

# Practice for Patent Application

Japan Patent Office

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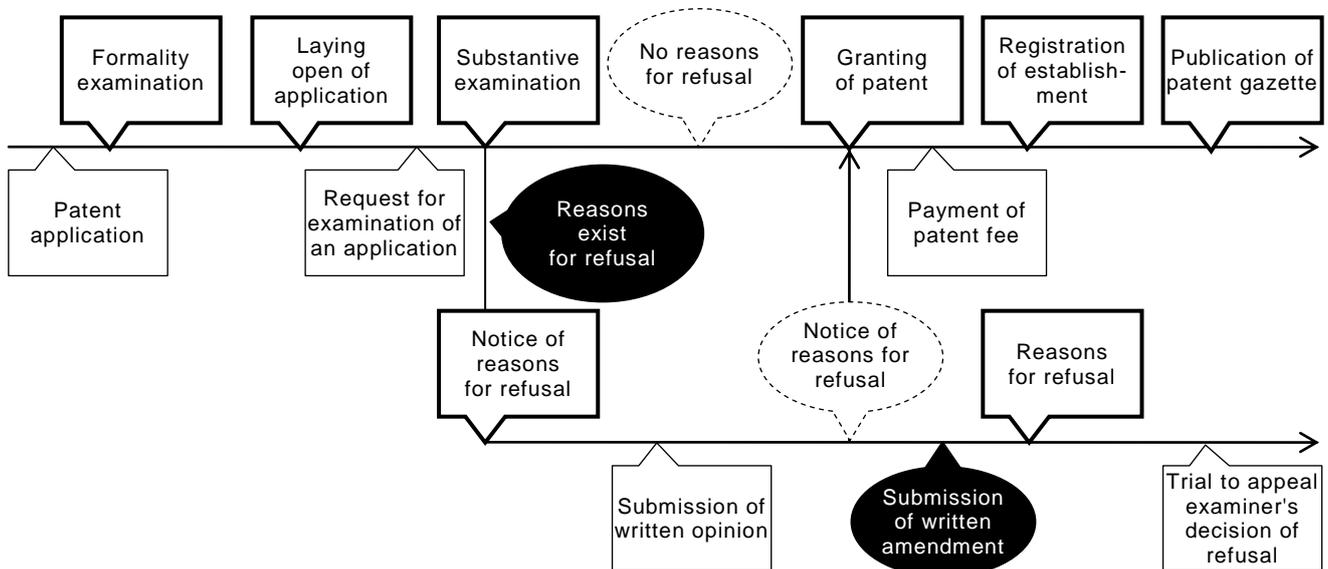
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## I. Patent Application Procedures

### 1. Patent Application Flowchart (Figure 1)



(Figure 1) Flowchart of patent application procedure

The figure above is a general flowchart showing the patent application procedures in Japan—from application to registration.

### 2. Overview

#### 1) Principle of documentary proceeding (Article 1(1) of the Regulations under the Patent Act.)

In principle, patent application and other patent procedures under the Patent Act in Japan shall be in writing.

#### 2) Working language (Article 2(1) of the Regulations under the Patent Act)

In principle, documents shall be written in the Japanese language.

### 3. Patent applications (Article 36)

#### 1) Application documents (Article 36(2))

When filing a patent application, the applicant shall submit the following five documents: (1) Application form, (2) Description, (3) Scope of claims, (4) Required drawings, and (5) Abstract.

#### 2) Application form (Article 36(1))

The “Application form” shall state the following two matters:

- (1) Name and domicile or residence of the applicant(s) for the patent
- (2) Name and domicile or residence of the inventor(s)

#### 3) Description

(1) Role played by the description

The “description” is a written document serving as technical literature that discloses the contents of the invention for which the application is being filed.

(2) Matters to be stated in the description

The description shall state the following three matters: (Article 36(3))

i) The title of the invention

Example) “handkerchief” shall be stated in case of an invention concerning a handkerchief.

ii) A brief explanation of the drawing(s)

Example) [Figure 1] represents a front view of an handkerchief according to an embodiment of the present invention.

iii) A detailed explanation of the invention

(3) Description requirements for a detailed explanation of the invention (Article 36(4))

i) In accordance with the provision under Article 24-2 of the regulations under the Patent Act, the statement shall be clear and sufficient as to enable any person ordinarily skilled in the art (= person skilled in the art) to which the invention pertains to “work” the invention. (Article 36(4)(i))

Specifically, a “detailed explanation of the invention” shall be made by stating the problem to be solved by the invention and its solution, and other matters necessary for a person ordinarily skilled in the art to which the invention pertains, to understand the technical significance of the invention.

A. Case of a product invention

A statement shall be stated clearly and sufficiently as to enable a person skilled in the art to manufacture and use a product pertaining to the claimed invention.

Example) In the case of an invention pertaining to a handkerchief  $\alpha$ , the statement shall be stated clearly and sufficiently as to enable a person skilled in the art to manufacture and utilize the handkerchief  $\alpha$ .

B. Case of a process invention

A statement shall be stated clearly and sufficiently as to enable a person skilled in the art to use the process pertaining to the invention.

Example) In the case of an invention pertaining to a handkerchief sewing inspection process  $\beta$ , the statement shall be stated clearly and sufficiently as to enable a person skilled in the art to use it.

C. Case of a process invention for producing a product

A statement shall be stated clearly and sufficiently as to enable a person skilled in the art to produce a product utilizing the process.

Example) In the case of an invention pertaining to a process  $\gamma$  for producing

a handkerchief, a statement shall be stated clearly and sufficiently as to enable a person skilled in the art to produce it.

- ii) Where the person requesting the granting of a patent has knowledge of any invention(s) related to the claimed invention that has been known to the public through publication (publicly known invention through publication) at the time of filing of the patent application, a “detailed explanation of the invention” shall provide the source of the information concerning the invention(s) known to the public through publication, such as the name of the publication, etc. (Article 36(4)(ii))

Example) Where an applicant X files a patent application for an invention pertaining to a handkerchief  $\alpha$ , and s/he knows the invention  $\alpha'$  published in a magazine P that relates to invention  $\alpha$ , s/he shall state the name of the publication in the detailed explanation of the invention.

#### 4) Scope of claims

##### (1) Role played by the scope of claims

“Scope of claims” serves as a certificate of title defining the content of the patent right, and as a written document defining the subject of the examination concerning patent requirements at the Patent Office.

##### (2) Purport of the scope of claims (Article 36(5))

- i) The “scope of claims” shall state all matters deemed necessary to specify the invention for which the applicant requests the granting of a patent. (Former clause of article 36(5))

Example) Where applicant X of an invention  $\alpha$  pertaining to a handkerchief thinks that a, b, and c are all essential components of the invention, X shall state “a handkerchief  $\alpha$  consisting of a, b, and c” in the scope of claims.

- ii) However, in the “scope of claims,” an invention specified by a statement in one claim may be the same invention specified by a statement in another claim. (Latter clause of the article 36(5))

Example) An invention of a more specific concept pertaining to the following Claim 2 is included in an invention of a more generic concept pertaining to the Claim 1. Therefore, the inventions stated in Claims 1 and 2 are the same invention. In such case, the scope of claims may be stated as follows.

[Claim 1] front view of a polygonal handkerchief

[Claim 2] front view of a rectangular handkerchief

##### (3) Description requirements for the scope of claims (Article 36(6))

- i) The invention for which a patent is sought shall be stated in the “detailed explanation of the invention” of the description. (Article 36(6)(i))
- ii) The invention for which a patent is sought shall be clear. (Article 36(6)(ii))
- iii) The statement for each claim shall be concise. (Article 36(6)(iii))

(4) The statement shall be composed in accordance with Ordinance of the Ministry of Economy, Trade and Industry. (Article 36(6)(iv) of the Patent Act, Article 24-3 of the Regulations under the Patent Act.)

i) For each claim, the statements shall start on a new line, with one number being assigned thereto.

ii) Claims shall be numbered consecutively.

iii) In the statements in a claim, reference to other claims shall be made by the numbers assigned thereto.

iv) When a claim refers to another claim, the claim shall not precede the claim to which it refers.

Example) Legitimate statements of the scope of claims that meet each requirement stated above shall be as follows:

[Claim 1] a handkerchief  $\alpha$

[Claim 2] a manufacturing device  $\beta$  for handkerchief  $\alpha$

#### 5) Required drawings

Drawings shall be submitted where required when filing a patent application. Drawings only serve a supplementary function in facilitating the understanding of the technical contents of the invention for which a patent is sought. Therefore, they are not mandated in Japan as a document to be attached to an application form.

#### 6) Abstract (Article 36(7) of the Patent Act, Article 25-2 of the Regulations under the Patent Act)

The “abstract” shall state a summary of the invention disclosed in the description, scope of claims or drawings, and the number assigned to the drawing most appropriate to be published in the Patent Gazette (= representative drawing.)

### 4. Exception to lack of novelty of invention (Article 30)

#### 1) Outline of the system

Essentially, a patent shall not be granted for an invention that has lost its novelty (each item of Article 20(1)), but an invention that satisfies certain requirements shall be deemed as not having lost its novelty. Such system is called an “exception to the lack of invention novelty.”

#### 2) Reasons for exception to lack of novelty

Exception to lack of novelty shall be applicable in the following two cases:

(1) An invention that has lost its novelty against the will of the applicant (Article 30(1))

“Against the will” applies to a case where an invention has lost its novelty even though an applicant had the intention to keep the invention secret. For example, in the case where an invention is stolen and disclosed by an industrial spy.

(2) An invention that has lost its novelty due to an applicant’s own act (Article 30(2))

In the case where an invention has lost its novelty due to the act of the person having the right to obtain a patent, this provision shall be applied exhaustively. Such cases include inventions made public through the implementation of a test, a printed publication, the Internet, a presentation at an academic conference or a briefing session for investors, a display at an exhibition, or the production and distribution of a patented products.

However, this provision shall not be applicable where an invention has lost its novelty due to the publication of an application filed by a person having the right to obtain a patent in various domestic and foreign bulletins. (Statement in parentheses of Article 30(2))

For example, where X has filed an application A for an invention  $\alpha$ , and the Patent Office has issued an unexamined patent publication pertaining to the application A, X cannot file an application B pursuant to Article 30 concerning the unexamined patent publication pertaining to the application A.

3) Persons to whom this provision is applicable

Article 30 is applicable to “persons having the right to obtain a patent”; that is, “inventors” and persons who “have succeeded to the right to obtain a patent” from the inventor.

4) Objective criteria

An invention that has lost its novelty and an invention for which a patent application is filed need not be identical. For example, where an invention  $\alpha$  has lost its novelty, and an applicant files an application A pertaining to an invention  $\beta$ , Article 30 shall be applicable to invention  $\alpha$ .

5) Time requirements (Article 30(1) and (2))

When seeking the application of Article 30, the application must be filed within six months from the date on which the invention lost its novelty, regardless of the reasons thereof.

6) Procedural requirements (Article 30(3))

Any person seeking the application of Article 30(2) shall submit a written request for the application of Article 30 to the Commissioner of the Patent Office at the time of filing the patent application, and a written certificate required for the application of Article 30 within thirty days from the date of filing the patent application.

However, the procedures above are not required when seeking the application of Article 30(1), since in many cases, it is deemed that the applicants themselves are unaware that the invention has lost its novelty against their will.

7) Legal effect (Article 30(1) and (2))

With the application of Article 30, an invention is deemed as not having lost its novelty.

