

Examination Handbook

for Patent and Utility Model

Japan Patent Office

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

Part I Outline of Examination

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Chapter 1 Principles of the Examination and Flow of Examination

1101 Timing of Application of the Examination Guidelines and the Reasons for Refusal, etc. relating to the Examination Guidelines

Timing of Application of the Examination Guidelines and the Examination Handbook is indicated in Table 1. And reasons for refusal and the reasons for dismissal of the amendment relating to the Examination Guidelines is indicated in Table. 2.

Table 1: Timing of Application of the Examination Guidelines and the Examination Handbook

Act · Ministerial Ordinance	1990 Act	1993 Act	1994 Act	1999 Act	2002 Act	2003 Act	2004 Act	2006 Act	2008 Act	2011 Act	2015 Act	2018 Act	2022 Ministerial Ordinance
Effective date	From Dec. 1, 1990	From Jan. 1, 1994	From Jul. 1, 1995	From Jan. 1, 2000	From Sep. 1, 2002	From Jan. 1, 2004	From Apr. 1, 2005	From Apr. 1, 2007	From Apr. 1, 2009	From Apr. 1, 2012	From Apr. 1, 2016	From June 9, 2018	From Apr. 1, 2022
Point of law revision	* Introduction of abstract	* Improvement of scope of amendments * Introduction of utility model registration system	* Introduction of system of application accompanied by foreign language documents * Easing of description requirements for description	* Article 29 (being publicly known or publicly worked in foreign country, being made available to public through electrical communication lines) * Revision of patent term extension registration system	* Introduction of system of disclosure of information on prior art documents * Clarification to the effect that "a product" includes a computer program * Separation of scope of claims from description (from Jul. 1, 2003)	* Requirement of unity of invention	* Introduction of system of patent application based on utility model registration * Enlargement of allowable range of correction to utility model registration	* Prohibition of amendment changing special technical feature of invention * Easing of timing restriction for divisional applications * Prevention of abuse of divisional application system * Extension of period for submission of translations of foreign language document application	* Extension of period for filing request for appeal against examiner's decision of refusal	* Revision of provision concerning exceptions to lack of novelty of invention * Revision of provision concerning usurped application as prior application	* Introduction of system of reference filing	* Revision of provision concerning exceptions to loss of novelty of invention	* Introduction of Multi-Multi Claim Restriction ※Addition of Article 24ter(v) of the Ordinance for Enforcement regarding Delegated Ministerial Ordinance Requirement on Statement of Claims (Article 36(5)(iv) of the Patent Act)
Outline of Examination	Part I Outline of Examination (*) Statements on the Examination Guidelines after Part II shall be according to the following Timing of Application.												
Description and Claims	Part II Chapter 1 Requirements for Description												
					Part II Chapter 1 Section 3 Requirements for Disclosure of Information on Prior Art Documents								
	Part II Chapter 2 Requirements for Claims												
	Former Examination Guidelines Part I Chapter 2 Requirements of Unity of Application					Part II Chapter 3 Unity of Invention							
Patentability	Part III Patentability												
Amendments of Description, Claims or Drawings	Former Examination Guidelines Part III Amendments of Description, etc.	Part IV Amendments of Description, Claims or Drawings											
Priority	Part V Priority												
Special Application	Examination Guidelines for Each Industry Division of Application (Revised)	Part VI Chapter 1 Division of Patent Application											
Part VI Chapter 1 Section 2 Notice under Article 50bis													
Part VI Chapter 2 Conversion of Application													
Part VI Chapter 3 Patent Application Based on Utility Model Registration													
Part VI Chapter 4 Reference filing													
Foreign Language Written Application			Part VII Foreign Language Written Application										
International Patent Application			Part VIII International Patent Application										
Extension of Patent Term	Part IX Extension of Patent Term												
Utility Model	(Substantially the same guidelines as those for patent applications)	Part X Utility Model											
Application examples of the specific technical fields	Examination Handbook Annex B Chapter 1 Computer software related Inventions												
	Portions related to "storage medium" claims, "2.1 Eligibility for Patent" (applications filed on or after Apr. 1, 1997)												
	Portions related to "program" claims (applications filed on or after Jan. 10, 2001)												
	Examination Handbook Annex B Chapter 2 Biological Inventions												
	Examination Handbook Annex B Chapter 3 Medicinal Inventions												

The "Examination Guidelines for Patent and Utility Model" is in principle applicable to applications filed on or after July 1, 1995. However, the portions added or modified as a result of subsequent revision made to the Act, changes to examination practice, and the like may only be applicable to a limited range of patent applications. In addition, subsequent revisions and changes may be associated with clarification of the previous interpretations and practices, revised provision and changed practices will also serve as reference information in interpretation of handling of applications filed prior to the Act 1994 entering into force.

Table 2: Timing of Application of the reasons for refusal and the reason for dismissal of the amendment relating to the Examination Guidelines

Act・Ministerial Ordinance			1990 Act	1993 Act	1994 Act	1998 Act	1999 Act	2002 Act	2003 Act	2004 Act	2006 Act	2011 Act	2022 Ministerial Ordinance	
Effective date			From Dec. 1, 1990	From Jan. 1, 1994	From Jul. 1, 1995	From Jan. 1, 1999	From Jan. 1, 2000	From Sep. 1, 2002	From Jan. 1, 2004	From Apr. 1, 2005	From Apr. 1, 2007	From Apr. 1, 2012	From Apr. 1, 2022	
Reason for refusal	Requirements for Description	Enablement Requirement	Article 36(4)						Article 36(4)(i) (*9)					
		Ministerial Ordinance Requirement												
		Requirements for Disclosure of Information on Prior Art Documents												
	Description Requirements of Claims	Support Requirement	Article 36(5)(i), (6)			Article 36(5)(i) (*4)								
		Clarity Requirement	Article 36(5)(ii), (6)			Article 36(5)(ii) (*4)								
		Conciseness Requirement				Article 36(5)(iii) (*4)								
		Ministerial Ordinance Requirement on Statement of Claims	Article 36(5)(iii), (6)			Article 36(6)(iv) (*4)								
	Unity of Invention		Article 37							(*10)				
	Eligibility for Patent and Industrial Applicability		Article 29(1) main paragraph											
	Novelty		Article 29(1)						(*8)					
	Inventive Step		Article 29(2)						(*8)					
	Secret Prior Art		Article 29bis		(*1)									
	Prior Application		Article 39(1) (*4)				(*7)			(*11)		(*13)		
	Category of Unpatentable Invention		Article 32			(*5)								
Reason for dismissal of the amendment	Amendment Adding New Matter			Article 17(2) (including Article 17bis(2)) (*2)		Article 17bis(3) (*6)								
	Amendment Changing Special Technical Feature of Invention										Article 17bis(4) (*12)			
	Amendment for other than the Prescribed Purposes	Deletion of a claim		Article 17bis(3)(i) (*3)		Article 17bis(4)(i)							Article 17bis(5)(i) (*12)	
		Restriction in a limited way of the claims		Article 17bis(3)(ii) (*3)		Article 17bis(4)(ii)							Article 17bis(5)(ii) (*12)	
		Correction of errors		Article 17bis(3)(iii) (*3)		Article 17bis(4)(iii)							Article 17bis(5)(iii) (*12)	
		Clarification of an ambiguous statement		Article 17bis(3)(iv) (*3)		Article 17bis(4)(iv)							Article 17bis(5)(iv) (*12)	
	Requirement of independent patentability			Article 17bis(4), Article 126(3) (*3)		Article 17bis(5), Article 126(5)							Article 17bis(6), Article 126(7) (*12)	
	Reason for refusal	Foreign Language Written Application	New Matter beyond the Original Text				Article 17bis(3) (*6)							
New Matter beyond Translation						Article 49(v) (*6)								
	Points of law revision		Introduction of abstract	(*1) Application for utility model registration for which Utility Model Gazette has been issued serves as the basis for the prior-art effect as a result of abolition of publication of unexamined application and publication of examined application and publication of unexamined application for utility model registration system. (*2) Improvement of scope of amendments (new matter) (*3) Incorporation of system of first notice of reasons for refusal and final notice of reasons for refusal	(*4) Easing of description requirements for description (*5) Reducing and decreasing of subject of unpatentable ground (atomic nucleus transformation material) (retroactively applied) (*6) Incorporation of system of foreign language application	(*7) Application waived and application for which examiner's decision or trial decision of refusal became final and binding no more serves as prior application in the meaning of § 39(5).	(*8) Addition to the ground of refusal of novelty, of the inventions which have been publicly known or publicly worked in foreign country, and which have been made available to public through electrical communication lines.	(*9) Introduction of system of disclosure of information of prior art documents	(*10) Revision of unity of invention	(*11) Article 39(4) was revised in response to introduction of system of patent application based on utility model registration, so that application can be filed for invention identical with device of utility model registration.	(*12) Incorporation of system prohibiting amendment changing special technical feature of invention	(*13) Article 39(6) is deleted, so that usurped application also serves as prior application.	(*14) Introduction of Multi-Multi Claim Restriction (Article 24ter(v) of the Ordinance for Enforcement was added for Article 36(6)(iv).)	

Chapter 2 Procedures of Examination

1201 Searches of Prior Art Documents by Registered Search Organizations

1. Overview

The "searches of prior art documents by registered search organizations" is an investigation work aimed at making the registered search organizations preliminarily investigate a part of searches of prior art documents to be conducted by the examiner to speed up the examination and improve the quality thereof.

This investigation work is based on provision of Article 36 of the Act on the Special Provisions to the Procedure, etc. concerning Industrial Property Rights (Act No. 30 of 1990), and the registered search organizations that can work this investigation work must be registered for each section of conducting the investigation work (sections 1-39) (provided in Article 56 of Regulations under the same act) on the basis of the provision of Article 37 of the same act.

2. Scope of searches of prior art documents by registered search organizations

The scope of searches of prior art documents by the registered search organizations, in many cases, covers patent documents written in English language, as well as domestic patent documents. Further, in some cases, the scope may cover patent documents written in Chinese, Korean, and German language. In some fields, non-patent literatures may be also investigated by using a database such as STN.

3. Report for searches of prior art documents by registered search organizations

The report for searches of prior art documents by the registered search organizations is, in principle, reported by an online meeting between the searcher and the examiner, where application concerned technical contents, search policy, search results, and technical contents of documents shown are explained verbally, using materials as appropriate.

In some cases, the process may be conducted solely through the materials without an verbal report.

Regardless of the form of the report, the examiner will instruct the searchers to conduct supplementary searches as necessary.

4. Security management for retrieval report

Retrieval reports which have been already delivered can be in public perusal by Japan Platform for Patent Information (J-PlatPat).

Since the retrieval report remains unpublished information until it becomes in public perusal by J-PlatPat, the examiner needs to manage it appropriately to prevent leaks.

5. Estimation by examiner

The examiner estimates the results of the prior art searches by the registered search organizations by using an estimation form.

Estimation results are fed back to each registered search organization as well as will also be used in the selection of the registered search organizations of each section to conduct the investigation work in the following fiscal year, thereby improving the quality of investigation conducted by this investigation work.

1202 Submission of information to Patent Applications

The submission of information by third parties to patent application, provided in Article 13bis of the Regulations under the Patent Act, enables provision of information about that the invention claimed in the patent application has no novelty nor inventive step, and the like, to the patent application pending in the Patent Office. Hereinafter, practical operations of the submission of information to patent application, provided in Article 13bis of the Regulations under the Patent Act, are described.

After granting a patent, the submission of information under Article 13ter of the Regulations under the Patent Act is possible. In addition, also to the application for a utility model registration and a utility model registration, the submission of information under Article 22 of the Regulations under the Utility Model Act and Article 22bis of the Regulations under the Utility Model Act is possible.

(Reference) Japan Patent Office Web site "About the Submission of Information by Third Parties"

<https://www.jpo.go.jp/system/patent/shinsa/johotekyo/index.html>

1. Information provider

Anyone can submit information.

Entry of a name, etc. in a column of [Provider] can be omitted. In this case, "omitted" should be stated in columns of [Address or Residential Address] and [Name] (Refer to Form 20 Note 4 of Regulations under the Patent Act).

2. Subject of submission of information

The submission of information under Article 13bis of the Regulations under the Patent Act can be conducted only to the patent application pending in the Patent Office. For patent applications not pending in the Patent Office (For example, patent applications for which decision of refusal has become final, patent applications that have been abandoned, dismissed, or declined, or patent applications for which establishment of patent right has been registered), submission of information under Article 13bis of the Regulations under the Patent Act cannot be conducted. Presence or absence of a request for examination is not regarded.

3. Information that can be submitted

(1) Information that a patent shall not be granted for the claimed invention of the subject application according to the provisions of respective items of Article 29(1) of the Patent

Act (Novelty) (including information related to a distributed publication or information that were made publicly available through an electric telecommunication line, and information based on a publicly known invention or an official invention)

- (2) Information that a patent shall not be granted for the claimed invention of the subject application according to Article 29(2) of the Patent Act (Inventive step)
- (3) Information that a patent shall not be granted for the claimed invention of the subject application according to the provision of Article 29bis of the Patent Act (Secret prior art)
- (4) Information that a patent shall not be granted for the claimed invention of the subject application according to the provisions of Article 39(1) to (4) of the Patent Act (Prior application)
- (5) Information that the claimed invention of the subject application is not an invention of the main paragraph in Article 29(1) of the Patent Act or an industrially applicable invention
- (6) Information that the subject application does not satisfy the description requirements provided in Article 36(4) or (6) of the Patent Act (excluding information related to Article 36(6)(iv) of the same Act)
- (7) Information that the amendments of description, claims or drawings, attached to the request of the subject application do not satisfy the requirements provided in Article 17bis(3) of the Patent Act (including new matter) (not including information related to the new matter beyond the translation text in applications in foreign language and foreign language patent applications, etc. (including international applications recognized as patent applications and written by foreign language. The same shall apply hereinafter.))
- (8) Information that matters stated in description, claims or drawings attached to a request for application in foreign language are not within a range of matters stated in the original language text (including new matter as to the original text)
- (9) Information that matters stated in description, claims or drawings attached to a request for foreign language patent application, etc. are not within a range of matters stated in description, claims or drawings on the international filing date, etc. (including the

constructive international filing date) (foreign language patent application, etc. including new matter as to the original text)

(Points to Note) The submission of information cannot be conducted with respect to the reasons for refusal under Article 17bis(4) of the Patent Act (Amendment that Changes a Special Technical Feature of an Invention), Article 25 (Enjoyment of Foreign applicant's rights), Article 32 (Unpatentable Ground), Article 36(6)(iv) (Ministerial ordinance requirement for claims), Article 37 (Unity of invention), Article 38 (Joint application), Article 49(iii) (Violation of Treaty), Article 49(vii) (Usurped Application), and to new matter beyond the translation text under Article 17bis(iii) related to applications in foreign language and foreign language patent applications, etc. (including a case where the wording of a phrase is changed with Article 184duodecies(2) and a case where mutatis mutandis is applied with Article 184vicies(6)).

4. Materials that can be submitted

The information provider can submit "documents" for the purpose of certifying that the information that he/she intends to submit is right. The "documents" that can be submitted include publications, a copy of descriptions, claims of the patent or utility models registration or drawings, attached to a request for a patent application or an application for a utility model registration, and certificate such as experimental report. Objects not applicable to the "document", such as a videotape recording an operation of a device, cannot be submitted.

Cases where "documents" other than publications, a copy of descriptions, claims or drawings of the patent or utility model registration, attached to a request for a patent application or an application for a utility model registration, are submitted are described below.

(1) Cases where information that the claimed invention of the subject application is an invention that was made publicly available through an electric telecommunication line is provided, and contents of electronic technical information on the Internet and the like, indicating that the invention was made publicly available through an electric telecommunication line prior to the filing are printed out and submitted

In this case, the submitted printout of information is required to include an address where the information is acquired and contact info for inquiries related to the information together with contents of the information, indication of a published date of the information. At that time, it is preferred that certificate by a person having authority or responsibility for its publication, preservation, and the like is attached with respect

to the information. (See 3.1.2 in "Part III Chapter 2 Section 3 Procedure of Determining Novelty and Inventive Step" of "Examination Guidelines")

- (2) Cases where information that the claimed invention of the subject application is the publicly known invention is provided, and a manuscript for a lecture or the like showing that the invention is explained in a lecture or an explanatory meeting or the like prior to the filing is submitted
- (3) Cases where information that the claimed invention of the subject application is the publicly worked invention is provided, and a document that states a mechanical apparatus, system, and the like related to the invention worked in a situation that is or may be publicly known prior to the filing is submitted
- (4) Cases where information that no detailed description of the invention is stated so that a person skilled in the art can work the claimed invention of the subject application, and an experimental report or the like for explaining it is submitted
- (5) Cases where information that matters described in description, claims or drawings attached to a request of the subject application are not in a range of matters described in an original language text (including new matter as to the original text), and for the purpose of explaining it, certificate that describes proper translation of the corresponding part and, if needed, a copy of a technical term dictionary or the like for clarifying that the description of description, claims or drawings is mistranslated is submitted
- (6) Cases where, when the subject application includes description for specifying a product by an action, a function, characteristics, or properties, information that claims of the subject application goes against Article 36(6)(ii) because the action, characteristics, and the like are not commonly used by a person skilled in the art, and its definition or its test/measurement process cannot be understood by a person skilled in the art, or that the claimed invention is an invention disclosed in a publication distributed prior to the filing, and an experimental report or the like is submitted for the purpose of explaining it

5. Dealing with the submitted information

The examiner confirms the contents of the provided information basically, and utilizes it effectively in examination.

6. Dealing with a case where the submitted material is a document other than a copy of descriptions, claims or drawing of a patent or utility model registration attached to a request for a patent application or an application for utility models registration, or publications

Only when existence of a fact to be certificated by the submitted document is convinced without an examination of evidence (an examination of a witness, an inspection, an examination of a party concerned, an expert testimony and a documentary evidence) for the provided information and the submitted material, the document is adopted to examine the presence or absence of the reasons for refusal. In a case where it is recognized that there are the reasons of refusal, the examiner notifies the reasons of refusal.

In a case where the applicant opposes to the existence of the fact by means of a written opinion and the like to a notice of reasons for refusal, and where it is recognized that an examination of evidence is required for judging that decision of refusal is just due to the reasons for refusal on the ground of the fact found on the basis of the submitted document, the examiner does not make decision of refusal on the ground of the reasons for refusal.

(Explanation)

According to the Patent Act, because there is no provision of examination of evidence in examination of patent application, it is interpreted that the examination of evidence cannot be conducted in examination of patent application. Accordingly, even in a case where examination of patent application is conducted on the basis of the provided information and submitted material in the submission of information by third parties, the examiner does not make examination of evidence. Therefore, in a case where conviction about the existence of the fact to be certificated by the submitted material cannot be formed unless the examination of evidence for the submitted material is conducted, and therefore, conviction that there are the reasons for refusal cannot be formed, the examiner cannot adopt the submitted material to issue a notice of reasons for refusal.

On the other hand, the examination of application takes a principle of examination of evidence by ex officio, and existence or non-existence of the reasons for refusal is ex-officio investigation matters. Therefore, in a case where information is submitted, the examiner is required to make examination within a range of ex-officio detection that is normally conducted in the examination of patent applications. Accordingly, in a case where conviction that there are reasons of refusal can be formed without examination of evidence on the basis of the provided information and the submitted material, it is proper that the examiner issues a notice of reasons for refusal based

on above matter, from a view point of stable grant of right.

Here, even in a case where a notice of reasons for refusal based on the submission of information is issued, similar to a case of the ordinary notice of reasons for refusal, the examiner is required to examine again whether or not the decision of refusal is proper on the basis of the reasons for refusal in consideration of subsequent counterargument of the applicant. In a case where it is recognized that conviction formation by examination of evidence is required for proper decision of refusal as a result of the consideration of the counterargument of the applicant, and the like, conducting the decision of refusal without examination of evidence is not proper. However, because the examination of evidence cannot be conducted in examination of the patent application, in the final analysis, the examiner cannot make the decision of refusal in the above case.

It goes without saying that the examination similar to the examination of evidence within a range of ex officio detection normally conducted in the examination of patent applications, such as inquiry to the National Diet Library about reception date of the publications, and inquiries to government and municipal offices about truth or falsehood of official documents, and the like, can be conducted.

7. Feedback to information provider

The examiner feeds back a utilization situation of the provided information at the information provider's wish (a wish of feedback is stated in a column of [Reasons for Submission] of an information statement).

The examiner prepares the "Notice to Submission of Information" using the designated form and submits it to the Coordination Division via electronic media. The Coordination Division incorporates the data as an internal document, and then, mails it to the information provider in sealed covers.

(Points to Note at Entry)

- (1) An address and a name of the information provider (or of a representative if exists) are described in a destination column.
- (2) In a case where an address and a name are omitted and an identification number is stated in the information statement, the address and the name are looked up from the identification number and entered. In this case, the address and the name can be confirmed by inputting the identification number from "Work Common Menu"→"Inquiry Work"→"Requester Registration Inquiry".

Form of the “Notice to Submission of Information”
(Feedback about Submission of Information)

〒 〇〇〇 - 〇〇〇〇

情報提供者（代理人がいる場合には代理人）の住所

情報提供者（代理人がいる場合には代理人）の氏名・名称 様

情報提供に対するお知らせ

作成日 クリックで日付を入力

特許庁審査官 審査官名（官補の場合は指導官名） （審査官（補）コード）

特願 〇〇〇〇 - 〇〇〇〇〇〇 号（特開 〇〇〇〇 - 〇〇〇〇〇〇 号公報）に対して情報提供をしていただきありがとうございました。検討の結果、いただきました情報は、

アイテムを選択してください。

アイテムを選択してください

審査に利用しました

審査に利用しませんでした

既に審査に利用していました

（※）「審査に利用」とは、審査官が拒絶理由通知・補正却下の決定・前置報告などを作成する際にその情報を利用したことを言います。

[備考]

8. Notification to the applicant

The patent applicant is notified of the fact that information is submitted.

9. Public perusal of the submitted information

The submitted information is made available for public perusal. However, for the submission of information made anonymously, information related to identifying the submitter shall not be available for public perusal or inquiry.

10. Opportunities of clarification, interview, and the like for the information provider, related to the information

Since the information provider is not a party concerned in examination of the patent application, it is not recognized that the examiner and the information provider contact each other by an interview and the like for the purpose of clarification related to the information, explanation about propriety of patent for the subject application, and the like. In addition, the information submitter cannot be a person whom the examiner demands submission of the document and the like, according to Article 194(1) of the Patent Act.

11. Dealing with information that becomes available for examiner after final decision

Even for information submitted before the registration of establishment of patent right, the examiner does not take into account information that becomes available for the examiner after the decision to grant a patent. In addition, even for information submitted before decision of refusal is fixed, the examiner does not take into account the submission of information that becomes available for the examiner after decision of refusal (However, this rule does not apply to a case of pendency to reconsideration by examiners before appeal proceedings after the information becomes available for the examiner).

1203 Examination When Utilizing the Search Result, etc. of Japan Patent Office as International Authority, Foreign Patent Office and Registered Search Organizations

The examiner effectively utilizes the search result or preliminary examination result of Japan Patent Office as the International Searching Authority and International Preliminary Examining Authority, and the search result or examination result of foreign patent office or the search result of registered search organizations (hereinafter referred to as the "search result, etc. of Japan Patent Office, foreign patent office or registered search organizations"). If determining, based on the examiner's knowledge and experience, that the examiner can make examination appropriately and effectively according to the search result, etc. of Japan Patent Office, foreign patent office or registered search organizations, the examiner is not required to make prior art search. When making prior art search additionally, the examiner is required to exclude the scope of the search that has already been made by Japan Patent Office, the foreign patent office or registered search organizations from the scope of search, unless it is highly possible that more significant prior art documents would be found within the scope of the search made by Japan Patent Office, the foreign patent office or registered search organizations.

1204 Record of Search Results of Prior Art Documents

1. Technical field(s) to be searched

When a reason for refusal is to be notified after first prior art search, the technical field(s) to be searched (stated in accordance with the international patent classification, etc.) should be stated in the "Record of the search results of prior art documents" section. (See 3.2 in "Part I Chapter 2 Section 2 Prior Art Search and Determination of Novelty, Inventive step, etc." of the Examination Guidelines)

- (1) The "Technical Field(s) to be searched" is generally stated in accordance with the International Patent Classification (IPC).
- (2) Where the prior art has been searched in the course of the examination, the relevant "Technical Field(s) to be searched" should be stated even when any cited document or prior art document to be stated was not found.
- (3) Where commercial database was used and information considered to be useful for the applicant, etc. has been found, the name of the commercial database is to be stated (e.g., CA (STN)).
- (4) IPC codes do not need to be stated for technical fields for which search is conducted using only international universal commercial database and it is difficult to state the "Technical Field(s) to be searched" using the IPC codes.

2. Prior art document(s)

When there is prior art that does not constitute the reasons for refusal but is considered to be useful for amendment by an applicant, etc. or when new prior art information is added in drafting a decision to grant a patent, information on the documents can also be stated in the record in view of the disclosure of the documents. (See 3.2 in "Part I Chapter 2 Section 2 Prior Art Search and Determination of Novelty, Inventive step, etc." of the Examination Guidelines)

Notice of Reason for Refusal

Application Number	JP XXXX-XXXXXX	
Drafting Date	(YY/MM/DD)	
Examiner in Charge	(examiner's name)	XXXX XX
Patent Attorney	(attorney's name)	
Article(s) Applied	Article 29(1)(iii)	(Novelty)

This application should be refused for the following reasons. If having any opinion on the refusal, the applicant may submit the written opinion within sixty (60) days from the sending of the notice.

Reason

1. (Novelty) The invention(s) defined in the following claim(s) of this application is/are disclosed in the publication(s) listed below, which was/were distributed in Japan or in a foreign country, or made available to the public through electric telecommunication line prior to filing of this application, and thus unpatentable under Article 29(1)(iii) of the Patent Act.

Notes (Regarding cited documents etc., see the list thereof shown below.)

- Claim 1
- Cited Document 1
- Remark

<List of Cited Documents, etc.>

1. JP SXX-XXXXXXA

<Record of the search results of prior art documents>

- | | |
|-------------------------------------|--|
| · Technical field(s) to be searched | IPC B43K 8/00 to 8/24 |
| | Database Name |
| · Prior art document(s) | JP HXX-XXXXXX |
| | (The point "B" stated in paragraph xxxx, line xx of the description in the detailed description of the invention of this application is stated in page xx, column xx, line xx of this document.) |

This record of the result of prior art search is not a component of the reason(s) for refusal.

For any inquiry including about the content of this notice of reason for refusal or request for an interview, please contact us at the number below. Should Applicant wish to send a proposed amendment, etc., please notify us in advance.

When contacting us by e-mail, please include your name, affiliation, application number, telephone number and the name of the examiner (assistant examiner) and send to the e-mail address (*) below. If any uncertainty about the content of the e-mail communication arises, we may confirm it by telephone.

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

* ●●●●●@jpo.go.jp (replace "●●●●●" above with "PAxxx")

1205 Patent Application to be Refused

A patent application shall be refused where it falls under any one of the following (Article 49) (See Table. 2 in 1101 of this Examination Handbook, concerning the List of reasons for refusal related to the Examination Guidelines).

[Reasons according to Article 49(i)]

1. Amendment adding new matter

This is a case where the amendment of the description, claims or drawings originally attached to the application does not comply with requirement as provided for in Article 17bis (3) of the Patent Act.

(This is applicable to applications filed on or after July 1, 1995. It should be noted that Article 17 (2) of the Act as revised in 1993 (including the cases where it is applied mutatis mutandis pursuant to Article 17bis (2)) is applied to applications filed from January 1, 1994 to June 30, 1995.)

2. Amendment changing special technical feature of an invention

This is a case where the amendment made to the claims does not comply with the requirements as provided for in Article 17bis (4) of the Patent Act.

(This is applicable to applications filed on or after April 1, 2007.)

[Reasons according to Article 49(ii)]

3. Enjoyment of rights by foreign nationals

This is a case where the applicant is a foreign national not domiciled or resident (or, in the case of a juridical person, with a business office) in Japan and may not enjoy a patent right under provisions of Article 25 of the Patent Act.

4. Eligibility for Patent

This is a case where the claimed invention is not an invention as defined in the first sentence of Article 29(1) of the Patent Act.

5. Industrial Applicability

This is a case where the claimed invention is not an industrially applicable

invention as defined in the first sentence of Article 29(1) of the Patent Act.

6. Novelty

This is a case where the claimed invention is not an invention that has novelty as provided for in each of the items of Article 29(1) of the Patent Act.

(With regard to applications filed on or after January 1, 2000, a reason for refusal is also raised against an invention publicly known in a foreign country (item (i)), publicly worked in a foreign country (item (ii)), or made publicly available through an electric telecommunication line (item (iii)).)

7. Inventive step

This is a case where the claimed invention is an invention that does not have an inventive step under Article 29(2) of the Patent Act.

8. Secret prior art

This is a case where the claimed invention is an unpatentable invention under the provisions of Article 29bis.

(With regard to applications filed on or after July 1, 1995, the range of matters stated in the foreign language document has the prior-art effect under this article with respect to a foreign language written application. Likewise, the range of matters stated in the description, etc. of the international application as of the international filing date has the prior-art effect under this article with respect to a patent application in foreign language under the Patent Cooperation Treaty (only those for which translations of the description and claims are submitted).

9. Unpatentable ground

This is a case where the claimed invention falls under Article 32.

10. Joint application

This is a case where the right to obtain a patent is jointly owned but the patent application is not filed by all the joint owners (Article 38).

11. Prior application

(1) Between patent applications filed on different dates

This is a case where two or more patent applications claiming identical inventions have been filed on different dates (including a case where they are filed by the same applicant) and the patent application concerned is not the one that has been filed on the earliest date (Article 39(1)) shall be not entitled to obtain a patent for the invention claimed.

(2) Between patent applications filed on the same date

This is a case where two or more patent applications claiming identical inventions have been filed on the same date (including a case where they are filed by the same applicant) and no agreement is reached by consultations or consultations are unable to be held by the applicants (Article 39(2)).

(3) Patent application and application for utility model registration filed on different dates

This is a case where an invention claimed in a patent application and a device claimed in an application for utility model registration are identical and the patent applications and the utility model registration are filed on different dates (including a case where they are filed by the same applicant), and the patent application is filed after the application for utility model registration (Article 39(3)).

(4) Patent application and application for utility model registration filed on the same date

This is a case where an invention claimed in a patent application and a device claimed in an application for utility model registration filed on the same date are identical (including a case where they are filed by the same applicant) and no agreement is reached by consultations or consultations are unable to be held by the applicants (Article 39(4)).

(Where examination is conducted for an application filed on or after January 1, 1999, applications waived and applications for which the examiner's decision or trial decision to the effect that a patent application is to be refused, in addition to applications withdrawn or dismissed, are deemed never to have been filed in the application of the first-to-file rule, and thus these applications are not treated as prior applications. However, as an exception to this rule, the following applications are treated as the prior application in the application of the first-to-file rule (in other

words, they retain the status of prior application): applications for which the examiner's decision or trial decision to the effect that the patent application is to be refused has become final and binding because of the failure to reach an agreement for applications of the same invention on the same date (Article 39(5))

Also, with regard to applications filed on or after April 1, 2012, a usurped patent application also has the status of a prior application under the first-to-file rule.)

[Reason according to Article 49(iii)]

12. Violation of treaty

This is a case where the claimed invention is not patentable under the provisions of any relevant treaty.

[Reasons according to Article 49(iv)]

13. Description requirement

This is a case where the patent application does not comply with the requirements for claims and description, etc. as provided for in Article 36(4)(i) or Article 36(6).

14. Unity of invention

This is a case where the patent application does not comply with the requirement under Article 37 of the Patent Act.

(With regard to applications filed on or after January 1, 2004, the provision of the unity of invention has been revised to be in line with the unity of invention under the Patent Cooperation Treaty.)

[Reason according to Article 49(v)]

15. Requirements for disclosure of information on prior art documents

This is a case where the notice under Article 48septies has been given but the patent application yet fails to comply with the requirement under Article 36(4)(ii) in spite of an amendment made to the description or submission of a written opinion.

[Reason according to Article 49(vi)]

16. New matter s to beyond translation

This is a case where the patent application is a foreign language written

application and the matters stated in the description, etc. originally attached to the application is not within the scope of matters stated in the foreign language documents.

This also applies to a case where the claimed invention is a patent application in foreign language, etc. and the matters stated in the description, etc. originally attached to the written application for the patent application do not remain within the scope of matters stated in the description, etc. of the international application as of the international filing date (184octodecies).

[Reason according to Article 49(vii)]

17. Usurped patent application

This is a case where the applicant for the patent does not have the right to obtain a patent for the invention.

See the Examination Guidelines, etc. for applicability of the above laws and regulations (See Table. 1 in 1101 of this Examination Handbook, concerning the timing of the application of the Examination Guidelines)

1206 Specification of the Claim in which the Reasons for Refusal Have Not Been Found

In cases where the examiner issues the notice of reasons for refusal concerning the application including the claim in which the reasons for refusal have not been found, the examiner specifies the claim in which the reasons for refusal have not been found, in the following manner.

1. Basic ideas

The specification of the claim in which the reasons for refusal have not been found is made, in order to express more clearly, the intention of the examiner for such claims and to make it easy for the applicant to treat (especially, treatment by means of deletion of those other than such claims) the notice of reasons for refusal.

In accordance with above purpose, in cases where, if the claim is only stated in claims, the examiner has not found the reasons for refusal at this point, such claim is considered as "the claim in which the reasons for refusal have not been found." That is, in cases where the reasons for refusal at the point can be resolved only by the amendment deleting that other than such claim, the examiner specifies the claim as "the claim in which the reasons for refusal have not been found."

2. Methods for describing the additional remark

The following example of sentence (beforehand described in examples of general sentences of Articles) is prepared in examples of general sentences of the business systems for examination of patent and utility model. In () of "Claim ()" of the following example of sentence, the examiner adds number of claim in which the reasons for refusal have not been found.

If not describing the additional remark pertaining to the claim in which the reasons for refusal have not been found, the examiner deletes this example of sentence.
(Example of sentence)

<The claim in which the reasons for refusal have not been found>

Concerning the invention pertaining to Claim (), at this point, the reasons for refusal have not been found. In cases where the reasons for refusal are newly found, the reasons for refusal will be notified.

3. Examples

[Case 1] (Cases where there is lack of inventive step in part of claims)

There are two claims. The lack of inventive step has been found in Claim 1, but the other reasons for refusal have not been found in Claim 1.

[Handling of the additional remark]

It falls under the cases where, if Claim 2 is only stated in claims, the reasons for refusal have not been found. Therefore, the examiner specifies Claim 2 as the claim in which the reasons for refusal have not been found.

[Case 2] (In case of violation on enablement requirements)

There are two claims. Enablement requirements are violated, but the other reasons for refusal have not been found.

[Handling of the additional remark]

If there is violation on enablement requirements concerning all claimed inventions (in this case, Claim 1 and Claim 2), regardless of whether either claim is independently stated, it falls under the cases where the reasons for refusal due to violation on enablement requirements exist. Therefore, the examiner does not specify the claim in which the reasons for refusal have not been found.

On the other hand, when the invention pertaining to Claim 1, for example, does not satisfy the enablement requirements, but the invention pertaining to Claim 2 satisfies the enablement requirements, it falls under the cases where, if Claim 2 is only stated in claims, the reasons for refusal have not been found. Therefore, the examiner specifies Claim 2 as the claim in which the reasons for refusal have not been found.

[Case 3] (Cases where new matters have been added)

There are two claims. New matters have been added to the description.

[Handling of the additional remark]

Since the reasons for refusal due to the addition of new matters beyond the description exist, regardless of whether either claim is independently stated in the claims, the examiner does not specify the claim in which the reasons for refusal have not been found.

Furthermore, when new matters have been only added to Claim 1 and new matters have not been added to Claim 2 and to the description, it falls under the cases where, if Claim 2 is only stated in claims, the reasons for refusal have not been found. Therefore, the examiner specifies Claim 2 as the claim in which the reasons for refusal have not been found.

[Case 4] (Cases where there is lack of unity and also there is lack of inventive step in part of claims)

There are three claims. The lack of unity exists between Claim 1, 2 and Claim 3. The reasons for refusal due to the lack of inventive step have been found in Claim 1. [Handling of the additional remark]

It falls under the cases where, if Claim 2 is only stated in claims, the reasons for refusal have not been found. Therefore, the examiner specifies Claim 2 as the claim in which the reasons for refusal have not been found.

Furthermore, the examiner states, in the statements of the reasons for refusal due to the lack of unity, the matter to the effect that Claim 3 has not been examined on novelty, etc. due to the lack of unity.

4. Points to note

(1) The additional remark is described in both the non-final notice of reasons for refusal and the final notice of reasons for refusal.

In view of the purpose of this policy of expressing clearly the intention of the examiner to the applicant or agent and making it easy for them to treat the notice of reasons for refusal, the examiner specifies, according to above manner, the claim in which the reasons for refusal have not been found in both the non-final notice of reasons for refusal and the final notice of reasons for refusal.

(2) Characteristics of the additional remark for specifying the claim in which the reasons for refusal have not been found

Examination Departments uniformly state, in the notice of reasons for refusal, the additional remark for specifying the claim in which the reasons for refusal have not been found, but such remark is not the reason for refusal and also does not constitute the matter to be stated which has legal effect.

When examining the cases with inconsistency between the claims specified in the additional remark and the statements of the reasons for refusal, the examiner takes appropriate measures for each individual case, in consideration of the statements of the notice of reasons for refusal or the applicant's assertion in the written opinion or the like.

When comprehensively determining on the applicant's assertion in the written opinion, etc., if it is clear that the applicant recognizes the correctness of the statements of the main text of the notice of reasons for refusal, the examiner proceeds with examination according to the statements of the main text of the notice of reasons for refusal. On the other hand, if it is not clear whether the applicant recognizes the correctness of the statements of the main text of the notice of reasons for refusal, the examiner takes appropriate measures, including re-issuance of the same effect of the notice of reasons for refusal, so as not to make a surprise attack on the applicant

concerning the reasons for refusal or the decision of refusal.

(3) Cases including the reasons for refusal which cannot be determined on a claim basis

To be specific, in cases where the reasons for refusal (Note) due to the errors in all the description or the addition of new matters or the like exist which cannot be determined on a claim basis, the examiner does not specify the claim in which the reasons for refusal have not been found.

(Note) See 4. in "Part I Chapter 2 Section 3 Notice of Reasons for Refusal" of the Examination Guidelines

(4) Points to note, concerning the claims in a form of citation

Concerning the claims in a form of citation, the examiner also determines whether the claims constitute the claim in which the reasons for refusal have not been found, according to "1. Basic ideas."

To be specific, it should be noted that, in cases where the reasons for refusal due to violation on clarity or due to the addition of new matters exist in the invention pertaining to the claims in an independent form, the similar reasons for refusal often exist in the claims in a form of citation.

(5) Points to note, concerning the claims which refer to any claims in violation of Article 24ter(v) of the Ordinance for Enforcement of the Patent Act

Concerning an invention pertaining to claims which refer to any claims in violation of Article 24ter(v) of the Ordinance for Enforcement of the Patent Act, it is excluded from a subject of examination as to novelty, inventive step, and others despite no reasons for refusal under Article 36(6)(iv) of the Patent Act based on Article 24ter(v) of the Ordinance for Enforcement of the Patent Act (Note). Specification of "the claim in which the reasons for refusal have not been found" is conducted for the purpose of making it easier to respond to a notice of reasons for refusal. Therefore, the examiner does not specify the claim that has not been subject to examination as "the claim in which the reasons for refusal have not been found".

(Note) See 2.2 in "Part II, Chapter 2, Section 5 Ministerial Ordinance Requirements for Statement of Claims" of the Examination Guidelines

5. Example of the Additional Remark in the Notice for Reasons for Refusal

See

Notice of Reason for Refusal

Application Number JP XXXX-XXXXXX
Drafting Date (YY/MM/DD)
Examiner in Charge (examiner's name) XXXX XX
Patent Attorney (attorney's name)
Article(s) Applied Article 29(2) (Inventive step)

This application should be refused for the following reasons. If having any opinion on the refusal, the applicant may submit the written opinion within sixty (60) days from the sending of the notice.

Reason

1. (Inventive step) Since the following claimed invention in this application has been easily invented by a person skilled in the art to which the invention belongs before filing, based on the invention stated in the following publications issued in Japan or a foreign country or based on the invention made available to the public through electronic communication network before filing, the following claimed invention is not patented under Article 29(2) of the Patent Act.

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

- Claim 1, 4
- Cited Document 1, 2
- Remark

<The claim in which the reasons for refusal have not been found>

Concerning the inventions pertaining to Claim (2, 3, 5-7), at this point, the reasons for refusal have not been found. In cases where the reasons for refusal are newly found, the reasons for refusal will be notified.

<List of the cited document, etc.>

1. JP SXX-XXXXXXA
2. JP HXX-XXXXXXA

<Record of the result of prior art searches>

· Technical field(s) to be searched IPC B43K 8/00 to 8/24
Database Name
· Prior art document(s) JP HXX-XXXXXX
(The point "B" stated in paragraph xxxx, line xx of the description in the detailed description of the invention of this application is stated in page xx, column xx, line xx of this document.)

This record of the result of prior art search is not a component of the reason(s) for refusal.

For any inquiry including about the content of this notice of reason for refusal or request for an interview, please contact us at the number below. Should Applicant wish to send a proposed amendment, etc., please notify us in advance.

When contacting us by e-mail, please include your name, affiliation, application number, telephone number and the name of the examiner (assistant examiner) and send to the e-mail address (*) below. If any uncertainty about the content of the e-mail communication arises, we may confirm it by telephone.

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

* ●●●●@jpo.go.jp (replace "●●●●" above with "PAxxx")

1207 Manners to Be Stated in the Publications, etc. Which is Cited in the Reasons for Refusal of the Patent Application

In cases where the examiner cites publications, etc. in the reasons for refusal of the patent application, manners of statements concerning publications, etc. are as follows^{1,2}.

1. Publication of national patent application, utility model application, etc.³ (Examples of statements)

(1) Case of the description of the patented invention or publication of registered utility model (issued before the year of 1956)

A. The description of Japanese Patent No. XXXXXXXX

B. Publication of Registered Utility Model No. XXXXXXXX

(2) Case of publication of registered utility model based on the new act of utility model which came into force on the date of 1 January, 1994

Publication of Registered Utility Model No. 3XXXXXXX

(3) Case of gazette containing the patent or utility model of the application of the decision to grant a patent or decision of registration which has made on or after the date of 1 January, 1996

A. Japanese Patent No. XXXXXXXX

B. Publication of Utility Model Registration No. XXXXXXXX

(4) Case of publication of examined patent application or utility model application (Publication of examined application)

A. Publication of Examined Patent Application S No. XX - XXXXXXXX

B. Publication of Examined Utility Model Application S No. XX - XXXXXXXX

C. Publication of Examined Patent Application H No. XX - XXXXXXXX

D. Publication of Examined Utility Model Application H No. XX - XXXXXXXX

However, in case of Publication of Examined Utility Application in 1922 and 1923

¹ Regarding the number part, statements should, in principle, be listed in accordance with those in the publications.

² Not only should publications be cited in the reasons for refusal, but the same manners also apply when listing referenced documents. The relevant documents include notices of reasons for refusal, decisions to grant a patent, decisions of refusal, decisions to dismiss amendments, and reconsideration reports of reconsideration by examiners prior to appeal proceedings.

³ Since all publications (including Publications of Registered Utility Model that have been issued on or after the date of 5 January, 2006 and Publications of Registered Design that have been issued on or after the date of 5 January, 2007) including patent, utility model, etc. issued on or after the date of 1 April, 2015 are issued by using internet, when citing such publications in the reasons for refusal, etc., the term “publication” is not used for such publications (the terms “citation,” “cited document,” etc. are used).

E. Publication of Examined Utility Model Application No. XXXXXX (Year of 1922)

F. Publication of Examined Utility Model Application No. XXXXXX (Year of 1923)

In case of Publication of Examined Utility Model during the period of Taisyou after the year of 1924,

G. Publication of Examined Utility Model Application No. XXXXXX in Taisyou XX

(5) Case of publication of unexamined patent application or unexamined utility model application

A. JP SXX - XXXXXXXA

B. JP HXX - XXXXXXXA

C. JP 20XX - XXXXXXXA

D. JP SXX - XXXXXXXU (*)

E. JP HXX - XXXXXXXU (*)

F. JP 20XX - XXXXXXXU (*)

* Points to Note

Even if it is sufficient to cite only Publication of Unexamined Utility Model Applications, it is requested to cite full text of the description, including microfilm and CD-ROM, to the examiner's best ability (See below (7)), so that, afterward, the examiner is not required to notify the reasons of refusal again.

(6) In case of published Japanese translations of PCT international publication for patent application or utility model application

A. National Publication of International Patent Application S No. XX - XXXXXX

B. National Publication of International Patent Application H No. XX - XXXXXX

C. National Publication of International Patent Application No. 20XX - XXXXXX

D. National Publication of International Utility Model Application S No. XX - XXXXXX

E. National Publication of International Utility Model Application H No. XX - XXXXXX

F. National Publication of International Utility Model Application No. 20XX - XXXXXX

(7) Case of the description, etc. in full text of Japanese utility model applications based on the former act of utility model on or before the date of 31 December, 1993

<Issued on or before the date of 7 January, 1993>

Microfilm that records the contents of the description and drawings attached to the request of Japanese Utility Model Application H No. 02 - XXXXXX (JP H 03 - XXXXXXXU) (issued by Japanese Patent Office on the date of Xday Xmonth, 1991), or

Microfilm of Japanese Utility Model Application H No. 02 - XXXXXX (JP

H03 - XXXXXXXU)

<Issued on or after the date of 8 January, 1993>

CD-ROM that stores the contents of the description and drawings originally attached to the request of Japanese Utility Model application H No. 05 - XXXXXXX (JP H06 - XXXXXXXU) (issued by Japanese Patent Office on the date of Xday Xmonth, 1994), or

CD-ROM of Japanese Utility Model Application H No. 05 - XXXXXXX (JP H06 - XXXXXXXU)

<Issued on or after the date of 8 January, 2004>

JP 2004 - XXXXXXXU

(8) Case of design bulletin

Publication of Design Registration No. XXXXXXXX

Publication of Similar Design Registration of Design Registration No. XXXXXX
X_X

2. The Description and the Abstract of the Description, etc., of the Patent Applications of Foreign Intellectual Property Offices and International Organizations (Examples of Statements)

(1) World Intellectual Property Organization

The expression when citing in the reasons for refusal of the patent application	Types of documents
International Publication No. WOXX/XXXXXX	(WO, A1)
International Publication No. WO20XX/XXXXXX ⁴	(WO, A2)
The Search Report of International Publication No. WOXX/XXXXXX The Search Report of International Publication No. WO20XX/XXXXXX	(WO, A3)
International Publication No. WOXX/XXXXXX(A4) International Publication No. WO20XX/XXXXXX(A4)	(WO, A4)
International Publication No. WOXX/XXXXXX(A8) International Publication No. WO20XX/XXXXXX(A8)	(WO, A8)
International Publication No. WOXX/XXXXXX(A9) International Publication No. WO20XX/XXXXXX(A9)	(WO, A9)

⁴ Since the international publications issued on or after the date of 1 April, 2006 have been issued by using internet, when citing such publications in the reasons for refusal, etc., the term “publication” is not used for such publications (the terms such as “citation,” “cited document” are used).

