

61-05 P D T**Examination of a Request for Appeal Against Examiner's
Decision of Refusal**

1. Effects of Procedures that Were Made in Examination

The procedures made in the examination have effects on an appeal against examiner's decision of refusal (Patent Act Article 158, Design Act Article 52, Trademark Act Articles 56(1), 68(4)).

2. Amendment in Filing a Request for Appeal

(1) When a request for appeal against examiner's decision of refusal of patent application is filed, the following items may be amended for the specification, claims, or drawings attached to the application only if the amendment is made at the same time of filing an appeal (Patent Act Article 17-2(1)(iv)).

A. Allowable scope of amendment of the claims (Patent Act Article 17-2(5))

(A) Deletion of claim(s)

(B) Restriction by limitation of claim(s) (→Addition of the number of claims, see (2003 (Gyo-ke) 230), Judgment of Tokyo High Court, April 14, 2004; (2005 (Gyo-ke) 10192), Judgment of IP High Court, April 25, 2005)

(C) Correction of clerical error

(D) Clarification of ambiguous descriptions about matters pointed out in the reasons for refusal

Regarding (B), restriction by limitation of claim(s), the amended claim(s) should be patented independently upon the filing of the patent application (Patent Act Article 17-2(6)→Patent Act Article 126(7)).

B. An amendment may not be made to the specification, claims or drawings by adding new matters which are beyond the scope of the specification, claims or drawings (or in case of a foreign language application, a translation)

originally attached to the application (Patent Act Article 17-2(3)).

However, when an amendment is made by a correction for an incorrect translation, the amendment beyond the scope of the matters described in the translation is permitted if the amendment falls within the scope of the matters described in a foreign language application (Patent Act Article 17-2(3)).

C. An invention for which a determination has been made as to whether it may not be patented in a notice of reasons for refusal received before the amendment at the time of request for appeal may not be amended to change into another invention with a different technical feature of the invention (Patent Act Article 17-2(4)).

D. An amendment not satisfied with the requirements of A., B., C. shall be dismissed (Patent Act Article 159(1)→Patent Act Article 53).

(2) Regarding an application of design registration, an amendment may be made as long as the application is pending to an appeal (Design Act Article 60-3) (→6. (2)).

(3) Regarding an application for trademark (defensive mark) registration, designated goods or services described in the application, or a trademark (mark) for which a trademark (defensive mark) registration is sought may be amended under the provision of Trademark Act Article 68-40(1). However, if the amendment changes the gist related thereto, the application shall be dismissed under the provision of Trademark Act Article 16-2(1) applied mutatis mutandis to Trademark Act Articles 55-2(3), 68(2). The fact that such an amendment is not allowable is the same as examination. An amendment restoring designated goods or services that have been amended by restriction once is considered to cause a change of the gist thereof.

(4) An amendment made at the same time of requesting an appeal is proceeded as below.

A. Submission of the documents to a reception counter of the JPO: a request for appeal and a written amendment are submitted together at once.

B. Submission of the documents by mail, etc.: a request for appeal and a written amendment are sent by one envelope.

C. Submission via the electric information processing system: a request for appeal and a written amendment are entered in succession. Specifically, store all files to send at the same time in a [file folder to send], select all files to send, and then click an [online application]button.

(5) When an amendment to delete claims is made at the same time of filing an appeal, “the number of claims” which is a basis of calculation of appeal fees is the number of amended claims. In this case, provide an item [the number of claims] in a written request for appeal and describe the number of claims after amendment therein.

(6) When an amendment is made after service of a certified copy of the first decision of refusal for a patent application, the entire text of the claims must be amended as a unit (Enforcement Regulations of the Patent Act. Form 13, Remarks 7).

Then, an amendment of the claims at the time of requesting an appeal and in an appeal should be made in the entire text of the claims as a unit, not each claim as a unit.

3. Reconsideration by Examiner Before Appeal (Patent Act Articles 162~164)

(1) If an appeal against examiner’s decision of refusal for patent application is filed and, at the same time of filing the appeal, an amendment is made to the specification, claims or drawings attached to the written application, the Commissioner of the JPO shall have an examiner examine the filing (Reconsideration by examiner before appeal) (Patent Act Article 162).

(2) If reconsideration by examiner before appeal is made, an appellant shall be notified to that effect.

(3) Except in a case where an examiner reaches the decision to the effect that a patent is to be granted, the examiner shall report the results of the

examination to the Commissioner of the JPO without making a decision on the appeal (Patent Act Article 164(3)).

