

<Relevant Provisions>

Patent Act

(Amendment of Description, Claim, or Drawing attached to the Request)

Article 17-2

(Omitted)

(2) to (4) (Omitted)

(5) In addition to the requirements provided in the preceding two paragraphs, in the cases set forth in items (i), (iii) and (iv) of paragraph 1 (the case set forth in item (i) thereof being limited to the case where the applicant has received a notice under Article 50-2 along with the notice of reasons for refusal), the amendment of the scope of claims shall be limited to those for the following purposes:

(i) to (iv) (Omitted)

(6) (Omitted)

(Patent applications)

Article 36

(Omitted)

(2) The description, scope of claims, drawings (where required), and abstract shall be attached to the application.

(3) to (7) (Omitted)

(Certification of filing date)

Article 38bis

The Commissioner of the Patent Office shall certify the date on which the application with regard to a patent application is submitted as the date of the filing of a patent application, except in cases where the patent application falls under any of the following items:

(i) where it is recognized that indication of requesting the grant of a patent is not clear;

(ii) where the statement of the name of the applicant(s) does not exist or it is recognized that the said statement is not so clear to specify the applicant(s); and

(iii) where description (in foreign-language-written-application, the matters to be stated in the description are stated in foreign-language as provided by Ordinance of the Ministry of Economy, Trade and Industry under Article 36bis(1); hereinafter, the same shall apply in this Article) is not attached to the said

application (except in the case where a patent application is filed by a method prescribed in the paragraph (1) of the immediately following Article).

(2) to (9) (Omitted)

(Patent application by a method for claiming to refer an earlier patent application)

Article 38ter

Except for a case of filing a foreign-language-written-application, a person requesting the grant of a patent, notwithstanding Article 36(2), may file a patent application by a method for claiming to refer a patent application made by the person (including one made in a foreign country, hereinafter referred to as "earlier patent application" in this Article); provided, however, that this shall not apply where the patent application falls under item (i) or (ii) of Article 38bis(1).

(2) A person filing a patent application by a method under the preceding paragraph shall submit to the Commissioner of the Patent Office a document stating thereof and matters as provided by Ordinance of the Ministry of Economy, Trade and Industry, at the time of filing the said patent application.

(3) A person who has filed a patent application by the method under paragraph (1) shall submit the description and drawing(s) (if necessary) to be submitted with the application of the said patent application, and the document as provided by Ordinance of the Ministry of Economy, Trade and Industry with regard to the earlier patent application referred in the method under the said paragraph within the time limit as provided in Ordinance of the Ministry of Economy, Trade and Industry.

(4) Where the matters stated in the description and drawing(s) submitted under the preceding paragraph do not remain the matters stated in the description, claims or drawing(s) attached to the application of the earlier patent application referred in the method under paragraph(1) (in the case where the said earlier patent application is a foreign-language-written-application, foreign-language-documents; in the case where the said earlier patent application is filed in a foreign country, documents which are submitted at the time of filing the application and correspond to the description, claims or drawing(s)), the said patent application, notwithstanding Article 38bis(1), shall be deemed to have been filed at the time of submission of the description and drawing(s) under the preceding paragraph.

(5) The description and drawing(s) submitted under paragraph (3) shall be deemed to be submitted with the application.

(6) Any of the preceding paragraphs shall not apply to a new patent application

arising from the division of a patent application under Article 44(1), a patent application arising from the conversion of an application under Article 46(1) or (2), and a patent application based on a utility model registration under Article 46bis(1).

(Division of patent applications)

#### Article 44

An applicant for a patent may extract one or more new patent applications out of a patent application containing two or more inventions only within the following time limits:

- (i) at such time when or within such time period in which amendments of the description, scope of claims or drawings attached to the request are allowed;
- (ii) within 30 days from the date of service of a certified copy of the examiner's decision to the effect that a patent is to be granted (excluding the examiner's decision to the effect that a patent is to be granted under Article 51 as applied *mutatis mutandis* under Article 163(3) and the examiner's decision to the effect that a patent is to be granted with regard to a patent application that has been subject to examination as provided in Article 160(1)); and
- (iii) within three months from the date of service of a certified copy of the examiner's initial decision to the effect that the application is to be refused.

