

# PATENT PROSECUTION GUIDEBOOK in Japan

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# INTRODUCTION

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The main purpose of this guidebook is to provide patent practitioners in countries outside of Japan a simple explanation of procedures for obtaining Japanese patents.

The procedures for obtaining patents in Japan include procedures that can be dealt with substantially the same as those of the procedures in the United States and the EPO and procedures different from them.

First, the roles of the claims and description are common. The claims and description have crucially significant roles in patent systems. For example, in the patent prosecution phase, an amendment to overcome reasons for refusal must be done within the scope of matters stated in an originally-filed description and the like. In the rights enforcement phase, the applicant's allegations and advantageous evidence are limited to the scope of the matters described in the description and the like.

Further, notices of reasons for refusal are usually issued up to two times, the first (which is also referred as "non-final") notice of reasons for refusal and the final notice of reasons for refusal, similarly to the U.S. practice. However, the Japanese procedure is different from the U.S. procedure in various points.

This guidebook shows basic flows of patent prosecution in the Japan Patent Office. We also point out how to deal with the flows for patent practitioners in various countries including the U.S. and EPO members in the "ADVICE" sections as far as possible.

We hope that this guidebook will be useful for patent practitioners in the various countries when they file a patent application in Japan.

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# Chapter 1 Patent Application

## [1] Significance of Patent Application

A patent right becomes effective after a patent application is filed in the Japan Patent Office and its establishment is registered. The patent application requires to prepare documents in predetermined formats and file them with the Commissioner of Patents.

## [2] Route and Language of Patent Application

### (1) Filing Route

#### a) PCT Route

When the receiving office accords an international filing date to an international patent application based on the Patent Cooperation Treaty (PCT), it is deemed to be a Japanese patent application filed on the international filing date (Patent Act Article 184-3 (1)). This deemed application is referred to as "international patent application" (Patent Act Article 184-3 (2)).

#### b) Paris Route

Any person of a country of the Union of the Paris Convention can, on the basis of an application properly filed in one of the countries of the Union, file in the other countries a patent application with a claim of priority during a priority period (12 months) (Paris Convention Article 4 (A)). A patent application containing a priority claim under the Paris Convention can be treated the same in its examination as a patent application filed on the filing date in the first country.

## **(2) Submission of Translated Description**

### **a) PCT Route**

In the case of an international patent application, it is basically required to submit Japanese translations of the description and the like within 30 months from the priority date (Patent Act Article 184-4 (1)).

However, when national documents are submitted within a period of 28 to 30 months from the priority date, it is allowed to submit the translations of the description and the like within two months from the filing date of the national documents (Patent Act Article 184-4 (1) Proviso). Accordingly, the submission period of the translations can substantially be extended to a maximum of 32 months from the priority date.

### **b) Paris Route**

In the case of a patent application containing a priority claim under the Paris Convention, it is basically required to submit Japanese translations of the description and the like within 12 months from the priority date.

However, it is allowed to file the application with the description and the like attached in a foreign language (foreign language written application) within 12 months from the priority date. In the case of the foreign language written application, the original language of the description and the like is not limited to English, but may be any original language. When the foreign language written application is filed, it is required to submit Japanese translations of the description and the like within 16 months from the priority date (Patent Act Article 36-2 (2)). If the translations are not submitted within 16 months from the priority date, the applicant is notified accordingly, and it is allowed to submit the translations within

two months from the notification date (Patent Act Article 36-2 (4)). Accordingly, the filing period of the translations can substantially be extended up to 18 months from the priority date.

### **(3) Correction of Incorrect Translations**

#### **a) PCT Route**

In the case of an international patent application, when incorrect translations are found in the translations of the description and the like, the incorrect translations are allowed to be corrected on the basis of the description of the international patent application, which is written in the foreign language.

#### **b) Paris Route**

It is not allowed to correct incorrect translations when the application has been filed with the Japanese translations of the description and the like, without also submitting the description and the like in the foreign language.

Meanwhile in the case of the foreign language written application, the incorrect translations can be corrected on the basis of the submitted description and the like in the foreign language. Accordingly, the foreign language written application is recommended in considering the risk of incorrect translations.

### [3] Procedures for Patent Application

Procedures for obtaining a Japanese patent right starts from filing a request and the necessary attached documents to the Japan Patent Office.

#### (1) Documents Basically Required for Patent Application

i. Request

A request is a document that expressly indicates a manifestation of intention that an applicant requests a patent grant from the Japan Patent Office. The documents ii. to v. below are attached to the request for a patent application (see FIG. 1.1).

ii. Claims

iii. Description

iv. Drawings

v. Abstract

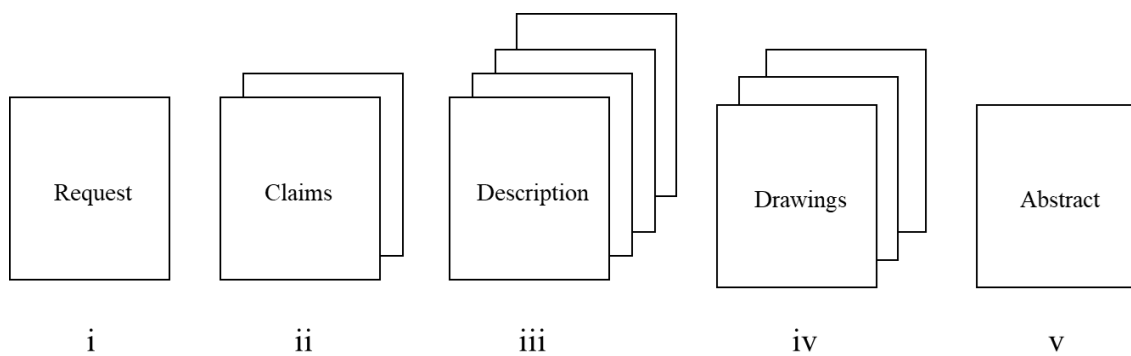


FIG. 1.1

#### (2) Filing of Application Documents

The application documents are electronically filed.

