

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

Part IX Extension of Patent Term

Contents

Chapter 1	Extension of a Patent Term as Compensation for the Curtailment of the Term	
9101	Relevant Acts and Articles When Calculating the Periods Specified in the Items of Article 67(3)	- 1 -
9102	Method of Calculating the Maximum Permissible Length of Extension Period	- 12 -
9103	Disqualification of Examiner with respect to Application to Register Patent Term Extension as Compensation for the Curtailment of the Term	- 18 -
9104	Patent Application to Which Article 67 of the Patent Act as Amended in 2016 is Applicable.....	- 19 -
Chapter 2	Extension of a Patent Term for Pharmaceutical Inventions	
9201	Handling of Relationship between Application to Register Patent Term Extension and Number of Dispositions	- 1 -
9202	Regarding Extended Term Where Two or More Trials Necessary for Obtaining Disposition Designated by Cabinet Order Were Conducted for One Single Disposition in Application for Registration of Patent Term Extension	- 2 -
9203	Patent Application to Which Article 67 of the Patent Act as Amended in 2016 is Applicable.....	- 4 -

Chapter 1 Extension of a Patent Term as Compensation for the Curtailment of the Term

9101 Relevant Acts and Articles When Calculating the Periods Specified in the Items of Article 67(3)

The following table provides a list of Acts and Articles that may be relevant when calculating the periods specified in the items of Article 67(3).

Items of Article 67(3)	Acts and Articles
<p>(i) (Period that was consumed to carry out a necessary procedure upon receipt of a notice or an order from the JPO Commissioner or an examiner)</p> <p style="padding-left: 2em;">In the case where a notice or an order (only those made by the JPO Commissioner or an examiner) is made based on the Patent Act (excluding Article 39(6) and Article 50), the Utility Model Act, the Act on Special Provisions for Procedures related to Industrial Property Rights, or any regulations established based on these Acts, if the procedure that is necessary to be carried out upon receipt of such notice or order is carried out, the deductible period starts from the date on which such notice or order is made and ends on the date on which such procedure is completed.</p>	<p>Patent Act</p> <ul style="list-style-type: none"> - Article 13 (1) and (2) (Replacement of Agents) - Article 17 (3) (Amendment of Proceedings) - Article 18-2 (2) (Dismissal of Non-Compliant Procedure) - Article 23 (1) (Order of Substitution) - Article 36-2 (3) (Submission of Translation) - Article 38-4 (2) (Notice When a Part of the Description or Drawings Lacks a Statement) - Article 43 (7) (Priority Claim Procedures under the Paris Convention) - Article 184-5 (2) (Submission of Documents and Order to Amend Procedures) - Article 184-11 (4) (Special Provisions on Patent Administrators for Overseas Residents) - Article 194 (1) (Submission of Documents)
	<p>Act on Special Provisions for Procedures related to Industrial Property Right</p> <ul style="list-style-type: none"> - Article 7 (2) (Procedures by Submission of Documents)
	<p>Regulations under the Patent Act/</p> <ul style="list-style-type: none"> - Article 5 (2) (Submission of Certificate) - Article 7 (Documents Necessary for Procedures Initiated by Foreigners)
	<p>Patent Registration Order</p>

	<ul style="list-style-type: none"> - Article 30 (1) (Documents to be Submitted by Order of the Commissioner of the Patent Office)
<p>(ii) (Period that was consumed as a result of an extension of the period during which a procedure should be carried out)</p> <p>In the case where an extension is made to the period during which a procedure should be carried out based on the Patent Act or any regulations established based on said Act (the "Patent Act and regulations"), the deductible period starts from the date on which the period during which the procedure should be carried out expires and ends on the date on which the procedure is completed.</p>	<p>Utility Model Act</p> <ul style="list-style-type: none"> - Article 2-2 (4) (Amendment of Procedures) - Article 6-2 (Order to Amend) - Article 48-7 (Submission of Drawings) - Article 48-5 (2) (Submission of Documents and Order to Amend Procedures, etc) - Article 2-5 (2), Article 11 (1), Article 48-15 (2), and Article 55 (3) (Application Mutatis Mutandis of the Patent Act) <p>Patent Act</p> <ul style="list-style-type: none"> - Extension of the period (due date for the payment of patent fees) specified in Article 108 (1) pursuant to Article 4 or Article 108 (3) - Extension of the period (a period by which procedures are to be undertaken) pursuant to Article 5 (1) or (3) <p>Act on Special Measures concerning Preservation of Rights and Interests of Victims of Specified Disaster</p> <ul style="list-style-type: none"> - Extension of the period (expiration date regarding administrative rights and interests) pursuant to Article 3 (3)
<p>(iii) (Period that was consumed to take a procedure after the expiration of the period during which such procedure should be carried out)</p> <p>In the case where a procedure specified in the Patent Act and regulations is required to be carried out within the prescribed period of time, if</p>	<p>Patent Act</p> <ul style="list-style-type: none"> - Article 30 (4) (Proving Document to Enjoy Exception to the Lack of Novelty of Invention) - Article 36-2 (6) (Translation of Foreign-Language Document) - Article 41 (1) (i) (Patent Application Claiming Priority) - Article 43 (8) (Documents to Claim Priority