(4) In the case of (3), a panel comprising of administrative judges examines the appeal and notifies an appellant to that effect.

4. Notice of Reasons for Refusal in this Appeal

(1) Appeal against examiner's decision of refusal of patent application

A. When a reason different from the reason stated in the decision of refusal is found, a panel should notify all reasons found in the examination and give an appellant an opportunity to file a written opinion by specifying a reasonable period. This does not apply when an amendment is dismissed at the time of filing a request for appeal, or after filing an appeal and the amendment is against the final notice of reasons for refusal (→C.) (Patent Act Article 159(2)→Patent Act Article 50).

(Example) When it becomes clear at the appeal stage that an amendment made at the examination stage violates the amendable scope against the final notice of reasons for refusal, said amendment is not dismissed (Patent Act Article 159(1)→Patent Act Article 53), but when the violation is an addition of new matters, a reasons for refusal (Patent Act Article 49(1)(i)) shall be notified in this appeal (→5. (1)).

B. In notifying a reason for refusal, except the reason that may not be determined on a claim-by claim basis (such as description deficiencies in the entire specification, addition of new matters, etc.), a reason for refusal due to lack of novelty or inventive step indicates per claim, and each claim is clarified in a reason for refusal to identify the claim found or not found a reason for refusal.

C. In reasons for refusal in this appeal, a notice of reasons for refusal which includes reasons exiting from the original application and reasons that should have been pointed out in the non-final reasons for refusal, in principle (Note

1), is equivalent to a notice of non-final reasons for refusal provided in Patent Act Article 17-2(1)(i). When only the reasons for refusal which are necessitated by amendment made in response to a previous non-final notification of reasons for refusal are notified, the notice is equivalent to the final notice of reasons for refusal provided in Patent Act Article 17-2(1)(iii). (Note 1) In this appeal, (A) a notice of reasons for refusal notified when there are no deficiencies except minor defects of descriptions in the specification and (B) a notice of reasons for refusal notified when claims which were not examined due to not to meet the requirements of the unity of invention, are the final notice of reasons for refusal. These reasons for refusal are considered a final notice of reasons for refusal even if they exist from the original application and they have not been notified in non-final reasons for refusal.

D. An amendable scope and handling of unlawful amendment are different depending on either non-final or final of a notice of reasons for refusal (→5. (1)). When a final notice of reasons for refusal is issued, indicate the notice is final.

E. In a case where an appeal is filed against a decision to dismiss the amendment made in the previous examination, and an amendment is not submitted in filing an appeal, when reasons for refusal are notified in this appeal, it should be clarified that the notice is issued based on either specifications, etc. in connection with the determination on whether the decision of dismissal of the amendment is lawful (→61-05.1 1. (2) A (B)). (2) An appeal against an examiner's decision of refusal of an application for design application, application for trademark registration and an application for defensive mark registration

When a reason for refusal different from one in the examiner's decisions of refusal is found, an appellant should be notified said reason and given an

opportunity to submit a written opinion by specifying a reasonable period of time (Design Act Article 50(3), Trademark Act Articles 55-2(1), 68(4)).

5. Amendment in this Appeal (Except When Filing a Request for Appeal)

(1) In an appeal against examiner's decision of refusal of a patent application, if a notice of reasons for refusal is notified, an appellant may amend the specification, claims or drawings (Patent Act Article 159(2)→Patent Act Article 50→Patent Act Article 17-2(1)(ii)).

A. When a notice of reasons for refusal notified in this appeal case corresponds to a "non-final notice of reasons for refusal" under Patent Act Article 17-2(1)(i) (Patent Act Article 159(2)→Patent Act Article 17-2(1)(ii)), the specification, claims or drawings (or in case of a foreign language application, a translation) attached to the application may be amended without adding a new matter (Patent Act Article 17-2(3)). However, when an amendment is made by a written correction for an incorrect translation, the amendment beyond the scope of the matters described in the translation is possible if the amendment falls within the scope of the matters described in a foreign language application (Patent Act Article 17-2(3)). An amendment that violates the requirements of amendment is subject to a reason for refusal (Patent Act Article 159(2)→Patent Act Article 50).