 **ADVICE**

- i. We will prepare the request. In your order letter, please let us know bibliographic items, such as the applicant and the inventor.
- ii. We will translate the claims, description, abstract, and drawings into Japanese when the original language is English. In the case the original language is a language other than English, please translate them into English or Japanese and send it to us.
- iii. At your request, we will revise the claims, description, abstract, and drawings to suit Japanese patent practice for a fee.
- iv. The power of attorney includes a general power of attorney and an individual power of attorney. We will send you any of them via E-mail. Please fill the date and send it back to us by postal mail or E-mail.



## Chapter 2 Preparation of Application Documents

### [1] Matters to be Stated in Request

#### (1) Japanese national phase of International Patent Application

National documents are submitted in entering into the national phase in Japan.

#### (2) Japanese Patent Application containing a priority claim under the Paris Convention

The following matters are basically required to be stated in the request for the application in Japan.

- i. International patent classification
- ii. Nationality, residence, and name of inventor
- iii. Identification number, nationality, residence, and name of applicant
- iv. Identification number and name of agent
- v. Priority claim under the Paris Convention
- vi. Fee
- vii. List of submitted documents

The patent is granted to the applicant. The applicant is identified by "nationality", "residence", and "name". Note that the residence can be substituted by the identification number.

#### **ADVICE**

Please let us know if you have ever filed a patent, a utility model, a design, or a trademark in Japan. You should already have the identification number provided then.

## [2] Matters to be Stated in Claims

### <1> Characteristics of Claims

The claims define the invention. The content and the concept of the wordings described in the claims define the scope of protection of the patent invention (technical scope) (Patent Act Article 70(1)). This characteristic of the claims is identical to the characteristics in the Patent Act in your country.

### <2> Description Requirements for Claims

Patent Act Article 36 specifies the following as recitation requirements for the claims to secure the function of the claims as described above.

#### **(1) Patent Act Article 36(5) (Matters Necessary to Specify Invention)**

- i. The claims should recite sufficient matters to identify (define) the invention for which the applicant requests a grant of a patent.
- ii. The subject of patentability and the like and the patent scope should be determined on the basis of the claims stated under the responsibility of the applicant.

#### **(2) Patent Act Article 36(6)(i) (Support Requirements)**

Inventions not stated in the description cannot be stated in the claims.

#### **(3) Patent Act Article 36(6)(ii) (Clarity Requirements)**

It is necessary that the invention is clearly understood from one claim. As long as the invention is clearly understood, the following claim styles are acceptable.

- Claims in alternative forms, such as a Markush form

- Product-by-process claims
- Claims identified by operation, function, property, etc.

**(4) Patent Act Article 36(4)(i) (Enablement Requirements)**

The detailed description of the invention must be described clearly and sufficiently so as to enable any person ordinarily skilled in the art to carry out the invention.

**[3] Requirements of Unity of Invention**

The claims can include multiple claims that individually state respective inventions having a common technical relationship (Patent Act Article 37).

Patent Act Implementing Regulation stipulated in Patent Act Article 37 designates that the requirements of unity of invention have a relationship in which two or more inventions have identical or corresponding special technical features and are linked as to form a single general inventive concept as illustrated in the figure below.

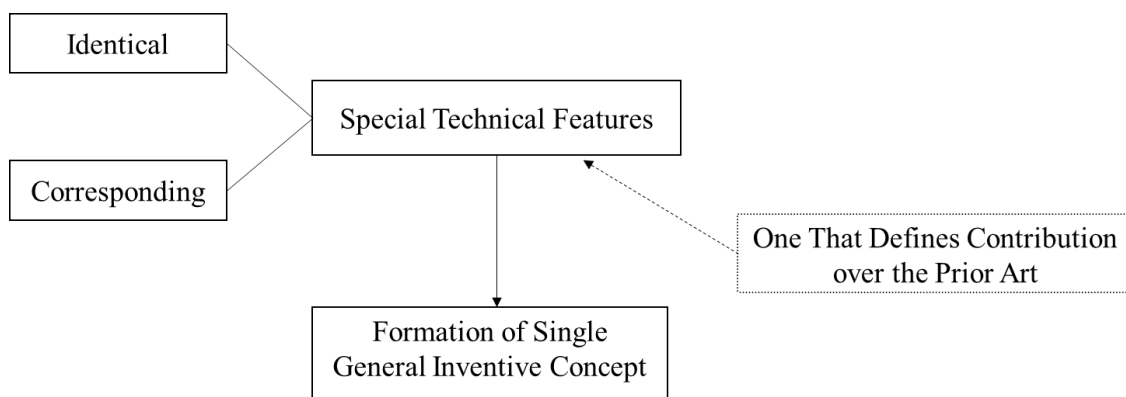


FIG. 2.1

The concept of unity as described above is allowed to be applied to different invention categories as illustrated in the figure below.

