

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

Part VII Chapter 1 Overview of Foreign Language Written Application System

## Chapter 1 Overview of Foreign Language Written Application System

See "Part VIII International Patent Application," concerning the handling of international patent applications in foreign language (foreign language patent applications).

### 1. Overview

The foreign language written application system is a system by which a person who seeks a patent (in this chapter, hereinafter, referred to as the "applicant") may file a patent application by attaching to a patent request the written document and written abstract in foreign language as prescribed in an Ordinance of the Ministry of Economy, Trade and Industry, instead of the description, claims, required drawings (in this chapter, hereinafter, referred to as "description, etc.") and abstract (Article 36bis(1)).

Foreign applicants usually file a patent application in Japan, claiming the priority under the Paris Convention based on the first application in foreign language. If only applications in Japanese were admissible, foreign applicants might be required to prepare the translation in a short period of time in cases where there is no choice but to file a patent application immediately before the expiration of the period for claiming the priority under the Paris Convention. In addition, it is not admissible to add, by amendments, other than the matters which are not stated in the originally attached description, etc. Therefore, in cases where foreign applicants file a patent application by translating the first application into Japanese and if there is any mistranslation in the process of translating a foreign language into Japanese, no invention may achieve appropriate protection, including opportunity to correct the mistranslation based on the statements in foreign language.

For solving these problems, the foreign language written application system has been established.

### 2. Documents concerning Foreign Language Written Application

#### 2.1 Patent request

Concerning a foreign language written application, the applicant should file a patent request in Japanese similarly as the regular patent applications in Japanese (in

this part, hereinafter, referred to as simply "regular patent application").

## 2.2 Foreign language document and foreign language abstract document

(1) The applicant may attach the foreign language document and foreign language abstract document instead of the description, etc. and abstract set forth in Article 36(2) (Article 36bis(1) and Article 25quarter of Regulations under the Patent Act).

(2) Foreign language documents are the following documents of item (i) and (ii).

- (i) foreign language document stating the matters (Article 36(3) to (6)) necessary to be stated in the description, etc. and the claims
- (ii) among required drawings, those stating the explanation included in themselves, in foreign language

In addition, a foreign language abstract document is a document stating the matters (Article 36(7)) necessary to be stated in the abstract, in foreign language.

Furthermore, a foreign language document is not the description, etc. as prescribed in Article 36(2). Moreover, a foreign language abstract document is not the abstract as prescribed in Article 36(2).

(3) In cases where patent request, foreign language document and foreign language abstract document have been submitted, the patent application in foreign language is accepted as a regular patent application and the filing date is accorded for the request.

## 2.3 Translation

(1) The applicant who files a foreign language application is required to submit the translation into Japanese of the foreign language document and foreign language abstract document within 16 months from the filing date (earliest priority date, in case of the application claiming priority) (Article 36bis(2)). However, in cases where the foreign language application is a patent application based on a divisional application, converted application, or utility model registration, the applicant may submit the translation within 2 months from the filing date of that application, even after the expiration of the period of 16 months from the filing date of original application (the proviso of the same paragraph).

If the translation has not been submitted within the period for submission of the

translation, it is notified to the applicant under the name of the Director-General of the Patent Office. (Article 36bis(3)). The applicant can submit the translation of the foreign language document within 2 months from the notified date (Article 36bis(4) and Article 25septies(4) of Regulations under the Patent Act)

Meanwhile, even if the drawings filed at the filing date do not include explanations, the applicant is required to submit the translation of all drawings.

See 3., concerning the handling in cases where the translation has not been submitted.

(2) The translation of foreign language document is deemed as the description, etc. filed as attached to the patent request, and the translation of a foreign language abstract document is deemed as the abstract filed as attached to the patent request (Article 36bis(8)).

#### 2.4 Written correction of mistranslation

(1) If the applicant who files a foreign language written application amends the description, etc. for the purpose of correction of mistranslation, the applicant is not required to submit written amendment, but written correction of mistranslation stating the reasons for correcting mistranslation (Article 17bis(2)).

(2) If the applicant who files a foreign language written application makes amendment of the description, etc. (in this part, hereinafter, referred to as "regular amendment") together with the amendment for the purpose of correction of mistranslation, the applicant may include the matters of amendment corresponding to regular amendment into written correction of mistranslation.

