the description of specification, claims or drawings in a foreign-language application is not within the scope of description of the foreign-language document, the application will be rejected (Article 49(6)) or invalidated. (Article 123(1)(v))

(ii) if the description of specification, claims or drawings in a PCT foreign-language application is not within the scope of description of the specification, claims or drawings of the international application as of the international application date, the application will be rejected (Article 49(6)) or invalidated. (Article 123(1)(v)) (Article 184 octies decies).

When we say “new matter to original text,” “original text” means the “foreign-language document” in the case of a foreign-language application, and “specification, claim and drawings of the international application as of international application date” in the case of a PCT foreign-language application.

[New Matter to Translation]

In the event a general amendment does not meet requirements set forth in Article 17bis(3) as stated above, in other words, in case of either of the following cases, the amendment is deemed as adding a “New Matter to Translation”:

(i) When correction of mistranslation is yet to be filed, if general amendment adds to the specification, claims or drawings matters beyond the scope of translation set forth in Article 36bis(2) which is deemed as specification, claims and drawings.

(ii) When correction of mistranslation has been filed, if a subsequent general amendment adds to the specification, claims or drawings matters beyond the scope of translation set forth in Article 36bis(2) which is deemed as specification, claims and drawings, or specification, claims and drawings amended as a result of the correction of mistranslation.

Addition by general amendment of a new matter to translation as in (i) and (ii) above will constitute reasons for refusal (Article 17bis(3), Article 49(1)) or reasons for rejecting amendments if the general amendment is filed during the prescribed time period after the Final Notice of Reasons for Refusal or simultaneously with appeal against decision of rejection. (Articles 53, 159(1) and 163(1))

Provisions relating to a new matter to translation will not apply to an amendment by correction of mistranslation.

A general amendment may be filed with respect to specification, claims and drawings of a foreign-language application. It is construed, however, this general amendment should be made within the scope of translation (including corrected specification if after correction of mistranslation has been filed) (Article 17bis (3) Prohibition of New Matter to Translation), and any contradictory

general amendment may constitute reasons for refusal.

In other words, since it is very likely that foreign-language documents correspond to translation, the examiner decides whether or not a new matter is added based on the translation, and if an amendment beyond the scope of description in the translation is filed (including corrected specification if after correction of mistranslation has been filed), it will be deemed as rejected as if new matters are added to the original text.

(2) How to Deal With It

[New matter to Original Text]

If, for instance, a description in a foreign-language document such as “rubber treated to be heat-resistant” is simply translated into Japanese as “rubber,” a new matter to the original text will be found.

In the case of a foreign-language application, substantive examination is conducted with respect to specification on assumption that foreign-language the document corresponds to the specification, claims and drawings, and thus the foreign-language document and the specification are compared with each other only when there occurs certain doubt with respect to the identity of both documents. Hence, a new matter to the original text will constitute reasons for refusal.

When notice of reasons for refusal is issued based on a new matter to the original text, the applicant needs to file an amendment or correction of the mistranslation to correct the specification and other documents to describe it within the scope of the relevant foreign-language document. When filing an amendment, it is desirable to state the purpose and meaning of the amendment. If the applicant submits both amendment and correction of mistranslation, a single correction of mistranslation may be referred to for both.

[New Matter to Translation]

The applicant who received notice of reasons for refusal based on a new matter to translation can take the following measures:

- (i) file an amendment deleting the description relating to the alleged new matter to the translation in the same way as a response to a new matter in an ordinary Japanese-language application;
- (ii) file correction of mistranslation to clarify that the description relating to the alleged new matter to the translation is based on a correction of mistranslation (as a result of which the new matter to the translation will be deemed as legitimately added to the specification). In this case, the part of the

specification including the new matter to the translation should be stipulated in the item “[Subject Part of Correction]” in the correction of mistranslation in which “[Means of Correction]” should be designated as “Alteration.” In the item “[Reasons for Correction],” reasons for correction should be described based on the specification before the alleged new matter to translation was added.