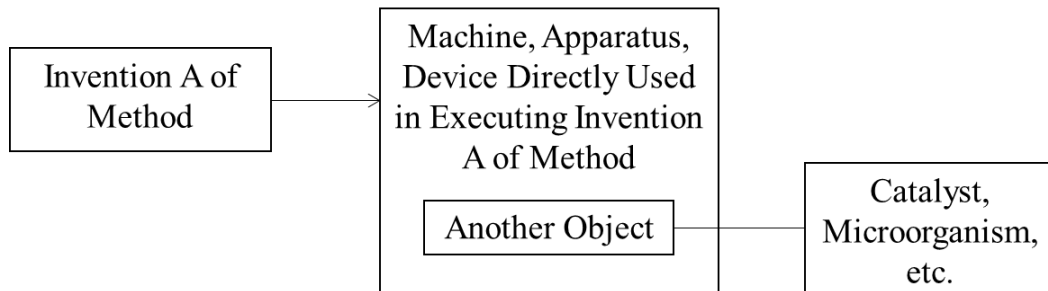


FIG. 2.2

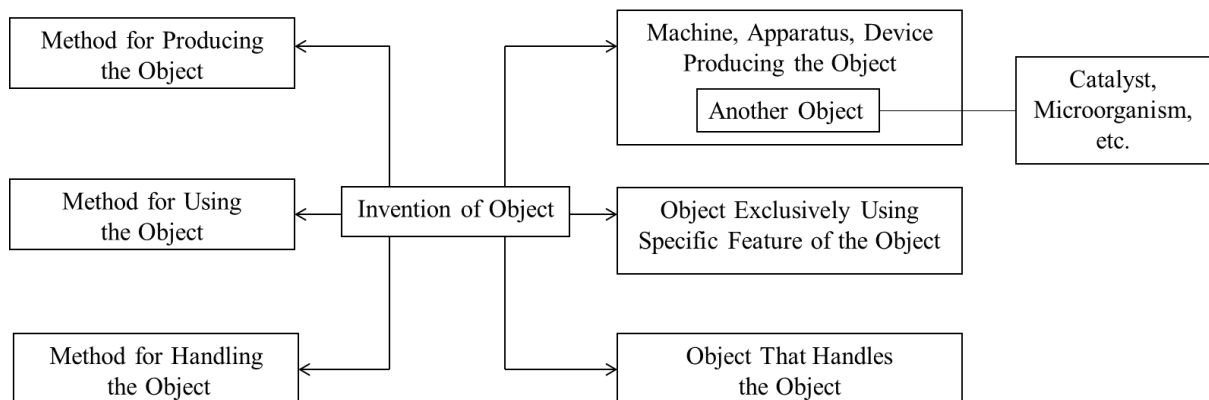


FIG. 2.3

**📌 ADVICE**

The requirements of unity of invention in Japan illustrated in FIG. 2.1 to FIG. 2.3 have parts in common to and parts different from the requirements of restriction in the U.S. and unity of invention in the EPO. The following describes the outlines of requirements of restriction in the U.S. and of unity in the EPO as reference.

Restriction in the U.S.	Unity of Invention in the EPC
<p>Determination of unity of invention is different in that it questions the existence of relevance between a plurality of inventions. The following shows some examples.</p> <p>a) When an invention of "product" and an invention of "process of making" are each claimed, and the "process of making" is not obvious for making the "product" and the process can be used to make another product (MPEP 806.05(f)).</p> <p>b) When there is a relationship similar to the above-described a) between an invention of "process" and an invention of "apparatus" or between an invention of "apparatus" and an invention of "product" (MPEP 806.05(e), (g)).</p>	<p>Article 82 specifies unity of invention as "one invention only or a group of inventions so linked as to form a single general inventive concept." Rule 44 specifies the "general inventive concept" as "there is a technical relationship involving the same or corresponding special technical features."</p>

#### [4] Matters to be Stated in Description

##### <1> Form of Description

The following headlines shall be added to separate sections in the description under the Japan Patent Act (see FIG. 2.4).

【書類名】 [Document Name] 明細書 [Description]
【発明の名称】 [Title of Invention].....
【技術分野】 [Technical Field]
.....
【背景技術】 [Background Art]
.....

【先行技術文献】 [Citation List]

【特許文献】 [Patent Literature]

【特許文献 1】 [Patent Literature 1] Patent Publication No. ....

【非特許文献】 [Non-Patent Literature]

【非特許文献 1】 [Non-Patent Literature 1].....

【発明の概要】 [Summary of Invention]

【発明が解決しようとする課題】 [Technical Problem]

.....

【課題を解決するための手段】 [Solution to Problem]

.....

【発明の効果】 [Advantageous Effects of Invention]

.....

【図面の簡単な説明】 [Brief Description of Drawings]

【図 1】 [FIG. 1].....

【発明を実施するための形態】 [Description of Embodiments]

.....

【産業上の利用可能性】 [Industrial Applicability]

【 0 0 0 1 】 [0001]

.....

【符号の説明】 [List of Reference Signs]

1 ...

FIG. 2.4

## <2> Matters Stated in Respective Headlines of Description

The matters to be stated in relation to the respective headlines of the description

are as follows.

[Title of Invention]

Indicate the content of the invention briefly.

[Technical Field]

State the technical field to which the invention belongs.

[Background Art]

i: Describe the prior art that should be compared with the invention.

This is where the closest prior art is stated and the prior art is analyzed. The problems to be solved, such as what sort of problems were present, what sort of functions failed to be achieved... etc., are presented.

ii: Disclosure of Prior Art Document Information

Prior art that is an invention known to the public through publication and known by the applicant at the time of filing is stated. It may be listed as follows.

[Patent Literature]

[Patent Literature 1] Japanese Unexamined Patent Application Publication No.

2001-XXXXXX

[Non-Patent Literature 1] "XXXX" by XXXX, published by XXXX, January 1st, 2001, pp.12 - 34

[Summary of Invention]

[Technical Problem]

Clearly present the problem to be solved by the invention.

[Solution to Problem]

This intrinsically corresponds to the invention identified in the Claims, but the description of the technical principle of the invention may be advantageous in some cases.

[Advantageous Effects of Invention]

State the effect that would be generated when all the elements stated in the claims function. That is, extract the unique effect that cannot be achieved by the prior art and state it.

[Brief Description of Drawings]

Give a brief description for the drawings representing the embodiment.

