

61-07 P D T**Appeal Decision of Appeal Against Examiner's Decision of Refusal**

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

(1) Types of appeal decision

A. When an appeal should be refused based on reasons for refusal of the original decision, an appeal decision to the effect that a request for appeal is groundless is rendered.

B. When it is determined that an appeal should not be refused based on reasons for refusal of the original decision, the appeal examination may be proceeded by applying the procedures of a notice of reasons for refusal, etc., to an appeal. As a result, when an appeal should be refused, an appeal decision is made to the effect that a request for appeal is groundless, whereas when reasons for refusal are not found, the original decision is revoked and an appeal decision is made to the effect that a request for appeal is approved (Patent Act Article 159(1)~(3). Design Act Article 50(1)~(3), Trademark Act Articles 55-2, 68(4)).

C. When it is determined that the original decision is revoked since an appeal should not be refused by reasons for refusal of the original decision, an appeal decision that further examination should be conducted may be also made (Patent Act Article 160(1), Design Act Article 52, Trademark Act Articles 56(1), 68(4)) (→1. (2)).

D. When a request for appeal is unlawful and may not be amended, an appeal is dismissed by appeal decision (→61-04 3.).

(2) Revocation of the original decision and remanded to examination

A. The Code of Civil Procedure regulates remanding of a case separately from necessary remand and voluntary remand (Code of Civil Procedure

Articles 307, 308) , whereas Paten Act, etc. regulates any remand is left to the discretion of administrative judges (Patent Act Article 160, Design Act Article 52, (Patent Act Article 160(1)(2) only applies mutatis mutandis), Trademark Act Articles 56(1), 68(4)).

B. Scope of remand

When it is determined in the proceedings of an appeal against examiner's decision of refusal that the case should not be refused by the reasons for refusal of the original decision, it is not desirable in terms of the administrative efficiency the fact that the original decision is revoked and the case is remanded to an examination immediately is to imply that a determination and a procedure that may be conducted in an appeal is conducted in an examination since the procedures of a notice of reasons for refusal, etc. are applied to an appeal. Therefore, in such a case the proceedings should be conducted in an appeal.

However, for the following cases, it is not appropriate to decide or cannot be decided by an appeal without remand, therefore, it is interpreted that the original decision is revoked and the case should be remanded to an examination.

(A) Where the substantial meaning of having two instances, an examination and an appeal trial, becomes meaningless if an appeal makes a decision without remand.

○ A substantial determination to the invention has not been examined, or the case is refused simply by formal reasons.

○ Indications of cited references have an error and the correct cited references are not known.

(B) Where it is illegal to decide by an appeal without remand

○ Examiner's decision of refusal is made without giving an opportunity to express an opinion.

2. Descriptions of Appeal Decision

(1) General matters for descriptions of appeal decision (→45-01~45-19)

(2) Basic ideas for descriptions of appeal decision

An appeal decision shows a final determination on an appeal case, and decides a disposition of the case. Therefore, even if an appeal decision is rescinded, it should be careful not to make an appeal decision in re-examination to the effect that a request for appeal is groundless due to other claims or other reasons for refusal except an unavoidable case where unexpected points are indicated in a court decision rescinding an appeal decision.

However, in the following cases, there is no need to make a decision based on the reason for refusal.

A. When a reason for refusal against one claim is denied by a court decision and if the reason for refusal against other claims is expected to dissolve, there is no need to make a decision based on the reason for refusal against said other claims (Court precedent: 2012 (Gyo-ke) 10341, 2010 (Gyo-ke) 10121).

B. When more than one reasons for refusal against one claim have not been dissolved, or when a reason for refusal against the entire specification and a reason for refusal against one claim have not been both dissolved, in principle, both reasons should be described in an appeal decision. However, when there is a risk of lacking consistency of an appeal decision if more than one reasons for refusal are described together, this shall not preclude a determination based on any one of the reasons for refusal.

(Note) After an appeal decision is rescinded, as results of re-examination, when a new reason for refusal is found by new evidence that is not binding a court decision, there is no illegality to make an appeal decision again based on the same conclusion.

However, even though an appeal decision is rescinded for one case, when an appeal decision to the effect that an appeal decision is groundless is repeated several times, as results of those, it should be noted that it makes a disposition of an appeal case delayed and an appellant may suffer a disadvantage.

When an appeal decision maintaining the original decision based on reasons for refusal made by an examiner may be rendered, it is sufficient to make an appeal decision only in the scope of the reasons for refusal made by the examiner. In that case, it is not necessary to examine other reasons for refusal *ex officio* deliberately.

(3) In an appeal against examiner's decision of refusal of patent application, descriptions of appeal decision in case of filing an appeal against examiner's decision to dismiss amendment made in the previous examination (Patent Act Article 53)

A. When an appeal against examiner's decision to dismiss amendment made in the previous examination is also filed, a determination whether to be appropriate of a decision to dismiss an amendment is not described in a conclusion of an appeal decision but in reasons for appeal decision (→61-05.1 1. (2) A (C)).

B. When an appeal against examiner's decision to dismiss amendment is also filed and an amendment was made at the time of requesting an appeal, a determination of an appropriateness of the amendment at the time of requesting an appeal results in a determination whether the decision to dismiss an amendment is appropriate (→61-05 1 1. (2) B).

A determination whether the amendment at the time of requesting an appeal is appropriate is described in reasons for appeal decision.

(4) Descriptions of appeal decision where a request is successful

An appellant may not file an appeal against an appeal decision where a request is successful. For this reason, an appeal decision of patent where a

request is successful describes necessary matters to cancel the original decision but not describe an interpretation of the claims more than necessary.

(5) Indication of conclusion (→45-04 5. (2)A)

3. Period until Appeal Decision Becomes Final and Binding (→46-00)

4. Effects of Appeal Decision

When an appeal decision revoking the original decision is remanded to an examination, the decision made in the appeal decision is binding upon the examiner on the case (Patent Act Article 160(2), Design Act Article 52, Trademark Act Articles 56(1) 68(4)).

5. Handling Fees and Burden of Costs

(1) Handling fees

A. Fees for an appeal should be paid under the provision of Patent Act Article 195 (2) (Design Act Article 67(2), Trademark Act Article 76(2)).

B. In this case, fees for an appeal against examiner's decision of refusal of patent application should be paid according to the number of claims.

(2) Burden of costs

The costs of an appeal against examiner's decision of refusal are borne by the appellant (Patent Act Article 169(3), Design Act Article 52, Trademark Act Articles 56(1), 68(4)).

(Revised Feb 2015)