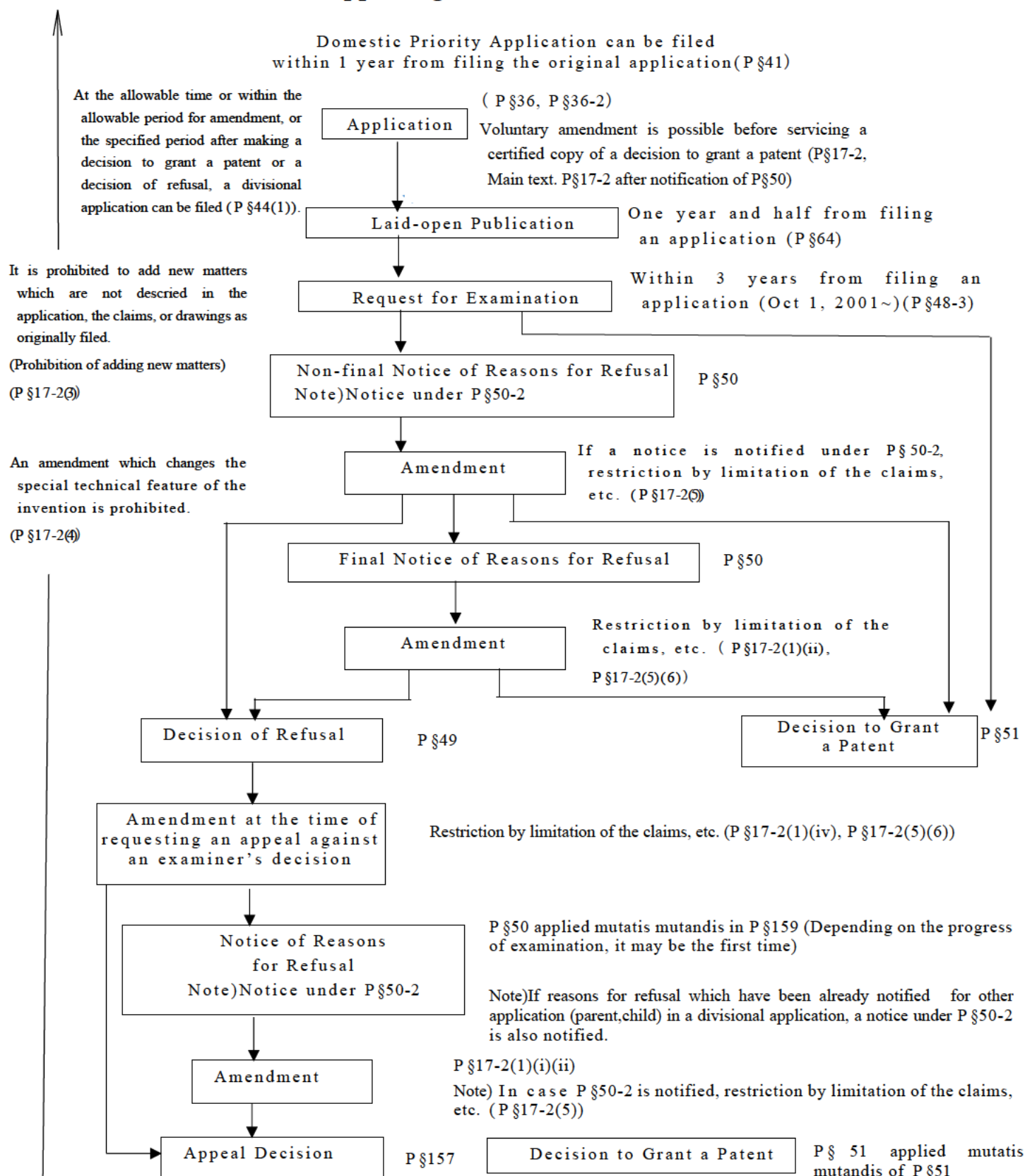


61-00.1 P

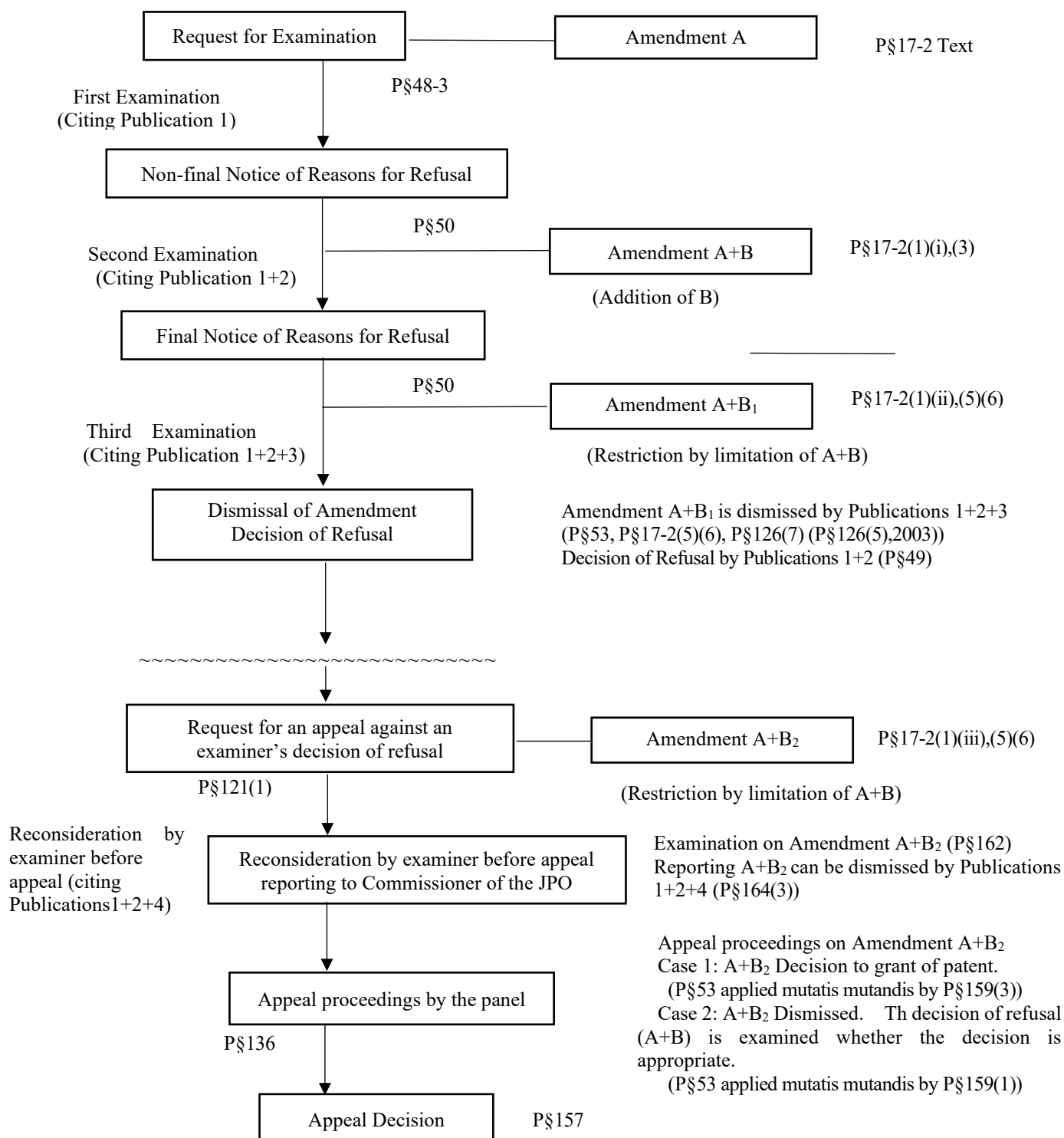
Basic Flow of Appeal Against Examiner's Decision of Refusal



(Revised Feb. 2015)

61-00.2 P

Simulated Cases for Patent Examination • Patent Trial



(Revised Feb. 2015)

61-01 P D T**Subject to Appeal Against Examiner's Decision of Refusal****1. Subject to Appeal**

An appeal against examiner's decision of refusal is to proceed further examination to decide an appropriateness of the decision when a person who has received a decision of refusal is dissatisfied with the decision. The procedures include reconsideration of the factual findings as well as interpretation or application of the law (Patent Act Article 121(1), Design Act Article 46(1), Trademark Act Article 44(1)).

A subject to an appeal against examiner's decision of refusal is a "decision to refuse".

2. An appeal against examiner's decision of refusal under the Trademark Act is shown below.

(1) Decision of refusal against an application of a trademark registration (including collective marks) (Trademark Act Article 15)

(2) Decision of refusal against an application of a defensive mark registration (Trademark Act Article 68(2)→Trademark Act Article 15).