[Description of Embodiments]

Describe a technique embodying the invention stated in the claims. This description must support the invention stated in the claims.

[Example]

State an example when the effect of invention is clearly specified by an experiment and the like.

The experiment is carried out with comparative examples, and the used method, apparatus, unit, etc. are clearly specified for replication studies.

[Industrial Applicability]

Clearly specify the industrial field of the invention.

### <3> Drawings

Drawings are not specified as a required document under the Patent Act, but they are usually necessary as a matter of practice in applications in fields of machinery, electricity, and information processing. The drawings may be unnecessary in chemical field etc.

Any of drawings showing six sides (a front view, a back view, a plan view, a bottom view, and a right/left side view) may be used, and additionally, a perspective view, a transparent view, a breakaway view, an exploded view, an enlarged view, a



cross-sectional view (including a partial cross-sectional view), an end view, a flowchart, etc. may be used.

#### <4> Abstract

The abstract is to state the outline of the invention in a short paragraph for ease of information search. "Problem", "Solution", and "Selected Drawing" are stated in the abstract. The number of characters is in a range of 100 to 400 Japanese characters (which is approximately 50 to 200 words in English).

#### ADVICE

Since violation of the section separation is not a reason for refusal, it is not necessary to add the same headlines as described above. However, violation of the description requirements for claims is a reason for refusal, and therefore, the description requirements need to be complied with.

The recitation in the claims and the description are significantly important for obtaining a patent. At your request, we will revise them for a fee.

The statements in the abstract are not considered for claim construction (Patent Act Article 70(3)).

## Chapter 3 Acceptance of Patent Application to Request for Examination of Application

### [1] Acceptance of Application

#### (1) Assignment of Application Number

As soon as application documents are filed online to the patent office, an application number is assigned (Patent Act Implementing Regulation Article 28).

#### (2) Filing date

The filing date is the day the application documents are sent to the Japan Patent Office online. The determination of patentability in the examination and the validity of patent right are determined on the basis of this filing date.

#### (3) Formality Examination

The accepted application is subject to a formality examination of whether the documents satisfy the formal requirements. When a formal defect is found, an order of amendment is issued. In the case where the amendment is not made, the application is dismissed (Patent Act Article 18).

### [2] Laying Open of Application

#### (1) Timing of Laying Open of Application

The content of a patent application is automatically provided in a laid-open application publication and disclosed in public one year and six months after the filing date (Patent Act Article 64). The first day of the calculation of the laying open of the

application is the filing date on which the application was filed in the first country in the case of a priority application under the Paris Convention, whereas it is the international filing date (or the priority date) in the case of an international patent application. The applications are laid open regardless of their examinations, which means the laid-open applications include ones to be patented and ones to be rejected in the future.

## **(2) Content of Laying Open of Application**

The laying open of a patent application is conducted by publishing the following matters of the patent application in the laid-open application publication (Patent Act Article 64(2)).

- i. the bibliographic items, such as the applicant and the application number;
- ii. the number and the date of the laying open of the application; and
- iii. the whole contents in the claims, description, drawings, and abstract.

## **(3) Effect Caused by Laying Open of Application**

The applicant may claim compensation against a third party who has implemented the invention, which includes the act of producing or using the invention, after the laying open of a patent application and prior to the registration establishing a patent right (Patent Act Article 65(1)). However, the right to claim the compensation is not allowed to enforce until the registration of establishing a patent right (Patent Act Article 65(2)).

## **[3] Request for Examination of Application**

The patent application is not examined just by filing the application. The Japan Patent Office starts an examination only when an express request for examination of

application is filed besides the filing of a patent application (Patent Act Article 48-2).

While the request for examination of the application can be filed simultaneously with the filing of the application, the request time limit is three years from the filing date (Patent Act Article 48-3(1)).

The application without the request for examination of the application within the above-described time limit is deemed to have been withdrawn (Patent Act Article 48-3(4)).

 **ADVICE**

The time limit for the request for examination of the application cannot be extended. We will remind you at the time of filing, one year after the filing, and two years after the filing. Please let us know the necessity of the request and its desirable timing.

## Chapter 4 Examination of Patent

### [1] Substantive Examination System

The Japanese patent system adopts a substantive examination system. Many developed countries adopt the substantive examination system for high stability of patent rights. Therefore, applicants inevitably conduct a variety of communications with the patent office before obtaining their patents. The examination by the Japan Patent Office has the following characteristics.

(1) When a notice of reasons for refusal is issued in an examination, the applicant has an opportunity to submit an argument (Submission of Argument). In many cases, the notices of reasons for refusal are issued twice, a "first" (non-final) notice of reasons for refusal and a "final" notice of reasons for refusal, and the applicant is allowed to state objections against the respective notices in arguments. When the final determination of the examination is a refusal, the applicant can request a re-examination by requesting an appeal against the examiner's decision of refusal. The applicant has an opportunity to submit an argument in the appeal as well.

(2) When an appeal decision of refusal is issued in the appeal, the applicant can file a litigation to rescind the appeal decision in the Intellectual Property High Court. The appeal decision is rescinded when the Intellectual Property High Court determines the appeal decision made by the patent office is illegal.

(3) Persons other than the applicant also have ways to be involved in the examination

by the patent office. That is, an opposition requesting a patent revocation after the patent grant or an appeal for patent invalidation requesting a patent invalidation can be filed.

## [2] Flows of Examination Procedures, etc.

FIG. 4.1 illustrates an outline of examination procedures, etc.

### **ADVICE**

At your request, we are pleased to explain the Japanese patent examination procedures at any time. Please feel free to contact us. In the case of receiving the notice of reasons for refusal, we would explain possible procedures to be taken by the applicant.

