

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

Section 2 Notification under Article 50bis

1. Overview

Article 50bis of the Patent Act provides for notification by the examiner in the examination of a divisional application and related matters. It stipulates that if the examiner is to give notice of reasons for refusal of a patent application and such reasons are the same as those for refusal of the original application, etc., then the examiner must include a statement to that effect.

The objective of the provision of Article 50bis (and Article 17bis(5)) is to encourage the applicant to fully scrutinize the reasons for refusal notified in the examination of the original application, etc., and refrain from dividing the application for the invention for which such reasons were already notified, without resolving such reasons.

If notification pursuant to the provision of Article 50bis (In this section, hereinafter, referred to as "Article 50bis notification.") is given together with a notice of reasons for refusal with respect to a patent application and the description, etc., are to be amended, then such amendment must meet the requirements prescribed in paragraphs 3 to 6 of Article 17bis, just as amendments after the final notice of reasons for refusal are required to do so. Amendments that do not satisfy such requirements are dismissed.

For the sake of clarity, in the cases described in (i), (ii) below, the examiner shall be careful not to apply the provision of Article 50bis more formally than necessary.

- (i) It is not clear whether the reasons for refusal at issue are the same as those stated in a notice of reasons for refusal of another patent application (e.g., reasons for refusal cannot be clearly identified from statements in a notice of reasons for refusal of another patent application).
- (ii) The reasons for refusal relate to errors or other minor improper in statements.

2. Determination on whether or not to Give the Article 50bis Notification

In connection with the patent application for which the examiner intends to give a notice of reasons for refusal (In this section, hereinafter, referred to as

"application concerned."), the examiner shall give the Article 50bis notification based on the reasons for refusal notified in connection with another patent application if all of the Requirements 1 to 3 below are met.

(Requirement 1) The application concerned and such other patent application are deemed to have been filed simultaneously pursuant to the provision of Article 44(2) (see 2.1).

(Requirement 2) The reasons for refusal of the application concerned are the same as those stated in a notice of reasons for refusal of such other patent application (see 2.2).

(Requirement 3) The notice of reasons for refusal of such other patent application was accessible to the applicant of the application concerned prior to the filing of a request for examination of the application concerned (see 2.3).

2.1 The application concerned and such other patent application are deemed to have been filed simultaneously pursuant to the provision of Article 44bis (Requirement 1)

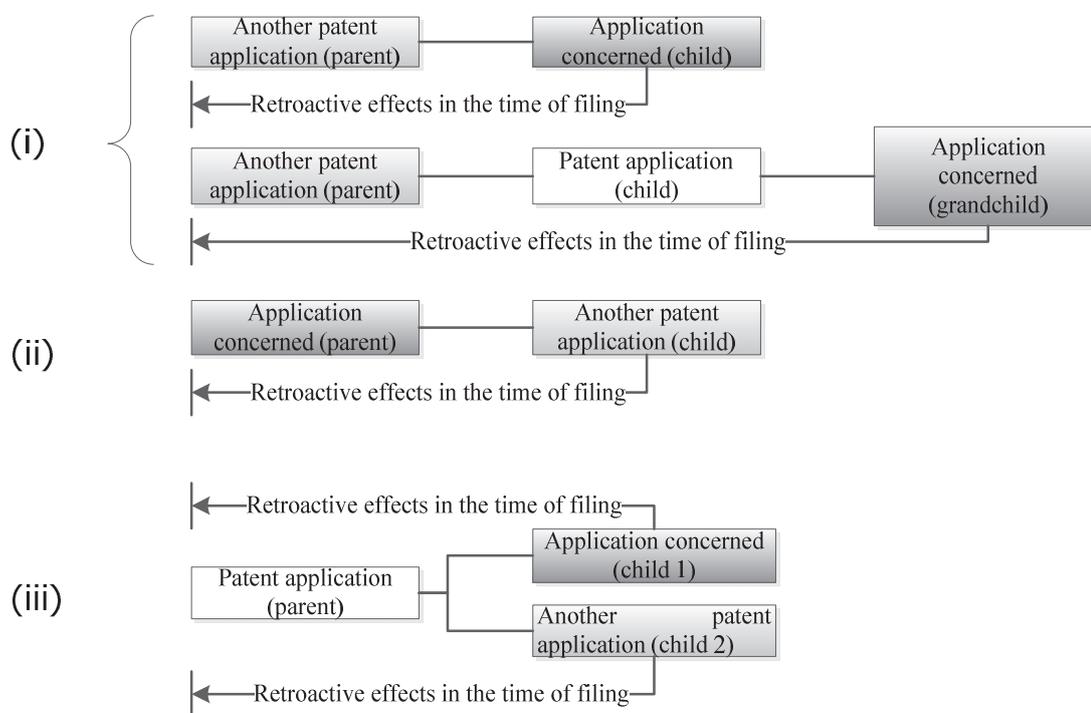
In order for the provision of Article 44(2) to be applied, at least either the application concerned or such other patent application must be a divisional application. Therefore, the examiner shall determine whether the relationship between the application concerned and such other patent application comes under any of the relationships set forth in (i) to (iii) below.