## 5. Procedures for a priority claim under the Paris Convention (Article 43)

### 1) Submission of a written document stating a request for a priority claim under the Paris Convention (Article 43(1))

A person desiring to take advantage of the priority under the Paris Convention shall submit to the Commissioner of the Patent Office a document stating the following matters, along with the patent application. In practice, however, an applicant may simply state the following matters in the application form:

- (1) Statement of the request for a priority claim under the Paris Convention
- (2) Name of the country belonging to the Union of the Paris Convention where the first foreign application was made
- (3) Date of filing the first foreign application

### 2) Submission of a written document required for the priority claim, etc. (Article 23(2) and (3))

In principle, a person who has made a declaration of priority under the Paris Convention shall submit to the Commissioner of the Patent Office a written document required for the priority claim within one year and four months from the date of first filing.

In principle, s/he shall also submit to the Commissioner of the Patent Office a written document stating the filing number of the first foreign application, along with the documentation required for the priority claim.

### 3) Effect where a document required for the priority claim is not submitted (Article 43(4))

Where a person who has made a declaration of priority fails to submit the documents specified above, the said priority claim shall lose its effect.

However, the patent application itself is effective and still pending before the Patent Office. Also, a patent application shall not be rejected on the grounds that the document required for a priority claim has not been submitted. (Article 4D(4) of the Paris Convention)

### 4) Exchange of data included in the documents required for a priority claim (Article 43(5))

Where a person makes a declaration of priority under the Paris Convention based on an application filed in a country that can exchange data included in the documents required for a priority claim with Japan, the documents required for a priority claim shall be deemed to have been submitted by the submission of the document stating information including the filing number of the first foreign application within one year and four months from the date of filing the first foreign application.

## 6. Foreign language written application (Article 36-2)

### 1) Outline of the system

In principle, the “Foreign language written application” system allows a patent application through the submission of information including a description written in a foreign language specified under article 25-4 of the Regulations under the Patent Act (= English,) instead of the description written in Japanese.

### 2) Handling of a foreign language written application (Article 36-2(1))

#### (1) Application form

The application form shall be written in Japanese even in case of a foreign language application.

#### (2) Foreign language documents

Explanations included in the description, the scope of claims or drawing(s) (where required) may be written in English, and are known as “foreign language documents.”

#### (3) Foreign language abstract

The abstract can be written in English, and is known as a “foreign language abstract.”

### 3) Time limit for the submission of the translation (Article 36-2(2))

However, the applicant for a foreign language written application shall, in principle, submit Japanese translations within one year and two months from the date of filing.

### 4) Handling of a foreign language written application where the translation is not submitted

#### (1) Where the translations of the description and the scope of claims are not submitted (Article 36-2(3))

Where the applicant of a foreign language written application does not submit the translations of foreign language documents (the description and the scope of claims), the patent application shall be deemed to have been withdrawn.

#### (2) Where the translation of the descriptive texts included in the drawings is not submitted

Where the applicant of a foreign language written application does not submit the translation of foreign language documents (descriptive texts included in the required drawings), the drawing(s) of the patent application shall be deemed never to have been submitted.

#### (3) Where the translation of the abstract is not submitted

Where the applicant of a foreign language written application does not submit the translation of the foreign language abstract, the Commissioner of the Patent Office shall issue a procedure amendment order (Article(3)(ii).) Where the

translation of the foreign language abstract is still not submitted, the patent application shall be withdrawn. (Article 18(1))

5) Legal effect of a foreign language written application (Article 36-2(6))

The translations shall be deemed to be the description, scope of claims, required drawings, and the abstract of a normal patent application.

Therefore, the contents stated in the translation shall be the basis on which the contents of the patent right are defined, and become the subject of examination at the Patent Office.

7. International patent application

1) Requirements for international patent applications (Article 184-3(1) and (2))

A patent application shall meet the following three requirements in order to be handled as an “international patent application” in Japan.

(1) It is an international application to which the international application date is accorded based on provisions under the Patent Cooperation Treaty (herein after referred to as “PCT”).

(2) It is an international application that specifies Japan as one of the designated states regulated under Article 4(1)(ii) of the PCT.

(3) It is a patent application

Example) Where X has filed an international application A on July 1, 2013 to the United States Patent and Trademark Office (USPTO) specifying Japan as one of the designated states, and USPTO, the receiving office, has accorded the date of receipt of the international application A as the international filing date, the international application A shall be handled as the international patent application A' in Japan

2) Handling of an international patent application (Article 184-3(1))

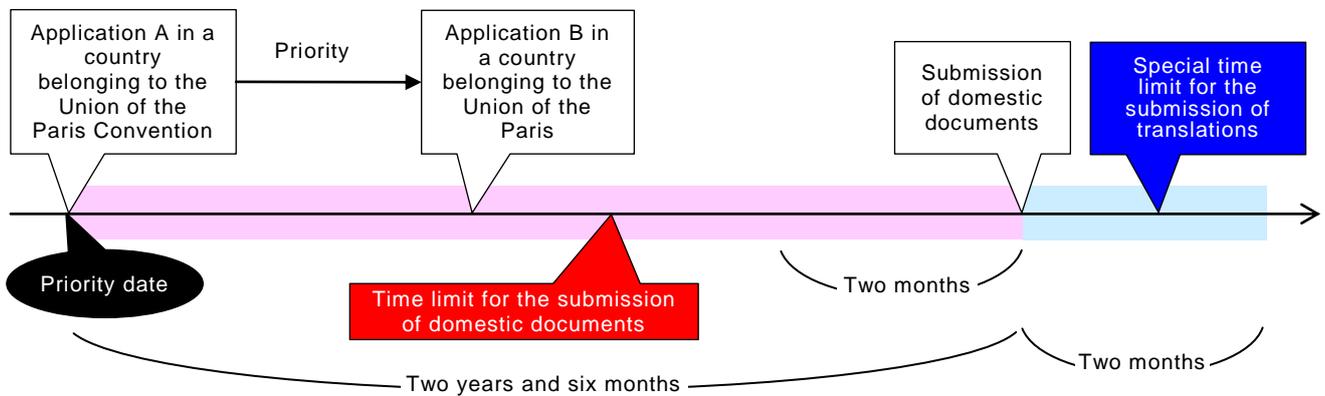
An international patent application shall be deemed to be a patent application filed in Japan on the international application date.

Example) In the example above, the international patent application A' filed by X shall be deemed to be a patent application filed in Japan on July 1, 2013.

3) Types of international patent applications

There are two types of international patent applications: those filed in a foreign language (patent applications in a foreign language) (Article 184-4(1)), and those filed in the Japanese language (patent applications in the Japanese language) (Article 184-6(2)).

4) The time limit for the submission of national documents and the national processing standard time (Figure 2)



(Figure 2) Time limit for the submission of domestic documents/  
special time limit for the submission of translations

(1) National documents (Article 184-5(1))

i) Matters stated in the national documents

The following three matters shall be stated in the national documents:

- A. Name and domicile or residence of the applicant
- B. Name and domicile or residence of the inventor
- C. Matters as provided by Ordinance of the Ministry of Economy, Trade and Industry, including the international application number

ii) Time limit for the submission of national documents

National documents shall be submitted within the time limit for the submission of national documents

iii) Applications for which the submission of national documents is required

All international patent applications require the submission of national documents. Therefore, submission of national documents is required regardless of whether it is a foreign language application or a Japanese application.

(2) The time limit for the submission of national documents (Article 184-4(1))

The “time limit for the submission of national documents” means a period of two years and six months from the priority date specified under Article 2 (xi) of the PCT.

(3) The time limit for the submission of translations (statement in parentheses in Article 184-4(1))

Where national documents are submitted during the period from two months before the expiration of the time limit for the submission of national documents to the expiry date thereof, the two months from the date of submission of the national documents shall be approved as the “special time limit for the

submission of translations.”

(4) National processing standard time (Article 184-4(6))

The national processing standard time refers to the following three timings:

- i) When the time limit for the submission of national documents expires
- ii) When the special time limit for the submission of translations expires (in case where such special time limits exist)
- iii) At the time of requesting where the applicant requests the examination of the application within the time limit for the submission of national documents or the special time limit for the submission of translations

5) National phase entry procedures

(1) National phase entry procedures for a patent application in Japanese language (Article 184-5)

i) Contents of national phase entry procedures

When filing a national phase entry application, an applicant of a patent application in the Japanese language shall undertake the following two procedures within the time limit for the submission of national documents:

- A. Submission of national documents
- B. Payment of fees (¥15,000)

ii) Handling of cases where an applicant fails to undertake procedures for the national phase entry application (Article 184-5(2) and (3))

Where an applicant of a patent application in the Japanese language fails to submit the national documents or pay the fees, the Commissioner of the Patent Office may issue a procedure amendment order. Where the applicant does not adequately respond to the procedure amendment order, the Commissioner of the Patent Office may dismiss the international patent application.

(2) In the case of patent applications in a foreign language (Article 184-4, 184-5)

i) Contents of the national phase entry procedures

When filing a national phase entry application, an applicant of a patent application in a foreign language shall undertake the following three procedures:

- A. Submission of national documents
- B. Payment of fees (¥15,000)
- C. Submission of Japanese translations of documents including the description

ii) Handling of cases where the national documents are not submitted, or the fees are not paid (Article 184-5(2) and (3))

Where the applicant of a patent application in a foreign language fails to submit the national documents or pay the fees within the time limit for the submission of national documents, the Commissioner of the Patent Office may issue a procedure amendment order. Where the applicant does not adequately, the Commissioner of the Patent Office may dismiss the international patent

application.

iii) Translations to be submitted (Article 184-4(1))

An applicant of a patent application in a foreign language shall submit Japanese translations of the description, scope of claims, drawings (the descriptive texts in such drawings only), and the abstract.

That is, s/he does not need to submit Japanese translations of the application form and drawings (diagram parts excluding the descriptive texts in such drawings).

iv) Time limit for the submission of translations (Article 184-4(1))

An applicant of a patent application in a foreign language shall, in principle, submit Japanese translations of documents including the description within the time limit for the submission of the national documents above.

v) Handling of cases where translations are not submitted

A. Handling of the description and scope of claims (Article 184-4(3))

Where an applicant of a patent application in a foreign language does not submit translations pertaining to the description and scope of claims, the international patent application shall be deemed to have been withdrawn.

B. Handling of the descriptive texts in drawings

Where an applicant of a patent application in a foreign language does not submit translations pertaining to the descriptive texts in drawings, the descriptive texts shall be deemed never to have existed.

C. Handling of the draft (Article 184-5(2)(3))

Where an applicant of a patent application in a foreign language does not submit translations pertaining to the draft, the Commissioner of the Patent Office may issue a procedure amendment order. Where the applicant does not adequately respond, the Commissioner of the Patent Office may dismiss the international patent application.

6) Effect of application form, etc. (Article 184-6) (figure 3)

Application in Japanese	Application in a foreign language	Normal patent application
Application form as of the international application date		Application form
Description as of the international application date	Translation of description as of the international application date	Description
Scope of claims as of the international application date	Translation of scope of claims as of the international application date	Scope of claims
Drawings as of the international application date	Translation of drawings as of the international application date	Drawings
Draft	Translation of draft	Draft

(Figure 3) Handling of various documents relating to international patent applications

(1) In the case of patent applications in the Japanese language

In the case of a patent application in Japanese language, the description as of the international application date shall be handled as it is for a description for a normal national application in Japan.

(2) In the case of patent applications in a foreign language

In the case of a patent application in a foreign language, documents including the translations of the description as of the international application date shall be handled as those for normal national applications in Japan.

(3) Handling of the application form

However, an application form as of the international application date shall be positioned as an application form of a normal national application, regardless of whether it is an application in a foreign language or a Japanese application.

8. Unity of invention (Article 37)

1) Contents of the provision

Two or more inventions may be the subject of a single patent application in the same application, provided that these inventions are of a “group of inventions” recognized as fulfilling the requirements of the “unity of invention.”