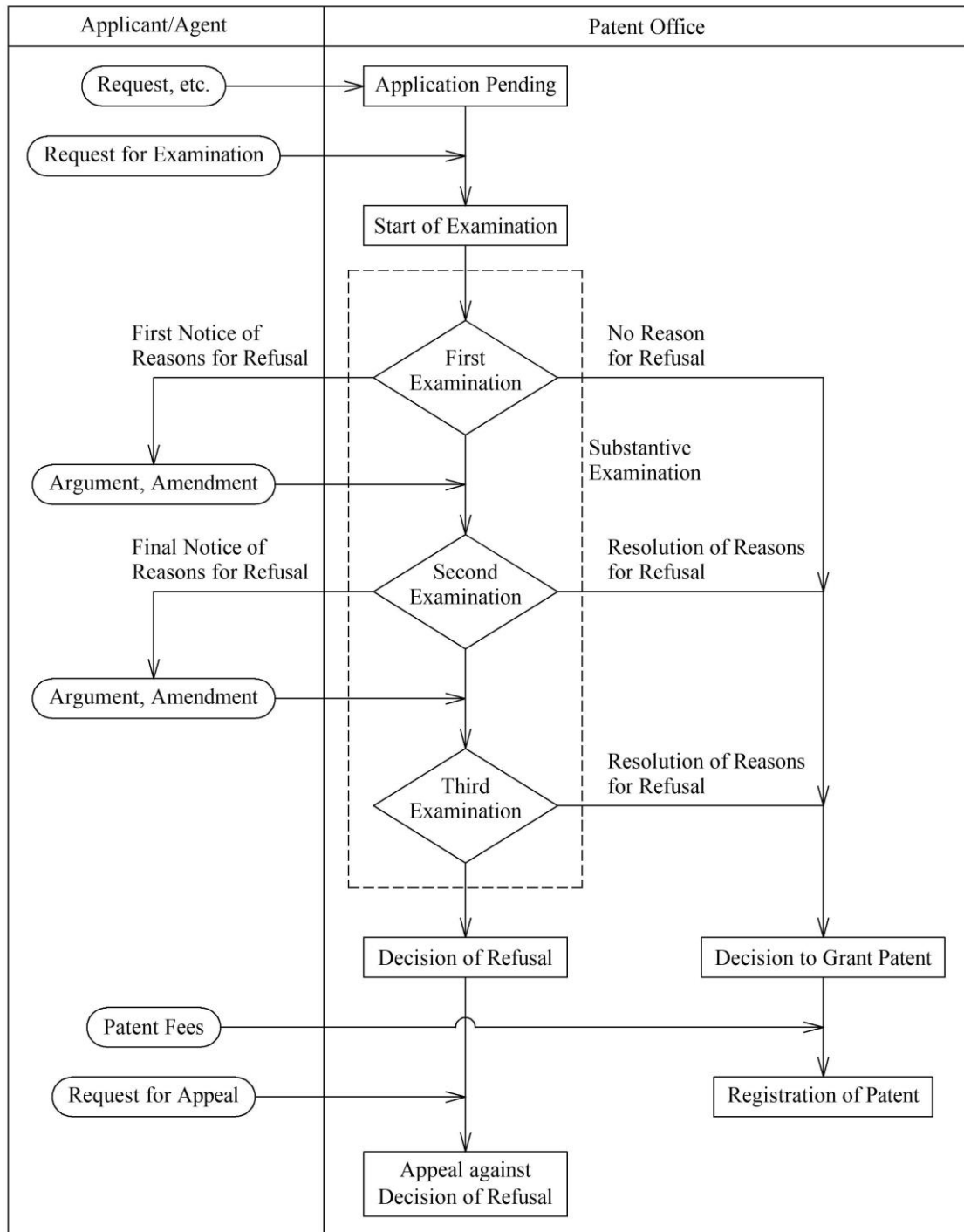


FIG. 4.1

## Chapter 5 Proceeding of Response by Applicant in Examination

### [1] Examination by Japan Patent Office

#### <1> Examination of Application

In the examination by the Japan Patent Office, an examiner determines whether a patent application has any reasons for refusal specified in the Patent Act or not. The examiner examines the application of which he or she is in charge alone, and makes an intermediate disposition, such as the notice of reasons for refusal, and a final decision of refusal or decision to grant a patent (Patent Act Articles 49 and 51).

#### <2> Content to be Examined

The Patent Act restrictively lists reasons for refusal, and specifies that the patent should be granted when no reason for refusal is found (Patent Act Article 51). Accordingly, a decision to grant a patent is rendered when there is no reason for refusal or the reasons for refusal are resolved.

The reasons for refusal are as follows. In the following, i. to vi. are substantive reasons, vii. to xi. are procedural reasons, and xii. to xiv. are subjective reasons. More than half of the reasons for refusal in the actual examinations are iii., a lack of inventive step.

(Substantive Reasons)

- i. the invention is not industrially applicable (Article 29(1) Main Paragraph)
- ii. no novelty (Article 29(1))



- iii. no inventive step (Article 29(2))
- iv. the invention is disclosed in a description of a prior laid-open application (Article 29-2)
- v. there is a prior application for the identical invention (Article 39)
- vi. the invention has grounds for unpatentability (Article 32) (e.g., morality, like producing humans through genetic manipulation)

(Procedural Reasons)

- vii. statement deficiency in the description (Article 36)
- viii. requirements of unity of invention are not met (Article 37)
- ix. addition of new matter by amendment (Article 49(i))
- x. unresolved deficiency of no information of prior art document (Article 49(v))
- xi. new matter not disclosed in the foreign language written description or the like is included (Article 49(vi))

(Subjective Reasons)

- xii. requirements of joint application are not met (Article 38)
- xiii. the applicant is not the inventor, and the applicant has not succeeded to the right to obtain the patent (what is called "a misappropriated application") (Article 49(vii))
- xiv. lack of legal capacity due to being a resident abroad (Article 25)

### <3> Procedures of Examination (Notification of Reasons for Refusal)

#### (1) Procedures of Examination

- a) The decision to grant a patent is rendered when no reason for refusal is found as the result of examination (Patent Act Article 51). On the other hand, a notice of

reasons for refusal is sent to the applicant (the agent in Japan) when any reasons for refusal are found (Patent Act Article 50).

