

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

Section 3 Notice of Reasons for Refusal

1. Overview

Where the examiner intends to render an examiner's decision to the effect that an application is to be refused, the examiner shall notify the applicant of the reasons for refusal and give the applicant an opportunity to submit a written opinion, designating an adequate time limit for such purpose (Article 50).

It is unfair for the applicant that the examiner renders the decision of refusal immediately without giving the applicant any opportunities for defense even when the examiner is convinced of the reasons for refusal. Moreover, it's not beyond the realm of possibility that the examiner makes a mistake. Under these circumstances, this provision aims at fair and appropriate operation of the procedures of a patent application, giving the applicant an opportunity for offering an opinion, as well as overcoming the reasons for refusal by amending the description etc., and also giving the examiner an opportunity for reconsidering with a written opinion, etc. (Reference) Decision by the Tokyo High Court, March 30, 1993 [Heisei 3-nen (Gyo Ke) No. 199], "COLORING METHOD"

2. Types of Notice of Reasons for Refusal

The Notice of reasons for refusal falls into the following two types in view of procedure.

- (i) Non-final notice of reasons for refusal (Article 17bis(1)(i))
- (ii) Final notice of reasons for refusal (Article 17bis(1)(iii))

2.1 Non-final notice of reasons for refusal

The "non-final notice of reasons for refusal" is a notice of reasons for refusal notifying reasons for refusal which should be notified in the first examination.

Therefore, the first notice of reasons for refusal is always the "non-final notice of reasons for refusal." A notice of reasons for refusal including reasons for refusal which should have been notified in the first examination is the "non-final notice of the reasons for refusal" in principle, even when the notice is notified after the first notice of reasons for refusal. (As for exceptions, see 3.2.1(2))

It is to be noted that amendments to a descriptions etc. should always meet the provision of Article 17bis(3), while amendments to claims made after receiving the non-final notice of reasons for refusal should meet the requirement of Article 17bis(4) in addition to the requirement of Article 17bis(3).

2.2 Final notice of reasons for refusal

The "final notice of reasons for refusal" is a notice of reasons for refusal notifying only reasons for refusal necessitated by amendments made in response to a "non-final notice of reasons for refusal" in principle.

Whether a second or later notice of reasons for refusal shall be the "non-final notice of reasons for refusal" or not should be substantively determined, not by the formal number of notifications.

As for specific determination as to whether a notice shall be the "non-final notice of reasons for refusal" or the "final notice of reasons for refusal," see 3.

Amendments to claims after receiving the "final notice of reasons for refusal" should meet the requirements of Article 17bis(5) and (6) in addition to the requirements of 17bis(3) and (4).

(Explanation)

If claims can be freely changed whenever a notice of reasons for refusal is received, the examination may have to be restarted on each occasion. This contributes to not only delays in examinations but also damages to fairness in treatment between applications with appropriate amendments and those without it. Therefore, in order to carry out a prompt examination while securing the fairness among applications, a system to issue the final notice of reasons for refusal and limit the content of amendments in response thereto is established so as to limit the amendments in response to the final notice of reasons for refusal to the scope in which the results of the examination that has been already completed can be effectively used.

Where a notice under Article 50bis is given along with a notice of reasons for refusal, amendments to claims should meet the same requirements as the amendments after receiving the "final notice of reasons for refusal" (see "Part VI Chapter 1 Section 2 Notice under Article 50bis").

3. Detailed Practices of Notice of Reasons for Refusal

In principle, the examiner should issue a notice of reasons for refusal at most two times (each of the "non-final notice of reasons for refusal" and the "final notice of reasons for refusal" once) and carry out examination, with effectiveness of the whole procedure being considered.

3.1 First notice of reasons for refusal

(1) The first notice of reasons for refusal is set to the "non-final notice of reasons for refusal."

(2) In principle, the examiner should give notice of all of the reasons for refusal which have been found in the first notice of reasons for refusal.

