

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

## Part VIII International Patent Application

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## 8001 Handling of Non-formal Comment in the Examination for the International Patent Application

The applicant may refute to the written opinion of the international search prepared by the international searching authority (ISA) by submitting a comment (called as "non-formal comment", since it is not prescribed in any treaties) to the International Bureau, instead of submitting the written answer or the written amendment upon requesting the international preliminary examination. The non-formal comment which is submitted is transmitted to each designated office. Each designated office can consider the non-formal comment during the national substantive examination. Whether or not the designated office considers the non-formal comment in the substantive examination depends on the determination of each designated office.

The Japan Patent Office (designated office) will treat the non-formal comment as follows.

### 1. A Case in Which the Non-formal Comment is Prepared in Japanese

It will be considered as a reference on the examination.

### 2. A Case in Which the Non-formal Comment is Prepared in Foreign Language

Where its translation is submitted to the Japan Patent Office as a written statement, the translation is considered as the reference in the examination. The coincidence in the contents between the translation and the original comment is not determined, and the translation is considered.

## 8002 Handling of the International Patent Application Based on the International Application in Which the Reference is Incorporated

### 1. Incorporation by Reference Based on the Application on Which the Priority is Based

The incorporation by reference is a procedure of incorporating in the international application with the claiming of the priority right by citing the description, etc. of the prior application on which the claiming of the priority right is based (hereinafter, referred to as "application on which the priority is based"), maintaining the international filing date without post-dated.

Incorporation by reference is utilized in a case where there is a lack of description, etc. in the international application claiming priority and the lack is completely stated in the description, etc. of the application on which the priority is based.

### 2. Handling of the DO Application Based on the International Application in Which the Reference is Incorporated

#### 2.1 A Case of the DO Application Based on the International Application Which was Filed Prior to September 30, 2012

The Japan Patent Office as the designated office or the selected office does not recognize the incorporation by reference for a DO application based on an international application which was filed prior to September 30, 2012.

Accordingly, the Japan Patent Office as the designated office or the selected office transmits a "Notification" stating that the date which is incorporated is deemed to be the international filing date for the DO application based on the international application in which the incorporation by reference is made. The applicant selects the following (i) or (ii) in response to the "Notification":

- (i) The applicant selects to submit a "Written request" to address the lacking description, etc. by ignoring the incorporation by reference. In this case, the incorporated portion is ignored, and the international filing date is not post-dated.
- (ii) The applicant selects to proceed with the incorporated description, etc., without submitting the "Written request." In this case, the international filing date is post-dated to the date when the incorporation was made (when, as a result, the international filing date is more than 12 months from the priority date, the priority right is invalidated.).

The examiner performs the substantive examination based on the result of selection by the applicant (see the following (1) and (2) for further details). The result of selection is determined by whether or not the "Written request" is submitted.

The "Notification" is included in the provisional file wrapper, while the "Written request" is not included therein. The "Written request" can be referred by selecting "Internal document (other internal document)" in "Window for selecting document list" which appears by pushing a button of "Refer the document list" in WindowManager (Examiner) in the peripheral system of examination of Patent and Utility Model.

(1) Points to note on the examination

(a) A case in which the "Written request" is submitted

The examiner performs the substantial examination upon deeming that the portion that is incorporated by reference (a portion to be ignored) is not included in the description, etc. (the description, the claims, or the drawings) as of the international filing date.

Accordingly, where only the matter stated in the portion which is incorporated by reference is included in the translation, the matter corresponds to new matter as to the original text (Article 49(vi) of the Patent Law applied by replacing the provision of Article 184octodecies of the Patent Law). Hence, where a doubt is raised about coincidence between the description, etc. as of the international filing date (a portion other than the portion incorporated by reference) and the translation according to Examination guidelines "Part VII Chapter 2 Examination of Foreign Language Written Application," 2.2<sup>1</sup>, the examiner confirms whether or not new matter as to the original text is present (see the following (2) for details).