(3) Decision of refusal against an application for renewal registration of duration of the right under a defensive mark registration (Trademark Act Article 65-4(1))

(4) Decision of refusal against an application of reclassification of trademark registration of the designated goods of the trademark right (Supplementary Provisions of the Trademark Act Article 6)

(5) Decision of refusal against an application of reclassification of trademark registration of the designated goods under a defensive mark (Supplementary Provisions of the Trademark Act Article 23 →Supplementary Provisions of

the Trademark Act Article 6)

(6) Decision of refusal against the first application of renewal registration of duration of trademark right for an overlapped registration of trademark (Act to partially revise the Trademark Act, etc. (Act No. 68 of 1996) Supplementary Provisions of the Trademark Act Article 13(1))

(Revised Feb 2015)

61-02 P D T
Party Concerned of
Appeal Against Examiner's Decision of Refusal

1. Appellant

(1) An appellant is a person who has received a decision of refusal (including a successor) (Patent Act Article 121(1), Design Act Article 46(1), Trademark Act Articles 44(1), 68(4), Supplementary Provisions of the Trademark Act Article 13)(Note).

(Note)

A. A person who receives a decision of refusal is an appellant, i.e., a person who has a right to obtain a patent.

B. When a co-owner of the right to obtain a patent requests an appeal for the right jointly owned, all co-owners should jointly file the request (Patent Act Article 132(3), Design Act Article 52, Trademark Act Articles 56(1), 68(4)).

(2) Handling of a request for appeal filed by a part of joint applicants (→22-03 3.(1))

2. Intervention

Regarding an appeal against examiner's decision of refusal, a provision of an intervention (Patent Act Article 148, Design Act Article 52, Trademark Act Articles 56(1), 68(4)) or a provision of an application of intervention (Patent Act Article 149, Design Act Article 52, Trademark Act Articles 56(1), 68(4)) is not applied (→61-06 9., →21-08 1.(11)).

(Revised Feb 2015)

61-03 P D T**Time When a Request for Appeal Against Examiner's Decision
of Refusal Can Be Filed****1. Time when a request for appeal can be filed**

(1) An appeal can be filed within three months from the date on which a certified copy of a decision of refusal was served (Patent Act Article 121(1), Design Act Article 46(1), Trademark Act Article 44(1)).

An appeal against examiner's decision of refusal can be filed only after a certified copy of the decision of refusal is served.

If an appeal against examiner's decision of refusal is requested without receiving a decision of refusal, the request is dismissed by decision.

(Clause example of reasons for dismissal)

Since a request for appeal for the case was filed before a decision of refusal is made, the request is against the provision of Patent Act Article 121 (1) and this deficiency cannot be amended. Therefore, the appeal decision is rendered as concluded.

(2) If a person requesting an appeal may not file a request within the above period due to reasons not attributable, the person may file an appeal within 14 days (or within two months if the person is an overseas resident) after the date on which the reasons disappeared but within six months after the above period has been passed (Patent Act Article 121(2), Design Act Article 46(2), Trademark Act Article 44(2)).

(3) The Commissioner of the JPO may extend the term provided in Patent Act Article 4 (Design Act Article 68(1), Trademark Act Article 77(1)) for a person in a remote area or an area with transportation difficulty by request or ex officio (→25-01). However, the term except for an appeal against examiner's decision of refusal of a patent application (Patent Act Article

121) will not be extended in principle (\rightarrow 25-04 2., 4.).

(Revised Feb 2015)

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)

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)

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)

61-06 P D T
Procedure of Proceedings on Appeal Against Examiner's
Decision of Refusal

1. Order of Proceedings

(1) Principle

A case of appeal against examiner's decision to dismiss amendment is examined according to an order of filing date of the request for appeal.

However, a case with an old filing date (including a retroactive filing date and a priority date of claiming priority) is examined promptly.

(2) In the following cases, not necessarily in order of the filing date, a case should be examined at an early stage.

A. When a written explanation of circumstances concerning the accelerated examination is submitted and the prescribed requirements are satisfied.

(→see Guideline for Accelerated Examination published on JPO' website)

B. When there are other special circumstances that an early examination is deemed necessary.

2. Documentary Proceedings

An appeal against examiner's decision of refusal is documentary proceedings.

