

# PART I

## Introduction

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*Prosecution* of a patent application is a term generally used to describe the procedures performed by the applicant before a patent office for obtaining a patent after the filing of the patent application and before the issuance of a Notice of Allowance or a Notice of Rejection by an examiner or a Decision of Allowance or a Decision of Rejection by appeal examiners. The primary objective of obtaining a patent, despite considerable cost, is to gain a financial benefit from enforcing the patent and protecting the invention. If the obtained patent is not enforceable or is too difficult to enforce, the money spent to obtain the patent will have been wasted. It is therefore indispensable to consider the enforceability of the patent when prosecuting a patent application. In Part I, as an introduction to Part II, the outline of prosecution is explained in stages, namely before the issuance of a Notice of Reason for Rejection, issuance of a Notice of Reason for Rejection, and filing of an amendment and an argument.

# 1

## Introduction

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### **1.1. Procedures Pertaining to the Examination of a Patent Application**

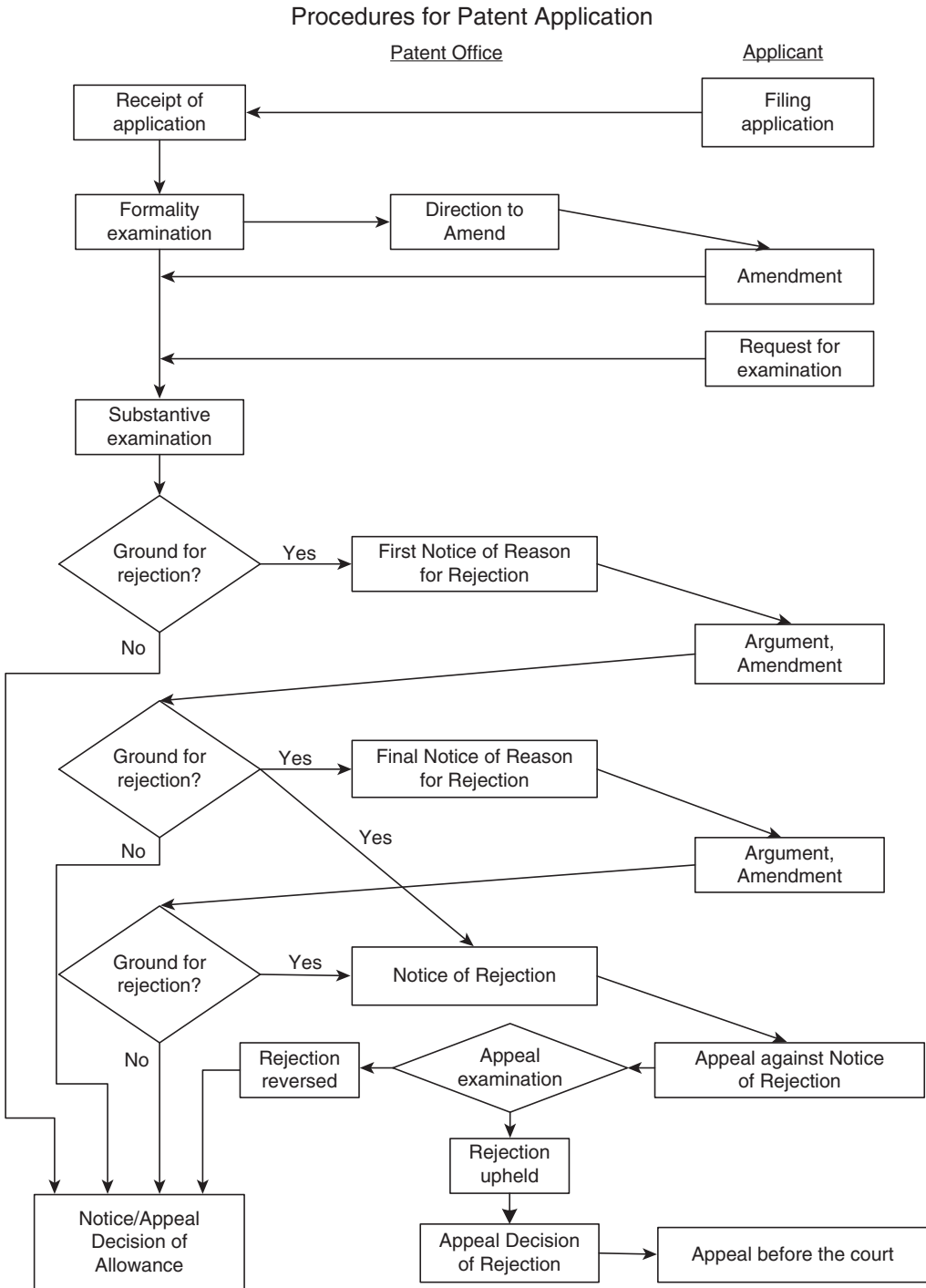
#### **(1) Flowchart**

The general procedures for patent application examination, including applicant responses, are shown in the following flowchart.