However, where notification of only a reason for refusal is likely to lead to amendments by which not only the notified reason for refusal but also another reason for refusal will be overcome at the same time, multiple reasons for refusal should not be always notified redundantly. For instance, where notification of only a reason for refusal in terms of lack of inventive step is likely to lead to amendments by which not only the reason for refusal in terms of lack of inventive step but also a reason for refusal in terms of non-compliance with description requirements will be overcome, the reason for refusal in terms of non-compliance with description requirements should not be always notified.

3.2 Second or later notice of reasons for refusal

For the second or later notice of reasons for refusal, the examiner should give notice of the reasons for refusal after determining whether it should be set to the "final notice of reasons for refusal" or the "non-final notice of reasons for refusal" according to the following.

In a case where it is not fallen into the following practical examples shown in 3.2.1 to 3.2.2 and whether the notice shall be the "non-final notice of reasons for refusal" or the "final notice of reasons for refusal" is not clear, the examiner returns to the purport of the system (see (Explanation) of 2.2) and makes a decision so that the applicant's opportunity for amendment may not be unreasonably limited.

3.2.1 Cases where "final notice of reasons for refusal" should be notified

A notice of reasons for refusal notifying only reasons for refusal necessitated by amendments made in response to a "non-final notice of reasons for refusal" shall be the "final notice of reasons for refusal".

(1) Types of the notice of reasons for refusal notifying only reasons for refusal necessitated by amendments

- a A notice of reasons for refusal notifying only reasons for refusal necessitated by the amendments to a description, etc. made by the applicant in response to a "non-final notice of reasons for refusal"

Example 1: In a case where the statement of the detailed description of the invention becomes obscure or new matters were added to the statement of the detailed description of the invention by amendments, a notice of reasons for refusal notifying only that effect.

Example 2: In a case where new reasons for refusal in terms of lack of novelty, inventive step, etc. should be notified as to the examined claims to which new technical matters were added by amendments or of which technical matters were deleted or limited by amendments, a notice of reasons for refusal notifying only the new reasons for refusal.

Example 3: In a case where new reasons for refusal in terms of lack of novelty, inventive step, etc. should be notified due to amendments made to add claims, a notice of reasons for refusal notifying only the new reasons for refusal.

Example 4: In a case where amendments adding new matters to the claims or amendments causing deficiency in descriptions were made, a notice of reasons for refusal notifying only that effect.

Example 5: In a case where a claim is amended so that it includes any invention which is not the subject of the examination with regard to the requirements other than those described in Article 17bis(4) in accordance with "Part IV Chapter 3 Amendment Changing Special Technical Feature of Invention," a notice of reasons for refusal notifying only that effect.

Example 6: In a case where a claim is amended so that it includes any invention which is not the subject of the examination with regard to the requirements other than those described in Article 37 in accordance with "Part II Chapter 3 Unity of Invention," a notice of reasons for refusal notifying only that effect.

Example 7: In a case where a claim is amended so that it includes any invention which is not the subject of the examination with regard to the requirements other than those described in Article 36(6)(iv) and Regulations under the Patent Act Article 24ter(v) in accordance with "Part II Chapter 2 Section 5 Ministerial Ordinance Requirement on Statement of Claims", a notice of reasons for refusal notifying only that effect.

Example 8: In cases to which two or more of items Example 1 to Example 6 shown above are applicable, a notice of reasons for refusal notifying only these effects.

b A notice of reasons for refusal notifying only reasons for refusal necessitated as a result of the examination of novelty, inventive step etc. required after amendments were made in response to a "non-final notice of reasons for refusal" on the claim excluded from a subject of the search.

(Explanation)

Where claims which had not been examined in terms of novelty, inventive step, etc. (limited to the case where it is clearly expressed in the notice that the claims had been excluded from a subject of the search and therefore examinations on novelty, inventive step, etc. had not been conducted with the reason thereof) were amended and the invention after the amendments is examined, a notice to be notified shall be the "final notice of reasons for refusal" because this case is substantially the same as restarting examination on claims added by amendments.

Example 9: In a case where claims which had not been examined on novelty, inventive step, etc. because the statement of the claims was too obscure to understand even if the description and the drawings were taken into account were amended and reasons for refusal in terms of lack of novelty, inventive step, etc. are found as to the unexamined claims after the amendments, a notice of reasons for refusal notifying only that effect.

