Japan

“Janssen Pharmaceutical”

Patent Act, Secs. 133(3), 131(1) – *Janssen Pharmaceutical K.K. v. The Commissioner of the Patent Office*

**Intellectual Property High Court
6 June 2012**

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A patent application can be dismissed where the applicant has been notified of defects in the application and does not respond within the indicated time limit.

The chief trial examiner dismissed the application by a ruling based on Sec. 133(3) Patent Act on the ground that the applicant had not made any amendment to the claims within the time limit designated by a communication from the Patent Office. The applicant now alleges that the chief trial examiner should have notified him or confirmed his intention before a ruling of dismissal. The court held that the chief trial examiner has discretion to decide when to make a ruling of dismissal of procedure based on Sec. 133(3) Patent Act where no amendments have been made to the written request for compliance with Sec. 131(1) Patent Act (the written description requirement) within a time limit designated by an order of amendment based on Sec. 133(1) Patent Act. This is different only where such dismissal of the application exceeds the chief trial examiner’s discretionary power, or must be considered an abuse of such power. Considering the fact that the plaintiff did not furnish any concrete explanation for the amendment to the written request and did not amend the claims though the objections raised by the Office were clear and there was enough preparation time until the expiration of duration designated by an order of amendment, the court found that the dismissal of the application was within the Office’s discretion.

Summarised by Hisayoshi Yokoyama.