#### **(2) Rewarding Practice**

The invention of each patent application is generally unique, so each Notice of Reason for Rejection is also unique. Prosecution of each patent application will therefore be unique. Patent attorneys are inherently faced with a different situation with each application and often with each rejection. Furthermore, frequent revisions of the Patent Act and Regulations often require applicants and patent attorneys to adopt new strategies. It is also usually desirable to prosecute patent applications with a goal of enforcing the patent. The author hopes that the information in this book will assist readers in achieving an effective and rewarding practice in patent prosecution.

**Procedures for Examination and Responses for Patent Applications**



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## 1.2. Examination by Examiner (Patent Act, s47)

### (1) Examiner

When a patent application is filed with the patent office and examination of substantive requirements (substantive examination) is requested, examination is performed by a single patent examiner (Patent Act, Section 47[1]). The qualifications for patent examiners are prescribed by a cabinet order (Patent Act, s47[2], Enforcement Ordinance of Patent Act, s12). Specifically, examination performed by an examiner includes prior art search; assessment and decision of legal requirements; drafting of communications, such as a Notice of Reason for Rejection (s50), decision of dismissal of amendments (s53), Notice of Rejection (s49), and Notice of Allowance (s51); as well as interviews with applicants and their attorneys. Accordingly, the opposing party of the applicants in the prosecution of patent applications are generally patent examiners (examination in an appeal against an examiner's decision of rejection is performed by a panel of appeal examiners [s136]).

### (2) Sources of Law

An examiner assesses whether or not a patent application satisfies the requirements for patentability based on the Patent Act (hereinafter the "Act" or relevant section numbers), the Patent Regulations ("Regulations"), and the Examination Guidelines for Patents and Utility Models ("Examination Guidelines"). The procedures that are necessary for examination are comprehensively set out in the Examination Handbook for Patents and Utility Models ("Examination Handbook"). The objectivity of decisions and procedures should thereby be guided and hopefully ensured. However, examiners are human, so there are some variances in assessment and procedures, depending on the individual examiners. The applicant may therefore gain strategic advantages by noting the name of the examiner in the Notice of Reason for Rejection and modifying the prosecution of the patent application accordingly. Incidentally, it is generally considered that the quality and uniformity of examination by the examiners of the Japan Patent Office are significantly better than those of the examiners of many foreign patent offices.

When responding to the examiner's objections, the applicant should use the helpful decisions by the appeal examiners of the patent office and decisions by the Intellectual Property High Court (IP High Court) in litigations for rescinding trial decisions, as well as the various sources of law described earlier.

NOTE: The term *sources of law* is generally used to describe the forms of law that can be applied, especially those that can be cited in decisions by the courts. In this book, however, the term *sources of law* is used to describe the basis for the decisions made in examination and in trial examination by the patent office, various legislations, Examination Guidelines, and the Examination Handbook.

## SOURCES OF LAW FOR PROSECUTION OF PATENT APPLICATIONS

- Legislations and ordinances: Patent Act, Regulations for Enforcement of Patent Act, formalities requirements, etc.
- Guidelines: Examination Guidelines, Examination Handbook, various guidelines and manuals
- Precedent: Decisions in appeals before the patent office, decisions by the IP High Court, etc.

### (3) Examination Guidelines

#### *[1] The Nature of Examination Guidelines*

The purpose of the Examination Guidelines is to describe the basic principles for patent examiners in assessing requirements for patentability. The Examination Guidelines are also widely used by the applicants as a reference for prosecution of patent applications. However, the Examination Guidelines are compiled in a way that ensures the decisions by the patent office are fair and rational. The Examination Guidelines are different from the “guidelines for examination” prescribed in Administrative Procedure Act, Section 5 (which is prescribed in Patent Act, Section 195-3 as not applicable) and are not binding.

“[W]hether or not the contents of the interpretation of the provision . . . of the Patent Act were specifically stipulated in the Patent and Utility Model Examination Guidelines to be applied to the application of the present patent does not have influence on the interpretation (of the provisions of the Patent Act)” (IP High Court 2006; [Gyo-Ke], 10042 “Polarizing Film”).

## MEANING OF THE CODES OF THE COURT CASES CITED IN THIS BOOK

**(Gyo-Ke):** Appeal against a decision in an invalidation trial before the IP High Court (formerly jurisdiction of the Tokyo High Court)

**(Gyo-Tsu):** Final appeal (as of right) before the Supreme Court in relation to an invalidation trial

**(Gyo-Hi):** Final appeal (with leave) before the Supreme Court in relation to an invalidation trial

**(Wa):** Infringement litigation before the district court

**(Ne):** Appeal from infringement litigation

**(O):** Final appeal from infringement litigation

#### *[2] Expressions in the Examination Guidelines*

There are expressions in the Examination Guidelines that are very difficult for applicants (or attorneys) to understand. This is because the Examination Guidelines are written in expressions that are very precise (albeit sometimes very convoluted) so that

they can be applied even to instances that are exceptional and to guide examiners regarding when they should reject patent applications, rather than how applicants can obtain patents. While this book cites numerous sections from the Examination Guidelines, it also attempts to explain strategies for prosecution using simpler language without compromising accuracy. This is for the benefit of all readers, including those who are not yet familiar with Japanese patent practice. This book also aims to accommodate the viewpoint of applicants.