<p>an applicant is permitted to carry out the procedure even after the expiration of the period during which the procedure should be carried out, the deductible period starts from the date on which the period during which the procedure should be carried out expires and ends on the date on which the procedure is completed.</p>	<p>under the Paris Convention)</p> <ul style="list-style-type: none"> - Article 43-2 (1) (Patent Application Claiming Priority as under the Paris Convention) - Article 44 (7) (Divisional Application) - Article 46 (5) (Converted Application) - Article 46-2 (3) (Patent Application Based on Utility Model Registration) - Article 48-3 (5) and (7) (Request for Examination of Application) - Article 108 (4) (Payment of Patent Fees) - Article 184-4 (4) (Translation of Foreign-Language Patent Application) - Article 184-11 (6) (Notification of Appointment of Patent Administrator)
<p>(iv) (Period consumed as a result of the suspension of an administrative disposition or notification upon request or due to any other act of an applicant)</p> <p>In the case of the suspension of an administrative disposition or notification specified in the Patent Act, the Act on Special Provisions for Procedures related to Industrial Property Rights, or any regulation established based on these Acts (the "laws and regulations related to the Patent Act") upon request or due to any other act of an applicant, the deductible period starts</p>	<p>Regulations under the Patent Act</p> <ul style="list-style-type: none"> - Article 38-6-3 (Period for Submission of Documents Requesting the Application of Exception to Lack of Novelty of Invention) - Article 38-14 (Submission of Priority Document Relating to International Patent Application) <p>Patent Act</p> <ul style="list-style-type: none"> - Article 13 (4) (Dismissal of Procedures Undertaken by Agent Ordered to be Replaced) - Article 18 (Dismissal of Procedures) - Article 18-2 (1) (Dismissal of Non-Compliant Procedure) - Article 49 (Decision of Refusal) - Article 50 (Notice of Reasons for Refusal) - Article 51 (Decision to Grant a Patent) - Article 53 (Dismissal of Amendments) <p>Act on Special Provisions for Procedures related to Industrial Property Rights</p> <p>Article 7 (3) (Dismissal of Procedures)</p>

<p>from the date of such request or act and ends on the date on which reasons for suspending such disposition or notification cease to exist.</p>	<p>Patent Registration Order - Article 16 (Ex-Officio Registration)</p>
<p>(v) (Period consumed as a result of the filing of a request for reduction or exemption of a patent fee or a handling fee or a request for deferment of payment thereof)</p> <p>Regarding the payment of a patent fee or handling fee specified in the Patent Act and regulations, if a decision is made with regard to the reduction or exemption of a patent fee or a handling fee or with regard to the deferment of payment thereof, the deductible period starts from the date on which a request for reduction or exemption of a patent fee or a handling fee or a request for deferment of payment thereof is made and ends on the date on which such decision is made.</p>	<p>Patent Act - Article 109 (Reduction or Exemption of Patent Fees or Deferment of Payment of Patent Fees) - Article 195-2 (Reduction or Exemption of Fees for Requesting the Examination of Application)</p>
	<p>Order for the Patent Act-related Fees - Article 1-3 (Request for Reduction or Exemption)</p>
	<p>Act on Strengthening Industrial Competitiveness - Article 17 (Approval of a Plan for Specified Investment for Developing New Business) - Article 75 (Reduction of Patent Fees for Patent Application concerning Invention in Technology Fields Contributing to Strengthening Industrial Competitiveness)</p>
	<p>Act on Enhancement of Small and Medium Sized Enterprises' Core Manufacturing Technology - Article 9 (Special Provisions on Patent Fees)</p>
	<p>Act on Special Measures to Promote Research and Development Business, etc. by Specified Multinational Enterprises - Article 10 (Special Provisions on Patent Fees)</p>
	<p>Act on the Promotion of Technology Transfer from Universities to Private Business Operators - Article 8 (Special Provisions on Patent Fees)</p>

	- Article 13 (Accreditation of Research and Development Incorporated Administrative Agency Technology Transfer Operations)
<p>(vi) (Period consumed as a result of the withdrawal of a written supplement for the description, etc.)</p> <p>If a written supplement for the description, etc. is withdrawn under Article 38-4 (7), the deductible period starts from the date on which a written supplement for the description, etc. is submitted under Article 38-4 (3) and ends on the date on which the written supplement for the description, etc. is withdrawn under Article 38-4 (7).</p>	<p>Patent Act</p> <p>- Article 38-4 (7) (Withdrawal of Written Supplement for Description)</p>
<p>(vii) (Period consumed as a result of an appeal against an examiner's decision of refusal)</p> <p>If an appeal against an examiner's decision of refusal is filed, the deductible period is one of the periods specified in (vii-1) to (vii-3) below, according to the cases (vii-1) to (vii-3):</p> <p>(vii-1) In an appeal against an examiner's decision of refusal (including a re-appeal against the final JPO decision concerning an appeal against an examiner's decision of refusal), if a JPO decision is made to grant a patent, the period starting from the date on which a certified copy of an examiner's decision of refusal is served and ending on the date on which a certified copy of the JPO decision is served.</p>	<p>Patent Act</p> <p>- Article 51 (Decision to Grant a Patent) applied mutatis mutandis in Article 159 (3) which may apply mutatis mutandis in Article 174 (2)</p> <p>- Article 160 (1) which may apply mutatis mutandis in Article 174 (2) (Order to further Examine)</p> <p>- Article 51 (Decision to Grant a Patent) applied mutatis mutandis in Article 163 (3)</p>