9. Unity of Invention (Article 37 of the Patent Law)

(1) Overview

Article 37 of the Patent Law which became effective in January 2004 provides that “more than one invention may be included in a single patent application if they have a certain technical relationship with each other as defined by ordinance of the Ministry of Economy, Trade and Industry and are deemed as a group of inventions meeting the requirements for unity of invention.”

Moreover, Article 25octies of Patent Law Implementing Rules provides as follows:

1. Technical relationship as defined by ordinance of the Ministry of Economy, Trade and Industry as set forth in Article 37 of the Patent Law shall mean such technical relationship that more than one invention is related to each other as if they form a single general inventive concept because of a single or a special technical feature shared by such inventions.

2. A special technical feature as provided for in the preceding paragraph shall mean such technical feature that will contribute to the prior arts of the claimed inventions.

3. Existence of technical relationship as provided for in Paragraph 1 of this Article shall be decided irrespective of whether more than one invention is described in separate claims or in a single claim in an alternative way.

This law amendment was drafted based on PCT’s requirements for unity of invention to ensure international harmonization of the patent system.

During the examination practice, “special technical feature” of each invention is identified based on the description of specification, claims and drawings (hereinafter referred to as “Specification”) and the common knowledge in the art as of the filing date and whether the identical or corresponding “special technical feature” is shared by relevant inventions will be decided. If a consistent or corresponding special technical feature does not exist, the inventions do not meet the requirements for unity of invention.

Even if the requirements for unity of invention are deemed met as a result of the process

described above, relevant inventions may subsequently not meet the requirements for unity of invention if it appears that the “special technical feature” does not contribute to the prior arts any more than when, for instance, a “special technical feature” is found in a prior art, unless another identical or corresponding special technical feature exists.

During the examination practice, unity of invention is decided by the relationship to inventions described in the first part of the claims, and regular examination will be carried out with respect to claims meeting the requirements for unity of invention.

Although failure to meet requirements for unity of invention (Article 37) constitutes reasons for refusal (Article 49), it will not be a ground for invalidation (Article 123).

Article 37 of the Patent Law prior to January 2004 provided an exhaustive list of conditions meeting requirements for unity of invention. While its statutory structure is significantly different from the amended Article 37, there is virtually no difference in the aspect of enforcement.

(2) How to Deal With It

(i) Various responses a to notice of reasons for refusal may be considered based on lack of unity of invention as well as lack of novelty/inventiveness with respect to a part of claims, which includes:

<1> Deleting claims with respect to which no novelty/inventiveness examination has been conducted due to lack of unity of invention, and amend the rest of the claims to overcome the alleged lack of novelty/inventiveness.

Full consideration should be made to file a divisional application for deleted claims.

<2> Deleting claims which were rejected based on lack of novelty/inventiveness and try to overcome reasons for refusal based on lack of unity of invention with the rest of the claims;

<3> Refuting that there is unity of invention.

(ii) If reasons for refusal are based only on lack of unity of invention, i.e., if there is no reason for refusal with respect to claims which are found as having novelty/inventiveness, the claims are considered to meet the requirements for novelty/inventiveness. Thus the response should be:

<1> Deleting claims with respect to which no novelty/inventiveness examination has been conducted.

To file a divisional application for the deleted claims; or

<2> Refuting that there is unity of invention.

10. Non-Disclosure of Prior Art Information

(1) Overview

This provision was introduced in September in 2002. According to Article 36(4)(ii) of the Patent Law, the detailed explanation of invention needs to disclose the title of publication containing the published invention relating to the claimed invention (such invention as defined in Article 29(1)(iii)) and other location information relating to the published invention, hereinafter referred to as “Prior Art Information”) if the person seeking the patent was aware of such published invention at the time of the filing date. The examiner who found failure to meet this requirements or who found it necessary may inform the applicant thereof and give an opportunity for the applicant to file an opinion letter within a reasonable time period. (Article 48(7) of the Patent Law)

If, with amendment or opinion letter with respect to specification, the patent application still does not meet the requirements of Article 36(4)(ii), a notice of reasons for refusal will be issued (Article 49(5)). Failure to meet these requirements, however, do not constitute reasons for invalidation (Article 123(1)) because, since the provision was introduced mainly to facilitate prompt examination, failure to meet these requirements does not mean a significant flaw in the claimed invention and granting a patent to such an application does not directly or significantly affect interests of a third party.