Furthermore, in order for the provision of Article 44(2) to be applied, the substantive requirements for the division of a patent application must also be met. Therefore, the examiner shall also confirm whether the application concerned or such other patent application, whichever is filed as a divisional application, satisfies the substantive requirements for division and thus the application concerned and such other patent application are deemed to have been filed simultaneously. (Note 1)

- (i) The application concerned is one of a group of divisional applications based on another patent application (Note 2)
- (ii) Such other patent application is one of a group of divisional applications based on the application concerned
- (iii) Both the application concerned and such other patent application are among a group of divisional applications based on the same patent application

(Note 1) For his or her judgment as to whether or not Requirement 1 is satisfied, the examiner shall rely on statements in the description etc. of the application concerned and such other patent application as they stand when reasons for refusal of the application concerned are notified. For the substantive requirements for the division of a patent application, see "Section 1 Requirements for Division of Patent Application."

(Note 2) A group of divisional applications based on a patent application refers to a series of divisional applications derived from a single patent application. Examples include divisional applications derived from a single original application, and a divisional application (grandchild application) whose original application is such a divisional application (child application).



2.2 Reasons for refusal of the application concerned are the same as those stated in a notice of reasons for refusal of such other patent application (Requirement 2)

Reasons for refusal of the application concerned are the same as those stated in a notice of reasons for refusal of such other patent application (Notes 1) if the reasons for refusal of the application concerned and of such other patent application are based on the same clause and their specifics are substantially identical to each other. (Note 2)

Specifically, the examiner shall determine whether or not Requirement 2 is met, as follows. Assuming that the description, etc., of the application concerned are the same as the description, etc., of another patent application as they stand after an amendment is made in response to a notice of reasons for refusal, the examiner shall determine in this respect on the basis of whether the description, etc., of the application concerned have resolved the reasons for refusal stated in the notice of reasons for refusal of such other patent application. If the examiner finds that the reasons for refusal are not resolved, he or she shall conclude that Requirement 2 is met.

(Note 1) "Notice of reasons for refusal of such other patent application" does not refer solely to a notice of reasons for refusal given upon the examination of such other application, but also includes notices of reasons for refusal based on appeals against the examiner's decision of refusal, retrials, and reconsideration by examiners before appeal proceedings.

Decisions to dismiss amendments and refuse patent applications are not "notices of reasons for refusal." Therefore, the examiner shall not give the Article 50bis notification if the reasons for refusal of the application concerned are identical solely to those stated in decisions to dismiss amendments to or refuse another patent application.