In order to fulfill the requirements of “unity of invention,” two or more inventions must have a “technical relationship” among them, as specified under Article 25-8 of the Regulations under the Patent Act.

2) Subjects of Examination for Unity of Invention

Whether or not the requirements of a unity of invention are fulfilled shall be judged by examining inventions described in the scope of claims.

In principle, whether or not the requirements of unity of invention are fulfilled shall be judged by a technical relationship among the inventions described in the claims. However, in the case where it is expressed by alternatives in a claim, an examination concerning whether or not the requirements of unity of invention are fulfilled shall be carried out with respect to relationships among the alternatives.

Example) Where element a cannot be said to be a special technical feature, the following cases shall be handled as lacking in unity of invention:

1) [Claim 1] a + b [Claim 2] a + c

2) [Claim 1] a + (b or c)

3) Examples that satisfy the requirements of unity of invention:

(1) Where two or more inventions have the same special technical feature

Example) [Claim 1] Polymeric compound A

[Claim 2] A food packaging container composed of polymeric compound A

(2) Where two or more inventions have corresponding special technical features

Example) [Claim 1] Conductive ceramics made by adding titanium carbide in silicon nitride

[Claim 2] Conductive ceramics made by adding titanium nitride in silicon nitride

(3) Where inventions have a specific relationship

Example) Product and method of producing it, product and machine, etc. for producing it

[Claim 1] A titanium alloy A

[Claim 2] A method for producing titanium alloy A

## **II. Various Procedures Following the Filing of the Application**

### 1. Examination

#### 1) Types of examinations

There are two main types of examinations pertaining to a patent application in Japan: the “formality examination” and the “substantive examination.”

#### 2) Formality examination

##### (1) Examination timing

The formality examination is conducted immediately after the filing of the application.

##### (2) Person who conducts the examination:

The formality examination is conducted by the Commissioner of the Patent Office.

##### (3) Subjects of examination:

The formality examination concerns the procedural requirements and formal requirements pertaining to patent applications.

##### (4) Handling of requirement violations

###### i) In the case of minor violations

Example) Where a seal is not affixed on the document where required

The Commissioner of the Patent Office shall require an applicant to amend a procedure (Article 17(3).) The Commissioner of the Patent Office may dismiss the procedures where an applicant fails to make an amendment (Article 18(1).)

###### ii) In the case of major violations that are not amendable

Example) Where the scope of claims is not attached to a patent application.

After giving the applicant an opportunity to submit a document stating an explanation (Article 18-2(2)), the commissioner of the Patent Office shall dismiss the procedure (Article 18-2(1).)

#### 3) Substantive examination

##### (1) Examination timing (Article 48(2))

The substantive examination shall be initiated after the filing of a request for examination.

##### (2) Persons who may file a request for the examination of an application (Article 48-3(1))

Any person, not only applicants, may file a request for the examination of an application. (Article 48-3(1))

##### (3) Timing of a request for the examination of an application (Article 48-3(1))

In principle, a request for the examination of an application shall be filed within three years from the filing date of the patent application.

##### (4) Withdrawal of a request for the examination of an application (Article 48-3(3))

A request for the examination of a patent application may not be withdrawn.

However, even in the case where a request for the examination of a patent application has been filed, the patent application itself may be withdrawn.

- (5) Handling of cases where a request for the examination of an application is not filed (Article 48-3(4))

Where a request for the examination of an application is not filed, the patent application shall be deemed to have been withdrawn, and the patent shall therefore not be granted.

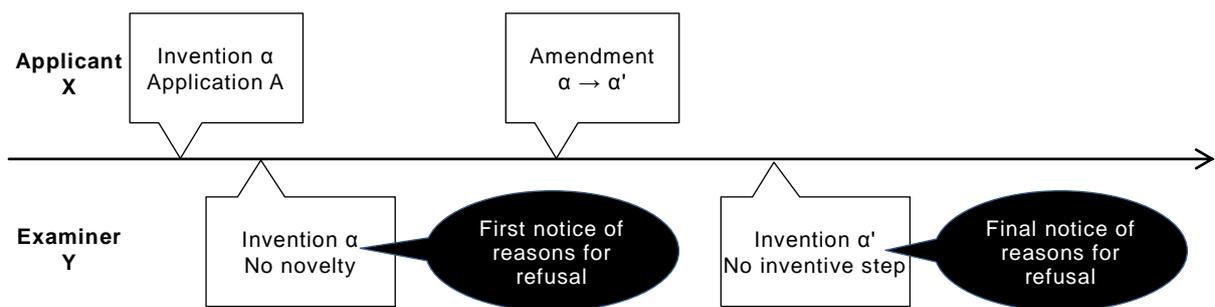
- (6) Person who conducts the substantive examination (Article 47)

The substantive examination shall be conducted by an “examiner” of the Patent Office.

- (7) Subjects of the substantive examination

Subjects of the substantive examination concern the substantive requirements (patentability requirements), such as industrial applicability, novelty, and inventive step.

- 4) Notice of reasons for refusal (Article 50) (figure 4)



(Figure 4) First and final notices of reasons for refusal

“Notice of reasons for refusal” aims to give the applicant an opportunity to submit a written opinion where the examiner finds reasons for refusal for the patent application, as well as to give the examiner an opportunity to reexamine the application on the basis of the written opinion submitted by the applicant.

There are two types of notice of reasons for refusal: “First notice of reasons for refusal” and “Final notice of reasons for refusal.”

The “First notice of reasons for refusal” is the first-time notice for an applicant that points out the reasons for refusal.

The “Final notice of reasons for refusal” notifies only the reasons for refusal necessitated by an amendment made in response to “the first notice of reasons for refusal.”

- 5) Final decision

The “final decision” is the conclusion made by an examiner on the substantive examination conducted by him/herself.

There are two types of final decisions: “Decision to grant a patent” and “Decision of refusal.”

(1) Decision to grant a patent (Article 51)

“Decision to grant a patent” is a decision to grant a patent rendered by an examiner where no reasons for refusal are found with regard to the patent application.

Where a decision to grant a patent is rendered, an applicant shall in principle pay patent fees for each year during the period from the first year to the third year within 30 days from the date on which a certified copy of the examiner’s decision to grant a patent has been served. (Article 108(1))

The establishment of a patent right shall be registered (Article 66(2)) and a patent right shall become effective (Article 66(1)), upon the payment of the patent fees above by the applicant.

(2) Decision of refusal (Article 49)

“Decision of refusal” is a decision to refuse a patent rendered by an examiner where the reasons for refusal are still unsolved even though an examiner has notified an applicant of the reasons for refusal.

An applicant who is dissatisfied with the decision of refusal may further file a request for a trial against the examiner’s decision of refusal (Article 121).

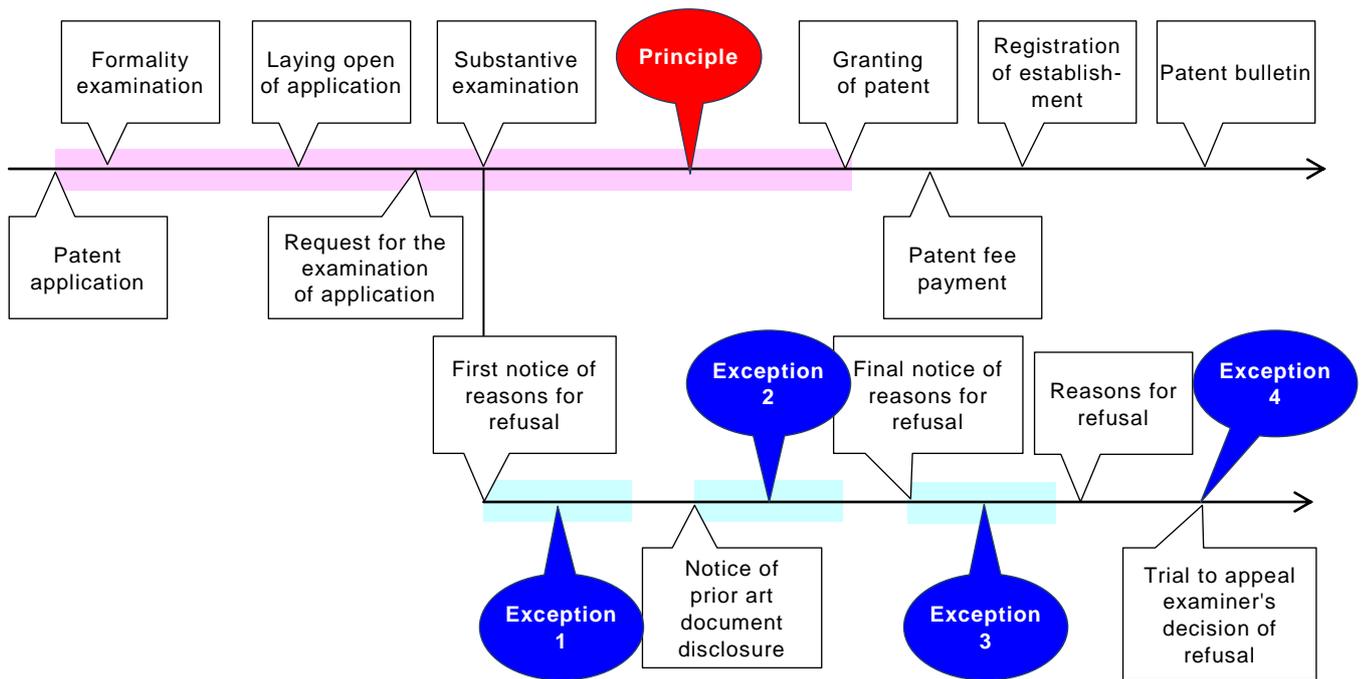
## 2. Amendments

1) Person who may make an amendment (Main clause of Article 17-2(1))

The “applicant” can make an amendment.

Each applicant can make an amendment independently in case of a joint application.

## 2) Timing of the substantive amendment (Article 17-2(1)) (Figure 5)



(Figure 5) Timing of amendments

### (1) Timing in principle (Body of Article 17-2(1))

In principle, an applicant may make an amendment during the period from the filing of a patent application to the delivery of a certified copy of the examiner's decision to grant a patent.

### (2) Exceptional timing (Each item of Article 17-2(1))

However, an amendment may only be made under the following timings, in cases where an applicant has received a notice of reasons for refusal from the examiner:

- i) Within the designated time limit for the submission of a written opinion where an applicant has received the first notice of reasons for refusal.
- ii) Within the time limit designated in the notice where an applicant has received a notice requesting the disclosure of prior art documents after the receipt of a notice of reasons for refusal.
- iii) Within the time limit designated in the final notice of reasons for refusal, where an applicant has received a further notice of reasons for refusal after the receipt of the first notice of reasons for refusal.
- iv) At the same time as the filing of a request for a trial against an examiner's decision of refusal, where an applicant files such a request.

## 3) Scope of amendment (Article 17-2(3))

### (1) Scope of amendment in principle

An amendment shall be made within the scope of the matters stated in the description, scope of claims, or drawings (hereinafter, “description, etc.”) originally attached to the application.

For example, where the description originally attached to the application only states “front view of a rectangular handkerchief,” an amendment stating “a polygonal handkerchief in the front view” is, in principle, not approvable.