Since its first introduction in September 2002, this system actually had been implemented on a trial basis to publicize the system by merely adding to the non-final notice of reasons for refusal remarks that the requirements are not met, without issuing a notice based on Article 48 septies. Such trial implementation, however, was terminated in April 2006, when the system was duly implemented pursuant to the provisions.

Since this provision may pose excessive burden on individual applicants, or applicants which are small- or medium-sized companies, it is considered that the system will not be implemented uniformly but rather flexibly to ensure prompt examination

(2) How to Deal With It

In the first place, a specification should be drafted to clearly indicate the novelty and inventiveness of the claimed invention and the gravity of the resulting effect by explaining the problem solved by the claimed invention in comparison with the latest conventional technology. By doing so, the validity of the right may be properly argued in subsequent, if any, patent dispute.

Hence, it is a matter of course that the applicant should disclose as prior art information <1> relevant inventions found by the applicant in the prior art search conducted during research and development and prior to filing an application for the claimed invention; <2> relevant inventions disclosed in the applicant's works such as technical papers published prior to the filing date; and <3> inventions disclosed in the specification claims or drawings of prior applications filed by the applicant.

It is especially desirable that the latest patent references of the applicant's own be disclosed without fail because they are presumed to be known to the inventor and applicants and will clarify patentability of the claimed invention

(i) Response to Notice based on Article 48 septies

In response to a notice based on Article 48 septies, the applicant may add prior art information by amendment or argue in an opinion letter that he/she does not know of any relevant published invention. It is desirable that an amendment adding prior art information accompany an opinion letter stipulating an outline of the relevant published invention and similarities and differences between the claimed invention and the relevant published invention.

(ii) Response to Notice of Reasons for Refusal

In response to a notice of reasons for refusal, the applicant may add prior art information by amendment or argue in an opinion letter that he/she does not know of any relevant published invention. It is desirable that an amendment adding prior art information accompany an opinion letter stipulating an outline of relevant published invention and similarities and differences between the claimed invention and the relevant published invention. An amendment adding relevant published inventions to the specification, claims or drawings will be rejected in general as the addition of a new matter.

11. Other Reasons for Refusal

Other reasons for refusal which include the following are rarely referred to and thus detailed explanations are omitted.

(1) Non-patentable invention (Article 32 of the Patent Law)

- invention offending public order and morals

(2) Competency of a foreigner (Article 25 of the Patent Law)

(3) Joint application (Article 38 of the Patent Law)

Request of examination must be filed jointly as well (Article 132 of the Patent Law)

(4) Misappropriated application (Article 49(6))

(5) Invention violating international convention (Article 49(3) of the Patent Law)

VI. Other Procedures

1. Exception to Loss of Novelty of Invention (Article 30 of the Patent Law)

(i) Overview

Under the Japanese patent system, an invention which was published prior to the filing date cannot be patented. There is, however, statutory exception to loss of novelty (Article 30 of the Patent Law) under which novelty of an invention will not be lost by disclosure by the applicant him/herself if the applicant voluntarily disclosed the invention under special circumstances to contribute to the development of the industry, and then filed the patent application.

(ii) Procedures to be eligible for Statutory Exception to Loss of Novelty of Invention (Article 30)

(a) The person eligible to patent files a patent application within six (6) months after disclosure of the invention;

(b) Document requesting application of exception to loss of novelty is filed simultaneously with the application.

(c) Document to prove that the applicant meets the requirements for exception to loss of novelty is filed within thirty (30) days after the filing date.

If there is inconsistency between what the inventor disclosed prior to the filing date and what is disclosed in the patent application, or if applicant's ownership of right is not clear, a certificate to clarify such matters should to be filed.

(iii) Priority Claim based on the Paris Convention

Even if novelty is lost prior to the filing date in a country, the applicant will still be entitled to exception to loss of novelty by taking the prescribed procedures if a patent application is filed in Japan within six (6) months after the date of loss of novelty.