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### **1.3. Request for Examination of Application (Patent Act, s48-3)**

#### **(1) Objective**

Substantive examination of a patent application is conducted only if examination is requested for the patent application (s48-2).

Not all patent applications are filed in order to obtain patents—some applications are “defensively” filed; that is, in order to prevent others from obtaining patents. In other cases, the value of the patent application may only become clear a few years after filing the patent application, after evaluating, for example, likelihood of patentability of the invention, market demand, or compatibility with technology standards. By allowing the applicants to request examination within a prescribed period after the filing date for only those applications that the applicants genuinely wish to receive a patent for (s48-2), the examination process on the whole can be streamlined.

#### **(2) Who Can Request Examination**

While it is usually the applicant of the patent application that requests examination, the Act allows anyone to request examination (s48-3[1]). If examination is requested by a third party, the applicant is notified of the request (s48-5[2]). In practice, examination request by a third party is often accompanied by information relating to patentability of the application (Patent Regulation, rule 13-2).

(U.S. practice offers no such examination opportunity to nonapplicants. Instead, an examination fee is paid by the applicant along with the initial filing fee and the application is then automatically placed in a procedural queue that eventually leads to its examination by a patent examiner.)

If examination is requested and a Notice of Reason for Rejection is issued, the scope for permissible amendments will become limited. It may therefore be strategic to anonymously request examination of applications by competitors at an early stage in order to reduce the time for the applicant to consider a broader range of claim amendments.

### **(3) Period for Requesting Examination**

Examination must be requested within 3 years from the filing date (s48-3 [1]). However, for a divisional application, examination can be requested within 30 days of the filing date of the divisional application, even if it is more than 3 years from the filing date of the parent application (s48-3 [2]).

If examination is not requested within the prescribed period, the application is deemed to have been withdrawn (s48-3 [4]). It is therefore necessary to diligently watch the deadline for requesting examination. The request for examination cannot be withdrawn once submitted (s48-3 [3]).

The period for requesting examination under the Act was previously 7 years for patent applications filed on or before September 31, 2001. The period for requesting examination under Korean patent law is 5 years. In light of this, the author feels the change from 7 years to 3 years may have been too drastic. In practice, examination is requested at the end of this 3-year period for a large majority of patent applications. Further, when there was a temporary provision for extension of time for payment of the fee for requesting examination between April 1, 2010, and March 31, 2012, the period for requesting examination was effectively extended to 4 years. This temporary measure was met with enthusiasm by many applicants.

### **(4) Fee for Requesting Examination**

The official fee for requesting examination to be paid to the patent office is, by default, “the total of 118,000 yen (102 yen = 1 USD, as of July 2014) plus 4,000 yen for each of the claims” (s195, table of fees). Accordingly, a large number of claims incur a higher fee for requesting examination. For example, for an application with 30 claims, the fee for requesting examination is 238,000 yen. If no special technical feature (STF) is found in examination, as will be explained in Chapter 5 (section 5.6.6), the examiner will only examine Claim 1 and limited claims having specific relationship with Claim 1 (in particular, claims directly and serially appended to Claim 1 and claims that include all features of Claim 1). For example, if only Claims 2–10 have such a relationship with Claim 1, then Claims 11–30 by default will not be examined, and 80,000 yen of the examination request fee will be wasted. Even if Claims 11–30 are pursued in a divisional application, there will be fees of 15,000 yen for filing a divisional application and 198,000 yen for requesting examination for the divisional application. To avoid this, the applicant should carefully review the application before requesting examination to structure the claim tree in such a way as to maximize the number of claims that can be examined even if a unity objection is raised.

(In U.S. practice, the requirements of unity of invention can give rise to restriction requirements that can similarly limit which claims are examined, notwithstanding the applicant having already paid examination fees for such claims. While related to that idea of “unity of invention,” the so-called special technical



feature noted earlier is a more complicated and perhaps nuanced feature of Japanese patent practice. This book accordingly pays considerable attention to this concept in the pages that follow.)

