

62-03 P**Handling of an Application When It Has Been Refused on the Grounds of No Inventive Step in the Examiner's Decision, However, Consider It Appropriate to Refuse the Same Application on the Grounds of No Novelty 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 inventive step based on the cited references, when it is found appropriate to refuse an invention in the application on the grounds of denying novelty based on the same cited references as above (when it is difficult to deny inventive step due to differences in problems, etc.), a new reason for refusal shall be notified. In a case of dismissal of amendment, a response shall be made with special attention.

However, it is substantially and formerly apparent that an appellant responds to the reasons for refusal by giving an opinion, etc. on novelty, it may make an appeal decision without notifying another reason for refusal (Notes 1~3).

(Note 1) ((1981(Gyo-ke)8), Judgment of Tokyo High Court, Sept 26,1984)

(Note 2) ((1987(Gyo-ke)225), Judgment of Tokyo High Court, May 31, 1989)

(Note 3) ((1991(Gyo-ke) 82), Judgment of Tokyo High Court, Nov 21, 1991)

(Revised Feb 2015)