

## 1. Appeal Against an Examiner's Decision of Refusal

### (i) Amendments to an appeal against an examiner's decision of refusal

<<Amendments to descriptions, etc.>>

**Q1:** What kind of amendment to description, etc. may be submitted at the time of requesting an appeal against an examiner's decision of refusal?

**A1:** At the time of requesting an appeal against an examiner's decision of refusal, it is possible to amend the description, the scope of claims for patent, or drawings attached to the patent application, at the same time as the request for an appeal against an examiner's decision of refusal. (In the case of designs and trademarks, it is possible to make amendments at any time while the appeals are pending.) Here, amendments can be made within the scope of matters described in the description, the scope of claims for patent, or drawings originally attached to the application (in the case of a foreign language written application, the translation of the foreign language document) (Patent Act §17-2 (3)). However, some restrictions are placed on, for example, the purpose of the amendments (Patent Act §17-2 (4), (5)).

When amendments are made to the scope of claims for patent at the appeal, it is necessary to submit a written amendment with the full text of the scope of claims for patent, rather than to submit a written amendment with the amended claims only (Regulations under the Patent Act, Form No. 13, Note 7).

<<Meaning of "at the same time">>

**Q2:** As for the timing requirements for submitting an amendment accompanying a request for an appeal, does "at the same time" have the meaning of "on the same day"? When filing online, is it also acceptable to make submissions "on the same day"?

**A2:** As stipulated in Patent Act Article 17-2, paragraph 1(iv), when amendments are made to descriptions, etc. accompanying a request for an appeal, written amendments must be submitted "at the same time" as the request for an appeal, not "on the same day" (Please refer to Chapter 61-05 2. (4) of the Manual for Trial and Appeal Proceedings regarding how to simultaneously submit amendments).

In the case of submitting amendments by using an electronic information processing system, please place all outgoing files to be sent at the same time in the [Outgoing File Folder], select all of these files, and, with the files selected, click the [Apply Online] button.

**Q3:** When a request for an appeal and an amendment (and/or divisional application) was not submitted "at the same time," what steps should be taken?

**A3:** If an amendment was not submitted at the same time as the request for an appeal, the amendment will be dismissed. Therefore, the request for the appeal will undergo appeal examination of its pre-amendment content by the panel, without undergoing reconsideration by the examiner before appeal proceedings. If the applicant wishes that proceedings (and/or reconsideration by the examiner before appeal) be conducted based upon the amended content, the applicant must make a request for an appeal again within

the prescribed period for appeal, where the applicant must submit the amendment (or divisional application) “at the same time.”

In this case, the fee for the request for the appeal will not be returned even if the request for the appeal is withdrawn.

<<In the case of communication trouble, failure, etc.>>

**Q4:** When filing online, what happens if a request for an appeal and an amendment (and/or divisional application) could not be sent “at the same time” due to communication trouble, etc.? For example, if an outgoing transmission is interrupted and one document is sent before the interruption and another is sent after the interruption, will both be deemed as having been submitted “at the same time”?

**A4:** The provisions of the Patent Act clearly specify that a request for an appeal and an amendment must be submitted “at the same time.” In a case where communication trouble, etc. occurred when you were submitting documents online, the submission will be judged on a case-by-case basis in accordance with the Patent Act, etc.

<<Amendments to design or trademark applications/ new applications following dismissal of amendments>>

**Q5:** In the case of an appeal against an examiner’s decision of refusal of a design or a trademark application, is an amendment possible only “at the same time” as the request for an appeal?

**A5:** The prescribed period for requesting an appeal for designs or trademarks is the same as that for patents, namely “within three months.” However, unlike patents, in the case of designs and trademarks there is no timing restriction for amendments accompanying a request for an appeal, and it is possible to make amendments at any time while the examination or the appeal is pending.

**Q6:** Following an examiner’s decision dismissing an amendment at the stage of an appeal against an examiner’s decision of refusal of a design or a trademark, what is the prescribed period during which a new application can be filed?