(2) USA

The expression when citing in the reasons for refusal of the patent application	Types of documents
The description of US Publication of Unexamined Patent Application No. 20XX/XXXXXX	(US, A1)
The description of US Patent No. XXXXXXXX	(US, A) (US, B1) (US, B2)
The description of US Reissued Patented Invention No. XXXXXXXX	(US, E)
The description of US Defense Application No. XXXXXXXX	(US, I4)
The description of US Plant Patented Invention No. XXXXXXXX	(US, P)
The description of US Design Patented Invention No. XXXXXXXX	(US, S)

(3) European Patent Office

The expression when citing in the reasons for refusal of the patent application	Types of documents
The description of EP Publication of Unexamined Patent Application No. XXXXXXXX	(EP, A1) (EP, A2)
The Search Report of EP Publication of Unexamined Patent Application No. XXXXXXXX	(EP, A3)
The description of EP Patent No. XXXXXXXX	(EP, B1)

(4) Germany⁵

The expression when citing in the reasons for refusal of the patent application	Types of documents
The description of DE (West Germany) Publication of Unexamined Patent Application No. XXXXXXXX	(DE, A)
The description of DE (West Germany) Publication of Unexamined Patent Application No. XXXXXXXXXXXXX	(DE, A1)
The description of DE (Federal Republic of Germany) Publication of Unexamined Patent Application No.	(DE, A1)

⁵ In Germany, the “description of publication of unexamined application” is expressed by “Offenlegungsschrift,” the “description of publication of examined application” is expressed by “Auslegeschrift,” the “description of patent application” is expressed by “Patentschrift,” and the “description of utility model application” is expressed by “Gebrauchsmuster.”

XXXXXXXXXXXXX	
The description of DE (West Germany) Publication of Examined Patent Application No. XXXXXXXXX	(DE, B)
The description of DE (West Germany) Patent No. XXXXXXXXX	(DE, B)
The description of DE (Federal Republic of Germany) Publication of Examined Patent Application No. XXXXXXXXX	(DE, B1) (DE, B2)
The description of DE (Federal Republic of Germany) Patented Invention No. XXXXXXXXX ⁶	(DE, C1) (DE, C2) (DE, C3) (DE, B3)
The description of DE (West Germany) Publication of Unexamined Utility Model Application No. XXXXXXXXX	(DE, U)
The description of DE (Federal Republic of Germany) Utility Model No. XXXXXXXXXXXXX	(DE, U1)
The description of DD (Former East Germany) Economic Patent No. XXXXXX	(DD, A1)

(5) Great Britain

The expression when citing in the reasons for refusal of the patent application	Types of documents
The description of GB Publication of Unexamined Patent Application No. XXXXXXXXX *The number is not less than 2000001	(GB, A)
The description of GB Publication of Examined Patent Application No. XXXXXXXXX *The number is not more than 1605224	(GB, A)
The description of GB Patent No. XXXXXXXXX	(GB, B)
The description of GB Patent Amendment No. XXXXXXXXX	(GB, C)

(6) France

The expression when citing in the reasons for refusal of the patent application	Types of documents
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⁶ When stating the “description of DE Patented Invention No. XXXXXXXXX,” with regard to B3, it is necessary to list the number part in twelve (12) digits (in case of the digits less than twelve (12), make twelve digits by supplementing “0”), and with regard to C1 through C3, it is necessary to list the number part in eight (8) or less digits (same as the statements of publications).

The description of FR Publication of Unexamined Patent Application No. XXXXXXXXX	(FR, A1)
The description of FR Additional Publication of Unexamined Patent Application No. XXXXXXXXX	(FR, A2)
The description of FR Publication of Unexamined Utility Model Certificate No. XXXXXXXXX	(FR, A3)
The description of FR Additional Publication of Unexamined Utility Model Application No. XXXXXXXXX	(FR, A4)
The description of FR Patented Invention No. XXXXXXXXX	(FR, A) (FR, A5) (FR, B) (FR, B1)
The description of FR Additional Patented Invention No. XXXXXXXXX	(FR, B2)
The description of FR Utility Model Certificate Patented Invention No. XXXXXXXXX	(FR, A7) (FR, B3)
The description of FR Additional Utility Model Certificate Patent No. XXXXXXXXX	(FR, B4)
The description of FR Pharmaceutical Special Patent No. XXXX	(FR, M)

(7) China

The expression when citing in the reasons for refusal of the patent application	Types of documents
The description of CN Publication of Unexamined Patent Application No. XXXXXXXX	(CN, A)
The description of CN Patent No. 1XXXXXX *The number has first letter of "1" and is 7 or 9 digits	(CN, B) (CN, C)
The description of CN Utility Model No. XXXXXXXX *The number is 7 or less digits, or has first letter of "2" and is 9 digits	(CN, Y)
The description of CN Utility Model No. 2XXXXXXX *The number has first letter of "2" and is 9 digits	(CN, U)
The description of CN Publication of Examined Patent Application No. XXXXXXXX *The number is 7 or less digits, or has first letter of	(CN, B)

"8" and is 8 digits	
The description of CN Publication of Examined Utility Model Application No. XXXXXXXX *The number is 7 or less digits, or has first letter of "8" and is 8 digits	(CN, U)

(8) The Republic of Korea

The expression when citing in the reasons for refusal of the patent application	Types of documents
KR Publication of Unexamined Disclosed Patent Application No. 10-XXXX-XXXXXXX	(KR, A)
KR Publication of Unexamined Disclosed Patent Application No. XXXX-XXXXXXX	(KR, A)
KR Publication of Patent No. 10-XXXX-XXXXXXX	(KR, B1)
KR Publication of Registered Patent No. 10-XXXXXXX	(KR, B1)
KR Publication of Patent No. XXXX-XXXXXXX	(KR, B1)
KR Publication of Registered Patent No. XXXXXXXX	(KR, B1)
KR Publication of Unexamined Disclosed Utility Model Application No. 20-XXXX-XXXXXXX	(KR, U)
KR Publication of Unexamined Disclosed Utility Model Application No. XXXX-XXXXXXX	(KR, U)
KR Publication of Utility Model No. 20-XXXX-XXXXXXX	(KR, Y1)
KR Publication of Registered Utility Model No. 20-XXXXXXX	(KR, Y1)
KR Publication of Utility Model No. XXXX-XXXXXXX	(KR, Y1)
KR Publication of Registered Utility Model No. XXXXXXXX	(KR, Y1)

(9) Switzerland

The expression when citing in the reasons for refusal of the patent application	Types of documents
The description of CH Patented Invention No. XXXXXXXX	(CH, A) (CH, A5) (CH, B) (CH, B5)
The description of CH Publication of Unexamined	(CH, A3)

Patent Application No. XXXXXXXXX	
The description of CH Publication of Examined Patent Application No. XXXXXXXXX	(CH, A4)

(10) Taiwan

The expression when citing in the reasons for refusal of the patent application	Types of documents
TW Publication of Unexamined Patent Application No. XXXXXXXXX	(TW, A)
TW Patent Publication No. XXXXXX	(TW, B)
TW Patent Publication No. I XXXXXX * The number consists of a leading 'I' followed by six digits.	(TW, B)

(11) Australia

The expression when citing in the reasons for refusal of the patent application	Types of documents
The description of AU Publication of Unexamined Patent Application No. XXXXXXXXXXXX	(AU, A) (AU, A1)
The description of AU Publication of Examined Patent Application No. XXXXXXXXXXXX	(AU, B2)

(12) Canada

The expression when citing in the reasons for refusal of the patent application	Types of documents
The description of CA Publication of Unexamined Patent Application No. XXXXXXXXX	(CA, A1)
The description of CA Patented Invention No. XXXXXXXXX	(CA, C)

(13) The Netherland

The expression when citing in the reasons for refusal of the patent application	Types of documents
The description of NL Publication of Unexamined Patent Application No. XXXXXXXXX	(NL, A)
The description of NL Patented Invention No. XXXXXXXXX	(NL, C)

(14) Austria

The expression when citing in the reasons for refusal of the patent application	Types of documents
The description of AT Patented Invention No. XXXXXXXXX	(AT, B)
The description of AT Utility Model No. XXXXXXXXX	(AT, U1)

(15) Denmark

The expression when citing in the reasons for refusal of the patent application	Types of documents
The description of DK Patented Invention No. XXXXXXXXX	(DK, B1)

(16) Sweden

The expression when citing in the reasons for refusal of the patent application	Types of documents
The description of SE Publication of Unexamined Patent Application No. XXXXXXXX	(SE, A)
The description of SE Patented Invention No. XXXXXXXXX	(SE, C2)

(17) Finland

The expression when citing in the reasons for refusal of the patent application	Types of documents
The description of FI Patented Invention No. XXXXXXXXX	(FI, B)

(18) The Czech Republic

The expression when citing in the reasons for refusal of the patent application	Types of documents
The description of CZ Patented Invention No. XXXXXXXXX	(CZ, B6)

(19) Russia (former Soviet Union)

The expression when citing in the reasons for refusal of the patent application	Types of documents
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The description of SU Patented Invention No. XXXXXXXXXX	(SU, A)
The description of RU Publication of Unexamined Patent Application No. XXXXXXXXX	(RU, A)

(20) Belgium

The expression when citing in the reasons for refusal of the patent application	Types of documents
The description of BE Patented Invention No. XXXXXXX	(BE, A)

(21) Spain

The expression when citing in the reasons for refusal of the patent application	Types of documents
The description of ES Patent for Invention No. XXXXXXXX *The number is 6 digits, or has first letter of "8" and is 7 digits	(ES, A1)
The description of ES Patent for Invention No. XXXXXXXX	(ES, A6)
The description of ES Publication of Unexamined Patent Application No. XXXXXXXX *The number is 7 digits and has search report	(ES, A1)

(22) Poland

The expression when citing in the reasons for refusal of the patent application	Types of documents
The description of PL Patented Invention No. XXXXXXX	(PL, B1)

When citing documents which there are not in above-mentioned examples, it shall conform to WIPO standard (Note) and be transcribed with the form of the code for the representation of states, other entities and intergovernmental organizations indicated in WIPO standard ST.3 + the number given to the document + the code for the identification of different kinds of patent documents indicated in WIPO standard ST.16.

(Code examples of documents conformed to WIPO standard)

TW 554776 U

TW M471126 U

(Note) WIPO Standard (WIPO Standard)

(http://www.wipo.int/standards/en/part_03_standards.html)

3. Patent application etc. cited in Secret Prior Art (Article 29bis of the Patent Act)
(Examples of statements)

It shall transcribe other applications (prior applications) in the form of application numbers (publication numbers).

(1) Cases where the prior application is a patent application and has been published
Patent application No. XXXX-XXXXXX (Published Unexamined Patent Application No. XXXX-XXXX)

(2) Application number for cases where the prior application is an international patent application in Japanese language without claiming priority and has been published
PCT/JP No. XXXX/XXXXXX (International Publication No. XXXX/XXXXXX)

(3) Cases where the prior application is an international patent application in foreign language such as PCT/US No. XXXX/XXXXXX and has been internationally publicized.

PCT/US No. XXXX/XXXXXX (International Publication No. XXXX/XXXXXX, National Publication of International Patent Application No. XXXX-XXXXXX)

(Note)

(Note) As for cases where the prior application is an international patent application in foreign language which shall be required to submit Japanese translations, adding the number of national publication of international patent application is recommended as a purpose of the confirmation. However, if the publication has not been issued when notifying the reason for refusal, the omission of the number thereof is allowable (refer to Article 184terdecies of the Patent Act).

4. Journal of technical disclosure of JIII (the Japan Institute of Invention and Innovation)
(Examples of statements)

(1) Journal of Technical Disclosure of JIII No. XX-XXXXXX

(2) Journal of Technical Disclosure of JIII No. 20XX-XXXXXX

5. Serial publication, Irregular publication, and Catalogue

- (1) Be stated in the order of the name of author, the name of article (the title of article), the name of publication, the country of publication, the name of publisher, the publishing date, the number of volume, the number of issue and the number of pages.
- (2) The name of author and the name of article can be, if not necessary, omitted.
- (3) The name of article may be stated in corner brackets or double quotations.
- (4) The name of publication is, in principle, stated without using abbreviated name.
- (5) The name of publisher can be omitted if there is no fear of misunderstanding.
- (6) The publishing date is stated in the Gregorian calendar. In relation to the filing date or the priority date of the application, if necessary, Month and day are stated. In addition, if the publishing date is unknown, the publishing date may be substituted by the receipt date, but the matter to that effect is clearly stated (e.g., received on 2007-12-1).
- (7) In cases where the number of volume can be substituted by the publishing date, the number of volume can be omitted.
- (8) Pages are stated by adding "p." or "pp.", etc. prior to the number. Total pages are, in principle, stated, and if total pages are not stated, the pages of an issue are stated. When citing multiple pages, if such multiple pages are successively listed, insert a hyphen or a tilde, ('~') between the first page and the final page, and if such multiple pages are discontinuously listed, insert a comma between them.
- (9) The country of publication is stated in brackets. In addition, in cases of the publication issued in Japan, the country of publication is omitted.
- (10) The publication in a foreign language is stated in an original language, in principle.

(Examples of statements)

- (1) INOUE Satoru, "New Movement of Optical Materials - infrared ray transmitting material-", Journal of SPSJ, The Spectroscopical Society of Japan, August 1996, Volume 45, Issue 4, pp.197-202
- (2) TATEMACHI Jyunichi, Other Seven Authors, "Ion Doping System", The Nissin electric review, Nissin Electric Co., Ltd., 7 December 1994, Volume 39, Issue 3, pp.52-58
(Note) Since there is no total page in the book, it is essential that Issue 3 should be listed.
- (3) Electronics, Ohmsha, 1968, Volume 40, Issue 3 pp. 500- 501, p.530
- (4) The Journal of Chemical Physics, (US), 1961, Vol. 34, No. 12, pp. 313-315
- (5) Nucleonics, (US), Mc Graw-Hill Book Company, April 1964, Vol. 22, No. 4, pp. 76-78, p.101

6. Books

- (1) Be stated in the order of the name of author (or the name of editor), the name of publication, the number of edition, the number of volume, the country of publication, the name of publisher, the publishing date, and the number of pages.
- (2) In case of the translation, be stated in the order of the name of original author (or the name of original editor), the name of translator, and the name of publication. In such cases, the name of the original author (or the name of the original editor) is stated first, followed by the name of the translator with the phrase "translated by." (3) In case of series such as lectures or complete works, the name of lectures or complete works and the number of volume of series are stated prior to the name of publication.
- (4) The name of publication is stated in corner brackets or double quotations without abbreviation.
- (5) If not stated in a book, the number of edition is not stated.
- (6) The manner of statements when citing the publishing date, the number of pages, and the country of publication, as well as publications in foreign languages, is equivalent to the case of serials.

(Examples of statements)

- (1) MURAOKA Youichi, "Lectures of University on Computer Science (Volume 11) Computer Architecture", Second edition, Modern Science Co., Ltd., November 1985, pp. 123-127
- (2) J. W. Mellor, "A Comprehensive Treatise on Inorganic and Theoretical Chemistry", Vol. 2, (US), Longmans Green and Co., 1931, p. 341

7. DERWENT abstract journal (issued on or after the date of 11 June 1980)

Be stated in the order of the name of abstract journal, the number of volume and issue, of abstract journal, the publishing date of abstract journal, the country of publication of abstract journal and the name of publisher of abstract journal, the classification of abstract journal (the classification of DERWENT), state-codes of abstract journal and the document number, the name of cited publication.

The name of abstract journal is as follows.

- (1) The classification of DERWENT A~M (chemical field): Basic Abstracts Journal
- (2) The classification of DERWENT P~X (non-chemical field): World Patents Abstracts Journal

8. Electronic technical information⁷

When citing electronic technical information searched through internet and other sources, the bibliographic items of the ascertained electronic technical information are stated in the following order, in the form of citation which shall be according to WIPO Standard ST.14.

- (1) The name of author
- (2) The title of the article (where possible)
- (3) The title of the publications, such as journals, monographs, and published conference proceedings, volume number, page number, index in the database, etc. (where possible)
- (4) Types of media [online]
- (5) The format of publication content in square brackets '[]'
The format of the publication content is stated in square brackets '[]' (e.g., [text], [audio], [video], [multimedia]). However, this element may be omitted for text publications.
- (6) The date of publication (the date of issue), the name of publisher (the name of issuer), and the place of publication (the place of issue)
- (7) The date of retrieval
State in parentheses the date when electronic technical information was retrieved from or searched through electronic media (e.g., [retrieved on 2025-7-30]).
- (8) The source and address of information
State the source of the document (e.g., name of internet platform), followed by the identifier (e.g., URL, Accession No.). If the identifier already specifies the source, the source of the publication may be omitted (e.g., Retrieved from <×× Library, <http://.....>>).
- (9) In cases where the name of author, the title, the name of publisher (the name of issuer), the place of publication (the place of issue), etc. are disclosed in the electronic technical information in a foreign language, the original language name should be stated, in principle.

(Examples of statements: Information obtained from product manuals, catalogs, or websites)

Example 1:

SHINSAKI Jun, Other Three Authors, "Movement of Novel Art", [online], [text], 1

⁷ The term “publication” is not used for the electronic technical information disclosed by using internet (the terms such as “citation,” “cited document” are used) when citing, in the reasons for refusal, etc.

April 1998, the Patent Society, [retrieved on 1999-7-30]. Retrieved from
<URL: [http:// tokkyo.shinsakijun.com/information/newtech.html](http://tokkyo.shinsakijun.com/information/newtech.html)>

Example 2:

Corebuilder 3500 Layer 3 High-function Switch, Datasheet, [online], 3Com Corporation, 1997, [retrieved on 1998-02-24]. Retrieved from
<<http://www.3com.com/products/dsheets/400347.html>>.

(Example of statements: Examples of entries from web pages retrieved from online databases)

Example 3:

DONG, XR, "Analysis of patients of multiple injuries with AIS-ISS and its clinical significance in the evaluation of the emergency managements", Chung Hua Wai Ko Tsa Chih, May 1993, Vol. 31, No. 5, pp. 301-302. (abstract) Medline [online]; United States National Library of Medicine, Bethesda, MD, USA. [retrieved on 1998-2-24] Retrieved from < Dialog Information Services, Palo Alto, CA, USA. Medline Accession no. 94155687, Dialog Accession no. 07736604.>

(Example of entries from web pages archived in the Wayback Machine of the non-profit organization Internet Archive)

Example 4:

World Web Archive, "National Diet Library Internet Resources Collection and Preservation Project", [online], [text], 17 October 2017, [retrieved on 2020-2-21], Retrieved from
<https://web.archive.org/web/20171016190152/http://warp.ndl.go.jp/contents/recommend/world_wa/index.html>

(Reference) In cases where web pages are retrieved from the Wayback Machine, the numeric part of the displayed URL indicates the date and time when the web page became publicly accessible via telecommunications networks. For example, in the URL "https://web.archive.org/web/20130427103728/...", the segment "20130427103728" represents Coordinated Universal Time (UTC) on 27 April 2013, at 10:37:28, which corresponds to Japan Standard Time (JST) on the same day at 19:37:28. This was recognized in the ruling of the Intellectual Property High Court on 24 October 2019 (2018, (Gyo-ke) 10178).

9. Document Produced by a Standards Defining Organization (SDO)⁸

If citing the document produced by a Standards Defining Organization (SDO), state the ascertained bibliographic items of the document produced by the SDO in the following order.

- (1) The name of author
- (2) The title of SOD
- (3) The name of SDO and the unique standard reference number of SDO⁹
- (4) The date of publication
- (5) International Standard Serial Number (ISSN)
- (6) The information to be particularly referenced

If citing the document produced by the SDO retrieved from internet, etc. state the information in addition to above information of "8. Electronic technical information" (refer to the following example of statements).

(Example of statements)

NTT DOCOMO, Power-control mechanisms for dual connectivity [online],
3GPP TSG-RAN WG1#77 R1-142264, 10 May 2014, [retrieved on 2017.03.22].
Retrieved from
<URL:http://www.3gpp.org/ftp/tsg_ran/WG1_RL1/TSGR1_77/Docs//R1-42264.zip>,
pp.1-8

⁸ A general term for various technical documents including the formulated standards, proposed standards to be adopted and the contributions submitted by the members in the process of formulating the technical standard.

⁹ As for the name of the SDO, list the full name or the well-known acronym of the SDO. If available, the name of the relevant conference or working group is also listed. As for the unique standard reference number, list the unique identification number to identify the document used by the SDO, including the id, the version, etc.

1208 Handling in Cases Where a Plurality of Written Amendments etc. were Submitted

1. Where a plurality of amendments are made before the first examination or in designated period in the non-final notice of reasons for refusal

When amendments are made a plurality of times regarding the description etc. before the first examination or in a designated period in the non-final notice of reasons for refusal, the content of a newer amendment is reflected on the description etc.

Accordingly, when a plurality of amendments is made regarding the same portion of the description etc., the content of an amendment finally made on the portion is reflected on the description etc.

2. Where a plurality of amendments is made in designated period in the final notice of reasons for refusal

When amendments are made a plurality of times regarding the description etc. in a designated period in the final notice of reasons for refusal, the content of an amendment satisfying the requirements of Article 17bis(3) to (6) and having a newer content of an amendment is reflected on the description etc.

Accordingly, when a plurality of amendments is made regarding the same portion of the description etc., the content of an amendment satisfying the requirements of Article 17bis(3) to (6) and the content of an amendment finally made on the portion is reflected on the description etc.

When a plurality of amendments is made in a response period to the final notice of reasons for refusal, the Examiner determines whether each amendment should be rejected in accordance with the order on which the amendments are made.

The Examiner determines as follows when it is determined whether the second or later amendment satisfies the requirements of Article 17bis(3) to (6).

(1) Regarding Article 17bis(3), it is determined whether an amendment regarding the description etc. is one adding a new matter using the originally attached description etc. as a standard.

(2) Regarding Article 17bis(4), it is determined whether an amendment made regarding the claims is an amendment that changes a Special Technical Feature of an invention depending on whether the claimed invention after the amendment satisfies the

requirements of unity of invention with all the inventions on which a determination as to whether a patent cannot be granted is made in the notices of reasons for refusal issued so far (Note).

(Note) "The inventions on which a determination as to whether a patent cannot be granted is made in the notices of reasons for refusal" mean the invention on which an examination regarding novelty (Article 29(1)), an inventive step (Article 29(2)), secret prior art (Article 29bis) and earlier application (Article 39) is made.

(3) Regarding Article 17bis(5) and (6), using the description etc. legitimately amended just before the second or later amendment as a standard, whether an amendment made regarding the claims applies to any purpose of each item of Article 17bis(5) is determined, and if the amendment aims at Article 17bis(5)(ii) (restriction in a limited way of the scope of the claims), whether it satisfies the requirement of Article 17bis(6) (requirements for independent patentability) is determined.

1209 Handling in Cases Where There are Errors in the Notice of Reasons for Refusal

Errors are handled as follows in cases where errors have been found in the notice of reasons for refusal which the examiner sent.

1. Cases where errors have been found before the expiration of the prescribed period of the notice of reasons for refusal

The examiner continues the examination upon the agreement, by inviting the applicant or agent (hereinafter referred to as "the applicant, etc.") to respond after interpreting the errors in a correct manner or to point out, in the written opinion, the matter to the effect that the reasons for refusal are not appropriate.

2. Cases where errors have been found after the expiration of the prescribed period of the notice of reasons for refusal.

The examiner issues the notice of reasons for refusal again, regardless of whether the written opinion has been submitted.

However, in the following cases, the examiner is not required to issue the notice of reasons for refusal again.

(1) Cases where the applicant, etc. determines the matters as the errors of statements, and submits the written opinion after interpreting the errors in a correct manner

(2) Cases where the applicant, etc. does not respond to the errors (including the cases where the written opinion has been submitted), and also the errors are slight errors such as mere misuse or omission or the like that hardly affect the reasons which the examiner intends.

When making the decision of refusal in the cases of above (1) and (2), it is preferable to add the clarification of the errors as the remark in the margin of the decision of refusal.

(Explanation)

In cases where there are errors in the notice of reasons for refusal, it does not mean that the examiner has issued the correct reasons for refusal to the applicants, etc., and thus the examiner is required to issue the notice of reasons for refusal again. However, similarly as the cases of above (1) and (2), in cases where it is recognized that the correct reasons for refusal have been already delivered to the applicant, etc., re-issuance of the notice substantially means issuance of the same notice of reasons for refusal, and thus the errors are handled as described in this paragraph.

1210 Points to which Attention Should be Paid when Drafting Decision to Grant a Patent

1. Consultation Prescribed in Article 39(2) and (4) of the Patent Act

Where the result of the consultation is reported¹⁰, and the application of one applicant as selected is decided to grant a patent, the following (1) and (2) is entered, by the examiner, in the "Memorandum of agreeing consultation" in a creation window of "Decision to grant a patent". (Note)

(1) Name or appellation and domicile or residence of the applicant except one patent applicant as selected by the consultation

(2) Name and domicile or residence of the inventor or the designer of the invention or the device of the application of the applicant mentioned in the above-mentioned

(1)Where the patent applicants are also the same, the (1) and (2) shall be entered.

(Note) Article 29 of the Regulations under the Patent Act prescribes that agreement on the consultation must be described in the Patent Gazette.

2. Exceptions to lack of novelty of invention prescribed in Article 30

(1) Cases where the application of exceptions to lack of novelty of invention is recognized

Where to apply the provision of the exception to loss of novelty of invention is recognized to decide to grant a patent concerning the patent application, a fact which is not regarded as a reason for loss of novelty concerning the invention of the patent application is entered by the examiner in the "Fact of application of exceptions to lack of novelty of invention" in the creation window of "Decision to grant a patent".

In addition, in the entering, concerning the application for which the decision to grant a patent is made, it shall be confirmed whether Article 30 of the Patent Act revised on 2011 is applied or Article 30 of the Patent Act prior to the revision is applied¹¹, since the content of each item of Article 30 of the Patent Act revised on 2011, and an appropriate item from items 1 to 3 shall be selected.

¹⁰ Where the result of the consultation is not reported, even if the reasons for refusal under the provision of Article 39(2) or (4) of the Patent Act are overcome by the procedures such as the amendment of the Claims or the withdrawal of the application, it is not necessary to prepare the "Memorandum of agreeing consultation".

¹¹ Refer to "3232 Patent Applications to which Article 30 of the Patent Act as amended in 2018 is Applicable" or "Operational Guidelines for Applicants to Seek the Application of Exceptions to lack of novelty of Invention, corresponding to the Patent Act Article 30 revised in 2011". (https://www.jpo.go.jp/e/faq/yokuaru/document/hatumei_reigai/e_tebiki.pdf).

Example of stating a case for which Article 30 of the Patent Act revised on 2011 is applied

(1) Applied Article 30(1) of the Patent Act, presented against the applicant's will on xx, xx, xxxx)

(2) Applied Article 30(2) of the Patent Act, presented on xxth meeting of xx corporate juridical person held at xx university on xx, xx, xxxx

The point about the above is described in the Patent Gazette.

(Explanation)

If such a measurement is not made to clarify that the above-mentioned fact is not regarded as the reason for loss of novelty concerning the application, a third party who does not know this may file a trial for patent invalidation upon citing the above-mentioned fact. Therefore, it shall be treated as mentioned in the main sentence for preventing to file such a trial for patent invalidation.

(2) Cases where the application of exceptions to lack of novelty of invention is not recognized

a When the examiner makes decision to grant a patent for the patent application without recognizing the application of exceptions to lack of novelty, if the examiner does not indicate even once, in the notice of reasons for refusal or decision of refusal, the reasons why the application of exceptions to lack of novelty is not recognized, the examiner issues the notice (with prescribed period) under the name of the examiner, in advance, concerning the matter to the effect that the examiner makes decision to grant a patent for the patent application without recognizing the application of exceptions to lack of novelty and the reasons why the application of exceptions to lack of novelty is not recognized. The examiner makes decision to grant a patent after the period of one month (in case of residents of Japan) or three months (in case of overseas residents) without entering anything in the "Fact of application of exception to lack of novelty of invention" in the creation window of "Decision to grant a patent". During this period, if the applicant asserts, in the written statement, etc. that the application of exceptions to lack of novelty of invention should be recognized, the examiner makes decision to grant a patent after determining again whether exceptions to lack of novelty of invention should be applied in consideration of the assertion.

Example of statements of above notice

Notice			
Application Number	JP XXXX-XXXXXX		
Drafting Date	(YY/MM/DD)		
Examiner in Charge	XX XX	XXXX	XX
Patent Attorney	XX XX		
<p>If the applicant has any opinion on the following matter, please submit the written statement within XX days from the sending date of this notice.</p> <p style="text-align: center;">Note</p> <p>With regard to the invention for which the applicant seeks the application of the provision of Article 30 (X) of the Patent Act, such provision cannot be applied for the following reason.</p> <p>Since the reasons for refusal have not been found in the application at this point, the examiner makes decision to grant a patent without recognizing the application of such provision, after the period of one month (three months in case of overseas residents) from the sending date of this notice, provided that if the reasons for refusal are newly found, the reasons for refusal will be notified.</p> <p>the invention to which the provision is not applicable</p> <p style="padding-left: 40px;">the invention disclosed on X page of XX Society Journal Volume X Issue X, X publishing (XX year X month X day)</p> <p>Reason</p> <p>....(For example, state the reasons why the examiner has determined that the application did not satisfy 2.1 "(Requirement 2) The invention was disclosed resulting from an action of the right holder, and the right holder filed a patent application" of the Examination Guidelines "Part III Chapter 2 Section 5 Exceptions to lack of novelty of Invention")</p> <p>For the application of such provision, the applicant is expected to assert the "fact of successions or the like of the right to obtain a patent" in the written statement, to the extent that the examiner can understand the fact that invention was disclosed resulting from an action of the right holder, and the right holder filed a patent application.</p> <hr style="border: 0.5px solid black; margin: 10px 0;"/> <p>For any inquiry including an interview request regarding this notice, please contact us at the number below. Should the applicant wish to transmit a proposed amendment via e-mail, please notify us by phone in advance.</p> <p style="text-align: center;">Examination Department of X XX Division (PA XX) The Name of examiner TEL. 03 - 3581 - 1101 extension</p>			

b When the examiner makes decision to grant a patent for the patent application without recognizing the application of exceptions to lack of novelty, if the examiner has indicated, in the notice of reasons for refusal or decision of refusal, the reasons why the application of exceptions to lack of novelty was not recognized, the examiner promptly makes decision to grant a patent without entering anything in the "Fact of application of exception to lack of novelty of invention" in the creation window of "Decision to grant a patent".

3. Deposition of microorganism

Where there is an accession number provided for the deposition of the microorganism, the examiner enters its accession organization and accession number in the "microorganism deposition" in the creation window of "Decision to grant a patent."

4. Handling a case in which the name of invention or the name and the like of the applicant is long

Number of characters which can be displayed in the column of the name of invention and the columns of the applicant and the representative is limited. When the written draft is confirmed and where the descriptions in their columns are truncated (where the number of character exceeds the limitation), "Name of invention to be continued: xxxx" is stated in the remark column of the creation window of "Decision to grant a patent" to state a truncated portion, or "Name of invention: xxxxxxxxxx" is stated therein to state all of the name of invention and the like (in this case, since the truncated portion is kept as an internal data, the button of "Alteration" shall not be pushed to edit a column of "Name of invention/device").

5. Handling a case in which the retroactive effect of the filing date is not recognized

(1) Setting the filing date (retroactive date)

Where the retroactive effect of the filing date (the retroactive date) is not recognized concerning the special application (Note), the examiner sets the filing date (retroactive date) in the "Filing date (retroactive date)" of the creation window of "Decision to grant a patent".

Where the retroactive effect of the filing date is only recognized in its part (for example, a case in which while the retroactive effect of the filing date for the child application concerning the grandchild application is recognized, the retroactive effect of the filing date for the parent application is not recognized), the filing date (retroactive date) is set by selecting the original application for which the retroactive effect is recognized in "Filing date (retroactive date)", and where the whole retroactive effect of the filing date is not recognized (where the filing date is the actual filing date of the special application), the filing date (retroactive date) is set to the actual filing date of the special application by not selecting any of the original applications in the "Filing date (retroactive date)".

(Note) The special application means a divisional application, a converted application or a patent application based on the utility model registration.

(2) Notice to the applicant

When the examiner makes decision to grant a patent for the patent application without recognizing the retroactive effect of the filing date, if the examiner does not indicate even once, in the notice of reasons for refusal or the like, the reasons why the retroactive effect of the filing date is not recognized, the examiner issues the “Notice by the examiner (other Notices) (with time limit)”, in advance, concerning the matter to the effect that the examiner makes decision to grant a patent for the patent application without recognizing the retroactive effect of the filing date and the reasons why the retroactive effect of the filing date is not recognized. The examiner makes decision to grant a patent after the period of one month (in case of residents of Japan) or three months (in case of overseas residents). During this period, if the applicant asserts, in the written statement, etc. that the retroactive effect of the filing date should be recognized, the examiner makes decision to grant a patent after determining again whether the retroactive effect of the filing date should be recognized in consideration of the assertion.

Example of statements of above notice

	Notice	
Application Number	JP XXXX-XXXXXX	
Drafting Date	(YY/MM/DD)	
Examiner in Charge	XX XX	XXXX XX
Patent Attorney	XX XX	
<p>If the applicant has any opinion on the following matter, please submit the written statement within XX days from the sending date of this notice.</p> <p style="text-align: center;">Note</p> <p>Since the retroactive effect of the filing date is not recognized in the application for the following reason, the application is deemed to have been filed on XX year X month X day.</p> <p>Since the reasons for refusal have not been found at this point, the examiner makes decision to grant a patent without recognizing the retroactive effect of the filing date after the period of one month (three months in case of overseas residents) from the sending date of the notice, provided that if the reasons for refusal are newly found, the reasons for refusal will be notified.</p> <p>Reason</p> <p>....(For example, state the reasons why the examiner has determined that the requirements for divisional application were not recognized.)</p> <p>-----</p> <p>For any inquiry including an interview request regarding this notice, please contact us at the number below. Should the applicant wish to transmit a proposed amendment via e-mail, please notify us by phone in advance.</p> <p>Examination Department of X XX Division (PA XX) The Name of examiner TEL. 03 – 3581 – 1101 extension</p>		

6. Number of claim

Where the number of claim displayed on the creation window of “Decision to grant a patent” is different from the actual number of claim, the examiner amends such a number (especially, a case of reconsideration by examiners before appeal proceedings).

7. Handling a case in which a filing date of a “reference filing” is regarded as a day of submission of the description and the drawings

(2) Setting the filing date

Where the examiner makes decision to grant a patent for the reference filing regarding the day of submission of the description and the drawings as a filing date, the examiner makes a contact with Examination Standards Office (Note) upon making the decision to grant the patent. Then, the examiner confirms that a filing date displayed on the window of “Application” of “Basic matters” on application master screen is set to the day of submission of the description and the drawings and makes decision to grant a patent. When the examiner prepares a draft of decision to grant a patent, the examiner inputs statement that “the filing date is set to year/month/day on which the description and the drawings were submitted” in the remark column of the creation window of “Decision to grant a patent”. Further, the examiner briefly inputs statement that the patent application referencing previous application is granted regarding the day of submission of the description and the drawings as a filing date and a reason why the day of submission of the description and the drawings is regarded as a filing date.

(Note) The examiner is not required to make a contact with the Examination Guideline Section when the examiner notifies reasons for refusal or refusal.

(2) Notice to the applicant

When the examiner makes decision to grant a patent for the reference filing regarding the day of submission of the description and the drawings as a filing date, if the examiner does not indicate even once, in the notice of reasons for refusal or the like, the reasons why the examiner regards the day of submission of the description and the drawings as a filing date, the examiner issues the notice (with prescribed period) under the name of the examiner, in advance, concerning the matter to the effect that the examiner makes decision to grant a patent regarding the day of submission of the description and the drawings as a filing date and the reason why the examiner regards the day of submission of the description and the drawings as a filing date. Then, the examiner makes decision to grant a patent after the period of one month (in case of residents of Japan) or three months (in case of overseas residents). During this period,

if the applicant asserts, in the written statement, etc., that the filing date should be set to the day of filing the application, the examiner makes decision to grant a patent after determining again the filing date of the patent for the reference filing in consideration of the assertion.

Example of statements of above notice

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

If the applicant has any opinion on the following matter, please submit the written statement within XX days from the sending date of this notice.

Note

The present application is regarded, for the reasons as set forth below, that the matters stated in the description and the drawings do not remain in the matters stated in the description, claims, or drawing(s) attached to the application of the earlier patent application (in the case where the said earlier patent application is a foreign-language-written-application, foreign- language-documents; in the case where the said earlier patent application is filed in a foreign country, documents which are submitted at the time of filing the application and correspond to the description, claims or drawing(s)). Therefore, the said patent application shall be deemed to have been filed on XX year X month X day on which the description and the drawings were filed (Article 38-3 (4)).

Since the reasons for refusal have not been found in the application at this point, the examiner makes decision to grant a patent regarding that the present application was filed when the description and the drawings were submitted, after the period of one month (three months in case of overseas residents) from the sending date of this notice, provided that if the reasons for refusal are newly found, the reasons for refusal will be notified.

Reason

.... (For example, state the reasons why the examiner has determined that the matters stated in the description and the drawings do not remain in the matters stated in the description, claims, or drawing(s) attached to the application of the earlier patent application.)

For any inquiry including an interview request regarding this notice, please contact us at the number below. Should the applicant wish to transmit a proposed amendment via e-mail, please notify us by phone in advance.

Examination Department of X XX Division (PA XX) The Name of examiner
TEL. 03 - 3581 - 1101 extension

1211 Service of Certified Copy of Decision to Grant a Patent and Fixation of Decision to Grant a Patent

Where a Decision to grant a patent is determined, the JPO Commissioner shall serve its copy to the patent applicant (Article 52(2) of the Patent Act).

The Decision to grant a patent is fixed at a time in which the copy of the Decision is served.

1213 Points to Which Attention Should be Paid When Drafting Decision of Refusal

1. Handling a case in which the name of invention or the name of applicant and the like is long

There is a limit to a number of characters that can be displayed in the column for the title of invention and the column of the applicant and the representative. Where the descriptions in these columns are truncated (where the number of characters exceeds the maximum number) when a written draft is confirmed, "Title of invention to be continued: xxxxxxxx" and the like is stated in the last part of the remarks column of the body sentence of the written draft to state the truncated portion, or "Title of invention: xxxxxxxx" and the like is stated to state the entire title of the invention and the like.

2. Note when the decision of refusal based on Article 39 of the Patent Act is drafted

2.1 Prior application

(1) "(1) Where the applicant of the claimed application is different from the applicant of another application " of "4.4.1 Where another application is an prior application" of Examination Guidelines for Patent and Utility Model "Part III Chapter 4 Prior Application"

After waiting for the earlier application to become final, such a statement is made in the remarks column when drafting the Decision of refusal.

(Example of sentence)

The application of Patent Application No. xxxx-xxxxxx was registered as Patent No. xxxxxxxx

(2) "(2) Where an applicant of the application concerned and the applicant of the other application are identical with each other " of "4.4.1 Where another application is an prior application" of Examination Guidelines for Patent and Utility Model "Part III Chapter 4 Prior Application "

Even if the prior application does not become final, the Decision of refusal is made.

2.2 Co-pending applications filed on the same date

(1) Where the reason for refusal is that no agreement has been reached by consultations or consultations are unable to be held, the decision of refusal is not readily made even though no written opinion and the like are submitted. It is confirmed whether or not all of the other applications are withdrawn, waived or the like, and the Decision of refusal will be made, except in the case where all of the applications are withdrawn, waived, and the like.

(2) Where no agreement is reached by consultations, such a statement is stated in the remark column of the Decision of refusal.

(Example of sentence)

Since the patent applicant of the present application has not been reported according to the gist described in the invitation dated xx, xx, xxxx, it is deemed that no agreement with the applicant of the Patent (Utility Model) application No. xxxx-xxxxxxx has been reached by consultations.

3. Handling a case in which the retroactive effect of the filing date is not recognized

Concerning the special application (Note 1), where the retroactive effect of the filing date is not recognized (Note 2), the examiner sets the filing date (retroactive date) in the "Filing date (retroactive date)" of the creation window of "Decision of refusal".

Where the retroactive effect of the filing date is partially recognized (for example, while the retroactive effect of the filing date concerning the grandchild application is recognized as the filing date of the child application, where the retroactive effect until the filing date of the parent application is not recognized and the like), the filing date (retroactive date) is set by selecting the original application for which the retroactive effect is recognized in "Filing date (retroactive date)". On the other hand, where none of the retroactive effect of the filing date is recognized (a case in which the actual filing date of the special application is recognized), the filing date (retroactive date) is set to the actual filing date of the special application by not selecting any of the original applications in the "Filing date (retroactive date)".

(Note 1) A special application means a divisional application, a converted application or a patent application based on utility model registration.

(Note 2) A case in which the retroactive effect of the filing date is not recognized means a case in which the Decision of refusal is made in a situation that the retroactive effect of the filing date is partially or wholly not recognized, by pointing out an indication that the retroactive effect of the filing date is partially or wholly not recognized in the notice of reasons for refusal(See

4.1 in “Part VI Chapter 1 Section 1 Requirements for Division of Patent application”, 3. in “Part VI Chapter 2 Conversion of Application” and “Part VI Chapter 3 Patent Application Based on Utility Model Registration” of the Examination Guidelines). Except in this case, the filing date is treated to be retroactive.

1214 Final Conclusion of Decision of Refusal

Final conclusion of the Decision of refusal means a state that the Decision of refusal could not be cancelled by a statement of dissatisfaction prescribed in the Patent Act. The case in which the Decision of refusal becomes final and conclusive is item (i) or (ii) below:

- (i) A case in which no request for appeals against an examiner's decision of refusal has been filed after 3 months have passed (Note) (where the applicant is an overseas resident, a 1-month extension is granted by JPO commissioner ex officio) in principle from the date of the dispatch of the copy of such a Decision; and
(Note) See Trial and Appeal Manual 61-03 for further details.
- (ii) A case in which, where such a request for a trial and appeal is filed, the Trial Decision that the request of the trial and appeal is not established or the request of the trial and appeal is dismissed becomes final and conclusive, or the Decision to dismiss the written request becomes final and conclusive.

1215 Handling in Cases Where the Amendment of Claims after the Final Notice of Reasons for Refusal is Considered to Aiming at Two or More Matters Listed in Items of Article 17bis(5) of the Patent Act

When the amendments of the description, etc. made after issuing final notice of reasons for refusal satisfy the requirement of Article 17bis (3) and (4), if it is determined that the amendments of claims aim to two or more matters listed in the items of Article 17bis (5), the examiner handles the amendments as follows.

1. Where purposes of amendments of a plurality of claims or a plurality of parts of a claim are respectively different

In cases where an amendment related to at least one part or more aims at restriction in a limited way of claims and the claimed invention cannot be granted a patent independently, the examiner rejects the amendment. (See 3.2 in "Part I Chapter 2 Section 6 Decision of Dismissal of Amendments" of the Examination Guidelines)

Example 1: When an amendment of the claimed invention of Claim 1 aims at correction of a clerical error and an amendment of the claimed invention of Claim 2 aims at restriction in a limited way of claims, and moreover, the claimed invention of amended Claim 2 cannot be granted a patent independently, the examiner rejects the amendments.

2. Handling in a case where one amendment of certain claim can be said as made aiming at two or more items listed in Article 17bis (5)

In a case where, with regard to one amendment of certain claim, the applicant asserts one purpose and the amendments are considered to have been made for the purpose, the examiner proceeds with examination, assuming as the amendments have been made for the purpose.

For the reasons or the like that the applicant does not assert the purpose of the amendments, that the applicant asserts multiple purposes, or that the applicant asserts the purpose of the amendments but the amendments are not considered to have been made for such purpose, in cases where it cannot be specified that the amendments aim at any of two or more items listed in Article 17bis (5), the examiner handles the amendments as follows.

In cases where it is considered that one amendment of certain claim have been

made for the purposes only of two or more matters of deletion of a claim, correction of errors or clarification of an ambiguous description for any purpose, the examiner proceeds with examination based on the description, etc. after the amendments, without dismissing the amendments.

In cases where it is considered that one amendment of certain claim have been made for the purpose of restriction of claims or for the purpose of other matters, the examiner determines, among above purpose, whether there is a purpose that if the amendments are made for such purpose, it is considered that the decision of refusal should not be made.

If there is a purpose that it is considered that the decision of refusal should not be made for, the examiner proceeds with examination, assuming as the amendments have been made for the purpose.

Regardless of whether the amendments aim at restriction of claims in a limited way or other purposes, if it is consequently considered that the decision of refusal should be made, the examiner proceeds with examination, assuming as the amendments have been made for the purpose of restriction of claims in a limited way.

In cases where it is considered that the amendments of claims aim at above two or more matters of the items listed in Article 17bis (5), if it cannot be specified that the amendments aim at any of above two or more items, the examiner can invite the applicant to submit the document in which the applicant explains that the amendments aim at any of the items listed in Article 17bis (5) As a result, in cases where it can be determined that the amendments aim at any of the items, the examiner proceeds with examination, assuming as the amendments have been made for the purpose.

Example 2: In claims before the amendments, claim 1 and Claim 2 (that is dependent claim of Claim 1) are stated. Thus, in cases where the amendments are made in such a manner as Claim 2 before the amendments is only stated, it is considered that the amendments aim at deletion of Claim 1 or aim at restriction of claims in such a manner as Claim 1 is restricted by constitution of Claim 2 after deleting Claim 2.