<p>(vii-2) In the case where an examiner's decision is rescinded in an appeal against an examiner's decision of refusal (including a re-appeal against the final JPO decision concerning an appeal against an examiner's decision of refusal), if a JPO decision is made to conduct further examination, the period starting from the date on which a certified copy of the examiner's decision of refusal is served and ending on the date on which a certified copy of the JPO decision is served.</p> <p>(vii-3) In the case of reexamination before the appeal, if an examiner's decision to grant a patent is made, the period starting from the date on which a certified copy of the examiner's decision of refusal is served and ending on the date on which a certified copy of the examiner's decision to grant a patent is served.</p>	
<p>(viii) (Period consumed as a result of carrying out a procedure specified in the Administrative Complaint Review Act)</p> <p>If an administrative determination is finalized in response to a request for review under the Administrative Complaint Review Act with regard to an administrative disposition made under the laws and regulations related to the Patent Act, the deductible period starts from the date of the request for review and ends on the date on which a certified copy of the administrative</p>	<p>Administrative Complaint Review Act</p>

determination is served.	
(ix) (Period consumed as a result of the procedure specified in the Administrative Case Litigation Act) If a judgment is finalized concerning an action filed under the Administrative Case Litigation Act with regard to an administrative disposition made under the laws and regulations related to the Patent Act, the deductible period starts from the date of the filing of the action and ends on the date on which the judgment concerning the action is finalized.	Administrative Case Litigation Act
(x) (Period consumed as a result of suspension or discontinuation of a procedure specified in the Patent Act and regulations) If a procedure specified in the Patent Act and regulations is suspended or discontinued, the deductible period is the period of suspension or discontinuation.	Patent Act - Article 24 (Application Mutatis Mutandis of Articles of the Code of Civil Procedure) - Article 54 (In relation to Litigation)
	Code of Civil Procedure - Article 124 (1) (i) to (v) (Continuance of Litigation Proceedings and Substitution) - Article 130 (Suspension Due to Court Inability to Execute Duties) - Article 131 (Suspension due to the Incapacitation of a Party)
	Corporate Reorganization Act - Article 52 (1) applied mutatis mutandis in Article 34 (3)(i) - Article 52 (4) applied mutatis mutandis in Article 34 (3)(ii) - Article 52 (1) and (4) applied mutatis mutandis in Article 53 - Article 52 (1) applied mutatis mutandis in Article 74 (3)
	Bankruptcy Act

	<ul style="list-style-type: none"> - Article 44 (1) and (4) applied mutatis mutandis in Article 46 - Article 44 (1) applied mutatis mutandis in Article 96 (2)(i) - Article 44 (4) applied mutatis mutandis in Article 96 (2)(ii)
	<p>Civil Rehabilitation Act</p> <ul style="list-style-type: none"> - Article 67 (2) applied mutatis mutandis in Article 69 - Article 68 (2) and (4) applied mutatis mutandis in Article 69 - Article 67 (2) applied mutatis mutandis in Article 83 (3) - Article 68 (2) applied mutatis mutandis in Article 83 (3)

(Explanation)

The items of Article 67 (3) specify types of the periods that the Comprehensive and Progressive Agreement for Trans-Pacific Partnership (hereinafter referred to as “the TPP 11 Agreement”) allows signatories to exclude from the “unreasonable delays” set forth in the Agreement. Such periods include periods consumed for procedures or dispositions carried out for a reason not attributable to the Patent Office, including procedures which have not been carried out within a prescribed period for a reason attributable to the applicant and procedures which the Patent Office cannot carry out due to natural disasters, and periods necessary for appeals and court trials that take place before a patent right is established and registered.

Item (i) (Period that was consumed to carry out a necessary procedure upon receipt of a notice or an order from the JPO Commissioner or an examiner.)

Because normal patent filing procedure does not suppose a procedure, such as submission of documents to correct deficiencies, which is carried out upon receipt of a notice or an order from the JPO Commissioner or an examiner, and such procedure is carried out for a reason not attributable to the Patent Office, a period consumed to carry out such procedure is not included in the maximum permissible length of extension period. The period not included in the maximum permissible length of extension period is a period starting from the date on which such notice or order is made and ending on the date on which such procedure is completed, which includes an extended portion of the period when the period for carrying out such procedure is extended.

A notice specified in Article 50, however, is issued for most of patent applications examined and regarded as constituting normal patent application procedure. Thus, a response period to the notice under Article 50 is considered to be included in a period of five years from the filing of an application or three years from request for examination and excluded from item (i). Likewise, the period for consultation as specified in Article 39 (6) is also excluded since the period is equivalent to the response period to a notice as specified in Article 50.