(iv) International Application based on the Patent Cooperation Treaty (PCT)

An international application under the Patent Cooperation Treaty must be filed within six (6)

months after the date of loss of novelty due to special disclosure.

2. Priority Examination (Article 48sexies of the Patent Law, Article 31bis of the Patent Law Implementing Rules)

(i) Overview

The purpose of priority examination (Article 48sexies of the Patent Law (Law in 1994) is to facilitate balancing of interests between patent applicant and third parties by examining eligible patent applications in preference to those of other parties and eliminating flaws accompanied by statutory publication of the application system. For instance:

- <1> To protect the applicant by promptly granting a patent when the long-time examination of the application and a third party's use during that period have an unexpectedly significant cost which cannot be recovered by monetary compensation;
- <2> To protect a third party by promptly deciding refusal when the third party using the invention has received a warning pursuant to Article 65 of the Patent Law (Law in 1994) and when the claimed invention lacks patentability.

(ii) Requirements for Prior Examination

A patent application needs to meet the following four (4) requirements to be eligible for prior examination:

1. Request for examination is filed with respect to the patent application;
2. Patent application was filed after disclosure of invention and prior to decision of grant;
3. A third party uses the claimed invention prior to the statutory publication and after grant of the application.
4. Priority examination is required.

Such situations where priority examination is required and when urgent examination is needed is found based on comprehensive consideration of the following matters in view of the fact that harmful effects of the statutory publication system should be removed.

3. Expedited Examination

(1) What is Expedited Examination?

The expedited examination system is the system under which an application meeting certain requirements is examined on an expedited basis in response to an applicant's request.

(2) Application Eligible for Expedited Examination (See chart below)

(i) Request for examination has been filed.

(ii) The application meets any of the following requirements;

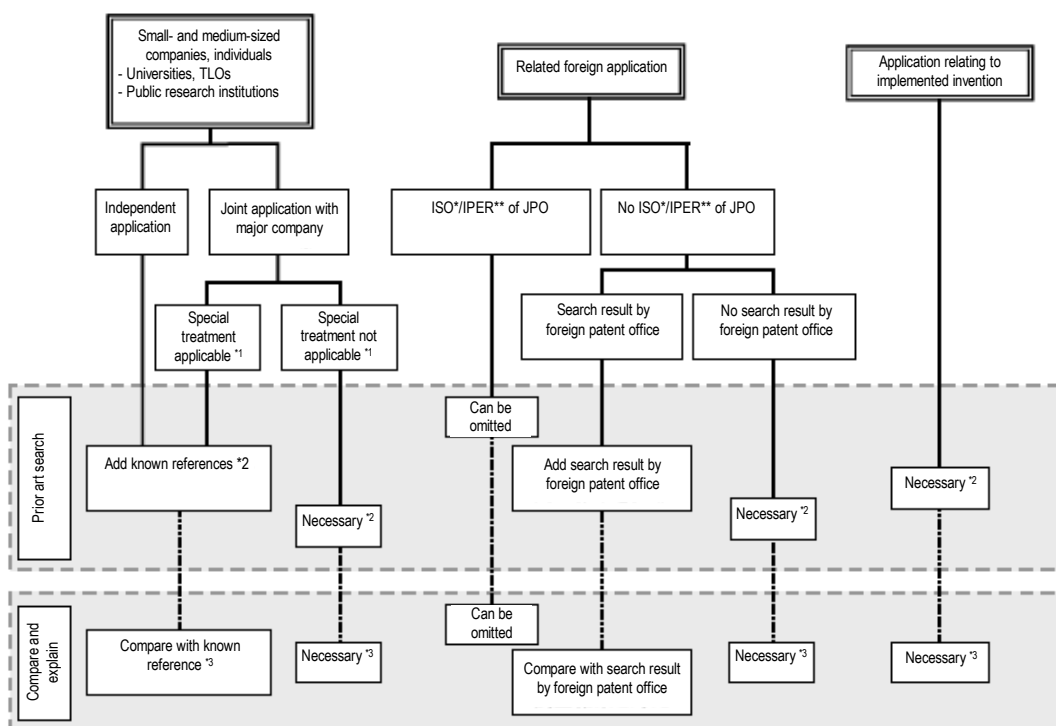
<1> application filed by small- or medium-sized company, individual, university or public research institution;

<2> Corresponding foreign application

The applicant has filed a patent application (including international application) for the same invention with the patent office or other governmental agency in countries other than Japan (hereinafter referred to as “corresponding foreign application”).