(2) In the case referred to in the preceding paragraph, the new patent application shall be deemed to have been filed at the time of filing of the original patent application; provided, however, that this shall not apply for the purposes of application of these provisions and the provision of Article 30(3) in the case where the new patent application constitutes another patent application as prescribed in Article 29bis or a patent application as prescribed in Article 3bis of the Utility Model Act.

(3) For the purpose of application of Article 43(2) (including the cases where it is applied *mutatis mutandis* in Article 43bis(2) (including the case where it is applied *mutatis mutandis* in paragraph 3 of the preceding Article) and in paragraph 3 of the preceding Article) in the case where a new patent application is filed under paragraph 1, "within one year and four months from the earliest of the following dates" in Article 43(2) shall be deemed to be replaced with "within one year and four months from the earliest of the following dates or three months from the date of filing of the new patent application, whichever is later."

(4) Where a new patent application is filed under paragraph 1, any statements or documents which have been submitted in relation to the original patent application

(in the case of a submission under Article 43(2) (including the cases where it is applied mutatis mutandis pursuant to Article 43bis(2) (including the case where it is applied mutatis mutandis pursuant to paragraph (3) of the preceding Article; hereinafter the same shall apply in this paragraph) and paragraph (3) of the preceding Article), including statements or documents provided by electronic or magnetic means) and are required to be submitted in relation to the new patent application under Article 30(3), 41(4), or 43(1) and 43(2) (including the cases where these provisions are applied mutatis mutandis in Article 43bis(2) and in paragraph 3 of the preceding Article) shall be deemed to have been submitted to the Commissioner of the Patent Office simultaneously with such new patent application.

(5) If the period as provided in Article 108(1) is extended under Article 4 or Article 108(3), the 30-day period as provided in paragraph (1)(ii) shall be deemed to have been extended only for that period as extended.

(6) If the period as provided in Article 121(1) is extended under Article 4, the three-month period as provided in paragraph (1)(iii) shall be deemed to have been extended only for that period as extended.

(7) If the applicant of a new patent application as provided in paragraph 1 cannot file such new application within the time period provided in item (ii) or (iii) of the same paragraph due to a reason not attributable to the applicant, then, notwithstanding these provisions, the applicant may file such new application within 14 days (or two months, if the applicant is a resident abroad) from the day when such reason ceases to exist, but no later than six months from the expiry of the time period provided in these provisions.

(Conversion of application)

#### Article 46

An applicant of utility model registration may convert the application into a patent application; provided, however, that this shall not apply after the expiration of three years from the date of filing of the utility model registration application.

(2) An applicant of design registration may convert the application into a patent application; provided, however, that this shall not apply after the expiration of three months from the date of service of a certified copy of the examiner's initial decision to the effect that the application for design registration is to be refused or after the expiration of three years from the date of filing of the design registration application (except within three months from the date of service of a certified copy of the

examiner's initial decision to the effect that the application for design registration is to be refused).

(3) If the period as provided in Article 46(1) of the Design Act is extended under Article 4 of the Patent Act as applied mutatis mutandis in Article 68(1) of the Design Act, the three-month period as provided in the proviso of the preceding paragraph shall be deemed to have been extended only for that period as extended.

(4) If an application is converted pursuant to the provision of paragraph 1 or 2, the original application shall be deemed to have been withdrawn.

(5) If a person who intends to convert an application pursuant to the provision of paragraph 1 cannot convert such application within the time period provided in the proviso thereof due to a reason not attributable to him or her or if a person who intends to convert an application pursuant to the provision of paragraph 2 cannot convert such application within the three-year period provided in the proviso thereof due to a reason not attributable to him or her, then, notwithstanding these provisions, he or she may convert such application within 14 days (or within two months if he or she is a resident abroad) from the day when such reason ceases to exist, but no later than six months from the expiration of the time periods provided in these provisions.