A chief administrative judge, however, may conduct an appeal by oral proceedings by request of the party or ex officio (Patent Act Article 145(2), Design Act Article 52, Trademark Act Articles 56(1), 68(4)).

3. Oral Proceedings (→33-00)

4. Ex Officio Proceedings (→36-01)

In an appeal, reasons that a party or an intervenor does not allege may be examined. However, a purport of the request that an appellant does not allege may not be examined (Patent Act Article 153(1)(3), Design Act Article 52, Trademark Act Articles 56(1), 68(4)).

5. Consolidated Proceedings (→30-03)

Proceedings of an appeal against examiner's decision of refusal may be consolidated (Patent Act Article 154, Design Act Article 52, Trademark Act Articles 56(1), 68(4)).

6. Inquiry (→37-00~37-02)

A chief administrative judge may inquire a party (Patent Act Article 134(4), Design Act Article 52, Trademark Act Articles 56(1), 68(4)).

7. Suspension and Termination (→26-01~26-01.1)

When necessary for an appeal, the procedures may be terminated until an appeal decision of another appeal becomes final and binding or court procedures is completed (Patent Act Article 168, Design Act Article 52, Trademark Act Articles 56(1), 68(4)).

8. Others

Provisions for submission of a written reply, a request for correction, and an intervention and an application of intervention are not applied to an appeal against examiner's decision of refusal (Patent Act Article 161, Design Act Article 52, Trademark Act Articles 56(1), 68(4)) (→61-02 2.).

(Revised Feb 2015)

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 Patent 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)

61-10 P D T

Handling of Cases When an Application Is Converted After, or at the Same Time, a Request for Appeal Against Examiner's Decision of Refusal Is Filed

When after filing an appeal against examiner's decision of refusal within the statutory period and a converting an application (for example, in a case where a patent application is converted into a utility model application), it is handled that there is a lawful conversion of the application and at the same time the application for said appeal case is deemed to be withdrawn.

The same applies when an appeal against examiner's decision of refusal is filed within the statutory period and a conversion of application is filed on the same day.

(Handling of a request for appeal when an application is withdrawn. →61-05 9.)

1. When an Application Is Converted After Filing an Appeal Against Examiner's Decision of Refusal

There is a court precedent for handling of this case ((1959 (Gyo-na) 61) Judgment of Tokyo High Curt, Sept 15, 1960).

This court precedent is related to a conversion of application under Old Utility Model Act Article 5, if a decision indicated therein applies to the current law, it is roughly as follows.

(1) Possibility of conversion of application after requesting an appeal

According to Utility Model Act Article 10, when a patent application is converted to a utility model application, for obtaining a benefit regarding the priority of the application date provided in Utility Model Act Article 10(3),

it is apparent that it is required the conversion of application should be made within the statutory period.

However, the law does not provide any other requirements, for example, when an appeal is filed against a decision of refusal, it does not stipulate any matters that may be conducted only after conclusion of the appeal procedures. Substantially, even if an appeal, claim rights of the original application such as a right for obtaining a patent is a purpose (a subject) of the proceedings, and it is not essentially different from the original application, and therefore it should be interpreted whether an appeal is pending or not does not give any effect on the possibility of conversion of application under Utility Model Act Article 10.

Then, a conversion of application filed within the statutory period from the date on which a certified copy of a decision of refusal is served is lawful and valid regardless of filing an appeal.

(2) Possibility of coexistence of an application of utility model registration and a request for appeal

The question is what will happen to the appeal according to (1), or whether they may coexist, but there are no regulations in the law whether both should coexist. However, Utility Model Act Article 10(5) states “when a conversion of application is filed under the provision of paragraph (1) or (2), the patent application or the application of design registration is deemed to be withdrawn.” Thus, a patent application with respect to an appeal is deemed to be withdrawn, and it is interpreted that the legal matters related to said patent application is extinguished. Therefore, it is interpreted that the appeal naturally ends due to a loss of a subject of appeal and only an application of utility model registration after conversion of application remains.

2. When an Application Is Converted in Filing an Appeal Against Examiner’s Decision of Refusal

In this case, see (1964 (Gyo-ke) 52) Judgement of Tokyo High Court, Nov 10, 1964.

This court precedent has the same effect as an item 1.

