

63-04 P**Drafting of Decisions When an Examiner's Decision to Dismiss
Amendment Is Rendered Along with an Appeal Decision in
Appeal Against Examiner's Decision of Refusal**

When a decision to dismiss amendment is rendered along with an appeal decision in an appeal against examiner's decision of refusal, a conclusion and reasons for a decision to dismiss the amendment states in reasons for an appeal decision establishing or denying the request. A decision to dismiss amendment is not issued in a separate document.

In this case, a conclusion of the decision to dismiss the amendment does not state in a conclusion of the appeal decision.

1. Appeal Decision Denying the Request

A decision to dismiss amendment is disputed as a reason for rescinding the appeal decision on the grounds that there is an error in finding the gist of the present invention in the appeal decision.

In that case, if an appeal decision and a decision to dismiss amendment are made in a separate document, it is not clear for a plaintiff of a suit rescinding an appeal decision whether a decision to dismiss amendment is also rescinded when an appeal decision is rescinded. Therefore, it is appropriate that a conclusion and reasons for a decision to dismiss amendment that may be disputed only on the grounds for rescinding the appeal decision indicate in reasons of appeal decision.

If a conclusion of a decision to dismiss amendment describes in the section of conclusion of an appeal decision, when filing a lawsuit, it could have been misunderstood that the conclusion of the decision to dismiss amendment is

also a subject to a lawsuit. In a conclusion of the appeal decision, a description should be only “The request for appeal in this case is groundless.”

2. Appeal Decision Establishing the Request

The same drafting form as item 1. applies to item 2., and a conclusion of an appeal decision only states “The original decision is revoked. The present invention shall be patented.”

(Revised Feb 2015)