<3> Application relating to implemented invention

The applicant or a person who has obtained a license for the claimed invention from the applicant uses the invention claimed in the subject patent application (hereinafter referred to as “application relating to implemented invention”).



4. Japan-US Patent Examination Highway Scheme (Operated on a Trial Basis)

(1) What is the Patent Examination Highway?

The patent examination highway has been operated on a trial basis since July 2006 for the purpose of facilitating expedited patenting in foreign countries and reducing the burden of examination in each patent office while improving the quality of examination by enhancing usability of prior art search and examination results made by the first country.

The patent examination highway aims to give the applicant the opportunity to have an expedited examination by simple procedures at the patent office of the second country (the second patent office) with respect to an application which has been found patentable by the patent office of the first country (the first office).

To be eligible for expedited examination set forth in paragraph 3 above at the Japan Patent Office, the applicant needs to file a document stating implementation of prior art search, comparison of the result of such search with the claimed invention and patentability of the claimed invention. Under the patent examination highway system, however, the applicant may omit those procedures by submitting patent claims and office actions of the first patent office.

(2) Timing of Implementation of the Japan-US Patent Examination Highway Scheme

The period of trial operation is one (1) year from July 2006, after which the patent office of both countries will evaluate the results of the trial operation and aim for the official launch.

(3) Eligible Application

This scheme may be available to applications filed with the Japan Patent Office which meet the following requirements a. through d. by submitting a copy of the necessary documents relating to corresponding applications with the US Patent and Trademark Office.

a. The application legitimately claims priority under the Paris Convention based on a corresponding US application or a corresponding application in the first country (except for PCT applications).

b. The corresponding US application already has claims found as patentable.

c. All the claims as of the filing date of the application fully correspond to one of the claims of the corresponding US application which was found patentable.

d. Examination of the application has not been started at the Japan Patent Office.

5. Interview with Examiner

At the end of each notice of reasons for refusal is the statement that “Any inquiry with respect to this Notice of Reasons for Refusal or request of interview relating to this case may be made to the following address” followed by the telephone number of the examiner. As the technical matter of patent applications become more and more complex and advanced, interviews have become an important supplementary procedure to ensure good communication between examiners and applicants or their agents and facilitate examination procedures. (See “Interview Guidelines”)

Hence, the applicant may actively request an interview if he/she believes the examiner made a decision in error or with respect to a complicated invention, invention of which inventiveness requires delicate decision, or other matters.

Typical interviews may be outlined as follows:

(1) Purposes of Interview

(i) Interview to Explain Claimed Invention in Comparison to Prior Art

The person appearing at the interview may explain to the examiner the prior art he/she found or the examiner cited in the notice of reasons for refusal in comparison with the claimed invention, discuss the difference of claimed invention to prior arts and argue patentability of the claimed invention.

(ii) Interview to Explain Amendment of Specification

The person appearing at the interview may explain and request the examiner’s opinion in advance with respect to composition of planned amendment, correction of mistranslation, opinion letter or certificate of laboratory experiment.

Care should be taken that the examiner’s opinion on the amendment and other matters will not have any legal effect and that the way to compose a patent specification must ultimately the decision and responsibility of the applicant based on his/her intention.

Typical interviews for explaining an amendment to a specification are described below in a. and b.