Item (ii) (Period that was consumed as a result of an extension of the period during which a procedure should be carried out)

Because normal patent filing and examination procedure does not suppose an extension of the period during which a procedure should be carried out and such extension is not attributable to the Patent Office, a period consumed as a result of such extension is not included in the maximum permissible length of extension period

Item (iii) (Period that was consumed to take a procedure after the expiration of the period during which such procedure should be carried out)

The Patent Act, specifically Article 30 (4), etc., exceptionally allows the applicant to take a procedure after a legal period expires when he/she has a reason not attributable to him/her or is not found to have been intentional. As such procedures are procedures which is carried out for a reason not attributable to the Patent Office, including procedures which the Patent Office cannot carry out due to natural disasters and procedures which have not been carried out within a prescribed period for a reason attributable to the applicant, a period from the expiration of a legal period to the completion of the procedure is not included in the maximum permissible length of extension period.

Item (iv) (Period consumed as a result of the suspension of an administrative disposition or notification upon request or due to any other act of an applicant)

Because normal patent filing procedure does not suppose the suspension of an administrative disposition or notification upon request or due to any other act of the applicant, that is, the suspension of an administrative disposition or notification not provided by the laws and regulations but decided at the discretion of the Patent Office, and such suspension is made for a reason not attributable to the Patent Office, a period consumed until the reason for suspension ceases to exist is not included in the maximum permissible length of extension period.

Item (v) (Period consumed as a result of the filing of a request for reduction or exemption of a patent fee or a handling fee or a request for deferment of payment thereof)

Because documents requesting the reduction or exemption of a handling fee for examination request or a patent fee are submitted for a reason attributable to the applicant, examining such documents does not constitute a normal procedure. Thus, a period consumed to examine such documents is not included in the maximum permissible length of extension period.

Item (vi) (Period consumed as a result of the withdrawal of a written supplement for the description, etc.)

Because the withdrawal* of a written supplement for the description, etc. does not constitute a normal procedure and suspends filing and examination procedure until supplement procedure is completed, a period from such withdrawal to the completion of supplement procedure is not included in the maximum permissible length of extension period. (*In case of withdrawal, the original description is examined)

Items (vii) (Period consumed as a result of an appeal against an examiner's decision of refusal)

Because the TPP 11 Agreement allows signatories to exclude from “unreasonable delays” a period consumed other than during the processing or examination of a patent application by the

Authority granting a patent, a period required for appeals and court trials is excluded from a period of “unreasonable delays.

Item (viii) (Period consumed as a result of carrying out a procedure specified in the Administrative Complaint Review Act)

Item (ix) (Period consumed as a result of the procedure specified in the Administrative Case Litigation Act)

Because the TPP 11 Agreement allows signatories to exclude from “unreasonable delays” a period consumed other than during the processing or examination of a patent application by the Authority granting a patent, a period required for a procedure under the Administrative Complaint Review Act or the Administrative Case Litigation Act with respect to a disposition to dismiss an application in filing procedure is excluded from a period of “unreasonable delays.

Item (x) (Period consumed as a result of suspension or discontinuation of a procedure specified in the Patent Act and regulations)

Because normal patent filing procedure does not suppose the suspension or discontinuation of a procedure under the Patent Act and regulations and such suspension or discontinuation is made for a reason not attributable to the Patent Office, a period of such suspension or discontinuation is not included in the maximum permissible length of extension period.

9102 Method of Calculating the Maximum Permissible Length of Extension Period

The maximum permissible length of extension period is calculated based on the calendar year as specified in 3.1.2 of Chapter 1, Part IX of the Examination Guidelines.

The calculation method is as follows:

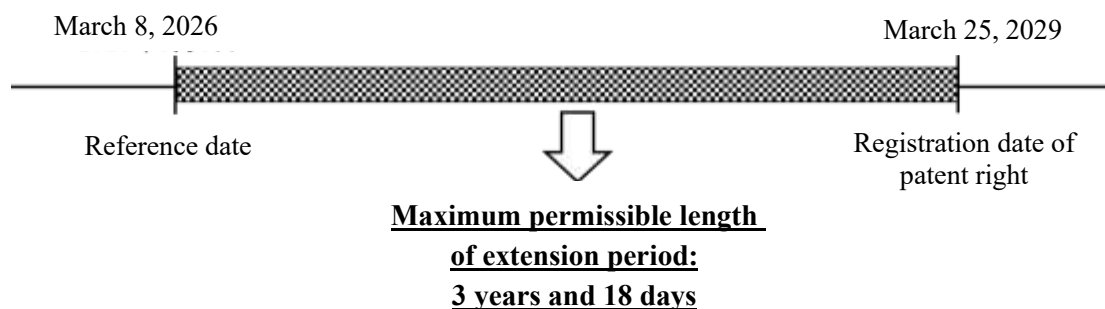
1. When none of the periods specified in items of Article 67 (3) intervenes

(1) Express a period from the reference date* to the registration date of the patent right in year-month-day format based on the calendar year to determine the maximum permissible length of extension period.