(Note 2) In such cases where there are two or more reasons for refusal of the application concerned and a notice of reasons for refusal of another patent application also includes more than one reason for refusal, if one of the reasons for refusal of the application concerned is the same as one of the reasons for refusal stated in such notice for such other application, then the reason for refusal of the application concerned shall be deemed to be identical with the one stated in the notice of reasons of refusal of such other application.

2.3 The notice of reasons for refusal of such other patent application was accessible to the applicant of the application concerned prior to the filing of a request for examination thereof (Requirement 3)

The examiner shall conclude that Requirement 3 is met if the notice of reasons for refusal of such other application comes under either (i) or (ii) below.

- (i) The notice of reasons for refusal reached the applicant of the application concerned prior to the filing of a request for examination thereof
- (ii) The notice of reasons for refusal was accessible to the applicant of the application concerned prior to the filing of a request for examination of the

application concerned (Note)

(Note) If such other patent application was laid open prior to the filing of a request for examination of the application concerned, such notice of reasons for refusal is deemed to have been accessible to the applicant of the application concerned prior to the filing of a request for examination of the application concerned.

This does not depend on whether the applicant of the application concerned is the same as or different from the applicant of such other application; in the case of different applicants, the notice of reasons for refusal of such other application is not sent to the applicant of the application concerned, but is deemed accessible to him or her so long as such other application is laid open.

(Points to note)

In the cases set forth in (i) or (ii) below, it shall be deemed that the applicant of the application was not accessible to the notice of reasons for refusal of such other application prior to the filing of the request for examination of the application concerned, unless the request for examination of the application concerned was obviously filed "after" the arrival (or the becoming accessible) of the notice of reasons for refusal.

(i) The notice of reasons for refusal of such other application arrived at the relevant applicant on the same day when the request for examination of the application concerned was filed

(ii) The notice of reasons for refusal of such other application became accessible on the same day when the request for examination of the application concerned was filed

<h3>3. Procedure of Examination for Determination on whether or not to Give the Article 50bis Notification</h3>

3.1 Procedure

If the Application concerned is a divisional application or the original application of a divisional application, the examiner shall determine whether or not to give the Article 50bis notification. If any written statement has been submitted that the description, etc., of the application concerned have resolved the reasons for refusal stated in a notice of reasons for refusal of another patent application, then the examiner shall take it into consideration.

If the examiner concludes in accordance with 2. that all of the Requirements 1 to 3 are met, then the examiner shall give the Article 50bis notification together with a notice of reasons for refusal of the application concerned.

If any of Requirements 1 to 3 above is not satisfied, however, the Article 50bis notification shall not be given with respect to the application concerned.

(Point to consider)

As shown in 1. , in the cases described in (i) and (ii) below, the examiner shall be careful not to apply the provision of Article 50bis more formally than necessary.

(i) It is not clear whether the reasons for refusal at issue are the same as those stated in a notice of reasons for refusal of another patent application (e.g., reasons for refusal cannot be clearly identified from statements in a notice of reasons for refusal of another patent application).

(ii) The reasons for refusal relate to errors or other minor improper in statements.

3.2 Matters to be stated in the Article 50bis notification

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.

(Point to consider)

The examiner shall not omit describing the reasons for refusal in sufficient detail in the notice of reason for refusal of the application concerned even if the Article 50bis notification contains information that helps identify reasons for refusal stated in a notice of reasons for refusal of another patent application. This is because, even if the application concerned is a divisional application or the like, it is still a different application from the original application or the like, so it is inappropriate if the notice of reasons for refusal of the application concerned cannot be understood without taking into consideration a notice of reasons for refusal of another patent application.

<h3>4. Procedure of Examination where an Amendment is Made in Response to a Notice of Reasons for Refusal Accompanied by the Article 50bis Notification</h3>
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The examiner shall proceed with his or her examination as follows, depending

on whether the notice of reasons for refusal accompanied by the Article 50bis notification is "non-final" or "final."