### **AVERAGE NUMBER OF CLAIMS AT THE TIME OF FILING**

**2013:** 9.8  
**2014:** 9.5  
**2015:** 10.2  
**2016:** 10.1  
**2017:** 10.4  
**2018:** 10.7

#### **(5) Amendment**

When requesting examination, it is recommended that the applicant review and amend as necessary so that the claims are novel and have an STF. Further, the applicant should ensure that Claim 1 and the other independent claims have the same or corresponding STF. In anticipation of the examiner finding Claim 1 to lack an STF, it is advised to make sure that each of the claims appended to Claim 1 are directly and serially dependent on Claim 1, in so far as the unity of invention is concerned. There will be a cost savings if the number of claims is reduced to the essential claims.

#### **(6) Request for Refund of Fee**

If the application is withdrawn or abandoned after the request for examination and before the issuance of the first Notice from the examiner, half of the fee for requesting examination can be refunded if the request is filed within 6 months of the withdrawal or abandonment of the application (s195[9]). If the applicant plans to withdraw or abandon an application, it is advisable to file a notice of withdrawal or a notice of abandonment, or otherwise advise the patent office of the intention as soon as possible.

### **NUMBER OF WITHDRAWAL AND ABANDONMENT BEFORE COMMENCEMENT OF EXAMINATION**

**2013:** 5,709  
**2014:** 2,662  
**2015:** 3,057  
**2016:** 2,801  
**2017:** 2,651  
**2018:** 2,203

## 1.4. Accelerated Examination

### (1) Objective

Ordinarily, examination is conducted in the order of when the request was received, and the first Notice issues approximately 9.3 months on average after the examination request. However, some applications require a more highly prioritized examination than others. Accordingly, when applicants wish for earlier examination of their applications, they can submit their request with a Written Explanation for the need to accelerate examination. Accelerated examination is implemented by the patent office's discretionary power.

Within the accelerated examination system, there are normal accelerated examinations, super-accelerated examinations, and Patent Prosecution Highway (PPH) schemes, which are all in popular demand. Further, the Act provides for preferential examination (s48-6), though this appears to be rarely used.

(U.S. practice also provides certain opportunities to request accelerated examination, ranging from fairly simple representations regarding the age or health of the inventor up to relatively procedurally challenging processes.)

### AVERAGE WAIT FOR THE FIRST ACTION

Average period between the examination request and the first Notice of Reason for Rejection or Notice of Allowance:

**2013:** 12.5 months

**2014:** 9.3 months

**2015:** 9.7 months

**2016:** 9.4 months

**2017:** 9.3 months

**2018:** 9.3 months

### (2) Normal Accelerated Examination

#### **[1] Requirements**

The application must be one of the following:

- An application by a small or medium entity, individual, university, public research institute, etc.
- An application having a corresponding foreign patent application
- An application related to an invention being worked
- A green-technology-related application
- An application related to earthquake disaster recovery support
- An application related to the Act for Promotion of Japan as an Asian Business Center

## ***[2] Procedures***

The applicant must file a Written Explanation for the need for accelerated examination, which indicates prior art documents and includes a comparison between the claimed invention and the prior art. There is no additional official fee.

## ***[3] Effect***

In 2019, there were 22,912 requests for accelerated examination and the average time between the request and the first action was 2.3 months.

## **(3) Super-Accelerated Examination**

### ***[1] Requirements***

The application must relate to an invention that is being used and has a corresponding foreign patent application. It is also required that all submissions made in the 4 weeks prior to requesting super-accelerated examination were made online.

### ***[2] Procedures***

The applicant must file a Written Explanation for the need for accelerated examination, which discloses prior art documents and includes a comparison between the claimed invention and the prior art. There is no additional official fee.

### ***[3] Effect***

The first office action issues within a month from requesting super-accelerated examination. The period for responding to a Notice for Reason for Rejection is shortened to 30 days (2 months for foreign applicants). The turnaround time for subsequent office actions is less than 1 month.

## **(4) Patent Prosecution Highway (PPH)**

Under the PPH scheme, the examiner uses as reference the examination results by the patent office (the “first patent office”) of a corresponding foreign application in another country (i.e., the country in which the first patent application was filed in order to accelerate examination at the Japan Patent Office, the second patent office). The PPH scheme applies to patent applications claiming priority under Paris Convention for the Protection of Industrial Property and international applications.

### ***[1] Normal PPH***

The PPH scheme is intended to benefit applicants by facilitating obtaining patents in countries other than the first country, as well as by reducing the workload of the examination by the respective patent office by using examination results achieved by the first patent office.

**(i) Requirements**

A patent application filed with the Japan Patent Office (the second patent office) must claim priority from a first patent application filed with a foreign patent office (the first patent office). The Japanese patent application must include a claim that the first patent office indicated was patentable. Every claim in the Japanese patent application must have sufficient correspondence with one of the claims of the first application that was indicated as patentable by the first patent office.

**(ii) Procedures**

The applicant must request accelerated examination by filing a Written Explanation for the need for accelerated examination. The claims are amended as needed, such that each claim has sufficient correspondence with one of the claims found patentable by the first patent office. The Written Explanation does not need to disclose prior art documents or compare the claimed invention against prior art documents.