**A6:** When an amendment has been dismissed at the stage of the appeal against an examiner’s decision of refusal of a design or a trademark, a new application for a design or a trademark following the dismissal of the amendment at the appeal stage can be filed “within thirty days” from the date on which a certified copy of the examiner’s decision of dismissing the amendment has been served.

<<Calculation of the fee for request for appeal when submitting an amendment “at the same time”>>

**Q7:** When submitting an amendment “at the same time” as a request for an appeal, is the “number of claims” calculated for the fee of a request for an appeal, etc. the number at the time of the decision of refusal, or the number after the amendment?

**A7:** The fee will be in accordance with the number of claims after an amendment that is made at the same time as the request for an appeal. At that time, please insert the field

[Number of claims] on the Written Request for Appeal and provide the number of claims after the amendment (Chapter 61-05 2. (5) of the Manual for Trial and Appeal Proceedings).

If the number of claims at the time of the request for an appeal increases above the number of claims that formed the basis of an application examination request fee that has already been paid, with the result that said fee is no longer sufficient, then a fee for the application examination request will be required (Chapter 21-09 of the Manual for Trial and Appeal Proceedings). However, please note that amendments that increase the number of claims are often ruled unlawful in an appeal proceeding.

<<Relationship with amendments at the examination stage>>

**Q8:** In a case where an amendment has been submitted at the examination stage for the purpose of restricting the scope of claims for patent, is it possible to submit an amendment that restores the scope of claims for patent to that of the time of filing the application when requesting an appeal against an examiner's decision of refusal?

**A8:** Amendments submitted at the time of requesting an appeal against an examiner's decision of refusal in accordance with the Patent Act Article 17-2, Paragraph 1 (iv) must fall within the scope of matters written in the description, scope of claims for patent, or drawings that were originally attached to the application, as stipulated in Paragraph 3 of the same Article, and amendments concerning the scope of claims for patent must fulfill the requirements of each item of Paragraph 5 of the same Article. Normally, when an amendment is submitted in order to restore the scope of claims for patent to that of the initial application at the time of requesting an appeal against an examiner's decision of refusal after an amendment has been submitted at the examination stage for the purpose of restricting the scope of claims, the amendment at the time of requesting an appeal against an examiner's decision of refusal will fail to fulfill the requirements of each item in the Patent Act Article 17-2, Paragraph 5.

**Q9:** An examiner noted that an amendment to the scope of claims for patent that was submitted at the examination stage failed to comply with the Patent Act Article 17-2, Paragraph 3 (addition of new matters). However, since the amendment was left unchanged, an examiner's decision of refusal was issued. Under such case, when I request an appeal against the examiner's decision of refusal, does an amendment that deletes the new matters at the time of the request for an appeal fulfill the requirements stipulated in each item of the Patent Act Article 17-2, Paragraph 5?

**A9:** Even if you submit an amendment that deletes matters used to specify the invention that were deemed additions of new matters at the time of the request for an appeal, the deletion of matters used to specify the invention corresponds to expansion of the scope of claims for patent, and thus such amendment is normally deemed to not fulfill the requirements for purpose of the amendment (the requirements of each item of Patent Act §17-2 (5)). However, it is possible to submit an amendment that deletes the claim itself containing such description (Patent Act §17-2 (5) (i)).

**Q10:** At the examination stage, an examiner dismissed an amendment and issued a decision of refusal. I want to object to the dismissal of the amendment and intend to make an appeal against the examiner's decision through a request for appeal. The dismissed amendment was the best that I could make, and therefore, I wish to obtain a patent right with this content. What particular points should I heed?

**A10:** To make the subject of the appeal proceedings clear, it is advisable to state an objection to the examiner's decision to dismiss the amendment at the same time as the request for appeal, after having resubmitted an amendment with the same content as the dismissed amendment. However, without submitting an amendment at the time of a request for an appeal, it is also possible to state an objection to the examiner's decision of refusal in the Written Request for Appeal while simultaneously stating an objection to the examiner's decision to dismiss the amendment of the previous examination (Chapter 61-05 of the Manual for Trial and Appeal Proceedings).

