

61-04 P D T**Procedures for Filing a Request for Appeal Against Examiner's
Decision of Refusal**

1. Written Request for Appeal

(1) General

A. A person who files a request for appeal against examiner's decision of refusal should submit a written request for appeal satisfied with the formal requirements under Patent Act Article 131 (Enforcement Regulations of the Patent Act Article 46 (Form 62), Enforcement Regulations of the Design Act Article 14, Enforcement Regulations of the Trademark Act Article 14).

B. Required items and formality of a written request (→21-00~08)

(2) Purport of the request (Patent Act Article 131(1)(iii), Design Act Article 52, Trademark Act Articles 56(1), 68(4))

A. A purport of the request indicates what kind of appeal decision an appellant seeks for and should specify a patent application subject to the request.

B. An item "Purport of Request" generally describes "The original decision shall be revoked. An appellant seeks the appeal decision that the present invention of the case should be patented."

(3) Grounds for the request (Patent Act Article 131(1)(iii), Design Act Article 52, Trademark Act Articles 56(1), 68(4))

A. Grounds for the request describe the grounds for revocation of the decision of refusal corresponding to the purport of the request.

B. An item "Grounds for Request" describes a history and points of the grounds for the decision of refusal, and grounds for revocation of the decision of refusal concretely and clearly (→21-03 1.).

C. When the specification, claims or drawings are amended with submission of a request for appeal, describe the grounds for revocation of the decision of refusal based on the amended specification, claims and drawings.

D. An appeal against examiner's decision to dismiss amendment of the patent application made at the examination stage may be instituted together at filing an appeal against examiner's decision of refusal (Patent Act Article 121) (Patent Act Article 52(3)).

An appeal against examiner's decision to dismiss amendment made at the appeal stage may be instituted at a suit rescinding the appeal decision of the appeal against examiner's decision of refusal (Patent Act Article 178) (Patent Act Article 159(1) → Patent Act article 53(3)).

E. When an appeal against examiner's decision to dismiss amendment made in the examination is filed and no amendment is made for the specification, claims, or drawings at requesting an appeal, describe a dissatisfaction of an appellant with the decision, and grounds for revocation of the decision to dismiss the amendment, and then describe grounds for revocation of the decision of refusal based on the amended specification, claims and drawings.

F. When an appeal against examiner's decision to dismiss amendment made in the examination is filed and an amendment is made for the specification, claims, or drawings, describe the grounds for revocation of the decision of refusal based on the amended specification, drawings and drawings made at the requesting an appeal. An amendment at filing a request for appeal is made for the specification, claims, or drawings which are subject to the decision of refusal. Matters dissatisfied with the decision to dismiss amendment are required to include in the amendment at filing a request for appeal. Namely, when the amendment same as one dismissed is made, a written amendment with the same content shall be submitted.

2. Proceedings of Written Request for Appeal, and Dismissal of the Request

by Decision due to Non-Compliance with Formal Requirements

(1) A chief administrative judge shall order an amendment when a written request for appeal against examiner's decision to refusal violates the provision under Patent Act Article 131(1) or corresponds to the provision under Patent Act Article 133(2) (Patent Act Article 133(1)(2), Design Act Article 52, Trademark Act Articles 56(1), 68(4)). If an appellant fails to amend, the written request for appeal shall be dismissed by decision (Patent Act Article 133(3), Design Act Article 52, Trademark Act Articles 56(1), 68(4)) (→21-02, 44-01).

(Note) For an appeal against examiner's decision of refusal for the patent application, if the specification, claims, or drawings are amended in filing a request for appeal (Reconsideration by examiner before appeal), the Commissioner of the JPO shall order an amendment (Patent Act Article 17(3)). If an appellant fails to do so, the request for appeal shall be dismissed (Patent Act Article 18).

3. Dismissal of Request by Appeal Decision

Even if a request for appeal does not violate the formality requirements of a written request (Patent Act Articles 131(1), 133(2)), when the request is unlawful request and may not be amended, the request shall be dismissed by appeal decision (Patent Act article 135, Design Act Article 52, Trademark Act Articles 56(1), 68(4)) (→21-02).

(Example 1) Where a request for appeal is filed after the period during which an appeal may be filed (Patent Act Article 121(1)(2), Design Act Article 46(1)(2), Trademark Act Article 44(1)(2)) (Clause example of appeal decision→45-20).

(Example 2) Where a request for appeal is not filed by all members of the joint owners of the right to obtain a patent (Patent Act Article 132(3) →22-03 3. (1), 61-02, Clause example of appeal decision 45-20)

(Example 3) Where more than one appeals against examiner's decision of refusal are filed for the same patent application, requests for appeal other than the first request (→45-19). However, when only one request is left and other requests are withdrawn before the requests for appeal other than the first request are dismissed by appeal decision, the remaining request for appeal becomes lawful.

4. Amendment for Written Request for Appeal

(1) When the appeal is pending before the JPO, the written request for appeal may be amended (Patent Act Article 17(1), Design Act Article 60-3, Trademark Act Article 68-4(1)). The amendment must not change the gist of the request. However, this does not apply to the grounds for the request (Patent Act Article 131-2 (1)(i), Design Act Article 52, Trademark Act Articles 56(1),68(4)) (→30-01).

(2) Determination of appropriateness of the amendment by the panel (→30-01).

(3) Handling of supplement of the grounds for request for appeal (→21-06).

5. Abandonment, Withdrawal (→43-01~43-05)

(Revised Feb 2015)