The applicant can submit an argument and amend the claims, description, and the like with an amendment against the notice of reasons for refusal (Patent Act Articles 50 and 17-2(1)).

A response period for an applicant as a resident abroad to submit the argument and the amendment is three months. This response period can be extended two months by filing a request for extension and another month by filing another request for extension (total of three months by requesting twice).

**b)** Basically, there are a total of two notifications: a first notice of reasons for refusal issued at the first examination after the examination request, and a final notice of reasons for refusal issued at the second examination after the first notice of reasons for refusal (Patent Act Article 17-2(1)(i) and (iii)).

## [2] Response to First Notice of Reasons for Refusal by Applicant

The applicant can amend the claims and description and submit an argument for claiming patentability on the basis of the claims after the amendment after the first notice of reasons for refusal.

The amendment after the first notice of reasons for refusal can freely change the claims as long as the changes are within the scope of the originally filed description and the like with no restrictions except for addition of new matter and amendment infringing the unity requirements of the claims.

The argument argues for the patentability based on the claims after the amendment.

The most common reason for refusal is the lack of inventive step (Patent Act Article 29(2)). The inventive step is determined on the basis of the Patent Office Examination Guidelines.

These Examination Guidelines are detailed guidelines summarized on the basis of the experience of past examinations. The Examination Guidelines are revised by legal precedents of the Intellectual Property High Court as necessary. The figure below simplistically illustrates factors of determining the inventive step specified in the Examination Guidelines.

When we attempt to make an argument against the notice of reasons for refusal for our application, we must analyze that "factors in support of the non-existence of an inventive step" are not present and "factors in support of the existence of an inventive step" are present and logically claim that the inventive step is present.

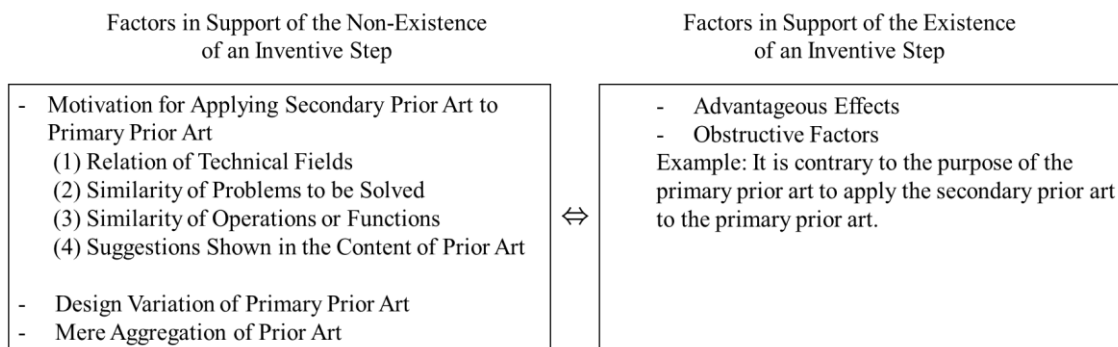


FIG. 5.1 Main Factors for Reasoning

<Source: The Examination Guidelines, Part III, Chapter 2, Section 2, 3.>

**👉 ADVICE**

We analyze the reasons for refusal and provide you an argument proposal and claim amendment proposal when the notice of reasons for refusal is issued. In

consideration of these proposals, you can make a decision for the response to be taken.

Our analysis for the reasons for refusal easily can be understood with your knowledge of obviousness in the U.S. or problem-solution approaches for the EPO. For example, it is possible to argue the existence of a "factor teaching away", similarly to cases in the U.S.

We recommend that the claims be amended on the first notice of reasons for refusal, which corresponds to the first OA, because the amendment is strictly limited on the final notice of reasons for refusal, similarly to the U.S. practice. It is a common strategy to incorporate dependent claims into the independent claim after a final notice of reasons for refusal, similarly to the U.S. practice.

### [3] Response to Final Notice of Reasons for Refusal by Applicant

The decision of refusal is issued without the final notice of reasons for refusal when the examiner has determined that at least a part of the first reasons for refusal is maintainable even after the submission of the argument and the amendment for the first notice of reasons for refusal. However, when the reasons for refusal is caused by the amendment, the final notice of reasons for refusal is issued.

The applicant can submit the argument and the amendment for the final notice of reasons for refusal as well. The amendment of the claims after the final notice of reasons for refusal is restricted to removal of claims, restriction of claims in a limited way, error correction, and clarification of an ambiguous statement (Patent Act Article 17-2(4)).

The restriction of claims in a limited way is often used for amendment of the claims. To satisfy the restriction of claims in a limited way, the amendment is limited to adding a matter identifying the invention in series (which is an incorporation of a

dependent claim or a limitation from description), deleting an element from alternative statements, turning a generic concept into a more specific one, reducing the cited claims in multiple dependent form claims, etc., and the industrial applicability and the problem to be solved of the invention prior to the amendment shall be identical with those after the amendment (Patent Act Article 17-2(5)(ii)).

The argument must logically argue that the reasons for refusal is resolved based on the claims after amendment.

#### **ADVICE**

As a way to obtain a patent, it is beneficial to have an interview with the examiner and reflect the conviction of the examiner on the argument before the submission of the argument and amendment.

Interviews are held face-to-face, on the telephone, or online. Online interview is convenient as the communication is as easy as communicating face-to-face. We will have an interview with the examiner at your request.