<<Amendments that increase the number of claims>>

**Q11:** When submitting amendments at the time of requesting an appeal against an examiner's decision of refusal, is it possible to submit an amendment that substantially increases the number of claims, as long as the amendment does not expand or change the scope of claims for patent?

**A11:** The provision of the Patent Act Article 17-2, Paragraph 5 (ii) stipulates amendments for the purpose of restriction of the scope of claims where the restriction means to restrict matters to identify the invention stated in a claim or claims, with claims prior to an amendment remaining substantially identical with those after the amendment. An amendment which divides an invention described in a single claim into multiple claims and adds new claims does not correspond to the "restriction of the scope of claims for patents" stipulated in the aforementioned item (ii), even if the amendment as a whole restricts matters specifying the invention described in one claim. However, in a case where a single claim described in multiple dependent form is made into a claim in independent form with cited claims reduced, or in a case where a single claim whose components are described as alternatives is made into multiple claims with each of the alternative components restricted, it is possible to submit an amendment that increases the number of claims if these are in a substantial one-to-one correspondence relationship. (Reference: Intellectual Property High Court (Case Number: 2005 (Gyo-Ke) 10192), Tokyo High Court (Case Number: 2003 (Gyo-Ke) 230))

<<Amendments during the period of response to a notice of reasons for refusal>>

**Q12:** In an appeal against an examiner's decision of refusal, is the submission of amendments in response to a notice of reasons for refusal not restricted by the Patent Act Article 17-2, Paragraph 5?

**A12:** Since an appeal is a rehearing of an examination, whether a notice of reasons for refusal corresponds to "first" or "final" is determined with the procedures of the

examination stage taken into account. For that reason, if the notice is given only for matters required by an amendment in response to the first notice of reasons for refusal that was issued at the examination stage, the notice will be the final notice of reasons for refusal even in the case of a notice of reasons for refusal that is issued for the first time after a request for an appeal against an examiner's decision of refusal. In this case, the amendment will be subject to the restrictions of each item of the Patent Act Article 17-2, Paragraph 5, in the same manner as an amendment that is submitted at the time of a request for an appeal.

<<Request for an opportunity for amendment>>

**Q13:** In an appeal against an examiner's decision of refusal, is it possible to state via written report or to explain by phone or FAX that a draft of amendments has been prepared, without submitting amendments to the description, etc. at the time of requesting the appeal?

**A13:** An opportunity for amendment may be requested by written report, phone, or FAX. However, the decision of whether to accept the request is at the discretion of the panel. The Trial and Appeal Department, in principle, allows applicants to submit amendments only at the time of requesting the appeal, not granting opportunities for unnecessary amendments at the appeal stage. Accordingly, when the panel has decided that it can uphold a decision of refusal, it will issue that decision without granting an opportunity to make amendments. As such, please be aware that requests for an opportunity to make amendments at the appeal stage of a trial examination are unlikely to be approved.

(ii) Others

<<Divisional application>>

**Q14:** Should a divisional application also be filed "at the same time as", not "on the same day as", a request for appeal?

**A14:** A divisional application can be filed "within three months" from the date of service of a certified copy of the examiner's decision of refusal, regardless of whether you make a request for appeal (Patent Act §44 (1) 3). However, if you file a divisional application based on an application filed before April 1, 2007, it is necessary to file not "on the same day as" but "at the same time as" the request for an appeal, as stipulated in Article 17-2, paragraph 1 (iv) of the Patent Act.

**Q15:** How does the JPO handle a divisional application that is filed "on the same day as," not "at the same time as," a request for an appeal?

**A 15:** In a case of a divisional application based on an application filed before April 1, 2007, if it is not filed "at the same time as" the request for an appeal, it will be dismissed.

In a case of a divisional application based on an application filed on or after April 1, 2007, even if it is not filed "at the same time as" the request for an appeal, it will not be dismissed if it is filed "within three months" from the date of service of a certified copy of the examiner's decision of refusal.

