

Chapter 4 Reference filing (Patent Act Article 38ter)

1. Overview

Article 38ter of Patent Act rules relating to a patent application that a person desiring a patent files a patent application, without attaching description and necessary drawing(s) to the request, by a method where an applicant asserts that a patent application the person previously filed (hereinafter referred to as “earlier patent application” in this chapter) is to be referred to (hereinafter referred to as “reference filing” in this chapter).

In the same Article, even if description and drawing(s) are not attached to the request at the time of submission of the request of reference filing, if the description and the drawing(s) are submitted by an applicant within four months from the day of submission of the request together with a Document for Submitting Description, etc. (Article 27decies (6) of Regulations under the Patent Act; form 37bis) in which the applicant asserts that the earlier patent application is to be referred to, thus submitted description and drawing(s) are regarded as description and drawing(s) as attached to the request of reference filing and, therefore, the day of submission of the request may be admitted as a filing date.

The provision as to the reference filing rules one of requirements for admitting a filing date prescribed under the Patent Law Treaty (PLT). More specifically, the provision regulates how to handle an application when description and drawing(s) are substituted by reference to the earlier application (Article 5 (7) (a) of the PLT and Article 2 (5) (a) of Rules of the PLT).

2. Requirements for reference filing

In order for the reference filing to be admitted as a legally proper application, formal requirements (see, 2.1) should be satisfied. If the reference filing does not satisfy the formal requirements, the reference filing shall be dismissed.

If the reference filing satisfies the formal requirements, a filing date shall be admitted according to substantive requirements (see, 2.2).

2.1 Formal requirements for reference filing

2.1.1 Person entitled to file a reference filing

Entitled to file such application is a person who filed the earlier patent application (or a successor or a predecessor thereof) (Article 38ter (1)).

2.1.2 Type of application which is not applicable as the reference filing

An application which is not applicable as the reference filing is an application in foreign language (Article 36bis), a divisional application (Article 44), a converted application (Article 46), and a patent application filed based on a utility model registration (Article 46-2) (Article 38ter (1) and (6)).

2.1.3 Application which is applicable as the earlier patent application

An application which is applicable as the earlier patent application is a patent application filed in Japan or a foreign country.

2.1.4 Document which should be submitted in the reference filing

An applicant should submit documents of the below mentioned (i) to (iii) within four months from a day of submission of the request of reference filing (Article 38ter (3) and Article 27decies (3) and (4) of Regulations under the Patent Act).

- (i) a document for submitting description, etc. to which a description and drawing(s) are attached
- (ii) a certified copy of application, claims, or drawing(s) attached to the request of earlier patent application, or a document corresponding to the description, the claims, or the drawings (hereinafter referred to as “description, etc. of earlier patent application”) (hereinafter simply referred to as “certified copy”) (Note)
- (iii) translation of description, etc. of earlier patent application if it is stated in foreign language

(Note) In a case where the applicant has already submitted the certified copy to the Japanese Patent Office (in a case where the applicant has already submitted the certified copy as a

priority certificate for the other patent application, etc.), the applicant may omit submission of the certified copy if the applicant states thereof in the request. Further, in a case where the earlier patent application was filed in Japan, the applicant may omit submission of the certified copy (Article 27decies (5) of Regulations under the Patent Act and Article 26, Remark 32 of Form).

2.2 Substantive requirements for the reference filing

In a case where matters stated in the description or drawing(s) of reference filing remains in matters stated in the description, etc. of earlier patent application, the day of submission of the request of reference filing shall be a filing date of the reference filing. Otherwise, the day of submission of the description and drawing(s) shall be a filing date of the reference filing.

3. Determination on the Substantive Requirements

3.1 Concrete determination steps

The examiner makes determination as to whether or not matters stated in the description or drawing(s) of reference filing remain in matters stated in the description, etc. of earlier patent application by comparing the matters stated in the description or drawing(s) of reference filing (Note 1) with the matters stated in the description, etc. of earlier patent application (Note 2).

Where it is assumed that the description or drawing(s) of reference filing is a result of amendment of the description, etc. of earlier patent application, if the examiner makes determination that the amendment introduces a new matter in relation to the description, etc. of earlier patent application, the day of submission of the description or drawing(s) of reference filing shall be a filing date of the reference filing. Incidentally, with respect to determination as to whether or not the amendment introduces a new matter, see “Part IV, Chapter 2, Amendment Adding New Matter”.