For illustrative purposes, the procedure of examination where an amendment is made in response to a notice of reasons for refusal accompanied by the Article 50bis notification is shown in the figure below.

4.1 If the notice of reasons for refusal is "non-final"

If an amendment is made in response to the "non-final notice of reasons for refusal" accompanied by the Article 50bis notification, the examiner shall re-examine whether it was appropriate to give the Article 50bis notification, taking into consideration the applicant's arguments in written opinions, etc. (Note)

(Note) If the Article 50bis notification stated that two or more of the reasons for refusal of the application concerned are the same as those stated in a notice of reasons for refusal of another patent application, then the examiner shall conclude that it was appropriate to give the Article 50bis notification so long as any one of such reasons is still valid.

4.1.1 If it was appropriate to give the Article 50bis notification

The examiner shall examine whether the amendment made in response to the notice of reasons for refusal accompanied by the Article 50bis notification complies with any of the provisions of paragraphs 3 to 6 of Article 17bis. If the examiner determines that it is in violation of any of these provisions, he or she shall decide to dismiss the amendment. See "Part IV Amendments of Description, Claims or Drawings" for detailed guidelines on judgment as to the conformity of such amendment to these provisions.

(Point to consider)

If it was appropriate to give the Article 50bis notification at the time it was given, any subsequent amendment must still meet the provisions of paragraphs 3 to 6 of Article 17bis even if such amendment would cause the application concerned to cease to satisfy the substantive requirements for division, making it and another application at issue no longer qualified to be deemed to have been filed simultaneously.

The same applies if, following the Article 50bis notification for the application concerned, another patent application at issue is amended and ceases to satisfy the substantive

requirements for division, making it and the application concerned no longer qualified to be deemed to have been filed simultaneously.

If it was appropriate to give the Article 50bis notification, the examiner shall proceed with his or her examination in accordance with the following guidelines, which can be found in 3. to 5. of "Part I Chapter 2 Section 6 Decision of Dismissal of Amendment."

In so doing, the examiner shall read "final notice of reasons for refusal" in these guidelines as "non-final notice of reasons for refusal accompanied by the Article 50bis notification."

For the sake of clarity, if the examiner gives a renewed notice of reasons for refusal in accordance with 4.(3) or 5.(3) of "Part I Chapter 2 Section 6 Decision of Dismissal of Amendment," then the examiner shall examine whether or not to give the Article 50bis notification as well, in accordance with 2. and 3. .

4.1.2 If it was inappropriate to give the Article 50bis- notification

The examiner shall accept the amendment without dismissing it.

Moreover, if the previously notified reasons for refusal are not resolved in the application as so amended, the examiner shall give another "non-final notice of reasons for refusal," rather than immediately refusing the application.

If the examiner is to give notice of only the reasons for refusal that need to be notified in connection with the amendment, the examiner shall issue it as another "non-final notice of reasons for refusal," rather than as the "final notice of reasons for refusal." Moreover even in the case where the examiner notifies reasons for refusal that are identical with those stated in a notice of reasons for refusal of another patent application, the examiner shall not give the Article 50bis notification.

(Point to consider)

If it is found that an amendment is being made by the applicant asserting and assuming that the Article 50bis notification should not have been given as the reasons for refusal of a patent application and another patent application at issue are not considered to be identical, or on any other grounds, then the examiner shall treat the amendment as if the Article 50bis notification had not been given.

In other words, if the previously notified reasons for refusal are not resolved in the

application as so amended, the examiner shall refuse it.

If the examiner is to give notice of only the reasons for refusal that need to be notified in connection with such amendment, the notification shall be issued as the "final notice of reasons for refusal." Moreover, if the examiner notifies reasons for refusal that are identical with those stated in a notice of reasons for refusal of another patent application, the examiner shall give the Article 50bis notification as well.