(2) Special provisions concerning a foreign language written application (Article 17(2))

i) Handling of foreign language documents and foreign language abstracts

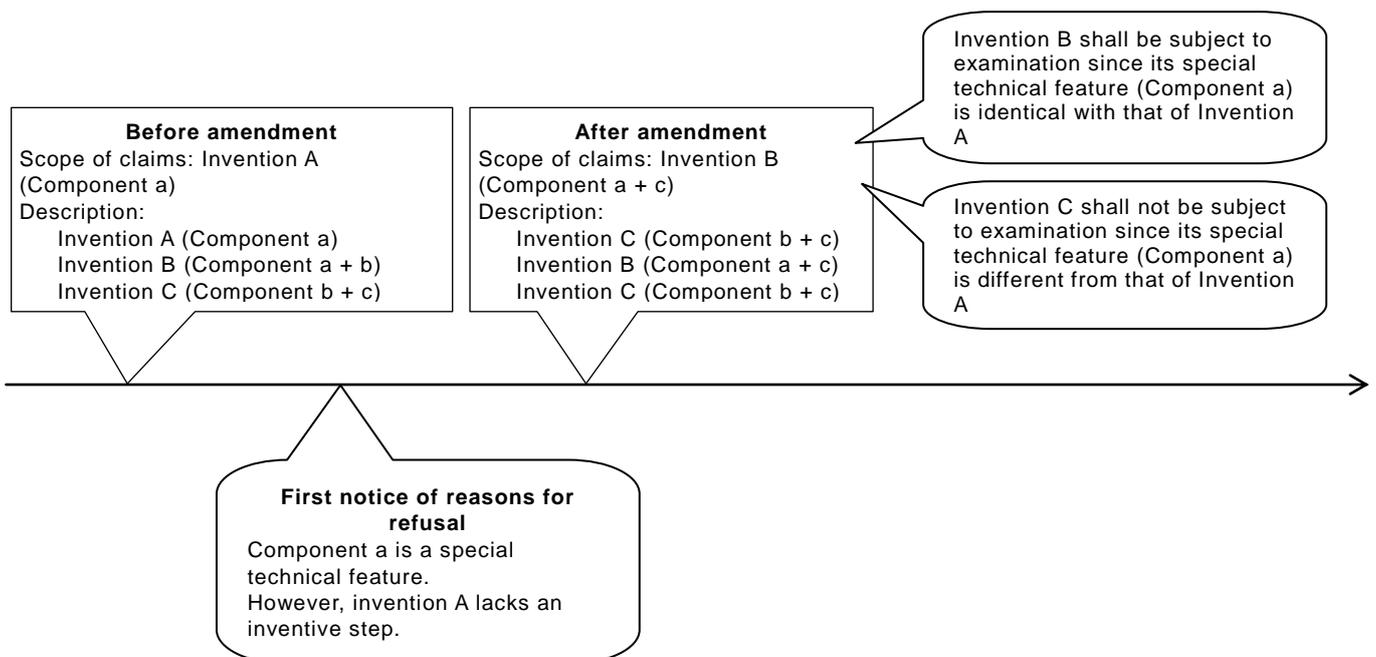
An applicant may not amend foreign language documents and foreign language abstracts themselves (= original texts).

ii) Scope of amendment based on the statement of correction of an incorrect translation (Article 17-2(2))

Where an applicant makes an amendment based on the statement of correction of an incorrect translation, s/he may make an amendment within the scope of the matters stated in the foreign language documents.

For example, in cases where inventions  $\alpha$  and  $\beta$  are stated in the foreign language documents of a foreign language written application, but invention  $\alpha$  alone is stated in the translation, an amendment may be made within the scope of the inventions  $\alpha$  and  $\beta$  stated in the foreign language documents through the submission of the statement of correction of an incorrect translation.

4) Restriction on the amendment of inventions lacking in unity of invention (Article 17-2(4)) (Figure 6)



(Figure 6) Restriction on the amendment of inventions lacking in unity of invention

This provision restricts the amendment of the “scope of claims” made after the receipt of the “first notice of reasons for refusal.”

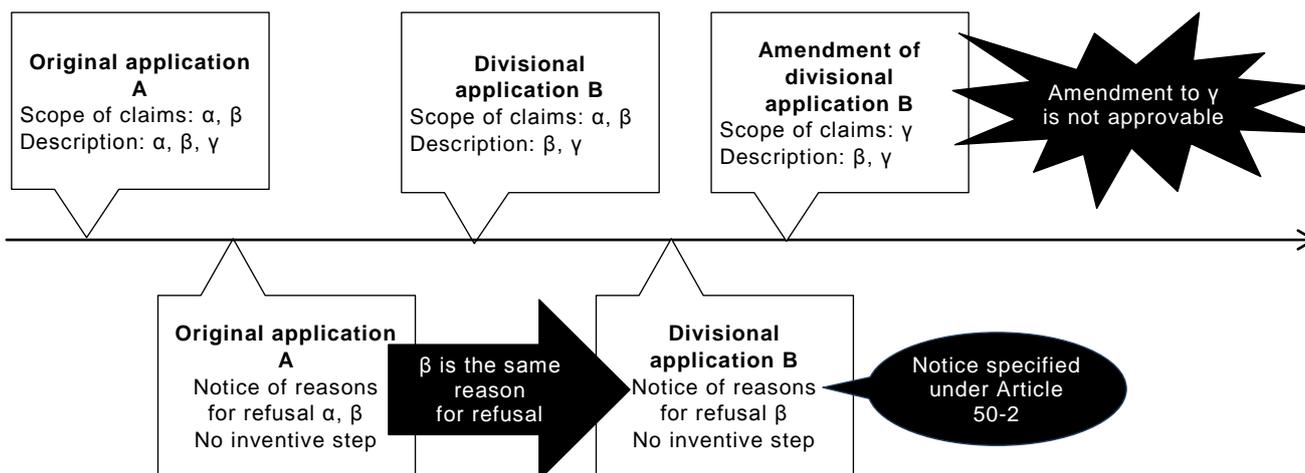
In this case, the invention for which determination of patentability is stated in the notice of reasons for refusal received prior to making the amendment, and the invention described in the amended scope of claims, shall fulfill the requirements of “unity of invention” stated above.

5) Restriction on the amendment of the scope of claims (Article 17-2(5))

(1) Cases where this provision is applied

This provision restricts the amendment of the “scope of claims” made at the following three times:

- i) When the final notice of reasons for refusal is received
- ii) When a request for a trial against an examiner’s decision of refusal is filed
- iii) When the first notice of reasons for refusal is received at the same time as the notice specified under Article 50-2. (figure 7)



(Figure 7) Restriction on the amendment of inventions in case of receipt of notice as specified under Article 50-2

(2) Contents of amendments approved under this provision

Amendments of the “scope of claims” made at the above stated times shall be limited to those for the following purposes:

- i) Deletion of a claim
  - Example) Before amendment
  - [Claim 1] Invention α → deletion
  - [Claim 2] Invention β
  - After amendment

[Claim 1] Invention β

ii) Restriction of the scope of claims in a limited way

Example) Amendment of the scope of claims from “a polygonal handkerchief in the front view” to “a rectangular handkerchief in the front view.”

iii) Correction of errors

Example) Amendment of an erroneous description, “male body” (男性体), to the correct description, “elastic body” (弾性体), stated in the scope of claims of a patent application pertaining to an invention concerning “elastic body.”

iv) Clarification of an ambiguous statement

6) Amendment procedures

(1) Normal amendment procedures

For any amendment of procedures, written amendment shall be submitted in writing. (Article 17(4))

(2) Procedures to correct an incorrect translation

Where an applicant of a foreign language written application corrects an incorrect translation concerning a foreign language written application, the applicant shall submit the statement of correction of the incorrect translation, stating the grounds thereof, and pay an additional fee of ¥19,000. (Article 17-2(2))

7) Effect of the amendment

Amendment shall be effective retroactively as of the filing of a patent application. Therefore, the amended contents are deemed to be the contents of the patent application originally filed.

3. Division of patent application (Article 44)

1) Outline of the system

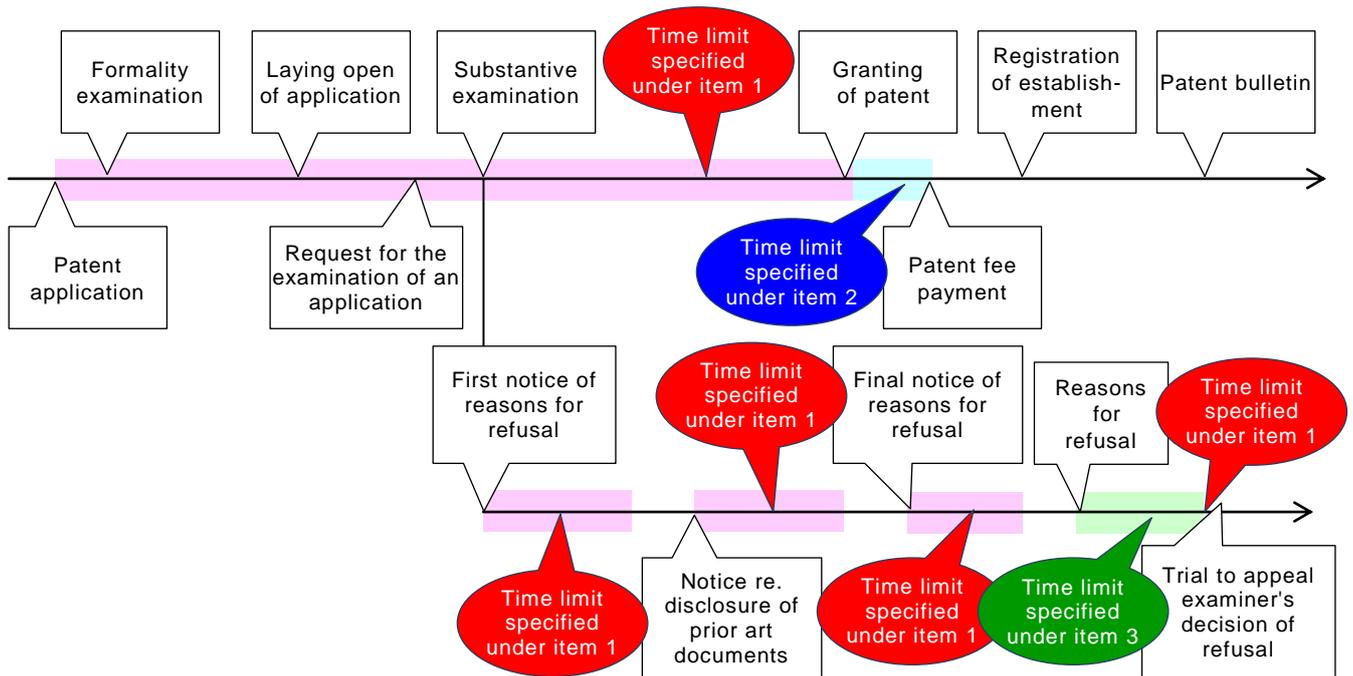
An applicant for a patent may extract one or more new patent applications out of a patent application containing two or more inventions.

2) Persons who may divide an application

The applicant of the application to be divided (original application) must be identical to that of the new application emerging from the division (divisional application) at the time of division.

Where the original application is a joint application, the application must be divided by all applicants. (Article 38)

### 3) Time requirements (Article 44(1)) (Figure 8)



(Figure 8) Time requirements for divisional applications

#### (1) Principle

Application can be divided, in principle, at the following three times:

- i) Within the time limit by which the description, etc. may be amended (Article 44(1)(i))
- ii) Within 30 days from the date on which a certified copy of an examiner's decision that a patent is to be granted has been transmitted (Article 44(1)(ii))
- iii) Within three months from the date on which a certified copy of an examiner's initial decision of refusal has been transmitted (Article 44(1)(iii))

#### (2) Special provisions concerning a foreign language written application

However, a foreign language written application can be divided only after the submission of a translation.