(Revised Feb 2015)

61-11 P

In Appeal Against Examiner's Decision of Refusal for a Patent Application, a Notice to the Patentees When an Invention Claimed in the Patent Application Is the Same Invention that Has Been Filed on the Same Day by a Different Applicant and Already Registered

1. According to "Patent Act Article 39" in Examination Guidelines, when an invention claimed in a patent application is the same invention that has been filed on the same day by a different applicant and already registered, the handling is as follows (→Examination Guidelines, Part III, Chapter 4 Prior Application (Patent Act Article 39), 4.4.2(1)b(b)).

“When issuing a notice of reasons for refusal under Article 39(2) or (4), the examiner shall notify the patentee or the owner of a utility model right of the fact.”

2. In response to this, when the same case occurs in an appeal against examiner's decision of refusal, handle the case in the same way.

(1) Clerical procedures of administrative judges

See the third page of this section for a text of a notice.

Enter a patent application number, a patent registration number, etc.

A. Notify all patentees or right holders of utility model right respectively.

B. When a patentee is not an overseas resident, enter a name of patentee.

A name of patentee is inquired with a registration master using online inquiry terminal.

C. When a patentee is an overseas residence, enter as follows.

As a result of inquiring with a registration master, when a patent administrator is appointed and registered, a name of patent administrator is entered. When a patent administrator is not appointed, a name of the agency of patent application at registration of establishment of the patent is inquired with a registration master and entered it.

(Revised June 2019)

Notice

Date:

Chief Administrative Judge, JPO

Patentee OOO Corporation

Agent XXXXX

We notify you of the followings on a patent of Patent No. OOOOO (Patent Application No. 2000-OOOOOO) of which you are a patentee (or a patent administrator).

Note

A notice of reasons for refusal was issued for the following patent application under the provisions of Patent Act Article 39(2) (4) since the invention of claim OO in the following patent application is the same as the above patent invention of claim XX which has been already registered.

Appeal 2000-000000

Patent Application 2000-000000

(See laid-open Patent Publication No. 2000-000000)

Appellant

Address (Domicile) 00000000

Name (Appellant) OOOO

Agent

Address (Domicile) 00000000

Name (Appellant) 0000

If there are co-owners, exclusive licensees, non-exclusive licensees for the above patent right, notify this notice to them.

61-12 T**Handling of Appeal Against Examiner's Decision Cases
When the Cited Trademarks are Pending in either a Trial for
Trademark Invalidity or a Trial for Rescission of Trademark
Registration**

In an appeal against examiner's decision of refusal for the Trademark Act Article 4(1)(xi) (in this section, 61-12, hereinafter referred to as "later appeal"), when a trial decision of an invalidation trial or a rescission trial with respect to the registered trademark cited in the appeal (in this section, 61-12, hereinafter referred to as a "first trial") is not finalized, the later appeal is handled as follows.

1. When a demand for the first trial is not successful, even before a decision of the first trial has been finalized, it is possible to make an appeal decision to refuse a trademark of the later appeal due to the fact that the registered trademark of the first trial is as a cited trademark.
2. When a demand for the first trial is successful (invalidation, rescission), the decision of the later appeal is pending until the decision of the first trial becomes final and binding.

Reasons are as follows.

The Trademark Act Article 4(1)(xi) provides that no trademark may be registered if the trademark is identical with, or similar to, another person's registered trademark which has been filed prior to the filing date of an application for registration of that trademark.

Then, the “final and binding” trial decision is required to invalidate or rescind the trademark registration under an invalidation trial or a rescission trial.

In a case where the first trial decision is a decision of invalidation or rescission, the trademark right exists until the trial decision becomes final and binding, and since the “registered trademark” exists in real, if the later appeal decision of registration is made before the trial decision becomes final and binding, a situation of an overlapped registration is occurred for the registered trademark with respect to the former trial and the trademark with respect to the later appeal.

In the Trademark Act eliminates an overlapped registration as provided in Trademark Act Article 4(1)(xi) (Identical with or similar to a registered trademark of others) and Article 8 (Prior application).

Therefore, it is not desirable to make a trial decision knowing that it may occur an overlapped registration situation.

When the decision of the former trial is unsuccessful, on the other hand, as the prior trademark is a “registered trademark”, the trademark of the later appeal falls under the Trademark Act Article 4(1)(xi), it may make a trial decision of refusal before a decision of the former trial becomes final and binding. In this case, the problem of overlapped registration will be never occurred.

(Revised Oct 2015)