

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

Chapter 1 Principles of Examination and Flow of Examination

1. Principles of Examination

An examiner should conduct a substantive examination for a patent application, i.e., examination concerning whether or not a patent should be granted for the application, or whether or not a patent application has any reasons for refusal. The examiner is required to make fair determinations based on high-level expertise.

The examiner should take note in particular of the following aspects:

- (1) To conduct examination as uniformly as possible in line with guidelines relevant to the examination, such as the Examination Guidelines, etc., paying due consideration to the promptness, accuracy, fairness and transparency;
- (2) On the premise that it is primarily the burden of the applicant (including the attorney; in this part, hereinafter simply referred to as "an applicant") to proceed with the prescribed procedures to obtain the patent right taking his/her own initiatives, the examiner conducting the examination should also take into account the purport of establishment of high-quality patent right.
- (3) To make an effort to ensure and further improve the quality of examination with respect to prior art search and determination on the requirements for patentability. The prior art search and the determination on patentability should be made taking into consideration complex nature and advancement of the technology by fully utilizing accumulated expertise of each examiner.
- (4) To perform efficient examination, ensuring sufficient communication with an applicant.

2. Flow of Examination

With regard to a patent application for which a request for examination is filed, the examiner conducts the examination in accordance with the following procedures.

For details of the examination procedures, see "Chapter 2 Procedures of Examination." Also, see Figure 1 for the flow of the examination procedures.

2.1 First round of examination

(1) Understanding and Specifying claimed invention (see "Chapter 2 Section 1 Specifying Claimed Invention.")

The examiner starts by carefully reading the description, claims, and drawings of the application to be subjected to the examination (in this part, hereinafter referred to as "the application concerned") so as to obtain sufficient understanding of the technical content of the invention. When a written amendment, etc. have been filed prior to the first round of the examination (the term "etc." refers to documents, etc. other than the written opinion and the written amendment (for example, a certificate of experiment results and a written statement). The same applies to usage of the term "etc." in this Part as in "written amendment, etc." and "written opinion, etc."), the examiner should sufficiently understand the content of these documents.

Also, the examiner specifies the claimed invention of the application concerned on the basis of the recitations of the claims of the application concerned.

(2) Prior art search and determination of existence of reasons for refusal (see "Chapter 2 Section 2 Prior Art Search and Determination of Requirements of Novelty, Inventive Step, etc.")

The examiner then examines the requirements associated with exclusion from the search such as the requirements of Ministerial Ordinance Requirement on Statement of Claims (Patent Act Article 36(6)(iv) and Regulations under the Patent Act Article 24ter(v)), requirements of unity of invention (Article 37) and requirements of description and claims (Article 36) and determines the invention to be subjected to the prior art search from among the claimed inventions of the application concerned.

Thus, the examiner conducts prior art search with regard to the claimed invention(s) determined as the subject of search concerning novelty (Article 29(1)), inventive step (Article 29(2)), secret prior art (Article 29bis), and prior application (Article 39) (in this part, hereinafter referred to as "novelty, inventive step, etc.").

The examiner, after completion of the prior art search, examines the novelty, inventive step, etc. of the claimed invention of the application concerned, which has been determined as the subject of search, on the basis of the search results. Also, the examiner examines the existence of other reasons for refusal.

(3) Notice of decision and notice of reasons for refusal (see "Chapter 2 Section 3 Notice of Reasons for Refusal" and "Chapter 2 Section 5 Decision.")

When the examiner does not find a reason for refusal as a result of the examination of the requirement of unity of invention, requirements of description and claims, novelty, inventive step, etc. as well as ascertainment of any other reasons for refusal, the examiner renders a decision to grant a patent (Article 51).

When a reason for refusal has been found, the examiner notifies the reasons for refusal (Article 50). There are two types of notice of reasons for refusal, i.e., "non-final notice of reasons for refusal" and "final notice of reasons for refusal." The first notice of reasons for refusal is always rendered as the non-final notice of reasons for refusal."

2.2 Examination following response to first notice of reasons for refusal

(1) Consideration of written opinion and written amendment, etc. (see "Chapter 2, Section 4 Handling of Written Opinion, Written Amendment, etc.")

When a written opinion, written amendment, etc. have been submitted, the examiner sufficiently considers the content of the submitted written opinion, written amendment, etc. and continues the examination.

Thus, the examiner confirms whether or not the reasons for refusal set forth in the notice of reasons for refusal is appropriate in light of the content of the written opinion, written amendment, etc. and, on the basis of the confirmation, determines whether or not the notified reason for refusal has been overcome, and whether or not there is any other reason for refusal.

