

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

Chapter 2 Conversion of Application (Patent Act Article 46)

1. Overview

Article 46 of the Patent Act prescribes that the applicant of an application for utility model or design registration may convert it into a patent application. And, this article prescribes that, if the conversion is carried out lawfully, the resulting patent application is deemed to have been filed at the same time as the original application.

Applicants sometimes hope to change the form of application into a more favorable one after its filing, on such grounds as the selection of an incorrect form of application (whether for a patent or for utility model or design registration) or a change in their business plans that take place after the filing of the original application. This is why the application conversion system was introduced.

Provided in 2. to 4. below are explanations in the case where the original application is for the registration of a utility model. Conversion from a design registration application will be explained in 5. .

In this Chapter, "original application" and "new patent application" are called "original application" and "converted application," respectively, regardless of whether the conversion is carried out lawfully or not.

2. Requirements for Conversion of Application

In order for the conversion of an application to be recognized as lawfully done, it must meet certain requirements. The requirements for conversion consist of formal requirements (see 2.1) and substantive requirements (see 2.2). If the conversion requirements are satisfied, the effect of the conversion of an application (see 2.3) is recognized.

2.1 Formal requirements for the conversion of an application

2.1.1 Person entitled to convert an application

Entitled to convert an application is the applicant thereof (Article 46(1)). This

means that the applicant of the original application and that of the converted application must be the same at the time of conversion.

2.1.2 When the conversion of an application is allowed

An application may be converted at any time except at the timings set forth in (i) and (ii) below.

- (i) After a utility model right is established and registered
- (ii) After three years from the date of filing of the application for utility model registration (Note)

(Note) Relief measures are provided in connection with this time limitation (Article 46(5)).

2.2 Substantive requirements for the conversion of an application

The conversion of an application must satisfy requirement 1 below as it is to change the original application into a different form of application. And, given the effect of conversion, that is, the converted application being deemed to have been filed at the same time as the original application, requirement 2 below must be satisfied, too.

(Requirement 1) The matters stated in the description, claims, or drawing of the converted application are within the scope of those stated in the description, claims, or drawings (In this chapter, hereinafter, referred to as "description, etc.") of the original application as they stand immediately prior to conversion.

(Requirement 2) The matters stated in the description, claims, or drawings of the converted 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.

However, in the case of the conversion of an application within the time period during which the description, etc., of the original application may be amended (within one month from the date of filing thereof (Article 2bis(1) of the Utility Model Act and Article 1 of the Ordinance for Enforcement of the Utility Model Act)), requirement 1 shall be deemed met if requirement 2 is satisfied. This is because a matter that is not

stated in the description, etc., of the original application as they stand immediately prior to the conversion thereof may be included by an amendment in the description, etc., of the original application before conversion, so long as it was stated in the description, etc., of the original application as they stood at the time of filing thereof.

2.3 Effect of conversion of application

If the conversion requirements are met, the converted application is deemed filed at the same time as the original application. If the substantive requirements in the conversion requirements are not satisfied, however, the converted application is not deemed filed at the same time as the original application, but is treated as being filed when actually submitted. If the formal requirements are not met, the converted application is dismissed per se. If the formal requirements are met, it is deemed that the original application has been withdrawn.

3. Judgment on the Substantive Requirements and Procedure of Examination therefor

The examiner shall proceed with his or her examination substantially in accordance with 3. and 4. of "Chapter 1 Section 1 Requirements for Division of Patent Application."

4. Point to Note when Making a Judgment on the Substantive Requirements

4.1 If the original application is a divisional application

If an application for utility model registration is divided and a divisional application derived therefrom is lawfully converted into a patent application, then the examiner shall make a judgment on the satisfaction of the division requirements in relation to the original application, assuming that the converted patent application is a divisional application (see "Chapter 1 Section 1 Requirements for Division of Patent Application").

5. Point to Note in Connection with the Conversion of a Design Registration Application into a Patent Application

If the original application is for design registration, it shall be treated in the same way as one that is for utility model registration; provided, however, that the examiner shall consider 5.1 and 5.2 below with respect to the permitted timings of and substantive requirements for conversion.

5.1 When the conversion of an application is allowed

An application may be converted at any time except at the timings set forth in (i) to (iii) below.

- (i) After a design right is established and registered
- (ii) After three months (Note 2) from the date of transmittal of a certified copy of the first decision of refusal of the design registration application (Note 1)
- (iii) After three years (Note 3) from the date of filing of the design registration application (except within three months (Note 2) from the date of transmittal of a certified copy of the first decision of refusal (Note 1))

(Note 1) Excluded is the case in which

- 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 (Patent Act Article 160(1) as applied mutatis mutandis in Article 52 of the Design Act, and Patent Act Article 49).

(Note 2) This period may be extended (Article 46(3)).

(Note 3) Relief measures are provided in connection with this time limitation (Article 46(5)).

5.2 Substantive requirements for the conversion of an application

The examiner shall deem "description, claims, or drawings" in 2.2 to be replaced by "statement in the application or drawing and so on attached to the request form."