

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

Chapter 3 Patent Application Based on Utility Model Registration (Patent Act Article 46bis)

1. Overview

The Patent Act stipulates in its Article 46bis that a patent application may be filed by an owner of utility model right on the basis of utility model registration after the establishment and registration of a utility model right, subject to the satisfaction of certain conditions. And, this article stipulates that, if a patent application based on utility model registration is filed lawfully, it is deemed to have been made at the same time as the relevant utility model registration application.

Applications for utility model registration may be converted into patent applications; however, utility model registration applications are registered without substantive examination, so conversion must be completed within a very short period. Under these circumstances, applicants of utility model registration would have difficulties converting their applications into patent applications when such conversion is desirable to better respond to changes in technological trends. This is why the filing of patent applications based on utility model registration is permitted.

2. Requirements for Patent Application based on Utility Model Registration

In order for a patent application based on utility model registration to be recognized as having been made lawfully, certain requirements must be met. Requirements for patent application based on utility model registration consist of formal requirements (see 2.1) and substantive requirements (see 2.2). If these requirements are satisfied, the effect of patent application based on utility model registration (see 2.3) is recognized.

2.1 Formal requirements for patent application based on utility model registration

2.1.1 Person entitled to file a patent application based on utility model registration

Entitled to file a patent application based on utility model registration is the holder of the utility model right to such registration (Article 46bis(1)). This means that

the holder of the utility model right and the applicant of the patent application based on utility model registration must be the same at the time of filing of that patent application.

For the sake of clarity, if there is an exclusive licensee, pledgee, or non-exclusive licensee for the utility model right, then the owner thereof must obtain its approval for this purpose (Article 46bis(4)).

2.1.2 When a patent application based on utility model registration may be filed

Patent applications based on utility model registration may be filed at any time except at the timings set forth in (i) to (iv) below.

- (i) After three years (Note) from the date of filing of the application for utility model registration at issue (Article 46bis(1)(i))
- (ii) When a request for a report of expert opinion on registrability of the utility model is filed by the applicant of the utility model registration or the owner of the utility model right (item (ii) of the same paragraph)
- (iii) After 30 days (Note) from the date of receipt of an initial notice that a request for a report of expert opinion on registrability of the utility model is filed by a person who is neither the applicant of the utility model registration nor the owner of the utility model right (item (iii) of the same paragraph)
- (iv) After the expiration of the originally designated period during which a written reply must be submitted in a trial for invalidation of utility model registration (item (iv) of the same paragraph)

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

2.1.3 Abandonment of a utility model right

For filing a patent application based on utility model registration, the owner of utility model right must abandon the relevant utility model right (Article 46bis(1) and Article 27sexies of the Ordinance for Enforcement of the Patent Act).

2.2 Substantive requirements for patent application based on utility model registration

Given the effect of patent application based on utility model registration, that is, the relevant patent application being deemed to have been filed at the same time as the relevant utility model registration application, requirement 2 below must be met in addition to requirement 1 below.

(Requirement 1) The matters stated in the description, claims, or drawings of the patent application based on utility model registration are within the scope of those stated in the description, claims, or drawings (In this chapter, hereinafter, referred to as “description , etc.”) of the application for the underlying utility model registration as they stood at the time of registration thereof (Article 46bis(2)).

(Requirement 2) The matters stated in the description, claims, or drawings of the patent application based on utility model registration are within the scope of those stated in the description, etc., of the application for the underlying utility model registration as they stood at the time of filing thereof.

For the purpose of requirement 1, if the description, etc., are corrected after the registration of the utility model, the description, etc., "as corrected" are regarded as the description, etc., as they stood at the time of registration (Article 14bis(11) of the Utility Model Act).

2.3 Effect of patent application based on utility model registration

A patent application based on utility model registration that meets the requirements is deemed to have been filed at the same time as the relevant utility model registration application. If the substantive requirements in requirements for patent application based on utility model registration are not satisfied, however, that patent application is deemed filed when actually submitted, rather than at the same time as the relevant utility model registration application. Note that, if the formal requirements are not met, the patent application based on utility model registration is dismissed per se.

<h3>3. Judgment on the Requirements for Patent Application based on Utility Model Registration, and Procedure of Examination therefor</h3>
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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 Examining a Patent Application based on Utility Model Registration

Even if the invention claimed in a patent application based on utility model registration is identical with the device claimed in the relevant utility model registration, the examiner shall take note of the fact that the provision under Article 39(4) of the Patent Act is not applied thereto (parenthesized provision thereof).