

20.03

Operating Procedures for the Case in Which Applicants Request Extension of the Specified Time Limit for Responding to a Notification of Reasons for Refusal by a Written Statement

Operating procedures for extension of the specified time limit for responding to a notification of reasons for refusal were modified following the enforcement of the Act for Partial Revision of the Patent Act and Other Acts (Act No. 55) on April 1, 2016.

The following procedures will be taken in a case where there has been a request for extension of the specified time limit for responding to a notification of reasons for refusal, a written instruction of submission of evidence, or a written instruction of consultation, by filing a written statement or other means (*1) but not through procedures for requesting extension of the time limit after April 1 of the same year.

(*1) Request by a written statement or other means refers to a request by a written statement, by a written opinion, in an interview, or over the phone, which are methods other than that by a written request for extension of the time limit.

For instance, a case where there are reasonable grounds to suspend the examiner's decision because of the relation with the cited trademark, etc., such as a case where the trademark cited in a notification of reasons for refusal is pending in an appeal against the examiner's decision of refusal, trial for cancellation, etc., is excluded as a subject of the following items, but a grace of examiner's decision is granted.

1. In a case where there is a response by a written statement, etc. within the specified time limit or after the expiration of the specified time limit, and it is judged from the contents of the written statement, etc. that extension of a time limit for responding to a notification of reasons for refusal is obviously requested, the examiners will encourage the applicants to promptly file a written request for extension of period (see reference) by a written notice.

In a case where there is a request for extension of the specified time limit for responding to a notice of reasons for refusal in an interview or over the phone, the examiners will orally encourage the applicants to file a written request for extension of period, and enter the statement to that effect in the record of interview or the record of contact.

2. In a case where extension of the specified time limit for responding to a notice of reasons for refusal was requested by a written statement, etc. mentioned in 1 and at the same time a written request for extension of period or a written opinion was not filed even when one month has passed after a written notice was sent, the examiners will send the second written notice promptly after due consideration of the contents of a written statement, etc.

In the second written notice, examiners will demand the applicants to submit reports or data which provide evidence for the circumstances pertaining to the extension of the time limit for response such as materials which certify the matters concerning negotiation on transfer (*e.g.*, e-mails, transfer agreements in the process of creation, etc. (confidential matters may be masked)), materials which were prepared for providing evidence for use or intention of use concerning the main paragraph of Article 3 (1), and materials which indicate preparation, etc. of certificate documents concerning Article 3 (2), and others including a written opinion, etc. which explain specific progress of the above procedures.

3. In a case where the written request for extension of period and reports and data responding to the second written notice were not submitted, the examiners will proceed with examination two months after the expiration of the specified time limit for responding to a notice of reasons for refusal.

In a case where materials were submitted in response to the second written notice but the contents are insufficient, and where applicants request for further extension of period, examiners will proceed with examination for a certain period of time upon due consideration of the details of materials submitted by the applicants.

Provided however, in a case where there are reasonable grounds even if more than six months have passed after the expiration of the specified time limit for responding to a notice of reasons for refusal, this does not apply.

<Reference>

- (1) Request for extension of period within the specified time limit for response

Whether the applicant is a domestic resident or an overseas resident, a one-month extension of the specified time limit for response can be granted by filing a written request for extension of period. The applicant needs to pay a fee of 2,100 yen when requesting the extension of the said time limit.

- (2) Request for extension of the specified time limit for responding to a notice of reasons for refusal after the expiration of the time limit

Whether the applicant is a domestic resident or an overseas resident, a two-month extension can be granted if a request for extension is filed within two months even after the expiration of the specified time limit for responding to a notice of reasons for refusal.

The applicant needs to pay a fee of 4,200 yen when requesting the extension of the said time limit.