

62-02 P**Handling of an Application When It Has Been Refused on the Grounds of No Novelty in the Examiner's Decision, However, Consider It Appropriate to Refuse the Same Application on the Grounds of No Inventive Step at Appeal**

In an appeal against the examiner's decision of refusal for a patent application that has been given a decision of refusal on the grounds of no novelty based on the cited references, when it is determined that an invention in the application is appropriate to be considered that it can be easily arrived based on the publicly known knowledge from the same cited references as above, it should be interpreted as a case where a reason for refusal different from the reason of original decision pursuant to Patent Act Article 159(2) is found. Therefore, another reason for refusal shall be notified.

In such a case, a reason for refusal of the original decision that denied novelty and a reason for refusal on the grounds of denying inventive step at appeal can be recognized as having the same purport, therefore, it should not be interpreted as a case discovering a reason for refusal different from a reason of the original decision, and there are court precedents in which a trial decision can be made immediately ((1950 (Gyo-na) 7, Judgment of the Tokyo High Court May 19, 1951), but all cases are related to the Patent Act of 1921 and the applicable provisions for novelty and inventive step are provided in the same old Patent Act Article 1, thus, it cannot be said that the above court precedent can be applied to the current law.

(Revised March 2012)