

## Appeal Board Questioning Using Re-Examination Report

On April 1, 2014, the Japan Patent Office (JPO) adopted a new system by which an applicant may be granted a "second chance" to argue against an Examiner's opinion in a decision of rejection.

An applicant may file a Request for a Trial Against the Decision of Rejection for an application which was rejected by an Examiner. If a substantive amendment to the application is submitted at the same time as the Request for a Trial Against the Decision of Rejection, the amended application is returned to the Examiner for re-examination.

Should an Examiner find that the amendment filed for an application which previously received a decision of rejection still remains unpatentable, the Appeal Board receives a report (Re-Examination Report) detailing the reason for rejection (Examiner's opinion) from the Examiner.

The applicant is granted an opportunity to provide an argument against the Examiner's opinion. The Appeal Board will issue a "Questions for Clarification" (also known as an Appeal Board Questioning), specifically, when the Re-Examination Report contains new references that were not previously cited in the Notice of Reasons for Rejection.

In some cases, the Appeal Board may decide not to issue an "Appeal Board Questioning" to the applicant and in other cases, the applicant may choose not to respond to the Appeal Board Questioning. In the latter case, an application by an applicant who has not responded to the Appeal Board Questioning is not treated less favorably.

The applicant may file a Reply with the JPO in response to the Examiner's opinion. At this point, no amendments may be made, unless the Examiner has stated that the previous amendments introduce a new matter. In this case, the applicant may suggest a "new" amendment(s) in the Reply. If the Appeal Examiners deem that the "new" amendment(s) are patentable, the applicant will be issued a Notice of Reasons for Rejection which

provides the applicant with the opportunity to submit the "new" amendment(s).

The Appeal Board Questioning is generally for appeal cases only in the fields of medical and biotechnical inventions, which is determined based on the International Patent Classification (IPC). For inventions in other fields, such as mechanical and electronic, the applicant receives a notification stating that a Re-Examination Report has been issued.

An applicant who has received a Notice that a Re-Examination Report has been issued for an invention which is not included among medical or biotechnical inventions may file a petition arguing against the Examiner's opinion in the Re-Examination Report. The petition must be filed prior to the commencement of the appeal examination which is determined by the Appeal Board after the issuance of a notification that the Appeal Board members have been designated.

After obtaining the Re-Examination Report, the applicant should file a petition informing the Appeal Board that the applicant wishes to state their opinion against the Examiner's opinion in the Re-Examination Report. This will postpone the commencement of the appeal examination. This petition should be filed as soon as the Re-Examination Report is obtained.

In February 2015, the JPO announced that Appeal Board's Questionings will be issued only as needed in all technological fields.