(6) The provisions of paragraphs 2 to 4 of Article 44 shall apply mutatis mutandis to the conversion of an application pursuant to the provision of paragraph 1 or 2.

(Patent applications based on utility model registration)

Article 46-2

Except for the following cases, a holder of utility model right may file a patent application based on his/her own utility model registration as provided in an Ordinance of the Ministry of Economy, Trade and Industry, in which case, the utility model right shall be abandoned:

- (i) when three years has elapsed from the date of filing of the application for the relevant utility model registration;
- (ii) when a request for the examiner's technical opinion as to the registrability of the utility model claimed in the utility model registration application or of the utility model registration (simply referred to as "utility model technical opinion" in the following item) is filed by the applicant of the utility model registration or the utility model right holder pursuant to the provision of Article 12(1) of the Utility Model Act;
- (iii) when 30 days has elapsed from the date of receipt of an initial notice pursuant to

the provision of Article 13(2) of the Utility Model Act that pertains to a request for a utility model technical opinion made by a person who is neither the applicant of the relevant utility model registration nor the holder of the relevant utility model right in connection with the relevant utility model registration application or the relevant utility model registration; and

(iv) when the period originally designated pursuant to the provision of Article 39(1) of the Utility Model Act in connection with a trial for the invalidation of the relevant utility model registration requested under Article 37(1) thereof, has expired.

(2) A patent application filed pursuant to the provision of the preceding paragraph shall be deemed to have been filed at the time of filing of the relevant utility model registration application if the matters stated in the description, scope of claims, or drawings attached to the patent request are within the scope of the matters stated in the description, scope of claims, or drawings attached to the utility model registration request on which the patent application is based; provided, however, that this shall not apply for the purpose of the application of these provisions in the case where such patent application is another patent application as provided in Article 29-2 or a patent application provided in Article 3-2 of the Utility Model Act, as well as the application of the provisions of Article 30(3), the proviso of Article 36-2(2), and Article 48-3(2).

(3) If a person who intends to file a patent application pursuant to the provision of paragraph 1 cannot file such application within the time period provided in item (i) or (iii) of the same paragraph due to a reason not attributable to him or her, then, notwithstanding these provisions, he or she may file such application within 14 days (or within two months, if he or she is a resident abroad) from the day when such reason ceases to exist, but no later than six months from the expiration of the time periods provided in these provisions.

(4) If there is an exclusive licensee, a pledgee, or a non-exclusive licensee pursuant to the provision of Article 35(1) of this Act as applied mutatis mutandis in Article 11(3) of the Utility Model Act, the provision of Article 77(4) of this Act as applied mutatis mutandis in Article 18(3) of the Utility Model Act or the provision of Article 19(1) of the Utility Model Act, then the holder of a utility model right may file a patent application pursuant to the provision of paragraph 1 only when the consent of such exclusive licensee, pledgee, or non-exclusive licensee has been obtained.

(5) The provisions of Articles 44(3) and 44(4) shall apply mutatis mutandis to the filing of a patent application pursuant to the provision of paragraph 1.

(Notice to the effect that the reasons for refusal stated therein are the same as those stated in a preceding notice)

Article 50-2

In the case where the examiner intends to give a notice of reasons for refusal for a patent application under the preceding Article, if such reasons for refusal are the same as those stated in a notice given under the preceding Article (including the cases in which it is applied mutatis mutandis in Article 159(2) (including the case in which it is applied mutatis mutandis in Article 174(2)) and in Article 163(2)) in connection with another patent application (limited to one that is deemed to have been filed simultaneously with the application concerned by virtue of the application of the provision of Article 44(2) to at least either of the application concerned and such other application) (except where the contents of such notice were not accessible to the applicant of the application concerned prior to the filing of a request for examination thereof), then the examiner shall also give a notice to that effect.