(*) The date five years after the filing of a patent application or the date three years after the filing of a request for examination of the application, whichever is later.

Example 1: Calculation method of the maximum permissible length of extension period when the reference date is March 8, 2026 and the registration date of the patent right is March 25, 2029, and none of the periods specified in items of Article 67 (3) intervenes

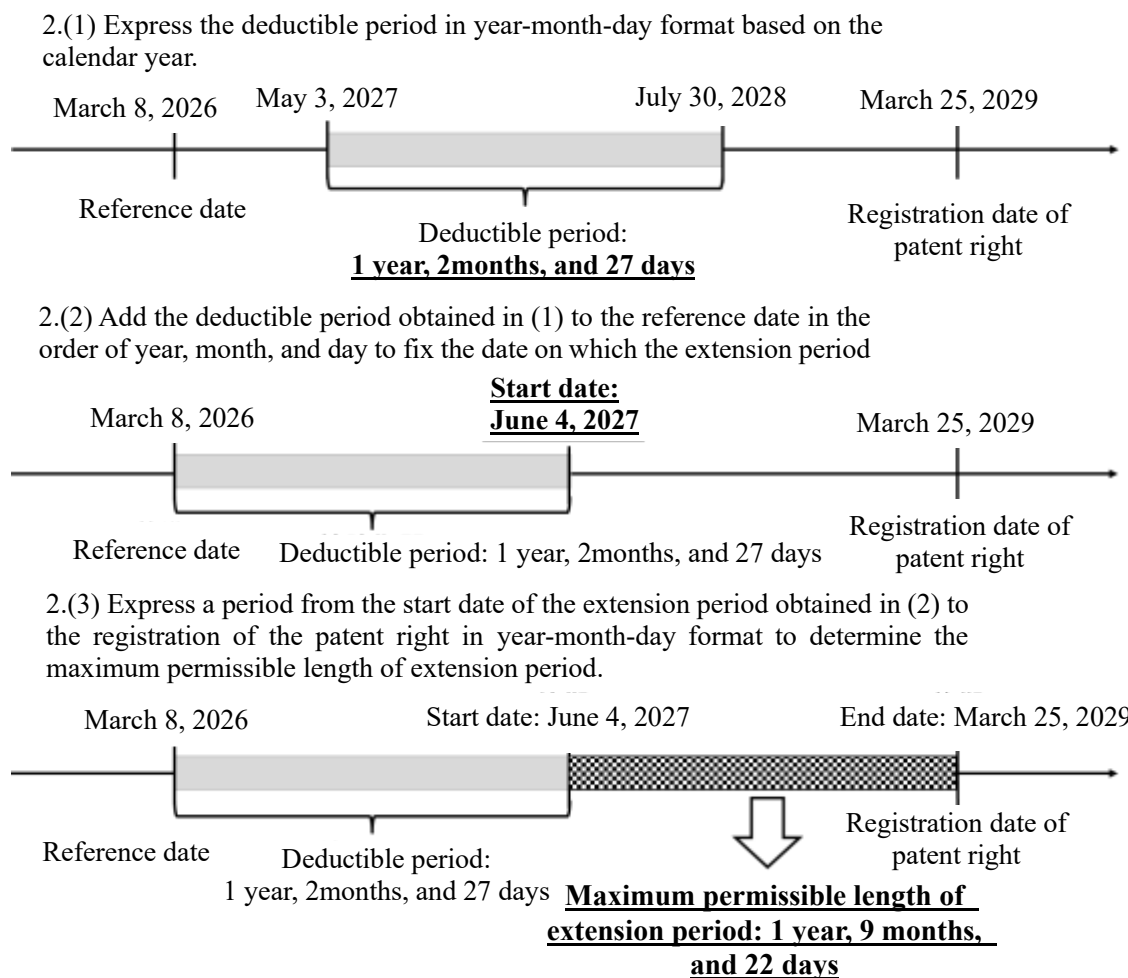
1.(1) Express a period from the reference date to the registration date of the patent right in year-month-day format based on the calendar year to determine the maximum permissible length of extension period.



2. When one of the periods specified in items of Article 67 (3) intervenes

- (1) Express the intervening period specified in items of Article 67 (3) in year-month-day format based on the calendar year.
- (2) Add the period obtained in (1) to the reference date in the order of year, month, and day to fix the date on which the extension period starts.
- (3) Express a period from the start date of the extension period obtained in (2) to the registration of the patent right in year-month-day format to determine the maximum permissible length of extension period.

Example 2: Calculation method of the maximum permissible length of extension period when the reference date is March 8, 2026 and the registration date of the patent right is March 25, 2029, and one of the periods specified in items of Article 67 (3) (referred to as a “deductible period” in the following figure) intervenes

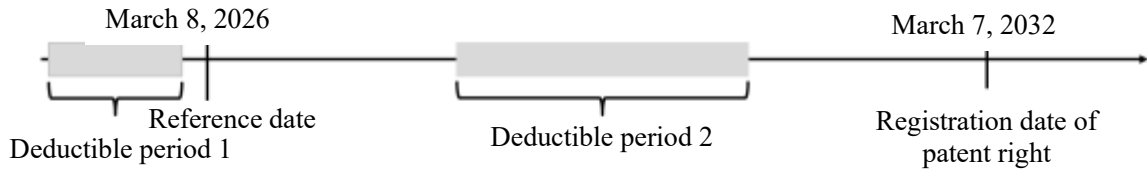


(Note) In this example, a “deductible period” does not start from 0:00 a.m. and the first day of the deductible period is not taken into account to fix the start date as specified in Article 3 (1). The same rule applies to the following examples.