In that case, when, in previous notice of reasons for refusal, the examiner issues such notice before the amendments due to lack of novelty and lack of inventive step in Claim 1 and due to lack of inventive step in Claim 2, but the reasons for refusal due to lack of inventive step cannot be maintained for the invention after the amendments (Claim 2 before the amendments) after referring to written opinion, etc. and the reasons for refusal due to lack of inventive step that is caused by novel prior art is found, if assuming as the amendments aim at restriction of claims,

the invention after the amendments is independently patentable. Therefore, the examiner makes decision of refusal due to lack of novelty and lack of inventive step in Claim 1 before the amendments, with dismissing the amendments.

However, if assuming the amendments have been made for the purpose of deletion of claim, the reasons for refusal cannot be maintained which have been previously issued. Therefore, the examiner newly issues the notice of reasons for refusal due to lack of inventive step.

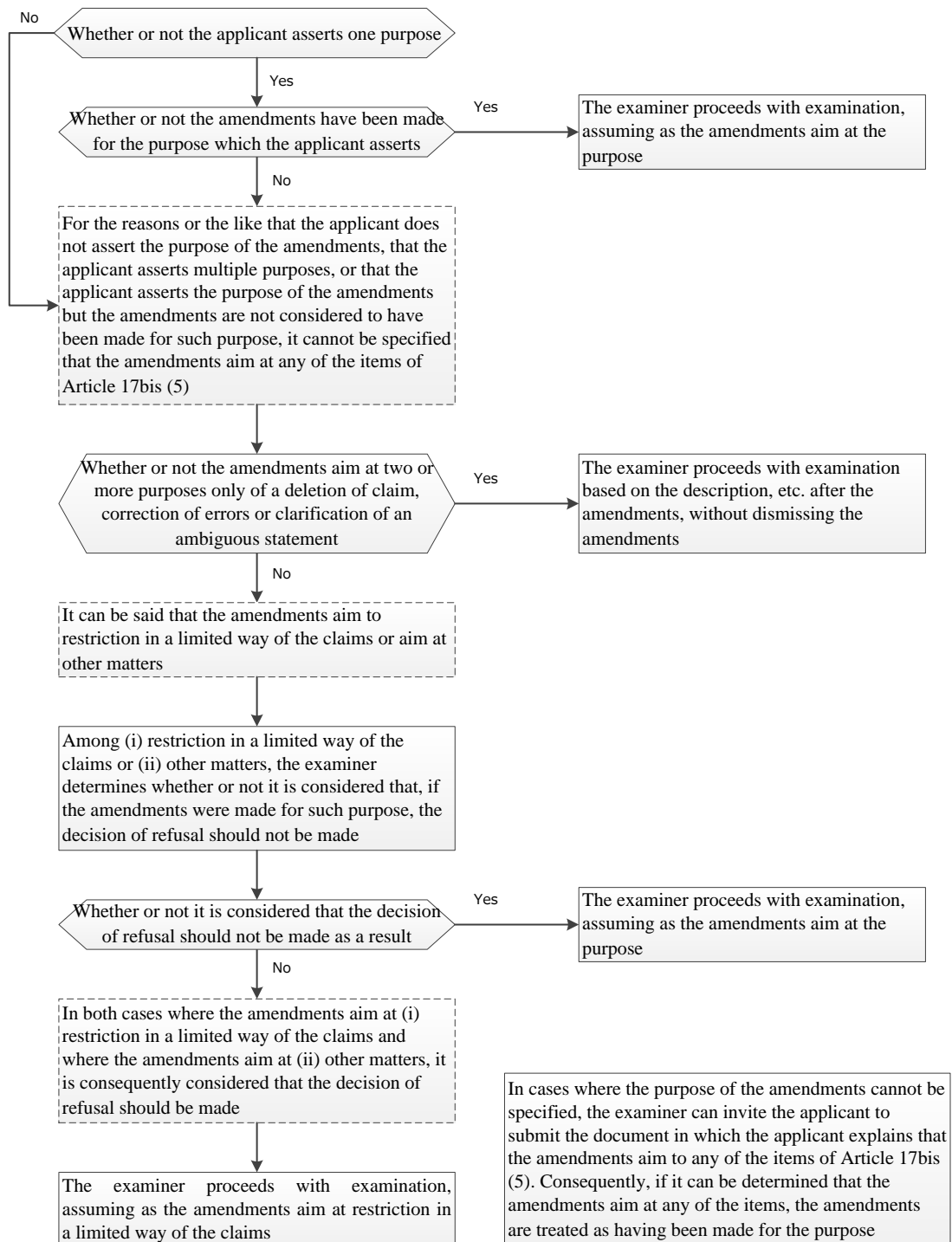
In that case and where it cannot be specified that the amendments aim at any of two or more items listed in Article 17bis (5) for the reasons or the like that the applicant does not assert the purpose of the amendments, that the applicant asserts multiple purposes, or that the applicant asserts the purpose of the amendments but the amendments are not considered to have been made for such purpose, the examiner proceeds with examination, assuming as the amendments have been made for the purpose of deletion of claim.

In addition, in cases where it is considered that, in the previous notice of reasons for refusal, the notice due to lack of inventive step has been issued for both of claim 1 and 2 before the amendments, and the reasons for refusal due to lack of inventive step can be maintained after the amendments, if assuming the amendments aim at restriction of claims in a limited way, the invention after the amendments is not independently patentable. Therefore, the examiner makes decision of refusal after dismissing the amendments. Moreover, if also assuming as the amendments aim at deletion of claim, the reasons for refusal due to lack of inventive step have not been resolved. Therefore, the examiner makes decision of refusal.

In this way, for any purpose, in cases where the examiner consequently makes decision of refusal and where it cannot be specified that the amendments aim at any of two or more items listed in Article 17bis (5) for the reasons or the like that the applicant does not assert the purpose of the amendments, that the applicant asserts multiple purposes, or that the applicant asserts the purpose of the amendments but the amendments are not considered to have been made for such purpose, the examiner proceeds with examination, assuming as the amendments aim at restriction of claims in a limited way.

FIG: Handling in a case where the amendments of certain claim are determined as aiming at two or more matters listed in each item of Article 17bis(5) (See 2.)

(*)The amendments shall satisfy the requirements of Article 17bis (3) and (4)



1216 Points to Which Attention Should be Paid When Drafting Decision of Dismissal of Amendment

1. Handling a case in which the name of invention or the name of applicant and the like is long

The number of letters that can be indicated in the columns of the title of invention, applicant, agent, etc. is limited. When the draft is checked and the statements of these columns are ended in the middle thereof (the maximum number of letters has been exceeded), a remarks column is added to the last portion or the like of the "Reason" column in the body of the draft and a statement such as "Remark: Continuation of the title of the invention is: OΔ..." is to be indicated so as to state the unintentionally truncated portion, or a statement such as "Remark: Title of Invention: XXOΔ..." is to be indicated so as to state the complete title of the invention, etc.

2. Decision to Dismiss Amendment against Written Amendment Changing Title of Invention

When a decision to dismiss the amendment is to be made against a written amendment that changes the title of the invention, the examiner confirms that the title of the invention prior to the amendment is stated, not the title of the invention amended by the written amendment, in the decision to dismiss the amendment.

(Explanation)

The above rule of handling is to be complied with as a decision to dismiss the amendment is made against the entire amendments included in the written amendment.

1217 Interview, etc.

The "interview" means an interview for communication between the examiner and the representative and the like (basically the applicant himself in a case where no representative is nominated. However, only in a case where the applicant is a legal entity and a case where an intellectual property member and the like of the legal entity can deal with it responsibly, the intellectual property member and the like is possible.) with respect to the examination of the patent application and includes technical explanation for facilitating understanding of technology of the examiner. The "interview" includes an on-site interview, for which the examiner makes a business trip, and an online interview.

In addition, "a contact by a telephone, via e-mail, or the like" for the above communication is handled as one corresponding to the above "interview".

* For details of the interview, etc., refer to "Interview Guideline [Patent Examination]".

(http://www.jpo.go.jp/shiryoku/kijun/kijun2/mensetu_guide_index.htm)

1218 Cases Where the Examiner Requests to Submit the Documents or Other Materials under the Provision of Article 194(1)

According to the provision of Article 194(1) of the Patent Act, the examiner may request a party concerned to submit documents or other materials necessary for the examination (hereinafter, referred to as "documents, etc."). According to this provision, for example, in the following cases, it is determined that the examiner may request the applicant and the like to submit a model, a specimen or the like, in addition to the document of the reference and the like as references to clarify the content of the invention .

1. Examples of documents, etc. which may be requested to submit

- (1) Where, in a case of identifying the claimed invention, it is difficult to understand the invention for reasons that the technical content of the invention is hard to understand, the length of the description or the number of claims is excessive, the examiner may request the applicant and the like to submit, for example, a document explaining a relationship of which matter specifying the invention stated in the claims corresponds to what portion in each example is, a document briefly explaining the gist of the invention, a chart indicating the relationships between claims, and the like.

(Explanation)

Where the content of the invention cannot be understood or can be hardly understood from the description, the claims, and the drawings, it is general practice to notify the reason for refusal. However, where the claimed invention of the patent application relates to a special expertise technique that makes it difficult to understand the invention, or it can be determined that the length of the description or the number of claims is excessive to require a long time to understand the invention, while there is apparently no deficiency in the description, the claims, and the drawings and it can be recognized to be inappropriate to treat with a procedure including notice of reasons for refusal, it can be recognized to be necessary on the treatment of the examination to take the above-mentioned measures other than the notice of reasons for refusal exceptionally in order to promote understanding of the invention. Accordingly, it shall be handled as the main sentence.

- (2) Where there is a point that is difficult to understand in the assertion of the written opinion in response to the notification of reason for refusal, and it can be recognized that this point has a great effect on the examination, the examiner may request the applicant and the like to submit a document further clearly explaining the assertion in the written opinion.

- (3) Where it is impossible to confirm the action and effect stated in the description without reference to the model, the specimen, the test report and the like (hereinafter, referred to as "specimen, etc."), and where submission of such specimen make it possible to confirmed the clearness and sufficiency of the content of the description or the drawings at the time of filing the application, the examiner may request the applicant and the like to submit the specimen, etc.

A test report and the like include published literature of an academic journal, a written expert opinion, and the like, and these documents are often desirably prepared by a third party.

- (4) Where it cannot be easily understood whether or not a divisional application complies with the substantial requirements for the division, or where it is necessary to take quite a long time for determining whether or not the claimed invention of the divisional application is not the same as the claimed invention of the original application or the claimed invention of another divisional application, the examiner may request the applicant and the like to submit a document explaining what portion in the description, etc. of the original application is changed, what matter stated in the originally-filed description, the claims, or the drawings of the original application serves as the basis for the claimed invention of the divisional application, that the claimed invention of the divisional application is not the same as the claimed invention of the original application or the claimed invention of another divisional application, and the like.
- (5) Where it cannot be easily understood whether or not the matters stated in the description or the drawings of a reference filing is within the matter stated in the description, etc. of an earlier patent application, the examiner may request the applicant and the like to submit a document explaining which matters stated in the description, the claims, or the drawings of the earlier patent application serves as the basis for the matters stated in the description or the drawings of the reference filing, and the like.
- (6) Where it cannot be easily understood that the amendment of the description, etc. is within the matter stated in the originally-filed description, etc., the examiner may request the applicant and the like to submit a document explaining any basis of the amendment. In addition, where it is unclear whether or not the amendment of the claims in response to the final notification of reason for refusal or at the time of requesting an appeals against an examiner's decision of refusal is made for any purposes of the items of Article 17bis(5) of the Patent Act, the examiner may also request the applicant and

the like to submit a document explaining that the amendment complies with any of the purposes.

- (7) Where the grounds of correction of incorrect translation is not sufficiently stated in the statement of correction of incorrect translation when the statement of correction of incorrect translation is submitted to amend the description, etc., the examiner may request the applicant and the like to submit a document explaining the ground of correction of incorrect translation.

2. Notification Requesting Submission of the Documents, etc.

- (1) Where the submission of the documents, etc. prescribed in the above 1. is requested, as the Notification, the "Notice by Examiner (other Notices) (with time limit) is used.

- (2) The designated time limit where the submission of the documents, etc. prescribed in the above 1. is requested shall be the same as the designated time limit for submitting the written opinion. Where it can be determined that preparing the specimen, etc. will require a long time, the examiner can designate a time limit different from the above time limit, depending on the circumstances. (See 04.09 and 04.10 in "Formality Check Manual")

- (3) The notification specifically states what documents, etc. the applicant and the like should submit, as shown in the following example sentence.

(Example of sentence)

A document explaining the correspondence between each matter for specifying the invention stated in claim 1 of this application and which portion of the example.

- (4) Concerning the document whose submission is requested mentioned in the above 1.(4), the notification shall request the applicant to prepare the document according to the example for description of the written petition (*) requesting submission of a document for filing a divisional application.

- (*) Japan Patent Office Homepage "Request to the applicant relating to document for explanation upon filing a divisional application (June 29, 2009)"
http://www.jpo.go.jp/tetuzuki/t_tokkyo/shinsa/bunkatu_yousei.htm

3. Borrowing of specimen, etc.

Where the model or the specimen which is submitted is borrowed, a "Borrowing of material" is take place.

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

Part II Description and Claims

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2001 Regarding Provisions of Article 36 and Effective Dates Thereof

Regarding provisions of article 36 and effective dates thereof, a list for the same is indicated in a table.

Table List of Provisions of Article 36 and Effective Dates Thereof

Law		Act in 1990	Act in 1994	Act in 2002
Effective Date		From December 1, 1990	From July 1, 1995	From September 1, 2002
Summary of Revision		* Introduction of Abstract Numbering of paragraphs was changed due to revision of Article 36(2)	*Revision of Article 36 Easing of the description requirement for the description: The detailed description of the invention shall be "clear and sufficient;" the scope of claims shall state "matters that the applicant considers necessary;" and the statement of the claims shall be "clear and concise."	Revision of Article 36 Introduction of information disclosure system for disclosure of prior art document (from September 1, 2002*1) Separation of the claims from the description (from July 1, 2003*2)
Provisions	Detailed Description of the Invention	Fourth paragraph The detailed description of the invention as provided in item (iii) of the preceding paragraph shall state an object, feature, and effect of the invention to the extent that any person ordinarily skilled in the art to which the invention pertains can easily work the invention.	Fourth paragraph The statement of the detailed description of the invention as provided in item (iii) of the preceding Paragraph shall be so clear and sufficient as to enable any person ordinarily skilled in the art to which the invention pertains to work the invention in accordance with Ordinance of the Ministry of Economy, Trade and Industry.	Fourth paragraph The statement of the detailed description of the invention as provided in item (iii) of the preceding paragraph shall comply with each of the following items: (i) in accordance with Ordinance of the Ministry of Economy, Trade and Industry, the statement shall be so clear and sufficient as to enable any person ordinarily skilled in the art to which the invention pertains to work the invention; and (ii) where the person requesting the grant of a patent has knowledge of any invention(s) (inventions as provided in Article 29(1)(iii), hereinafter the same shall apply in this item) related to the said invention, which has been known to the public at the time of filing of the patent application, the statement shall provide the source of the information concerning the invention(s) known to the public through publication such as the name of the publication and others.
	Claims	Fifth paragraph The scope of claims as provided in item (iv) of paragraph (3) shall comply with each of the following items: (i) the invention for which a patent is sought is stated in the detailed description of the invention; (ii) the scope of claims states a claim or claims that only defines indispensable constituent features of the invention for which a patent is sought (hereinafter referred to as "claim"); and (iii) the statement is composed in accordance with Ordinance of the Ministry of Economy, Trade and Industry.	Fifth paragraph The scope of claims as provided in item (iv) of paragraph (3) shall state a claim or claims and state for each claim all the matters that the applicant considers necessary to specify the invention for which the grant of a patent is sought. In this case, one claimed invention is not precluded from being the same as another claimed invention.	Fifth paragraph The scope of claims as provided in paragraph (2) shall state a claim or claims and state for each claim all the matters that the applicant considers necessary to specify the invention for which the grant of a patent is sought. In this case, one claimed invention is not precluded from being the same as another claimed invention.
		Sixth Paragraph The provisions of the preceding paragraph do not preclude the scope of claims in one claimed invention from being the same scope of invention in another claimed invention.	Sixth Paragraph The statement of the scope of claims as provided in item (iv) of paragraph (3) shall comply with each of the following items: (i) the invention for which a patent is sought is stated in the detailed description of the invention; (ii) the invention for which a patent is sought is clear; (iii) the statement for each claim is concise; and (iv) the statement is composed in accordance with Ordinance of the Ministry of Economy, Trade and Industry.	Sixth Paragraph The statement of the scope of claims as provided in paragraph (2) shall comply with each of the following items: (i) the invention for which a patent is sought is stated in the detailed description of the invention; (ii) the invention for which a patent is sought is clear; (iii) the statement for each claim is concise; and (iv) the statement is composed in accordance with Ordinance of the Ministry of Economy, Trade and Industry.

	Abstract	<p>Seventh paragraph</p> <p>The abstract as provided in paragraph (2) shall state a summary of the invention described in the descriptions or drawings, and any other matters as provided by Ordinance of the Ministry of Economy, Trade and Industry.</p>		<p>Seventh paragraph</p> <p>The abstract as provided in paragraph (2) shall state a summary of the invention described in the descriptions, the scope of claims or drawings, and any other matters as provided by Ordinance of the Ministry of Economy, Trade and Industry.</p>
Supplementary Provisions	Transitional Measures	(Omitted)	<p>The old act applies to applications filed under the old act (Supplementary Provisions §6(2)).</p>	<p>*1 The old act applies to applications filed under the old act (Supplementary Provisions §2(1)).</p> <p>*2 Applicable to patent applications filed on or after the effective date (including divisional applications, etc., filed prior to the effective date) (Supplementary Provisions §3).</p>

2002 Dealing with Cases Where Descriptions, Claims or Drawings have Description Deficiencies Not Applicable to the Reasons for Refusal

1. In a case where description deficiencies not applicable to the reasons for refusal have been found in the descriptions, claims or drawings (hereinafter, referred to as "descriptions, etc.")

When the Examiner notifies an applicant of a notice of reasons for refusal regarding novelty, inventive step or other reasons for refusal, he/she points out a part where the deficiencies exist in the descriptions, etc., in the "proviso" of the notice of reasons for refusal.

When a notice of reasons for refusal is not issued, the Examiner can deal with any one of the followings.

- (1) Before granting a patent, contacting the applicant or the representative (hereinafter referred to as "applicant, etc.") by telephone to facilitate correcting the deficiencies by voluntary amendment (limited to the period when the voluntary amendment by the applicant, etc. is allowed.).
- (2) When granting a patent, correcting the descriptions, etc. by ex officio (see the following 2).
- (3) Before granting a patent, contacting Formality Examination Office to ask to notify an applicant of an invitation for amendment under the Commissioner's name for the deficiencies (see the following 3).

When deficiencies in the descriptions, etc. (Note) fall under a reason for refusal, the Examiner notifies a notice of reasons for refusal, etc. due to description deficiencies of the description, etc., without following the above (1) ~ (3). Correction by ex officio stated in (2) is made only when it is requested by the applicant, etc. in principle (see 2.2(1)).

(Note) When determining deficiencies in the descriptions, etc. fall under a reason for refusal, the followings should be taken into consideration:

- (i) Even if there is minor deficiencies in the claims such as a clerical error, etc., it is not immediately determined that the deficiencies fall under a reason for refusal due to a violation of Clarity Requirement. When, for example, a person skilled in the art has found the claimed invention not ambiguous with minor deficiencies, such deficiencies do not fall under a reason for refusal due

to a violation of Clarity Requirement (see Examination Guidelines, Part II, Chapter 2, Section 3, 2.2(1)a).

- (ii) Even if there are minor deficiencies in the claims such as a clerical error, etc. but the statement of the descriptions, etc. is clear and sufficient in such a manner that a person skilled in the art can work the claimed invention based on the common general knowledge as of the filing, such deficiencies do not fall under a reason for refusal due to a violation of Clarity Requirement (see Examination Guidelines, Part II, Chapter 1, Section 1, 6.).

2. Correction by ex officio of descriptions, etc.

2.1 Examples of description deficiencies which can be subject to correction by ex officio

- (1) Cases where both expression and contents result in one as follows, with respect to the correction to the deficiencies

- | | |
|---|---------------------|
| (i) the Oatent Office | → the Patent Office |
| (ii) linear tor | → linear motor |
| (iii) the Patent Office the Patent Office | → the Patent Office |

- (2) Cases where the expression is not resulted in one but contents are resulted in one, and the expressional difference does not become an issue, with respect to the correction to the deficiencies

- (i) Additional remarks that it is a trade name

- (ii) Correction of the following misspelling or omitted letters

... that is X ... → ... that is as ..., or that is to ...

(X represents misspelling or omitted letters.)

- (iii) Correction of the title of the invention obviously different from the claims

(Example) Title of the Invention: XX DEVICE AND YY PROCESS → XX DEVICE

(Claims: XX device)

- (iv) Addition of a publication number, etc. for an application described as a conventional art

(Example) Japanese Patent Application No. S50-12345

→ Japanese Patent Application No. S50-12345 (JP S51-54321A)

2.2 Points of correction by ex officio

- (1) The Examiner communicates the content of correction with the applicant, etc. by telephone, etc. prior to a correction by ex officio and makes a response record clearly and specifically indicating the content of correction. This indication in the record can be replaced with the correction proposed by the applicant, etc., via e-mail, etc., by attaching it on the record. If the Examiner cannot obtain a consent of the correction from the applicant, etc., the correction by ex officio is not made except when the correction by ex officio is related to "matters or contents that clearly damage the public order or morality" in accordance with Examination Handbook, 3501, 2(2)), and the Examiner describes the non-consent of the correction from the applicant in a response record.
- (2) A correction by ex officio of descriptions, etc. is conducted by selecting "Data of Correction by Ex Officio" in a creation window of "Decision to grant a patent".

3. Invitation for amendment under the Commissioner's name

When description deficiencies are found in unclear drawings, etc. and the deficiencies are not relevant to other rejection such as addition of new matter, etc. (including matters excluded from the subject of the formality examination), the Examiner may contact Formality Examination Office and request to notify an applicant of an invitation for amendment for the deficiencies under the Commissioner's name if he/she finds it particularly necessary. In this regard, however, Formality Examination Office makes the final decision of an issuance of an invitation for amendment under the Commissioner's name for each case.

Examples of matters related to the description deficiencies which can be the subject of the request include the followings.

(Common to the Descriptions and the Claims)

- (1) Cases where a part of the descriptions or the claims is written in a foreign language (except for cases where general terms and technical terms are described in the original language in parentheses after Japanese names and cases where an application is filed in English or other foreign language under Article 36bis(1) of the Patent Act)
- (2) Cases where the column [Drawings] is provided in the descriptions or the claims

(Title of the Invention)

- (1) Cases where no title of the invention is described
- (2) Cases where a more than one columns of [Title of the Invention] are provided

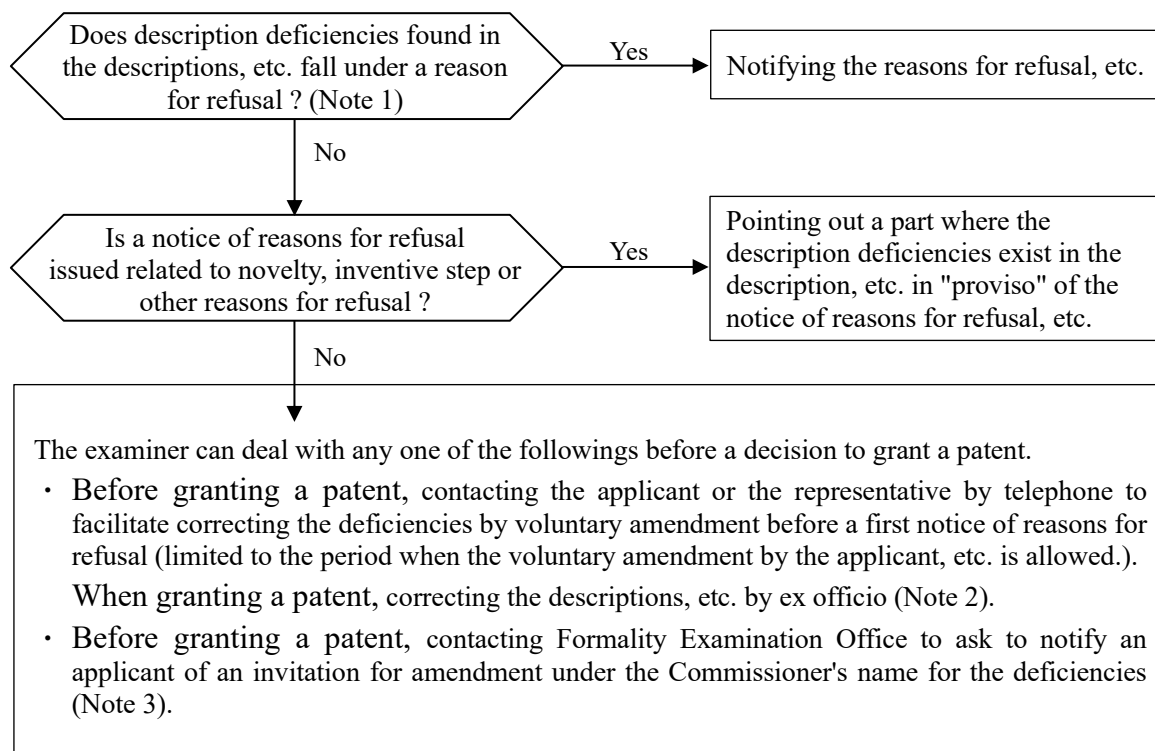
(Brief description of drawings)

- (1) Cases where the drawing number is not a consecutive number starting from 1
- (2) Cases where the Figure number and sub-drawing number of the drawings are not identified with the drawing number and sub-drawing number of the brief description of drawings
- (3) Cases where descriptions of all drawings and sub-drawings are not provided
- (4) Cases where more than one columns of [Brief Description of Drawings] are provided

(Drawings)

- (1) Cases where no drawing number is described when there are two or more drawings
- (2) Cases where the drawing number is not a consecutive number starting from 1
- (3) Cases where a drawing intended to form one drawing with one drawing number drawn on more than one sheet
- (4) Cases where a leader line that cannot be distinguished from other lines is drawn
- (5) Cases where drawings are unclear
- (6) Cases where letters in the drawings are extremely small
- (7) Cases where the explanation of the drawings is written in a foreign language (except for cases where general terms and technical terms are described in the original language in parentheses after Japanese names and cases where an application is filed in English or other foreign language under Article 36bis(1) of the Patent Act)
- (8) Cases where identical drawing numbers are not described to the same drawings when the same drawing numbers are assigned more than one drawing (Example. [Figure 2] and Fig. 3 are described for the same drawing)
- (9) Cases where the sub-drawing number is not a consecutive number (symbol)

Fig. Dealing with a case where description deficiencies have been found in descriptions, claims or drawings (descriptions, etc.)



(Note 1) When determining deficiencies in the descriptions, etc. fall under a reason for refusal, the followings should be taken into consideration:

- (i) Even if there is minor deficiencies in the claims such as a clerical error, etc., it is not immediately determined that the deficiencies fall under a reason for refusal due to a violation of Clarity Requirement. When, for example, a person skilled in the art has found the claimed invention not ambiguous with minor deficiencies, such deficiencies do not fall under a reason for refusal due to a violation of Clarity Requirement (see Examination Guidelines, Part II, Chapter 2, Section 3, 2.2(1)a).
- (ii) Even if there is minor deficiencies in the claims such as a clerical error, etc. but the statement of the descriptions, etc. is clear and sufficient in such a manner that a person skilled in the art can work the claimed invention based on the common general knowledge as of the filing, such deficiencies do not fall under a reason for refusal due to a violation of Clarity Requirement (see Examination Guidelines, Part II, Chapter 1, Section 1, 6.).

(Note 2) The examiner communicates the content of correction with the applicant, etc. by telephone, etc. prior to a correction by ex officio and makes a response record clearly and specifically indicating the content of correction. This indication in the record can be replaced with the correction proposed by the applicant, etc., via a facsimile, etc., by attaching it on the record. If the Examiner cannot obtain a consent of the correction from the applicant, etc., the correction by ex officio is not made except when the correction by ex officio is related to "matters or contents that clearly damage the public order or morality" in accordance with Examination Handbook, 3501, 2(2)).

(Note 3) Formality Examination Office makes the final decision of an issuance of an invitation for amendment under the Commissioner's name for each case.

2003 Handling of Trademark Name Appearing in Descriptions, Claims, or Drawings

Any trademark name (including a registered trademark throughout this section) that appears in the descriptions, claims, or drawings is to be handled as follows.

- (1) If a trademark name appears in the claims or in a portion or portions of the descriptions or drawings describing the claimed invention, a reason for refusal is generally notified for the patent application concerned on the grounds that it fails to comply with the requirement of Article 36(4)(i) or Article 36(6)(ii) of the Patent Act.

However, the above general rule shall not apply to cases (a) where it is found that the trademark name is in effect a common name of a substance or an item, or (b) where the trademark is not a common name of a substance or an item but it can be established that the following three conditions are all met (Notes 1, 2).

- (i) It can be recognized that there is sufficient significance as an invention in selecting the one having the trademark name selected in particular from among other similar products.
- (ii) The presence of the trademark name does not render the invention unclear (for example, it is unambiguous that the trademark had been always given only to items that have a constant quality, composition, configuration, and the like at least at the time of or prior to filing of the patent application for the claimed invention).
- (iii) It can be recognized in spite of the presence of the trademark name that the technique of the invention is sufficiently disclosed (for example, even when the commodity having the trademark name becomes commercially not available for a certain reason, an invention substantially identical with that invention can be readily worked by a person ordinarily skilled in the art to which the invention pertains).

(Note 1) Finding in accordance with the above case (a) shall not be made for a registered trademark name.

(Note 2) There would be substantially no situations where the finding in accordance with the case (b) can be made.

(Explanation)

A trademark is not always used only for a limited range of commodities. Also, even when

a trademark is used only for a limited range of commodities, the same trademark is often used for commodities that vary in their qualities, compositions, configurations, and the like depending upon their manufacturing times and the like. In particular, this tendency becomes conspicuous as the technological progress becomes more rapid. In addition, when commodities having a certain trademark are in particular distinguished over other similar commodities, their manufacturing method, compositions or any other technical aspects are in most cases kept confidential and not opened to public.

As a result, in normal cases, the invention for which a patent is sought will be not clear because a trademark name appears in the claims or in a portion or portions of the description or drawings describing the claimed invention or the detailed description of the invention will not be so clearly and sufficiently described that a person skilled in the art can work the claimed invention because the techniques relevant to the invention are not sufficiently disclosed. This is the reason for a need to comply with the above general rule of handling.

- (2) Where the presence of a trademark name does not cause a reason for refusal to be raised, the applicant is requested to make an amendment such that the trademark in question is replaced by any appropriate technical or scientific terms. When an appropriate technical or scientific term is not found, indication of the trademark name may be maintained. In that case, however, if the trademark in question is a registered trademark, an explanatory mark "(registered trademark)" should be added next to the trademark name, or an explanatory mark "(trademark)" should be added next to an unregistered trademark (Remarks 7, 9 of Form 29 of the Regulations under the Patent Act). The annotation to the effect that the trademark is in fact a trademark name may be made by an ex-officio correction (see 2002 of this handbook).

(Explanation)

If a trademark name is recited on an as-is basis in the descriptions, such recitation may cause confusion of the trademark with a common name of any item or substance, which is not appropriate. Moreover, the presence of the trademark name may cause misinterpretation as if the trademark were a common name, which in turn causes degradation in the function intrinsic to a trademark to represent the origin of goods, which further causes unexpected disadvantage to the holder of a trademark right or the holder of the right to use it.

Hence, if the trademark name remains to appear on an as-is basis in the descriptions without amendment to replace it by appropriate technical or scientific terms, it is necessary to clearly state that the name in question is actually a trademark name. This is the reason for a need to comply with the above general rule of handling.

2004 Measurement Act [Extract]

Patent Law Enforcement Regulations

Article 3 When providing a statement pertaining to the quantity of a state of a physical phenomenon stipulated in the Measurement Act (Act No. 51 of 1992) Article 2(1) in a document, the statement shall be made in accordance with Article 8 of the Act as well as Supplementary Provision Articles 3, 4, 5, 6, 8(1), and 8(3) of the Act.

Measurement Act (Act No. 51 of 1992) [Extract]

(Definitions, etc.)

Article 2 In this act, "measurement" refers to measuring the following listed matter (hereinafter, referred to as "quantity of a state of a physical phenomenon"), and "measurement unit" refers to that which is to be a criterion for measurement.

- i length, mass, time, current temperature, amount of substance, intensity of light, angle, solid angle, area, volume, angular velocity, angular acceleration, speed, acceleration, frequency, rotational speed, wavenumber, density, force, moment of force, pressure, stress, viscosity, kinetic viscosity, work, engineering rate, mass flow rate, flow rate, amount of heat, thermal conductivity, specific heat capacity, entropy, quantity of electricity, electric field strength, voltage, electromotive force, capacitance, magnetic field strength, magnetomotive force, magnetic flux density, flux, inductance, electrical resistance, conductance of electricity, impedance, power, reactive power, apparent power, amount of electrical power, amount of reactive power, amount of apparent power, attenuation of electromagnetic waves, power density of electromagnetic waves, radiation intensity, light flux, luminance, luminescence, sound power, sound pressure level, vibration acceleration level, concentration, neutron emission rate, radiation, absorbed dose, absorbed dose rate, kerma, kerma rate, irradiation dose, irradiation dose rate, dose equivalent or dose equivalent rate
- ii fineness, specific gravity, others defined by Cabinet Order

2 to 8 (omitted)

(Note "Cabinet Order" = Measurement Unit Ordinance, Article 2)

(Measurement Units Related to International System of Units)

Article 3 Among quantities of states of physical phenomena listed in Paragraph 1,

Section 1, of the previous Article, measurement units for those listed in the upper row of the Attached Table 1 are as listed in the bottom rows of the same table, and definitions for the same are defined by Cabinet Order in accordance with international decisions and practices related to measurement units of the General Conference of Weights and Measures, etc.

(Other Measurement Units)

Article 4 Other than quantities of states of physical phenomena stipulated in the previous article, measurement units for quantities of states of physical phenomena listed in the upper row of the Attached Table 2 are as listed in the bottom rows of the same table, and definitions for the same are defined by Cabinet Order.

2 Other than measurement units stipulated in the previous article, among quantities of states of physical phenomena listed in the upper row of the Attached Table 1, measurement units for those listed in the upper row of the Attached Table 3 are as listed in the bottom rows of the same table, and definitions for the same are defined by Cabinet Order.

(Note "Cabinet Order" in Paragraphs 1 and 2 = Measurement Unit Ordinance, Article 2)

Article 5 Other than measurement units stipulated in the preceding Article 2, measurement units, and definitions for the same, representing those in which the measurement unit has been multiplied by an integer power of 10 are defined by Cabinet Order.

2 Other than measurement units stipulated in the preceding Article 2 and the preceding Paragraph, measurement units, and definitions for the same, for lengths, masses, angles, areas, quantities, speeds, accelerations, pressures, and amounts of heat used in measurements of length at sea level and other special measurements defined by Cabinet Order are defined by Cabinet Order.

(Note "Cabinet Order" in Paragraphs 1 and 2 = Measurement Unit Ordinance, Articles 4 and 5)

(Prohibition on the Use of Non-Statutory Measurement Units)

Article 8 Measurement units (hereinafter referred to as "non-statutory measurement units") other than measurement units stipulated in Articles 3 to 5 (hereinafter referred to as "statutory measurement units") shall not be used for trading or

certification regarding quantities of states of physical phenomena listed in Article 2(1)(i).

2 to 3 (omitted)

[Attached Table 1] (Pertaining to Article 3)

Quantity of State of Physical Phenomenon	Measurement Unit
Length	Meter
Mass	kilogram, gram, ton
Time	second, minute, hour
Current	ampere
Temperature	Kelvin, Celsius degree or degree
Amount of Substance	mole
Intensity of Light	candela
Angle	radian, degree, second, minute
Solid Angle	steradian
Area	square meter
Volume	cubic meter, liter
Angular Velocity	radians per second
Angular Acceleration	radians per second per second
Speed	meters per second, meters per hour
Acceleration	meters per second per second
Frequency	Hertz
Rotational Speed	per second, per minute, per hour
Wavenumber	per meter
Density	kilograms per cubic meter, grams per cubic meter grams per liter
Force	newton
Moment of Force	newton-meter
Pressure	pascal or newtons per square meter, bar
Stress	pascal or newtons per square meter

Viscosity	pascal-second or newton-seconds per square meter
Kinetic Viscosity	square meters per second
Work	joule or watt-second, watt-hour
Engineering Rate	watt
Mass Flow	kilograms per second, kilograms per minute, kilograms per hour, grams per second, grams per minute, grams per hour, tons per second, tons per minute, tons per hour
Flow	cubic meters per second, cubic meters per minute, cubic meters per hour, liters per second, liters per minute, liters per hour
Amount of Heat	joule or watt-second, watt-hour
Thermal Conductivity	watts per meter per Kelvin, watts per meter per degree
Specific Heat Capacity	joules per kilogram per Kelvin or joules per kilogram per degree
Entropy	joules per Kelvin
Quantity of Electricity	coulomb
Electric Field Strength	volts per meter
Voltage	Volt
Electromotive Force	Volt
Capacitance	farad
Magnetic Field Strength	amperes per meter
Magnetomotive Force	ampere
Magnetic Flux Density	tesla or weber per square meter
Flux	weber
Inductance	henry
Electrical Resistance	ohm
Conductance of Electricity	siemens

Impedance	Ohm
Power	watt
Amount of Electrical Power	joule or watt-second, watt-hour
Power Density of Electromagnetic Waves	watts per square meter
Radiation Intensity	watts per steradian
Light Flux	lumen
Luminance	candelas per square meter
Luminescence	lux
Sound Power	watt
Concentration	mole per cubic meter, mole per liter, kilogram per cubic meter, gram per square meter, gram per liter
Neutron Emission Rate	per second, per minute
Radiation	becquerel, curie
Absorbed Dose	gray, rad
Absorbed Dose Rate	grays per second, grays per minute, grays per hour, rads per second, rads per minute, rads per hour
Kerma	gray
Kerma Rate	grays per second, grays per minute, grays per hour
Irradiation Dose	coulombs per kilogram, roentgen
Irradiation Dose Rate	coulombs per kilogram per second, coulombs per kilogram per minute, coulombs per kilogram per hour, roentgens per second, roentgens per minute, roentgens per hour
Dose Equivalent	sievert, rem
Dose Equivalent Rate	sieverts per second, sieverts per minute, sieverts per hour, rems per second, rems per minute, rems per hour

[Attached Table 2] (Pertaining to Article 4)

Quantity of State of Physical Phenomenon	Measurement Unit
Reactive Power	Bar
Apparent Power	volt-ampere
Reactive Energy	bar/second, bar/hour
Apparent Energy	volt-ampere, volt-ampere-hour
Attenuation of Electromagnetic Waves	decibel
Sound Pressure Level	decibel
Vibration Acceleration Level	decibel

[Attached Table 3] (Pertaining to Article 4)

Quantity of State of Physical Phenomenon	Measurement Unit
Rotational Speed	revolutions per minute, revolutions per hour
Pressure	atm
Viscosity	poise
Kinetic Viscosity	stokes
Concentration	percent by weight, parts per thousand by weight, ppmw, ppbw, pptw, ppqw, percent by volume, parts by thousand by volume, ppmv, ppbv, pptv, ppqv, pH

Supplementary Provisions

(Measurement Units)

Article 3 Measurement units listed in the lower rows of the Attached Table 1 of the Supplementary Provision, and measurement units representing those in which the measurement unit has been multiplied by an integer power of 10 and which are defined by Cabinet Order, until September 30, 1995, are treated as statutory

measurement units of Article 8(1) (hereinafter, simply "statutory measurement units") of the Measurement Act, revised (hereinafter, "New Act"), for quantities of states of physical phenomena listed in the upper row of the same table.

- 2 Measurement units listed in the lower rows of the Attached Table 2 of the Supplementary Provision, and measurement units representing those in which the measurement unit has been multiplied by an integer power of 10 and which are defined by Cabinet Order, until September 30, 1997, are treated as statutory measurement units for quantities of states of physical phenomena listed in the upper row of the same table.
- 3 Measurement units listed in the lower rows of the Attached Table 3 of the Supplementary Provision, and measurement units representing those in which the measurement unit has been multiplied by an integer power of 10 and which are defined by Cabinet Order, until September 30, 1999, are treated as statutory measurement units for quantities of states of physical phenomena listed in the upper row of the same table.
- 4 Definitions of measurement units stipulated in the prior Paragraph 3 are defined by Cabinet Order.

Article 4 Regarding measurement units stipulated from Paragraphs 1 to 3 of the previous Article, even subsequent to the date defined in these provisions, it is presumed that the measurement units may be treated as statutory measurement units.

- 2 In the case of the previous paragraph, a deadline for treating the measurement units as statutory measurement units by the Cabinet Order, as well as the extent of transactions and certifications that can be used for the same and methods used for the same, shall be defined.

(Measurement Units According to Imperial Units)

Article 5 Measurement units, and their definitions, according to Imperial units are defined by Cabinet Order.

- 2 (omitted)

(French Horsepower)

Article 6 French horsepower, when used for such trading or certification defined by Cabinet Order as trading, certification, etc., relating to an internal combustion engine, for the time being, it to be treated as a statutory measurement unit for engineering rate.

2 The definition of French horsepower is defined by Cabinet Order.

(Identifications, Etc., for Measurement Units)

Article 8 By the due date stipulated in Paragraphs 1 to 3 of Article 3 of the Supplementary Provision, identifications by measurement units defined by these provisions shall be provided in a document, and when attached to exhibits for goods, etc., identification of the same, regardless of provisions in Article 8(1) of the New Act, can be used for transactions or certifications even subsequent to the due date.

[Supplementary Provisions, Appendix 1]

Quantity of State of Physical Phenomenon	Measurement Unit
Force	dyne
Work	erg
Amount of Heat	kilogram-force meter, erg
Neutron Emission Rate	neutrons per second, neutrons per minute
Radiation	disintegrations per second, disintegrations per minute

[Supplementary Provisions, Appendix 2]

Quantity of State of Physical Phenomenon	Measurement Unit
Length	micron
Frequency	cycle or cycles per second
Magnetic Field Strength	ampere turns per meter, oersted
Magnetomotive Force	ampere turns
Magnetic Flux Density	gamma, gauss

Flux	maxwell
Sound Pressure	phon
Level	as defined
Concentration	

[Supplementary Provisions, Appendix 3]

Quantity of State of Physical Phenomenon	Measurement Unit
Force	kilogram-force, gram-force, ton-force
Moment of Force	kilogram-force meter
Pressure	kilograms-force per square meter grams-force per square meter, meter mercury column, meter water column
Stress	kilograms-force per square meter, grams-force per square meter
Work	kilogram-force meter
Engineering Rate	kilogram-force meters per second
Amount of Heat	
Thermal	calorie
Conductivity	calories per second per meter per degree, calories per hour per meter per degree
Specific Heat	calories per kilogram per degree
Capacity	

Chapter 1 Requirements for Description

2101 Points to Note When Acquisition of Prior Art Documents is Difficult

The Examiner, in such as a case in which acquisition of prior art documents disclosed in the detailed description of the invention is difficult, can issue a Notification by Examiner based on provisions of Article 194(1) (Submission, Etc., of Documents), and require that the applicant provide submission of an exhibit of documents, etc., necessary for examination.

2102 Determination Regarding An Amendment Adding Prior Art Document Information (Applied to Applications for Which the Filing Date (For Divisional/Converted Applications, Etc., the Actual Filing Date) Is On or Before December 31, 2008)

An amendment which adds content provided in prior art documents to the column for [Background Art] of the detailed description of the invention does not correspond to an addition of new matter, and therefore is legitimate. However, adding such information related to an evaluation of the invention as a comparison, etc., with the invention according to the claimed invention, or information related to an implementation of the invention, or adding contents provided in a prior art document to resolve a defect of Article 36(4)(i), corresponds to an addition of new matter, and therefore is an illegitimate amendment.

Regarding details, refer to 3.3.2(1) of "Part IV Chapter 2 Amendment Adding New Matter" of the Examination Guidelines.

2103 Example in Which It is Possible to Perform Notification of Article 48septies at the Same Time as or Subsequent to Notification of A First Reason for Rejection

For an application in which, for example, contents of prior art are provided in the detailed description of the invention, but prior art document information corresponding to the prior art is not provided, and therefore, it is found that the prior art document information disclosure requirement is not satisfied, if the prior art document information is necessary for determining novelty/inventive step, etc., then the Examiner may perform both the notification of Article 48septies and the first Notification of Reason for Rejection (limited to notifications which do not refer to publicly known literature, related to the prior art document information; hereinafter the same shall apply in this item) at the same time, or perform notification of Article 48septies subsequent to notification of the initial Notification of Reason for Rejection.

In addition, even in such a case as when the contents of the application are significantly unclear, and investigation regarding such patent requirements as novelty/inventive step is difficult, it is possible to simultaneously perform the notification of Article 48septies and a Notification of Reason for Rejection notifying only reasons for rejection related to description requirements, etc., of the descriptions and the claims.

However, notification of Article 48septies is not performed uniformly, but is only performed in a case in which the Examiner finds a need.

2104 Description Procedure for Journals

For the description procedure for journals, refer to 1207 of "Part I Chapter 2 Procedures of Examination" of the present handbook.

However, even in "(7) Cases of the description, etc. in full text of Japanese utility model applications based on the former act of utility model on or before the date of 31 December, 1993" in "1. Publication of national patent application, utility model application, etc., (Examples of statements)", description of "(5) Case of publication of unexamined patent applications or unexamined utility model application" is sufficient.

Chapter 2 Requirements for Claims

2201 Requirement of Definiteness When Description Using Alternative Forms Such as Markush Form Pertains to a Chemical Substance

When a description using an alternative form such as Markush Form relates to chemical substances, then if the requirements of the following (i) to (ii) are satisfied, the substances possess similar qualities or functions, and therefore, it is possible to clearly understand the one invention.

- (i) Chemical substances pertaining to all options have common properties or activities.
- (ii) There is a common chemical structure, namely, all options share an important chemical structure element (Note 1); or if the shared chemical structure is not a determination criterion, then all options belong to a chemical substance group (Note 2) that is recognized as one group in the technical field to which the invention belongs.