(b) A case in which the "Written request" is not submitted

The examiner performs the substantial examination upon deeming that the portion which is incorporated by reference is included in the description, etc. as of the international filing date.

As a result of the international filing date being post-dated to the date of incorporation, if the international filing date is more than 12 months from the priority date, the claiming of the priority right is invalidated. Therefore, note the reference date upon determining novelty, inventive step, and the like.

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<sup>1</sup> For example, where no amendment corresponding to the main gist of the "Written request" is made by the applicant despite the submission of the "Written request" that the incorporation by reference be ignored, it is perceived to be a case in which there is a doubt in the coincidence between the description, etc. as of the international filing date and the translation.

(2) Confirmation measures of the matter stated in the portion in which the incorporated by reference is made

Number of page (page on the international publication) or figure in which the portion incorporated by reference is included is stated in a predetermined column of the "NOTIFICATION ON DECISION OF CONFIRMATION OF INCORPORATION BY REFERENCE OF ELEMENT OR PART (RO/114)" notified to the applicant by the receiving office in the international phase ([Appendix 1](#)). In addition, "INCORPORATED BY REFERENCE (Rule 20.6)"<sup>2</sup> is indicated at the bottom portion of page of the international publication, in which the incorporation by reference is made.

Accordingly, the matter stated in the portion in which the incorporation by reference is noted can be confirmed by referring the corresponding page of the international publication.

Since RO/114 is not included in the provisional file wrapper, reference is made to RO/114 in a "Miscellaneous notification" of "Window of inquiring application master item" which appears by pushing a button "Inquiring application master" of WindowManager (Examiner) in the peripheral system of examination of Patent and Utility Model or on "PATENTSCOPE" of the WIPO homepage ([Appendix 2](#)).

There is a case in which the incorporation by reference is made not for the whole corresponding page, but only for a portion thereof. Whether the portion in which the incorporation by reference is made is for the whole page or only for a portion thereof can be confirmed by referring the letter to request the incorporation by reference which is submitted by the applicant to the receiving office by using the "PATENTSCOPE" (3.(iii) of [Appendix 2](#)). However, the examination can proceed on an assumption that the incorporation by reference is made for the whole page, except a case that there is a high possibility that the incorporation by reference only for a portion of the page has been made<sup>3</sup>, since the incorporation by reference is often made for the whole page.

## 2.2 A Case of the DO Application Based on an International Application Which was Filed after October 1, 2012

The Japan Patent Office as the designated office or the selected office recognizes incorporation by reference for a DO application based on an international application

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<sup>3</sup> For example, it includes a case in which asserts in a written opinion or a written petition that the incorporation by reference is made only for a portion of the page.

which was filed after October 1, 2012. The DO application based on the international application in which the incorporation by reference is made enters the national phase to have the international filing date and the content of the description, etc. which are recognized by the receiving office.

The examiner performs the substantive examination<sup>4</sup> based on the international filing date and the content of the description, etc. which are recognized by the receiving office.

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<sup>4</sup> Where it is found that the element or the part which is incorporated by reference is not completely stated in the application on which the priority is based, the examiner shall contact the Examination Standards office.

Example of RO/114 (notified prior to June 2009)

PATENT COOPERATION TREATY

From the RECEIVING OFFICE

PCT

NOTIFICATION ON DECISION OF CONFIRMATION OF INCORPORATION BY REFERENCE OF ELEMENT OR PART

(PCT Rule 20.6(b) and (c))