(2) Notice of decision to grant patent and notice of reasons for refusal (see "Chapter 2 Section 3 Notice of Reasons for Refusal" and "Chapter 2 Section 5 Decision")

When it is determined that the notified reasons for refusal has been overcome as after reviewing the content of the written opinion, written amendment, etc. and any other reasons for refusal is not found, the examiner renders a decision to grant a patent (Article 51).

When it is determined that the notified reasons for refusal has not been overcome even when the content of the written opinion, written amendment, etc. is taken into account, the examiner renders a decision of refusal (Article 49).

When it is determined that the notified reasons for refusal has been overcome but any other reasons for refusal has been found, the examiner again notifies the reasons

for refusal (Article 50). If the notice of the reasons for refusal at this stage only contains a reason or reasons for refusal notification of which has been necessitated as a result of the amendments entered by a response to the prior notice of reasons for refusal, the notice of reasons for refusal is made final (i.e., rendered as the "final notice of reasons for refusal").

2.3 Examination following response to final notice of reasons for refusal

(1) Assessment of written opinion, written amendment, etc. and review of dismissal of amendment (see "Chapter 2 Section 4 Handling of Written Opinion, Written Amendment, etc." and "Chapter 2 Section 6 Decision of Dismissal of Amendment".)

When a written opinion, written amendment, etc. have been submitted, the examiner sufficiently considers the content of the submitted written opinion, written amendment, etc. and first determines whether or not the notice of reasons for refusal was appropriately made final to be rendered as the "final notice of reasons for refusal."

When it is determined that the notice was improperly made final as the "final notice of reasons for refusal," the examiner conducts the examination on the basis of the description, claims and drawings amended by the written amendment.

When it is determined that the notice was properly made final as the "final notice of reasons for refusal," the examiner determines whether or not the amendments by the written amendment comply with the requirements for amendments.

When it is determined that the amendment complies with the requirements for amendments, the examiner conducts the examination on the basis of the description, claims and drawings amended by the written amendment.

The examiner, where it is determined that the amendment fails to comply with the requirements for amendment, determines that the amendment is to be dismissed and continues the examination on the basis of the description, claims, drawings, etc. prior to submission of the written amendment.

(See Figure 2 for the flow of the examination where a written amendment is filed in response to a "final notice of reasons for refusal.")

When a written opinion has been filed but a written amendment has not been filed, the examiner considers sufficiently the content of the submitted written opinion and continues the examination.

(2) Notice of decision and notice of reasons for refusal (see "Chapter 2 Section 3 Notice

of Reasons for Refusal" and "Chapter 2 Section 5 Decision.")

When it is determined that the notified reasons for refusal has been overcome and no other reasons for refusal are found, the examiner renders a decision to grant a patent (Article 51).

When it is determined that the notified reasons for refusal is not overcome, the examiner renders a decision of refusal (Article 49).

When it is determined that the notified reasons for refusal has been overcome but any other reasons for refusal has been found, the examiner notifies the reasons for refusal upon consideration of whether the notice of reason for refusal should be rendered as a "first notice of reasons for refusal" or made final (i.e., rendered as a final notice of reasons for refusal) (Article 50).

Also, where a written amendment was filed and it is determined that the amendment to be entered by this written amendment should be dismissed, the examiner renders a decision to dismiss the amendment (Article 53(1)) and renders a decision to grant a patent or renders a notice of reasons for refusal.

2.4 Reconsideration by examiners before proceedings

When a demand for appeal against examiner's decision of refusal has been filed for the application for which a decision of refusal was rendered (in this part, hereinafter referred to as "demand for appeal") and an amendment has been made at the time of filing of the demand for appeal, the examiner should conduct examination for the application before the appeal (Article 162). This examination is called "reconsideration by examiner before appeal proceedings."

The overview of the reconsideration by examiner before appeal proceedings is as follows (for the flow of procedures of the reconsideration by examiner before appeal proceedings, see "Chapter 2 Section 7 Reconsideration by Examiners before Appeal Proceedings" and Figure 3).

In the reconsideration by the examiners before the appeal proceedings, the examiner first considers whether or not the amendment at the time of filing of the demand for appeal complies with the requirements for amendments,

When it is determined that the amendment in question complies with the requirements for amendments, the examiner conducts the reconsideration before appeal on the basis of the description, claims, and drawings as amended. If the amendment in question fails to comply with the requirements for amendment, the examiner conducts

the reconsideration before appeal on the basis of the description, claims, and drawings at the time of the decision of refusal.

The examiner renders a decision to grant a patent, a notice of reasons for refusal, or a report to the Commissioner of the Patent Office (Article 164(3)) (in this part, hereinafter referred to as a "reconsideration report") in accordance with the results of the reconsideration before appeal.