(Note 1) "All options share an important chemical structure element" refers to the following either (a) or (b). Moreover, the chemical structure element may be one portion, or a combination of individual portions that are mutually linked.

- (a) such a case as in which a plurality of chemical substances have a shared chemical structure occupying a significant portion of the chemical structure thereof
- (b) in the case when the chemical substance only shares an insignificant portion of the chemical structure, the case in which the shared chemical structure, in view of the prior art, constitutes a structurally conspicuous portion

(Note 2) "A chemical substance group recognized as one group" refers to a group of chemical substances that are predicted to act in the same manner under the invention provided in the claims on the basis of knowledge in the technical field of the same. That is to say, it means that an equivalent result can be acquired even if each of the chemical substances belonging to this chemical substance group is interchanged.

2202 Description Forms for Claims - Independent and Dependent Forms

In Article 24ter(iii) of the Patent Law Rules of Practice, it is described that "citation of another claim in the statement of a claim shall be performed using the number imparted to that claim," and in the item (iv) of the same paragraph, it is described that "when providing a claim so as to refer to a statement of another claim, the claim shall be provided prior to the cited claim." In this manner, as a description form for a claim, providing another claim by reference is admitted, and a claim provided using this type of description form is referred to as a "dependent form claim." In addition, a claim provided which does not refer to another claim is referred to as an "independent form claim." Furthermore, for both types, only the description expression differs, and both types receive equivalent handling.

1. Independent-form claims

A description of an independent-form claim is possible regardless of whether or not the invention according to the independent-form claims is the same as an invention according to another claim.

2. Dependent-form claims

2.1 A typical dependent-form claim

A dependent-form claim is used to simplify the description of a claim so as to avoid a duplicate description of text in the claims. However, a description according to the dependent-form claim is possible regardless of whether or not the invention according to the dependent-form claim is the same as an invention according to a claim referring to an invention according to the dependent claim.

A typical example in which a claim can be provided in the dependent-form is a case in which a claim comprising all features of one other preceding claim is provided.

By providing a claim in dependent form in this type of case, it is possible to omit repeated descriptions of text, as well as to clarify differences between a cited claim and a claim which is provided so as to cite the cited claim, and therefore, there are such advantages as reducing burden on the applicant, and facilitating understanding by a third party.

Example: a typical claim in dependent form.

[Claim 1] Construction-use wall material comprising thermal insulation material

[Claim 2] The construction-use wall material according to claim 1, for which the thermal insulation material is polystyrene foam

2.2 Dependent-form claims other than the above.

Even in such cases as the following (i) or (ii), unless the statement of the claim becomes unclear, there are cases in which the statement of a claim becomes brief by referring to a statement of another claim so as to perform description as a dependent-form claim.

- (i) when providing a claim in which a portion of matter for identifying an invention of another preceding claim is substituted
- (ii) when providing a claim of a category expression which is different from another preceding claim

Example 1: A dependent-form claim in which a portion of matter for identifying an invention of another preceding claim is substituted

[Claim 1] A transmission device of a specific structure provided with a gear transmission mechanism

[Claim 2] In the transmission device provided in claim 1, a transmission device provided with a belt transmission mechanism instead of the gear transmission mechanism

Example 2: A dependent-form claim described by reference to a statement of a claim expressed using a different category

[Claim 1] A ball bearing of a specific structure.

[Claim 2] A manufacturing method for the ball bearing described in claim 1 using a specific step

Example 3: A dependent-form claim described by reference to a statement of a claim of a subcombination

[Claim 1] A bolt having a thread of a specific structure.

[Claim 2] A nut having a thread of a specific structure engaging the bolt described in claim 1.

2.3 Multiple dependent-form claims

A multiple dependent-form claim is a claim described by reference to a description of two or more other claims (regardless of whether they are in dependent-form or independent-form), and is used to simplify the description of all claims of a patent.

A claim in this form, in comparison with separately describing a plurality of claims in ordinary dependent-form, although having merits in aspects of description and fees, is a single unit for waiver or a trial for invalidation, and therefore, also inherently possesses such demerits as being waived or invalidated together. Therefore, the determination of whether to use ordinary dependent-form claims or multiple dependent-form claims should be made after sufficiently comparing and considering such points, and the selection of the same should be entrusted to the determination of the applicant.

In addition, in Patent Law Rules of Practice Form 29bis [Remarks] 14 Ni, it is described that, when describing a claim in multiple dependent-form, descriptions of two or more other claims should be referred to as alternatives to each other, and the same technical limitation should be attached in description thereof (Patent Law Rules of Practice Form 29bis [Remarks] 14).

Example: A description of a claim using a multiple dependent-form claim

[Claim 1] An air-conditioning device having a specific structure

[Claim 2] The air-conditioning device described in claim 1 having a wind direction adjustment mechanism.

[Claim 3] The air-conditioning device described in claims 1 or 2 having an air volume adjustment mechanism.

Moreover, where, when a claim is stated referring to a statement of more than one other claim in the alternative, the preceding claim which it refers is the one which refers to a statement of more than one other claim in the alternative, it violates the Delegated Ministerial Ordinance Requirement on Statement of Claims (Article 36(6)(iv), the Ordinance for Enforcement Art. 24ter(v)) (see 2. in "Part II Chapter2 Section5 Ministerial Ordinance Requirement on Statement of Claims" of the Examination Guidelines.)

3. The relationship between rules of practice form remarks pertaining to described forms for claims and reasons for rejection

In a case of describing using a form referring to multiple clauses, when citations of two or more descriptions of claims are not stated as alternatives to each other (examples 1 and 2), or when the same technical limitation is not attached thereto (examples 3 and 4), there are cases in which there is no match to the instructions pertaining to the described form for a claim within the form remarks of the Patent Law Rules of Practice (Patent Law Rules of Practice Form 29bis [Remarks] 14 Ni). However, these instructions are not requirements that are legally required, and therefore, this is not a violation of Article 36(6)(iv).

However, the Examiner shall note that there are cases in which an invention may become unclear by citations of statements of two or more other claims not being stated as alternatives to each other, or by the same technical limitation not being attached thereto.

(i) There are cases in which, by way of citations of statements of claims not being stated so as to be alternatives to each other, the description becomes unclear, and as a result, a claimed invention becomes unclear. However, the Examiner shall note that even if the citations are not stated so as to be alternatives to each other, there are cases in which the invention is clear.

Example 1: An example in which an invention becomes unclear as a result of citation of statements of claims not being stated as alternatives to each other:

[Claim 1] An air-conditioning device having a specific structure

[Claim 2] The air-conditioning device described in claim 1 having a wind direction adjustment mechanism.

[Claim 3] The air-conditioning device described in claims 1 or 2 having an air volume adjustment mechanism.

(Explanation)

In claim 3, claims 1 and 2 are connected using the conjunction "and," and therefore, the citations are not stated so as to be alternative to each other, and the invention pertaining to claim 3 is unclear (see 2.2(1) of "Part II, Chapter 2, Section 3: Requirement of Definiteness" of the Examination Guidelines).

Example 2: An example in which an invention is clear although citations of statements of claims are not stated as alternatives to each other.

[Claim 1] A bolt having a thread of a specific structure.

[Claim 2] A nut having a screw groove of a specific structure.

[Claim 3] A fastener device comprising the bolt described in claim 1 and the nut described in claim 2.

(Explanation)

In Claim 3, claims 1 and 2 are connected using the conjunction "and." However, it is clear that the fastener device of claim 3 is a fastener device comprising both the bolt of claim 1 and the nut of claim 2, and therefore, the invention is clear.

(ii) There are cases in which, as a result of the same technical limitation not being attached to claims to be referred to, the invention is unclear. However, the Examiner shall note that, even if the same technical limitation is attached, there are cases in which the invention may be clear, or that even if the same technical limitation is attached, there are cases in which the invention may be unclear.

Example 3: An example in which the same technical limitation is not attached to a claim to be referred to, and therefore, the invention is unclear:

[Claim 1] An air-conditioning device having a specific air volume adjustment structure A.

[Claim 2] An air-conditioning device having a specific state display structure B.

[Claim 3] The air-conditioning device described in claim 1 having a wind direction adjustment mechanism, or the air-conditioning device described in claim 2 having a timer mechanism.

(Explanation)

To claims 1 and 2 referred to in claim 3, different technical limitations are each attached, and therefore, the invention pertaining to claim 3 is unclear (see 2.2(4) of "Part II, Chapter 2, Section 3: Requirement of Definiteness" of the Examination Guidelines).

Example 4: An example in which the claims that are referred to so as to be alternative to each other do not have the same technical limitation attached thereto, and therefore, do not match instructions for form remarks (see Patent Law Rules of Practice Form 29bis [Remarks] 14 **Ni**); however, options for claim descriptions have similar properties or functions, and therefore, the requirement for definiteness is not violated.

[Claim 1] An air-conditioning device having a specific structure.

[Claim 2] The air-conditioning device described in claim 1 having a wind direction adjustment mechanism.

[Claim 3] The air-conditioner device described in claim 1 having an air volume adjustment mechanism, or the air-conditioner device described in claim 2 having a timer mechanism.

(Explanation)

In claims 1 and 2 cited in claim 3, a different technical limitation of a "wind direction adjustment mechanism" and a "timer mechanism" is each attached, respectively. However, both of the options have a similar property or function in the point of being an air-conditioning device having a specific structure.

Example 5: An example in which, even if the same technical limitation is attached to claims to be referred to, inventions pertaining to the claims to be referred to belong to mutually different categories, and therefore, the category of the claimed invention is unclear.

[Claim 1] An artificial heart of a specific structure

[Claim 2] A manufacturing method for an artificial heart of a specific structure by way of a specific step.

[Claim 3] A manufacturing method for the artificial heart described in claim 1, or the artificial heart described in claim 2, provided with a specific safety device.

(Explanation)

To claims 1 and 2 referred to in claim 3, the same technical limitation of a being "provided with a specific safety device" is attached. However, the invention pertaining to claim 1 is an "invention of a product," and the invention pertaining to claim 2 is a "manufacturing method," and therefore, the inventions pertaining to the cited claims 1 and 2 belong to different categories. As a result, the category of the invention related to claim 3 is unclear, and therefore, the invention related to claim 3 is unclear (see 2.2(3) of "Part II, Chapter 2, Section 3: Requirement of Definiteness" of the Examination Guidelines).

2203 Points to Note in Examination When a Claim for an Invention of a Product Recites the Manufacturing Process of the Product

Examiner shall proceed with the examination while paying attention to the following points when determining whether or not “4.3.2 The case where a claim concerning an invention of a product includes a manufacturing method for a product” of “Part II Chapter 2 Section 3 Clarity Requirement” is relevant, and proceeding with the examination in cases where it is relevant.

- (1) The Examiner shall determine, on the basis of the present handbook, Section 2204, whether or not at least a portion of claims pertaining to an invention of a product corresponds to a "case where a claim concerning an invention of a product includes a manufacturing method for a product".
- (2) The Examiner shall determine, on the basis of the present handbook, Section 2205, whether or not, when a determination is made of correspondence to the "case where a claim includes a manufacturing method for a product" in the above (1), regarding the description, whether or not the description corresponds to a "case of existence of impossible/impractical circumstances¹." In addition, if a claim and a proof have been made that the circumstances exist in the descriptions, an opinion, etc., a determination is to be made in consideration of the same.
- (3) Subsequent to Final Notification of Reasons for Rejection, after receiving a demand for an Appeal Against Examiner's Decision of Rejection/Refusal or a notification of Article 50bis, regarding an amendment which treats a "description of a manufacturing method for the product" as, simply, a description of such aspects as a structure or characteristics, or an amendment which, if a manufacturing method for the product is provided in the invention for the product, simply treats the invention as an invention of the manufacturing method for the product, then the Examiner, normally, shall find that the amendment is an amendment corresponding to a clarification of an unclear description (Article 17bis(5)(iv)).²

¹ I.e., " circumstances that is impossible or utterly impractical to define the product by its structure or characteristics at the time of filing."

² Hypothetically speaking, if the amendment is not performed, then ordinarily, this means that a Notification of Reasons for Rejection for violation of the requirement for definiteness has been notified, and furthermore, in applying the provisions of Article 17bis(5), the legislative intent of the same should be sufficiently taken into consideration so as not to operate any more strictly than necessary. Therefore, this time, the amendment is to be admitted. The provisions of the same paragraph are to be treated as having been provided with the intent of establishing an examination

procedure which quickly and accurately secures granting of rights while taking into consideration the basic purpose of the patent system, which is to fully achieve protection for an invention, and in this end, an amendment in response to a Final Notification of Reasons for Rejection is to be performed within a scope in which it is possible to effectively utilize the examination results that have already been performed. Furthermore, it is considered that even if the amendment is admitted, the examination results that have already been performed can generally be effectively utilized.

2204 Determination on Whether or Not "When a Claim for an Invention of a Product Recites the Manufacturing Process of the Product" is Relevant

1. Basic idea

- (1) The examiner determines whether or not at least a portion of a claim for an invention of a product corresponds to a "case where a claim recites the manufacturing process of the product" by taking into consideration, in addition to the description, the claims, and the drawings, as well as common general knowledge, at the time of the filing of the application, in the technical field to which the invention belongs. (It is necessary to note that even if one of the following types or examples appears to be relevant, there are cases in which different determinations may be made on the basis of common general knowledge in the technical field.)

Particularly, even if a claim corresponds formally to one of the following types or examples showing "where a claim recites the manufacturing process of the product", when it is clear what structure or characteristics of the product are represented by the manufacturing process (Note)³ considering the description, claims and drawings as well as common general knowledge, at the time of the filing of the application, in the art to which the invention belongs, the examiner does not consider that the claimed invention violates the clarity requirement on the basis that it corresponds to a case "where a claim recites the manufacturing process of the product".

(Note) The Pravastatin Sodium Case decisions (the Supreme. Court of Japan, June 5, 2015, Second Petty Bench, case Nos. 2012 (Ju) 1204 and 2012 (Ju) 2658)

- (2) In view of the fact that the burden of proof for the description requirement, in general, is on the applicant side, the examiner may notify, if he/she considers appropriate, a reason for refusal for the violation of the clarity requirement and thereby provide the applicant with an opportunity to argue and verify that "impossible or impractical circumstances" exist, or an opportunity to submit a written opinion and/or amendment. It is appropriate to avoid, by doing so, the situation where a patent is subsequently granted containing a reason for invalidation,

³ An example where it is considered to be clear what structure or characteristics of the product are represented by the manufacturing process, if considering the description, claims and drawings as well as common general knowledge, at the time of the filing of the application, in the art to which the invention belongs, although the case falls under Type (1-1):

"an apparatus having an anchorage formed by inserting a bolt provided with a convex portion into a hole provided with a concave portion so that the concave portion and the convex portion are engaged, and screwing a nut into an end portion of the bolt"

or the interests of third parties are unfairly prejudiced.

2. Types and examples corresponding to "case where a claim recites the manufacturing process of the product"

Type (1-1): Case in which, pertaining to manufacturing, a description of chronological elements exists

Example:

"A compound A sodium salt prepared by a process comprising the steps of:

- a) forming an enriched organic solution of the compound A;
- b) precipitating a compound A as its ammonium salt;
- c) purifying the ammonium salt by recrystallization;
- d) transposing the ammonium salt to sodium salt; and
- e) isolating a compound A sodium salt."

Example of Amendment:

"A manufacturing process for a compound A sodium salt comprising the steps of:

- a) forming an enriched organic solution of the compound A;
- b) precipitating a compound A as its ammonium salt;
- c) purifying the ammonium salt by recrystallization;
- d) transposing the ammonium salt to sodium salt; and
- e) isolating a compound A sodium salt."

Type (1-2): Case in which, pertaining to manufacturing, a description of a technical feature or condition exists

Examples:

"A polymer C acquired by reacting a monomer A with a monomer B at 50°C."

"A fluorescent body formed by sintering under 1 to 1.5 atmospheric pressures."

"A rubber manufactured good in which roughening treatment, in which a particulate substance is caused to collide with the exterior surface, has been applied"

Examples of Amendment:

"A manufacturing method for a polymer C in which a monomer A is reacted with a monomer B at 50°C."

"A manufacturing method for a fluorescent body manufactured via a sintering step under 1 to 1.5 atmospheric pressures."

"A manufacturing method for a rubber manufactured good in which roughening treatment, in which a particulate substance is caused to collide with the exterior surface, has been applied"

Type (1-3): Case of referring to an invention of a manufacturing process

Examples:

"A rubber composition manufactured using any of the manufacturing methods in claims 1 to 8"

"A polymer manufactured using any of the manufacturing methods in claims 1 to 4"

Examples of Amendment:

(Normally, if an invention of a manufacturing method is left as referred to, it is not possible to prevent, by way of an amendment, a "case in which a manufacturing method for a product is described" from being relevant.)

3. Types and examples not corresponding to a "case where a claim recites the manufacturing process of the product"

Type (2): Case in which, by indicating simply a state of the product, a claim recites the structure or characteristics of the product subject to the invention

Examples:

"An item in which a resin composition has been cured"

"An article in which an affixed chip is bonded to a sensor chip"

"An item in which A is formed to be of a different thickness from B"

"A composition formed by combining A with B"

"A tire created using a rubber composition"

"A laminated film formed by placing a layer C between a layer A and a layer B"

"Removably configured"

"A member B welded to a member A"

"A chamfered member"

"A lid caulked to a body"

"Spun twisted yarn using roving A and roving B"

"A pigment coated with a polymer A"

"A polymer polymerized a monomer A and a monomer B"

"A PEGylated protein"

"A modified protein A after translation"

"A humanized antibody"

"A protein having an amino acid sequence represented by SEQ. No. X in which at least one amino acid is deleted, substituted or added"

• In particular, shown below are terms whose concept is established as those specifying the structure or feature (property) of products. (For example, the definition, etc., of such a term can be found in a dictionary, a textbook, or a technical standards document, etc., and in this light, it is considered that the concept of that term has been established as that specifying the structure or feature (property) of a product.)

"A casting", "A casting product", "A forging"

"A welded part", "A brazed part", "A soldered part", "A fusion-spliced part"

"A machined part", "A cut off part", "A ground surface", "A press-fit surface", "A press-fit structure"

"A sintered object", "A green compact"

"An oriented film", "A blown film"

"Printed parts", "A printed coil", "A printed capacitor"

"A coating film", "A vapor-deposited film", "(as a layer or a film) A coating layer"

"A diffusion layer", "An epitaxial layer", "An epitaxial growth layer";

"Float glass", "A hot-dip zinc-coated steel sheet", "Vulcanized rubber", "An embossed product"

"A welded assembly", "An integrally molded article"

"Isolated cell", "Extract", "Threshed rice", "Spirits", "Plating layer"

(Points to Note)

Even if the wording in a claim differs from that in the operative examples of the above Type (2), it does not mean, thereby, the claim does not fall under Type (2). For example, when there is the wording which is similar to but is different in an expression from one of the operative examples in the above, the relevance to Type (2) is not denied only because of such difference in expression. The Examiner performs the examination based on the above "1. Basic idea".

2205 Determination on “Impossible/Impractical Circumstances” in Examination When a Claim for an Invention of a Product Recites the Manufacturing Process of the Product

1. Basic idea

- (1) The Examiner shall determine whether there exist "impossible/impractical circumstances" on the basis of claims/proofs by the applicant. At that time, the Examiner shall also take into consideration technical knowledge in the technical field to which the invention belongs (it is necessary for the Examiner to note that even if the following types and operative examples are formally relevant, there are cases in which different determinations may be made on the basis of technical knowledge in the technical field).
- (2) Unless there is reasonable doubt regarding the content of a claim/proof by the applicant regarding the existence of "impossible/impractical circumstances" (normally, unless the Examiner indicates a concrete doubt at the time of a Notification of a Reason for Rejection or the time of a Decision of Rejection), the Examiner shall make a determination that impossible or unrealistic circumstances exist.

2. Types and operative examples corresponding to "impossible/unrealistic circumstances"

Type (i): Case in which analyzing the structure or features of an item at application time is technically impossible

Type (ii): Case in which, in view of the fact that, due to the nature of a patent application, rapidity, etc., are required, significantly excessive financial expenditure or time would be required to perform work to identify the structure or properties of the item.

Operative Example:

- Cells, etc., created by a new genetic manipulation
(Judgment of the Second Petty Bench of the Supreme Court (June 15, 2015(Minshu vol. 69 No. 4 Page 700, Minshu vol. 69 No. 4 Page 904)))
- A monoclonal antibody prepared by a hybridoma cell A
(Reference Decision: Appeal 2014-17732)
- Animal and plant obtained by the breeding method such as crossbreeding
(Reference Decision: Appeal 2014-10863)

Reference examples are provided at the end of this section, in which applicants of a patent assert or verify cases where a patented invention falls under Type (i) or (ii), or both and "Impossible/Impractical Circumstances" exists.

3. Types and operative examples not corresponding to "impossible/unrealistic circumstances"

Type (iii): Case in which a relationship with the invention of the present application is completely undescribed

Operative Example:

- A case in which, simply, only a claim that time is required for creating the "the claims" has been made
- A case in which, simply, only a claim that performing description using a manufacturing method is easier to understand

● Reference examples of arguments and verification presented by applicants involving “impossible or impractical circumstances” (See 2.)

The followings are reference examples of arguments and verification involving “impossible or impractical circumstances”

(Note) The JPO hereby provides applicants with those examples, for a reference purpose, where the existence of “impossible or impractical circumstances” can be recognized in patent examination⁴, but does not show types of examples in an exhaustive manner. Thus, even if a case does not fall under any of those, it does not necessarily mean that the existence of “impossible or impractical circumstances” for that case cannot be recognized. Conversely, even if the formality of any of the examples below is followed, such circumstances are not always recognized, since, in practice, the existence of “impossible or impractical circumstances” is considered on a case by case basis, taking into account the specific content of arguments and verification.

Regarding claims for products reciting manufacturing processes of the products, when a person skilled in the art cannot understand features of a product (structure, property, etc.) even considering the content of the description and drawings as well as the common general knowledge at the time of the filing of an application, to the extent that patentability

⁴ In procedures in which a third party is involved after a patent is granted, a conclusion on whether the circumstances exist or not may change depending on the contents of arguments and verification presented by the parties.

requirements such as novelty and inventive step cannot be determined, the invention is deemed to be unclear regardless of the existence of “impossible or impractical circumstances”, since the invention cannot be understood from one claim in such a case⁵. The following examples are shown on the premise that an invention does not involve such unclearness.

Furthermore, the following examples do not prejudge whether an invention satisfies the patentability requirements such as novelty and inventive step.

Example 1

(1) Claim

[Claim 1] An aromatic device comprising:
a holder having at least one air vent opening; and
an aroma generation source and a heating element disposed in said holder,
wherein said aroma generation source includes an activated carbon molding and is heated with said heating element at the temperature in the range from X to Y degrees Celsius,
wherein said aroma generation source is produced by heating said activated carbon molding impregnated with a solution of an aromatic ingredient A at the temperature of less than or equal to the heating temperature of said heating element for Z hours or longer.

(2) Arguments and verification regarding “impossible or impractical circumstances” presented by the applicant in a written opinion

The present invention relates to an aromatic device having an aroma generation source where an aromatic ingredient A existing near the surface of an activated carbon molding is volatilized and the aromatic ingredient existing deeply inside of the activated carbon molding remains. In order to specify the feature of the present invention which cannot be seen in the prior art, claim 1 includes a part stating that said activated carbon molding impregnated with a solution of an aromatic ingredient A is heated at the temperature of less than or equal to the heating temperature of said heating element for Z hours or longer. With that claim element as described, the present invention can obtain an aromatic device which is capable of preventing volatilization of the aromatic ingredient in storage, thereby it can solve the problem of the prior art that the emission efficiency of the aromatic ingredient varies depending on the state of preservation (see paragraphs X-X in the description of the present application).

⁵ Examination Guidelines for Patent and Utility Model, Part II, Chapter 2, Section 3, Clarity Requirement, 4.3.1(2).

However, it is not possible to directly define the feature of the present invention described above by the structure or property of the product.

First, it is impossible to specify the feature of the invention (i.e. the aromatic ingredient exists not near the surface but deeply inside of the activated carbon molding) simply by the wording such as “said aromatic ingredient exists only in the region deeper than XX μm from the surface”, in light of the fact that each activated carbon molding has a different structure and different properties associated therewith. In addition, there is no other wording clearly specifying the feature described above by structure or property.

Secondly, it is also impossible to specify the structure or property of the aroma generation source having the feature described above by analyzing the results of measurement, even considering the analytical technique at the time of the filing of the application. Specifically, methods of measuring the state of existence of materials in detail include, for example, a scanning electron microscope (SEM), ..., but any of those measuring methods can only measure the state of the surface of samples and thus is not appropriate for analyzing porous material having complicated inside structures such as activated carbon. Even if an analytical technique such as X-ray diffraction (XRD) is used, accurate data cannot be obtained due to volatilization of the aromatic ingredient. As described, there was actually no appropriate means for measurement and analysis.

Assuming that the state of the aromatic ingredient existing inside of the activated carbon molding can be measured by cutting off a sample of the molding to expose the inside thereof, this only reveals a microscopic state of the specific sample. It is utterly impractical to find an index specifying the feature described above through numerous trial-and-error processes by performing difficult operations and measurements repeatedly many times and then utilizing statistical processing methods.

In Example 1 described above, the written opinion explains in a concrete manner that the wording cannot be found specifying the structure or property concerning the difference between the present invention and the prior art, and that it is impossible or impractical to analyze and specify such structure and property based on the measurement. Therefore, Example 1 is deemed to be the case where the existence of “impossible or impractical circumstances” can be recognized.

Example 2**(1) Claim**

[Claim 1] A thin film semiconductor device comprising:
 a structure of ...; and
 an oxide semiconductor film consisting of XXX oxide as an active layer,
 wherein the oxide semiconductor film is formed on a substrate by sputtering, using a target of metal oxide, at the temperature of the surface of the substrate from X to Y degrees Celsius.

(2) Arguments and verification regarding “impossible or impractical circumstances” presented by the applicant in a written opinion

An oxide semiconductor film consisting of XXX oxide is formed on a substrate by sputtering under controlling the temperature of the surface of the substrate from X to Y degrees Celsius, so that the resulting oxide semiconductor film has high crystallinity. The present invention provides a thin film semiconductor device having the resulting oxide semiconductor as an active layer, thereby a high performance of switching can be achieved (see the description of the present application, paragraphs X-X).

A conventional thin film semiconductor device using an oxide semiconductor film can be only obtained with a relatively low performance due to low crystallinity of an oxide semiconductor film (see JP YYYY-XXXXXX A). This means when the thin film semiconductor is used for a cellular phone of which battery capacity is limited, available time on one charge is not long, and thereby usability as the cellular phone is impaired (see the description of the present application, paragraphs Y-Y).

Though the difference between the present invention and the prior art is attributed to the difference in crystallinity of an oxide semiconductor film, in light of the non-uniformity of the thin film crystal, it is not possible categorically to specify the structure or property of the difference.

Meanwhile, the difference in crystallinity between them could be measured by X-ray diffraction (XRD) in principle, however, in practice, it is required to produce or purchase the statistically-significant number of thin film semiconductor devices of the present invention and those of the prior art respectively, and to measure a numerical feature of XRD spectrum for statistically processing the feature, and then to find a significant index and its actual value to distinguish between the present invention and the prior art through those processes. Those processes need

enormous time and costs. Furthermore, since the prior art has huge variations, the number to be statistically significant cannot be clearly determined.

Therefore, it is not practical that the feature of the present invention is specified by the structure of property of the product of the invention after the index and its value are found in the way as described above.

In Example 2 described above, similar to Example 1, the written opinion also explains in a concrete manner that the wording cannot be found specifying the structure or property concerning the difference between the present invention and the prior art, and that it is impossible or impractical to analyze and specify such structure and property based on the measurement. Therefore, Example 2 is deemed to be the case where the existence of “impossible or impractical circumstances” can be recognized.

Example 3

(1) Claim

[Claim 1] An oil-in-water type creamy emulsion composition for foods comprising water, an oil component, emulsifiers, a component A and a component B, and having viscosity of X-Y mPa·s ,

wherein said emulsion composition includes an emulsifier X and an emulsifier Y with 10-20/30-40 weight ratio,

and wherein an oil phase containing said emulsifiers, the component A and the component B are prepared in advance by mixing and stirring them and then the resulting product is added to a water phase to obtain said emulsion composition.

(2) Arguments and verification regarding “impossible or impractical circumstances” presented by the applicant in a written opinion

The present invention prepares in advance an oil solution in which the prescribed emulsifiers, component A and component B are dispersed in the solution, and then the oil solution is added to a water phase for emulsion. The present invention provides an oil-in-water type creamy emulsion composition for foods having a good foam stability compared to one obtained by a conventional method in which a water phase dissolving an emulsion, a component A and a component B is added to an oil phase for emulsion (see the description of the present application, paragraphs X-X).

As described, compared to the prior art, the good foam stability achieved by the present invention is caused by the microscopic difference in a dispersed state of the components provided by the different manufacturing process. The microscopic difference in the dispersed state cannot be identified by the general index such as a composition or viscosity.

Even if it is attempted to express the property of foam stability itself in a numerical range, a microscopic dispersed state in an oil-in-water type creamy emulsion composition for foods varies depending on a composition of a raw material, a temperature, a stirring speed and other manufacturing conditions. Then, if a microscopic dispersed state is different, a numerical value of foam stability naturally changes. Thus, manufacturing the product with raw materials constituting various compositions under various manufacturing conditions such as the temperature and the stirring speed and measuring the foam stability of each resulting product requires impractical numbers of experiments and drastically huge economic expenses. Furthermore, the result cannot be expressed in a claim comprehensively.

Therefore, it is utterly impractical to “specify a product directly by structure or property at the time of the filing of an application” with regard to the present invention.

Example 3 as described falls under the case where the concrete aspects of the structure or property of the product vary depending on various concrete modes of the manufacturing method recited in the claim, and those concrete aspects cannot be expressed comprehensively, thus it is impossible or impractical to specify the product directly by its structure or property. The written opinion explains the situation concretely. Therefore, Example 3 is deemed to be the case where the existence of “impossible or impractical circumstances” can be recognized.

Example 4

(1) Claim

[Claim 1] A flavor improving agent prepared by the successive steps of:

obtaining a concentrated solution by heating and concentrating sugar cane juice at the temperature of 120-130 degrees Celsius until an indicator of a sugar refractometer becomes 70-80 degrees with a Brix scale; and collecting distillation by collecting and cooling vapor which can be obtained by distilling said concentrated solution at the temperature of 120-130 degrees Celsius.

(2) Arguments and verification regarding “impossible or impractical circumstances” presented by the applicant in a written opinion

The present invention relates to a flavor improving agent obtained by collecting the distillation of sugar cane juice through each manufacturing process described in claim 1 of the present invention. The flavor improving agent of the present invention is manufactured by heating and concentrating the sugar cane juice at the temperature of 120-130 degrees Celsius until an indicator of a sugar refractometer becomes 70-80 degrees with a Brix scale before distillation, thereby the flavor improving agent of the present invention can have an effect of adding an agreeable natural flavor of brown sugar on foods compared to the conventional flavor improving agent produced by simply distilling and purifying concentrated sugar cane juice without heating and concentrating the juice which can bring such high sugar content. This comparison is clearly shown in Examples X-X and Comparative examples Y-Y in the present description.

First, the description “an agreeable and natural flavor” cannot be expressed quantitatively such as in the numerical range because it is an index relying on a subjective preference of people.

It is the common general knowledge at the time of the filing of the present application that a flavor improving agent derived from a natural product such as sugar cane juice is a composition containing various different chemical substances, and the flavor becomes different from an interaction of the each chemical substance. The flavor improving agent of the present invention and the conventional flavor improving agent as described above have 99.99 wt% of the same composition, as described in Table X in the present description. From this fact, it is apparent that very small amount of a component (a trace component) contributes to giving a good effect of the flavor improving agent of the present invention as described above. However, there are a very large number of such components which constitute the flavor improving agent of the present invention, and some of those components are less than the detection limit of analytical instruments.

Therefore, it is impossible to analyze and specify which chemical substance in trace components contributes to giving an effect of adding a good flavor among a very large number of trace components constituting the flavor improving agent of the present invention. This is because there are a large number of types of chemical substances contained in the analysis objects and the components less than the detection limit cannot be analyzed.

Assuming that an analyzer which has a quite low detection limit of concentration is used and thereby the trace components constituting the flavor improving agent can be all specified, a chemical substance which generates “an agreeable and natural flavor” of the present invention cannot be specified just by identifying a flavor of each trace component because a flavor in the

flavor improving agent is generated by blending flavors of a plurality of chemical substances. Therefore, in order to specify the chemical substance, it is required to try all the combination of all chemical substances constituting the flavor improving agent of the present invention including a large number of trace components and to identify the flavor generated by each combination one by one, which needs an enormous number of trials. In addition, for these trials, a large number of all trace components should be purified until they reach to a high purity respectively since an influence of a chemical substance other than a chemical substance used for a trial should be completely eliminated.

In conclusion, it would have to be said for “a flavor improving agent” of claim 1 of the present invention that it is utterly impractical to specify “a flavor improving agent” directly by its structure or property, by means of clearly specifying component(s) contributing to the effect of the present invention.

In Example 4 as described above, the written opinion concretely explains that it is impossible or impractical to specify the product directly by its structure or property since the product is derived from a natural product. Therefore, the present example is deemed to be the case where “impossible or impractical circumstances” exist.

Example 5

(1) Claim

[Claim 1] A polymerized composition prepared by the steps of:

reacting preliminarily a compound having three or more mercapto groups in one molecule and a compound having two or more isocyanate groups in one molecule for 5 to 10 minutes at the temperature of 40-50 degrees Celsius; and then

reacting a reaction solution containing the oligomer obtained by the reaction described above, a compound having two mercapto groups in one molecule and ...

(2) Arguments and verification regarding “impossible or impractical circumstances” presented by the applicant in a written opinion

... A polymerized composition defined in claim 1 comprises a compound having three or more mercapto groups in one molecule as a raw material, and further comprises an oligomer obtained under the reaction condition that the compound is preliminary reacted at the temperature of 40-50 degrees Celsius for 5-10 minutes. Therefore, a structure of the resulting polymerized composition becomes absolutely too complicated to express by a general formula (a structural formula), which

is the common general knowledge for a person skilled in the art. It is also impossible to express the polymerized composition by the property because a property of a substance cannot be easily understood until a structure thereof is specified, as the property can be determined accordingly, and also because a property of a resulting polymerized composition obtained by a reaction of multiple different kinds of monomers varies depending on a compounding ratio of monomers or a reaction condition. Namely, a polymerized composition defined in claim 1 of the present invention cannot be specified directly by the structure or property of the product, but can be specified only by a process (manufacturing process) for preparation of the product.

Therefore, the invention of the polymerized composition defined in claim 1 is deemed to be the case where impossible or utterly impractical circumstances to “specify the product directly by its structure or property at the time of the filing of an application” exist.

In Example 5 as described above, the written opinion concretely explains that it is impossible or impractical to specify the product directly by its structure or property since the product is a polymer having complicated and a wide variety of structures. Therefore, the present example is deemed to be the case where the existence of “impossible or impractical circumstances” can be recognized.

2299 Miscellaneous

Regarding matters in the left column of the lower table, see the referenced location in the right column.

	Referenced Location
Handling when "(deleted)" is described for a claim by way of an amendment at the international phase	"8003 Handling in Cases Where Amendment of "Deletion" of Claims is Indicated at an International Phase" of "Part VIII International Patent Application"

Chapter 3 Unity of Invention (Patent Act Article 37)

2301 Regarding Procedure for Determining Subject of Examination on the Basis of Special Technical Features When a Plurality of Invention Groups Containing the Original Invention Exist

The following case example is provided for describing the procedure for decision of the subject of examination in a case where two or more technical features that may serve as the special technical feature are found in one single invention for which the presence or absence of the special technical feature is to be determined, in the context of "4.1 Decision of subject of the examination based on special technical features" ⁶ in "Part II Chapter 3 Unity of Invention" of the Examination Guidelines⁷.

Case Study:

Claim 1: $X + Y$

Claim 2: $X + \alpha$

Claim 3: $Y + \beta$

In the above case, the same "technical feature X" is found in both the invention according to claim 1 " $X + Y$ " and the invention according to claim 2 " $X + \alpha$ " and the same "technical feature Y" is found in both the invention according to claim 1 " $X + Y$ " and the invention according to claim 3 " $Y + \beta$."

Suppose that the descriptions, etc. state that the "technical feature X" and the "technical feature Y" are both novel, both of them may apparently be found to be "the special technical feature," and at least either of them is subsequently proved to be in fact "the special technical feature."

In such a case, the Examiner first selects the technical feature (for example, X), which is likely to achieve contributions over the prior art with regard to the first invention (the invention according to claim 1). Further, the Examiner identifies the other invention (claim 2: $X + \alpha$), which is associated in terms of the technical feature (X) with the invention according to claim 1 ($X + Y$), as the subject of examination. If it has been found, after examination is started for the invention first identified as the subject of

⁶ See (Note 5) of 4.1(4) in "Part II Chapter 3 Unity of Invention" of the Examination Guidelines.

⁷ This example is similar to case 16 of "2. Case Studies related to Unity of Invention" of Attached Document A.

examination, that the technical feature X does not constitute the special technical feature, then the subject of examination is changed to the invention (claim 3: $Y + \beta$) associated in terms of the other technical feature (Y) with the invention according to claim 1 ($X + Y$).⁸

(Points to Note)

If, in a case where two or more technical features that may serve as the special technical feature are found in one single invention for which the presence or absence of the special technical feature is to be determined, selection of a certain technical feature results in the existence of any claimed invention that is not identified as the subject of examination and selection of the other technical feature ensures that all of the claimed inventions are identified as the subject of examination, then the latter technical feature is to be selected in preference to the former technical feature.

⁸ In this case, the invention of claim 2 is not treated as the "invention for which an examination may be made without substantially conducting additional prior art searches and making a determination as a result of examining inventions that were identified as the subject of the examination based on their special technical features" on the ground that the examination for the invention of claim 2 has been already started.

2302 Regarding "An Invention for Which an Examination may be Made without Substantially Conducting Additional Prior Art Searches and Making a Determination as a Result of Examining Inventions that is Decided the Subject of the Examination"

Section 4.2(2) in "Part II Chapter 3 Unity of Invention" of Examination Guidelines states to add to the subject of examination "An invention for which an examination may be made without substantially conducting additional prior art searches and making a determination as a result of examining inventions⁹ that is decided the subject of the examination based on 4.1 and 4.2(1)" (hereinafter, "inventions for which examination has substantially completed") as inventions for which it is efficient to perform examination together with inventions treated as subjects of examination on the basis of 4.1 and 4.2(1).

Therefore, regarding "an invention for which examination has substantially completed," a description is provided below.

1. Basic idea

Whether or not it is possible to perform examination without requiring a substantially additional prior art searches and making a determination (whether an examination has substantially completed) is determined, in accordance with the technical field to which an application belongs, for each case, in consideration of the substantial effort required for searches for prior art, and determination of description requirements or patent requirements, that shall additionally be performed.

2. Regarding examples corresponding to "inventions for which examination has substantially completed"

In Section 4.2(2) in "Part II Chapter 3 Unity of Invention" of Examination Guidelines, inventions corresponding to the following (i) through (v) are, normally, treated as "inventions for which examination has substantially been completed." For

⁹ Inventions that are deemed to be examined at "4.1 Decision of subject of the examination based on special technical features " and "(1) Claimed inventions in the same category that include all matters specifying the invention of the invention first claimed in the claims" of "4.2 Decision of subject of the examination based on examination efficiency" in "Part II Chapter 3 Unity of Invention" of the Examination Guidelines,

inventions corresponding to these, if examination regarding an invention treated as a subject of examination on the basis of 4.1 and 4.2(1) is performed, normally, it can be concluded that examination (novelty, inventive step, etc.) regarding the relationship with prior art has been substantially completed, and therefore, if examination (description requirements, etc.) for other than the relationship with the prior art has also been substantially completed, then it can be concluded to be "an invention for which examination has substantially completed." Moreover, if the examination (description requirements, etc.) for other than the relationship with the prior art regarding the invention to be a subject of examination is performed on the basis of 4.1 and 4.2(1), then regarding the inventions corresponding to the following (i) through (v) as well, examination (description requirements, etc.) of other than the relationship with the prior art can usually be treated as having been substantially completed.

(i) Other inventions that differ only in terms of expression from inventions that is decided the subject of the examination based on 4.1 and 4.2(1)

"Other inventions that differ only in terms of expression from inventions that were identified as the subject of the examination based on the 4.1 and 4.2(1)" includes not only "other inventions that differ only in terms of category expression with respect to the invention identified as the subject of examination on the basis of 4.1 and 4.2(1)," but also inventions that pertain to the same category and only differ in their expression with respect to the invention identified as the subject of examination on the basis of 4.1 and 4.2(1).

For example, the invention according to claim 7 of Case 28 in the Attached Document A "2. Case Studies related to Unity of Invention" is the other invention that pertains to the same category and only differs in their expression with respect to the invention according to claim 1.

(ii) Other inventions which added, deleted or replaced well-known or commonly used art with respect to inventions that is decided the subject of the examination based on 4.1 and 4.2(1), which do not produce any new effects

For example, the invention according to claim 4 in Case 28 and the portions referring to claim 1 of the inventions according to claims 3, 4 in Case 26 of the Attached Document A, "2. Case Studies related Unity of Invention" are other inventions which added, deleted or replaced well-known or commonly used art with respect to the

invention according to claim 1, and do not produce any new effects.

(iii) Other inventions whose difference from inventions that is decided the subject of the examination based on 4.1 and 4.2(1) is a "designs modified along specific application of techniques" or "optimally or preferably modified numerical ranges" and it is easily determined said change does not produce any advantageous effects in comparison with the prior art

For example, if it has been found that "the invention identified as the subject of examination on the basis of 4.1 and 4.2(1)" does not have novelty or involve an inventive step over the prior art, and if it is readily determined that the invention whose difference from "the invention identified as the subject of examination on the basis of 4.1 and 4.2(1)" is a "modification of design in applying specific techniques" or "optimization or suitable reduction of numerical ranges" which does not produce any advantageous effects in comparison with the prior art, then the result of examination to the effect that the invention does not involve an inventive step can be obtained substantially without the need of additional prior art searches and making a determination. Accordingly, it can be said that the examination regarding the relationship with prior art (novelty, inventive step, etc.) is substantially completed for the invention.

(iv) In cases where it has been found that an invention has no novelty or inventive step as a result of examining inventions that is decided the subject of the examination based on 4.1 and 4.2(1), other inventions which have wider concept that covers said invention

When it has been found that an invention does not have novelty or involve an inventive step as a result of examining invention "X + Y" that was identified as the subject of the examination based on 4.1 and 4.2(1), the result of examination to the effect that the invention "X" that has a wider concept covering the invention does not have novelty or involve an inventive step will be usually obtained on the basis of this result of examination substantially without the need of additional prior art searches and making a determination. It can be said that the examination regarding the relationship with prior art (novelty, inventive step, etc.) has been substantially completed for the invention "X."

(v) In cases where a point having some matters specifying the invention has been found out to have novelty and inventive step as a result of examining inventions that is decided the subject of the examination based on 4.1 and 4.2(1), other inventions that include said

matters specifying the invention

Example:

Claim 1: A bicycle comprising a structure A and a structure B

(* The claimed invention has the special technical feature of "a bicycle comprising a structure A and a structure B.")

Claim 2: A bicycle comprising a structure A, a structure B, and a structure C.

Claim 3: A bicycle comprising a structure A and a structure C.

(Explanation)

The special technical feature of "bicycle comprising a structure A and structure B" is found in the invention according to claim 1. Moreover, suppose that Document 1 describes "a bicycle comprising a structure A" and Document 2 describes "a bicycle comprising a structure B," and inventive step of the invention according to claim 1 has been denied based on the combination of Document 1 and Document 2.

Subsequently, it has been found as a result of examination of the invention according to claim 2 having this special technical feature that the novelty or inventive step consists in the fact that the invention has the matters defining the invention of "a bicycle comprising a structure C." In this case, the result of examination to the effect that the invention of claim 3 has novelty or inventive step will be obtained substantially without the need of additional prior art searches and making a determinations. Accordingly, it can be said that the examination regarding the relationship with prior art (novelty, inventive step, etc.) has been substantially completed for the invention according to claim 3.

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

Part III Patentability

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Chapter 1 Eligibility for Patent and Industrial Applicability (Main Paragraph of Article 29(1) of Patent Act)

3101 Example of a Case in which the Question is whether or not Humans are Included in the Objects of Methods of Surgery, Therapy or Diagnosis

Examination guidelines "Part III Chapter 1 Eligibility for Patent and Industrial Applicability," 3.1.1 (Excerpt)

Methods of surgery therapy or diagnosis of humans have been termed "medical activity" and are normally practiced by medical doctors (including those who are directed by medical doctors, hereinafter referred to as "medical doctors").

A method considered as any one of (i) to (iii) shown below is considered as an "invention of methods of surgery, therapy or diagnosis of humans".

- (i) Methods of surgery of humans (see (1))
- (ii) Methods of therapy of humans (see (2))
- (iii) Methods of diagnosis of humans (see (3))

The following methods of (a) and (b) are included in "inventions of methods of surgery, therapy or diagnosis of humans".

- (a) Methods for contraception or delivery
- (b) Methods for processing samples that have been extracted from a human body (e.g., a method of dialyzing blood) or analyzing the samples during the process on the presumption that the samples are to be returned to the same body for therapy (except for the methods described in 3.2.1(4)b)

Even if methods of surgery, therapy or diagnosis are practiced on animals in general, unless it is clear that the methods practiced on humans are explicitly excluded, the methods are deemed as being "inventions of methods of surgery, therapy or diagnosis of humans".

