

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

Part VI Chapter 1 Section 1 Requirements for Division of Patent Application

Chapter 1 Division of Patent Application

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1. Overview

Article 44 of the Patent Act, which covers the division of patent applications. This article stipulates that the applicant may make part of a patent application containing two or more inventions a new patent application. And, this article stipulates that, if a patent application is lawfully divided, the new application is deemed to have been filed at the same time as the original application.

The patent application division system was established to provide as much access to legal protection as possible for inventions that are included in patent applications and do not meet the requirement of unity of invention, pursuant to the objective of the patent system; i.e., the granting of exclusive rights for a certain period in exchange for publication.

In this Chapter, an "original application" and a "new application" are called an "original application" and a "divisional application," respectively, regardless of whether or not the division is carried out lawfully.

2. Requirements for and Effect of Division of a Patent Application

In order for the division of a patent application to be recognized as lawfully done, it must meet certain requirements for division of applications (In this chapter, hereinafter, referred to as "requirements for division."). The requirements for division consist of formal requirements (see 2.1) and substantive requirements (see 2.2). If the requirements for division are satisfied, the effect of the division of the application (see 2.3) is recognized.

2.1 Formal requirements for the division of a patent application

2.1.1 Person entitled to divide a patent application

Entitled to divide a patent application is the applicant thereof (Article 44(1)). In other words, the applicant of the original application and that of the divisional application must be the same at the time of division.

2.1.2 When the division of a patent application is allowed

A patent application may be divided at any of the timings set forth in (i) to (iii) below.

- (i) During the time period in which amendments to the description, claims, or drawings (In this chapter, hereinafter, referred to as "description, etc.") are allowed (Article 44(1)(i)) (Note 1)
- (ii) Within 30 days from transmittal of a certified copy of a decision to grant a patent (Note 2) (Article 44(1)(ii)) (Notes 3 to 5)
- (iii) Within three months from transmittal of a certified copy of the non-final decision of refusal (Note 6) (Article 44(1)(iii)) (Notes 4 and 5)

(Note 1) For information about when amendments to the description, etc. are allowed, see 2. of "Part IV Chapter 1 Requirements for Amendments."

(Note 2) The following cases are excluded.

- (a) If a decision to grant a patent is given upon reconsideration by examiners before appeal proceedings (Article 51 as applied mutatis mutandis in Article 163(3)).
- (b) If a decision of refusal is cancelled by an appeal against the examiner's decision of refusal and is referred back by an appeal decision for re-examination, and a decision to grant a patent is given (Articles 160(1) and 51).

(Note 3) Even before 30 days have passed from the date of transmittal of a certified copy of a decision to grant a patent, once the registration of the patent right is established, the application may not be divided as it is no longer pending at the Patent Office.

(Note 4) A decision in an appeal against the examiner's decision of refusal is not a decision to either grant or refuse a patent, so the time periods set forth in (ii) and (iii) above do not include the time period following the transmittal of a certified copy of the appeal decision.

(Note 5) The time periods set forth in (ii) and (iii) above may be extended or otherwise changed (Article 44 (5) to (7)).

(Note 6) The following cases are excluded.

- If a decision of refusal is cancelled by an appeal against the examiner's decision of refusal and is referred back by an appeal decision for re-examination, and another decision of refusal is given (Articles 160(1) and 49).

2.2 Substantive requirements for the division of a patent application

The division of a patent application is to make part of a patent application containing two or more inventions a new patent application; therefore, Requirements 1 and 3 below must be met. Moreover, given the effect of division, that is, the divisional application being deemed to have been filed at the same time as the original application, Requirement 2 below must also be satisfied.

(Requirement 1) All of the inventions stated in the description, etc., as they stand immediately prior to the division of the original application do not together constitute the invention claimed in the divisional application.(see 3.1)

(Requirement 2) The matters stated in the description, etc., of the divisional application are within the scope of those stated in the description, etc., of the original application as they stood at the time of filing thereof. (see 3.2)

(Requirement 3) The matters stated in the description, etc., of the divisional application are within the scope of those stated in the description, etc., of the original application as they stand immediately prior to the division thereof. (see 3.3)

However, if a patent application is divided during the time period in which amendments to the description, etc., of the original application are allowed (Note), then Requirement 3 shall be deemed satisfied so long as Requirement 2 is met. This is because a matter which is not stated in the description, etc., of the original application as it stands immediately prior to the division thereof but was stated in the description, etc., of the original application as it stood at the time of filing thereof, may be included by an amendment in the description, etc., of the original application before it is divided.

(Note) For information about when amendments to the description, etc. are allowed, see 2. of "Part IV Chapter 1 Requirements for Amendments."

2.3 Effect of the division of a patent application

If the requirements for division are met, the divisional application is deemed filed at the same time as the original application. If the substantive requirements in the requirements for division are not satisfied, however, the divisional application is not deemed filed at the same time as the original application, but is treated as being filed when it is actually filed. If the formal requirements are not met, the divisional application is dismissed per se.

3. Determination on the Substantive Requirements

3.1 All of the inventions stated in the description, etc., as they stand immediately prior to the division of the original application do not together constitute the invention claimed in the divisional application (Requirement 1).