***[2] Patent Cooperation Treaty-Patent Prosecution Highway (PCT-PPH)***

The PCT-PPH scheme is intended to reduce the examination workload of the patent offices of respective countries by using the examination result in the International Phase of PCT applications. The pilot program of the PCT-PPH began on January 29, 2010.

**(i) Requirements**

The application must be a Japanese national phase entry application based on a PCT application. At least one claim must be indicated as patentable in the most recently issued version of the following: a Written Opinion by the International Search Authority (WO/ISA), a Written Opinion by the International Preliminary Examination Authority (WO/IPEA), and the International Preliminary Report on Patentability (IPRP). Every claim of the national phase entry application must have sufficient correspondence with one of the claims that have been indicated as patentable in the most recent assessment for the PCT application.

**(ii) Procedures**

Procedures are the same as the normal PPH described earlier.

***[3] PPH-MOTTAINAI***

The PPH-MOTTAINAI is a pilot program with more-relaxed requirements for requesting examination under the PPH scheme that began on July 15, 2011. The PPH-MOTTAINAI scheme is operated between Japan and any country that already has an ongoing scheme or a pilot program of PPH and participates in the PPH-MOTTAINAI program. Under the PPH-MOTTAINAI scheme, a positive examination result by the patent office of any participating country is sufficient for requesting examination under PPH, regardless of which country the first application was filed in.

**(i) Requirements**

The application must have a claim that has been found patentable by the patent office of a participating country. Every claim of the Japanese patent application must have sufficient correspondence with one of the claims that have been found patentable.

**(ii) Procedures**

Procedures are the same as the normal PPH described earlier.

**[4] Features of PPH**

The procedure is simple in that there is no requirement to explain the comparison with the prior art in the Written Explanation, which serves as the document for requesting PPH. On the other hand, due to the requirement that every claim in the Japanese patent application have sufficient correspondence with a claim that was found patentable by another patent office, it may result in unnecessarily limiting the scope of the claims.

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**1.5. Notice of Reason for Rejection (Patent Act, s50)****(1) The Nature of Notice of Reason for Rejection**

If an examiner finds grounds for rejecting the grant of a patent in relation to the specification etc. (“specification etc.” in this book refers to the claims, technical description, and drawings) or the invention of the patent application, he or she does not immediately issue a decision to reject the application; instead, the examiner notifies the applicant of the ground for rejection (s50, s159[2]) by issuing a Notice of Reason for Rejection. The applicant who receives a Notice of Reason for Rejection is given an opportunity to file an Argument (s50) and Amendments (s17-2) within a designated period. A domestic applicant (an applicant with an address in Japan) has 60 days to respond to a Notice, and a foreign applicant has 3 months (extendable by up to 3 months) to respond. Generally, all of the examiner’s grounds for rejection are identified in the first Notice of Reason for Rejection (Examination Guidelines, Part IX, Section 2, 4.3.1). Examiners are encouraged to include in the first Notice any indications of amendments that may bring the application into condition for allowance. Accordingly, if all of the objections raised in the first Notice are overcome, the patent application should generally satisfy the requirements for patentability. The Examination Guidelines (Part IX Section 2, 4.2[2]) also require that a Notice of Reason for Rejection clearly identifies and distinguishes claims having objections from those claims without any objections. Applicants can therefore use the Notice of Reason for Rejection as a guideline for how to prosecute the patent applications to an allowable state. Many times, rather than taking an antagonistic approach to the Notice of Reason for Rejection, an applicant who challenges the Notice with a positive attitude will find that is the first step to a satisfactory prosecution result.

## (2) Reasons for Rejection

The grounds for rejection are exhaustively listed in Section 49 of the Act. The main grounds for rejection are as follows:

- Lack of novelty and/or inventive step (s29[1][2])
- Not satisfying the requirements for descriptions in the specification etc. (s36)
- Not satisfying the requirement of unity of invention (s37)
- Not qualifying as a legal definition of an invention and/or lacking industrial applicability (s29[1], first paragraph)
- Prior application (s39 [double patenting], s29-2 [whole-of-contents novelty])
- Not satisfying the requirements for amendment (s17-2)
- Unpatentable invention (s32)

## (3) Procedures for Examination

The procedures for examination are as follows:

1. Construct the invention of the claims
2. Assess the unity of invention
3. Assess the requirements for description in the specification and claims (hereinafter “patent specification”)
4. Prior art search
5. Assess novelty and inventive step
6. Notice of Reason for Rejection

Notwithstanding that usual procedural order of assessment in patent examination, this book will first discuss the novelty and inventive steps, followed by the requirements for description in the patent specification and unity of invention. Lack of novelty and lack of an inventive step are the most common objections, and understanding the concept of novelty is essential to understanding other aspects of the requirements for patentability, including unity of invention.