(2) Requirements for Attendee

It is desirable that the person appearing at the interview is:

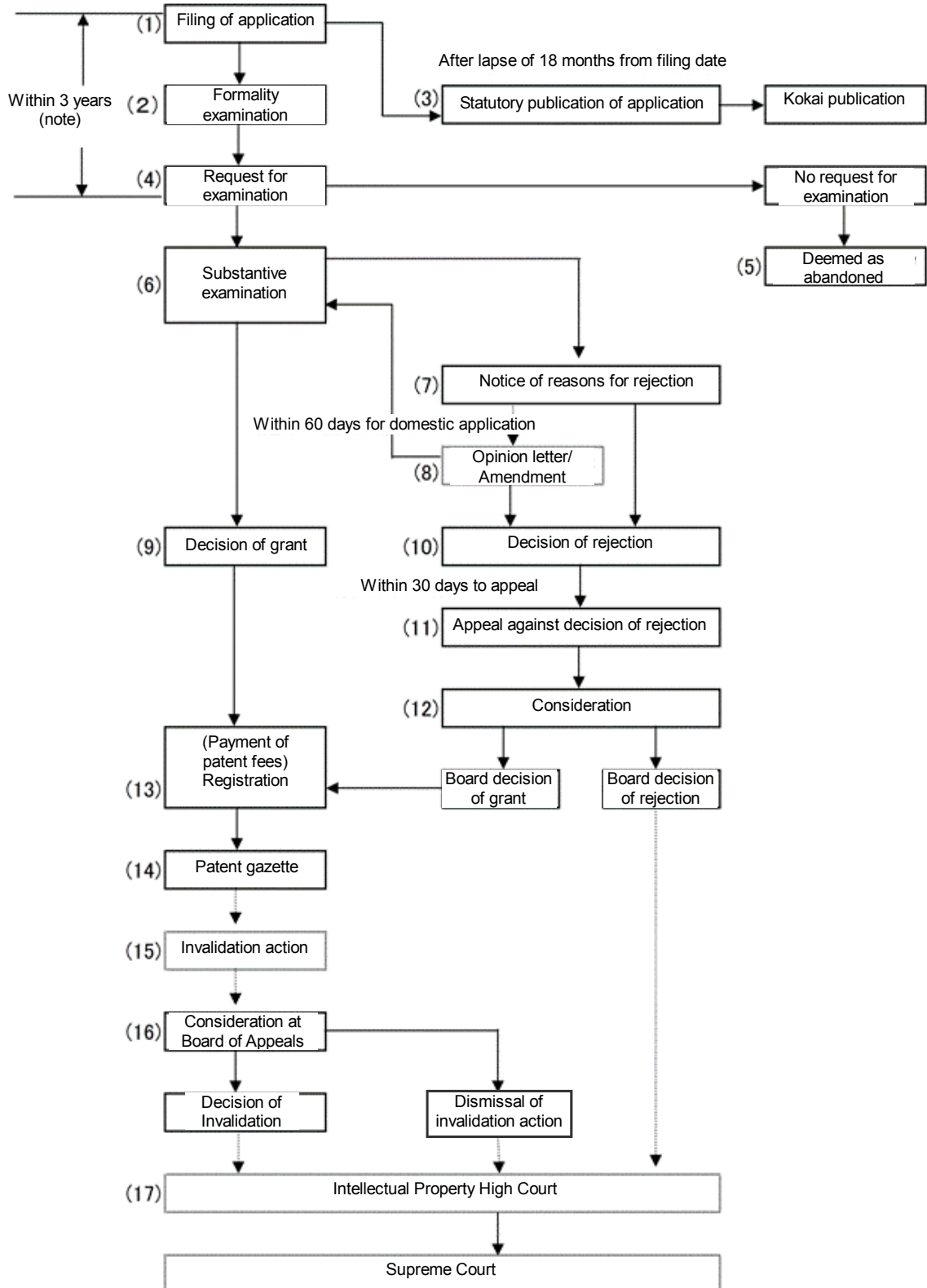
(i) the applicant (or the person who has the right to represent a company in the case of a corporate application)

- (ii) the agent or designated agent who is already reported with respect to the application; or
- (iii) the patent attorney who has been asked to act on behalf of the applicant, or an agent who has the right to appoint a sub-agent with respect to the interview with the examiner, and who has a certificate of such appointment (power of attorney).

The person appearing at the interview may bring, if necessary, the inventor and/or staff in charge (staff of the patent division of a company, staff of a patent attorney's office ...).

Appendix 1

Patenting Procedures



Appendix 2