Requirement 1 is usually satisfied.

(Explanation)

Usually, various inventions are identified from the description, etc., from many angles and in many phases, so they can be said to present two or more inventions. All of the two or more inventions stated in the description, etc., of the original application together constitute the invention claimed in the divisional application if all of the inventions identified from the description, etc., of the original application are stated in the claims of the divisional application; however, this practice, which means non-compliance with Requirement 1, is not expected in ordinary cases.

Therefore, the mere fact that the statement of the claims of the divisional application is the same as that of the claims of the original application does not provide a ground for the satisfaction of Requirement 1. If the invention claimed in the divisional application is the same as the one claimed in the original application after division, see 6.2.

3.2 The matters stated in the description, etc., of the divisional application are within the scope of those stated in the description, etc., as they stood at the time of filing

of the original application (Requirement 2)

The examiner shall determine in this respect by supposing that the Description, etc., of the divisional application are the description, etc., as they stand after an amendment is made to the "description, etc., of the original application as they stood at the time of filing thereof" and then by evaluating whether such amendment is to add any new matter in relation to the "description, etc., of the original application as they stood at the time of filing thereof." (Note)

(Note) For judgment as to whether the amendment is to add a new matter, see "Part IV Chapter 2 Amendment Adding New Matter". Common general knowledge considered in making a judgment in this respect is as of the filing of the original application.

3.3 The matters stated in the description, etc., of the divisional application are within the scope of those stated in the description, etc., as they stand immediately prior to the division of the original application (Requirement 3)

The examiner shall make a judgment in this respect by supposing that the description, etc., of the divisional application are the description, etc., as they stand after an amendment is made to the "description, etc., as they stand immediately prior to the division of the original application" and then by evaluating whether such amendment is to add any new matter in relation to the "description, etc., as they stand immediately prior to the division of the original application." (Note)

(Note) Same as Note of 3.2 .

4. Procedure of Examination for Determination on the Substantive Requirements

4.1 Treatment in the case where the substantive requirements are not met

If the examiner finds that the substantive requirements are not met, he or she shall provide a specific statement of such failure and the reasons for such finding in the notice of reasons for refusal or the decision of refusal.

4.2 Request for the submission of written explanations necessary for judgment on the

substantive requirements

- (1) If it is not easy for the examiner to determine whether or not the substantive requirements are satisfied, then he or she may request the applicant to submit documents that provide explanations about (i) and (ii) below and so on, pursuant to the provision of Article 194(1).
 - (i) Changed portions from the description, etc., of the original application as they stand immediately prior to the division thereof or at the time of filing thereof
 - (ii) Statement of the description, etc., of the original application as they stood at the time of filing thereof which supports the invention according to the claims of the divisional application

If the applicant has submitted a written statement which includes an explanation of these points, then the examiner shall scrutinize it before deciding whether or not to request the submission of additional written explanations.

- (2) If the applicant fails to give substantial explanations on the examiner's request as set forth in (1) above and it is considerably difficult for the examiner to conclude that the substantive requirements are met, then the examiner may proceed with his or her examination on the assumption that the substantive requirements are not met.

<h2>5. Points to Note Concerning Determination on the Requirements for Division</h2>
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5.1 Divisional application whose original application is a divisional application

The applicant may file a divisional application ("child application") from an original application ("parent application") and further file a divisional application ("grandchild application") from a child application.

In this case, if all of the conditions set forth in (i) to (iii) below are satisfied, the examiner shall, when examining the grandchild application, deem it to have been filed at the same time as the parent application.

- (i) The child application meets all the requirements for division in relation to the parent application.
- (ii) The grandchild application meets all the requirements for division in relation to the child application.
- (iii) The grandchild application meets all the substantive requirements for division

in relation to the parent application. (Note)

(Note) "Description, etc., as they stand immediately prior to the division of the original application" as an element of Requirement 3 set forth in 2.2 refers, in this case, to "description, etc., of the parent application as they stand immediately prior to the division of the child application from the parent application."

5.2 If an application is divided on the same day when an appeal against the examiner's decision of refusal is filed

If division takes place on the same day when an appeal against the examiner's decision of refusal of the original application is filed, then the examiner shall examine the substantive requirements for division as if such division took place at exactly the same time as the filing of such appeal (during the time period in which amendments are allowed) (see 2.2), unless it is obvious that such division has not taken place simultaneously with the filing of such appeal.

6. Points to Note Concerning Examination of Divisional Application

6.1 Confirmation of the contents of examination, appeal, etc., of other applications

When examining a patent application and a single application (e.g., a child application) selected from a group of divisional applications based on the patent application (Note), the examiner shall confirm the contents of examination, appeals, and other proceedings pertaining to such patent application and others in such group (e.g., the parent application).

(Note) A group of divisional applications based on a patent application refers to a series of divisional applications derived from a single patent application.

6.2 Treatment in the case where the invention claimed in the divisional application is the same as the one claimed in the original application after division

If the divisional application is lawful and the invention claimed therein is the same as the one claimed in the original application after division, then the provision of

Article 39(2) shall apply.

The examiner shall apply the provision of Article 39(2) in accordance with "Part III Chapter 4 Prior Application."