### 3. Handling in Cases Where Translation has not been Submitted

#### 3.1 Cases where translation of "foreign language document (other than drawings)" has not been submitted

In cases where the translation of foreign language document other than drawings has not been submitted during the period (See 2.3(1)) for submitting translation as set forth in Article 36bis(2) and (4), the foreign language written

application is deemed to have been withdrawn (Article 36bis(5)).

### 3.2 Cases where translation of drawings of "foreign language document" has not been submitted

In cases where the translation of drawings has not been submitted, the patent application is not deemed to have been withdrawn, but is handled as the patent request without drawings.

The applicant and the examiner should keep in mind that, as a result, the detailed description of the invention or the claims may fail to satisfy the requirements of statements or the requirements for patentability, and thus the correction of mistranslation may be necessary.

### 3.3 Cases where translation of abstract has not been submitted

Even though the translation of abstract has not been submitted within 16 months from the filing date, the patent application is not deemed to have been withdrawn. However, lack of submission of such translation may be subject to an order of amendment and dismissal of proceedings (Article 17(3)(ii) and Article 18(1)).

## 4. Amendment of the Description, etc. of Foreign Language Written Application

### 4.1 Document treated as the subject of amendment

Concerning foreign language written application, the description, etc. (See 2.3(2)) is treated as the subject of amendment. Foreign language documents and foreign language abstract documents are not entitled to amendment (Article 17(2)).

### 4.2 Period for amending the description, etc.

Concerning a foreign language written application, the period for amending the description, etc. is the same as the period for amending the description, etc. of regular patent applications. In addition, the period for amendment is the same as the above period, regardless of a regular amendment or the amendment for the purpose of correction of mistranslation (See "Part IV Chapter 1 Requirements for Amendments,"

concerning the period for amendment).

## 5. Reasons for Refusal against Foreign Language Written Application

Concerning foreign language written application, the matters which fall under the following 5.1 constitute the reasons for refusal, in addition to the matters which fall under the reasons for refusal in regular patent applications.

In addition, in cases where addition of new matters falls under the following 5.2, the addition constitutes the reasons for refusal.

### 5.1 Addition of new matters to original text (See 2. of "Chapter 2 Examination of Foreign Language Written Application")

In cases where a foreign language written application includes those matters stated in the description, etc. which fall within the matters (new matters beyond original text) other than those stated in foreign language document, the application constitutes the reasons for refusal (Article 49(vi)).

### 5.2 Addition of new matters beyond translation (See 3. of " Chapter 2 Examination of Foreign Language Written Application")

In cases where foreign language written application includes, by written amendment, those matters stated in the description, etc. after amendment which fall within the matters (new matters beyond translation) other than those stated in the following document of item (i) or (ii), the application constitutes the reasons for refusal (Article 17bis(3)).

(i) In cases where written correction of mistranslation has not been submitted, the translation which is deemed as the description, etc. submitted as attached to the patent request

(ii) In cases where the description, etc. has been amended by submitting written correction of mistranslation, the translation, the description, etc. after the amendment

## 6. Handling of Various Patent Applications

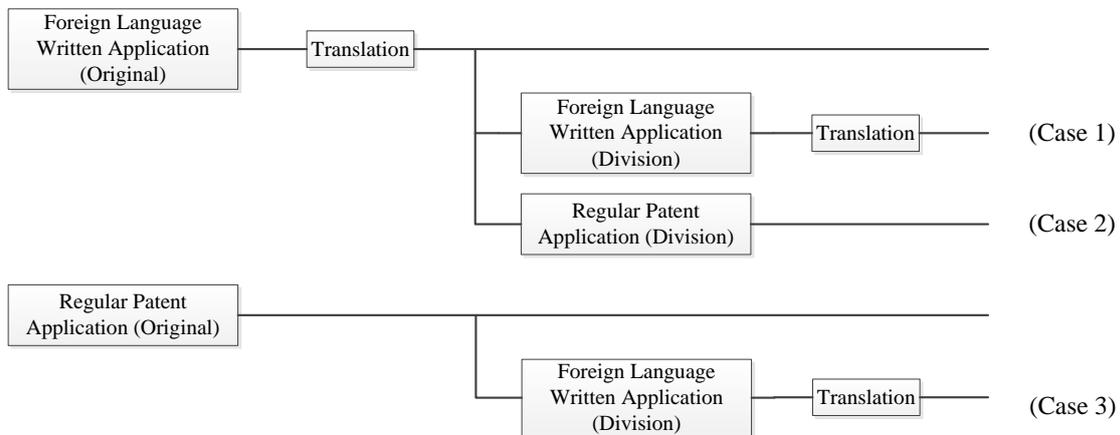
A foreign language written application is that which has been accepted as a regular national patent application. Therefore, a divisional application or converted application based on a foreign language written application, or claim of internal priority is admitted.