(Example of the case in which it is obvious that humans are excluded from the object of the method of surgery, therapy or diagnosis)

Example 1: In the case in which it is stated in the claim that the object of the method of surgery, therapy or diagnosis is a "non-human mammal"

(Example of the case in which the object of surgery, therapy or diagnosis might include humans

Example 2: In the case in which it is stated in the claim that the object of the method of surgery, therapy or diagnosis is a "mammal"

Chapter 2 Novelty and Inventive Step (Patent Act Article 29(1) and (2))

3201 Example of cases in which it could be determined that the claimed invention lacks novelty, and that it lacks inventive step

Examples of the cases in which it could be determined that the claimed invention lacks novelty, and that it lacks inventive step are as follows:

- (i) When the claimed invention has formal or factual alternatives, and where the invention lacks novelty if the claimed invention is recognized based on one alternative, and the invention lacks inventive step if the claimed invention is recognized based on the other alternative
- (ii) When multiple working examples are stated in the cited document, and where the claimed invention lacks novelty, if the cited invention is recognized on one working example, and the claimed invention lacks inventive step if the cited invention is recognized based on the other working example
- (iii) When the claimed invention is expressed with a generic concept, and the cited invention is expressed with the more specific concept

In this case, the claimed invention lacks novelty due to the reason that the claimed invention contains the cited invention. In addition, if the difference between the generic concept and the more specific concept is taken as the difference between the claimed invention and the cited invention, the claimed invention that is a generic concept is a matter at which a person skilled in the art could have easily arrived from the cited invention expressed with a more specific concept, and the claimed invention lacks inventive step.

Example: When the matter specifying the invention for the claimed invention is "an elastic body," and only "a spring" is disclosed in the cited document

In this case, since the claimed invention includes a spring, it lacks novelty. In addition, as a person skilled in the art could easily arrive at the idea that "an elastic body" of the claimed invention could be an elastic body other than a spring, the claimed invention lacks inventive step.

- (iv) When the claimed invention is expressed using a numerical range, and the cited

invention discloses a specific numerical value which is within the numerical range

In this case, the claimed invention lacks novelty because it includes the cited invention. In addition, if it is easy for a person skilled in the art to take the difference between the numerical range and the specific value as the difference between the claimed invention and the cited invention and to vary the specific value to another value included in the numerical range, the claimed invention lacks inventive step.

Example: When the claimed invention defines the numerical range $a \sim x \sim b$ for a parameter x , and the cited invention discloses only a specific value x_1 , wherein $a < x_1 < b$

In this case, the claimed invention lacks novelty because it includes the cited invention. In addition, if it is easy for a person skilled in the art to vary x_1 to another value included in the numerical range defined by the claim, the claimed invention lacks inventive step.

(v) When the cited invention is an invention in which certain feature is added to the claimed invention

In this case, the claimed invention lacks novelty, because it includes the cited invention. In addition, taking the added feature in the cited invention as the difference between the claimed invention and the cited invention, if a person skilled in the art could have easily arrived at an invention which consists of solely the concept specified by the claim separating the feature in question, the claimed invention lacks inventive step.

Example: When the claimed invention is an arm for robot having a specific first joint and the cited invention is an arm for robot having a specific first joint and a specific second joint

In this case, the claimed invention lacks novelty, because it includes the cited invention. On the other hand, if a person skilled in the art could have easily arrived at grasping the invention as an independent inventive concept with only the first joint separating the second joint in the cited invention, the claimed invention lacks inventive step.

(vi) When the claimed invention can be interpreted for multiple meanings, and not only lack of novelty but also lack of inventive step can be pointed out

Example: When the claim has a statement "mail" and it cannot be known if it means the "electronic mail" or "mail by post," and, it can be determined that the claimed

invention has novelty when the former meaning is used for interpretation, but does not have inventive step, and that the claimed invention does not have novelty when the latter meaning is used for interpretation

3202 Supreme Court decision in the human conjunctival mast cell stabilizer

The Intellectual Property High Court (hereinafter referred to as “the IPHC”) consequently failed to sufficiently consider the effect of the invention of the patent at issue, in particular, whether the effect was unexpected and remarkable, from the perspective of whether a person skilled in the art could not have expected the effect as being brought about by the structures defined in the claims of the patent at issue at the time of the priority date, and whether the effect was remarkable beyond the scope that a person skilled in the art could have expected from the structures. There is no other choice but to consider that the IPHC immediately denied that the effect of the invention of the patent at issue was unexpected and remarkable only from the fact that it was known that each of other compounds having a comparative effect to that of the compound of the patent at issue existed at the time of the priority date, and rescinded the JPO's decision, on the premise of the decision that it could have been easily conceived of the idea to apply the compound of the patent at issue to a use relating to the invention of the patent at issue. This IPHC's decision reflects an error in the interpretation and application of laws and ordinances.

(Judgment of the Third Petty Bench of the Supreme Court, August 27, 2019 (2018 (Gyo Hi) No.69) “*Topical ophthalmic formulations containing doxepin derivatives for treating allergic eye diseases*”)

(Explanation)

Where “advantageous effects over the prior art” “exceeds what is predictable based on the state of the art at, these effects are factors in support of the existence of an inventive step” is specified in the text of “3.2.1(1) Consideration of advantageous effects over the prior art” of “Part III Chapter 2 section 2 Inventive Step” in the Examination Guidelines. “Factors in support of the existence of an inventive step” of “advantageous effects over the prior art” are considered where the examiner determines that the reasoning is possible to apply other prior arts based on the various matters pertaining to factors in support of the non-existence of an inventive step with respect to the differences between the claimed invention and the primarily prior art from the perspective of a person skilled in the art (refer to (3) of “3.Detail of Determination of Inventive Step”).

Thus, in making the determination in detail of “3.2.1(1) Consideration of advantageous effects over the prior art”, it is required to sufficiently consider from the perspective of whether a person skilled in the art could not have expected the effect as

being brought about by the structures that the reasoning is possible to apply other prior arts to the prior art (“the constituent features defined in each claim of the patent at issue” being introduced in the Supreme Court decision), and whether the effect was remarkable beyond the scope that a person skilled in the art could have expected from the structures.

Moreover, in light of the Supreme Court decision, which addressed that “the effect of the invention of the patent at issue was unexpected and remarkable” should not be dined “only from the fact that it was known that each of other compounds having a comparative effect to that of the compound of the patent at issue existed at the time of the priority date”, it is not appropriate to determine that the effect of the invention of the patent at issue does not “exceed what is predictable based on the state of the art” only from the fact that it was known that the other compound having a comparative effect to that of the compound of the patent at issue.

3203 Points to note when choosing main cited invention

Examination guidelines "Part III, Chapter 2, Section 2 Inventive Step," 3.3 (2) (Excerpt)

The examiner selects generally the primary prior art which is same as or close to the claimed invention from the aspect of technical field or problem to be solved.

In order to choose the best suited main cited invention, Examiner should also take into consideration the mode for carrying out the claimed invention and the main cited invention.

3204 Supreme Court decision in the lipase case

"In examining concerning requirements for patentability provided for in Article 29(1) and (2) of the Patent Act, namely novelty and inventive step of the invention pertaining to the patent application, while the gist of invention pertaining to the patent application must be identified as the premise for comparing the invention with the invention provided for in each item of Article 29(1), this identification of the gist should be made, unless the circumstances are exceptional, based on statements in the claims in the descriptions attached to the request. Limited to exceptional cases in which technical meaning of the statement in the claims cannot be unambiguously clearly understood, or it is obvious at a glance that the statement is an error in the light of statements in the detailed description of the invention, it is allowed to take into consideration the statement of the detailed description of the invention of the descriptions."

(Judgment of the Second Petty Bench of the Supreme Court, March 8, 1991 (1987 (Gyo Tsu) No. 3, Minshu Vol.45, No.3, at 123) "*The method of measurement of triglyceride*")

Shuhei SHIOTSUKI, "*Hankai* (commentary of court cases), civil cases, 1991, page 39

"8 Meaning of 'to take into consideration'

Since matters pertaining the gist of the invention and the scope of the right (constituent features) are stated in condensed form in statements in the claims, in most cases, meaning of content cannot be grasped with through-reading. However, exceptional cases for which the Supreme Court judged that the statement of the detailed description of the invention may be taken into consideration as 'exceptional case in which technical meaning of the statement in the claims cannot be unambiguously clearly understood, or it is obvious at a glance that the statement is an error in the light of the statement of the detailed description of the invention' is not such case. Namely, the decision showed a theory that, in the process of identifying the gist of invention, it is necessary to look through detailed description of the invention and statements of drawings in order to make the technical details of the invention clear, but, in the process of defining the technical matters which constitutes the gist of the invention after understanding technical details, constituent features which are stated only in detailed description of the invention and drawings may not be added exceeding the statements in the claims, and, in this sense, it stated that only in exceptional cases, statement in the detailed description of the invention may be taken into consideration."

3205 Example of a determination whether or not the prior art was made public before the filing of the application in question

For example, for an invention which becomes publicly known before noon in Japan, if a patent application is filed in the afternoon of the same day, the invention publicly known before noon is an invention publicly known in Japan before the filing of the patent application.

3206 Points to note in recognizing cited invention, when the matter stated in the publication is stated in Markush form

Examination guidelines "Part III, Chapter 2, Section 3, Procedure of Determining Novelty and Inventive Step," 3.1.1(1)a (Excerpt)

The examiner should not cite what is neither a disclosure of the publications nor the equivalent of the disclosure of the publications because such a matter is not "prior art disclosed in publications."

If a "matter stated in a publication" is stated in Markush form, the Examiner needs to consider whether or not it is possible for a person skilled in the art to identify an invention which has only one of the alternatives as a matter specifying the invention.

3207 Example of a case in which an invention disclosed in a publication cannot be used as a cited invention

Examination guidelines "Part III, Chapter 2, Section 3 Procedure of Determining Novelty and Inventive Step," 3.1.1(1).b

The examiner should not cite a disclosure that a person skilled in the art is able to recognize based on the descriptions in publications or equivalents to such descriptions as "prior art" where it falls into the following case (i) or (ii).

(i) Where it is not clear that a person skilled in the art is able to manufacture a product of the prior art based on the descriptions of the publications and the common general knowledge at the time of filing

(ii) Where it is not clear that a person skilled in the art is able to use the process of the prior art based on the descriptions of the publications and the common general knowledge at the time of filing.

For example, when a chemical compound is shown in a publication with the name or chemical structural formula of the chemical compound, if the chemical compound is not stated, even if the common general knowledge as of the filing is taken into consideration, so that it is obvious that a person skilled in the art could produce the chemical compound, the chemical compound cannot be a "cited invention" (when the publication is a patent document, and has a claim in Markush form in which the chemical compound is a part of the alternatives as the cited invention, it does not mean that the claim does not satisfy enablement requirement of Article 36(4)(i)).

3208 When a password is necessary for access to a web page, etc. or access to the web page, etc. is charged, but the matter posted on the web page, etc. is available for the public

Even when a password is necessary for access to a web page, etc. or access to the web page, etc. is charged, if the posted invention satisfies both of (i) and (ii) below, the invention posted on the web page, etc. can be deemed to have become publicly available.

- (i) Existence of the matter posted on the web page, etc. and the location could be known by the public
- (ii) Unidentified persons could have accessed the matter.

3209 Examples of the case in which the point is whether or not a matter posted on web page, etc. is available for the public

(1) Example of matters which are available for the public

- (i) Matters which are registered to a search engine and searchable, or information of which existence or location can be known by the public

(For example, matters linked with relevant academic associations, news, etc., or matters of which address is inserted in means for transmitting information to the public, such as newspapers and magazines).

- (ii) Where existence of the matter posted on the web page, etc. and the location could be known by the public, and password is necessary for reading, the web page which is accessible to unspecified persons only by entering a password

(In this case, matters posted on a web page, etc. which, regardless whether or not it is charged, anybody can access by obtaining a password without any discrimination by taking certain procedures can be deemed as available for the public.)

- (iii) Where existence of the matter posted on the web page, etc. and the location could be known by the public, and reading of the web page is charged, unspecified persons can access the web page by paying the charge

(In this case, matters posted on web page, etc. which anybody can access without any discrimination by paying the charge can be deemed as available for the public.)

(2) Example of matters which are hard to say as available for the public

Even if posted on web page, etc., matters which fall under any of the items below are hard to be deemed as available for the public.

- (i) A matter which is posted on Internet, etc., but, excluding casual access, inaccessible because no address is made public

- (ii) Persons who can access the information are limited to members of specific associations or business enterprises, etc., and the information is handled as privileged (for example, internal system which is available only for the employees, etc.)

- (iii) Information of which contents are coded so that it cannot be decoded usually

(Excluding the case, regardless of whether it is charged or free, in which any person can obtain a tool for decryption by certain means.)

- (iv) Matters which are not open for a period sufficient for the public to see them

(for example, matters opened on the Internet only for a short time period)

3210 Handling of cases in which there is extremely little doubt about alteration of matters posted on web page, etc., or cases in which alteration is doubted

Since matters posted on a web page, etc. are vulnerable to alteration, a doubt could occur whether the matter posted on a web page, etc. which is intended to be cited was posted for the indicated period with the same content. The Examiner should handle the cases in which doubt about alteration of matters posted on web page, etc. is extremely little, or cases in which alteration is doubted respectively as shown in (1) and (2) below.

(1) When there is extremely little doubt concerning whether or not the matter posted on a web page, etc. which is intended to be cited was posted for the indicated period with the same content

With web pages, etc. as exemplified in (i) to (iv) below, normally, such doubt is extremely little. Concerning such web pages, etc., the Examiner may assume that the content which is posted when the Examiner accesses the web page etc. was posted in the period indicated on the web page, etc.

- (i) Web pages of publishing companies which have been publishing publications, etc. for many years
- (ii) Web pages of academic organizations (academies, universities, etc.)
- (iii) Web pages of international organizations (standardization organizations, etc.)
- (iv) Web pages of public organizations (ministries, etc.)

(2) When there is a doubt about whether or not the matter posted on a web page, etc. which is intended to be cited was posted for the indicated period with the same content

For example, a case in which the invention intended to be cited is posted on a web page, etc. of a private person on which matters obviously different from the fact are enumerated falls under this example. In this case, the Examiner should examine the doubt by inquiring the contact address indicated as an address for inquiries etc. whether or not it has been altered. If the doubt is dismissed as a result of the examination, the Examiner may cite invention posted on the web page, etc. In the case in which the doubt is not dismissed, the Examiner should not cite the invention. In addition, if the address for inquiries is not clear, the Examiner should not cite such invention.

3211 Procedures for citing an invention which became available for the public through an electric telecommunication line

When citing an invention which became available for the public through an electric telecommunication line, the invention should be treated as follows:

(1) If there exists a publication which describes an invention with the same content as that of the invention which became available for the public through an electric telecommunication line, and both the web page, etc. on which the invention is posted and the publication which described the invention can be cited, the preference should be given to the publication.

(2) Handling of cited web page, etc.

Information on a web page, etc. might have been altered or deleted when the applicant or a third party accessed even if the information existed when the Examiner conducted prior art search. In such case, it is difficult for the applicant or third party to take actions sufficiently. Therefore, in order to compile web pages, etc. cited in notices of reasons for refusal, etc. in the database, the Examiner should take the following procedures.

- a. To print out or electronically file information of the cited web page, etc.
- b. To record the date and time of access, the name of the accessing Examiner, the application number of the application from which the information is cited, and the address from which the information was obtained, etc. on the printout or the electronic file of a. above and to submit it for data accumulation.

(3) Manners to be stated as cited documents, etc. when citing web page, etc.

When citing a web page, etc. retrieved through the Internet, etc., the statements should be listed in compliance with "1207 Manners to Be Stated in the Publications, etc. Which is Cited in the Reasons for Refusal of the Patent Application" in Part I, Chapter 2 of this Examination Handbook.

3212 Submission of information for an invention which became available for the public through an electric telecommunication line

When offering information for an invention which became available for the public through an electric telecommunication line, a party who offers information shall provide a printout of the contents of the electronic technical information from the Internet, etc. in order to prove that the offered information is correct.

The submitted printout of the information must contain the address from which the information is obtained and the address for inquiries for the information, together with the contents of the information, and showing the posting times and dates of the information. It is preferable that a certificate issued by an authorized person or a person responsible for posting, conservation, etc. of that information be included.

3213 Points to note when carrying out a prior art search for unpublished application through Internet, etc.

For any application which has not been laid open as of the prior art search, Examiner may carry out search for prior art information through the Internet, etc. If the Internet, etc. is used, however, since there is a possibility of leakage of retrieved information and the invention of the application might leak to a third party from the search formula and the search term, etc. (Note), Examiner must be careful in conducting retrieval.

In addition, for example, if Examiner finds the cited document from a literature list of an academic society on a web page, etc., or has obtained electronic technical information through offering of information, there is no worry that the claimed invention might leak.

Note: In cases shown below, it is highly probable that the invention leaks to third parties.

- (i) When searching with a new combination of generic terms
- (ii) When searching for invention in which a publicly known matter is used for a new use
(using the matter for the use is new)

3214 Examples of publicly worked inventions (Article 29(1)(ii))

Examination guidelines "Part III, Chapter 2, Section 3, Procedure of Determining Novelty and Inventive Step," 3.1.4 (Excerpt)

"Publicly worked prior art" means prior art which has been worked in a situation where the prior art is or could be publicly known.

Example 1: Example of an invention worked in a situation in which it becomes publicly known

For example, an invention in a case in which it is allowed in a plant for unspecified persons to observe the manufacturing process of a certain product, when the situation is such that a person skilled in the art could easily know the details of the invention by just viewing the situation of manufacturing

Example 2: Example of an invention worked in a situation in which there is possibility that it becomes publicly known.

For example, an invention related to the manufacture in a case in which it is allowed in a plant for unspecified persons to observe the process of manufacturing a certain product, when the situation is such that satisfies both (i) and (ii) below:

- (i) Situation in which a part of the manufacturing process cannot be known when viewing the outside of the equipment, and the invention as a whole cannot be known unless the part is known
- (ii) Situation in which visitors can (the plant does not refuse) watch the inside of the equipment, or to have the inside explained by plant workers

3215 Points to note concerning recognition of cited invention

Examination guidelines "Part III, Chapter 2, Section 3, Procedure of Determining of Novelty and Inventive Step," 3.3

The examiner should take note of the avoidance of hindsight which brings about a misunderstanding of the evidence which discloses the prior art according to the contexts of the description, claims or drawings of the application subject to the examination after obtaining knowledge of the claimed inventions. The prior art should be understood based on the evidence disclosing the prior art (for publications, along the contexts of the publications).

In addition, the Examiner should note the following points.

- (1) The Examiner should not identify cited inventions only from a part of statement of the publication, etc. without reasonable ground.
- (2) The Examiner should not determine the content of the invention stated in a publication, etc. only from its feature, but should determine taking into consideration points of view of the problem to be solved, technical field, etc.

3216 Example of alternatives

Examination guidelines "Part III, Chapter 2, Section 3, Procedure of Determining Novelty and Inventive Step," 4.1.1 (Note 1)(Excerpt)

"Alternatives" means both formal alternatives and substantial alternatives.

"Formal alternatives" means a description of the claim which is understood obviously as alternatives.

For example, claims in Markush form, multiple dependent form claims citing other claims alternatively, etc. fall under claims containing formal alternative.

Examination guidelines "Part III, Chapter 2, Section 3, Procedure of Determining Novelty and Inventive Step," 4.1.1 (Note 1)(Excerpt)

"Substantial alternatives" means a comprehensive expression which is intended to include a limited number of more specific matters substantially.

Whether or not it is "substantial alternative" is determined by taking into consideration the statements of the descriptions and drawings, as well as the common general knowledge as of the filing in addition to the statements of the claim. For example, claims having a statement like "alkyl group with 1 to 10 C (number of carbons)" (this comprehensive expression contains methyl group, ethyl group, etc.), etc. are claims containing substantial alternative.

In contrast to this, the statement "thermoplastic resin," for example, should not be deemed as a statement expressed by comprehensively bracketing concrete matters included in the concept except the case in which it should be interpreted so taking into consideration the statements of the descriptions and drawings as well as the common general knowledge as of the filing as in the case in which definitions of terms are included in the detailed description of the invention. Therefore, the Examiner need to know that such statement does not fall under substantial alternative. Namely, the concept of "thermoplastic resin" includes an unspecified number of concrete matters (for example, polyethylene, polypropylene, etc.), the Examiner should determine that it is a generic concept specified by a common character (in this case, thermal plasticity) of the concrete matters.

3217 Relation between the determination as to novelty and inventive step of the claimed invention having alternatives, and the end of prior art search

Handling of Examination guidelines "Part III, Chapter 2, Paragraph 3, Proceeding of examination of novelty and inventive step," 5.1.1 has no relation with the point in what case prior art search may be terminated. In this regard, refer to Examination guidelines "Part I, Chapter 2, Section 2, Prior Art Search and Determination of Novelty and Inventive Step, etc." 3.1.3.

3218 Example of a case in which a statement to specify a product using functions, characteristics, etc. is recognized as having a meaning different from the usual meaning

Example: Heat-resistant alloy having a composition of ...

(Explanation)

In certain cases, as a result of identification of the claimed invention taking into consideration the statements of the descriptions and drawings, as well as the common general knowledge as of the filing, the statement, "heat-resistant alloy," should be interpreted to mean an "alloy used for a use in which heat resistance is necessary." In this case, the Examiner should follow Examination guidelines "Part III, Chapter 2, Section 4, Claims Including Specific Expressions," 3.

3219 When it is difficult to compare with the cited invention by statements of functions, characteristics, etc. and exact comparison cannot be made (reason to doubt that novelty is prima facie denied)

1. Proceeding of examination

In certain cases, it is difficult to compare with the cited invention a claim which contains a statement to specify a product by functions, characteristics, etc., and falls under (i) and (ii) below.

In such case, without conducting exact comparison of identical features and differences with the product of the cited invention, if the Examiner has a reason to doubt that two of them are prima facie identical, unless there is difference in other parts, the Examiner should give a notice of reasons for refusal due to lack of novelty. In the notice of reasons for refusal, the Examiner should show without fail the ground for the reason to doubt that they are prima facie identical, and, if necessary, state what kind of refutation or clarification would be effective in the Examiner's opinion.

If the applicant refutes or clarifies the reason to doubt that they are prima facie identical with a written opinion, certificate of experimental results, etc., and the Examiner is not convinced that the claimed invention lacks novelty, the reason for refusal dissolves.

When the reason to doubt that they are prima facie identical concerning novelty does not dissolve because of the reason that the refutation, or clarification by the applicant is abstract or generic, etc., and the Examiner is convinced that the claimed invention lacks novelty, the Examiner should make a decision of refusal.

However, the Examiner should not apply such handling using any invention for which the cited matter identifying the invention falls under (i) or (ii) below as a cited invention. In addition, if it is possible to determine on novelty through means other than this exceptional way, however, a normal way should be used.

(i) When stated functions, characteristics, etc., do not fall under any of the followings:

(i-1) Standard one (Note 1)

(i-2) One customarily used by a person skilled in the art in the technical field in question (Note 2)

(i-3) One in the technical field in question; even if it is not customarily used by a person skilled in the art, a person skilled in the art can understand its relation with one customarily used by a person skilled in the art

- (ii) Multiple functions, characteristics, etc. are stated in the claim, and each of them corresponds to any of (i-1) to (i-3) above, but, looked as one in which two or more of such functions, characteristics, etc. are combined, it falls under (i) above as a whole

(Note 1) Standard one means such that has a definition as defined by JIS (Japanese Industrial Standards), ISO Standards (Standards of International Organization of Standardization), or IEC Standards (Standards of International Electrotechnical Commission), and can be quantitatively determined by testing or measuring methods established by those organizations.

(Note 2) One customarily used by a person skilled in the art means such that is customarily used in the technical field in question by a person skilled in the art, and its definition and testing and measuring methods can be understood by a person skilled in the art.

2. Example of cases in which Examiner has a reason to doubt prima facie identical

- (a) When the functions, characteristics, etc. of the claimed invention can be converted to those by other definitions or testing or measuring method, and, a product of the cited invention that can be deemed identical to the claimed invention judging from the result of such conversion is found
- (b) When the claimed invention and the cited invention are identified with identical or similar functions, characteristics, etc., but the measuring conditions or evaluating method are different and fall under both of (i) and (ii) below
 - (i) When there is certain relation between measuring conditions or evaluating method of the claimed invention and the cited invention.
 - (ii) When such probability is high that the functions, characteristics, etc. of the cited invention are included in the functions, characteristics, etc. of the claimed invention, if the functions, characteristics, etc. of the cited invention are measured or evaluated with the measuring conditions or evaluating method for the claimed invention.
- (c) When a structure of a product deemed as identical with the product of the claimed invention becomes clear after the filing, and it is found that the product was publicly known before the filing

- (d) When a cited invention is identical or similar to one which is stated in the descriptions or drawings of the application as the mode for carrying out is found

(For example, when a cited invention having the identical manufacturing process with the manufacturing process stated as the mode for carrying out and similar starting material is found, or when a cited invention having a similar manufacturing process to the manufacturing process stated as the mode for carrying out and identical starting material is found, etc.)

- (e) When a matter specifying the invention other than matters specifying the invention expressed with functions, characteristics, etc. is common between the cited invention and the claimed invention, and falls under both of (i) and (ii) below

(i) When the cited invention has problems or beneficial effects identical or similar to problems or beneficial effects of matters specifying the invention expressed with the functions, characteristics, etc.

(ii) When such probability is high that functions, characteristics, etc. of the cited invention are included in functions, characteristics, etc. of the claimed invention

3. A notice of reasons for refusal based on a certificate of experimental results, etc. submitted by submission of information by third parties

In order to explain that the claimed invention in which numerical range or mathematical expressions (including inequalities) are used as a statement to identify the product with action, function, etc. is an invention stated in publication, etc. distributed before the filing, generally, it often becomes necessary to prove it by experiments.

In the information system, due to the above necessity, a certificate of experimental results, etc. may be submitted, as a "document" to explain that the claimed invention is the invention published in publication, etc. distributed before the filing. In such case, the submitted certificate of experimental results, etc. should state the matter to be certified, details of the experiments, and experimental results.

When citing a certificate of experimental results, etc. submitted by such submission of information by third parties in a notice of reasons for refusal, the date of submission, the names of persons that conducted the experiments, etc. of the used certificate of experimental results, etc. should be stated to specify the cited evidence in the notice.

Certificates of experimental results, etc. submitted by submission of information can be browsed.

An example of certificate of experimental results is shown below.

Example of certificate of experimental results

(When certifying that the product stated in a publication is identical with the product of the claimed invention)

<p style="text-align: center;">Certificate of Experimental Results</p> <p style="text-align: right;">_____(month) _____(day) _____(year) XXX Corporation YYY Laboratory xxx yyy</p>	
1.	Date of the experiment
2.	Place of the experiment
3.	Person who conducted the experiment XXX Corporation YYY Laboratory xxx yyy
4.	Objectives of the experiment For example, state as follows: "To manufacture polyethylene film disclosed in the working example 1 in JP H xx-xxxxxx, and measure xx and xx of obtained film, and confirm that the polyethylene film of the claimed invention and the polyethylene film stated in the working example 1 of the above laid-open patent are identical product"
5.	Details of the experiment Show manufacturing conditions for the product in question concretely, so that it becomes obvious that the product stated in the publication is replicated faithfully. (In certain cases, merely a statement, "The film was manufactured in accordance with the working example 1 of JP H xx-xxxxxx " might be insufficient.) When any new condition is added in manufacturing the product, or an experiment cannot be conducted under conditions identical with those stated in the publication, state the reason also.) Then, in order to confirm that the product stated in the publication was replicated, measure the properties measured in the publication and state the results.

6. Results of the experiment

In order to confirm that the product stated in the publication is identical with the product of the claimed invention, measure the necessary properties and state the results. In measuring the properties of the product in question, conditions should be shown concretely so that it becomes clear that the conditions are identical with the measuring conditions used in the claimed invention. (In certain cases, merely a statement, "xx and yy were measured under the similar conditions to that of the claimed invention" might be insufficient.) When any new condition is added in the measuring, or an experiment cannot be conducted under conditions identical with those stated in the claimed invention, state the reason also.

3220 When comparison with the cited invention by statements of functions, characteristics, etc. is difficult and exact comparison cannot be made (reason to doubt that inventive step is prima facie denied)

1. Proceeding of examination

In certain cases, it is difficult to compare with the cited invention a claim which contains a statement to specify a product by functions, characteristics, etc., and falls under either one of (i) and (ii) below.

In such a case, without making exact comparison of identical features and differences with the product of the cited invention, if the Examiner has a reason to doubt that both of them are prima facie similar products and that inventive step of the claimed invention is denied, the Examiner should give a notice of reasons for refusal due to lack of inventive step. In the notice of reasons for refusal, the Examiner should show without fail the ground for the reason to doubt that they are prima facie similar, and, if necessary, state what kind of refutation, or clarification would be effective in the Examiner's opinion.

If the applicant refutes or clarifies the reason to doubt that they are prima facie similar with written opinions, certificates of experimental results, etc., and the Examiner is not convinced that the claimed invention lacks inventive step, the reason for refusal dissolves.

When the reason to doubt that they are prima facie identical concerning inventive step does not dissolve because of the reason that the refutation or clarification by the applicant is abstract or generic, etc., and the Examiner is convinced that the claimed invention lacks inventive step, the Examiner should make a decision of refusal.

However, the Examiner should not apply such handling when using as a cited invention any invention for which the matter identifying the invention falls under (i) or (ii) below. In addition, if it is possible to determine on inventive step through means other than this exceptional way, however, a normal way should be used.

(i) When stated functions, characteristics, etc., do not fall under any of the following:

(i-1) Standard one (Note 1)

(i-2) One customarily used by a person skilled in the art in the technical field in question (Note 2)

(i-3) One in the technical field in question; even if it is not customarily used by a person skilled in the art, a person skilled in the art can understand its relation with one customarily used by a person skilled in the art

- (ii) Multiple functions, characteristics, etc. are stated in the claim, and each of them corresponds to any of (i-1) to (i-3) above, but, when looked as one in which two or more of such functions, characteristics, etc. are combined, it falls under (i) above as a whole

(Note 1) Standard one means such that it has a definition as defined by JIS (Japanese Industrial Standards), ISO Standards (Standards of International Organization of Standardization), or IEC Standards (Standards of International Electrotechnical Commission), and can be quantitatively determined by testing or measuring methods established by those organizations.

(Note 2) One customarily used by a person skilled in the art means such that it is customarily used in the technical field in question by a person skilled in the art, and its definition and testing and measuring methods can be understood by a person skilled in the art.

2. Example of cases in which Examiner has a reason to doubt prima facie identical

- (a) When functions, characteristics, etc. of the claimed invention can be converted to those by other definition or testing or measuring method, and, a product of the cited invention that can be the ground for denying inventive step of the claimed invention judging from the result of such conversion is found
- (b) When the claimed invention and the cited invention are identified with identical or similar functions, characteristics, etc., but the measuring conditions or evaluating method are different and fall under both of (i) and (ii) below
 - (i) When there is a certain relation between measuring conditions or evaluating method of the claimed invention and the cited invention
 - (ii) When such probability is high that the functions, characteristics, etc. of the cited invention are similar to the functions, characteristics, etc. of the claimed invention, if the functions, characteristics, etc. of the cited invention are measured or evaluated with the measuring conditions or evaluating method for the claimed invention, and the cited invention becomes the ground to deny inventive step.
- (c) When a structure of a product deemed as identical with the product of the claimed invention becomes clear after the filing, and it is found that the product was such that it

could have been easily invented from a publicly known invention before the filing

- (d) When a cited invention is identical with or similar to one which is stated in the descriptions or drawings of the application as the mode for carrying out is found and the cited invention can be the ground for denying inventive step

(For example, when a cited invention having the identical manufacturing process with the manufacturing process stated as the mode for carrying out and similar starting material is found, or when a cited invention having the similar manufacturing process to the manufacturing process stated as the mode for carrying out and identical starting material is found, etc.)

- (e) When a matter specifying the invention other than matters specifying the invention expressed with functions, characteristics, etc. is common between the cited invention and the claimed invention, or such that causes lack of inventive step, and falls under both of (i) and (ii) below

(i) When the cited invention has problems or beneficial effects identical with or similar to problems or beneficial effects of matters specifying the invention expressed with the functions, characteristics, etc.

(ii) When the cited invention can be the ground for denying inventive step.

3221 When comparison with the cited invention is difficult and exact comparison cannot be made because a statement on "another sub-combination" exists in the claim (reason to doubt that novelty is prima facie denied)

1. Proceeding of examination

There could be a case in which comparison with the cited invention is difficult and exact comparison cannot be made because the claim includes statement on "another sub-combination."

In such case, same as in 3218, if the Examiner has a reason to doubt that two of them are prima facie the same products and novelty of the claimed invention should be denied without making comparison of the exactly identical features and the difference to the product of the cited invention, the Examiner should give a notice of reasons for refusal due to lack of novelty. In the notice of reasons for refusal, the Examiner should show without fail the ground for the reason to doubt that they are prima facie identical, and, if necessary, state what kind of refutation, or clarification would be effective in the Examiner's opinion.

If it is possible to determine on novelty through means other than this exceptional way, however, a normal way should be used.

2. Example of a case in which Examiner has a reason to doubt prima facie identical

(a) When the relationship between one sub-combination and another sub-combination is the same or similar between the claimed invention and the cited invention, and the probability that the inventions of the sub-combinations are identical is high, and the cited invention is used as the ground for denying novelty

Example: When the content or nature of information sent/received between the sub-combination and another sub-combination is the same or similar, and the probability that inventions of sub-combinations are identical is high.

3222 When comparison with the cited invention is difficult and exact comparison cannot be made because a statement on "another sub-combination" exists in the claim (reason to doubt that inventive step is prima facie denied)

1. Proceeding of examination

There could be a case in which comparison with the cited invention is difficult and exact comparison cannot be made because the claim includes statement on "another sub-combination."

In such a case, same as in 3219, if the Examiner has a reason to doubt that both of them are prima facie the same products and inventive step of the claimed invention should be denied without making comparison of the exactly identical features and the difference from the product of the cited invention, the Examiner should give a notice of reasons for refusal due to lack of inventive step. In the notice of reasons for refusal, the Examiner should show without fail the ground for the reason to doubt prima facie identical, and, if necessary, state what kind of refutation or clarification would be effective in the Examiner's opinion.

If it is possible to determine on inventive step through means other than this exceptional way, however, a normal way should be used.

2. Example of a case in which Examiner has a reason to doubt prima facie identical

(a) When the relationship between one sub-combination and another sub-combination is the same or similar between the claimed invention and the cited invention, and the probability that the inventions of the sub-combinations are similar is high, and the cited invention is used as the ground for denying inventive step

3223 When comparison with the cited invention is difficult, and exact comparison cannot be made, because it is extremely difficult to determine what the product itself is structurally
(reason to doubt that novelty is prima facie denied)

1. Proceeding of examination

Concerning a claim that includes specification of product by the manufacturing method, there could be a case in which it is extremely difficult to determine what the product itself is structurally. In such case, same as in 3218, if the Examiner has a reason to doubt that both of them are prima facie same products and novelty of the claimed invention should be denied without making comparison of the exactly identical features and the difference from the product of the cited invention, the Examiner should give a notice of reasons for refusal due to lack of novelty. In the notice of reasons for refusal, the Examiner should show without fail the ground for the reason to doubt prima facie lack of novelty, and, if necessary, state what kind of refutation or clarification would be effective in the Examiner's opinion.

However, this way of handling should not be applied by using an invention in which the matter specifying the invention is such that the product is specified by the manufacturing method as the cited invention.

If it is possible to determine on novelty through means other than this exceptional way, however, a normal way should be used.

2. Examples of cases in which examiner has a reason to doubt prima facie identical

- (a) When a cited invention of a product of which starting material is similar to that of the claimed invention and which is manufactured with the same manufacturing process is found
- (b) When a cited invention of a product of which starting material is identical with that of the claimed invention and which is manufactured with a similar manufacturing process is found
- (c) When the structure of the product that is identified after the filing as identical with the product of the claimed invention becomes clear, and it is found to have been publicly known before the filing

- (d) When a cited invention is identical or similar to what is stated as the mode for carrying out in the descriptions or drawing of the application is found

3224 When comparison with the cited invention is difficult, and exact comparison cannot be made, because it is extremely difficult to determine what the product itself is structurally
(reason to doubt that inventive step is prima facie denied)

1. Proceeding of examination

Concerning claims that include specification of product by manufacturing method, there could be a case in which it is extremely difficult to determine what the product itself is structurally. In such a case, the same as in 3219, if the Examiner has a reason to doubt that both of them are prima facie same products and inventive step of the claimed invention should be denied without making comparison of the exactly identical features and the difference from the product of the cited invention, the Examiner should give a notice of reasons for refusal due to lack of inventive step. In the notice of reasons for refusal, the Examiner should show without fail the ground for the reason to doubt prima facie lack of inventive step, and, if necessary, state what kind of refutation or clarification would be effective in the Examiner's opinion.

However, this way of handling should not be applied by using an invention in which the matter specifying the invention is such that the product is specified by the manufacturing method as the cited invention.

If it is possible to determine on inventive step through means other than this exceptional way, however, a normal way should be used.

2. Examples of cases in which examiner has a reason to doubt prima facie identical

- (a) When a cited invention of a product of which starting material is similar to that of the claimed invention and which is manufactured with the same manufacturing process is found
- (b) When a cited invention of a product of which starting material is identical with that of the claimed invention and which is manufactured with a similar manufacturing process is found
- (c) When the structure of the product that is identified after the filing as identical with the product of the claimed invention becomes clear, and it is found that the product is such that it could be invented easily from the publicly known invention before the filing

- (d) When a cited invention which denies inventive step concerning a product identical with or similar to what is stated as the mode for carrying out in the descriptions or drawing of the application is found

3225 Article 29(1) of the Patent Act applicable to applications filed on or before December 31, 1999

Article 29(1) of the Patent Act

An inventor of an invention that is industrially applicable may be entitled to obtain a patent for the invention, except for the following:

- (i) Inventions that were publicly known in Japan, prior to the filing of the patent application
- (ii) Inventions that were publicly worked in Japan, prior to the filing of the patent application
- (iii) Inventions that were described in a publication distributed in Japan or a foreign country, prior to the filing of the patent application

3226 Concrete Example of "Proving Document" in which Contents of the Same Degree as a Those in "Providing Document" according to the Form Exemplified in Examination Guidelines, Part III, Chapter 2, Section 5, 2.3.1 are Stated

Examination guidelines "Part III Chapter 2 Section 5 Exceptions to Loss of Novelty of Invention," 2.3.2 (Excerpt)

2.3.2 The case where the "proving document" which is not compliant with the form mentioned in 2.3.1 has been submitted

The examiner shall determine whether it is proved that the Requirements 1 and 2 is satisfied on the basis of the submitted "proving document."

For example, if contents equivalent to the "proving document" compliant with the form mentioned in 2.3.1 are stated in the submitted document, in principle, the examiner shall determine that it is proved that Requirements 1 and 2 are satisfied, and shall admit the application of the provision of Article 30(2).

However, even if the "proving document" compliant with the form mentioned in 2.3.1 has been submitted, in the case where the examiner finds evidence which casts any doubt on the fact that the "disclosed invention" is an invention to which the provision of Article 30(2) is applicable, the examiner shall not admit the application of the provision of Article 30(2).

When both of (i) and (ii) below are submitted as "Providing Documents," the Examiner should determine, as a general rule, that it has been proven that Requirements 1 and 2 are satisfied, and allow application of the provision of Article 30(2).

- (i) A copy of publication in which "fact of publication" is stated to the degree that it can be understood that "(Requirement 1) "The patent application was filed within one year from the day on which the invention was made public" is satisfied
- (ii) A document in which "fact of succession of the right to obtain a patent, etc." is stated to the degree that it can be understood that "(Requirement 2) "The invention was made public as a result of an act of the person having the right to obtain a patent and the person filed the patent application for the invention published" is satisfied

3227 Concrete Example of a Case in which Applicant's Assertion is Taken into Consideration in Determining on Application of the Provision of Article 30(2)

Examination guidelines "Part III Chapter 2 Section 5 Exceptions to Loss of Novelty of Invention," 2.4 (Excerpt)

With regard to an "disclosed invention" for which "facts of disclosure" are explicitly stated in the "proving document", after the examiner issues a notice of reasons for refusal without admitting the application of the provision of Article 30(2), the applicant may assert that the application of the provision of Article 30(2) should be admitted through a written opinion, a written statement, or other such documents. In this case, the examiner shall determine again whether it is proved that Requirements 1 and 2 are satisfied, in consideration of the assertion of the applicant together with the matters stated in the "proving document".

For example, when "fact of publication" is stated explicitly, but "fact of succession of the right to obtain a patent, etc." is not explicitly stated in the "Providing Document," if the applicant makes an assertion concerning the "fact of succession of the right to obtain a patent, etc.," the Examiner should take such assertion into consideration.

On the other hand, the Examiner should not take into consideration the applicant's assertion concerning "invention made public" for which "fact of publication" is not explicitly stated in the "Providing Document." This is because that, if the applicant's assertion is taken into consideration even for the "invention made public" for which "fact of publication" is not explicitly stated in the "Providing Document," the result in that any invention for which application of the provision of Article 30(2) is sought may be added indefinitely, and which departs from the intention of the provision of Article 30(3) or (4) in which the timing of submitting the "Providing Document" is restricted, and third parties might suffer from unexpected disadvantage.

3228 Method for Describing the Ground for not Allowing Application of Exceptions to Loss of Novelty of Invention

Examination guidelines "Part III Chapter 2 Section 5 Exceptions to Loss of Novelty of Invention," 4.1 (Excerpt)

In the case where the application of the provision of exceptions to loss of novelty of invention which is sought is not admitted, the examiner shall clearly state the reasons why the application of the provision is not admitted in a notice of reasons for refusal or a decision of refusal.

When the Examiner uses as a cited invention any invention for which the applicant sought application, the Examiner should state reason why application is not allowed in addition to a reason for refusal concerning novelty or inventive step.

Since the Examiner has determined on applicability when starting examination (Refer to Examination guidelines "Part III Chapter 2 Paragraph 5 Exceptions to loss of novelty of invention," 2.2), the Examiner should add the reason why application is not allowed together with other reason for refusal, even when the invention for which the applicant sought application is not used as a cited invention.

3229 Procedures for Having Exceptions to Loss of Novelty of Invention Applied

The Patent Office has prepared "Operational Guidelines for Applicants to Seek the Application of Exceptions to Loss of Novelty of Invention applied" and "Compiled Q&A concerning the Exceptions to Loss of Novelty of Invention " and provides them on its website of the Patent Office so that applicants seeking application of exceptions to loss of novelty of invention can take required steps smoothly.

Homepage address: http://www.jpo.go.jp/tetuzuki_e/t_tokkyo_e/e_pae_paa30.htm

- (1) When seeking application of exceptions to loss of novelty of invention for a patent application to which Article 30 of the Patent Act as amended in 2018 is applicable
 - (i) "Operational Guidelines for Applicants to Seek the Application of Exceptions to Loss of Novelty of Invention, corresponding to the Patent Act Article 30 revised in 2018"
 - (ii) "Compiled Q&A concerning the Exceptions to Loss of Novelty of Invention, corresponding to the Patent Act Article 30 revised in 2018"
- (2) When seeking application of exceptions to loss of novelty of invention for a patent application to which Article 30 of the Patent Act before the amendment in 2011 is applicable
 - (i) "Operational Guidelines for Applicants to Seek the Application of Exceptions to Loss of Novelty of Invention, corresponding to the Patent Act Article 30 revised in 2011"
 - (ii) "Compiled Q&A concerning the Exceptions to Loss of Novelty of Invention, corresponding to the Patent Act Article 30 revised in 2011"

3230 History of Amendments of Article 30

Filing date	July 1, 1995 to December 31, 1999	January 1, 2000 to March 31, 2012	April 1, 2012 to March 31, 2015	From April 1, 2015 to June 8, 2018	From June 9, 2018
(1)	In the case of an invention which has fallen under any of the items of Article 29(1) by reason of the fact that the person having the right to obtain a patent has conducted a test, has made a presentation in a printed publication, or has made a presentation in writing at a study meeting held by an academic group designated by the Commissioner of the Patent Office, such invention shall be deemed not have fallen under any of the items of Article 29(1) in a patent application which was filed by the person within six months from the date on which the invention first fell under any of those items.	In the case of an invention which has fallen under any of the items of Article 29(1) by reason of the fact that the person having the right to obtain a patent has conducted a test, has made a presentation in a printed publication, has made a presentation through electric telecommunication lines, or has made a presentation in writing at a study meeting held by an academic group designated by the Commissioner of the Patent Office, such invention shall be deemed not have fallen under any of the items of Article 29(1) for the purpose of Article 29(1) and (2) for the invention claimed in a patent application which was filed by the person within six months from the date on which the invention first fell under any of those items.	In the case of an invention which has fallen under any of the items of Article 29 (1) against the will of the person having the right to obtain a patent, such invention shall be deemed not to have fallen under any of the items of Article 29 (1) and (2) for the invention claimed in a patent application which has been filed by the said person within six months from the date on which the invention first fell under any of said items.	In the case of an invention which has fallen under any of the items of Article 29 (1) against the will of the person having the right to obtain a patent, such invention shall be deemed not to have fallen under any of the items of Article 29 (1) for the purpose of Article 29 (1) and (2) for the invention claimed in a patent application which has been filed by the said person within one year from the date on which the invention first fell under any of said items.	
(2)	In the case of an invention which has fallen under any of the items of Article 29(1) against the will of the person having the right to obtain a patent, the preceding paragraph shall also apply to the invention claimed in the patent application which was filed by the person within six months from the date on which the invention first fell under any of those paragraphs.	In the case of an invention which has fallen under any of the items of Article 29(1) against the will of the person having the right to obtain a patent, the preceding paragraph shall also apply for the purpose of Article 29(1) and (2) to the invention claimed in the patent application which was filed by the person within six months from the date on which the invention first fell under any of those paragraphs.	In the case of an invention which has fallen under any of the items of Article 29 (1) as a result of an act of the person having the right to obtain a patent (excluding those which have fallen under any of the items of the preceding paragraph by being contained in gazette relating to an invention, utility model, design or trademark), the preceding paragraph shall also apply for the purposes of Article 29 (1) and (2) the invention claimed in the patent application which has been filed by the said person within six months from the date on which the invention first fell under any of those items.	In the case of an invention which has fallen under any of the items of Article 29 (1) as a result of an act of the person having the right to obtain a patent (excluding those which have fallen under any of the items of the preceding paragraph by being contained in gazette relating to an invention, utility model, design or trademark), the preceding paragraph shall also apply for the purposes of Article 29 (1) and (2) the invention claimed in the patent application which has been filed by the said person within one year from the date on which the invention first fell under any of those items.	
(3)	In the case of an invention which has fallen under any of the items of Article 29(1) by reason of the fact that the person having the right to obtain a patent has exhibited the invention at an exhibition held by the Government or a local public entity (hereinafter referred to as the "Government, etc."), an exhibition held by those who are not the Government, etc. where such exhibition has been designated by the Commissioner of the Patent Office, an international exhibition held in the territory of a member country of the Union of Paris Convention or a member of the World Trade Organization by its Government, etc. or those who are authorized thereby to hold such an exhibition, or an international exhibition held in the territory of a state which is neither of a member country of the Union of the Paris Convention nor a member of the World Trade Organization by its Government, etc. or those who are authorized thereby where such exhibition has been designated by the Commissioner of the Patent Office, paragraph (1) shall also apply to the invention claimed in the patent application which was filed by the person within six months from the date on which the invention first fell under any of those items.	In the case of an invention which has fallen under any of the items of Article 29(1) by reason of the fact that the person having the right to obtain a patent has exhibited the invention at an exhibition held by the Government or a local public entity (hereinafter referred to as the "Government, etc."), an exhibition held by those who are not the Government, etc. where such exhibition has been designated by the Commissioner of the Patent Office, an international exhibition held in the territory of a member country of the Union of Paris Convention or a member of the World Trade Organization by its Government, etc. or those who are authorized thereby to hold such an exhibition, or an international exhibition held in the territory of a state which is neither of a member country of the Union of the Paris Convention nor a member of the World Trade Organization by its Government, etc. or those who are authorized thereby where such exhibition has been designated by the Commissioner of the Patent Office, paragraph (1) shall also apply for the purpose of Article 29(1) and (2) to the invention claimed in the patent application which was filed by the person within six months from the date on which the invention first fell under any of those items.	Any person seeking the application of the preceding paragraph shall submit to the Commissioner of the Patent Office, at the time of filing of the patent application, a document stating the same and, within thirty days from the date of filing of the patent application, a document proving the fact that the invention which has otherwise fallen under any of the items of Article 29(1) is an invention to which the preceding paragraph of this Article may be applicable.	Any person seeking the application of the preceding paragraph shall submit to the Commissioner of the Patent Office, at the time of filing of the patent application, a document stating the same and, within thirty days from the date of filing of the patent application, a document proving the fact that the invention which has otherwise fallen under any of the items of Article 29(1) is an invention to which the preceding paragraph of this Article may be applicable (in the subsequent paragraph, "Certificate").	
(4)	Any person seeking the application of paragraph (1) or (3) concerning an invention applied for a patent shall submit to the Commissioner of the Patent Office, at the time of filing of the patent application, a document stating the same and, within thirty days from the date of filing of the patent application, a document proving the fact that the invention is an invention to which paragraph (1) or (3) of this Article may be applicable.	Any person seeking the application of paragraph (1) or (3) shall submit to the Commissioner of the Patent Office, at the time of filing of the patent application, a document stating the same and, within thirty days from the date of filing of the patent application, a document proving the fact that the invention which has otherwise fallen under any of the items of Article 29(1) is an invention to which paragraph (1) or (3) of this Article may be applicable.	When any person submitting the "Certificate" cannot submit it within the period provided for in the preceding paragraph because of certain reason not attributable to such person, notwithstanding the provision of paragraph (3), such person may submit the "Certificate" within 14 days (two months for any person residing abroad) after the reason disappears and within six months after the period elapses.		

