

**62-06 P D T****In Appeal Against Examiner's Decision of Refusal, Handling of Reasons for Refusal that Have Been Notified in the Examination, but Not Become Reasons for the Examiner's Decision**

In an appeal case where there are more than one reasons for refusal have been issued at the same time or separately in the examination and an application was refused by some of said reasons as grounds for the decision, when a panel found the application may not be refused by the reasons for refusal as grounds for the decision but may be refused by the reasons already notified in the examination, in principle, the reasons for refusal that were not grounds for the decision as well as all reasons for refusal found in an examination ex officio are notified upon conducting another ex officio examination.

1. In an appeal against examiner's decision of refusal, when a reason different from reasons as grounds for the decision is found, it should be notified and an opportunity to submit a written opinion should be given by specifying a reasonable period of time (Patent Act Article 159(2)).

2. Reasons for refusal that are on the basis of the determination of refusal of the application in the appeal have been already notified to an appellant (an applicant) and an opportunity to state an opinion was also given (Patent Act Article 50). Since the procedures made in the examination has legal effects also on the appeal, there is no question of illegality even if another notice of reasons for refusal is not issued (Patent Act Article 158).

3. However, it is supposed in making a decision of refusal, that all claims for which reasons for refusal notified previously have not been resolved are pointed out and all reasons for refusal that have not been resolved clearly describe in a decision of refusal. Since an appellant ought to consider that the reasons for refusal for which an application should be refused in the appeal have been already resolved, there is a risk that it will be taken as a surprise attack due to the reasons for refusal from the perspective of the appellant without giving any opportunity to state an opinion. It is rather appropriate to conduct another ex officio examination and notify a notice of reasons for refusal including all reasons for refusal found by the examination.

(Revised October 2015)