In addition, concerning a divisional application, converted application, patent application based on utility model registration, or application claiming internal priority, there is no difference from regular patent applications in view of filing a patent application. Accordingly, in case of filing these applications, foreign language written applications are admitted.

## 6.1 Handling of divisional application

### 6.1.1 Types of divisional application

As types of the divisional application related to foreign language written application, the following cases can be indicated.



### 6.1.2 Cases where original application is made in foreign language, the period for filing a divisional application (Case 1 or Case 2)

The period for filing a divisional application in cases where a foreign language written application is an original application, is basically the same as the period for filing a divisional application in cases where a regular patent application is an original application. However, since the description, etc. of the original application to be divided does not exist until submitting the translation for an original application, the applicant cannot file a divisional application during this period.

### 6.1.3 Points to note on examination

#### (1) Cases where original application is foreign language written application (Case 1 or Case 2)

The document submitted at the filing date of original application is a foreign language document. Therefore, concerning the requirement of “within the matters stated in the description, etc. as of the filing of original application” (See 2.2 and 3.2 of “Part VI Chapter 1 Section 1 Requirements for Division of Patent Application”) among the substantial requirements of division of patent application, the examiner makes a determination based not on the translation of the original application but based on the foreign language document.

However, it is highly possible that the contents of the foreign language document and those of translation correspond with each other. Therefore, it is generally sufficient to make determination based on the translation of the original application.

#### (2) Cases where divisional application is foreign language written application (Case 1 or Case 3)

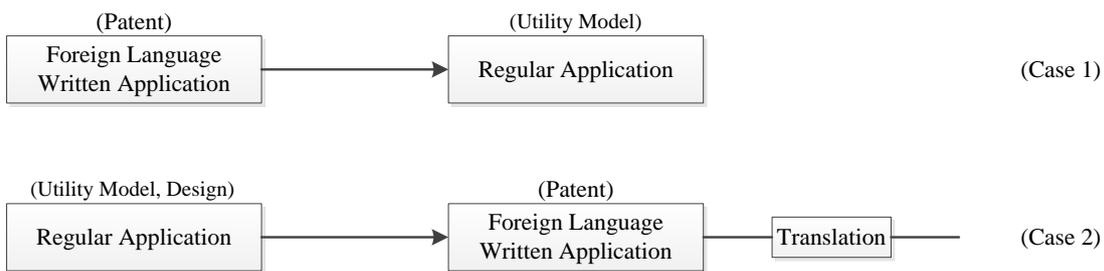
The examiner determines whether the substantial requirements of division of patent application are satisfied based not on the foreign language document but based on the translation deemed as the description, etc., or in cases where amendment has been made after the filing, based on the description, etc. after the amendment.

When the translation deemed as the description, etc., or in cases where amendment has been made after the filing, the description, etc. after the amendment, satisfies the substantial requirements of division of patent application, even if foreign language document does not satisfy the substantial requirements, it is considered that the division of patent application has been appropriately made.

## 6.2 Handling of converted application

### 6.2.1 Types of Converted Application

It is not admitted that an application for utility model registration or application for design registration is made in such a manner as a foreign language written application. Accordingly, as types of the converted application related to foreign language written application, the following cases can be indicated.



### 6.2.2 The period for filing converted application in cases where original application is foreign language written application (Case 1)

The period for filing a converted application in cases where original application is foreign language written application, is same as the period for filing a converted application in cases where original application is a regular patent application.

### 6.2.3 Points to note on examination, etc.

#### (1) Cases Where Original Application is Foreign Language Written Application (Case 1)

The document which has been filed at the filing date of original application is foreign language document. Therefore, the examiner does not determine on the substantive requirements of conversion of patent application based on the translation of original application but based on foreign language document.

However, it is highly possible that the contents of foreign language document and those of translation correspond with each other. Therefore, in cases where translation has been submitted, it is generally sufficient to make determination based on the translation of original application.

#### (2) Cases Where Converted Application is Foreign Language Written Application (Case 2)

The examiner does not determine whether the substantive requirements of conversion of patent application are satisfied based on foreign language document but based on the translation deemed as the description, etc., or in cases where amendment has been made after the filing, based on the description, etc. after the amendment.