3. When more than one of the periods specified in items of Article 67 (3) intervene and those periods do not overlap

- (1) Express all the intervening periods specified in items of Article 67 (3) in year-month-day format based on the calendar year.
- (2) Add together the periods obtained in (1). However, do not count 30 days as a month and 12 months as a year.
- (3) Add the period obtained in (2) to the reference date in the order of year, month, and day to fix the date on which the extension period starts.
- (4) Express a period from the start date of the extension period obtained in (3) to the registration of the patent right in year-month-day format to determine the maximum permissible length of extension period.

Example 3: Calculation method of the maximum permissible length of extension period when the reference date is March 8, 2026 and the registration date of the patent right is March 7, 2032, and one of the periods specified in items of Article 67 (3) (referred to as a “deductible period” in the following figure) intervenes before and after the reference date



3.(1) Express the deductible periods in year-month-day format based on the calendar year.

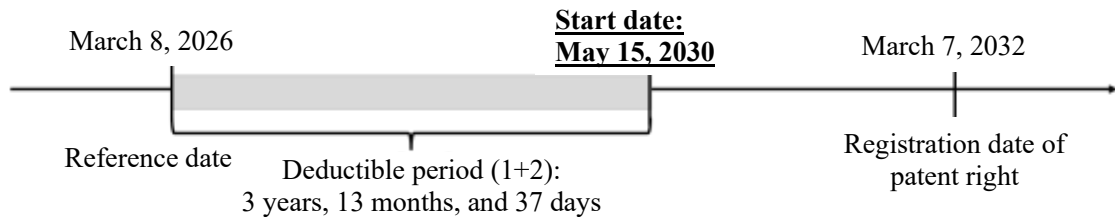
Deductible period 1: **1 year, 2 months, and 27 days**
 Deductible period 2: **2 years, 11 months, and 10 days**

3.(2) Add together the deductible periods obtained in (1).

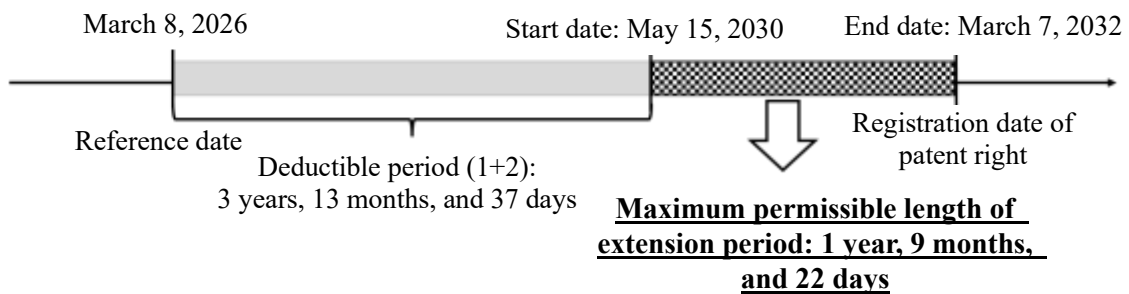
Deductible period 1: 1 year, 2 months, and 27 days
 Deductible period 2: 2 years, 11 months, and 10 days

➔ **3 years, 13 months, and 37 days**

3.(3) Add the deductible period obtained in (2) to the reference date in the order of year, month, and day to fix the date on which the extension period



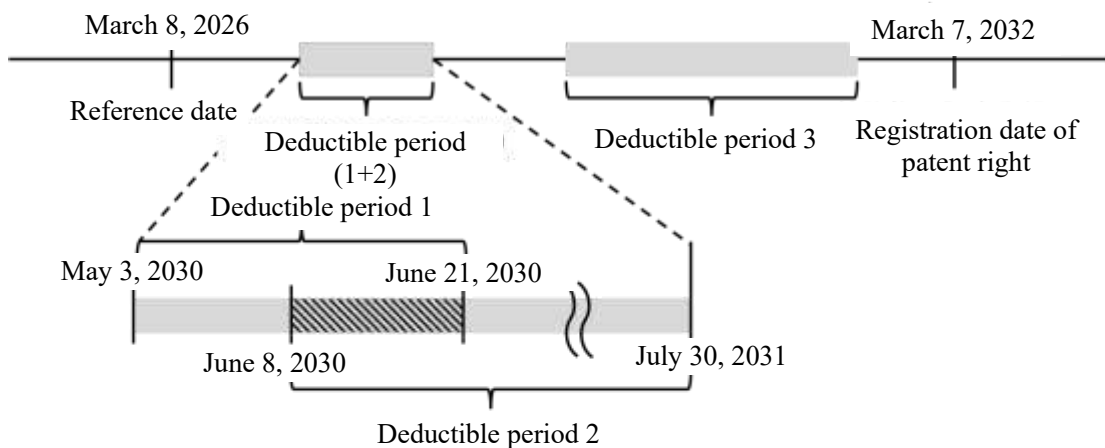
3.(4) Express a period from the start date of the extension period obtained in (3) to the registration of the patent right in year-month-day format to determine the maximum permissible length of extension period.