<p>To:</p> <div style="background-color: black; width: 100px; height: 40px; margin: 5px 0;"></div>	<p>Date of mailing <i>(day/month/year)</i></p> <p style="text-align: right;">31 Dec 2007</p>
<p>Applicant's or agent's file reference</p> <div style="background-color: black; width: 100px; height: 15px; margin: 5px 0;"></div>	<p><b>IMPORTANT NOTIFICATION</b></p>
<p>International application No.</p> <div style="background-color: black; width: 100px; height: 15px; margin: 5px 0;"></div>	<p>International filing date/Date of first receipt of papers <i>(day/month/year)</i></p> <p style="text-align: center; border: 1px solid black; border-radius: 50%; padding: 2px;">24 May 2007</p>
<p>Applicant</p> <div style="background-color: black; width: 100px; height: 15px; margin: 5px 0;"></div>	

Date on which the request for application, etc. is originally filed (In this example, May 24, 2007)

This receiving Office has found that:

1.  the requirements of Rules 4.18 and 20.6(a) have been complied with and that an element or part is considered to have been contained in the purported international application on the date on which one or more elements referred to in Article 11(1)(ii) were first received by this receiving Office (for further details on the international filing date accorded see Form PCT/RO/105 issued separately) (Rule 20.6(b)).

This decision concerns page number(s) 3-21 of the international application received on 6/25/07.

For the purposes of Rule 20.6(a)(ii), this decision has been based on:

a.  the priority document furnished under Rule 17.1(a), (b) or (b-bis).

b.  a copy of the earlier application as filed (Rule 20.6(a)(i)).

May or may not mention the alternatives a. and b. (The only difference is the measure for submission of the document relating to the priority right)

Page(s) which are incorporated by reference (In this example, pages 3 to 21)  
The number of a figure may sometimes be stated therein

Date on which the incorporation by reference is made (In this example, June 25, 2007)

The international filing date and the range of the originally-filed description, etc. which are recognized in Japan (designated office or selected office) \*A case of a DO application based on an international application which was filed prior to September 30, 2014  
June 25, 2007, when the "Written request" is not submitted  
The portion which is incorporated by reference on pages 3 to 21 is also included in the originally-filed description, etc.  
May 24, 2007, when the "Written request" is submitted  
The portion which is incorporated by reference on pages 3 to 21 is not included in the originally-filed description, etc.

Form PCT/RO/105  
Form PCT/RO/105  
The form was partially changed after July, 2009, as mentioned on the next page.

Example of RO/114 (New form after July 2009)

PATENT COOPERATION TREATY

From the RECEIVING OFFICE

PCT

NOTIFICATION ON DECISION OF CONFIRMATION OF INCORPORATION BY REFERENCE OF ELEMENT OR PART

(PCT Rule 20.6(b) and (c))

<p>To:</p>	
<p>Applicant's or agent's file reference</p>	<p><b>IMPORTANT NOTIFICATION</b></p>
<p>International application No.</p>	<p>Date of mailing <i>(day/month/year)</i></p>
<p>Applicant</p>	<p>International filing date/Date of first receipt of papers <i>(day/month/year)</i></p>

Date on which the application, etc. is originally filed

This receiving Office has found that:

1.  the requirements of Rules 4.18 and 20.6(a) have been met. The requirements of Article 11(1)(iii) were first received by this Office (see Form PCT/RO/105 issued separately) ( )

This decision concerns page number(s) \_\_\_\_\_

Page(s) stating the matters to be incorporated by reference  
(The number of pages may sometimes be stated therein)

received on \_\_\_\_\_

Date on which the incorporation by reference is made

For the purposes of Rule 20.6(a)(ii), this decision has been based on:

a.  the priority document furnished under Rule 17.1(a), (b) or (b-bis).

b.  a copy of the earlier application as filed (Rule 20.6(a)(ii)).

May or may not mention the alternatives a. and b.  
(The only difference is the measure for submission of the document relating to the priority right)

This decision concerns page number(s) \_\_\_\_\_

The content of the description is not substantially different from that in the previous form.

<p>Name and mailing address of the receiving Office</p>	<p>Authorized officer</p>
<p>Facsimile No.</p>	<p>Telephone No.</p>



## Appendix 2

## A Measure of Confirming a Portion in Which the Incorporation by Reference is Made using PATENTSCOPE

### 1. Input the International Application Number

Access the following URL.