3231 Patent Applications to which Article 30 of the Patent Act as amended in 2018 is Applicable

(*) Concerning patent applications filed on or before December 8, 2017, refer to "3232 Inventions that were published on or before December 8, 2017 under Article 30 of the Patent Act as amended in 2018 is Applicable"

(1) Normal applications

Patent applications filed on or after June 9, 2018

(2) Patent applications according to divisional applications, converted applications and utility model registrations

Patent applications of which original applications were filed on or after June 9, 2018

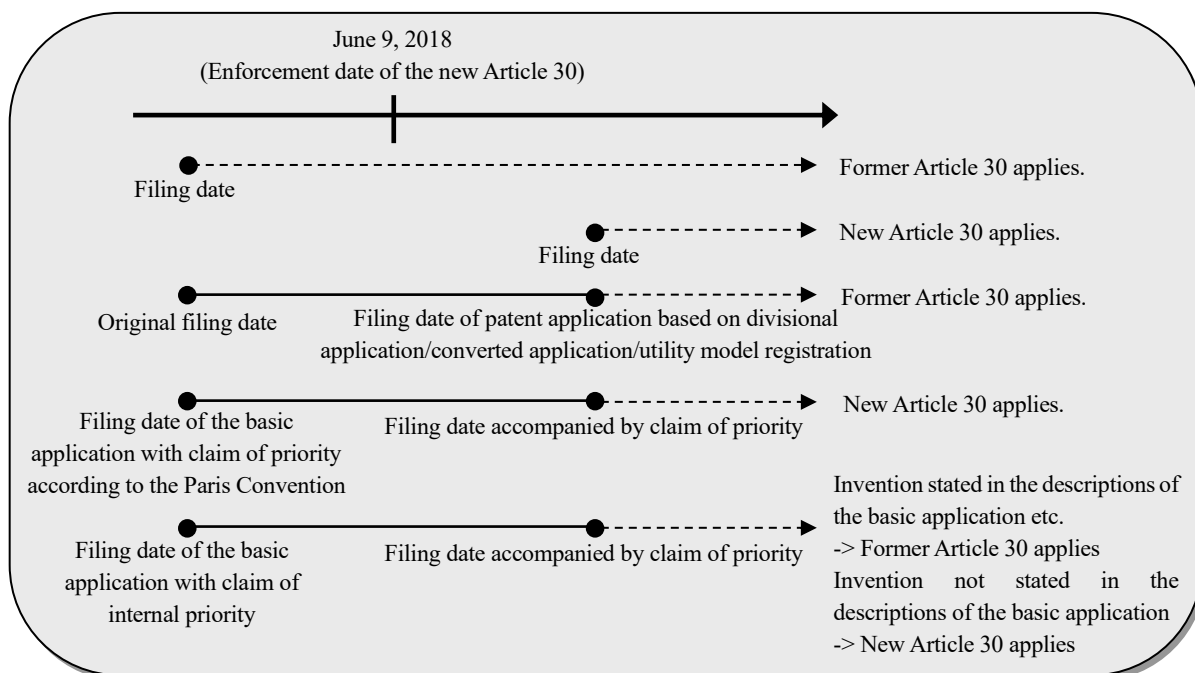
(3) Applications with claim of priority according to the Paris Convention

Patent applications of which applications with claim of priority were filed on or after June 9, 2018

(4) Applications with claim of internal priority

As a general rule ^(Note), applications for which basic application for claimed priority were filed on or after June 9, 2018

(Note) For inventions not stated in the descriptions, the claims or the drawing (descriptions, etc.) originally attached to the basic application, inventions accompanying claim of internal priority filed on or after June 9, 2018

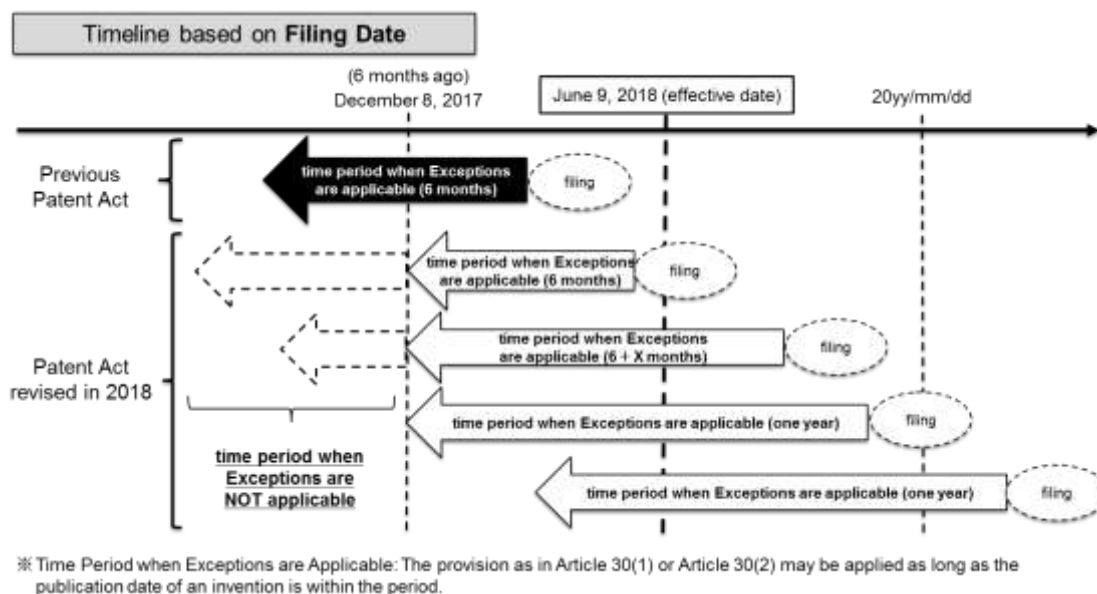
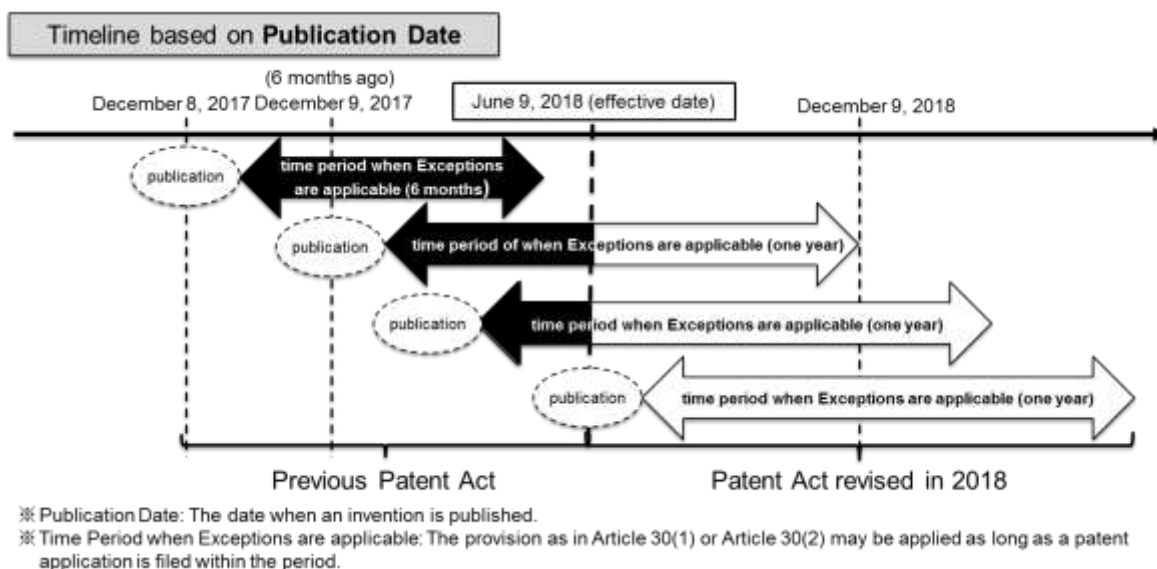


Former Article 30: Article 30 of the Patent Act before amendment of 2018

New Article 30: Article 30 of the Patent Act amended in 2018

3232 Inventions that were published on or before December 8, 2017 under Article 30 of the Patent Act as amended in 2018 is Applicable

The provision of Article 30(1) or Article 30(2) of the Patent Act is not applicable on the inventions that were published on or before December 8, 2017, even if their patent applications are filed on or after June 9, 2018. Further, the provision of exceptions to loss of novelty of invention is not applicable on the inventions unless the inventions should be filed within 6 month form the date when the invention was published.



3233 Patent Applications to which Article 30 of the Patent Act as amended in 2018 is Applicable

(1) Normal applications

Patent applications filed between April 1, 2012 and June 8, 2018.

(2) Patent applications according to divisional applications, converted applications and utility model registrations

Patent applications of which original applications were filed between April 1, 2012 and June 8, 2018.

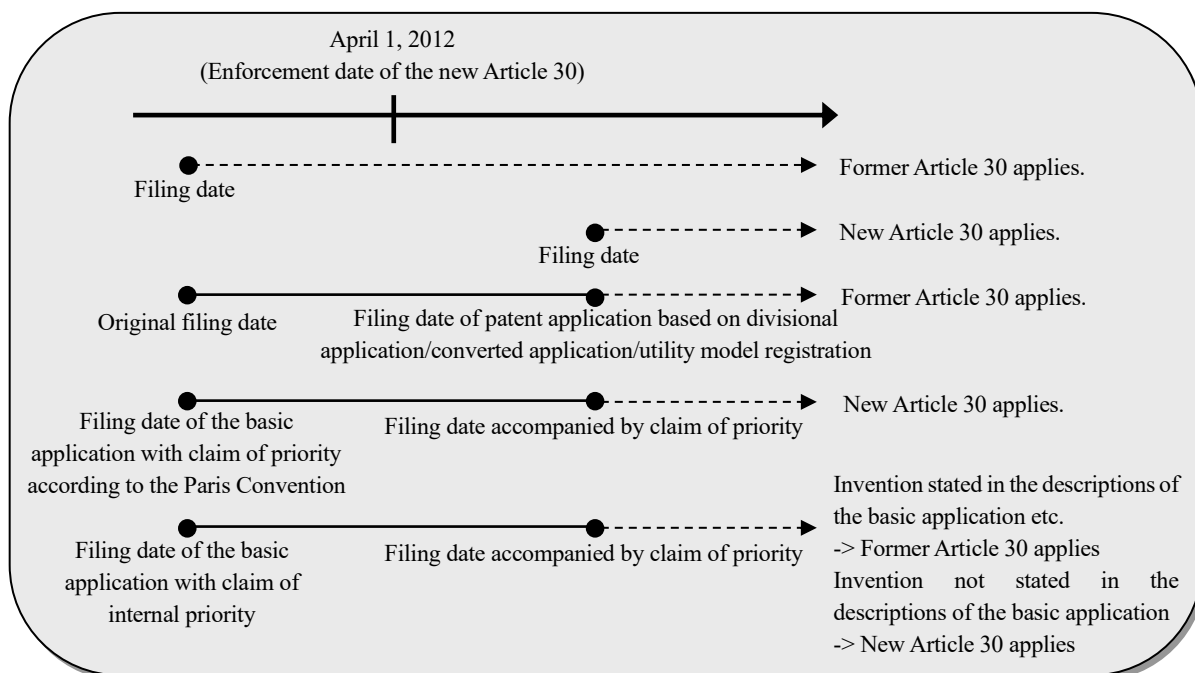
(3) Applications with claim of priority according to the Paris Convention

Patent applications of which applications with claim of priority were filed between April 1, 2012 and June 8, 2018.

(4) Applications with claim of internal priority

As a general rule (Note), applications for which basic application for claimed priority were filed between April 1, 2012 and June 8, 2018.

(Note) For inventions not stated in the descriptions, the claims or the drawing (descriptions, etc.) originally attached to the basic application, inventions accompanying claim of internal priority filed between April 1, 2012 and June 8, 2018.



Former Article 30: Article 30 of the Patent Act before amendment of 2011

New Article 30: Article 30 of the Patent Act amended in 2011

3234 Patent Applications to which Article 30 of the Patent Act prior to the Amendment of 2011 is Applicable

(*) Concerning patent applications filed on or before December 31, 1999, refer to "3234 Application of Article 30 to Patent Applications filed on or before December 31, 1999."

(1) Conditions for application for the provision of Article 30(1) or (3) of the Patent Act

The following requirements 1 to 3 are the conditions for application of Article 30(1) or (3) of the Patent Act. The Examiner should determine whether or not the "Providing Document" under the provision of Article 30(4) of the Patent Act has proven that the following Requirements 1 to 3 are satisfied.

(Requirement 1) A patent application was filed within six months from the date of disclosure of the invention.

(Requirement 2) The event that caused lack of novelty of the invention corresponds to the publication as provided for in Article 30(1) or (3) of the Patent Act.

(Requirement 3) The invention was made public by the person having the right to obtain a patent and the person filed the patent application.

(2) Determination as to applicability of the provision of Article 30(1) or (3) of the Patent Act

(i) Timing of determination

The invention made public, for which the applicant attempted to prove that the invention in question is eligible for application of the provision of Article 30(1) or (3) of the Patent Act, may also serve as evidence denying novelty and inventive step of the claimed invention, so long as the same provision is not applicable to the invention made public. In view of this, the applicability of this provision should be determined in principle prior to starting the examination.

(ii) Procedure of determination

When a "Providing Document" prepared in accordance with the form shown in Examination guidelines, "Part III Chapter 2 Section 5 Exceptions to Loss of Novelty of Invention," 2.3.1 is submitted within 30 days from the filing date of the patent application, the Examiner should, as a general rule, determine that it has been proven that Requirements

1 to 3 are satisfied.

However, even if a "Providing Document" prepared in accordance with the form shown in Examination guidelines, "Part III Chapter 2 Section 5 Exceptions to Loss of Novelty of Invention," 2.3.1 has been submitted, the Examiner should not allow application of the provision of Paragraph 1 or 3, if Examiner finds any evidence that causes any doubt about applicability of the provision of paragraph 1 or 3 to the invention.

After a notice of reasons for refusal is issued without admission of the application of the provision of paragraph 1 or 3, if the applicant asserts in the written opinion, a written statement, etc. that application of the provision of paragraph 1 or 3 should be allowed, the Examiner should refer to Examination guidelines "Part III Chapter 2 Section 5 Exceptions to Lack of Novelty of invention," 2.4 and Examination handbook "3226 Concrete Example of a Case in which Applicant's Assertion is Taken into Consideration in Determining on Application of the Provision of Article 30(2)."

"Providing Document" prepared in accordance with the form under Examination guidelines "Part III Chapter 2 Section 5 Exceptions to Loss of Novelty of Invention," 2.3.1 means Document A stated in "Operational Guidelines for Applicants to Seek the Application of Exceptions to Loss of Novelty of Invention " (Revised edition published in March 2010) (Certificate by applicant in accordance with prescribed form).

(3) Conditions for application for the provision of Article 30(2) of the Patent Act

The Examiner should determine whether or not it is reasonably explained by the written opinion, written statement etc. submitted by the application that the following two requirements are satisfied

(Requirement 1) A patent application was filed within six months from the date of disclosure of the invention.

(Requirement 2) The invention was made public against the will of the person having the right to obtain a patent.

(4) Points to note

Refer to Examination handbook "Part I Chapter 2 Procedures of Examination," 2. for notes in drafting a decision to grant a patent.

3235 Application of Article 30 to Patent Applications filed on or before December 31, 1999

(1) Conditions for application of the provision of Article 30(1) or (3) of the Patent Act

The following Requirements 1 to 4 are the conditions for application of the provision of Article 30(1) or (3) of the Patent Act. Examiner should determine whether or not the "Providing Document" provided for in Article 30(4) proves that the "Providing Document" provided for in Article 30(4) of the Patent Act satisfied all of the following requirements 1 to 4.

(Requirement 1) A patent application was filed within six months from the date of disclosure of the invention.

(Requirement 2) The event that caused lack of novelty of the invention corresponds to the publication as provided for in Article 30(1) or (3) of the Patent Act.

(Requirement 3) The invention was made public by the person having the right to obtain a patent and the person filed the patent application.

(Requirement 4) The invention made public is the invention of the patent application.

(2) Conditions for application of the provision of Article 30(2) of the Patent Act

The Examiner should determine whether or not written opinion, written statement, etc. submitted by the applicant have reasonably explained that the following three requirements are satisfied.

(Requirement 1) The patent application was filed within six months from the day on which the invention was made public

(Requirement 2) The invention was made public against the will of the person having the right to obtain a patent

(Requirement 3) The invention made public is the invention of the patent application

3299 Others

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

	Reference
Procedure of describing for publication, etc. cited in a reason for refusal due to lack of novelty, or inventive step	"1207 Matters to Be Stated in the Publications, etc. Which is Cited in the Reasons for Refusal of the Patent Application " in "Part I Chapter 2 Procedures of Examination"
Handling of the case of "anticancer drug comprising compound X"	Appendix B, "Chapter 3 Medical invention"
Points to note in a decision to grant when steps to seek application of the provision of Article 30 are taken	2. in "1210 Points to which Attention Should be Paid when Drafting Decision to Grant a Patent " in "Part I Chapter 2 Procedures of Examination"

Chapter 3 Secret Prior Art (Patent Act Article 29bis)

3301 A Case in Which Comparison Between the Claimed Invention and the Cited Invention is Difficult Due to the Descriptions Etc. of Function, Feature, Etc., and Cannot be Carried Out Precisely

This case conforms to 3218 to 3223 of "Part III Chapter 2 Novelty and Inventive Step".

Chapter 4 Prior Application (Patent Act Article 39)

3401 Points to Note in a Case in Which Embodiments of the Claimed Invention and the Earlier Application Invention are Identical

The examiner shall not determine that the claimed invention and the earlier application invention are "the same" simply because one embodiment related to the claimed invention and one embodiment related to the earlier application invention are identical. Because the claimed invention and the earlier application invention are creation of technical ideas utilizing the law of nature (Article 2(1) of Patent Act, Article 2(1) of Utility Model Act), determination on whether or not the claimed invention and the earlier application invention are "the same" should be carried out by determining not embodiments but identity of technical ideas.

3402 Reasons to Determine Whether or not the Claimed Invention and the Co-Pending Application Invention Filed on the Same Date are "the Same" as Described in 3.2.2 of "Part III Chapter 4 Earlier Application" of the Examination Guidelines in a Case in Which the Other Application is the Co-Pending Application Filed on the Same Date

Examination guidelines "Part III Chapter 4 Prior Application" 3.2.2 (Excerpt)

When an invention A and an invention B are applied on the same day and are the same (means "same" referred to in 3.2.1. This shall apply to corresponding counterparts in this paragraph hereunder) in the both cases of (i) and (ii) provided below, the examiner shall identify that the claimed invention and inventions claimed in the claims of the co-pending applications filed on the same date (hereinafter referred to as "co-pending inventions" in this chapter).

- (i) Where the invention A is presumed to be an earlier application and where the invention B is presumed to be a later application**
- (ii) Where the invention B is presumed to be an earlier application and where the invention A is presumed to be a later application**

In the meantime, even in a case where the invention B of the later application and the invention A of the earlier application are the same provided that the invention A is taken as an earlier application and that the invention B is taken as a later application, when the invention A of the later application and the invention B of the earlier application are not the same provided that the invention B is taken as an earlier application and that the invention A is taken as a later application, the examiner shall interpret that the claimed invention and the co-pending inventions are not the "same" (e.g., the invention A is a "spring," and the invention B is an "elastic member").

For example, with respect to such inventions A and B that the invention A is a more specific concept invention and the invention B is a generic concept invention, in a case where both are respectively filed on the same date (e.g., in a case where the invention A is "a spring" and the invention B is "an elastic body", and both inventions are respectively filed on the same date), it is not proper that both inventions are considered to be the same. It is because that, in consideration that it is not determined that the claimed invention A and the earlier application invention B are considered to be the same in a case where the filing date of the application concerned and the filing date of the other application are different from each other, it is not proper that the invention A and the invention B are considered to be the same and there are the reasons for refusal in both of the application concerned and

the other application filed on the same date.

3403 A Case in Which Matters Specifying the Invention of the Earlier Application Invention or Co-Pending Application Invention Filed on the Same Date Have Alternatives

In this case, on the basis of descriptions and drawings of the earlier application or the co-pending application filed on the same date and the common general knowledge as of the filing of the earlier application or the co-pending application filed on the same date, the invention at the time when only any one of the alternatives is supposed to be the matters specifying the invention must be recognized by a person skilled in the art from the claim(s). Accordingly, for the claim(s) in the Markush form, for example, it is required to examine whether or not one might say that a part of the alternatives is an invention that can be recognized singly by a person skilled in the art.

3404 Determination on whether or not the Claimed Invention Having
Alternatives cannot be Patented according to the Provisions of Article 39,
and Relationship with Termination of the Prior Art Search

Handling of 4.3 of "Part III Chapter 4 Prior Application" of the examination guidelines is not related to whether or not the prior art search can be terminated in what case. For this point, refer to 3.1.3 of "Part I Chapter 2 Section 2 Prior Art Search and Determination of Novelty, Inventive Step etc." of the examination guidelines.

3405 Fixation of Prior Application

“Fixation of Prior Application” under 4.4.1(1) of Part III Chapter 4 Prior Application” of the Examination Guidelines means the cases of (i) and (ii) as follows:

(i) Cases where registration of establishment of patent right is accomplished

(Explanation)

Even after the certified copy of the examiner’s decision or the trial decision to the effect that the patent are to be granted has been served, in the case where the payment of patent fees (Article 108(1)) is not made within the prescribed period and registration of establishment of patent right (Article 66) is not accomplished, there is a possibility that the application will be dismissed (Article 39(5)) and the status of prior application will be lost. Therefore, it shall be decided to have the status of prior application only when registration of establishment of patent right is accomplished.

(ii) Cases where the decision or the trial decision to the effect that the patent application has become final and binding on the basis that the latter sentence of either Article 39(2) or (4) is applicable to the application

(Explanation)

Even if the decision or the trial decision to the effect that the patent application has become final and binding on the basis that the latter sentence of either Article 39(2) or (4) is applicable to the application, the prior-art effect of the application shall not be lost (Article 39(5)). Therefore, where the decision or the trial decision thereof has become final and binding, it shall be decided to have the status of prior application.

3406 Notification to the Patentee (the Utility Model Right Holder), Etc. at the time when a Notice of Reasons for Refusal is issued in a Case Where the Invention Related to the Patent Application is the Same as an Invention (Device) Related to the Patent (Utility Models) Filed on the Same Date by a Different Applicant and That Has Already Registered

1. Cases where the patentee (the utility model right holder), etc. is notified

In a case where an invention related to the patent application is the same as an invention (device) related to a patent (utility models) filed on the same date by a different applicant and that has already registered, the patentee (the utility model right holder), etc. is notified of the fact when the applicant is notified of the reason for refusal based on the provision of Article 39(2) or (4) of Patent Act.

2. Form and procedure of the notification

The examiner enters necessary items in the notice to the patentee (the utility model right holder) (Annex 1) and the notice to the patent applicant¹ (Annex 2), signs the examiner's name, and then, submits a copy of each notice to an approval person together with a draft. After the approval is finished, each notice is submitted to the Coordination Division. The Coordination Division scans the notice as an internal document, and then, mails it in sealed covers.

Since the notice is not the consultation invitation (In a case where one application is patented or registered as a utility model, no consultation is permitted.), there might be no response from the applicant to the notice.

(Points to Note at Entry)

- (1) A drafting date of a notice of reasons for refusal is entered in the date field.
- (2) An address and a name of an agent (of the patent applicant in a case where there is no agent) are entered in a destination field of the notice to the patent applicant.
- (3) In a destination field of the notice to the patentee (the utility model right holder),
 - (i) in a case where the patentee (the utility model right holder) is not a foreign resident, an address and a name of the patentee (the utility model right holder)

¹ The patent applicant is also notified for a reason that both the applicant and the patentee (the utility model right holder) are notified of the notification of reasons for refusal almost simultaneously.

are entered.

- (ii) in a case where the patentee (the utility model right holder) is a foreign resident,
 - (i-1) in a case where a patent (utility models) administrator is nominated, an address and a name of the patent (utility models) administrator are entered.
 - (i-2) in a case where no patent (utility models) administrator is nominated, an address and a name of the patent (utility models) administrator at the registration of establishment are entered.

Annex 1

-

To.

Notice (For Patentee)

H , ,

Examiner _____ ()
 (Signature) Author Code

To. Patentee

Please be informed of the following respect related to a patent that you are the patentee :

Japanese Patent No.
 (Japanese Application No. -).

NOTE

A notice of reasons for refusal based on the provision of Article 39(2) of Patent Act is issued to the undermentioned application because it is recognized that an invention related to Claim () of the undermentioned application is identical to an invention related to Claim () of the abovementioned patent that was filed on the same date and has been already registered.

Japanese Patent Application No. -
 (JP - A)

Applicant

Address

Name

Agent

Address

Name

In a case where there is a joint owner, an exclusive licensee, and a non-exclusive

licensee for the abovementioned patent right, please inform the joint owner, the exclusive licensee, and the non-exclusive licensee of the contents of this notification.

Although no consultation of Article 39(6) of Patent Act can be held in a case where one of the applications has been patented, this notification is issued because it is valuable to have a chance of substantial consultation between the patent applicant and the patentee for the purpose of avoiding reasons for refusal or grounds for invalidation and of obtaining appropriate protection.

The abovementioned patent applicant is also notified of this notification.

Annex 2

-

To.

Notice (For Patent Applicant)

H , ,

Examiner _____ ()
(Signature) Author Code

To. Applicant

Please be informed of the following respect related to an application that you are the applicant :

Japanese Patent Application No. -
 (JP - A).

NOTE

A notice of reasons for refusal based on the provision of Article 39(2) of Patent Act is issued to the abovementioned application because it is recognized that an invention related to Claim () of the abovementioned application is identical to an invention related to Claim () of the undermentioned patent that is filed on the same date and has been already registered.

Japanese Patent No.
 (Japanese Patent Application No. -)

Patentee

Address

Name

Patent administrator

Address

Name

For details of the patentee and the exclusive licensee, please confirm the registry.

Although no consultation of Article 39(6) of Patent Act can be held in a case where one of the applications has been patented, this notification is issued because it is valuable to have a chance of substantial consultation between the patent applicant and the patentee for the purpose of avoiding reasons for refusal or grounds for invalidation and of obtaining appropriate protection.

The abovementioned patentee is also notified of this notification.

3407 A Case in Which Consultation Shall be Ordered Only for Application Concerned

In a case where the applicant of the application concerned and the applicant of the other application are the same, and the application concerned and the other application satisfy any one relationship of the following (i) to (iii), the examiner can invite the consultation only for the application concerned.

- (i) Cases where the application concerned is one patent application of the divisional application group based on the other patent application (Note).
- (ii) Cases where the other patent application is one patent application of the divisional application group based on the application concerned.
- (iii) Cases where both the application concerned and the other patent application are one patent application of the divisional application group based on the same patent application.

(Note) The divisional application group based on the patent application refers to a series of divisional applications deriving from one patent application. This includes divisional applications based on one patent application, as well as divisional applications (grandchild applications) based on the divisional application (child applications).

3408 A Case in Which Comparison Between the Claimed Invention and the Earlier Application Invention or the Co-Pending Application Invention Filed on the Same Date is Difficult Due to the Descriptions Etc. of Function, Feature, Etc., and Cannot be Carried Out Precisely.

This case conforms to 3218 to 3223 of "Part III Chapter 2 Novelty and Inventive Step" of this handbook.

3409 Amendment History of Article 39

Application Date	July 1, 1995 - March 31, 1997	April 1, 1997 - December 31, 1998	January 1, 1999 - March 31, 2005	April 1, 2005 - March 31, 2012	April 1, 2012 -
(1)	Where two or more patent applications claiming identical inventions have been filed on different dates, only the applicant who filed the patent application on the earliest date shall be entitled to obtain a patent for the invention claimed.				
(2)	Where two or more patent applications claiming identical inventions have been filed on the same date, only one applicant, who was selected by consultations between the applicants who filed the applications, shall be entitled to obtain a patent for the invention claimed. Where no agreement is reached by consultations or consultations are unable to be held, none of the applicants shall be entitled to obtain a patent for the invention claimed.				
(3)	Where an invention and a device claimed in applications for a patent and a utility model registration are identical and the applications for a patent and a utility model registration are filed on different dates, the applicant for a patent may obtain a patent for the invention claimed therein, only if the application for a patent is filed prior to the application for a utility model registration.				
(4)	Where an invention and a device claimed in applications for a patent and a utility model registration are identical and the applications for a patent and a utility model registration are filed on the same date, only one of the applicants, selected by consultations between the applicants, shall be entitled to obtain a patent or a utility model registration. Where no agreement is reached by consultations or no consultations are able to be held, the applicant for a patent shall not be entitled to obtain a patent for the invention claimed therein.		Where an invention and a device claimed in applications for a patent and a utility model registration are identical (excluding the case where an invention claimed in a patent application based on a utility model registration under Article 46-2(1) (including a patent application that is deemed to have been filed at the time of filing of the patent application under Article 44(2) (including its mutatis mutandis application under Article 46(6)) and a device relating to the utility model registration are identical) and the applications for a patent and a utility model registration are filed on the same date, only one of the applicants, selected by consultations between the applicants, shall be entitled to obtain a patent or a utility model registration. Where no agreement is reached by consultations or no consultations are able to be held, the applicant for a patent shall not be entitled to obtain a patent for the invention claimed therein.		
(5)	Where an application for a patent or a utility model registration has been withdrawn or invalidated, the application for a patent or a utility model registration shall, for the purpose of paragraphs (1) to (4), be	Where an application for a patent or a utility model registration has been withdrawn or dismissed, the application for a patent or a utility model registration shall, for the purpose of paragraphs (1) to (4), be	Where an application for a patent or a utility model registration has been waived, withdrawn or dismissed, or where the examiner's decision or trial decision to the effect that a patent application is to be refused has become final and binding, the application for a patent or a utility model registration shall, for the purpose of paragraphs (1) to (4), be deemed never to have been filed; provided, however, that this shall not apply to the case where the examiner's decision or trial decision to the effect that the patent application is to be refused has become final and binding on the basis that the latter sentence of paragraph (2) or (4) is applicable to the patent application.		

	deemed never to have been filed.	deemed never to have been filed.	
(6)	An application for a patent or a utility model registration filed by a person who is neither the inventor nor designer nor the successor in title to the right to obtain a patent or a utility model registration shall, for the purpose of application of paragraphs (1) to (4), be deemed to be neither an application for a patent nor an application for a utility model registration. (deleted after April 1, 2012)		The JPO Commissioner shall, in the case of paragraph (2) or (4), order the applicant to hold consultations as specified under paragraph (2) or (4) and to report the result thereof, designating an adequate time limit. ((7) before March 31, 2012)
(7)	The JPO Commissioner shall, in the case of paragraph (2) or (4), order the applicant to hold consultations as specified under paragraph (2) or (4) and to report the result thereof, designating an adequate time limit.		Where no report under the preceding paragraph is submitted within the time limit designated under the paragraph, the JPO Commissioner may deem that no agreement under paragraph (2) or (4) has been reached. ((8) before March 31, 2012)
(8)	Where no report under the preceding paragraph is submitted within the time limit designated under the paragraph, the JPO Commissioner may deem that no agreement under paragraph (2) or (4) has been reached.		

* For applications from April 1, 2015, the wording "Article 46(5)" is changed to "Article 46(6)".

3499 Others

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

	Reference
Request for submission of a document explaining that the invention related to the divisional application is not the same as the invention related to the original application and the invention related to the other divisional application	1.(4) in "1218 Cases Where the Examiner Requests to Submit the Documents or Other Materials under the Provision of Article 194(1) " in "Part I Chapter 2 Procedures of Examination"
Points to note in a case where decision to grant a patent is issued for an application of one applicant defined by the consultation	1. in "1210 Points to which Attention Should be Paid when Drafting Decision to Grant a Patent " in "Part I Chapter 2 Procedures of Examination"
Points to note in a case where decision of refusal based on <u>Article 39</u> is drafted	2. in "1213 Points to Which Attention Should be Paid When Drafting Decision of Refusal " in "Part I Chapter 2 Procedures of Examination"

Chapter 5 Category of Unpatentable Invention (Patent Act Article 32)

3501 Handling of Cases in Which Matters or Contents That Clearly Damage the Public Order or Morality are Described in the Descriptions or Drawings

In a case where the JPO Commissioner recognizes that publication in the patent official gazettes, of the matters described in the descriptions and the claims and the contents of the drawings may damage the public order or the morality (hereinafter, referred to as "public order and morality"), such matters or contents are not published in the publication of unexamined patent applications (Article 64(2) proviso). On the other hand, with respect to the gazette containing the patent after the decision to grant a patent, there are no provisions related to unpublication of such matters or contents by the JPO Commissioner (Refer to Article 66(3)).

In a case where the matters and contents that clearly damage the public order and morality are described in the descriptions or the drawings (hereinafter, referred to as "descriptions etc."), the reason for refusal of violation of Article 32 cannot be notified for only that reason. The reason for refusal of violation of Article 32 is issued to the claimed invention (Article 49-2).

Accordingly, even when the matters or contents that clearly damage the public order and morality are described in the descriptions etc., in a case where the examiner takes no reaction, such a case that the matters or contents that are not published in the publication of unexamined patent applications at publication of unexamined application is published in the gazette containing the patent occurs.

Thus, in a case where the matters or contents that clearly damage the public order and morality are described in the descriptions etc., handling is performed as follows.

1. When a reason for refusal is found, the examiner notifies of the reason for refusal to point out a part where the matters or contents that clearly damage the public order and morality in the descriptions etc., in the "proviso" of the notice of reasons for refusal, and suggests amendment that can resolve the matters.
2. In a case where it is determined that the decision to grant a patent is possible because no reasons for refusal are found, the examiner deals with the cases as follows.

- (1) Before the first notice of reasons for refusal, the examiner contacts the applicant or the agent by telephone to facilitate getting rid of the matters or the contents that clearly damage the public order and morality in the descriptions etc. by voluntary amendment.
- (2) If not before the first notice of reasons for refusal, the examiner contacts the applicant or the agent by telephone to correct the descriptions etc. by ex officio with acknowledgement if at all possible (Refer to 2.2 of 2002 of "Part II Chapter 1 Description Requirement for Detailed Description of the Invention"). The examiner performs the minimum correction by ex officio after consultation with a person in an administrative position.

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

Part IV Amendments of Description, Claims or Drawings

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Chapter 3 Amendment Changing Special Technical Feature of Invention (Patent Act Article 17bis(4))

Chapter 4 Amendment for other than the Prescribed Purposes (Patent Act Article 17bis(5))

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Chapter 1 Requirements for Amendments (Patent Act Article 17bis)

4101 List of Relevant Articles

	July 1, 1995 to March 31, 2007	After April 1, 2007
Reasons for Refusal	Article 49(i)	
Amendment Adding New Matter	Article 17bis (3)	
Amendment Changing Special Technical Feature of Invention		Article 17bis (4)
Dismissal of Amendment	Article 53(1)	
Amendment Adding New Matter	Article 17bis (3)	
Amendment Changing Special Technical Feature of Invention		Article 17bis (4)
Amendment for other than the Prescribed Purposes	Article 17bis (4)	Article 17bis (5)
Requirement of Independent Patentability	Article 126(5) as applied mutatis mutandis under Article 17bis (5)	Article 126(7) as applied mutatis mutandis under Article 17bis (6)

Chapter 2 Amendment Adding New Matter (Patent Act Article 17bis(3))

4201 Reference Court Decision Regarding the Term "Matters Obvious from the Statement in the Originally Attached Description, etc."

Tokyo High Court decision July 1, 2003 (case of request for rescission of trial decision 2002 (Gyo Ke) No. 3) "Network Transmission System such as Game and Japanese Pinball"

"Also, in order for matters to be found obvious from those actually stated therein, the matters must be such that any person skilled in the art who should contact what is actually stated would understand them as if they were stated therein. Matters that could only be understood easily if any explanation is provided therefor cannot be obvious matters."

The above court decision will serve as a reference for understanding the meaning of the term as such of "matters obvious from the statement in the originally attached description, etc."

4202 Example of Amendment Changing Matters Specifying the Invention

Examination guidelines "Part IV Chapter 2 Amendment Adding New Matter," 3.3.1
(Excerpt)

(1) In the case of an amendment which converts the matters specifying the invention into generic concepts or deletes or changes them

- a In the case where an amendment which converts the matters specifying the invention in a claim into generic concepts or deletes or changes them introduces any new technical matter, such an amendment shall not be permitted.
- b On the other hand, even in the case of an amendment which converts the matters specifying the invention in a claim into generic concepts or deletes or changes them, particularly, in the case of an amendment which deletes part of the matters specifying the invention in a claim, if it is obvious that the amendment does not add any new technical significance, the amendment does not introduce any new technical matter. Therefore, such an amendment shall be permitted (Example 1).

For example, in the case where a matter to be deleted is not related to a problem to be solved by the invention and is obviously an optional additional matter from the statement in the originally attached description, etc., the amendment does not add any new technical significance in many cases.

(Amendment changing the matters specifying the invention (example of above "a"))

Example:

[Claim]

Amendment for changing the phrase "when control means are not executed normally" to the phrase "based on a negation signal in case control means are not executed normally."

[Originally attached description, etc.]

It is merely stated that, when the control means are not executed normally, the absence of a positive signal lasts for a predetermined period of time and a resetting signal is generated.

(Explanation)

This amendment adds a configuration in which the resetting signal is generated based on "a negation signal," which is different from the no signal state. This is not, however, stated in the originally attached description, etc.

4203 Points to Note for Amendment by Applicant

- (1) When the applicant intends to make an amendment, the applicant is requested to explicitly specify the amended portions by indicating underlines thereto. The applicant is also requested to indicate portions of the originally attached description, etc. as the basis for amendment in a written statement in the case of a voluntary amendment and in a written opinion in the case of an amendment to respond to a notice of reasons for refusal, and to explain that an amendment is made within the scope of matters stated in the originally attached description, etc.

(Explanation)

As an applicant knows the content of the matters stated in the originally attached description, etc. and the content of the amendment, the applicant requested, when making an amendment, to fully explain that the amendment is made within the scope of the matters stated in the originally attached description, etc. in a written statement or a written opinion. When failing to eliminate doubt as to whether or not an amendment is made within the scope of the matters stated in the originally attached description, etc., the amendment cannot be found to be made within the scope of the matters stated in the originally attached description, etc.

For example, in the example of "an elastic support" of 3.2(ii) of "Part IV Chapter 2 Amendment Adding New Matter" of the Examination Guidelines for Patent and Utility Model, if an applicant establishes that a person skilled in the art would naturally understand that "an elastic support" means "a helical spring," referring to the drawings, etc., which eliminates any doubt as to whether or not the amendment is within the scope of matters stated in the originally attached description, etc., then the amendment is permitted. When such a doubt is not eliminated, the amendment is not found to be made within the scope of the matters stated in the originally attached description, etc.

- (2) The applicant should be reminded that the patent involves a ground for invalidation if the patent was granted with content beyond the scope of the matters stated in the originally attached description, etc.

4299 Others

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

	Refer to:
Request for submission of a document explaining the basis for the amendment	1.(6) in "1218 Cases Where the Examiner Requests to Submit the Documents or Other Materials under the Provision of 194(1)" in "Part I Chapter 2 Procedures of Examination"

Chapter 3 Amendment Changing Special Technical Feature of Invention
(Patent Act Article 17bis(4))

Chapter 4 Amendment for other than the Prescribed Purposes (Patent Act Article 17bis(5))

4499 Others

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

	Refer to:
Points to Note in a case where more than one round of amendment has been made within the designated time period of the final notice of reasons for refusal	2. in "1208 Handling in Cases Where a Plurality of Written Amendment etc. were submitted" in "Part I Chapter 2 Procedures of Examination"
Handling of cases where the amendment made to the claims after the final notice of reasons for refusal is determined as being made for more than one purpose from the items of Article 17bis (5) of the Patent Act	"1215 Handling in Cases where the Amendment of Claims after the Final Notice of Reasons for Refusal is Considered to Aiming at Two or More Matters Listed in Items of Article 17bis (5) of the Patent Act" in "Part I Chapter 2 Procedures of Examination"
Request for submission of a document explaining the purpose(s) of the amendment	1.(6) of "1218 Cases Where the Examiner Requests to Submit the Documents or Other Materials under the Provision of 194(1)" in "Part I Chapter 2 Procedures of Examination"

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

Part V Priority

Contents

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Chapter 1 Priority under the Paris Convention

5101 The Case Where an Applicant is Not Found to have Intentionally Failed to File a Patent Application Claiming Priority under the Paris Convention within 12 Months from an Application Filed in a First Country

An applicant who fails to file a patent application claiming priority under the Paris Convention within the period of priority may claim such priority for the same patent application pursuant to the Paris Convention even after a lapse of such period and the applicant files the application within 2 months from the date of expiry of the period of priority, specified in Article 27-4-2 (2) of Regulations under the Patent Act, and yet, this shall not apply where the applicant is found to have intentionally failed to file the patent application within the priority period (Note) (Article 43-2 (1) of the Patent Act) . Such a case shall be handled in accordance with 3. and 4. of "Part V Chapter 1 Priority under the Paris Convention" of the Examination Guidelines as in the case of an application claiming priority under the Paris Convention.

An applicant claiming priority under the Paris Convention shall submit the documents stating the matters specified in Article 43 (1) of the Patent Act to the JPO Commissioner within the period of time specified in the Ordinance of the Ministry of Economy, Trade and Industry (i.e. Article 27-4-2 (3) (i), (ii) and (iv) of Regulations under the Patent Act).

(Note) The examiner needs not make a determination on the "the fact that has not been intentional". Such determination is made through formality checks.

5102 Regular National Application Filed in a Member Country of the Union of the Paris Convention

Regular national application filed in a member country of the Union of the Paris Convention means an application filed under national laws and regulations of a member country of the Union of the Paris Convention or an application deemed to be a regular national application under a bilateral or multilateral treaty concluded between member countries of the Union of the Paris Convention that meets the requirements to establish a filing date of the application. Even an application withdrawn, abandoned, or refused by a decision after filing of the patent application, therefore, may be a basis of the claim of priority under the Paris Convention so far as it satisfies the above (Article 4 A (3) of the Paris Convention).

5103 The Case Where a Subsequently Filed Application is Deemed to be the First Application

Even if two applications are filed for the same subject in the same member country of the Union of the Paris Convention, a subsequently filed application is deemed to be the first application so far as both of the following requirements are met:

- (i) when the earlier patent application is withdrawn, abandoned or refused by a decision before the filing date of the subsequently filed application, without becoming open to public inspection and without any rights remaining; and
- (ii) when the earlier patent application does not constitute a basis of the claim of priority under the Paris Convention.

5104 Reason Why a Determination on the Effect of Claiming the Priority under the Paris Convention is Made Dependent on Whether There is Any Addition of a New Matter

The Paris Convention establishes that "elements of the invention" shall be specifically disclosed by the application documents as a whole filed in a first country in order that the claim of priority under the Paris Convention takes effect. (Article 4 H of the Paris Convention). It is understood that, in order to meet the above requirement, the claimed invention grasped from statements in the application documents as a whole filed in Japan needs to be within the scope of the matters stated in the application documents as a whole filed in the first country.

5105 Example Where the Claimed Invention Filed in Japan is Converted within the Scope of the Matters Stated in the Application Documents as a Whole Filed in a First Country

[Application filed in a first country]

The claimed invention filed in the first country is related to a specific compound, and the application documents as a whole state an embodiment of an anticancer agent containing the compound as an active ingredient.