#### 4) Objective requirements

Objective requirements for divisional applications vary depending on the timing of the divisional application.

(1) The following two objective requirements shall be fulfilled, in case of divisional applications, within the time limit by which the description may be amended:

- i) The claimed inventions of the divisional application shall not comprise all of the inventions detailed in the description of the original application immediately prior to being divided.

Example) In the case of an original application A comprising inventions  $\alpha$  and  $\beta$ ,

a divisional application B consisting of the invention  $\alpha$  alone is approvable, while a divisional application C consisting of both inventions  $\alpha$  and  $\beta$  is not approvable.

- ii) Matters detailed in the description of the divisional application shall be within the scope of matters detailed in the description of the original application as of the filing.

Example) In the case of an original application A comprising inventions  $\alpha$  and  $\beta$ , a divisional application B consisting of the invention  $\alpha$  alone is approvable, while a divisional application C consisting of an invention  $\gamma$  that is not stated in the description of the original application A as of the filing is not approvable.

- (2) Where divisional applications are made not within the time limit for amendments of descriptions, the following requirement shall be fulfilled in addition to the two objective requirements mentioned above:

Matters detailed in the description of the divisional application shall be within the scope of matters detailed in the description of the original application immediately prior to being divided.

Example) In cases where the amendment to delete the invention  $\gamma$  is made to an original application A comprising of inventions  $\alpha$ ,  $\beta$  and  $\gamma$ , a divisional application B consisting of the invention  $\alpha$  alone is approvable, while a divisional application C consisting of the invention  $\gamma$  is not approvable.

#### 5) Procedural requirements

- (1) The following two procedures are required in order to divide applications:

- i) A procedure for a new patent application
- ii) Amendment to delete the invention for which a divisional application has been filed from the scope of claims of the original application. (Article 30 of the Regulations under the Patent Act)

Example) Where filing a divisional application B consisting of invention  $\alpha$  based on an original application A consisting of inventions  $\alpha$  and  $\beta$ , the divisional application B is deemed to have been filed at the time of filing of the original patent application A. Therefore, unless invention  $\alpha$  is deleted from the scope of claims for the original application A, the original application A and the divisional application B are deemed to be overlapping patent applications pertaining to the identical invention  $\alpha$  filed on the same day, and one or both the applications shall be rejected. Therefore, an amendment is necessary to delete the invention  $\alpha$  from the scope of claims of the original application A.

- (2) Where procedures for an application of exception to lack of novelty of invention and a priority claim have been undertaken at the time of filing an original application, those procedures need not be undertaken again at the time of filing a divisional application.

Example) Where procedures for an application of Article 30 has been undertaken concerning an original application A consisting of inventions  $\alpha$  and  $\beta$ , procedures for an application of Article 30 need not be undertaken again at the time of filing a divisional application B consisting of invention  $\alpha$  alone.

#### 6) Legal effect of divisional applications

##### (1) Where a divisional application is legal

A divisional patent application shall be deemed to have been filed at the time of retroactively filing an original patent application. (Main clause of Article 44(2))

Example) Where X has filed a divisional application B stating an invention  $\beta$  in the scope of claims, etc. based on an original application A stating an invention  $\alpha$  in the scope of claims and inventions  $\alpha$  and  $\beta$  in the description, and Y has presented the invention  $\beta$  at an academic conference after the original application A, the divisional application B is deemed to have novelty, and shall therefore not be rejected.

##### (2) Where a divisional application is illegal

A divisional patent application shall not be deemed to have been filed at the time of filing an original patent application retroactively.

Failure to fulfill the requirements for divisional applications shall not directly constitute reasons for refusal or invalidation. However, they may eventually constitute reasons for refusal or invalidation, since the time of filing of the divisional application shall be the actual time of doing so (the actual time of the filing).

Example) Where X has filed a divisional application C stating an invention  $\gamma$  in the scope of claims based on an original application A stating an invention  $\alpha$  in the scope of claims and inventions  $\alpha$  and  $\beta$  in the description, and Y has presented the invention  $\gamma$  at an academic conference after the original application A and before the divisional application C, the divisional application C is deemed to lack novelty, and shall therefore be rejected.

#### 4. Conversion of application (Article 46)

##### 1) Outline of the system

This system allows an applicant of a utility model registration or a design registration to convert the application into a patent application.

##### 2) Persons who may convert to a patent application (Article 46(1) and (2))

The applicant of the original application must be identical to the applicant of the converted application at the time of filing the converted application.

In the case where the original application is a joint application, the application must be converted by all applicants. (Article 14)

##### 3) Time requirements

(1) In the case of a conversion from a utility model application to a patent application (Article 46(1))

i) First, the utility model registration application needs to be pending before the Patent Office (Main clause of Article 46(1))

That is, a utility model application may be converted to a patent application during the period after the filing of a utility model application before the establishment and registration of the utility model right.

ii) However, a utility model application may not be converted to a patent application after three years from the date on which the utility model application was filed, even though the application is still pending before the Patent Office. (Conditional clause of Article 46(2))

(2) In the case of a conversion from a design application to a patent application (Article 46(2))

i) The design application needs to be pending before the Patent Office (Main clause of Article 46(2))

That is, a design application may be converted to a patent application during the period after the filing of a design application before the establishment and registration of the design right.

ii) However, a design application may not be converted to a patent application after three months from the date on which the certified copy of the examiner's initial decision for refusal has been served, even though the design model is still pending before the Patent Office. (Conditional clause of Article 46(2))

iii) In principle, a design application may not be converted to a patent application after three years from the date on which the design application was filed, even though the design application is still pending before the Patent Office. (Conditional clause of Article 46(2))

#### 4) Objective requirements

The following two objective requirements shall be fulfilled in order to convert a utility model application or a design application to a patent application.

(1) Matters detailed in the description of the converted application shall be within the scope of matters detailed in the description of the original application as of the filing.

Example) A utility model application A consisting of devices  $\alpha$ ,  $\beta$ , and  $\gamma$  can be converted to a patent application B consisting of  $\alpha$  and  $\beta$  alone, and also to a patent application C consisting of all of  $\alpha$ ,  $\beta$ , and  $\gamma$ .

(2) However, in the case of a conversion not within the time limit for amendments of an original application, matters detailed in the description of the converted application shall be within the scope of matters detailed in the description of the original application immediately prior to being converted.

Example) Where an amendment to delete the device  $\gamma$  has been made to a utility model application A consisting of devices  $\alpha$ ,  $\beta$ , and  $\gamma$ , the application can be converted to a patent application B consisting of devices  $\alpha$  and  $\beta$  alone, but cannot be converted to a patent application C consisting of all of  $\alpha$ ,  $\beta$ , and  $\gamma$ .

#### 5) Procedural requirements

- (1) Conversion of an application requires a procedure for filing a new patent application.
- (2) Where procedures for an application of exception to lack of novelty of invention and priority claim have been undertaken at the time of filing an original application, such procedures need not be undertaken again at the time of filing a converted application (*mutatis mutandis* application under Article 44(4)).
- (3) Authorized agents, such as patent attorneys, may not file a converted application unless expressly empowered to do so. (Article 9)

#### 6) Legal effect of a converted application

##### (1) Where a converted application is legal

A converted patent application shall be deemed to have been filed at the time of filing of an original patent application retroactively (*mutatis mutandis* application under the main clause of Article 44(2)).

However, unlike the case of a divisional application, the original application is deemed to have been withdrawn. (Article 46(4))

##### (2) Where a converted application is illegal

A converted patent application shall not be deemed to have been filed at the time of filing of an original patent application retroactively.

Failure to fulfill the requirements for converted applications shall not directly constitute reasons for refusal or invalidation, however, as is the case with a divisional application. It may eventually constitute reasons for refusal or invalidation, since the time of filing of the converted application shall be the actual time that filing occurs (the actual time of filing).

Even in the case where a converted application has no retroactive effect, the original application is deemed to have been withdrawn. (Article 46(4))

### 5. Patent applications based on utility model registration (Article 46-2)

#### 1) Outline of the system

This system allows a holder of utility model right to file a new patent application based on his/her own utility model registration.

#### 2) Persons who may file applications for patents based on utility model registration (Article 46-2(1))

The applicant of a patent application based on utility model registration must be the "owner of the utility model right." (Article 46-2 (1))

### 3) Time Requirements (Each item of Article 46-2(1))

A patent application based on utility model registration can be filed except for the following four cases:

- (1) Where three years have lapsed from the date of filing of an application for the said utility model registration (Article 46-2(1) (i))
- (2) Where a petition requesting the examiner's technical opinion as to the registrability of the utility model (utility model technical opinion) is filed by the utility model right holder (Article 46-2(1) (ii))
- (3) Where 30 days have lapsed from the date of receiving an initial notice pertaining to a petition requesting the utility model technical opinion filed by a third party (Article 46-2(1) (iii))
- (4) Where an invalidation trial against the utility model registration has been filed, the time limit initially designated for the submission of a written answer has expired

### 4) Objective requirements (Main clause of Article 46-2(2))

In order to file a patent application based on utility model registration, the following two objective requirements shall be fulfilled:

- (1) Matters detailed in the description attached to the patent application based on utility model registration shall be within the scope of matters detailed in the description attached to the request for utility model registration on which the said patent application is based (Article 46-2(2)).

Example) Where a utility model right B was registered after an amendment to delete device  $\beta$  was made to a utility model registration application A, consisting of devices  $\alpha$  and  $\beta$ , an application C based on a utility model registration consisting of the device  $\alpha$  alone is approvable, whereas an application D based on a utility model registration consisting of devices  $\alpha$  and  $\beta$  is not approvable.

- (2) Matters detailed in the description attached to the patent application based on utility model registration shall be within the scope of matters detailed in the description as of the filing of the application for utility model registration of the utility model registration on which the said patent application is based.

Example) Where a utility model registration application A consisting of the device  $\alpha$  alone has been filed and a utility model B is registered, an application C based on a utility model registration consisting of the device  $\alpha$  alone is approvable, whereas an application D based on a utility model registration consisting of devices  $\alpha$  and  $\beta$  is not approvable.

### 5) Procedural requirements

In order to file a patent application based on utility model registration, the following procedures need to be undertaken:

- (1) A procedure for a new patent application

- (2) Waiver of utility model right (Article 46-2(1))
- (3) Where there is an interested person, such as an exclusive licensee of a utility model right, the consent of the said person shall be obtained concerning an “abandonment of utility model right” (*mutatis mutandis* application under Article 97(1)), and “filing of a patent application based on utility model registration.” (Article 46-2(4)), respectively.
- (4) Where procedures for an application of exception to lack of novelty of invention and a priority claim have been undertaken at the time of filing an original application, those procedures need not be undertaken again at the time of filing an application based on utility model registration (*mutatis mutandis* application under Article 44(4)).
- (5) Authorized agents, such as patent attorneys, shall not file an application based on utility model registration unless expressly empowered to do so. (Article 9)
- 6) Legal effect of a patent application based on utility model registration
- (1) Where a patent application based on utility model registration is legal, the patent application shall be deemed to have been filed at the time of filing of an original utility model registration application retroactively. (Main clause of Article 46-2(2))  
However, a patent application based on utility model registration and the original utility model registration application are not deemed as applications pertaining to an identical invention or device filed on the same day. (Statement in parentheses of the Article 39(4))  
For example, where filing a patent application C pursuant to Article 46-2 based on a utility model registration B obtained pertaining to a utility model registration application A, C is deemed to have been filed at the time of the filing of A. However, C and A are not deemed as applications pertaining to an identical invention or device filed on the same day. Consequently, C shall not be rejected in connection with A.  
A patent application based on utility model registration cannot be converted back to a utility model registration application again. (Statement in parentheses of Article 10(1), (2) of the Utility Model Act)
- (2) Where a patent application based on utility model registration is illegal, the patent application shall not be deemed to have been retroactively filed at the time of filing an original utility model registration application.  
Such application is usually rejected due to the lack of novelty based on the utility model registration application published in the utility model bulletin on which the said application is based.  
For example, where filing a patent application C based on a utility model registration B obtained pertaining to a utility model registration application A, C is not deemed to have been filed at the time of filing A. Therefore, C shall be

rejected due to the lack of novelty based on a utility model bulletin published concerning a utility model registration B.