## (4) Categories of Notice of Reason for Rejection

### ***[1] First Notice and Final Notice***

Procedurally, there are two categories of Notices of Reason for Rejection. The first category is the first Notice of Reason for Rejection (s17-2 [1][i]) that the applicant receives for the first time. The second category is the Final Notice of Reason for Rejection, which is a further Notice that the applicant receives after having received a First Notice of Reason for Rejection (hereinafter “Final Notice of Reason for Rejection,” s17-2 [1][iii]). If the Notice indicates 「<<<<Final>>>>」, it is a Final Notice of Reason for Rejection. If there is no such indication, it is a First Notice of Reason for Rejection. When a Final Notice of Reason for Rejection

issues, there will be restrictions on allowable amendments with respect to the claims. These are called *restricted-narrowing amendments* (s17-2 [5], [6]). These restrictions are intended to ensure prompt examination by limiting the amendments to those where the examination that has been conducted thus far can be effectively utilized.

## CATEGORIES OF NOTICE OF REASON FOR REJECTION

First Notice of Reason for Rejection  
Final Notice of Reason for Rejection

Generally, a Final Notice of Reason for Rejection notifies the grounds for rejection that arose as a result of an amendment made when responding to a First Notice of Reason for Rejection. Conversely, even when a Notice follows a previous “First” Notice, the follow-up Notice is identified as a “First” Notice of Reason for Rejection if the ground for rejection did not arise as a result of any amendment made when responding to a Notice of Reason for Rejection. In other words, all Notices of Reason for Rejection are considered a First Notice unless it qualifies as a Final Notice. The term *First Notice of Reason for Rejection* is used throughout the legislation, Guidelines, and this book, other than where it is notated as a “first Notice of Reason for Rejection” (e.g., in Chapter 11), indicating the first Notice issued after commencement of examination.

Incidentally, if an objection raised in a Notice of Reason for Rejection was not overcome even with the amendment made when responding to a First Notice of Reason for Rejection, a Notice of Rejection (versus a Notice of Reason for Rejection) will issue without issuance of an intervening Final Notice of Reason for Rejection.

### ***[2] Cases Where Final Notices of Reason for Rejection Are Issued***

#### **(i) Where Only the Grounds for Rejection That Became Necessary to Notify as a Result of an Amendment Made When Responding to a First Notice of Reason for Rejection**

For example, this includes a case where a new objection is raised, such as lack of an inventive step that is different from a previously raised objection as a result of adding a technical feature to an already-examined claim in response to a First Notice. It also includes a case where an amendment is made that adds new matter or does not satisfy the requirements of the description.

#### **(ii) Where the Notice Relates to a Claim That Was Not Examined for Patentability**

This is where an objection such as lack of novelty and/or an inventive step arises as a result of an amendment made when responding to the First Notice. An example of this case is when an objection such as lack of novelty and/or lack of an inventive step

is raised with respect to an amended claim, where patentability requirements such as novelty and/or an inventive step were not assessed in the First Notice because of the claim not satisfying the requirement of description.

**(iii) Where the Notice Relates to a Minor Deficiency  
in Description**

This is where, although a ground for rejection for deficiency in description (s36) existed, as well as lack of novelty/inventive step (s29), only a lack of novelty/inventive step was notified in the First Notice. As a result of the ground for rejection for deficiency in description not being notified, the deficiency issue remains notwithstanding the amendment in response to the First Notice and the subsequent Notice, then addresses the deficiency in description.

**[3] Responding to a Final Notice of Reason for Rejection**

When responding to a Final Notice of Reason for Rejection, care must be taken when preparing an amendment of the specification etc. because the scope of amendment in response to a Final Notice is significantly restricted (s17-2 [5][6]). If the requirements for amendment are not satisfied, the amendment is dismissed (s53). This will be discussed in more detail in Chapter 12.

**(5) Example of a First Notice of Reason for Rejection on  
the Basis of S29(1)(iii)**

**NOTICE OF REASON FOR REJECTION**

Application Number: 2000-123456  
 Drafting Date: H22<sup>1</sup> April 1  
 Examiner: XXXXXXXXX  
 Attorney of Applicant: Mr. John Patent  
 Applicable Legislation: s29(1)

This application should be rejected for the following reason. If there is a response to be made in relation to this, the response should be submitted within 60 days of the issuance of the present Notice.

Reason

The invention of the below-indicated claims of the present application is an invention that was described in a distributed publication, or was made publicly available through an electric telecommunication line in Japan or a

<sup>1</sup> Japanese calendar. H22 is 2010. Years will be indicated using the Western calendar where possible in this book.



foreign country, prior to the filing of the patent application. The invention is therefore an invention prescribed in Patent Act Section 29(1)(iii) and is not patentable.