(Note 1) Claim(s) and abstract of the reference filing shall not be the basis for comparison and determination.

(Note 2) In a case where the certified copy has already been submitted (including a case where the certified copy has already been submitted as the priority certificate for the other

patent application (see, 2.1.4 (note)), the description, etc. of earlier patent application stated in the certified copy shall be used in comparison and determination. Where the earlier patent application was filed in Japan and where submission of the certified copy was omitted, the description as of filing the application shall be used, as the description, etc. of earlier patent application, in comparison and determination. The same shall apply hereafter in this chapter.

3.2 Case where the description, etc. of earlier patent application is stated in foreign language

Since it is highly probable that the content of the description, etc. of earlier patent application coincides with the content of translation thereof (see, 2.1.4 (iii)), it is usually sufficient for the examiner to make determination based on the translation of the description, etc. of earlier patent application. The examiner makes determination based on the description, etc. of earlier patent application only if any questions arise in consistency between the description, etc. of earlier patent application and its translation (Note).

(Note) If any questions arise in consistency there between, see (1) of “2.2 Procedures of Examination of the determination of the new matters beyond the original text” and (1) of “2.3 Typical Examples in which comparison with the foreign language documents is necessary” in “Part VII, Chapter 2, Examination of Foreign Language Written Application”. At the time of referencing, it is assumed that the description, etc. of earlier patent application and its translation correspond to “document in foreign language” and “description, etc.”, respectively, in “Part VII, Chapter 2, Examination of Foreign Language Written Application”.

4. Procedure of Examination for Determination on the Substantive Requirements

(1) If the examiner determines that the matters stated in the description or drawing(s) of reference filing remains in the matters stated in the description, etc. of earlier patent application, the examiner proceeds the examination admitting the day of submission of the request of reference filing as a filing date.

(2) If the examiner determines that the matters stated in the description or drawing(s) of reference filing do not remain in the matters stated in the description, etc. of earlier patent application, the examiner proceeds the examination admitting the day of submission of the description and the drawing(s) as a filing date.

In this case, when the examiner issues Notice of Reasons for Refusal, Notice of Refusal, etc., the examiner shall specify, in the Notice of Reasons for Refusal, the Notice of Refusal, etc., why the examiner determined that the matters stated in the description or drawing(s) of reference filing do not remain in the matters stated in the description, etc. of earlier patent application, concerting the matter to the effect that the examiner admits the day of submission of the description and the drawing(s) as a filing date, and thus admitted filing date.

(3) Against the examiners determination that the day of submission of the description and drawing(s) is admitted as a filing date, the applicant may submit Written Opinion stating argument, explanation, etc. against the admission, and Written Amendment stating that the day of submission of the request of reference filing should be set to a filing date (e.g., Written Amendment to delete the matters which do not remain in the matters stated in the description, etc. of earlier patent application from the matters stated in the description or the drawing(s)).

(4) If the description or drawing(s) was amended according to the submission of the Written Amendment mentioned in (3), the examiner determines again as to whether or not the description or drawing(s) after amendment remains in the matters stated in the description, etc. of earlier patent application. If the examiner determines that the description or drawing(s) after amendment remains in the matters stated in the description, etc. of earlier patent application, the examiner proceeds the examination admitting the day of submission of the request of reference filing as a filing date.

Even when Written Amendment has not been submitted, if the examiner determined that the day of submission of the request of reference filing should be set to a filing date in consideration with contents of the Written Opinion mentioned in (3), the examiner proceeds the examination admitting the day of submission of the request of reference filing as a filing date.

(5) If the examiner changes a filing date to the day of submission of the request of reference filing accepting the Written Amendment and the Written Opinion mentioned in (3) received from the applicant and, therefore, if the examiner issues Notice of

Reasons for Refusal, Notice of Refusal, etc., the examiner shall specify, in the Notice of Reasons for Refusal, the Notice of Refusal, etc., concerning the matter to the effect that the examiner admits the day of submission of the request of reference filing as a filing date, and thus admitted filing date.

(6) If the examiner issues Notice of Reasons for Refusal, Notice of Refusal, etc. still admitting the day of submission of the description and drawing(s) as a filing date even after considering the Written Amendment and the Written Opinion mentioned in (3), the examiner shall specify, in the Notice of Reasons for Refusal, the Notice of Refusal, etc., the reason why the applicant's argument, explanation, etc. are not acceptable, concerning the matter to the effect that the day of submission of the description and drawing(s) is admitted as a filing date, and thus admitted filing date.