### **Use of Divisional Application**

A divisional application is a new application filed by extracting another invention disclosed in the description after the application has become pending before the Japan Patent Office (Patent Act Article 44). One of the characteristics of a divisional application is that the parent application and the child application coexist (see FIG. 5.2). A divisional application also brings a practical benefit to the examination in that the refused claims and the claims to be patented are separated and then examined as separated applications. That is, the allowable claims in one of the applications can

pass to issue, while prosecution can continue on refused claims in the other application.

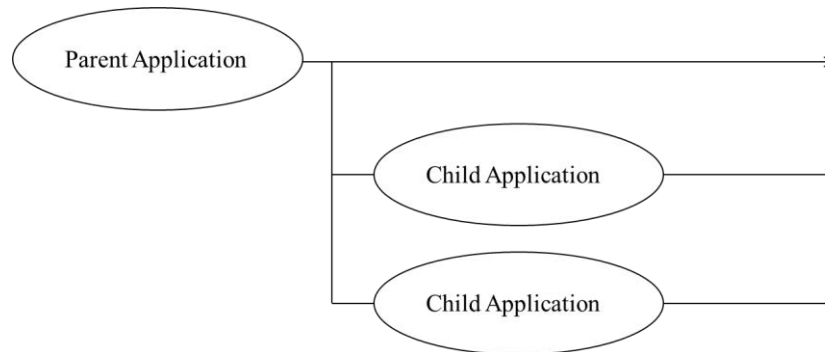


FIG. 5.2

When the claims are amended to respond to a notice of reasons for refusal, the unity of invention may fail to be satisfied a posteriori. In such a case, a part of the claims may be filed as a divisional application, and thus, it can be examined separately from the parent application.

**👉 ADVICE**

The Japanese Patent Office does not have the request for continued examination permitted in the Patent Office in the U.S. Their substitution in the Japanese Patent Act is the divisional application. This divisional application can be used for a purpose similar to that of the request for continued examination, and we will advise you to use it.

**[4] Decision to Grant Patent and Decision of Refusal**

After a response by the applicant to the first notice of reasons for refusal or a response by the applicant to the final notice of reasons for refusal, the examiner

re-examines whether the reasons for refusal have been resolved by reading the argument and amendment. When the reasons for refusal are resolved, the decision to grant a patent is issued, and when the reasons for refusal are not resolved, the decision of refusal is issued. Either a certified copy of the decision to grant a patent or a certified copy of the decision of refusal is served to the applicant (Patent Act Article 52 (2)) by which the applicant will know the final result of the examination.

## [5] Registration of Establishment

The application that has received a decision to grant a patent is registered in the patent registry when the applicant or the agent pays maintenance fees for the first year to the third year within 30 days (Patent Act Article 108(1)) from the certified copy service date of the decision to grant a patent (Patent Act Article 66(2)). This time limit for payment can be extended by up to 30 days. The patent right becomes effective upon registration in the patent registry (Patent Act Article 66(1)). The patent number starting with "Japanese Patent No." is granted at this point.

After the registration of establishment, a certificate of patent is sent to the applicant (who is already a patentee at this time). A patent publication is issued based on the registration of the patent right (Patent Act Article 66(3)). This patent publication functions as a so-called registration certificate.

## Chapter 6 Procedures for Appealing against Refusal after Examination

### [1] Appeal against Decision of Refusal

Some patent applications are patented by examination, and others are rejected. While applicants can accept final and binding rejections of some patent applications, there also are rejections that cannot be accepted. When the applicant cannot accept the decision of refusal, the applicant can file a request for an appeal against an examiner's decision of refusal. An appeal is conducted by a panel consisting of three (or five) administrative judges more carefully than the examination. The appeal procedure is illustrated in FIG. 6.1.

### [2] Procedure for Appeal against Examiner's Decision of Refusal

#### <1> Request for Appeal

The request for appeal by a resident abroad must be filed within four months from the service date of the certified copy of the decision of refusal (Patent Act Article 121). This period cannot be extended.

The request for appeal must include the grounds for why the invention of the application is patentable (Patent Act Article 131(1)).

#### <2> Reconsideration by Examiner before Appeal Proceeding

When the claims and the like are amended when the request for appeal is filed, a procedure for reconsideration by the examiner before the appeal proceeding is conducted (Patent Act Article 162). The reconsideration by the examiner before the



appeal proceeding is a procedure in which the examiner who has issued the decision of refusal re-examines the application prior to the appeal proceeding by the administrative judges. The examiner either grants a patent for an application that should be patented or leaves the decision on the appeal to the panel of the administrative judges for only an application the examiner still considers should not be patented (Patent Act Article 164).

### **<3> Appeal Proceeding**

The administrative judges examine the grounds for the decision of refusal made by the examiner and the grounds for the request for appeal, and when the grounds for the decision of refusal is not reasonable, they examine whether any other reasons for refusal exist or not. When the administrative judges do not find any new reasons for refusal, they make the appeal decision that the application should be patented (Patent Act Article 51 applied mutatis mutandis in Article 159(3)). After the service of the certified copy of the patent appeal decision, the establishment of a patent right is registered upon the payment of the patent fees.

On the other hand, when the administrative judges judge that there is no reason found to rescind the decision of refusal, they make the appeal decision that the application should be rejected (the appeal decision of refusal).