Example 10: In a case where claims with which only reasons for refusal of adding new matters were notified without examining on novelty and inventive step because the claims were clearly added new matter were amended and reasons for refusal in terms of lack of novelty, inventive

step, etc. are found as to the amended claims, a notice of reasons for refusal notifying only that effect.

Example 11: In cases to which both items Example 9 and Example 10 shown above are applicable, a notice of reasons for refusal notifying only these effects.

(Points to note)

When the examiner considers that the claimed invention before amendments should not have been excluded from a subject of the prior art search as a result of taking into consideration a written opinion etc., reasons for refusal in terms of lack of novelty, inventive step, etc. notified as to the claimed invention after the amendments shall be notified in the "non-final notice of reasons for refusal."

c A notice of reasons for refusal notifying only reasons for refusal necessitated as a result of the examination of the requirements other than the aforementioned Ministerial Ordinance Requirement required after amendments were made in response to a "non-final notice of reasons for refusal" on any claim which had not been the subject of the examination with regard to the requirements other than those described in Ministerial Ordinance Requirement on Statement of Claims (Article 36(6)(iv) and Regulations under the Patent Act Article 24ter(v)).

(Explanation)

Where claims which had not been examined in terms of the requirements other than those described in Ministerial Ordinance Requirement on Statement of Claims (Article 36(6)(iv) and Regulations under the Patent Act Article 24ter(v)) (limited to the case where it is clearly expressed in the notice that examinations on the requirements other than the aforementioned Ministerial Ordinance Requirement had not been conducted with the reason thereof) were amended and the invention after the amendments is examined, a notice to be notified shall be the "final notice of reasons for refusal" because this case is substantially the same as restarting examination on claims added by amendments.

(Points to note)

When the examiner considers that the claimed invention before amendments should not have been assessed to be a violation of the aforementioned Ministerial Ordinance Requirement as a result of taking into consideration a written opinion etc., reasons for refusal notified as to the claimed invention after the amendments shall be notified in the "non-final notice of reasons

for refusal."

(2) Special Case where a "final notice of reasons for refusal" may be rendered

- a In addition to the reasons for refusal to the effect that there is not novelty, an inventive step, etc., there are minor improper descriptions (those recognized as "correction of errors" or the "clarification of an ambiguous statement" set forth in Article 17bis(5)(iii) to (iv)). However, only the reasons for refusal pertinent to novelty, an inventive step, etc., are notified, and reasons for refusal pertinent to description requirements are not notified. As a result there still remain minor improper descriptions. In such a case, a further notice of reasons for refusal for notifying the improper descriptions can be rendered as a "final notice of reasons for refusal."

(Explanation)

Minor improper descriptions are usually expected to be corrected when amendment is made in response to a notice of reasons for refusal pertinent to novelty, an inventive step, etc. Further, even if the improper descriptions are not corrected and pointed out in a "final notice of reasons for refusal," improper descriptions recognized as "final notice of reasons for refusal," improper descriptions recognized as "correction of errors" or the "clarification of an ambiguous statement" set forth in Article 17bis(5)(iii) to (iv)) are allowed as amendment after the "final notice of reasons for refusal." Therefore, the improper descriptions are handled as stated above.

- b As to a claim for which a search has completed in accordance with 3.1.3 (Note) in "Section 2 Prior Art Search and Determination on Novelty, Inventive Step, etc.," previous reasons for refusal are resolved by amendment, whereas reasons for refusal based on a new prior-art document, etc., are found. In such a case, a further notice of reasons for refusal to be issued at this time can be rendered as a "final notice of reasons for refusal."
- c Where, although the notified reasons for refusal are unresolved, the examiner can show an action available for the applicant to resolve the reasons for refusal and determine that an agreement with the applicant for taking the action can be expected, a notice of reasons for refusal which will be notified when the agreement is concluded as a result of communication being established with the applicant can be taken as a "final notice of reasons for refusal" (see 3. in "Section 5 Decision"

and 3.5 in "Section 7 Reconsideration by Examiners before Appeal Proceedings")

- d An invention subjected to amendments that are intended for restriction in a limited way does not fulfill requirements set forth in Article 36(6). In such a case, when the improper description is a minor one and it is expected that the invention be patentable by making a simple amendment to remedy the improper description, a further notice of reasons for refusal notified after the amendment is made can be rendered as a "final notice of reasons for refusal."