Note (Refer to the List of Cited Documents for the Cited Documents)

Claim: 1  
Cited Document: 1  
Consideration

The XXXXX of Cited Document 1 is equivalent to YYYYYY of the invention defined in Claim 1, and it is considered that there is no difference in the matters defining the inventions in the two.

[Claims for which no ground for rejection is found]

With regard to the invention of Claims 2 and 3, no ground for rejection is found at this stage. If a new ground for rejection is found, the ground for rejection will be notified.

#### List of Cited Documents

1. JP Hxx-xxxxxs A1 Publication
- 
- 

#### Record of Prior Art Search Result

Searched Field: IPC B43K 8/00-8/24 DB name

Prior Art Document: JP Hyy-yyyyyy A1 Publication

This record of prior art search result does not constitute a ground for rejection.

If you have any questions or wish to conduct an interview in relation to the present Notice of Reason for Rejection, please contact the following:

Patent Examination Z Division ZZZ group ZZZZ (examiner's name)

Ph. 03 3581 1101 (ext zzzz) Facsimile 03 3501 zzzz

## (6) Response to a Notice of Reason for Rejection

The applicant must file an argument (s50) and, if necessary, an amendment (s17-2) (and/or file a divisional application [s44]) to the commissioner of the patent office within 60 days (3 months for a foreign applicant, extendable by up to 3 months) from the date of issuance of the Notice of Reason for Rejection. The application will be rejected unless all of the objections are overcome. The applicant should therefore file a response to address and overcome all of the objections raised in the Notice.

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## 1.6. Amendment (s17)

### (1) Substantive Amendment

Amendments include formalistic amendments (e.g., an amendment of details in the Patent Request) and substantive amendments for amending the content of the patent specification/claims. While an application is pending with the patent office, an amendment can be made provided that the corresponding requirements are satisfied (s17). The amendments discussed in this book are mainly substantive amendments.

An amendment is a document that the applicant submits to the commissioner of the patent office for the purpose of amending (by correcting errors in, revisions to, additions to, deletions of) the contents of the patent specification (s17)—for example, to overcome an objection. There are various statutory requirements regarding the timing and nature of the amendments. Whether or not amendments are permissible is assessed by the examiner.

(To some considerable extent, U.S. practice differs from Japanese practice when it comes to what the practitioner can consider adding to, or deleting from, an already-examined claim. While prohibitions against the introduction of new matter are familiar, other restrictions in Japanese practice are based upon considerations that are either less important in U.S. practice, or not important at all. The details provided in this book regarding such limitations in Japanese practice shed considerable light on what will likely be quite unfamiliar territory to the average U.S. practitioner.)

The requirements of the timing of amendments (s17-2 (1)) will be discussed in detail in Chapter 9. The requirements for the contents of amendments (i.e., the addition of new matter is not permissible (s17-2 [3]), the requirement of unity of invention between assessed claims and amended claims (s17-2 [4]), restrictions on narrowing amendments (s17-2 [5]), and patentability of the amended claims (s17-2[6]) will be discussed in detail in Chapters 10–12.

### (2) Effects of Amendment

An appropriately made amendment is antedated to the filing date of the patent application, and the patent application is deemed to have been filed with the specification as amended. If an amendment does not satisfy timing requirements, a Notice of Reason for Dismissal is issued to give the applicant an opportunity to file a Statement of Explanation, after which the amendment will be dismissed (s18-2) absent a suitable explanation. If an amendment does not satisfy the requirements for the contents of amendment, it may result in issuance of a Notice of Reason for Rejection or dismissal of the amendment. This will be discussed in detail in Chapters 10–12.

When amending the patent specification, the main objective is to overcome objections. Appropriate and effective amendments can make the application patentable and are therefore a very effective tool for applicants.

On the other hand, amendments constitute a part of the prosecution history, and the history of amendments may be considered when construing the scope of the claimed invention (s70). Further, in applying the Doctrine of Equivalents, amendments are assessed in the fifth criterion of intentional exclusion (Ball Spline Bearing case [H6] [O] 1083, Supreme Court, February 24, 1998). It should be noted that, after the grant of a patent, the historical record of amendments is often disadvantageous for the patentee.

### EFFECTS OF AMENDMENT

- Antedated to the filing date of the application
- Assists in obtaining a patent
- Constitute prosecution history

### (3) Substantive Amendment

The format of an amendment is prescribed in the Regulation Format 13. An example is shown below. There is no official fee for submitting an amendment, unless the number of claims is increased.

### (4) Abandonment of Claims After Grant

After the grant of a patent, while it is not possible to file an amendment to delete claims, it is possible to abandon the patent with respect to a part of the claims (s185, s98[1][i]). By abandoning the patent with respect to a part of the claims, the annuity fees for the fourth year onward that are dependent on the number of claims can be reduced.