<<Transfer to pre-appeal phase/Cancellation of pre-appeal proceedings>>

**Q16:** I received a notice of transfer to pre-appeal phase. What does this mean?

A16: In a case where amendments have been submitted at the time of requesting an appeal, examiners should conduct a reexamination of the application with the amended description to determine whether or not the granting of a patent is possible before the trial examination by the panel begins (Patent Act §162). In order to initiate reexamination by examiners, a notice of transfer to pre-appeal phase is sent to the requester of the appeal or to the agent thereof when the case is transferred from the Trial and Appeal Department to the Examination Department. As a result, the examiner will revoke the original decision and will make a decision to grant the patent (patent registration granted before appeal proceeding: Patent Act §164 (1)) or will decide to uphold the original decision, and will then report the result of the pre-appeal proceedings to the Commissioner (report of pre-appeal proceedings: Patent Act §164 (3)).

**Q17:** I received a notice of cancellation of pre-appeal proceedings. What does this mean? Also, can you inform me of subsequent progress status?

A17: A notice of cancellation of pre-appeal proceedings is sent to the requester of the appeal or to the agent thereof when the result of the pre-appeal proceedings is reported to the Commissioner (Patent Act §164 (3)). Upon the submission of the report of pre-appeal proceedings, the JPO Commissioner will direct an administrative judge to try the appeal case (Patent Act §137 (1)). In other words, when the pre-appeal proceedings are cancelled, the validity of the original decision by the examiner will be left to the discretion of the panel. Regarding the progress status of the appeal examination, please contact us via Inquiry for [Appeal Examination Status](#).

<<Submission of evidence after notification of the closing of appeal examination has been issued >>

**Q18:** I received a notice of the closing of appeal examination. Is this notice always sent to the requester of an appeal? Also, is it not possible to submit evidence after we have received this notification?

A18: A notice of the closing of appeal examination (Patent Act §156 (1)) announces to the requester of an appeal that a decision on the appeal will soon be made. However, when the decision upholds an appeal against an examiner's decision of refusal, a notice of the closing of appeal examination is normally not sent, as its omission is not considered to be disadvantageous to the requester of the appeal.

If the applicant submits a written appeal brief after receiving the notice of the closing of appeal examination, the document will not be subjected to examination. However, even after the notice of the closing of appeal examination has been issued, appeal examination may be reopened by petition from parties concerned, or *ex officio*, if recognized as necessary by the chief administrative judge (for example, when investigation of key evidence has not been completed, when written appeal brief or amendment has been submitted at the same time that the notice of the closing of appeal examination has been sent, etc.). However, please note that appeal examination will not

be reopened if there is not appropriate reason to do so, even if requested by petition.

<<Request for interview before the start of appeal examination>>

**Q19:** If I wish to apply for an interview with an examiner before the start of proceedings in an appeal against an examiner's decision of refusal, when would be the deadline to do so?

**A19:** If you wish to request an interview with an examiner before the start of proceedings in an appeal against an examiner's decision of refusal, please submit a request in writing (i.e., a written statement) , stating the desire for an interview as early as possible.

<<Accelerated appeal examination>>

**Q20:** When an application is subjected to accelerated examination at the examination stage, is it automatically eligible for accelerated appeal examination?

**A20:**

In order that an application that has been subjected to accelerated examination can be eligible for accelerated appeal examination, you need to file a request for accelerated appeal examination separately from a request for accelerated examination. Similarly, if you wish to request accelerated handling at the pre-appeal phase, you also need to file for accelerated appeal examination.

<<Extension of the period for requesting appeal against an examiner's decision of refusal>>

**Q21:** Is it possible to receive an extension of the period for filing a request for an appeal examination?

**A21:** A request for the extension of the period will not be approved. However, in a case where an applicant is an overseas resident, the period for requesting an appeal against an examiner's decision of refusal (with the exception of an appeal against an examiner's decision of refusal of an application for the registration of extension of the duration of a patent right) is extended *ex officio* by 1 month, and therefore the period for requesting an appeal against an examiner's decision of refusal is within 4 months from the date of delivery of a certified copy of the examiner's decision of refusal. As this is an *ex officio* extension, you do not have to submit a written request, etc. for the extension of the period.