4. When more than one of the periods specified in items of Article 67 (3) intervene and some or all of those periods overlap partly

- (1) When more than one of the periods specified in items of Article 67 (3) intervene and some or all of those periods overlap partly, combine the partly-overlapping periods into one period to remove an overlapping duration.
- (2) Express all the periods comprised of the combined period obtained in (1) and a non-combined period(s) (a period(s) that does(do) not overlap another period specified in items of Article 67 (3)) in year-month-day format based on the calendar year.
- (3) When there are more than one periods obtained in (2) and expressed in year-month-day format, add them up. However, do not count 30 days as a month and 12 months as a year.
- (4) Add the period obtained in (3) to the reference date in the order of year, month, and day to fix the date on which the extension period starts.
- (5) Express a period from the start date of the extension period obtained in (4) to the registration of the patent right in year-month-day format to determine the maximum permissible length of extension period.

Example 4: Calculation method of the maximum permissible length of extension period when the reference date is March 8, 2026 and the registration date of the patent right is March 7, 2032, and more than one of the periods specified in items of Article 67 (3) (referred to as a “deductible period” in the following figure) intervene



4.(1) When the deductible periods overlap partly, combine them into one period



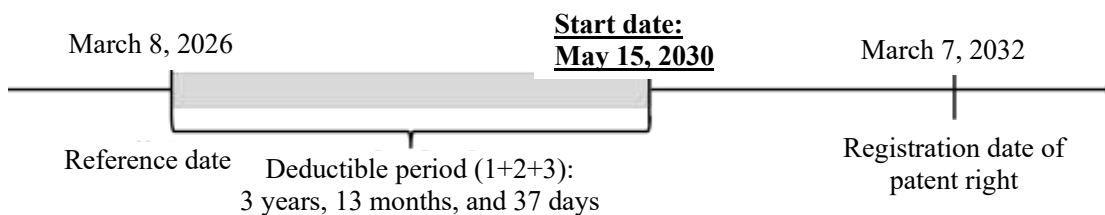
4.(2) Express the deductible periods in year-month-day format based on the calendar year.

Deductible period (1+2) ... 1 year, 2 months, and 27 days
 Deductible period (3) ... 2 years, 11 months, and 10 days

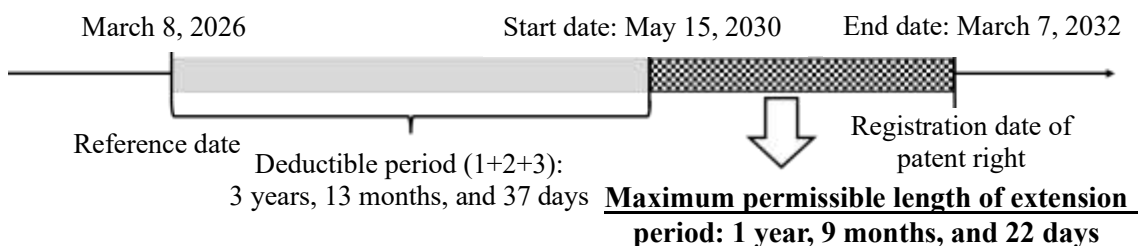
4.(3) Add together the deductible periods obtained in (2).

Deductible period (1+2) ... 1 year, 2 months, and 27 days
 Deductible period (3) ... 2 years, 11 months, and 10 days → 3 years, 13 months, and 37 days

4.(4) Add the deductible period obtained in (3) to the reference date in the order of year, month, and day to fix the date on which the extension period



4.(5) Express a period from the start date of the extension period obtained in (3) to the registration of the patent right in year-month-day format to determine the maximum permissible length of extension period.



9103 Disqualification of Examiner with respect to Application to Register Patent Term Extension as Compensation for the Curtailment of the Term

In the case where the examiner of an application to register a patent term extension as compensation for the curtailment of the term was involved as an examiner in the decision for a patent application related to a patent right in relation to which the above application has been filed, such examiner is disqualified from acting as examiner of the above application. (Article 139 (vi) applied mutatis mutandis in Article 67^{quater} where “against which the appeal has been filed” in Article 139 (vi) is replaced with “for a patent application related to a patent right in relation to which an application to register a patent term extension has been filed”)

According to this Article 139 (vi) applied mutatis mutandis, “the case where the examiner (of an application to register a patent term extension) was involved as an examiner in the decision for a patent application” is not limited to the case where the examiner made a decision, but includes the case where the examiner did not make a decision and issued a notice of reason for refusal or ruled dismissal of amendments.

