

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)

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)

62-04 P**Handling of the Publication of Unexamined Utility Model
Applications Used as Cited Publications**

In the proceedings of appeal, considering a publication of unexamined utility model application is totally different from a microfilm or CD-ROM of a specification and drawings as a cited publication (evidence), when a publication of unexamined utility model application is used as a cited publication, it is handled as follows.

1. In an appeal of examiner's decision, when a cited publication is a publication of unexamined utility model application, a strict determination is made whether the original decision can be maintained only with the content of the publication of unexamined utility model application (claims, drawings, and a brief description of the drawings) (the detailed description of the device which is not described in the publication of unexamined utility model application cannot be a basis of or cannot be taken into consideration of the determination).

2. When based on the detailed description of the device, a notice of reasons for refusal is issued in the appeal on this case. A format of the description of a publication is as follows (when an issuance is after January 8, 1993, CD-ROM).

① Microfilm of a specification and drawings (JPO issued on D/M/Y) attached to the application of Utility Model Application No. OO-OOO (Unexamined Utility Model Application Publication No. OO-OOO)

② Microfilm of Utility Model Application No. OO-OOO (Unexamined Utility Model Application Publication No. OO-OOO)

③ CD-ROM of a specification and drawings (JPO issued on D/M/Y) attached to the application of Utility Model Application No. OO-OOO (Unexamined Application Publication No. OO-OOO)

④ CD-ROM of Utility Model Application No. OO-OOO (Unexamined Utility Model Application Publication No. OO-OOO)

3. The proceedings of appeal are conducted respecting the purpose of the above items 1., 2., even when a cited publication in the examination is a publication of unexamined utility model application and a reason for request for appeal stating in a written request for appeal is based on the entire specification of the utility model application.

(Revised Feb 2015)

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)