3.2.2 The case where even a second-time or subsequent notice of reasons for refusal should be rendered as a "non-final notice of reasons for refusal"

Even in a case of a second-time or subsequent notice of reasons for refusal, when reasons for refusal that should have been pointed out by the examiner in the non-final notice of reasons for refusal are to be notified, the examiner notifies a "non-final notice of reasons for refusal" because the reasons for refusal do not stem from amendment.

Therefore, in a case corresponding to (1) or (2) provided below, the examiner notifies a "non-final notice of reasons for refusal."

In addition, if reasons for refusal that should have been pointed out in the first notice of reasons for refusal and reasons for refusal required to be notified resultant of amendment responding to the notice of reasons for refusal are to be simultaneously notified, the examiner notifies a "non-final notice of reasons for refusal."

- (1) The case where reasons for refusal, which should have been pointed out by the examiner at the first notice of reasons for refusal but were not found at that point in time, are notified

Example 1: Where reasons for refusal, such as improper descriptions in a description, lack of unity of an invention, etc., were overlooked when reasons for refusal to the effect of lack of novelty and an inventive step, were notified in a first notice of reasons for refusal, and where the reasons for refusal were found later

Example 2: Where reasons for refusal are found later in spite of the fact that no amendment was made to claims for which the first notice of reasons for refusal stipulated that no reasons for refusal was found.

Example 3: Where reasons for refusal based on lack of novelty or lack of an inventive step are found later in spite of the fact that amendment for restriction was made to a claim for which no reasons for refusal, or neither lack of novelty or lack of an inventive step, was notified by the first notice of reasons for refusal

Example 4: Where an examination was not performed in connection with novelty, an inventive step, etc. in spite of the fact that there was no rational reasons for not conducting the examination (see "Section 2 Prior Art Search and Determination on Novelty, Inventive Step, etc." 2(3)) at the first notice of reasons for refusal, and where reasons for refusal pertinent to novelty, an inventive step, etc. are to be notified in a second-time notice of reasons for refusal.

Example 5: As to claimed invention that includes matters specifying the invention that are expressed by choice A or B, both A and B were rendered as objects of examination. However, a reason for refusal was notified only for an invention grasped from the choice A in the first notice of reasons for refusal, and a reason for refusal was not notified for an invention grasped from the choice B. When reasons for refusal are notified for the invention grasped from the choice B in the second notice of reasons for refusal, the second-time notification is the case

- (2) The case where appropriate reasons for refusal are notified again because the reasons for refusal presented in the first notice of reasons for refusal are inappropriate

Example 6: No amendment was made in response to a first notice of reasons for refusal, whereas only a written opinion was submitted. When reasons for refusal are notified again, it is the "non-final notice of reasons for refusal".

Example 7: Reasons for refusal, such as lack of an inventive step, were notified in a first notice of reasons for refusal by citation of a prior-art document, amendment was made in response to the notice. In such a case, it is determined that the previous reasons for refusal are unreasonable with respect to the claims that have not been amended in view of the content of written opinion. When reasons for refusal are again notified by citing a different new prior-art document, it is the "non-final notice of reasons for refusal".

Example 8: When reasons for refusal based on lack of novelty and lack of an inventive step are notified for the invention made up of a matter A specifying the invention and a matter B specifying the invention, amendment was made to A, but no amendment was made to B. In such

case, it is the "non-final notice of reasons for refusal" if reasons for refusal are again notified by changing a prior-art document because the prior-art documents cited for B, which was not amended, is inappropriate.

4. Points to Note at the Time of Notice of Reasons for Refusal

A notice of reasons for refusal must specifically state reasons for refusal so that an applicant can clearly comprehend an intended meaning of the reasons. Reasons for refusal and answers to the reasons by the applicant become important materials later in defining a technical scope of a patented invention later as well as during procedures in the Patent Office. Therefore, reasons for refusal must be clear even when viewed from third parties.