### (5) Example of Amendment

[Document Name]	Amendment
[Date of submission]	April 1, 2010
[Attention]	Commissioner of Patent Office Mr. XXXXXXXXXXXX
[Case ID]	
[Application number]	2000-123456
[Amendment filed by]	
[ID code]	XXXXXXXXXXXX
[Name or address]	XXXXXXXXXXXX
[Attorney]	
[ID code]	XXXXXXXXXXXX
[Patent attorney]	
[Name]	
[Contact number]	XX-XXXX-XXXX
([Number of claims increased by amendment] X)	
[Amendment 1]	
[Document to be amended]	Claims
[Part to be amended]	All

[Method of amendment]	Revision
[Content of amendment]	
[Name of document]	Claims
[Claim 1]	XXXXXXXXXXXXXXXXXXXX
[Amendment 2]	
[Document to be amended]	Specification
[Part to be amended]	Paragraph 0012
[Method of Amendment]	Revision
[Content of Amendment]	
[0012]	XXXXXXXXXXXXXXXXXXXX

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## 1.7. Argument

### (1) Period for Argument

An Argument is a document to be submitted by the applicant in response to a Notice of Reason for Rejection in which the applicant submits that the grounds for rejection do not exist or are overcome (s50). The examiner assesses the application again after the issuance of a Notice of Reason for Rejection by considering the arguments the applicant presented in the Argument.

The examiner designates a period for filing a response in the Notice of Reason for Rejection. Ordinarily, a period of 60 days is designated for domestic applicants and a period of 3 months is designated for foreign applicants. If there is a justifiable reason for not being able to respond within the designated period, an extension of the period can be obtained by request from the applicant (s5[1]). For a domestic applicant, an extension of 1 month is granted if there is a need to conduct experimentation to compare the claimed invention with the invention cited in the Notice of Reason for Rejection. For a foreign applicant, in addition to the above reason, up to three extensions of 1 month each (maximum 3 months) is granted for the reason of translating the documents for responding to the Notice. Requests for extension must be lodged within the period for filing the response. If the applicant wishes to submit arguments after the period for filing a response, he or she can do this by submitting a Written Statement. However, there is no guarantee that the examiner will consider the Written Statement.

(U.S. practice differs in these regards by permitting the applicant to specify the desired period of extension—and to pay the corresponding fee—at the time of submitting the late response.)

### PERIOD FOR FILING A RESPONSE

Domestic applicants: 60 days

Foreign applicants: 3 months + 3 months extension

## (2) Effects of Argument

The examiner considers the arguments in the Argument and examines the patent application again. Accordingly, an argument is an important document to persuade the examiner to issue a Notice of Allowance for the patent application. As the examiner's opinion that the application is not patentable must be reversed, drafting of an Argument is not an easy task and will often test the skills of a patent practitioner.

Incidentally, Arguments can include arguments against the findings of the examiner, explanation of the meaning of terms used in the claims, description of the differences between the claimed invention and the cited invention in the objectives, configuration, and effects. Keep in mind that Arguments, like amendments, form a part of the prosecution history and can be referred to when construing the technical scope (s70) of the patented invention after the patent's registration.

If a submission by the applicant in the Argument influences the examiner to withdraw their ground for rejection, a patent is granted as a result of the submission being found persuasive. This is why the content of an Argument is considered in the construction of the technical scope of a patented invention. In light of the resultant file-wrapper estoppel, when enforcing a patent, the patentee cannot make assertions that are contrary to the positions presented in the Argument (the Tokyo High Court decision, February 1, 2000, H10 [Ne] 5507, "Simplified method of measurement of serum CRP"). Further, such positions presented in Arguments are considered when assessing the fifth criterion of intentional exclusion for the applicability for the doctrine of equivalents (the Supreme Court decision, February 24, 1998, H6[O] 1083, "Ball Spline Bearing"). Keep in mind that assertions in an Argument often work against the patentee after the grant of a patent. This will be explained in detail in Chapter 3.

### EFFECTS OF ARGUMENT

- Grant of patent
- File-wrapper estoppels

## (3) Format of Argument

The format of an Argument is prescribed in Regulations Format 48. The following is an example.

[Document Name]	Argument
[Date of Submission]	April 1, 2010
[Attention]	Patent Office Examiner XXXX
[Identification of Case]	
[Application Number]	Patent Application Number 2000-123456
[Applicant]	
[Identification Code]	XXXXXXXXXXXX
[Name or Address]	YYYY

[Attorney]  
[Identification Code]      XXXXXXXXXXXX  
[Patent Attorney]  
[Name]                      Taro Tokkyo  
[Telephone Number]      XX-XXXX-XXXX  
[Transmission Number]  
[Content of Argument]  
[Evidence]  
[List of Enclosures]

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## 1.8. Other Kinds of Responses to Notice of Reason for Rejection

Other responses to a Notice of Reason for Rejection, other than submission of an Argument and an amendment, include filing a divisional application (s44), converting the application (Utility Model Act [s10], Design Act [s13]), withdrawing or abandoning the application, and inaction.