Regulations under the Patent Act

(Procedure, etc. of a case where a person files a patent application by asserting referencing to an earlier patent application)

Article 27decies

Matters prescribed by the Ordinance of the Ministry of Economy, Trade and Industry under Article 38ter (2) of the Patent Act shall be listed below:

- (i) the name of country or international organization where the earlier patent application was filed
- (ii) the filing date of the earlier patent application
- (iii) the application number of the earlier patent application

(2) A person who intends to file a patent application in the manner prescribed in Article 38ter (1) of the Patent Act may omit submission of document prescribed under Article 38ter (2) if the person states concerning the matter to that effect in the request of the patent application and matters listed in the former paragraph.

(3) Period prescribed by the Ordinance of the Ministry of Economy, Trade and Industry under Article 38ter (3) of the Patent Act shall be four months from the day of filing the patent application.

(4) The document prescribed by the Ordinance of the Ministry of Economy, Trade and Industry under Article 38ter (3) of the Patent Act shall be the copies of

documents as of filing the earlier patent application certified by the country or the international organization where the application was filed, the documents corresponding to the description, claims, and drawing(s) of the application (including copies provided by electronic or magnetic means (meaning by electronic means, magnetic means, or other means that is impossible to perceive through the human senses alone), or copies thereof (hereinafter referred to as “certified copy, etc. of earlier patent application” in this article) and, in a case where the certified copy, etc. of earlier patent application is stated in a foreign language, Japanese translation thereof.

(5) A person who filed a patent application in the manner prescribed in Article 38ter (1) of the Patent Act may omit submission of the certified copy, etc. of earlier patent application, notwithstanding the provision of the preceding paragraph, in a case where the applicant has already submitted the certified copy, etc. of earlier patent application or the corresponding document to the Commissioner of the JPO, in a case where the applicant has already submitted the document prescribed under Article 43 (5) of the Patent Act (Article 43bis (2) of the Patent Act (including a case where applied mutatis mutandis pursuant to Article 43ter (3) of the Patent Act) and including a case where applied mutatis mutandis pursuant to Article 43ter (3) of the Patent Act) to the commissioner of the JPO (including a case where the applicant omits submission of the document in which matters prescribed in Article 27ter (3) (iii) are stated pursuant to the provision of Article 27quater (5)), or in a case where the earlier patent application was filed in Japan.

(6) In a case where the applicant submits the description and necessary drawing(s) pursuant to the provision of Article 38ter (3) of the Patent Act, the submission should be performed pursuant to Form 37bis.

(7) In a case where the applicant submits the certified copy, etc. of earlier patent application and Japanese translation thereof pursuant to the provision of Article 38ter (3) of the Patent Act, the submission should be performed pursuant to Form 22.

## Patent Law Treaty (PLT)

### Article 5 Filing Date

#### (1) [Elements of Application]

(a) Except as otherwise prescribed in the Regulations, and subject to paragraphs (2) to (8), a Contracting Party shall provide that the filing date of an application shall be the date on which its Office has received all of the following elements, filed, at



the option of the applicant, on paper or as otherwise permitted by the Office for the purposes of the filing date:

- (i) an express or implicit indication to the effect that the elements are intended to be an application;
- (ii) indications allowing the identity of the applicant to be established or allowing the applicant to be contacted by the Office;
- (iii) a part which on the face of it appears to be a description.

(b),(c) (Omitted)

(2) to (6) (Omitted)

(7) [Replacing Description and Drawings by Reference to a Previously Filed Application]

(a) Subject to the requirements prescribed in the Regulations, a reference, made upon the filing of the application, in a language accepted by the Office, to a previously filed application shall, for the purposes of the filing date of the application, replace the description and any drawings.

(b) (Omitted)

(8) (Omitted)

Regulations under the patent law treaty

Rule 2 Details Concerning Filing Date Under Article 5

(1) to (4) (Omitted)

(5) [Requirements Under Article 5(7)(a)]

(a) The reference to the previously filed application referred to in Article 5(7)(a) shall indicate that, for the purposes of the filing date, the description and any drawings are replaced by the reference to the previously filed application; the reference shall also indicate the number of that application, and the Office with which that application was filed. A Contracting Party may require that the reference also indicate the filing date of the previously filed application.

(b),(c) (Omitted)

(6) (Omitted)