

Note: When any ambiguity of interpretation is found in this provisional translation, the Japanese text shall prevail.

Part V: SPECIAL APPLICATIONS

CHAPTER 2 Conversion of Application

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Chapter 2 Conversion of Application

Patent Act Article 46 (Note)

An applicant of a utility model registration may convert the application into a patent application; provided, however, that this shall not apply after the expiration of 3 years from the date of filing of the utility model registration application.

2. An applicant of a design registration may convert the application into a patent application; provided, however, that this shall not apply after the expiration of 3 months from the date the certified copy of the examiner's initial decision to the effect that the application for a design registration is to be refused has been served or after the expiration of 3 years from the date of filing of the design registration application excluding the period of a maximum of 3 months after the date the (certified copy of the examiner's initial decision to the effect that the application for a design registration is to be refused has been served).

3. Where the period as provided in Article 46 1 of the Design Act is extended under Article 4 of the Patent Act as applied mutatis mutandis under Article 68(1) of the Design Act, the 3-month period as provided in the proviso to the preceding paragraph shall be deemed to have been extended only for that period as extended.

4. Where an application is converted under paragraph (1) or (2), the original application shall be deemed to have been withdrawn.

5. Paragraphs (2) to (4) of Article 44 shall apply mutatis mutandis to the case of conversion of an application under paragraph (1) or (2).

(Note) With regard to an application for design registration for which a certified copy of an examiner's initial decision of refusal was transmitted on or before March 31, 2009, "3 months" in Article 46(2) and (3) is read as "30 days."

1. Purport of the provisions for conversion of application

An applicant may wish to amend an application to a more favorable application after the filing of the application based on such reasons as the applicant chose a wrong application format (patent application, application for utility model registration or application for design registration) or converted the business plan after the filing of the original application. Therefore, conversion of the application is permitted and a new application shall be deemed to have been filed at the time of filing of the original application.

(Note) In this Chapter, explanation is made mainly on conversion from applications for utility model registration to patent applications. Conversion from applications for design registration to patent applications will be explained in "3.2 Points to be Noted Regarding Conversion from Application for Design Registration to Patent Application."

Hereinafter, "the original application" from which new applications are divided is referred to as "the original application" and "the new application" as the "converted application," insofar as there is no particular remark otherwise stated.

2. Requirements for Conversion of Application

2.1 Formal Requirements

2.1.1 Persons who may convert to patent application

A person who may convert an application is an applicant of the original application or its successor. That is, the applicant of the original application or its successor must be identical to the applicant of the converted application at the time of filing of the converted application (Article 46(1)).

2.1.2 Time Requirements

An application may be converted excluding the following cases:

- (1) After establishment and registration of utility model right
 - (2) After 3 years from the date on which an application for utility model registration was filed
- ((2) is applicable to converted applications whose original application was filed on or after October 1, 2001).

2.2 Substantive Requirements

In order to be deemed to have been filed for a converted application at the time that the original application was filed, the converted application must meet the following substantive requirements.

- (1) Matters described in the description, claims or drawings of the converted application shall be within the scope of matters described in the description, claims or drawings of the original application immediately prior to being converted.
- (2) Matters described in the description, claims or drawings of the converted application shall be within the scope of matters described in the description, claims or drawings of the original application as of the filing.

Determination of whether or not matters described in the description, claims or drawings of the converted application are within the scope of matters described in “the description, claims or drawings of the original application immediately prior to being converted” or “the description, claims or drawings of the original application as of the filing” will be made in the same way as determination on new matter (regarding determination on new matter, refer to “Part III Section I New Matter”)

However, a converted application filed when an amendment of the description, claims of utility model or drawings of the original application can be made (the period from filing of the application for utility model registration until as stipulated by the ordinance of the cabinet) does not require that the requirement (1) is met if the requirement (2) is met.

(Explanation)

Since conversion of an application is conversion of application formats between the original application and the converted application, the requirement (1) above must be met. Furthermore, considering the effect of conversion of an application as stipulated in Section 44(2) as applied mutatis mutandis under Section 46(5), that is, the converted application is deemed to have been filed at the time of original application, the requirement (2) must also be met.

However, regarding a converted application filed at the time that an amendment of the description, claims of utility model or drawings of the original application can be made, it is possible to file the converted application for matters not described in the description, claims of utility model registration or drawings of the original application immediately prior to being filed, by describing them in the description, claims of utility model registration or drawings of the original application through amendment, if they are described in the description, claims of utility model registration or drawings of the original application at the time of filing in order that the requirements (1) and (2) are

met. Therefore, it is suitable that the requirement (1) does not need to be met if the requirement (2) is met.

3. Other Remarks

3.1 The Proviso of Patent Law Article 44(2)

A converted application which meets “2. Requirements for Conversion of Application” above is in principle deemed to have been filed at the time of filing of the original application. However, it is dealt as if it was filed at the actual time of filing in the following cases (Article 44(2) as applied mutatis mutandis under Article 46(5)).

- (1) Application as “Another patent application” stipulated in the Patent Law Article 29-2 or “Patent Application” stipulated in the Utility Model Law Article 3-2.
- (2) Application of the stipulations in Article 30(4), Article 36-2(2), Article 41(4) and Article 43(1). (Refer to “Chapter 1 Division of Application 4. The Proviso of Patent Law Article 44(2)”)

3.2 Points to be noted when converting from an application for design registration to a patent application

3.2.1 Restriction of Timing

A converted application may be filed except the following cases.

- (1) After establishment and registration of design right.
- (2) After 3 months from the date on which an initial certified copy of decision of refusal of an application for design registration has been transmitted (where the period is extended under Section 46(3), after the extended period).
- (3) After 3 years (Note 2) from the date on which the application for design registration was filed (excluding the period within 3 months from the date on which the first certified copy of decision of refusal has been transmitted).

(Note 1) With regard to an application for design registration for which a certified copy of an examiner’s initial decision of refusal was transmitted on or before March 31, 2009, “3 months” is read as “30 days.”

(Note 2) This is applicable to converted applications whose original application date is on or after October 1, 2001. 7 years in the case of converted applications filed before that date.

3.2.2 Substantive Requirements

Judgment is made by changing from “The description, claims of an application for utility model registration or drawings” in “2.2 Substantive Requirements” to “Details of request or drawings attached to the request.”

(Reference: Tokyo High Court Decision October 9, 2002, Hei 13 (Gyo Ke) 311 “Storage Box,” and Tokyo High Court Decision January 20, 1998, Hei 6 (Gyo Ke) 153 “Hooded outer.”)