[Application filed in Japan]

The claimed invention filed in Japan is related to the anticancer agent containing the compound as an active ingredient while detailed descriptions of the invention and drawings are stated in the application documents as a whole filed in the first country.

(Determination on the priority)

Using the specific compound for the anticancer agent is stated in the application documents as a whole filed in the first country, and does not fall under the addition of new matter in relation to the matters stated therein. The claim of priority under the Paris Convention, therefore, takes effect.

5106 Example Where, with the Invention Stated in the Application Documents as a Whole Filed in a First Country, Another Matter Specifying the Invention not Stated Therein is Combined

[Application filed in a first country]

The application documents as a whole filed in the first country only state "vibration control structure that connects the lower story part and the upper story part of the structure with the vibration control device."

[Application filed in Japan]

It is claimed that the claimed invention filed in Japan is related to "vibration control structure that connects the lower story part and the upper story part of the structure with the vibration control device, and is equipped with means to control the connection".

(Determination on the priority)

The claimed invention filed in Japan has combined, with the invention stated in the application documents as a whole filed in the first country, another matter specifying the invention not stated therein. In other words, since the claimed invention falls under the addition of new matter in relation to the matters stated in the application documents as a whole filed in the first country, the claim of priority under the Paris Convention does not take effect.

5107 Determination on Whether or not the Claimed Invention Filed in Japan is Enabled or Not

Determination on whether or not the claimed invention filed in Japan is enabled or not is similar to that on enablement requirement of requirements for description. (See "Part II Chapter 1 Section 1 Enablement Requirement" of the Examination Guidelines for specific methods of determination)

Please see 1.1.4(4) of "Appendix B Chapter 2 Biological Inventions" for the case of claiming priority for which the deposit of biological material is necessary.

Example 1: The claimed invention filed in Japan becomes enabled after addition of an embodiment.

[Application filed in a first country]

No embodiment is stated in the application documents as a whole filed in the first country, and the claimed invention filed therein is not considered to be enabled.

[Application filed in Japan]

While the wording of the claimed invention filed in Japan is the same as that of the claimed invention filed in the first country, an embodiment is added in the detailed description of the invention or drawings, which makes the former invention enabled.

(Determination on the priority)

Since such addition of the embodiment makes the claimed invention filed in Japan go beyond the scope of the matters stated in the application documents as a whole filed in the first country, the claim of priority under the Paris Convention does not take effect.

(Explanation)

If the statement of an embodiment is added to the application documents filed in the first country, and the application is filed in Japan, which makes the claimed invention filed in Japan enabled, it will mean that new matter is added in relation to the matters stated in the application documents as a whole filed in the first country. With regard to the claimed invention filed in Japan, therefore, the claim of priority under the Paris Convention does not take effect.

Example 2: The claimed invention filed in Japan becomes enabled after the additional statement of experiment results showing usability.

[Application filed in a first country]

The claimed invention filed in the first country is a gene, and the application documents as a whole state that the gene can be made, but fail to clarify its function. So, the claimed invention filed therein is not considered to be enabled.

[Application filed in Japan]

The claimed invention filed in Japan is the same gene as that in the claimed invention filed in the first country. The statement of its function based on experiment results is added to the application documents as a whole filed in Japan, which makes the invention of the gene enabled.

(Determination on the priority)

Since the invention of the gene for which the application is filed in Japan does not fall within the scope of the matters stated in the application documents as a whole filed in the first country, the claim of priority under the Paris Convention does not take effect.

(Explanation)

If, in filing the application in Japan, the statement of usability of the invention is added to the statements in the application documents filed in the first country, which makes the claimed invention filed in Japan enabled, it will mean that new matter is added in relation to the matters stated in the application documents as a whole filed in the first country. With regard to the claimed invention filed in Japan, therefore, the claim of priority under the Paris Convention does not take effect.

Example 3: The claimed invention filed in Japan becomes enabled due to a change in the common general knowledge.

[Application filed in a first country]

The claimed invention filed in the first country is a transgenic plant, and the application documents as a whole filed there states a dicotyledonous plant alone as the embodiment. It is recognized that no monocotyledonous plant could be made as a transgenic plant in view of the statement and the common general knowledge at the time of filing.

[Application filed in Japan]

The statement in the application documents as a whole filed in Japan is the same as that in the documents filed in the first country. Thanks to advancement in the gene recombination technology after the filing in the first country, the common general knowledge at the time of filing in Japan is that it is possible to genetically

modify monocotyledonous plants as long as dicotyledonous plants can be modified genetically. The claimed invention filed in Japan for the gene recombination of the monocotyledonous plant, therefore, becomes enabled as well.

(Determination on the priority)

Since the part of the monocotyledonous plant goes beyond the scope of the matters stated in the application documents as a whole filed in the first country due to the change in the common general knowledge, the claim of priority under the Paris Convention takes effect only for the part of the dicotyledonous plant, and does not for the part of the monocotyledonous plant.

(Explanation)

With regard to the part of the monocotyledonous plant in the claimed invention filed in Japan, the change in the common general knowledge means addition of new matter in relation to the matters stated in the application documents as a whole filed in the first country. Hence, the claim of priority under the Paris Convention takes effect only for the part of the dicotyledonous plant in the claimed invention, and does not for the part of the monocotyledonous plant.

5108 The Case Where the Application Documents as a Whole Filed in the First Country States Only a Part of the Claimed Invention Filed in Japan

[Application filed in a first country]

The application documents as a whole filed in the first country only state corrosion resistant steel containing chromium.

[Application filed in Japan]

The invention in one claim filed in Japan refers to the corrosion resistant steel containing chromium, and the invention in the other claim refers to the corrosion resistant steel containing chromium and aluminum.

(Determination on the priority)

With regard to the corrosion resistant steel containing chromium, the invention of one claim filed in Japan, the claim of priority takes effect because it is stated in the application documents as a whole filed in the first country. On the other hand, with regard to the corrosion resistant steel containing chromium and aluminum, the invention in the other claim, the claim of priority under the Paris Convention does not take effect because it means addition of new matter in relation to the matters stated in the application documents as a whole filed in the first country.

5109 Example Where Matters Stated in the Application Documents Filed in the First Country are Stated in Separate Claims Filed in Japan

[Application filed in a first country]

The application documents "A" as a whole filed in the first country state corrosion resistant steel containing chromium, and the application documents "B" as a whole filed in the first country state the corrosion resistant steel containing chromium and aluminum.

[Application filed in Japan]

One of the claimed invention filed in Japan claiming priority based on both of the application documents "A" and "B" as a whole filed in the first country is the corrosion resistant steel containing chromium, and another of the claimed invention so filed is the corrosion resistant steel containing chromium and aluminum.

(Determination on the priority)

With regard to one of the claimed invention filed in Japan, the priority claim takes effect based on the application "A" filed in the first country. With regard to another of the claimed invention filed in Japan, the priority claim under the Paris Convention takes effect based on the application "B" filed in the first country.

5110 Example Where Matters Specifying the Invention Stated in the Claim Filed in Japan are Stated in the Applications Filed in a First Country in Common

[Application filed in a first country]

The applications (earlier application "A" and later application "B") documents as a whole filed in the first country state a digital camera equipped with an image pickup element of certain construction and an automatic focus device. The claimed invention in the application "A" is a digital camera equipped with an image pickup element of certain construction, and the invention in the claim in the application "B" is a digital camera equipped with an automatic focus device.

[Application filed in Japan]

The claimed invention filed in Japan claiming priority based on both of the applications "A" and "B" filed in the first country is a digital camera equipped with an image pickup element of certain construction and an automatic focus device.

(Determination on the priority)

This case is examined with the filing date in the application "A" in the first country, the earlier application, regarded as the base date because the claimed invention filed in Japan is stated in the applications (both of the application "A" and the application "B") documents as a whole filed in the first country.

Chapter 2 Internal Priority

5201 The Case Where an Applicant is Not Found to have Intentionally Failed to File a Sequent Patent Application Claiming Internal Priority within One Year from an Earlier Application

In the case where the applicant is not found to have intentionally failed to file a sequent patent application claiming internal priority within one year from the filing date of an earlier application (Note), the applicant may claim internal priority within the period of one year and two months, specified in Article 27-4-2 (1) of Regulations under the Patent Act, from the filing date of the earlier application (Article 41 (1) parentheses in (i) of the Patent Act).

If the applicant claims internal priority, he/she shall submit to the JPO Commissioner a document stating thereof and the indication of the earlier application within the period of time specified in the Ordinance of the Ministry of Economy, Trade and Industry (Article 27-4-2 (3)(i) to (iii) of the Regulations under the Patent Act).

(Note) The examiner needs not make a determination on the "the fact that has not been intentional". Such determination is made through formality checks.

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

Part VI Special Application

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

6101 Examination Procedures Regarding Determination of Substantive Requirements

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

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

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

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

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

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

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

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

(Explanation)

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

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

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

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

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

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

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

(Explanation)

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

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

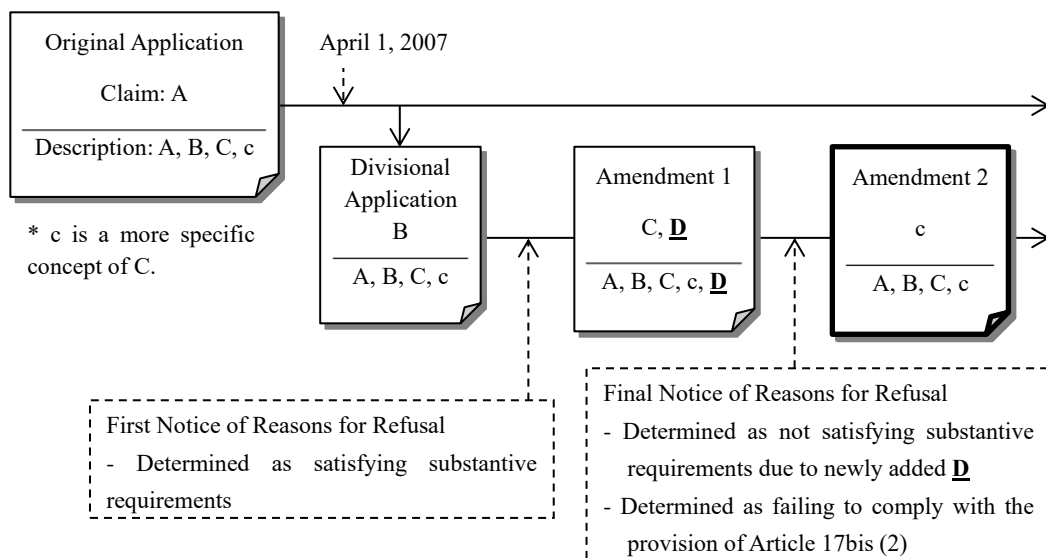
application but fails to comply with these provisions when it is determined at the time of actual filing of the divisional application (such an amendment can occur due to transitional measures upon revision of the Act, etc.). If determination regarding these provisions are made for this amendment prior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

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

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

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

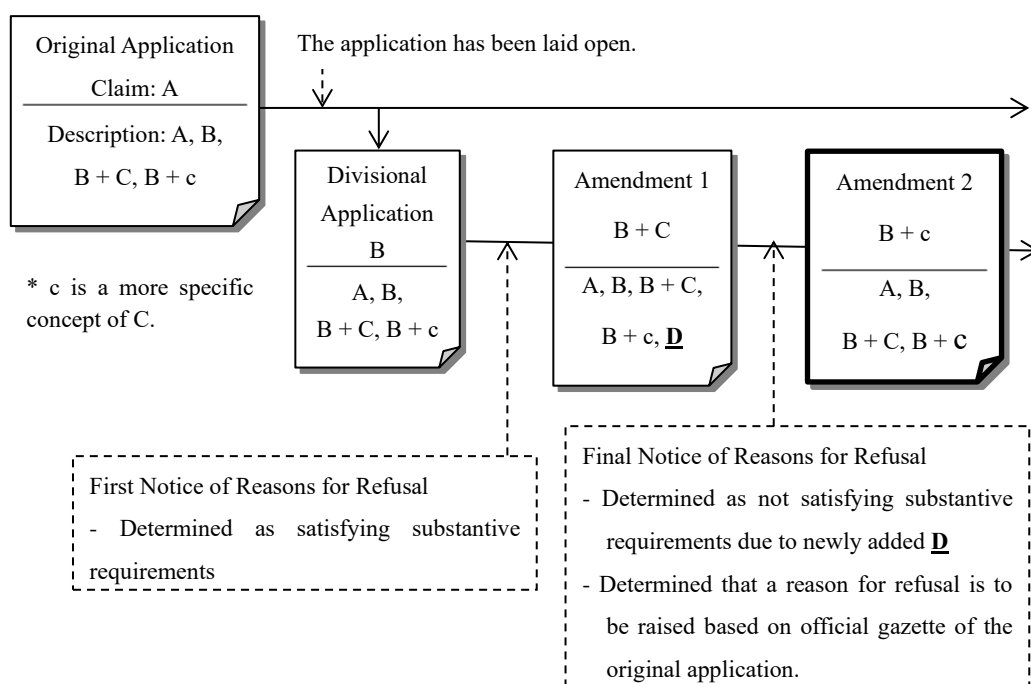
If determination as to the provisions of Article 17bis (4) to (6) has been made prior to the determination as to the substantive requirements, it is possible that the amendment 2 is dismissed as not complying with the provision of Article 17bis (4) as applied to applications filed on or after April 1,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



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

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

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



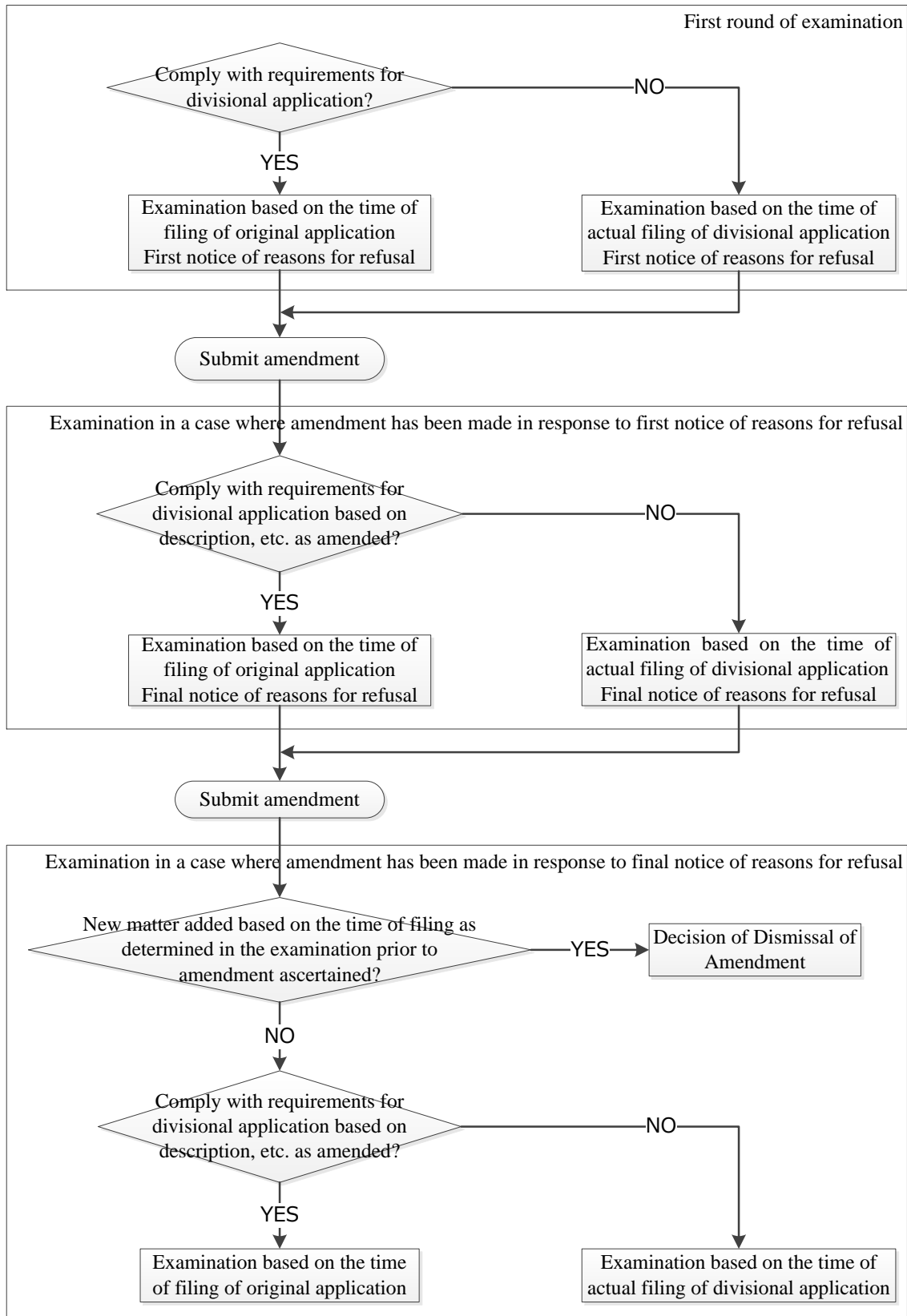
(3) Reconsideration by Examiner before Appeal proceedings

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

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

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

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



6102 Points to note in Examination of Grandchild Application

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

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

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

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

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

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

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

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

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

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

6103 Proviso of Patent Act Article 44(2)

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

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

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

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

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

(Explanation)

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

6105 History of Revisions of Patent Act Article 44

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

*Paragraph (7) is omitted.

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

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

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

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

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

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

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

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

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

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

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

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

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

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

Timing A: The timing when amendments to the description, claims, or drawings (hereinafter, referred to as "description, etc.") are allowed.

Timing B: The timing when amendments to the description, etc. are not allowed.

The judgement of the substantive requirements: The examiner shall determine whether the following requirements are met.

(Requirement 1) All of the inventions stated in the description, etc., as they stand immediately prior to the division of the original application do not together constitute the invention claimed in the divisional application.

(Requirement 2) The matters stated in the description, etc., of the divisional application are within the scope of those stated in the description, etc., of the original application as they stood at the time of filing thereof.

(Requirement 3) The matters stated in the description, etc., of the divisional application are within the scope of those stated in the description, etc., of the original application as they stand immediately prior to the division thereof.

However, if a patent application is divided at/during timing A, then Requirement 3 shall be deemed satisfied so long as Requirement 2 is met. This is because a matter which is not stated in the description, etc., of the original application as it stands immediately prior to the division thereof but was stated in the description, etc., of the original application as it stood at the time of filing thereof, may be included by an amendment in the description, etc., of the original application before it is divided.

6109 Operation Regarding Determination on Substantive Requirements for Division of Application

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

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

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

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

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

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

2. Patent application divided from the original application whose date of transmittal of

the certified copy of the decision of refusal is on or before March 31, 2009

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

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

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

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

3. Points to Note

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

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

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

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

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

Example 1:

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

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

Example 2:

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

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

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

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

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

(Explanation)

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

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

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

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

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

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

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

(Explanation)

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

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

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

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

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

6113 Points to note in Drafting Notice under Article 50bis

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

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

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

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

2. Example of Drafting

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

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

Note

The reasons for refusal of the present application

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

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

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

Remark

....."

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

[Reference]

Notice of Reasons for Refusal	
Number of patent application	Japanese Patent Application No. XXXX-XXXXXX
Drafting date	XX year X month X day
The examiner of the JPO	XX XX XXXX XX
The agent of the applicant	XX XX
Article applied	Article 29(2) (Inventive step), Article XX (XX)
<p><<<<The Notice of Reasons for Refusal including the Notice of Article 50bis of the Patent Act>>>></p> <p>This application should be refused for the following reasons. If having any opinion on the refusal, the applicant may submit the written opinion within sixty (60) days from the sending of the notice.</p> <p style="text-align: center;">Reasons</p> <p>1. (Inventive step) Since the following claimed invention in this application has been easily invented by a person skilled in the art to which the invention belongs before</p>	

filing, based on the invention stated in the following publications issued in Japan or a foreign country or based on the invention made available to the public through electronic communication network before filing, the following claimed invention is not patented under Article 29 (2) of the Patent Act.

2. ...

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

● Reason 1

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

.....

● Reason 2

<The claim in which the reasons for refusal have not been found>

Concerning the invention pertaining to Claim (), at this point, the reasons for refusal have not been found. In cases where the reasons for refusal are newly found, the reasons for refusal will be notified.

<List of the cited document, etc.>

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

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

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

Note

The reasons for refusal of the present application

- The reasons for refusal 1
- Claim 1

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

- The reasons for refusal 2
- Claim 2

Remark

.....

<The record of prior art searches results>

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

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

For any inquiry including about the content of this notice of reason for refusal or request for an interview, please contact us at the number below. Should Applicant wish to send a proposed amendment, etc., please notify us in advance. When contacting us by e-mail, please include your name, affiliation, application number, telephone number and the name of the examiner (assistant examiner) and send to the e-mail address (*) below. If any uncertainty about the content of the e-mail communication arises, we may confirm it by telephone.

Examination Department of X XX Division The name of examiner

Tel: 03-3581-1101 ext. xxxx

* ●●●●@jpo.go.jp (replace "●●●●" above with "PAxxx")

6130 Suspension of Examination of a Divisional Application While the Original Application is Pending Trial

A divisional application filed after a decision of refusal has been issued for the original application, where the original application is pending reconsideration by the examiner before appeal proceedings or an appeal against the examiner's decision of refusal, and for which a request has been made by the applicant, will, under certain conditions, be suspended from examination until the outcome of either the reconsideration by the examiner before appeal proceedings or the appeal against the examiner's decision of refusal of the original application is determined, under Article 54(1) of the Patent Act.

(Note) Refer to the JPO website below for more information on this operation.

“Suspension of examination of a divisional application while the original application is pending trial”

(https://www.jpo.go.jp/e/system/patent/shinsa/bunkatu-shutugan_chushi.html)

6199 Others

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

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

Chapter 2 Conversion of Application (Patent Act Article 46)

6201 Proviso of Article 44(2)

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

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

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

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

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

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

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

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

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

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

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

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

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

6301 Proviso of Patent Act Article 46bis (2)

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

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

Chapter 4 Reference filing (Patent Act Article 38ter)

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

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

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

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

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

(Points to be noted)

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

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

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

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

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

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

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

(Points to be noted)

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

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

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

The description and the drawings as initially submitted

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

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

Part VII Foreign Language Written Application

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Chapter 1 Overview of Foreign Language Written Application System

Chapter 2 Examination of Foreign Language Written Application

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Chapter 1 Overview of Foreign Language Written Application System

Chapter 2 Examination of Foreign Language Written Application

7201 Handling the Case of Submission of a Written Amendment and a Correction of Translation Error on the Same Date

When a written amendment and a correction of translation error are submitted on the same date, the Examiner determines, based on the order of amendments, whether there can be change to the content of the description etc.

The case where the content can be changed depending on the order of amendments is, for example, a case where concrete amendment portions in each amendment are the same or a case where a written amendment and a correction of translation errors are submitted after the final notice of reasons for refusal (the content can be changed depending on appropriateness of the amendments).

The case where the content cannot be changed depending on the order of amendments is for example, a case where a written amendment and a correction of translation error are submitted along with the first notice of reasons for refusal, and amendment portions in each amendment are different for the respective amendment.

1. Handling when Content can be changed depending on the Order of Amendments

(1) In a case where the content can be changed by the order of amendments, the Examiner determines the earliness and lateness based on the content of the written amendment and of the correction of translation error or the allegations by the Applicant etc.

When the earliness and lateness is clear, it is determined that the amendments are made in the order of the earliness and lateness.

When the earliness and lateness is unclear from the content of the written amendment and the correction of translation error and no allegation by the Applicant etc. is made, the Examiner contacts the Applicant and requests the submission of a petition etc. for explaining the order of the amendments. Moreover, it is determined that the amendments are made in the order of amendments explained in the petition etc.

(2) When the written amendment and the correction of translation error are submitted on the same day as amendments before the first examination or as amendments in a

response period to the first notice of reasons for refusal, the Examiner proceeds the examination based on the content of the description, etc. on which the content of each amendment is reflected in the order of the determination according to the above (1).

(3) When the written amendment and the correction of translation error are submitted on the same day as amendments in a response period to the final notice of reasons for refusal, the Examiner determines, based on the order of such amendments, whether each amendment was legitimately amended. Moreover, the Examiner proceeds the examination based on the content of the description etc. in which the content of each amendment legitimately made is reflected with the order of determination according to above (1).

2. Handling when Content cannot be changed by the Order of Amendments

In a case where the content cannot be changed by the order of amendments, the Examiner proceeds the examination based on the content of the description etc. on which the content of written amendment and the correction of translation error is reflected.

7202 Handling the Case Where Submitted Translations Are Not Literal

In the case of a foreign language written application, the submitted documents that disclose the content of the invention at the time of filing (the documents corresponding to the originally filed Description, Claims, or Drawings in a regular patent application) are the foreign language documents. Furthermore, the translations of the foreign language documents are deemed to be the Description, Claims, and Drawings (hereinafter referred to as "the Description, etc."). Therefore, the examination of foreign language written applications is conducted based on these translations.

These translations are not required to be literal translations (one-to-one translations of the foreign language terms in the foreign language documents).

The examiner, when examining a foreign language written application, determines whether there is new matter not only based on the translations (i.e., new matter beyond the translations) in the same manner as in the examination of a regular patent application, but also based on new matter beyond the original text. In determining whether there is new matter beyond the original text in the translations of the foreign language documents, see 2.1 in "Part VII Chapter 2 Examination of Foreign Language Written Applications" of the Patent and Utility Model Examination Guidelines. That is, in case where the translations of the foreign language documents that have been properly translated into Japanese are regarded as "assumed translations", and where the translations of the foreign language documents (including the translations after the amendment made by the statement of written amendment or by the statement of correction of the incorrect translation) are considered as the amended Description, etc., corresponding to the assumed translations, the amendment is determined based on whether it adds new matter in relation to the assumed translations.

7299 Others

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

	Reference
The Notification by the Examiner pursuant to the provisions of Article 194(1) in the case where the description of the reasons and the like for correction are not sufficient.	"1218 Cases Where the Examiner Requests to Submit the Documents or Other Materials under the Provision of Article 194(1) " in "Part I Chapter 2 Procedures of Examination "

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," 2.2¹, 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.

¹ 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)"² 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 made³, 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

³ 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 examination⁴ based on the international filing date and the content of the description, etc. which are recognized by the receiving office.

⁴ 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.

Appendix 1

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

PATENT COOPERATION TREATY

From the RECEIVING OFFICE

To: [REDACTED]		PCT	
		NOTIFICATION ON DECISION OF CONFIRMATION OF INCORPORATION BY REFERENCE OF ELEMENT OR PART (PCT Rule 20.6(b) and (c))	
		Date of mailing (day/month/year)	31 Dec 2007
Applicant's or agent's file reference [REDACTED]		IMPORTANT NOTIFICATION	
International application No. [REDACTED]		International filing date/Date of first receipt of papers (day/month/year) 24 May 2007	
Applicant [REDACTED]			

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)(iii) 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)(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)

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.

Facsimile No. [REDACTED]

Form PCT/RO/114

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

To:		PCT NOTIFICATION ON DECISION OF CONFIRMATION OF INCORPORATION BY REFERENCE OF ELEMENT OR PART (PCT Rule 20.6(b) and (c))	
		Date of mailing (day/month/year)	
Applicant's or agent's file reference		IMPORTANT NOTIFICATION	
International application No.		International filing date/Date of first receipt of papers (day/month/year)	
Applicant		Date on which the application, etc. is originally filed	
This receiving Office has found that: 1. <input type="checkbox"/> the requirements of Rules 4.18 and 20.6(a) have been met in the purported international application. 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) _____ _____ 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. <input type="checkbox"/> the priority document furnished under Rule 17.1(a), (b) or (b-bis). b. <input type="checkbox"/> a copy of the earlier application as filed (Rule 20.6(a)(ii)). <input type="checkbox"/> the requirements of Rules 4.18 and 20.6(a) have not been met in the purported international application.			
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.			
Name and mailing address of the receiving Office		Authorized officer	
Facsimile No.		Telephone No.	

Form PCT/RO/114 (July 2009)

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' search interface. On the left, a list of fields is available for selection, each preceded by an 'AND' dropdown. The 'Application Number' field is circled. To the right of the fields is a column of equals signs (=) and a column of empty input boxes, each with a question mark icon. Below the fields, there is a section for 'Is Empty:' with radio buttons for 'N/A', 'Yes', and 'No'. At the bottom, there are filters for 'Language' (set to English), 'Stem' (checked), and 'Office' (set to All). A 'Specify' link is next to 'Office'. The bottom right shows '0 results' and a 'Search' button, which is circled. A 'Reset' button is also present.

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 document view interface. At the top, there is a row of tabs: 'PCT Biblio. Data', 'Description', 'Claims', 'National Phase', 'Notices', 'Drawings', and 'Documents'. The 'Documents' tab is circled. Below the tabs, there is a section titled 'Latest bibliographic data on file with the International Bureau'. This section contains two rows of fields: 'Pub. No.' and 'Publication Date' on the left, and 'International Application No.' and 'International Filing Date' on the right. The fields for 'Publication Date' and 'International Filing Date' are blacked out.

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
International Application Status ⓘ						
Date	Title	View				
11.09.2015	International Application Status Report	HTML, PDF				
Published International Application						
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.)				
⋮						
Related Documents on file at the International Bureau						
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.

8004 “Amendment under Article 34 of the Patent Cooperation Treaty”

When the applicant filing a patent application in Japanese language makes an amendment as provided for in Article 34 of the Treaty during the international phase, the Japan Patent Office records the 「条約 3 4 条補正（職権）」 (“Amendment under Article 34 of the Patent Cooperation Treaty” which can be viewed in English via One Portal Dossier service) based on the relevant documents in either of the following cases:

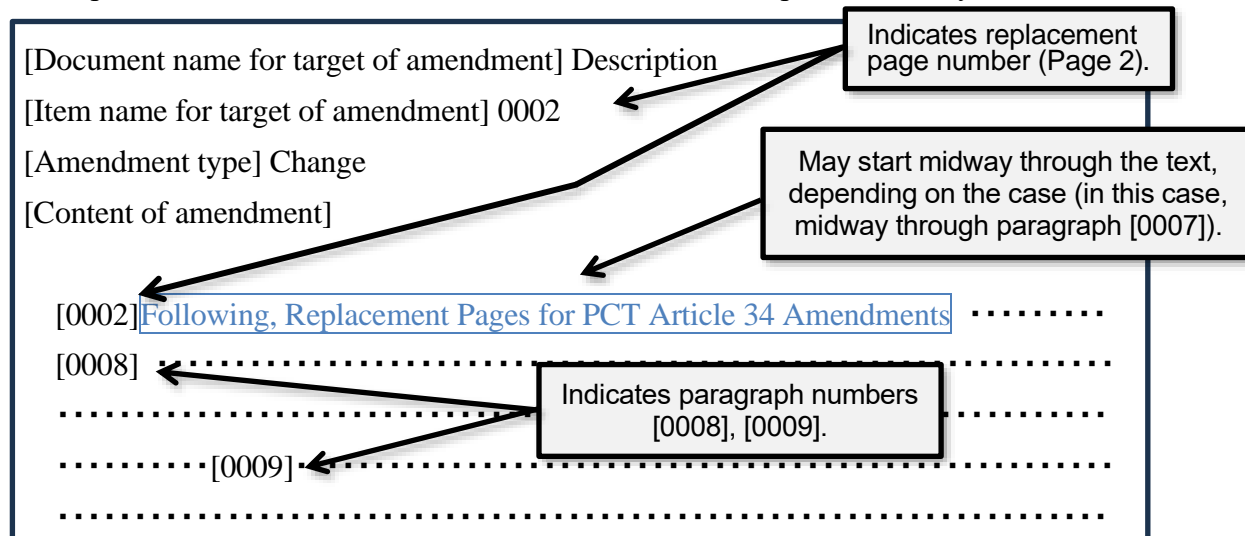
- (i) A copy is submitted by the applicant to the Commissioner of the Japan Patent Office on or before the date on which the National Processing Standard Time falls.
- (ii) A copy is served from the International Bureau to the Japan Patent Office.

Amendments to the description during the international phase are made on a page-by-page basis, and the data for the “Amendment under Article 34 of the Patent Cooperation Treaty” is created in a format consistent with the written amendments used in the national phase in Japan. Therefore, particular care should be taken when reviewing the prepared data, keeping these differences in mind.

(1) Points to Note during Examination

- Unlike the typical written amendment submitted by applicants, in this document, the “Item name for target of amendment” indicates replacement page numbers rather than paragraph numbers.
- Note that both the replacement page numbers and the paragraph numbers on the replacement pages are shown using square brackets “[].”

< Example of “Amendment under Article 34 of the Patent Cooperation Treaty” >



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

Part IX Extension of Patent Term

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Chapter 1 Extension of a Patent Term as Compensation for the Curtailment of the Term

9101 Relevant Acts and Articles When Calculating the Periods

The following table provides a list of Acts and Articles that may be relevant when calculating the periods specified in the items of Article 67(3) of the Patent Act and the period added by being replaced in Article 82(4) of the Economic Security Promotion Act.

Items of Article 67(3) and Article 82(4) of the Economic Security Promotion Act	Acts and Articles
<p>(i) (Period that was consumed to carry out a necessary procedure upon receipt of a notice or an order from the JPO Commissioner or an examiner)</p> <p>In the case where a notice or an order (only those made by the JPO Commissioner or an examiner) is made based on the Patent Act (excluding Article 39(6) and Article 50), the Utility Model Act, the Act on Special Provisions for Procedures related to Industrial Property Rights, or any regulations established based on these Acts, if the procedure that is necessary to be carried out upon receipt of such notice or order is carried out, the deductible period starts from the date on which such notice or order is made and ends on the date on which such procedure is completed.</p>	<p>Patent Act</p> <ul style="list-style-type: none"> - Article 13 (1) and (2) (Replacement of Agents) - Article 17 (3) (Amendment of Proceedings) - Article 18-2 (2) (Dismissal of Non-Compliant Procedure) - Article 23 (1) (Order of Substitution) - Article 36-2 (3) (Submission of Translation) - Article 38-4 (2) (Notice When a Part of the Description or Drawings Lacks a Statement) - Article 43 (7) (Priority Claim Procedures under the Paris Convention) - Article 184-5 (2) (Submission of Documents and Order to Amend Procedures) - Article 184-11 (4) (Special Provisions on Patent Administrators for Overseas Residents) - Article 194 (1) (Submission of Documents)
	<p>Act on Special Provisions for Procedures related to Industrial Property Right</p> <ul style="list-style-type: none"> - Article 7 (2) (Procedures by Submission of Documents)
	<p>Regulations under the Patent Act/</p> <ul style="list-style-type: none"> - Article 5 (2) (Submission of Certificate) - Article 7 (Documents Necessary for

	Procedures Initiated by Foreigners)
	Patent Registration Order - Article 30 (1) (Documents to be Submitted by Order of the Commissioner of the Patent Office)
	Utility Model Act - Article 2-2 (4) (Amendment of Procedures) - Article 6-2 (Order to Amend) - Article 48-7 (Submission of Drawings) - Article 48-5 (2) (Submission of Documents and Order to Amend Procedures, etc) - Article 2-5 (2), Article 11 (1), Article 48-15 (2), and Article 55 (3) (Application Mutatis Mutandis of the Patent Act)
(ii) (Period that was consumed as a result of an extension of the period during which a procedure should be carried out) In the case where an extension is made to the period during which a procedure should be carried out based on the Patent Act or any regulations established based on said Act (the "Patent Act and regulations"), the deductible period starts from the date on which the period during which the procedure should be carried out expires and ends on the date on which the procedure is completed.	Patent Act - Extension of the period (due date for the payment of patent fees) specified in Article 108 (1) pursuant to Article 4 or Article 108 (3) - Extension of the period (a period by which procedures are to be undertaken) pursuant to Article 5 (1) or (3)
	Act on Special Measures concerning Preservation of Rights and Interests of Victims of Specified Disaster - Extension of the period (expiration date regarding administrative rights and interests) pursuant to Article 3 (3)
(iii) (Period that was consumed to take a procedure after the expiration of the period during which such procedure should be carried out) In the case where a procedure specified in the Patent Act and	Patent Act - Article 30 (4) (Proving Document to Enjoy Exception to the Lack of Novelty of Invention) - Article 36-2 (6) (Translation of Foreign-Language Document) - Article 41 (1) (i) (Patent Application

<p>regulations is required to be carried out within the prescribed period of time, if an applicant is permitted to carry out the procedure even after the expiration of the period during which the procedure should be carried out, the deductible period starts from the date on which the period during which the procedure should be carried out expires and ends on the date on which the procedure is completed.</p>	<p>Claiming Priority)</p> <ul style="list-style-type: none"> - Article 43 (8) (Documents to Claim Priority under the Paris Convention) - Article 43-2 (1) (Patent Application Claiming Priority as under the Paris Convention) - Article 44 (7) (Divisional Application) - Article 46 (5) (Converted Application) - Article 46-2 (3) (Patent Application Based on Utility Model Registration) - Article 48-3 (5) and (7) (Request for Examination of Application) - Article 108 (4) (Payment of Patent Fees) - Article 184-4 (4) (Translation of Foreign-Language Patent Application) - Article 184-11 (6) (Notification of Appointment of Patent Administrator) <p>Regulations under the Patent Act</p> <ul style="list-style-type: none"> - Article 38-6-3 (Period for Submission of Documents Requesting the Application of Exception to Lack of Novelty of Invention) - Article 38-14 (Submission of Priority Document Relating to International Patent Application)
<p>(iv) (Period consumed as a result of the suspension of an administrative disposition or notification upon request or due to any other act of an applicant)</p> <p>In the case of the suspension of an administrative disposition or notification specified in the Patent Act, the Act on Special Provisions for Procedures related to Industrial Property Rights, or any regulation established based on these Acts (the "laws and regulations related to the Patent Act")</p>	<p>Patent Act</p> <ul style="list-style-type: none"> - Article 13 (4) (Dismissal of Procedures Undertaken by Agent Ordered to be Replaced) - Article 18 (Dismissal of Procedures) - Article 18-2 (1) (Dismissal of Non-Compliant Procedure) - Article 49 (Decision of Refusal) - Article 50 (Notice of Reasons for Refusal) - Article 51 (Decision to Grant a Patent) - Article 53 (Dismissal of Amendments) <p>Act on Special Provisions for Procedures related to Industrial Property Rights</p>

upon request or due to any other act of an applicant, the deductible period starts from the date of such request or act and ends on the date on which reasons for suspending such disposition or notification cease to exist.	Article 7 (3) (Dismissal of Procedures)
	Patent Registration Order - Article 16 (Ex-Officio Registration)
(v) (Period consumed as a result of the filing of a request for reduction or exemption of a patent fee or a handling fee or a request for deferment of payment thereof) Regarding the payment of a patent fee or handling fee specified in the Patent Act and regulations, if a decision is made with regard to the reduction or exemption of a patent fee or a handling fee or with regard to the deferment of payment thereof, the deductible period starts from the date on which a request for reduction or exemption of a patent fee or a handling fee or a request for deferment of payment thereof is made and ends on the date on which such decision is made.	Patent Act - Article 109 (Reduction or Exemption of Patent Fees or Deferment of Payment of Patent Fees) - Article 195-2 (Reduction or Exemption of Fees for Requesting the Examination of Application)
	Order for the Patent Act-related Fees - Article 1-3 (Request for Reduction or Exemption)
	Act on Strengthening Industrial Competitiveness - Article 17 (Approval of a Plan for Specified Investment for Developing New Business) - Article 75 (Reduction of Patent Fees for Patent Application concerning Invention in Technology Fields Contributing to Strengthening Industrial Competitiveness)
	Act on Enhancement of Small and Medium Sized Enterprises' Core Manufacturing Technology - Article 9 (Special Provisions on Patent Fees)
	Act on Special Measures to Promote Research and Development Business, etc. by Specified Multinational Enterprises - Article 10 (Special Provisions on Patent Fees)
	Act on the Promotion of Technology Transfer from Universities to Private Business

	<p>Operators</p> <ul style="list-style-type: none"> - Article 8 (Special Provisions on Patent Fees) - Article 13 (Accreditation of Research and Development Incorporated Administrative Agency Technology Transfer Operations)
<p>(vi) (Period consumed as a result of the withdrawal of a written supplement for the description, etc.)</p> <p>If a written supplement for the description, etc. is withdrawn under Article 38-4 (7), the deductible period starts from the date on which a written supplement for the description, etc. is submitted under Article 38-4 (3) and ends on the date on which the written supplement for the description, etc. is withdrawn under Article 38-4 (7).</p>	<p>Patent Act</p> <ul style="list-style-type: none"> - Article 38-4 (7) (Withdrawal of Written Supplement for Description)
<p>(vii) (Period consumed as a result of an appeal against an examiner's decision of refusal)</p> <p>If an appeal against an examiner's decision of refusal is filed, the deductible period is one of the periods specified in (vii-1) to (vii-3) below, according to the cases (vii-1) to (vii-3):</p> <p>(vii-1) In an appeal against an examiner's decision of refusal (including a re-appeal against the final JPO decision concerning an appeal against an examiner's decision of refusal), if a JPO decision is made to grant a patent, the period starting from the date on which a certified copy of an examiner's decision of refusal is served and ending on the date on which a</p>	<p>Patent Act</p> <ul style="list-style-type: none"> - Article 51 (Decision to Grant a Patent) applied mutatis mutandis in Article 159 (3) which may apply mutatis mutandis in Article 174 (2) - Article 160 (1) which may apply mutatis mutandis in Article 174 (2) (Order to further Examine) - Article 51 (Decision to Grant a Patent) applied mutatis mutandis in Article 163 (3)

<p>certified copy of the JPO decision is served.</p> <p>(vii-2) In the case where an examiner's decision is rescinded in an appeal against an examiner's decision of refusal (including a re-appeal against the final JPO decision concerning an appeal against an examiner's decision of refusal), if a JPO decision is made to conduct further examination, the period starting from the date on which a certified copy of the examiner's decision of refusal is served and ending on the date on which a certified copy of the JPO decision is served.</p> <p>(vii-3) In the case of reexamination before the appeal, if an examiner's decision to grant a patent is made, the period starting from the date on which a certified copy of the examiner's decision of refusal is served and ending on the date on which a certified copy of the examiner's decision to grant a patent is served.</p>	
<p>(viii) (Period consumed as a result of carrying out a procedure specified in the Administrative Complaint Review Act)</p> <p>If an administrative determination is finalized in response to a request for review under the Administrative Complaint Review Act with regard to an administrative disposition made under the laws and regulations related to the Patent Act, the deductible period starts from the date of the request for review</p>	<p>Administrative Complaint Review Act</p>

and ends on the date on which a certified copy of the administrative determination is served.	
<p>(ix) (Period consumed as a result of the procedure specified in the Administrative Case Litigation Act)</p> <p>If a judgment is finalized concerning an action filed under the Administrative Case Litigation Act with regard to an administrative disposition made under the laws and regulations related to the Patent Act, the deductible period starts from the date of the filing of the action and ends on the date on which the judgment concerning the action is finalized.</p>	Administrative Case Litigation Act
<p>(x) (Period consumed as a result of suspension or discontinuation of a procedure specified in the Patent Act and regulations)</p> <p>If a procedure specified in the Patent Act and regulations is suspended or discontinued, the deductible period is the period of suspension or discontinuation.</p>	<p>Patent Act</p> <ul style="list-style-type: none"> - Article 24 (Application Mutatis Mutandis of Articles of the Code of Civil Procedure) - Article 54 (In relation to Litigation)
	<p>Code of Civil Procedure</p> <ul style="list-style-type: none"> - Article 124 (1) (i) to (v) (Continuance of Litigation Proceedings and Substitution) - Article 130 (Suspension Due to Court Inability to Execute Duties) - Article 131 (Suspension due to the Incapacitation of a Party)
	<p>Corporate Reorganization Act</p> <ul style="list-style-type: none"> - Article 52 (1) applied mutatis mutandis in Article 34 (3)(i) - Article 52 (4) applied mutatis mutandis in Article 34 (3)(ii) - Article 52 (1) and (4) applied mutatis mutandis in Article 53 - Article 52 (1) applied mutatis mutandis in

	Article 74 (3)
	Bankruptcy Act - Article 44 (1) and (4) applied mutatis mutandis in Article 46 - Article 44 (1) applied mutatis mutandis in Article 96 (2)(i) - Article 44 (4) applied mutatis mutandis in Article 96 (2)(ii)
	Civil Rehabilitation Act - Article 67 (2) applied mutatis mutandis in Article 69 - Article 68 (2) and (4) applied mutatis mutandis in Article 69 - Article 67 (2) applied mutatis mutandis in Article 83 (3) - Article 68 (2) applied mutatis mutandis in Article 83 (3)
(xi) Article 82(4) of the Economic Security Promotion Act (Period consumed as a result of a security designation) The period from the date of receipt of a notification under the provisions of Article 70(1) of the Economic Security Promotion Act through the date of receipt of a notification under Article 77(2) of the said Act.	Economic Security Promotion Act - Article 70 (1) Security Designation - Article 77 (2) Security Designation Cancellation, etc.

(Explanation)

The items of Article 67 (3) specify types of the periods that the Comprehensive and Progressive Agreement for Trans-Pacific Partnership (hereinafter referred to as “the TPP 11 Agreement”) allows signatories to exclude from the “unreasonable delays” set forth in the Agreement. Such periods include periods consumed for procedures or dispositions carried out for a reason not attributable to the Patent Office, including procedures which have not been carried out within a prescribed period for a reason attributable to the applicant and procedures which the

Patent Office cannot carry out due to natural disasters, and periods necessary for appeals and court trials that take place before a patent right is established and registered.

Item (i) (Period that was consumed to carry out a necessary procedure upon receipt of a notice or an order from the JPO Commissioner or an examiner.)

Because normal patent filing procedure does not suppose a procedure, such as submission of documents to correct deficiencies, which is carried out upon receipt of a notice or an order from the JPO Commissioner or an examiner, and such procedure is carried out for a reason not attributable to the Patent Office, a period consumed to carry out such procedure is not included in the maximum permissible length of extension period. The period not included in the maximum permissible length of extension period is a period starting from the date on which such notice or order is made and ending on the date on which such procedure is completed, which includes an extended portion of the period when the period for carrying out such procedure is extended.