<https://patentscope.wipo.int/search/en/structuredSearch.jsf>

After the following window is displayed, input the international application number and push the "Search" button.

The screenshot shows the 'Field Combination' window in the PATENTSCOPE search interface. The window contains a list of search fields with 'AND' operators between them. The 'Application Number' field is circled in red. Below the list of fields, there are options for 'Language' (English), 'Stem' (checked), 'Office' (All), and 'Specify'. The 'Search' button is circled in red. The 'Is Empty' section has radio buttons for 'N/A', 'Yes', and 'No'. The '0 results' indicator is visible at the bottom right.

### 2. Select Document Tab

Open the window of the case to be applied, and select the tab "PCT Biblio. Data". Then select the "Documents" tab.

The screenshot shows the search results page for 'PCT Biblio. Data'. The 'Documents' tab is selected and circled in red. Below the tabs, there is a section titled 'Latest bibliographic data on file with the International Bureau'. The 'Pub. No.' and 'International Application No.' fields are redacted with black boxes.

### 3. Select the Document to be Subjected

A list of documents which are stored in PATENTSCOPE is displayed.

PCT Biblio. Data	Description	Claims	National Phase	Notices	Drawings	Documents
<b>International Application Status</b> ⓘ						
Date	Title					View
11.09.2015	International Application Status Report					HTML, PDF
<b>Published International Application</b>						
Date	Title					View
05.05.2011	最初の国際公開 (ISR 含む) (A1 18/2011)					PDF (73p.)
05.05.2011	引用による要素又は部分の補充確認に関する決定通知 (承認) (RO/114)					PDF (2p.)
05.05.2011	申立て					PDF (1p.)
05.05.2011	規則 20.6 に基づく引用により補充された用紙					PDF (58p.)
⋮						
<b>Related Documents on file at the International Bureau</b>						
Date	Title					View
08.05.2012	特許性に関する国際予備報告 (第一章) の英訳 (IB/373)					PDF (5p.)
⋮						
05.05.2011	引用による要素又は部分の補充確認 (規					PDF (1p.)

(ii) International publication

(i) Notification that the incorporation by reference is recognized transmitted to the applicant by the receiving office

(iii) Letter requesting the incorporation by reference submitted to the receiving office by the applicant

Among these, the following documents relating to the incorporation by reference are selected (displayed or downloaded) to confirm their contents.

- (i) Notification on decision of confirmation of incorporation by reference of element or part (RO/114)
- (ii) International publication (A1 or A2)
- (iii) Document confirming that the element or the part is included by reference

The number of the page (or the figure) which is incorporated by reference can be specified by referring to the above (i) or (ii).

There is a case in the above (iii) in which a portion of the page is specified (a case where the incorporation by reference is made for only a portion of the page).

### 8003 Handling in Cases Where Amendment of "Cancelled" of Claims is Indicated at an International Phase

Based on amendment of Article 19 or Article 34, in cases where the claims does not conform to Article 24ter (2) of the Regulations under the Patent Act (for example, "[claim 2] (Cancelled)" wherein claims are deleted while the caption remains undeleted), it does not constitute violation of Article 36(6)iv.

(Explanation)

Article 27(1) of the PCT provides that laws and regulations of the designated office or the selected office shall not request, with regard to the format or contents of a PCT international application, for requirements which are not provided in PCT or any of the rules that are based on PCT, or which are additional to the requirements provided in PCT or any of the rules that are based on PCT. Furthermore, Rule 6.1(c) which is based on PCT provides that, "with respect to the claims, how to place numbers in the case of amendment shall be provided for in the Administrative Instructions". Administrative Instructions No. 205(a) which corresponds to the foregoing provides that, in the case of deleting a certain claims, it is not necessary to place new numbers to the rest of the claims. As such, these cases shall be handled as indicated above.