## 6. Internal priority (Article 41)

### 1) Outline of the system

The internal priority system enables an applicant to file a later patent application based on an earlier patent application filed by him/herself. In application of certain provisions to the later application, determination shall be made setting the date of filing of the earlier application to be the standard.

### 2) Persons who may claim priority

- (1) An applicant of the earlier application on which the priority claim is based, (hereinafter, "earlier application") and an applicant of the later application that claims internal priority (hereinafter, "later application"), shall be the same at the time when the later application is filed. (Body of Article 41(1))

For example, when filing a patent application B claiming priority based on an earlier application A, the applicants of A and B must be the same person X at the time that the later application is filed.

- (2) However, where the earlier application is a joint application, the later application must be filed by all the applicants. (Article 14)

In the case of the example above, where the earlier application A is a joint application by X and Y, the later application shall also be jointly filed by X and Y.

### 3) Objective requirements

In order to claim internal priority, all of the following five requirements shall be fulfilled:

- (1) The invention that is the subject of a priority claim shall be stated in the scope of claims of the later application. (Body of Article 41(1))

- (2) The earlier application shall be a patent application or a utility model registration application as of filing. (Body of Article 41(1))

That is, internal priority cannot be claimed based on a "design registration application" or "trademark registration application."

- (3) The invention that is the subject of a priority claim shall be stated in the original description of the earlier application as of the filing. (Body of Article 41(1))

However, in cases where the earlier application was a foreign language written application, internal priority can be claimed in the scope of matters stated in the foreign language documents. (Body of Article 41(1))

For example, concerning a foreign language written application A, where inventions  $\alpha$  and  $\beta$  are stated in the foreign language documents while invention  $\alpha$  alone is stated in the translation, the applicant can file application B that claims internal priority concerning  $\beta$ .

(4) The earlier application shall not be a divisional application, a converted application, or an application based on utility model registration (Article 41(1)(ii))

(5) The earlier application shall be pending before the Patent Office.

That is, the earlier application on which priority claim is based shall not have been waived, withdrawn, or dismissed; the examiner's decision or the trial decision on the said application shall not have become final and binding (Article 41 (1)(iii)(iv)); and the registration of utility model right establishment with regard to the said application shall not have been effected. (Article 41 (1) (v))

#### 4) Time requirements (Article 41(1)(i))

In order to claim internal priority, the later application shall be filed within one year from the date of the filing of the earlier application.

For example, when filing an application B pertaining to inventions  $\alpha$  and  $\beta$  claiming priority based on the earlier application A pertaining to invention  $\alpha$ , B shall be filed within one year from the date of filing A.

#### 5) Procedural requirements (Article 41(4))

(1) A person requesting a priority claim shall submit to the Commissioner of the Patent Office a "document stating thereof" and the "indication of the earlier application" at the same time as filing a later application.

(2) Where an authorized agent such as a patent attorney files a patent application claiming internal priority, s/he must be expressly empowered to do so. (Article 9)

#### 6) Legal effect (Article 41(2))

Where an invention that is the subject of priority claim is stated in the description originally attached to the earlier application as of the filing of the earlier application, judgments shall be made concerning requirements for patentability and the relation of earlier and later applications, setting the date of filing the earlier application as the standard.

For example, where X files a later application B pertaining to inventions  $\alpha$  and  $\beta$  claiming priority based on an earlier application A pertaining to the invention  $\alpha$ , the later application B shall be deemed to have been filed at the time when the earlier application A was filed. Therefore, where Y files an application C pertaining to the invention  $\alpha$  later than the application A but earlier than the application B, B is deemed to be a prior application and shall obtain a patent for  $\alpha$ .

#### 7) Deemed withdrawal of the earlier application (Article 42(1))

The earlier application on which a priority claim is based shall be deemed to have been withdrawn when one year and three months has lapsed from the filing date of the earlier application.

In the case of the example above, the earlier application filed by X shall be deemed to have been withdrawn when one year and three months has lapsed from the filing date of the earlier application.

## 7. Trial to appeal an examiner's decision of refusal (Article 121)

### 1) Outline of the system

A "trial to appeal an examiner's decision of refusal" refers to the trial proceedings conducted by a panel of trial examiners, where an applicant is dissatisfied with an examiner's decision of refusal. (Article 121)

### 2) Persons who may request a trial

(1) A "person who has received an examiner's decision of refusal" may request a trial to appeal the examiner's decision of refusal. (Article 121(1))

(2) In the case of an examiner's decision of refusal for a joint application, the request for a trial to appeal examiner's decision of refusal needs to be filed by all applicants. (Article 132(3))

For example, in case of an examiner's decision of refusal for a joint application A filed by X and Y, X and Y shall jointly file the request for a trial against examiner's decision of refusal.

### 3) Time limit for a request for a trial (Article 121(1))

In principle, a request for a trial against an examiner's decision of refusal shall be filed within 30 days from the date the certified copy of the examiner's decision has been served.

### 4) Subject of a trial request

(1) A trial to appeal an examiner's decision of refusal judges whether or not there are reasons for refusal (each item of Article 49) for an invention claimed in a patent application.

Therefore, the subject of a trial to appeal an examiner's decision of refusal is not limited to whether or not there are reasons for refusal pointed out in the examiner's decision of refusal.

For example, where an examiner has rendered a decision of refusal for a patent application A based on the lack of novelty, a trial examiner may judge the existence of an inventive step in a trial to appeal an examiner's decision of refusal and render a trial decision for refusal based on the lack of an inventive step.

(2) A trial to appeal an examiner's decision of refusal shall not be requested on a claim by claim basis.

For example, where an examiner's decision of refusal is rendered for a patent application A consisting of Claims 1 and 2, a trial to appeal an examiner's decision of refusal concerning Claim 2 alone cannot be requested, even though an applicant wishes to obtain a patent for Claim 2 alone.

### 5) Continuous deliberation principle (Article 158)

Any procedure taken during the examination procedure shall also be effective in a

trial to appeal an examiner's decision of refusal.

For example, in a trial to appeal an examiner's decision of refusal for patent application A, an applicant does not need to resubmit material  $\alpha$  that s/he has submitted for the examination, and the trial examiner does not need to reexamine the same evidence concerning the material  $\alpha$  that was already examined by the examiner.

#### 6) Conclusion of a trial

A trial to appeal an examiner's decision of refusal shall conclude in the following cases:

- (1) An applicant may withdraw their request for a trial to appeal an examiner's decision of refusal before a trial decision becomes final and binding. (Article 155(1))
- (2) An unlawful request for a trial, such as a request for a trial to appeal an examiner's decision of refusal not filed within the time limit for a request for a non-amendable trial to appeal an examiner's decision of refusal stated above, may be dismissed by a trial decision. (Article 135)
- (3) Where a claim is rejected in a trial to appeal an examiner's decision for refusal, a "trial decision to reject the claim to appeal the examiner's decision" shall be rendered.

Where an applicant is dissatisfied with this trial decision, s/he may bring an action to the Tokyo High Court for the rescission of this trial decision within 30 days from the date on which a certified copy of the trial decision has been served. (Article 178(1)(3))

- (4) Where a claim is approved in a trial to appeal an examiner's decision for refusal, a "trial decision to approve the claim against the examiner's decision" shall be rendered.

In this case, where patent fees for each year during the period from the first to the third year have been paid within 30 days from the date on which a certified copy of the trial decision has been served (Article 108(1)), the establishment of a patent right shall be registered and an applicant may obtain a patent right (Article 66(1)(2)).

#### 7) Reconsideration by examiner before appeal

##### (1) Outline of the system (Article 162)

As for an application for which a request for a trial to appeal an examiner's decision of refusal has been filed, and to which an amendment has been made simultaneously with the filing of the request, the original examiner reconsiders the application prior to the trial by a trial examiner. This is called "reconsideration by examiner before appeal".

For example, where X, whose patent application A has been refused by examiner

Y, files a request for a trial to appeal the examiner's decision of refusal and simultaneously makes an amendment to delete the claim, application A shall be the subject of reconsideration by an examiner before the appeal, and be examined by the examiner Y first, not by a trial examiner.

(2) Conclusion of reconsideration by examiner before appeal

- i) Where the reasons for refusal are resolved, the examiner who has reconsidered the application shall decide to grant a patent and reconsideration by examiner before the appeal shall be concluded. (Article 163(3), 164(1))
- ii) Where the reasons for refusal are not resolved, the examiner who has reconsidered the application shall report the results of the examination to the Commissioner of the Patent Office and reconsideration by the examiner before the appeal shall be concluded. (Article 164(3))

The application shall then be subject to a trial to appeal the examiner's decision of refusal conducted by a trial examiner.

### **III. Contents of Patent Rights**

#### 1. Effect of patent right

A patentee shall have the exclusive right to work the patented invention as a business.

(Main clause of Article 68)

Therefore, a patent right has the following two effects:

##### 1) Active effect

Active effect of patent right is the exclusive right of a patentee to work the patented invention as a business.

For example, in the case of a clothes dryer  $\alpha$  for which X has obtained a patent, X can manufacture the drier  $\alpha$  exclusively as a business.

##### 2) Inactive effect

The inactive effect of a patent right is the right that can prevent the working of a patented invention as a business by third parties without a title such as a license, etc. or justifiable reasons such as the working of a patented invention for a research purpose.

In the case of the example above, where Y manufactures clothes dryer  $\alpha$  as a business without obtaining a license from X, and not for research or experimental purposes, X can stop the manufacture of clothes dryer  $\alpha$  by Y.

#### 2. Meaning of the term “as a business”

Generally, the term “as a business” is considered to mean “widely as a business.”

In other words, the effect of a patent right shall not extend to the working of a patented invention on a personal basis or in households, even though such cases also fall under the “working” of an invention.

In the case of the example above, the effect of patent right of the clothes dryer  $\alpha$  shall not extend to the case where clothes dryer  $\alpha$  is used to dry clothes on a personal basis or in households, since it does not fall under the term “as a business.”

##### 1) Necessity of commerciality

However, whether or not a patented invention is worked for a commercial (profit) purpose or not is irrelevant to whether or not it violates a patent right.

Therefore, in the case of the example above, even where a company Y uses the clothes dryer  $\alpha$  to dry customers’ clothes free of charge, it violates the patent right of company X since it falls under the term “as a business.”

##### 2) Necessity of repeated continuity

Also, whether or not a patented invention is worked continuously and repeatedly is irrelevant to whether or not it violates a patent right.

Therefore, in the case of the example above, where a company Y uses the clothes dryer  $\alpha$  only once to dry customers’ clothes, it violates the patent right of company X

since it falls under the term “as a business.”

### 3. Meaning of “working”

#### 1) Working of an invention of a product (Article 2(3)(i))

The “working” of an “invention of a product” means producing, using, assigning, etc. (assigning and leasing), exporting or importing, or offering for assignment, etc. (e.g. flyer distribution) of the said product.

For example, an invention pertaining to a clothes dryer  $\alpha$  is an invention of a product. Therefore, the effect of the patent right pertaining to  $\alpha$  extends to the manufacturing of  $\alpha$ , since it falls under the working of the invention  $\alpha$ .

