

**61-05.1 P**  
**Appeal Against Examiner's Decision of Refusal**  
**of a Patent Application**  
**Accompanied by (or not Accompanied by) Appeal Against**  
**Examiner's Decision to Dismiss Amendment**

1. Specification, Claims and Drawings Subject to Proceedings

(1) Not accompanied by an appeal against examiner's decision to dismiss amendment made in a prior decision (Patent Act Article 53(1)) (including a case where no decision was made to dismiss amendment in a prior decision)

A specification, claims and drawings subject to a decision of refusal are subject to proceedings. When an amendment is made at the time of filing an appeal, a specification, claims and drawings after amendment become a subject to proceedings.

(2) Accompanied by filing an appeal against examiner's decision to dismiss amendment in a prior decision

Even if there are no clear descriptions of an appeal against examiner's decision to dismiss amendment made in a prior decision, when an intention of appeal against the decision may be found from the entire application, for example, where an invention based on the amendment that was dismissed is indicated as the gist of the present invention, it would be handled as if there is an appeal against the decision.

A. An amendment was not made at the time of filing an appeal against the examiner's decision of refusal

(A) An appeal against examiner's decision to dismiss amendment is examined and when it is determined that the decision is unlawful, the proceedings thereafter are proceeded on the premise of revocation of the decision. Whereas when it is determined that the decision is lawful, a specification,

claims and drawings after the decision of dismissal (i.e., a specification, claims and drawings at the time of the decision of refusal) are subject to the proceedings afterward.

(B) When a notice of reasons for refusal is issued in appeal, it should be clarified in the notice that the reasons for refusal are issued based on which specification, etc. in relation to determination whether the decision to dismiss amendment is lawful (→61-05 4. (1)E).

(C) A determination whether the decision to dismiss amendment in a prior decision is appropriate is described in the reasons for appeal decision (→61-07 2. (3)A, 45-01~20).

B. An amendment was made at the time of filing an appeal against the examiner's decision of refusal

(A) An amendment in filing an appeal is made subject to a specification, claims and drawings after the decision to dismiss amendment (i.e., a specification, claims and drawings at the time of the decision of refusal). A specification, claims and drawings amended in filing an appeal are subject to the proceedings.

(B) When determining an amendment in filing an appeal, reasons for appeal against the decision to dismiss amendment shall be considered.

(C) When an amendment in filing an appeal should be dismissed, the proceedings thereafter are proceeded with a specification, claims and drawings at the decision of refusal.

## 2. Point of View About Subject of Proceedings Requested by an Appellant When Accompanied by an Appeal Against Examiner's Decision to Dismiss Amendment in the Prior Decision

(1) An amendment was not made at the time of filing an appeal against the examiner's decision of refusal

(Subject to proceedings)

A specification, claims and drawings amended by the amendment dismissed by the decision

(Point of view)

A purport of the law that “an appeal against examiner’s decision to dismiss amendment may be filed in an appeal against examiner’s decision of refusal” is interpreted as “the decision to dismiss amendment is found to be unlawful and based on this decision the determination of patentability on a specification, claims and drawings before amendment that was dismissed is found to be unlawful. Therefore, it is requested to determine patentability on a specification, claims and drawing amended by the dismissed amendment.”

(2) An amendment was made at the time of filing an appeal against the examiner’s decision of refusal

(Subject to proceedings)

A specification, claims and drawings amended by amendment in filing an appeal

(Point of view)

At the time of filing an appeal, dismissal of amendment is valid and a specification, etc. amended by the dismissed amendment is not used as a basis for amendment in filing an appeal.

A purport of the law that “an appeal against examiner’s decision to dismiss amendment may be filed in an appeal against examiner’s decision of refusal” is to “substantially guarantee an opportunity to file an appeal against examiner’s decision to dismiss amendment.” It is interpreted as “when filing an amendment at the time of filing an appeal, it is sufficient to allow to file an appeal against the dismissal of amendment at the time of filing the same amendment again as the amendment dismissed at the time of filing an appeal.”

(Therefore, when determining whether an amendment in filing an appeal satisfies the requirements of amendment based on the specification, etc. before amendment that was dismissed, an argument of the appellant against

the decision of dismissal of amendment stated in the written request for appeal will be considered. When the amendment was dismissed in filing an appeal, the specification, etc. before amendment that was dismissed in the examination (subject to the decision of refusal) become a subject to the proceedings thereafter.

According to this handling, at the time of filing an appeal, when an appeal against examiner's decision to dismiss amendment is filed with an amendment that makes only the part not related to the amended items which was dismissed in the prior examination, an appeal against examiner's decision to dismiss amendment is not substantially examined since the specification, etc. subject to the examination do not include the amended items to be examined about the appeal against the examiner's decision to dismiss amendment. In this case, considering the reasons for the appeal, an intention of an appellant is confirmed by means of an inquiry, etc. and if necessary, a panel gives an opportunity of amendment to an appellant.

(Revised Feb 2015)