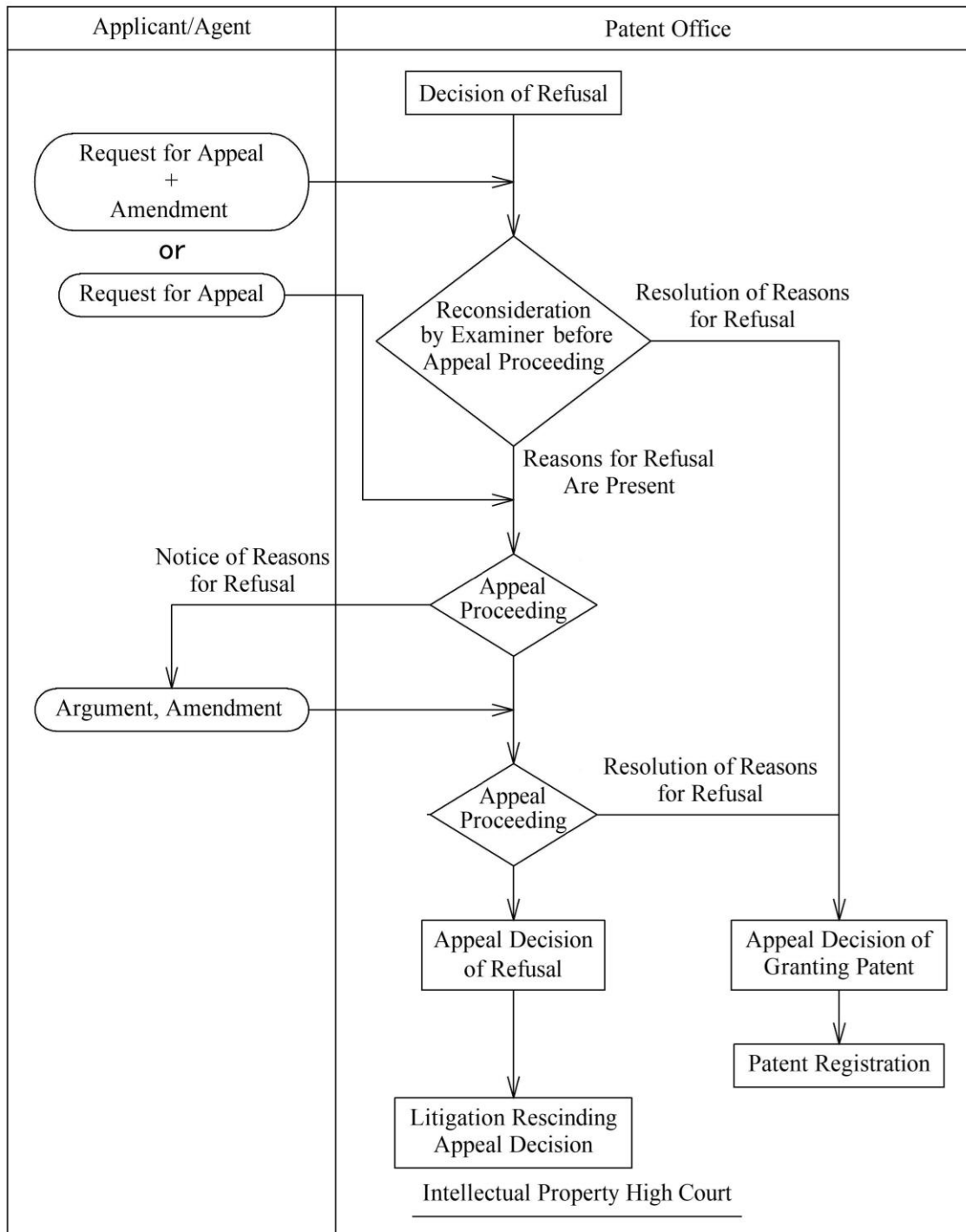


FIG. 6.1

## Chapter 7 Procedures for Appealing against Refusal after Appeal

### [1] Appeal against Appeal Decision of Refusal

In the appeal against the examiner's decision of refusal, an appeal decision of granting a patent or an appeal decision of refusal is rendered. When the applicant has an objection against the appeal decision of refusal, the applicant can file an action in the Intellectual Property High Court for a rescission of the appeal decision (Patent Act Article 178(1)). This litigation rescinding the appeal decision is a procedure to rescind the appeal decision in the case the appeal decision made by the patent office is found illegal.

### [2] Procedure for Litigation Rescinding Appeal Decision

#### <1> Time Limit of Action

The action by a resident abroad must be filed within 30 days (within 120 days in the case 90 days of extended period is provided) from the date on which the certified copy of the appeal decision has been served (Patent Act Article 178(3)). This period is invariable, and therefore, attention must be paid to avoid a default of period (Patent Act Article 178(4)).

#### <2> Procedure of Litigation in Court

The Intellectual Property High Court carries out appeal examination for the procedure for appeal in the litigation rescinding the appeal decision. The documents that have been submitted to the patent office and relating to the reasons for rescinding

the appeal decision must be submitted as evidentiary materials.

The examination of the appeal examination of the litigation rescinding the appeal decision determines the illegality of the appeal decision based on the reason and the evidence presented by a party.

### **<3> Subject of Litigation**

The subject of the proceeding of the litigation rescinding the appeal decision is whether the appeal decision is illegal, and the illegalities of both the procedure relating to the appeal decision and the substantive determination are the subjects of determination. Whether a patent should be granted or rejected is not determined. The scope of the examination is limited to the allegation and evidence indicated in the grounds for the appeal decision.

### **<4> Judgment**

When the claim by a plaintiff (that is, the applicant/appellant) is "Granted", the appeal decision is rescinded (Patent Act Article 181(1)), and when it is "Denied", the appeal decision is maintained. When the judgment that the appeal decision should be rescinded becomes final and binding, the patent office is restrained by this judgment, and must carry out a further proceeding of re-examination in accordance with the object of the judgement and render an appeal decision (Patent Act Article 181(5)).

This resumed examination generates a possibility of obtaining a patent.

If any questions about this guidebook or the Japanese patent practice arise, please feel free to contact us.



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