Specifically, the examiner shall notify reasons for refusal while paying attention to the following points.

(1) The examiner shall state reasons for refusal as concisely and clearly as possible so that the applicant can comprehend the reasons for refusal.

At this time, the examiner shall state reasons for refusal without being redundant to a great extent than required so that the applicant can make an amendment to acquire a patent right and so that the applicant can comprehend the essence of the reasons for refusal.

(2) Reasons for refusal are shown for each claim except reasons for refusal that cannot be determined for each claim (improper descriptions throughout the description, addition of a new matter, and the like). Further, a claimed invention for which reasons for refusal are found and a claimed invention for which reasons for refusal are not found can be distinguished from each other.

Incidentally, the examiner can make a remark on claims collectively in reasons for refusal as long as the same explanation of e.g. a comparison the claimed invention and cited invention and a determination shall apply to the claims in common.

(3) After a difference between the claimed invention and a cited invention is made clear, a rationale for negating an inventive step of the claimed invention is stated in reasons for refusal pertinent to lack of an inventive step.

(4) The examiner shall show only reasons for refusal in connection with Article 36(6)(iv) and Regulations under the Patent Act Article 24ter(v), Article 37 or Articles 17bis(4) for each of the following inventions after clearly stating that the invention was not examined in connection with the requirements other than those set forth in Article 36(6)(iv) and Regulations under the Patent Act Article 24ter(v), Article 37 or Articles 17bis(4), with regard to an invention (violating Article 36(6)(iv) and Regulations under the Patent Act Article 24ter(v)) which is not the subject of the examination with regard to the requirements other than those described in Article 36(6)(iv) and Regulations under the Patent Act Article 24ter(v) in light of "Part II Chapter 2 Section 5 Ministerial Ordinance Requirement on Statement of Claims," an invention (violating Article 37) which is not the subject of the examination in connection with the requirements other than Article 37 in light of "Part II, Chapter 3 Unity of Invention" or an amended invention (violating Article 17bis(4)) that is not the subject of the examination in connection with the requirements other than Article 17bis(4) in light of "Part 4 Chapter 3 Amendment Changing Special Technical Feature of Invention."

(5) As to an invention excluded from object of prior-art search, the examiner may show only applicable reasons for refusal while clearly stating that the invention was not examined in connection with novelty, an inventive step, etc.

However, the examiner must pay attention to minimize the number of inventions to be excluded from objects of prior-art search ("Section 2 Prior Art Search and Determination on Novelty, Inventive Step, etc.")

(6) When statements, etc., of the description fail to comply with the requirements set forth in Article 36(4)(i) or items of paragraph (6), the examiner shall specifically state portions of non-compliance and their reasons.

(7) Where rendering a "final notice of reasons for refusal," the examiner shall state that the notice is "final" and reasons thereof. Where the examiner shall not have stated either that the notice is final or the reasons thereof, the examiner shall not handle the patent application, as if the "final notice of reasons for refusal" were issued, even when the notice of reasons for refusal is appropriate to be handled as a "final."

Specifically, even if amendment made to the notice of reasons for refusal does not fulfill any of the requirements set forth in Articles 17bis(3) to (6), the examiner shall not decide to dismiss the amendment.

(8) When citing prior-art documents, and others, the examiner shall pay attention to the followings:

- a The examiner shall specify cited documents, and others, and provide statements in such a way that cited portions required to be compared with a claimed invention and make a determination become noticeable.
- b The examiner shall clearly show technical details found from cited documents, and others.
- c The Examiner shall sufficiently examine a necessity as to whether or not cited documents, and others, are only those necessary and sufficient for reasons for refusal.

(9) The examiner shall suggest the amendments, the divisional application and so on in the notice of reasons for refusal etc. willingly where it may be pointed out how the applicant can respond to overcome the reasons for refusal. (See 2.1 in "Section 8 Communication with Applicant and Request for Documents etc. Required for the Examination")