When the translation deemed as the description, etc., or in cases where amendment has been made after the filing, the description, etc. after the amendment, satisfies the substantive requirements of conversion of patent application, even if

foreign language document does not satisfy the substantive requirements, it is considered that the conversion of patent application has been lawfully made.

### 6.3 Handling of patent application based on utility model registration

#### 6.3.1 Types of patent application based on utility model registration

It is not admitted that application for utility model registration is made in such a manner as foreign language written application. Accordingly, as types of the patent application based on the utility model registration related to foreign language written application, following case can be indicated.



#### 6.3.2 Points to note on determination

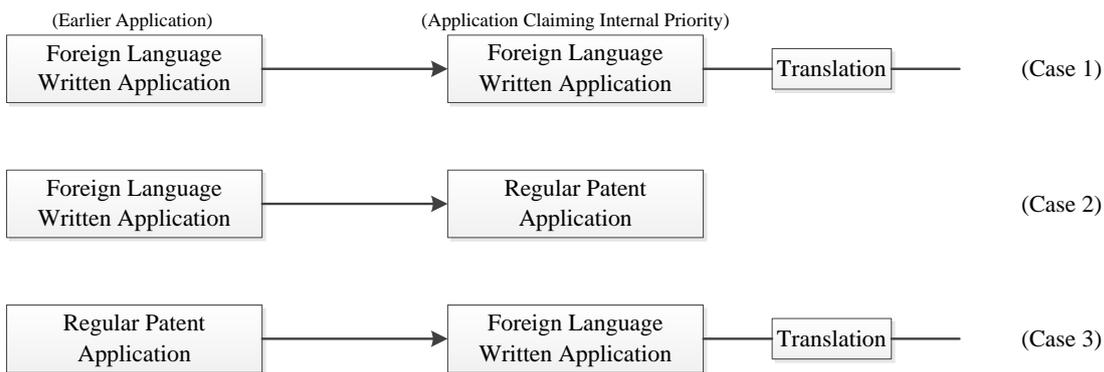
The examiner does not determine whether the substantive requirements of the patent application based on utility model registration are satisfied based on foreign language document but based on the translation deemed as the description, etc., or in cases where amendment has been made after the filing, based on the description, etc. after the amendment.

When the translation deemed as the description, etc., or in cases where amendment has been made after the filing, the description, etc. after the amendment, satisfies the substantive requirements of the patent application based on utility model registration, even if foreign language document does not satisfy the substantive requirements, it is considered that the patent application based on utility model registration has been lawfully made.

### 6.4 Handling of claim of internal priority

#### 6.4.1 Types of claim of internal priority

As types of the claim of internal priority related to foreign Language written application, the following cases can be indicated.



#### 6.4.2 In Cases where earlier application is foreign language written application, the period for claiming internal priority (Case 1 or Case 2)

In cases where earlier application is foreign language written application, the period for claiming internal priority is same as the period for filing a patent application claiming internal priority in cases where earlier application is a regular application.

#### 6.4.3 Points to note on examination

(1) Cases where earlier application which constitutes a basis of claim of internal priority is foreign language written application (Case 1 or Case 2)

In cases where the claimed invention of the application claiming internal priority falls within the matters stated in foreign language document of the earlier application which constitutes a basis of claim of internal priority, the effect of claim of internal priority is admitted (the bracket of main paragraph of Article 41(1)).

However, it is highly possible that the contents of foreign language document and those of translation correspond with each other. Therefore, in cases where translation has been submitted, it is generally sufficient to make determination based on the translation of earlier application.

(2) Cases where the application claiming internal priority is foreign language written application (Case 1 or Case 3)

The examiner determines whether the effect of claim of internal priority is admitted, by comparing earlier application with the translation deemed as the description, etc. of foreign language written application claiming priority, or in cases where amendment has been made after the filing, with the matters stated in the

description, etc. after the amendment.

With regard to the matters stated in earlier application, among the translation deemed as the description, etc. of foreign language written application, or in cases where amendment has been made after the filing, among the description, etc. after the amendment, the effect of claim of internal priority is admitted.

In any case of above (1) and (2), it is sufficient, in principle, to determine whether the effect of claim of internal priority is admitted, only when the prior art and the like which can be a basis of reasons for refusal has been found during the period from the filing date of earlier application to the filing date of the application claiming internal priority, similarly as the regular patent application claiming internal priority.