4.2 If the notice of reasons for refusal is "final"

If an amendment is made in response to the "final notice of reasons for refusal" accompanied by the Article 50bis notification, the examiner shall re-examine whether it was appropriate to give the Article 50bis notification and issue the notice of reasons for refusal as "final," taking into consideration the applicant's arguments in written opinions, etc.,(see Note to 4.1).

The examiner shall judge whether it was appropriate to issue the notice of reasons for refusal as "final" shall be judged in accordance with 3.2.1 of "Part I Chapter 2 Section 3 Notice of Reasons for Refusal."

4.2.1 If at least either the giving of the Article 50bis notification or the issuance of the notice as "final" was appropriate

The examiner shall examine whether the amendment made in response to the notice of reasons for refusal accompanied by the Article 50bis notification complies with any of the provisions of paragraphs 3 to 6 of Article 17bis. If the examiner determines that it is in violation of any of these provisions, he or she shall decide to dismiss the amendment. See "Part IV Amendments of Description, Claims or Drawings" for detailed guidelines on judgment as to the conformity of such amendment to these provisions.

(Point to consider)

If it was inappropriate to issue the notice of reasons for refusal as "final," but it was appropriate to give the Article 50bis notification at the time it was given, any subsequent amendment must still meet the provisions of paragraphs 3 to 6 of Article 17bis even if such amendment would cause the application concerned to cease to satisfy the substantive requirements for division, making it and another application at issue no longer qualified to be deemed to have been filed simultaneously.

The same applies if, following the Article 50bis notification for the application concerned, another patent application at issue is amended and ceases to satisfy the substantive requirements for division, making it and the application concerned no longer qualified to be deemed to have been filed simultaneously.

For the specific examination procedure in the case where at least either the giving of the Article 50bis notification or the issuance of the notice as "final" was appropriate, the examiner shall observe the following 3. to 5. of "Part I Chapter 2 Section 6 Decision of Dismissal of Amendment."

In so doing, the examiner shall read "final notice of reasons for refusal" in these guidelines as "final notice of reasons for refusal accompanied by the Article 50bis notification."

For the sake of clarity, if the examiner gives a renewed notice of reasons for refusal in accordance with 4.(3) or 5.(3) of "Part I Chapter 2 Section 6 Decision of Dismissal of Amendment," then the examiner shall examine whether or not to issue the notice as "final," and whether or not to give the Article 50bis notification as well, in accordance with 2. and 3. .

4.2.2 If both the giving of the Article 50bis notification and the issuance of the notice as "final" were inappropriate

The examiner shall accept the amendment without dismissing it.

Moreover, if the previously notified reasons for refusal are not resolved in the application as so amended, the examiner shall give another "non-final notice of reasons for refusal," rather than immediately refusing the application.

If the examiner is to give notice of only the reasons for refusal that need to be notified in connection with the amendment, the examiner shall issue it as another "non-final notice of reasons for refusal," rather than as the "final notice of reasons for refusal." Moreover, even in the case where the examiner notifies reasons for refusal that are identical with those stated in a notice of reasons for refusal of another patent application, the examiner shall not give the Article 50bis notification.

(Point to consider)

If it is found that an amendment is being made by the applicant asserting and assuming that the Article 50bis notification should not have been given as the reasons for refusal of the patent application and another patent application at issue are not considered to be identical, or

on any other grounds, and that the notice of reasons for refusal should have been issued as "non-final," then the examiner shall treat the amendment as if the Article 50bis notification had not been given and the notice had been issued as "non-final."

In other words, if the previously notified reasons for refusal are not resolved in the application as so amended, the examiner shall refuse it.

If the examiner is to give notice of only the reasons for refusal that need to be notified in connection with such amendment, the notification shall be issued as the "final notice of reasons for refusal." Moreover, if the examiner notifies reasons for refusal that are identical with those stated in a notice of reasons for refusal of another patent application, the examiner shall give the Article 50bis notification as well.

Figure Procedure of examination where an amendment is made in response to a notice of reasons for refusal accompanied by the Article 50bis notification