#### 2) Working of an invention of a simple process (Article 2(3)(ii))

The “working” of an “invention of a simple process” means the act of using the process.

For example, an invention pertaining to a process for drying clothes  $\beta$  is an “invention of a simple process.” Therefore, the effect of the patent right of  $\beta$  extends to the drying of clothes using  $\beta$ , since it falls under the working of the invention  $\beta$ .

#### 3) The working of an invention of a process for producing a product (Article 2(3)(iii))

The “working” of an “invention of a process for producing a product” means the act of using the process, as well as using the product produced by the process. Therefore, the effect of the patent right does not extend to a product produced by a process other than the patented process for producing a product.

For example, in the case where a clothes dryer  $\alpha$  has been patented, the effect of the patent right extends to the clothes dryer  $\alpha$  regardless of the process by which it was produced.

On the other hand, in the case where a process  $\beta$  for producing the clothes dryer  $\alpha$  has been patented, the effect of the patent right does not extend to a clothes dryer  $\alpha$  if it was produced by a different process  $\gamma$ .

### 4. Principles concerning the effect of a patent right

#### 1) Principle of independence of the act of working the invention

The “principle of independence of the act of working the invention” is a principle wherein the acts of working the invention stated above are independent of each other.

For example, where Y has manufactured a clothes dryer  $\alpha$  patented by X without X’s permission, Y shall be deemed to have violated the patent right of X. Where Z has purchased the clothes dryer  $\alpha$  manufactured by Y and sold it to W, Z shall also be deemed to have violated the patent right of X since the act of manufacturing by Y and the act of selling by Z are independent of each other.

#### 2) Exhaustion of a patent right (decision by the Supreme Court on July 1, 1997 on the

“BBS case”)

However, a patent right of a patented product shall be deemed to have been exhausted where a patentee has assigned the patented product within Japan. Therefore, the said patent right shall not extend to subsequent acts of assigning or using the patented product.

In the case of the example above, where Y has purchased the clothes dryer  $\alpha$  manufactured by X and assigned it to Z, this shall not constitute an infringement of the patent right of X.

3) Parallel import of a patented product (decision by the Supreme Court on July 1, 1997 on the “BBS case”)

Where a patentee has assigned a patented product outside Japan, the patentee may not, in principle, enforce the patent right concerning cases where the assignee imports the patented product into Japan.

For example, where X holds a patent right for a clothes dryer  $\alpha$  in Japan and the U.S., and Y has purchased  $\alpha$  in the U.S. and imported it into Japan, Y’s act shall not constitute an infringement of the patent right owned by X in Japan.

4) Repair/modification (Decision by the Supreme Court on November 8, 2007, on the “Ink tank case”)

Where a repaired or modified patented product is deemed a newly produced patented product that is not identical to the original patented product, a patentee may exercise the patent right over the repaired or modified patented product.

For example, where X has a patent right for a clothes dryer  $\alpha$  and Y has purchased the clothes dryer  $\alpha$  manufactured by X and sold it as it is to Z, Y’s act shall not constitute an infringement of the patent right owned by X since the patent right has been exhausted.

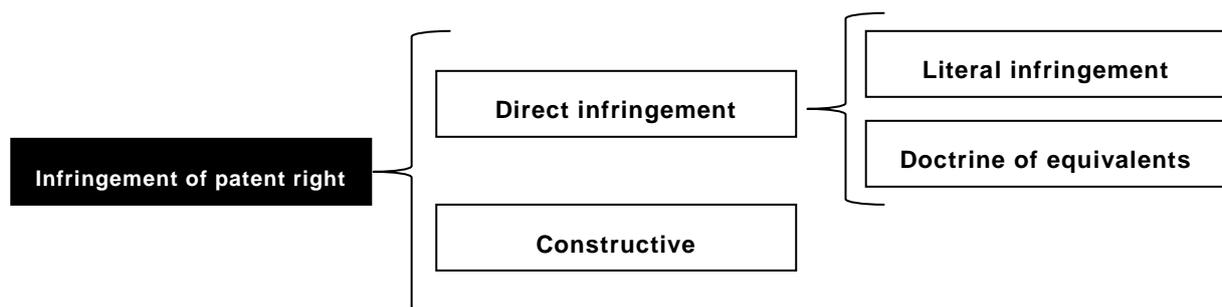
However, where Y has repaired or modified the clothes dryer  $\alpha$  manufactured by X and Y’s act is deemed “reproduction” of the clothes dryer  $\alpha$ , it shall constitute an infringement of the patent right owned by X.

## **IV. Infringement of Patent Rights**

### 1. Overview

Infringement of a patent right is the working of a patented invention as a business by a third party without a title such as a license, or justifiable reasons such as the working of a patent invention for experimental reasons. (Main clause of Article 68)

Infringements of patent rights include the following aspects (Figure 9).



(Figure 9) Aspects of patent right infringement

### 2. Criteria for determination of the technical scope

The scope covered by a patent right is known as the “technical scope” of the patented invention.

#### 1) Handling of the scope of claims (Article 70(1))

The technical scope of a patented invention shall be determined based upon the statements in “the scope of claims.” Therefore, in principle, matters stated in the scope of claims alone shall serve as the criteria for the determination of the technical scope, and matters not stated in the scope of claims shall not serve as criteria for the determination of the technical scope.

#### 2) Handling of the description and drawings (Article 70(2))

However, the meaning of terms stated in the scope of claims shall be interpreted in consideration of the statements in the description and drawings.

That is, where the specific meaning and definition of the terms stated in the scope of claims are described in a detailed explanation of the invention, the technical scope of a patented invention shall be determined in consideration thereof.

#### 3) Handling of the abstract (Article 70(3))

However, statements in the abstract shall not be taken into consideration in determining the technical scope, since the purpose of the abstract is simply to be used as technical information.

### 3. Literal infringement

“Literal infringement” refers to cases wherein the accused product is deemed to fall into the technical scope of a patented invention as a result of interpreting the wording stated in the scope of claims.

Therefore, the accused product falls under the technical scope of the patented invention, where the constitution of the accused product is identical to the constitution stated in the scope of claims.

For example, where X has a patent right for a clothes dryer  $\alpha$  consisting of parts A and B, a clothes dryer  $\alpha$  consisting of parts A and B falls under the technical scope of the clothes dryer  $\alpha$ , and therefore infringes the patent right of X.

On the other hand, where there is a part in the constitution stated in the scope of claims that is different from that of the accused product, the accused product is not, in principle, deemed to fall under the technical scope of the patented invention.

In the case of the above example, a clothes dryer  $\beta$  consisting of parts A and C does not fall into the technical scope of the clothes dryer  $\alpha$ , and therefore does not infringe the patent right of X.

### 4. Doctrine of equivalents (Decision by the Supreme Court on February 24, 1998, on the “ball spline case”)

However, even where there is a part in the constitution stated in the scope of claims that is different from that of the accused product, the accused product shall be regarded as equivalent to the constitution stated in the scope of claims and falling under the technical scope of the patented invention if the following five conditions are satisfied:

For example, where X has a patent right for a clothes dryer  $\alpha$  consisting of parts A and B, the following five conditions need to be satisfied in order for X to exercise the patent right over a clothes dryer  $\alpha'$  consisting of parts A and b:

- 1) The difference in the constitution is not an essential part of the patented invention.  
In the case of the example above, the component B shall not be an essential part of the clothes dryer  $\alpha$ .
- 2) The purpose of the patented invention can be achieved, and the same effect can be attained, even if a different part of the patented invention is replaced by the corresponding part of the accused product, etc.  
In the case of the example above, the purpose of the clothes dryer  $\alpha$  can be achieved, and the same effect can be attained, even if component B is replaced by component b.
- 3) A person having an ordinary skill in the art to which the invention pertains could have easily come up with the replacement mentioned in the right at the time of the manufacturing of the accused product.

In the case of the example above, a person having ordinary skill in the art to which the invention pertains can easily come up with the replacement of component B by component b at the time of the manufacturing of the accused product.

4) The accused product is not identical to a publicly-known technology at the time of the filing of the patent application for the patented invention, or could not have been easily deduced from the same at the time of the filing by a person skilled in the art. In the case of the example above, the clothes dryer  $\alpha'$  shall not be identical to a publicly-known technology at the time of the filing of the patent application for the patented invention, or shall not have been easily deduced from the same at the time of the filing by a person skilled in the art.

5) No special circumstances exist, such as the accused product being intentionally excluded from the scope of claims of the patented invention during the filing procedure.

In the case of the example above, no special circumstances exist, such as the clothes dryer  $\alpha'$  being intentionally excluded from the scope of claims of the clothes dryer  $\alpha$  in a written opinion submitted during the filing procedure.

#### 5. Constructive infringement (Each item of Article 101)

“Constructive infringement” refers to certain preliminary and contributory acts that do not originally infringe a patent, but are deemed to infringe a patent under the Patent Act.

##### 1) Acts of providing exclusive products (Article 101(i)(iv))

Acts deemed to constitute infringement of a patent right pursuant to the provisions under Article 101(i) and (iv) shall satisfy the following two requirements:

(1) Provision of “a product to be used exclusively for the production of the patented invention” or “a product to be used exclusively for the use of the process.” (Article 101(i))

Example) An assembly kit  $\beta$  consisting of all the necessary parts for the assembly of a clothes dryer  $\alpha$ , where X has a patent for a finished product of a clothes dryer  $\alpha$ .

(2) “Production, etc.” is conducted “as a business”

Example) In the case of the example above, where Y manufactures the assembly kit  $\beta$  for the clothes dryer  $\alpha$  as a business.

##### 2) Acts of providing any product indispensable for the resolution of the problem by the invention (Article 101(ii)(v))

Acts deemed to constitute infringement of a patent right pursuant to the provisions under Article 101(ii) and (v) shall satisfy the following five requirements:

(1) Provision of “a member to be used for the production of the product pertaining to the patented invention,” or “a member to be used for the use of the process

pertaining to the patented invention”

Example) Pigment  $\beta$  used for the ink of a ballpoint pen  $\alpha$ , where X has a patent right for a ballpoint pen  $\alpha$

- (2) Provision of a member indispensable for the resolution of the problem by the invention

Example) In the case of the example above, a special pigment  $\beta$  used for the ink of a ballpoint pen  $\alpha$ , where ballpoint pen  $\alpha$  uses an ink that vanishes over time

- (3) Provision of a member that is not widely distributed within Japan

Example) In the case of the example above, where  $\beta$  refers to normal ink widely distributed in Japan, it shall not constitute infringement of the patent right for the ballpoint pen  $\alpha$ .

- (4) Provision of a member knowing that the invention is a patented invention and that the member is used for the working of the patented invention

Example) In the case of the example above, a supplier Z of the pigment  $\beta$  needs to actually know that a buyer Y of a pigment  $\beta$  uses pigment  $\beta$  for the production of a ballpoint pen  $\alpha$ , and that the ballpoint pen  $\alpha$  has been patented.

- (5) Production of accused products as mentioned above as a business

Example) In the case of the example above, Z needs to manufacture pigment  $\beta$  as a business

- 3) Acts of possessing the patented product for the purpose of assigning (Article 101(iii), (vi))

Acts deemed to constitute infringement of a patent right pursuant to the provisions under Article 101(iii) or (vi) shall satisfy the following two requirements:

- (1) Possession of a “product pertaining to a patented invention” or a “product produced by the producing process pertaining to a patented invention”

- (2) Possession of a product for the purpose of assigning or exporting it as a business

Example) Where X has a patent right for a finished product of a clothes dryer  $\alpha$ , Y's act of keeping the clothes dryer  $\alpha$  in storage for a purpose of assigning or exporting it as a business shall be deemed infringement of the patent right of X.