(Explanation)

Examination of an application filed in the patent term extension registration system aimed at compensating for the curtailment of the term consists in determining the periods required for filing/examination procedures taken in connection with a patent application related to the above application. It is thus undesirable in terms of fairness that the examiner who was involved in the examination of such patent application is involved in the examination of the above application to register a patent term extension.

For this reason, a disqualification provision is provided to prevent an examiner having involved in the examination of a patent application from examining an application to register a patent term extension related to this patent application.

9104 Patent Application to Which Article 67 of the Patent Act as Amended in 2016 is Applicable

(1) Regular applications

Applications filed on or after March 10, 2020

(2) Divisional applications, converted applications, and patent applications based on utility model registration

Applications of which original applications are filed on or after March 10, 2020

(3) Applications claiming priority under the Paris Convention

Applications claiming priority which are filed on or after March 10, 2020

(4) Applications claiming internal priority

Applications claiming priority which are filed on or after March 10, 2020

Chapter 2 Extension of a Patent Term for Pharmaceutical Inventions

9201 Handling of Relationship between Application to Register Patent Term Extension and Number of Dispositions

One application to register a patent term extension must be filed for one disposition.

(Explanation)

Article 67septies of the Patent Act provides that the application to register a patent term extension shall be refused "when the disposition is not found to have been necessary for the working of the patented invention" (item (i) of the first paragraph). In other words, Article 67 septies requires that whether or not the "application to register a patent term extension" should be refused is determined depending on whether or not the "disposition" was necessary.

A factor that necessitates the registration of the patent term extension is caused in relation to each disposition, and the period during which the patented invention was unable to be worked and the effect of the patent right after registration of the patent term extension are to be determined on the basis of the individual disposition. Hence, one application to register a patent term extension should, in view of its nature, be filed for one single disposition on a per-disposition basis. Also, if one application to register a patent term extension is allowed to be filed for two or more dispositions by an applicant who has obtained the two or more dispositions at the same time in a certain period for one single patent right so that only he/she can enjoy the benefit of the registration of patent term extension on the basis of the two or more dispositions by one single application to register a patent term extension, such practice will lead to impermissible imbalance among applicants.

In view of the foregoing, the above rule of handling is to be complied with regarding the relationship between the application to register a patent term extension and the number of dispositions.

9202 Regarding Extended Term Where Two or More Trials Necessary for
Obtaining Disposition Designated by Cabinet Order Were Conducted for
One Single Disposition in Application for Registration of Patent Term
Extension

"The date on which testing necessary for obtaining the disposition commenced means" stated in 3.1.3 of Chapter 2, Part IX of the Examination Guidelines is deemed to be the day of commencement of a trial that is found in view of the patent application documents to be the first trial among a series of trials if the applicant demonstrates that he/she has conducted the series of trials in relation to a single disposition whose periods can be included in "the period during which the patented invention was unable to be worked" (see 3.1.3(1)).

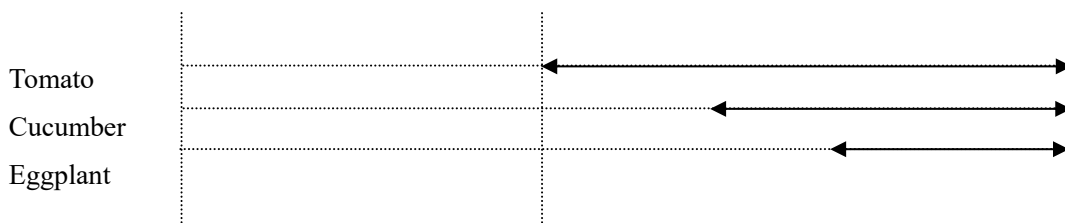
(Explanation)

(1) Commissioned field trials for agricultural chemicals often commence on different days depending on crops and applicable diseases or insects pests, etc., and an application for registration of an agricultural chemical may be filed for a set of the results of these trials so that one registration may be established.

Example for Reference

Patented Invention: "An insecticide containing A as an active ingredient"

Registration of Establishment of Patent Right



(Note) The solid lines each indicate the period from the date of commencement of a trial against aphids with regard to a1, which is a more specific concept of the active ingredient A to the date on which the applicant is notified of the registration, or in other words, to the date on which the applicant actually learns of the registration or could have learned of it.

(2) In the above reference example, the period from the date of commencement of the trial for the agricultural chemical with respect to tomatoes to the date on which the applicant is notified of the

registration, in other words, to the date before the date on which the applicant actually learns of the registration or could have learned of it corresponds to "the period during which the patented invention was unable to be worked". Thus, "the period for which the extension is requested" that does not exceed this period (which must be not more than five years) is deemed to be the extended term of the patent right.

9203 Patent Application to Which Article 67 of the Patent Act as Amended in 2016 is Applicable

(1) Regular applications

Applications filed on or after March 10, 2020

(2) Divisional applications, converted applications, and patent applications based on utility model registration

Applications of which original applications are filed on or after March 10, 2020

(3) Applications claiming priority under the Paris Convention

Applications claiming priority which are filed on or after March 10, 2020

(4) Applications claiming internal priority

Applications claiming priority which are filed on or after March 10, 2020