A notice specified in Article 50, however, is issued for most of patent applications examined and regarded as constituting normal patent application procedure. Thus, a response period to the notice under Article 50 is considered to be included in a period of five years from the filing of an application or three years from request for examination and excluded from item (i). Likewise, the period for consultation as specified in Article 39 (6) is also excluded since the period is equivalent to the response period to a notice as specified in Article 50.

Item (ii) (Period that was consumed as a result of an extension of the period during which a procedure should be carried out)

Because normal patent filing and examination procedure does not suppose an extension of the period during which a procedure should be carried out and such extension is not attributable to the Patent Office, a period consumed as a result of such extension is not included in the maximum permissible length of extension period

Item (iii) (Period that was consumed to take a procedure after the expiration of the period during which such procedure should be carried out)

The Patent Act, specifically Article 30 (4), etc., exceptionally allows the applicant to take a procedure after a legal period expires when he/she has a reason not attributable to him/her or is not found to have been intentional. As such procedures are procedures which is carried out for a reason not attributable to the Patent Office, including procedures which the Patent Office cannot carry out due to natural disasters and procedures which have not been carried out within a prescribed period for a reason attributable to the applicant, a period from the expiration of a legal period to the completion of the procedure is not included in the maximum permissible length of extension period.

Item (iv) (Period consumed as a result of the suspension of an administrative disposition or notification upon request or due to any other act of an applicant)

Because normal patent filing procedure does not suppose the suspension of an administrative disposition or notification upon request or due to any other act of the applicant, that is, the suspension of an administrative disposition or notification not provided by the laws and regulations but decided at the discretion of the Patent Office, and such suspension is made for a reason not attributable to the Patent Office, a period consumed until the reason for suspension ceases to exist is not included in the maximum permissible length of extension period.

Item (v) (Period consumed as a result of the filing of a request for reduction or exemption of a patent fee or a handling fee or a request for deferment of payment thereof)

Because documents requesting the reduction or exemption of a handling fee for examination request or a patent fee are submitted for a reason attributable to the applicant, examining such documents does not constitute a normal procedure. Thus, a period consumed to examine such documents is not included in the maximum permissible length of extension period.

Item (vi) (Period consumed as a result of the withdrawal of a written supplement for the description, etc.)

Because the withdrawal* of a written supplement for the description, etc. does not constitute a normal procedure and suspends filing and examination procedure until supplement procedure is completed, a period from such withdrawal to the completion of supplement procedure is not included in the maximum permissible length of extension period. (*In case of withdrawal, the original description is examined)

Items (vii) (Period consumed as a result of an appeal against an examiner's decision of refusal)

Because the TPP 11 Agreement allows signatories to exclude from “unreasonable delays” a period consumed other than during the processing or examination of a patent application by the

Authority granting a patent, a period required for appeals and court trials is excluded from a period of “unreasonable delays.

Item (viii) (Period consumed as a result of carrying out a procedure specified in the Administrative Complaint Review Act)

Item (ix) (Period consumed as a result of the procedure specified in the Administrative Case Litigation Act)

Because the TPP 11 Agreement allows signatories to exclude from “unreasonable delays” a period consumed other than during the processing or examination of a patent application by the Authority granting a patent, a period required for a procedure under the Administrative Complaint Review Act or the Administrative Case Litigation Act with respect to a disposition to dismiss an application in filing procedure is excluded from a period of “unreasonable delays.

Item (x) (Period consumed as a result of suspension or discontinuation of a procedure specified in the Patent Act and regulations)

Because normal patent filing procedure does not suppose the suspension or discontinuation of a procedure under the Patent Act and regulations and such suspension or discontinuation is made for a reason not attributable to the Patent Office, a period of such suspension or discontinuation is not included in the maximum permissible length of extension period.

Item (xi) (Period consumed as a result of Article 82(4) of the Economic Security Promotion Act)

The term of a security designation can be expected to last for a considerable period of time. If an extended term of the patent right is granted for such a period, the expiration date of the patent right will be significantly delayed, which will have a substantial impact on third parties. Thus, this paragraph provides that the term of a security designation shall be excluded from the extended term of the patent right.

9102 Method of Calculating the Maximum Permissible Length of Extension Period

The maximum permissible length of extension period is calculated based on the calendar year as specified in 3.1.2 of Chapter 1, Part IX of the Examination Guidelines.

The calculation method is as follows:

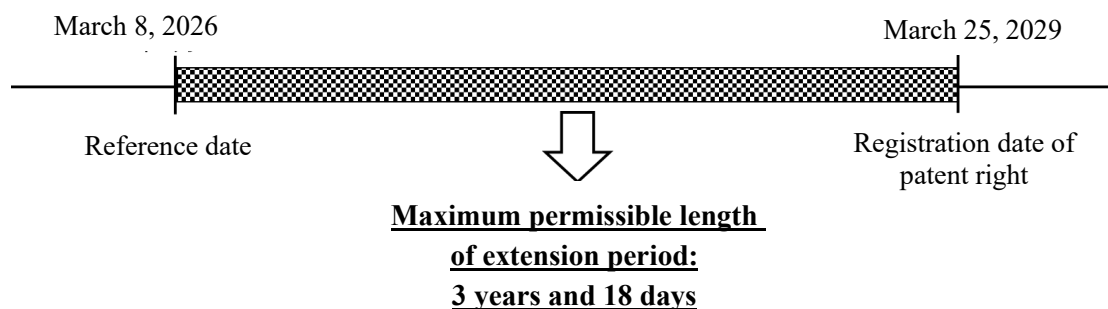
1. When none of the periods specified in items of Article 67 (3) intervenes

- (1) Express a period from the reference date* to the registration date of the patent right in year-month-day format based on the calendar year to determine the maximum permissible length of extension period.

(*) The date five years after the filing of a patent application or the date three years after the filing of a request for examination of the application, whichever is later.

Example 1: Calculation method of the maximum permissible length of extension period when the reference date is March 8, 2026 and the registration date of the patent right is March 25, 2029, and none of the periods specified in items of Article 67 (3) intervenes

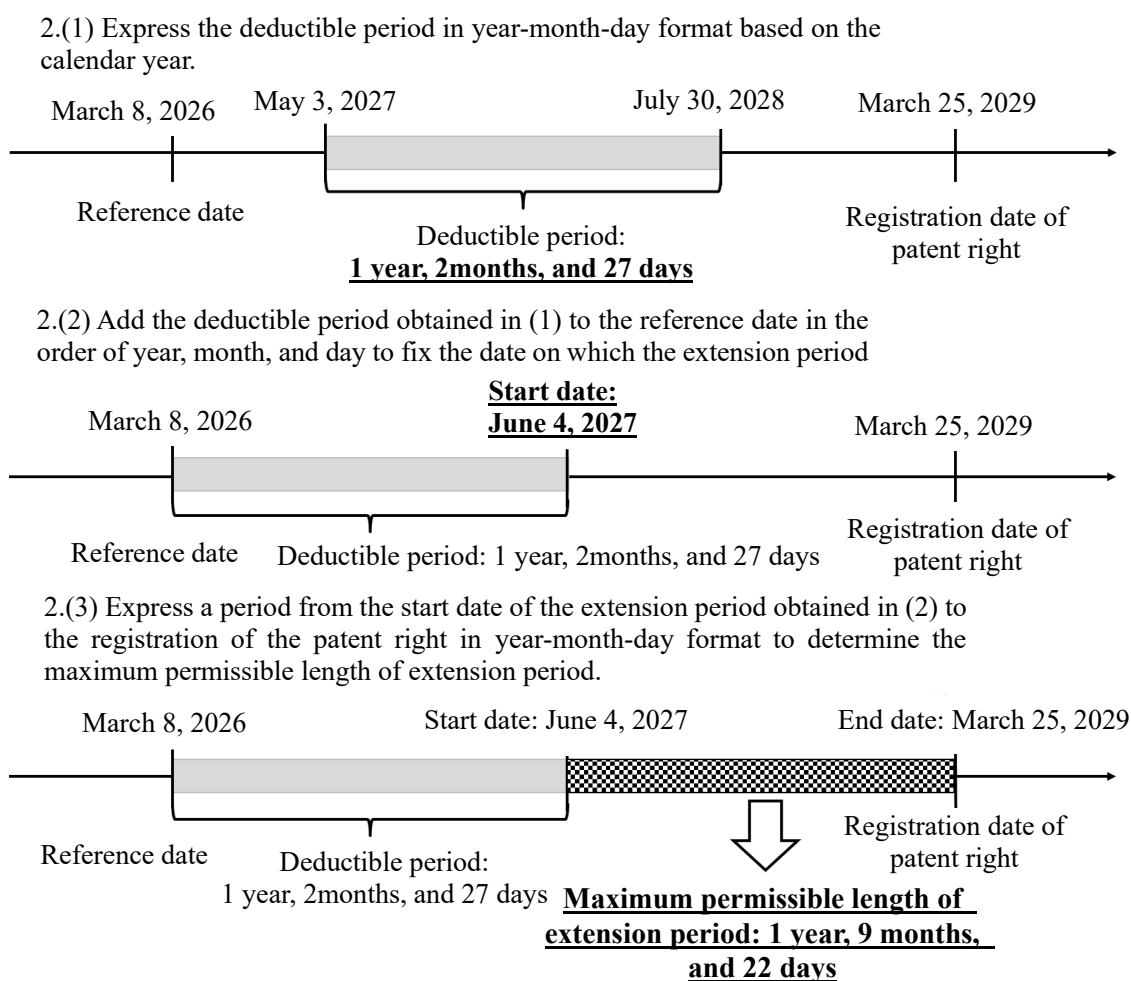
- 1.(1) Express a period from the reference date to the registration date of the patent right in year-month-day format based on the calendar year to determine the maximum permissible length of extension period.



2. When one of the periods specified in items of Article 67 (3) intervenes

- (1) Express the intervening period specified in items of Article 67 (3) in year-month-day format based on the calendar year.
- (2) Add the period obtained in (1) to the reference date in the order of year, month, and day to fix the date on which the extension period starts.
- (3) Express a period from the start date of the extension period obtained in (2) to the registration of the patent right in year-month-day format to determine the maximum permissible length of extension period.

Example 2: Calculation method of the maximum permissible length of extension period when the reference date is March 8, 2026 and the registration date of the patent right is March 25, 2029, and one of the periods specified in items of Article 67 (3) (referred to as a “deductible period” in the following figure) intervenes

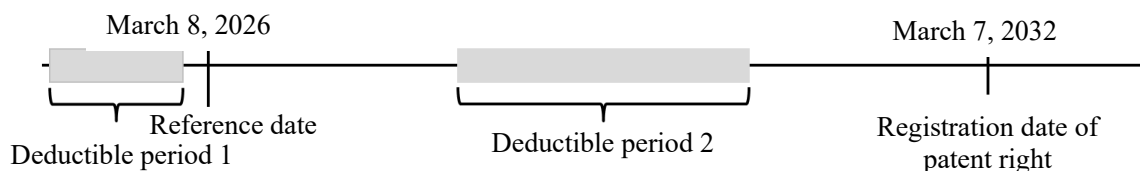


(Note) In this example, a “deductible period” does not start from 0:00 a.m. and the first day of the deductible period is not taken into account to fix the start date as specified in Article 3 (1). The same rule applies to the following examples.

3. When more than one of the periods specified in items of Article 67 (3) intervene and those periods do not overlap

- (1) Express all the intervening periods specified in items of Article 67 (3) in year-month-day format based on the calendar year.
- (2) Add together the periods obtained in (1). However, do not count 30 days as a month and 12 months as a year.
- (3) Add the period obtained in (2) to the reference date in the order of year, month, and day to fix the date on which the extension period starts.
- (4) Express a period from the start date of the extension period obtained in (3) to the registration of the patent right in year-month-day format to determine the maximum permissible length of extension period.

Example 3: Calculation method of the maximum permissible length of extension period when the reference date is March 8, 2026 and the registration date of the patent right is March 7, 2032, and one of the periods specified in items of Article 67 (3) (referred to as a “deductible period” in the following figure) intervenes before and after the reference date



3.(1) Express the deductible periods in year-month-day format based on the calendar year.

Deductible period 1: **1 year, 2 months, and 27 days**

Deductible period 2: **2 years, 11 months, and 10 days**

3.(2) Add together the deductible periods obtained in (1).

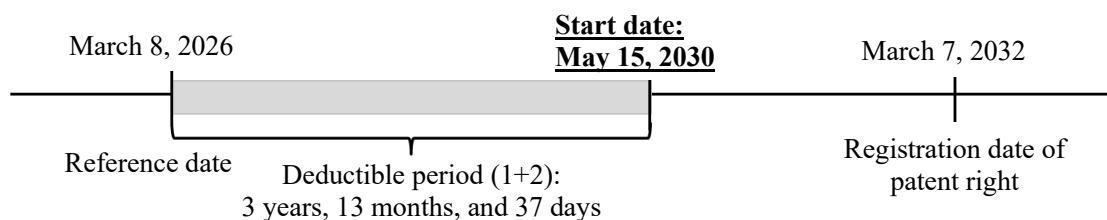
Deductible period 1: 1 year, 2 months, and 27 days

Deductible period 2: 2 years, 11 months, and 10 days

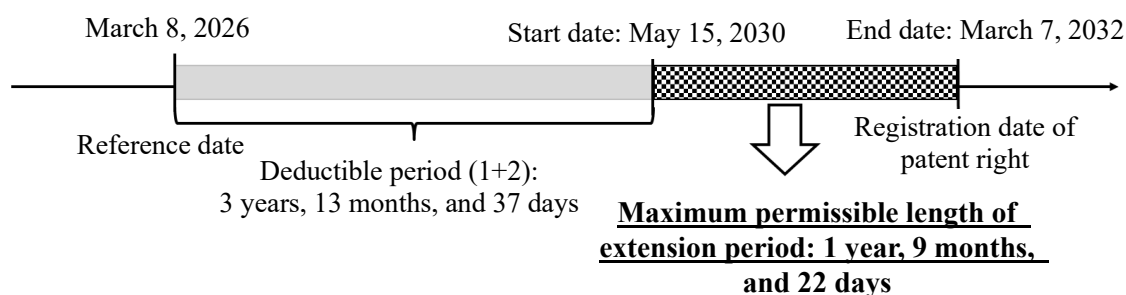


3 years, 13 months, and 37 days

3.(3) Add the deductible period obtained in (2) to the reference date in the order of year, month, and day to fix the date on which the extension period



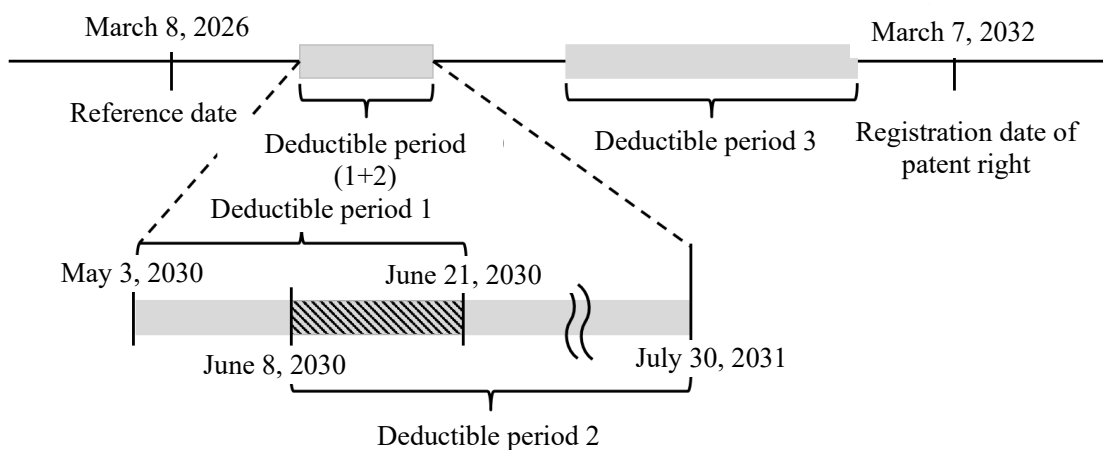
3.(4) Express a period from the start date of the extension period obtained in (3) to the registration of the patent right in year-month-day format to determine the maximum permissible length of extension period.



4. When more than one of the periods specified in items of Article 67 (3) intervene and some or all of those periods overlap partly

- (1) When more than one of the periods specified in items of Article 67 (3) intervene and some or all of those periods overlap partly, combine the partly-overlapping periods into one period to remove an overlapping duration.
- (2) Express all the periods comprised of the combined period obtained in (1) and a non-combined period(s) (a period(s) that does(do) not overlap another period specified in items of Article 67 (3)) in year-month-day format based on the calendar year.
- (3) When there are more than one periods obtained in (2) and expressed in year-month-day format, add them up. However, do not count 30 days as a month and 12 months as a year.
- (4) Add the period obtained in (3) to the reference date in the order of year, month, and day to fix the date on which the extension period starts.
- (5) Express a period from the start date of the extension period obtained in (4) to the registration of the patent right in year-month-day format to determine the maximum permissible length of extension period.

Example 4: Calculation method of the maximum permissible length of extension period when the reference date is March 8, 2026 and the registration date of the patent right is March 7, 2032, and more than one of the periods specified in items of Article 67 (3) (referred to as a “deductible period” in the following figure) intervene



4.(1) When the deductible periods overlap partly, combine them into one period



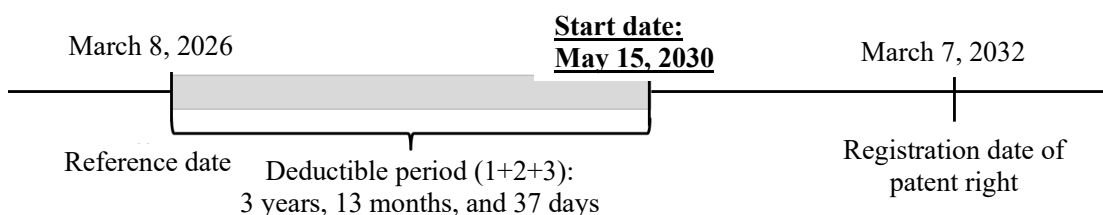
4.(2) Express the deductible periods in year-month-day format based on the calendar year.

Deductible period (1+2) ... 1 year, 2 months, and 27 days
 Deductible period (3) ... 2 years, 11 months, and 10 days

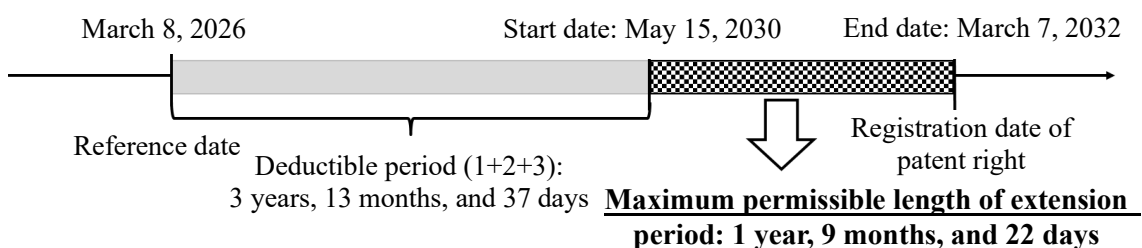
4.(3) Add together the deductible periods obtained in (2).

Deductible period (1+2) ... 1 year, 2 months, and 27 days
 Deductible period (3) ... 2 years, 11 months, and 10 days \Rightarrow 3 years, 13 months, and 37 days

4.(4) Add the deductible period obtained in (3) to the reference date in the order of year, month, and day to fix the date on which the extension period



4.(5) Express a period from the start date of the extension period obtained in (3) to the registration of the patent right in year-month-day format to determine the maximum permissible length of extension period.



9103 Disqualification of Examiner with respect to Application to Register Patent Term Extension as Compensation for the Curtailment of the Term

In the case where the examiner of an application to register a patent term extension as compensation for the curtailment of the term was involved as an examiner in the decision for a patent application related to a patent right in relation to which the above application has been filed, such examiner is disqualified from acting as examiner of the above application. (Article 139 (vi) applied *mutatis mutandis* in Article 67^{quater} where “against which the appeal has been filed” in Article 139 (vi) is replaced with “for a patent application related to a patent right in relation to which an application to register a patent term extension has been filed”)

According to this Article 139 (vi) applied *mutatis mutandis*, “the case where the examiner (of an application to register a patent term extension) was involved as an examiner in the decision for a patent application” is not limited to the case where the examiner made a decision, but includes the case where the examiner did not make a decision and issued a notice of reason for refusal or ruled dismissal of amendments.

(Explanation)

Examination of an application filed in the patent term extension registration system aimed at compensating for the curtailment of the term consists in determining the periods required for filing/examination procedures taken in connection with a patent application related to the above application. It is thus undesirable in terms of fairness that the examiner who was involved in the examination of such patent application is involved in the examination of the above application to register a patent term extension.

For this reason, a disqualification provision is provided to prevent an examiner having involved in the examination of a patent application from examining an application to register a patent term extension related to this patent application.

9104 Patent Application to Which Article 67 of the Patent Act as
Amended in 2016 is Applicable

(1) Regular applications

Applications filed on or after March 10, 2020

(2) Divisional applications, converted applications, and patent applications based on
utility model registration

Applications of which original applications are filed on or after March 10, 2020

(3) Applications claiming priority under the Paris Convention

Applications claiming priority which are filed on or after March 10, 2020

(4) Applications claiming internal priority

Applications claiming priority which are filed on or after March 10, 2020

Chapter 2 Extension of a Patent Term for Pharmaceutical Inventions

9201 Handling of Relationship between Application to Register Patent Term Extension and Number of Dispositions

One application to register a patent term extension must be filed for one disposition.

(Explanation)

Article 67septies of the Patent Act provides that the application to register a patent term extension shall be refused "when the disposition is not found to have been necessary for the working of the patented invention" (item (i) of the first paragraph). In other words, Article 67 septies requires that whether or not the "application to register a patent term extension" should be refused is determined depending on whether or not the "disposition" was necessary.

A factor that necessitates the registration of the patent term extension is caused in relation to each disposition, and the period during which the patented invention was unable to be worked and the effect of the patent right after registration of the patent term extension are to be determined on the basis of the individual disposition. Hence, one application to register a patent term extension should, in view of its nature, be filed for one single disposition on a per-disposition basis. Also, if one application to register a patent term extension is allowed to be filed for two or more dispositions by an applicant who has obtained the two or more dispositions at the same time in a certain period for one single patent right so that only he/she can enjoy the benefit of the registration of patent term extension on the basis of the two or more dispositions by one single application to register a patent term extension, such practice will lead to impermissible imbalance among applicants.

In view of the foregoing, the above rule of handling is to be complied with regarding the relationship between the application to register a patent term extension and the number of dispositions.

9202 Regarding Extended Term Where Two or More Trials Necessary for Obtaining Disposition Designated by Cabinet Order Were Conducted for One Single Disposition in Application for Registration of Patent Term Extension

"The date on which testing necessary for obtaining the disposition commenced means" stated in 3.1.3 of Chapter 2, Part IX of the Examination Guidelines is deemed to be the day of commencement of a trial that is found in view of the patent application documents to be the first trial among a series of trials if the applicant demonstrates that he/she has conducted the series of trials in relation to a single disposition whose periods can be included in "the period during which the patented invention was unable to be worked" (see 3.1.3(1)).

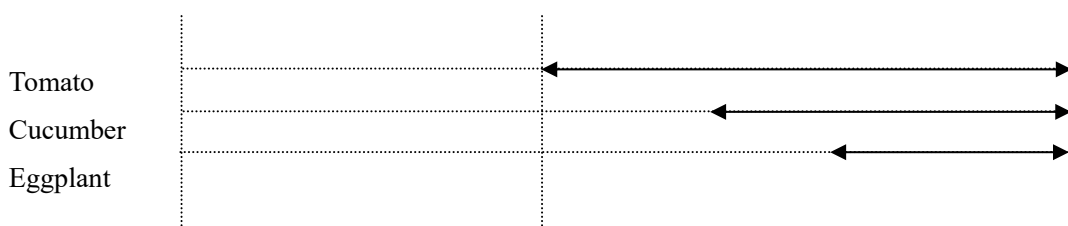
(Explanation)

(1) Commissioned field trials for agricultural chemicals often commence on different days depending on crops and applicable diseases or insects pests, etc., and an application for registration of an agricultural chemical may be filed for a set of the results of these trials so that one registration may be established.

Example for Reference

Patented Invention: "An insecticide containing A as an active ingredient"

Registration of Establishment of Patent Right



(Note) The solid lines each indicate the period from the date of commencement of a trial against aphids with regard to a1, which is a more specific concept of the active ingredient A to the date on which the applicant is notified of the registration, or in other words, to the date on which the applicant actually learns of the registration or could have learned of it.

(2) In the above reference example, the period from the date of commencement of the trial for the agricultural chemical with respect to tomatoes to the date on which the applicant is notified of the

registration, in other words, to the date before the date on which the applicant actually learns of the registration or could have learned of it corresponds to "the period during which the patented invention was unable to be worked". Thus, "the period for which the extension is requested" that does not exceed this period (which must be not more than five years) is deemed to be the extended term of the patent right.

9203 Patent Application to Which Article 67 of the Patent Act as Amended in 2016 is Applicable

(1) Regular applications

Applications filed on or after March 10, 2020

(2) Divisional applications, converted applications, and patent applications based on utility model registration

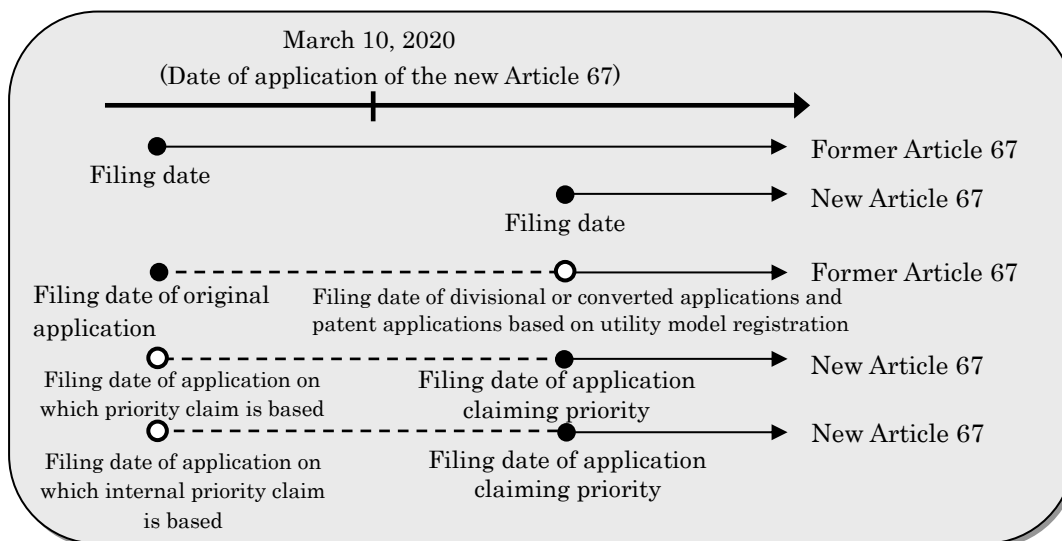
Applications of which original applications are filed on or after March 10, 2020

(3) Applications claiming priority under the Paris Convention

Applications claiming priority which are filed on or after March 10, 2020

(4) Applications claiming internal priority

Applications claiming priority which are filed on or after March 10, 2020



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

Part X Utility Model

Contents

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Chapter 1 Basic Requirements for Utility Model Registration

10101 Cases of Applicability to Shape, Structure, or Combination of the Item

(Cases of applicability to "shape" of the item)

Case 1: Nonskid dispersion powder for the road consisting of crushed quartz which is painted by a single color such as red and shaped into star forms

(Cases of applicability to "combination" of the item)

Case 2: A remote control network system for patients' data, consisting of input device for entering medical examination data of patients, a recording device for storing the medical examination data having been entered, and a display device for showing medical examination data by accessing said recording device through communication lines.

Case 3: A remote monitoring system which includes a monitoring camera for capturing images of the subject and a data processing terminal for receiving via communication lines the data, images of which have been captured by said monitoring camera, and which is characterized by a means for analyzing the received data and an alarm means for emitting a warning tone depending on the result of said data processing terminal.

10102 Handling of Violation of Public Order , Morality,etc. Regarding Application for Utility Model Registration

The following rule of handling applies where any statement that may contravene public order, morality, or public health has been found in the description, etc. attached to the application for utility model registration in the course of the examination of the basic requirements for utility model registration.

1. Case where the device defined by the recitations of the claim clearly contravenes the public order, morality, or public health

An amendment shall be ordered in accordance with Article 6bis(ii) of the Utility Model Act.

2. Case where the description or drawing contains any matter or content that clearly contravenes the public order and morality

The request of amendment under Article 6bis(ii) of the Utility Model Act shall not be made, but the applicant shall be contacted regarding the need for amendment, and the applicable matter or content shall be corrected ex officio.

Also, where all of the drawings are to be deleted as a result of the ex-officio correction made to the drawings, a request of amendment shall be made to present a supplementary drawing or drawings.

(Explanation)

Since a request of amendment under Article 6bis(ii) of the Utility Model Act is to be made with regard to the device claimed in the claim, it is not possible to make the request of amendment based on Article 6-2 (i) of Utility Model Act when any matter or content that clearly contravenes the public order and morality is only described in the description or drawings. Further, with regard to the publications of registered utility model application, there is no provision that is related to exemption from publication of the matters or content in violation of the public order and morality (Article 14(3) of the Utility Model Act). As such, it is necessary to provide appropriate measures to ensure that the matters or content that clearly contravenes the public order and morality does not appear in the publications of registered utility model application.

Also, every application for utility model registration must be accompanied by a drawing (Utility Model Act Article 5(2)). Accordingly, where all of the drawings are to be deleted, it is

necessary to make a request of amendment to submit a supplementary drawing or drawings.

Chapter 2 Utility Model Technical Opinion

10201 Preparation of a Report of Utility Model Technical Opinion

Article 12(4) of Utility Model Act

Where a request [a request for expert opinion on registrability of utility model] under paragraph (1) is filed, the JPO Commissioner shall direct an examiner to prepare a written report containing expert opinion on registrability of the utility model for which the request is filed (hereinafter referred to as "report of expert opinion on registrability of the utility model").

With regard to preparation of the report of expert opinion on registrability of the utility model, see APPENDIX C "Handbook for preparation of report of expert opinion on registrability of the utility model."

10202 Handling of Information Provided

- (1) Anyone can submit information concerning an application for a utility model registration or a utility model registration, such as publications (Article 22, Article 22bis of the Regulations under the Utility Model Act Article).
- (2) The examiner shall carefully review details of the information which has been provided and which becomes available upon preparing an opinion.
- (3) The examiner shall determine, with regard to the publications and the like relating to the information provided, which the examiner reviewed upon preparing an opinion, whether or not they are regarded as prior art documents denying novelty and the like of a device for the claims, and shall indicate the decision in the description of the scope of the research in the opinion.

10203 Interview, etc.

An Examiner should not hold interview pertain to a claim to meet requirements for novelty etc. (communication via telephone or e-mail is included). However, an examiner may as well hold an interview to receive technical explanations from an applicant, a right holder or his/her representative. If the interview is taken place to receive technical explanations, an examiner must keep a record of the explanations.

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

Part XI Affairs in General

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Chapter 1 General

11101 Qualification as Examiner

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

Patent Act

(Examination by the examiner)

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

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

Patent Act Enforcement Order

(Qualification as examiner)

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

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

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

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

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

(Affairs under the jurisdiction of First Examination department)

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

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

(Affairs under the jurisdiction of Second Examination Department)

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

(Affairs under the jurisdiction of Third Examination Department)

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

(Affairs under the jurisdiction of Fourth Examination Department)

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

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

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

(Abbreviated)

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

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

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

(Divisions and the like placed in First Examination Department)

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

Coordination Division

Design Division

(Job duty of Directors)

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

(Directors)

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

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

(Directors)

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

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

(Directors)

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

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

(Examiners and assistant examiners)

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

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

(Examination supervisor)

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

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

11103 Maintenance of Confidentiality by Examiners

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

Article 100(1) of the National Public Service Act

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

Article 200 of the Patent Act

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

11104 Provisions on Examination

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

1. Common provisions

Article 47(1) of the Patent Act

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

Article 48 of the Patent Act

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

(Reference)

Article 139 of the Patent Act

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

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

Article 48bis of the Patent Act

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

Article 48sexies of the Patent Act

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

Article 54(1) of the Patent Act

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

Article 54(2) of the Patent Act

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

Article 5(1) of the Patent Act

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

Article 160(2) of the Patent Act

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

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

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

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

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

3. Provisions pertinent to examiner's decision

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

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

4. Provisions pertinent to reconsideration by examiners before appeal proceedings

Patent Act Article 162, Article 163, Article 164

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

11105 Designation and Change of Assignment of Examiners

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

11106 Examination of Case of another Art Unit

1. A Director/Office Director may, if it is necessary by reasons of a business amount or progress of processing, cause a case under the jurisdiction of another Art Unit to be examined by an examiner who is familiar with that technical field (SMART examiner¹). When having a SMART examiner examine a case under the jurisdiction of another Art Unit, a Director/Office Director shall obtain the permission of the Director-General in charge (when the case is transferred between examination departments, both relevant Director-Generals in charge) along with doing so after consultation with the Director/Office Director of the other Art Unit concerned.

2. Progress of the case processed by the above-mentioned examination shall be managed by the manager of an Art Unit that makes a final decision on the said case, and Quality Control shall be also conducted under the said Art Unit.

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

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

Further, an affiliation shall be stated to the extent of a department name to which the Art Unit that makes a final decision on the case belongs, when examining a case of an Art Unit belonging to another department.

The contact telephone number, etc., should include the extension number and e-mail address of the examination office to which the examiner examining the case belongs.

¹ SMART (Skillful in Multiple ARTs) examiner is an examiner in charge of a plurality of Art Units.

11107 Designation of Examiner for a Case Remanded to Examination

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

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

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

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

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

11109 Reception of Patent Application and Assignment Change

1. Reception of patent application

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

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

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

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

11110 Guidelines for Official Writing (「公用文作成の考え方」)

Examiners are encouraged to preparing administrative documents, including notices of reasons for refusal and examiner's decisions, in accordance with the "公用文作成の考え方" and also be expected to be aware of the guidelines and other relevant materials when preparing the drafts.

Relevant Materials which can be referred when preparing administrative documents:

1. 「公用文作成の考え方」(建議)
2. 「現代仮名遣い」(昭和61年内閣告示第1号)
3. 「常用漢字表」(平成22年内閣告示第2号)
4. 「公用文における漢字使用等について」(平成22年内閣訓令第1号)
5. 「送り仮名の付け方」(昭和48年内閣告示第2号)
6. 「外来語の表記」(平成3年内閣告示第2号)

Chapter 2 Examination Related Affairs

11201 Accelerated Examination

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

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

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

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

11202 Examination Prior to Laying-Open of Application

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

<Description Example 1>

NOTICE

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

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

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

For any inquiry including about the content of this notice of reason for refusal or request for an interview, please contact us at the number below. Should Applicant wish to send a proposed amendment, etc., please notify us in advance.

When contacting us by e-mail, please include your name, affiliation, application number, telephone number and the name of the examiner

(assistant examiner) and send to the e-mail address (*) below. If any uncertainty about the content of the e-mail communication arises, we may confirm it by telephone.

Examination Department of X XX Division The name of examiner

Tel: 03-3581-1101 ext. xxxx

* ●●●●@jpo.go.jp (replace "●●●●" above with "PAxxx")

<Description Example 2>

NOTICE

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

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

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

NOTE

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

For any inquiry including about the content of this notice of reason for refusal or request for an interview, please contact us at the number below. Should Applicant wish to send a proposed amendment, etc., please notify

us in advance.

When contacting us by e-mail, please include your name, affiliation, application number, telephone number and the name of the examiner (assistant examiner) and send to the e-mail address(*) below. If any uncertainty about the content of the e-mail communication arises, we may confirm it by telephone.

Examination Department of X XX Division The name of examiner

Tel: 03-3581-1101 ext. xxxx

* ●●●●@jpo.go.jp (replace "●●●●" above with "PAxxx")

11203 Preferential Examination

1. Requirements for the preferential examination

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

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

(Explanation)

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

(Explanation)

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

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

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

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

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

2. Main cases where no preferential examination is needed

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

For example,

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

3. Selection of necessity of preferential examination

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

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

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

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

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

5. Propriety of appeal

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

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

11204 Examiner's Memorandum

The "Examiner's Memorandum" is treated as a document related to a patent as defined in Article 186, and is to be inspected.

Chapter 3 Reference Information

11301 Patent Application Technical Trend Research

1. Outline of the patent application technical trend research

The Japan Patent Office (JPO) conducts researches of patent application trends, etc., focusing on fields where new markets are expected to be created and technical fields that should be promoted as national policy, and publishes the results.

The patent application technical trend research has been conducted since FY1999, and the results of the researches have been compiled in a report.

2. Utilization of the research results

The research results are disseminated as reference information for companies, universities, etc. to consider their R&D strategies and intellectual property strategies, and as reference information for government ministries and public research institutes to formulate their policies. They are, within the JPO, also utilized as basic data for policies such as the establishment of a flexible examination system, revision of the FI/F-terms, and revision of the IPC, and are deployed to each examination search office and the relevant examination offices in the examination departments.

3. Browsing of the research results

The results of the recent patent application technical trend researches are available on the JPO Website.

The URL of the JPO Website is as follows:

<https://www.jpo.go.jp/resources/report/gidou-houkoku/tokkyo/index.html>

The results of the patent application technical trend researches are also available at the JPO Library, the National Diet Library, and the Intellectual Property Comprehensive Support Desks of each prefecture.

11302 Standard Technology Collection

1. Outline of the standard technology collection

The Japan Patent Office (JPO) identifies standard technologies, collects technologies, etc. described in non-patent literature such as articles, manuals, catalogs, and Web pages that accurately express the standard technologies, and organizes them into a collection of standard technologies.

The compilation of the standard technology collection was conducted from FY 2000 to FY 2006. In addition, "MIMO related technologies" was updated in FY 2017.

2. Utilization of the standard technology collection

This standard technology collection contains information (e.g., representative drawings) that accurately expresses standard technologies that are difficult to obtain from patent documents alone, and contributes to efficient patent examination as an examination document. The standard technology collection is deployed in the relevant examination offices in the examination departments.

3. Browsing of the standard technology collection

The standard technology collection for "MIMO-related technologies" updated in FY 2017 is available on the National Diet Library (NDL) Website. The URL is as follows:

<https://ndlsearch.ndl.go.jp/books/R100000039-I11515181>

The standard technology collection up to FY 2006 is available on the past JPO website, which has been stored in the "Web Archiving Project" of the National Diet Library. The URL is as follows.

https://warp.da.ndl.go.jp/info:ndljp/pid/10342974/www.jpo.go.jp/shiryosona/hyoujun_gijutsu.htm

11303 Formality Check Manual

In the Formality Check Manual, items to be a good reference for substantive examination of a patent and utility model are included. Those are extracted below.

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

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

	reduction/exemption of the fee payment for an examination request under the Patent Act or a request for a report of utility model technical opinion under the Utility Model Act, or a request for a reduction/exemption or deferment of the fee payment for a patent annual/registration fee (patent/utility model)
07.52	Fee reduction/exemption for individuals or legal entities (Article 9 of the Patent Act Enforcement Order, Article 1bis of Patent Fee Order) (patent)
07.53	Fee reduction/exemption for small and medium - sized enterprises (Article 10(i) of the Patent Act Enforcement Order) (patent)
07.54	Fee reduction/exemption for small/medium - sized enterprises satisfying the research and development requirements (Article 10(ii) of the Patent Act Enforcement Order) (patent)
07.55	Fee reduction/exemption for universities/research organizations etc. (Article 10(iii) of the Patent Act Enforcement Order) (patent)
07.56	Fee reduction/exemption for small enterprises (Article 10(iv) of the Patent Act Enforcement Order) (patent)
07.57	Fee reduction/exemption for enterprises etc. that have been established less than 10 years (Article 10(v) of the Patent Act Enforcement Order) (patent)
07.58	Fee reduction/exemption for small and medium sized enterprises that carries out a project under Approved Plan for Reconstruction and Revitalization of Fukushima according to the Act on Special Measures for the Reconstruction and Revitalization of Fukushima (Article 10(vi) of the Patent Act Enforcement Order) (patent)
07.60	Handling of a request for the fee payment of a reduction/exemption or deferment (utility model/trademark)
07.61	Fee reduction/exemption of the fee payment for a request for a report of utility model technical opinion under the Utility Model Act, or a request for a reduction/exemption or deferment of the fee payment for a utility model registration fee (utility model)
11. Method for indicating a person conducting procedures	
11.51	Handling in cases where indication of applicants etc. in a joint application or a joint appeal/trial is Party X "and (several) others"
11.52	About indication method and determination of the sameness of the domicile or residence in an application, a demand for appeal/trial etc.

11.53	Handling of separators and hyphens in a domicile or residence, full name or entity name in an application, demand for appeal/trial etc.
11.54	About indication of nationality and address of Taiwan
11.55	Regarding an application, demand for appeal/trial and registration request by an imprisoned criminal
11.58	Handling in cases where, in indication of a full name or entity name in an application, demand for appeal/trial etc., only the phonetic resulting from the way of reading a foreign language is different
13. Submission of a certificate and omission of documents to be submitted	
13.20	About statement of a domestic legal entity name in a certificate etc. stated in a foreign language
13.30	Handling of return of a certificate in cases where a request for return of a certificate is made
13.40	Signature
15. Acceptance and dismissal	
15.20	Handling of dismissal of a procedure with regard to an unlawful application document etc.
16. Violation of formality/Dismissal	
16.06	Handling of dismissal etc. of a payment document of annual (registration) fees for the registration of establishment
16.07	Handling of dismissal etc. of a payment document of annual (registration) fees after the registration of establishment
21. Application	
21.50	About amendment of an inventor etc. (patent/utility model/design)
21.51	About statement of the address of an inventor etc. (patent/utility model/design)
21.52	About correction of the indication of an applicant
21.53	Handling of an application with an unclear full name or entity name of an applicant
21.54	About amendment of an applicant in cases where a private business has filed an application under the name of a trade name etc. (2022.4)
21.55	About indication of the name of an inventor etc. (patent/utility model/design)
21.61	Handling of the certification of filing date (patent)
21.62	Patent application by a method for claiming to refer an earlier patent

	application (patent)
23. Description (patent/utility model)	
23.20	About amendment of procedures pertinent to the description, the scope of claims or drawings (patent/utility model)
23.21	Handling in cases where, on the occasion of an application filed on Jul. 1, 2003 or later, the description prepared by a method before the revision is attached to an application (patent/utility model)
23.22	About supplement of lacking parts of the specification or drawings (supplement of the lack) (patent)
24. Drawings (patent/utility model)	
24.10	Handling of "explanation about drawings" filled out in a drawing (patent/utility model)
24.11	Handling of photographs attached to an application etc. instead of drawings (patent/utility model)
28. Priority/Exceptions to lack of novelty, etc.	
28.01	Procedures of a priority claim under the Paris Convention or a priority claim recognized under the Paris Convention
28.02	Handling of withdrawal/waiver of a priority claim under Paris Convention etc.
28.10	Handling of procedures of priority claim based on a regular domestic application pursuant to Article 4A(2) of the Paris Convention
28.11	Handling pertinent to indication concerning priority claim
28.12	Handling of amendment of a written priority claim under the provision of Article 17quarter of the Patent Act or Article 2bis(1) of the Utility Model Act (patent/utility model)
28.21	Handling pertinent to elapse of the time due to the delay of an office work that issues a priority document(s).
28.41	Handling of priority claim based on a patent application etc. having formal irregularities (patent/utility model)
31. Special applications (division / conversion / amendment dismissal)	
31.32	Handling in cases where, about a patent application for which a decision of refusal was made, an application has been converted together with a demand for an appeal against an examiner's decision of refusal (patent/utility model/design)
43. Amendment	

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

58. Inspection and certification	
58.20	Inspection etc. of documents, models and specimens

11304 Appeal pursuant to the Administrative Complaint Review Act

A person who is dissatisfied with disposition of an administrative agency may enter a request for review pursuant to the Administrative Complaint Review Act (Article 2 of the Administrative Complaint Review Act). Furthermore, there is also the following provision. When a person has applied for a disposition with an administrative agency based on laws and regulations but the administrative agency takes no action for the application based on laws and regulations although a certain period of time has elapsed after the relevant application, the person may file a request for review with regard to the relevant inaction (Article 3 of the same Act).

In this regard, however, among dispositions in the Japan Patent Office, concerning: an examiner's decision; a rescission decision or an appeal/trial decision; a decision to decline a written opposition to the grant of a patent, a written request for appeal/trial or retrial or a written request for correction under Article 120-5(2) of the Patent Act or Article 134-2(1) of the same Act; and dispositions or inactions against which it is considered that an appeal is not allowed under the provision of the same Act, a request for review pursuant to the provisions of the Administrative Complaint Review Act is not allowed (Article 195-4 of the Patent Act).

In addition, it is understood that an invitation to correct, a notice of reasons for refusal, a notice to the effect that retroaction of an application date is not allowed, an advisory opinion and the like, do not exert influence on the right and duty or the legal status directly, and, not fall under the category of the [disposition](#), and therefore, no request for review pursuant to the Administrative Complaint Review Act may be filed against them.

As disposition in Japan Patent Office to be a subject of the Administrative Complaint Review Act, there is a disposition of dismissal (Article 13(4), 18, 18-2(1), 133(3), 133-2(1), 184-5(3) of the Patent Act and Article 7(3) of the Act on the Special Provisions to the Procedures, etc. concerning Industrial Property Rights. Except in cases falling under Article 195-4 of the Patent Act.) and the like, and the request for review against these dispositions is made to the JPO Commissioner, and the review of that request is conducted by review officers (persons involved in the disposition related to the request are disqualified).

Article 195-4 of the Patent Act (Restriction on requests for review under the provisions of the Administrative Complaint Review Act)

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

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

- (1) Decision to decline amendment (Main clause of Article 53(3))
- (2) Decision to decline a demand for judgment (Article 71(4))
- (3) Consideration decided by a ruling (Article 91-2) → Action Protesting the Amount of

(2024.3)

Consideration (Article 183)

- (4) Decision to the effect that a patent be maintained against an opposition to the grant of the patent concerned (Article 114(5))
- (5) Decision of permission or refusal for amendment of reason of demand for trial for invalidation
(Article 131-2(4))
- (6) Decision as to claim of exclusion or refusal of an administrative judge
(Article 143(3))
- (7) Decision on a request for intervention in a trial for invalidation and the like
(Article 149(5))