## 6. Remedies for patent infringements

Where a patent right is infringed, a patentee or exclusive licensee (hereinafter, “patentee, etc.”) may claim for civil and criminal remedies as follows:

### 1) Civil remedy

There are four types of civil remedies as follows:

- (1) Right to seek injunction (Article 100)

Example) Where X is a patentee of a clothes dryer  $\alpha$ , and Y manufactures the clothes dryer  $\alpha$  without the prior consent of X, X may demand Y to stop the manufacturing of the clothes dryer  $\alpha$ .

(2) Right to claim compensation for damages (Article 709 of the Civil Law)

Example) In the case of the example above, X may claim compensation for damages caused by Y due to the manufacturing of the clothes dryer α without prior consent of X.

(3) Right to claim for unjust enrichment (Article 703 and 704 of the Civil Law)

Example) In the case of the example above, X may claim return of the benefits earned by Y through the manufacturing of the clothes dryer X without the prior consent of X.

(4) Right to claim for measures to restore credibility (Article 106)

Example) In the case of the example above, where the clothes dryer α manufactured by Y without the prior consent of X is defective and consumers believe that the clothes dryer manufactured by X is also defective, X may demand that Y posts an apology in a national newspaper, etc.

2) Criminal punishment

A person who has infringed a patent right shall be subject to the following criminal punishment:

(1) Crime of direct infringement (Article 196) (Figure 10)

Charge	Imprisonment	Criminal fine	Cumulative imposition
Crime of direct infringement (Article 196)	Imprisonment with work for a term not exceeding ten years	Criminal fine not exceeding 10 million yen	○
Crime of constructive infringement (Article 196-2)	Imprisonment with work for a term not exceeding five years	Criminal fine not exceeding 5 million yen	○

(Figure 10) Extent of criminal punishment

Example) In the case of the example above, where Y is intentionally infringing X's patent right of the clothes dryer α, Y may be punished by imprisonment with work for a term not exceeding ten years.

(2) Crime of constructive infringement (Article 196-2)

Example) In the case of the example above, where Z supplies exclusive parts for the clothes dryer α for Y, Z may be punished by imprisonment with work for a term not exceeding five years.

(3) Dual liability (Article 201) (Figure 11)

Charge	Employer that is a juridical person	Employer that is a natural person
Crime of direct infringement	Criminal fine not exceeding 300 million yen	Criminal fine not exceeding 10 million yen
Crime of constructive infringement	Criminal fine not exceeding 300 million yen	Criminal fine not exceeding 5 million yen

(Figure 11) Dual liability

Example) In cases where an employee V of a company W has infringed X's patent right in relation to the business of the company W, V shall be subject to the criminal punishment and the company W shall also be subject to a criminal fine not exceeding 300 million yen.

## **V. Lapses of Patent Rights**

Patent rights shall be extinguished due to six reasons, including the expiration of the duration of a patent right.

### 1. Lapse due to the expiration of the duration of a patent right

1) In principle, the duration of a patent right shall expire after a period of 20 years from the filing date of the patent application. (Article 67(1))

2) The duration of a patent right whose application was filed with a domestic priority claim, or a priority claim under the Paris Convention, shall expire after a period of 20 years from the filing date of the later application claiming a priority. (Article 41(2) of the Patent Act, Article 4-2(5) of the Paris Convention)

For example, where a patent application B is filed with a priority claim based on an application A filed in a country belonging to the Union of the Paris Convention, the duration of the patent right of application B shall expire after a period of 20 years from the filing date of application B.

3) A divisional application, a converted application and a patent application based on utility model registration shall be deemed to have been filed at the time of filing the original application (main clause of Article 44(2) and Article 46-2(2)). Therefore, the duration of a patent pertaining to such applications shall expire after a period of 20 years from the filing date of the original application.

For example, where a utility model registration application A for a device  $\alpha$  (= invention  $\alpha$ ) is converted to a patent application B pertaining to the invention  $\alpha$ , the duration of the patent right pertaining to the patent application B shall expire after a period of 20 years from the filing date of the original utility model registration application A.

### 2. System for registration of extension of duration

#### 1) Outline of the system

Even though medical products and pesticides are patented, they cannot be manufactured and distributed unless approved by the government. For such cases, this system allows the extension of the duration of a patent right for up to “five years.”

#### 2) Persons who may file an application (Article 67-3(1)(iv))

An application for registration of extension of duration shall be filed by the patentee. For example, an application for registration of extension of duration of a patent for a painkiller  $\alpha$  shall be filed by X, a patentee of  $\alpha$ .

#### 3) Objective requirements (Article 67-3(1)(i)-(iii))

An application for registration of extension of duration of a patent right shall satisfy all of the following three requirements:

(1) The disposition designated by Cabinet Order shall be deemed to have been necessary to obtain for the working of the patented invention.

The “disposition designated by Cabinet Order” is an approval under the Pharmaceutical Affairs Law and a registration under the Agricultural Chemicals Regulation Act. (Article 3 of the Enforcement Order)

For example, it is the case where X needs to have obtained an approval under the Pharmaceutical Affairs Law for the manufacturing and distribution of the patented painkiller  $\alpha$ .

(2) The patentee, or the exclusive licensee of the patent, shall have obtained the disposition designated by Cabinet Order.

For example, X shall have obtained approval under the Pharmaceutical Affairs Law concerning patented painkiller  $\alpha$ .

(3) The period for which the extension is requested shall not exceed the period during which the patented invention was unable to be worked.

For example, where X was unable to manufacture and distribute the painkiller  $\alpha$  for three years, X can request an extension not exceeding three years.

4) Time requirements (Article 67-2(3) of the Patent Act and Article 4 of the Enforcement Order)

In principle, an application for registration of a patent right extension shall be filed within three months from the date on which the disposition designated by Cabinet Order was obtained.

5) Procedural requirements (Article 67-2(1), (2))

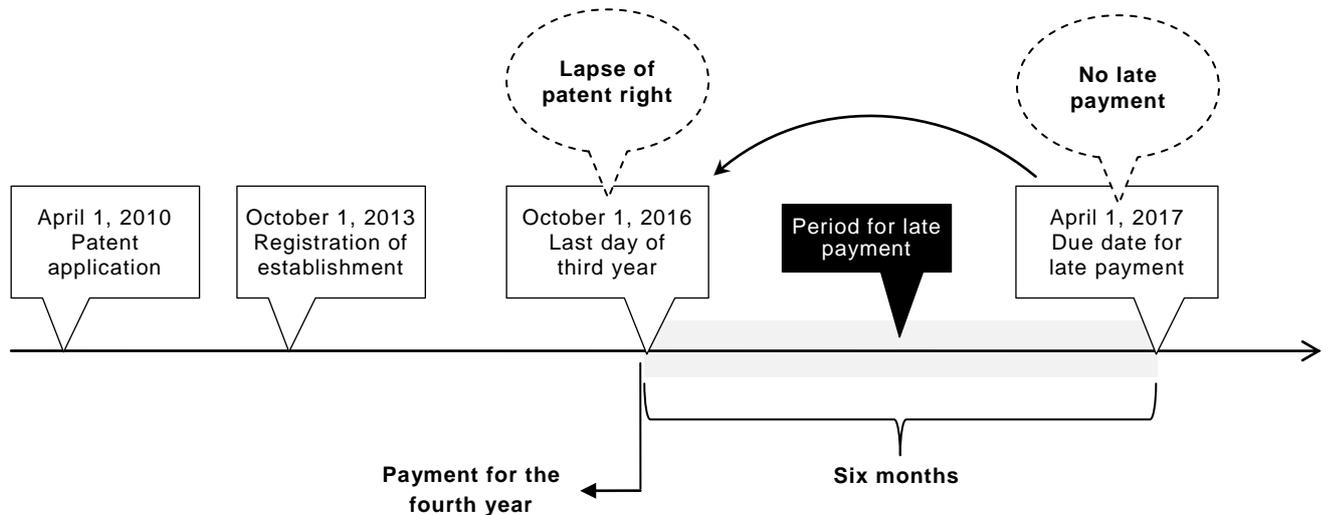
When applying for registration of extension of a patent right, a patentee shall submit to the Commissioner of the Patent Office a “written application” and “materials specifying the reason(s) for the extension.”

6) Effect of patent right in the case of duration extension (Article 68(2))

Where the duration of a patent right is extended, the effect of such patent right shall extend only to the overlapping parts of the scope where the prohibition of the working of the patent has been rescinded as a result of obtaining a disposition designated by Cabinet Order and the scope of claims. Therefore, the effect of the extended patent right shall not extend to non-overlapping parts.

For example, where X has obtained a patent right for a compound  $\alpha$ , and obtained an approval under the Pharmaceutical Affairs Law for a painkiller  $\alpha$ , the effect of a patent right after the registration of an extension for duration shall extend to the compound  $\alpha$  as a painkiller, but not to the compound  $\alpha$  when used, for example, as an explosive.

### 3. Lapse due to non-payment of patent fees (Figure 12)



(Figure 12) Lapse due to non-payment of patent fees

- 1) A patentee shall pay patent fees for each year from the date of the registration establishing the patent right to the expiration of the duration. (Article 107(1))
- 2) The patent fees for each year shall be paid in advance by the end of the previous year (Article 108(2).) For example, patent fees for the fourth year shall be paid by the end of the third year from the date of the registration establishing the patent right.

However, patent fees for multiple years may be prepaid in a lump sum. For example, patent fees for the fourth and fifth years may be paid before the end of the third year from the date of the registration establishing the patent right.

- 3) Even after the expiration of the time limit for the payment of patent fees stated above, the patentee may make a late payment of the patent fees within six months following the expiration of the said time limit, along with a patent surcharge equivalent to the amount of the patent fee. (Article 112 (1))

Where a patentee fails to make a late payment of the fees above, the patent right shall be deemed to have been extinguished retroactively upon expiration of the time limit for the original payment of patent fees. (Article 112(4).)

### 4. Lapse of patent right due to waiver

- 1) A patent right is a property right, so a patentee is free, in principle, to waive his/her patent right. However, the lapse of a patent right due to a waiver must be registered at the Patent Office in order to take effect. (Article 98(1))
- 2) A patent right waiver causes a disadvantage to licensees, so where there is an exclusive licensee, a patentee may waive the patent right only with the consent of the said exclusive licensee. (Article 97(1))

5. Lapse of patent right due to a final and binding trial decision for patent invalidation
  - 1) Any person may file a request for a patent invalidation trial at the Patent Office where there is a reason for invalidation, such as lack of novelty, etc. (Article 123)
  - 2) In principle, where a trial decision for patent invalidation has become final and binding, the patent right shall be deemed never to have existed, and be extinguished retroactively. (Article 125)
  
6. Lapse of patent right in absence of heirs
  - 1) The Civil Code stipulates that property shall belong to the National Treasury, where there is no successor. (Article 959 of the Civil Code)
  - 2) However, the Patent Act stipulates that a patent right shall lapse where there is no successor, since it is more reasonable to extinguish the right and enable the public to work the patented invention than to have it belong to the National Treasury. (Article 76)
  
7. Revocation of patent right based on the Antimonopoly Act
  - 1) When imposing a criminal punishment pursuant to the Antimonopoly Act, the court may issue a sentence that the patent shall be revoked. In this case, the Commissioner of the Patent Office shall, upon receipt of the transcript of the judgment, revoke the patent. (Article 100 of the Antimonopoly Act)
  - 2) For example, where patentee X sells product B to Y unfairly combined with a patented product A, X shall be subject to criminal punishment based on the Antimonopoly Act, and the patent right for A may be revoked.