B. When a notice of reasons for refusal notified in this appeal corresponds to a "final notice of reasons for refusal" under Patent Act Article 17-2(1)(iii), a scope of amendment is the same as the scope at the time of filing a request for appeal (Patent Act Article 159(2)→Patent Act Article 17-2(1)(iii)→Patent Act Article 17-2(3)(4)(5)(6)). An amendment that violates the requirement of amendment shall be dismissed (Patent Act Article 159(1)→Patent Act Article 53) (→6.(1)).

(2) In an application for design registration, an amendment may be made when a case is pending with the examination, appeal, or re-appeal (Design Act

Article 60-3).

(3) In an application for trademark registration and for defensive mark registration, an applicant, regardless of notifying reasons for refusal in this appeal, may amend the designated goods or services, or a trademark (mark) for which the trademark (defensive mark) registration is sought. Even an application for trademark (defensive mark) registration was filed before March 31, 1997 may be similarly amended regardless of having served of a certified copy of the publication after examination or having filed a petition of opposition before registration (→2. (3)).

6. Decision of Dismissal of Amendment in this Appeal

(1) Appeal against examiner's decision of refusal of patent application

When an amendment in filing an appeal or an amendment after filing an appeal and against the final reasons for refusal is found not to comply with the provisions under Patent Act Article 17-2(3)(4)(5)(6) before the service of a certified copy of the decision to grant a patent, the amendment shall be dismissed (Patent Act Article 159(1) →Patent Act Article 53).

When it becomes clear at the appeal stage that an amendment made at the examination stage violates the amendable scope against a final notice of reasons for refusal, the amendment is not dismissed but if the violation falls under an addition of new matters, a reason for refusal (Patent Act Article 49(1)(i)) shall be notified in this appeal.

(2) Appeal against examiner's decision of refusal of application of design registration

A. When an amendment of descriptions of application, or drawings, photos, models or samples attached to the application changes the gist thereof, the amendment shall be dismissed (Design Act Article 50(1) →Design Act Article 17-2(1)).

B. When an amendment is dismissed, an appeal decision shall not be made

until 30 days have passed from the date on which a certified copy of the decision to dismiss the amendment is served (Design Act Article 50(1)→Design Act Article 17-2(3)).

C. When an appellant files an appeal for revocation of the decision to dismiss the amendment, the proceedings shall be terminated until said appeal becomes final and binding (Design Act Article 50(1)→Design Act Article 17-2(4)).

D. When an appellant files a new application for design registration with the amended design within 30 days from the date on which a certified copy of the decision to dismiss the amendment is served, the original application is deemed to have been withdrawn ((Design Act Article 50(1)→Design Act Article 17-3(2) and the appeal proceedings shall be concluded (→61-05 9.).

E. A suit may be instituted with the Tokyo High Court (the IP High Court) against the decision to dismiss the amendment made in this appeal (Design Act Article 59(1)).

(3) Appeal against examiner's decision of refusal of an application for trademark registration and an application for defensive mark registration

A. When an amendment of the designated goods or services described in the application or a trademark that is sought to obtain the trademark registration changes the gist thereof, the amendment shall be dismissed (Trademark Act Articles 55-2(3), 68(4) → Trademark Act Article 16-2(1)).

B. When an amendment is dismissed, an appeal decision must not be made until 30 days have passed from the date on which a certified copy of the decision to dismiss the amendment is served (Trademark Act Articles 55-2(3), 68(4) → Trademark Act Article 16-2(3)).

C. When an appellant files an appeal for revocation of the decision to dismiss the amendment, the proceedings must be terminated until said appeal becomes final and binding ((Trademark Act Articles 55-2(3), 68(4) → Trademark Act Article 16-2(4)).

D. When an appellant files a new application for trademark (defensive mark) registration with the amended trademark (defensive mark) within 30 days of the amendment from the date on which a certified copy of the decision to dismiss the amendment, the original application is deemed to have been withdrawn (Trademark Act Articles 55-2(3), 68(4) → Trademark Act Article 17-3(2)) and the appeal proceedings shall be concluded (→61-05 9.).

E. A suit may be instituted with the Tokyo High Court (the IP High Court) against the decision to dismiss the amendment made in this appeal (Trademark Act Article 63(1), 68(5)).

7. Appeal Decision (→61-07)

8. Conclusion and Resumption of the Proceedings (→42-00)

9. Handling of Appeal in Withdrawal or Abandonment of Application

When the application pending in appeal is withdrawn or abandoned, the procedures of the appeal shall be concluded and an appeal decision is not necessary to be issued.

(Revised Feb 2015)