

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

## Part VIII International Patent Application

The "international patent application" in this part means an international patent application under the Patent Cooperation Treaty which is transferred into a national phase (relating to a patent application). In addition, a "patent application in Japanese language" means an international patent application made by Japanese, and a "patent application in foreign language" means an international patent application made by a foreign language.

### 1. Overview

The international patent application under the Patent Cooperation Treaty (PCT) has an effect as a formal internal patent application from the international filing date in each designated country when the international filing date is recognized, and the international filing date is deemed as a filing date in each designated country (Article 11(3) of PCT).

Therefore, the international patent application containing Japan as the designated country requesting the grant of a patent in Japan for which the international filing date is recognized will have an effect as a regular national patent application (which means a patent application provided by Article 36 or 36bis hereinafter in this Part).

In order to prescribe the handling for the international patent application containing Japan as the designated country which has such an effect, the provisions of Article 184ter to 184vicies are provided.

### 2. Documents relating to the international patent application

#### 2.1 The request on the international filing date

The request on the international filing date of the international patent application is deemed as the request which is submitted under the provision of Article 36(1) (Article 184sexies(1)).

#### 2.2 Description, claims, drawings and abstract on the international filing date

### 2.2.1 In case of the patent application in Japanese language

The description, the claims, the drawings on the international filing date (hereinafter, referred to as "description, etc. on the international filing date" in this part) and the abstract thereon are deemed to be the description, the claims, the drawings which are attached to the request to submit under the provision of Article 36(2) (hereinafter, referred to as "description, etc." in this part) and the abstract, respectively (Article 184sexies(2)).

### 2.2.2 In case of the patent application in foreign language

See 2.4 (2).

### 2.3 Document prescribed in Article 184quinquies(1)

(1) Regardless of the patent application in Japanese language and the patent application in foreign language, the application of the international patent application shall submit a document stating matters of an applicant, an inventor, an international patent application number and the like (hereinafter, in this Part, referred to as a "national document") within the time limit for the submission of national documents (Note) (Article 184quinquies(1)).

(Note) The time limit for the submission of national documents herein means a period of 2 year and 6 months from the priority date prescribed in Article 2(xi) of PCT (Article 184quater(1)).

(2) Where the national document is not submitted or where the procedures under Article 184quinquies(1) are violated, an order of amendment or a dismissal of the patent application will be subjected (Article 184quinquies(2)(i) to (iii) and (3)).

### 2.4 Translations

(1) An applicant of a patent application in foreign language shall submit Japanese translations of the description, claims, drawings (limited to the descriptive text in such drawings) (Note1), and the abstract as of the international application date within the Time Limit for the Submission of National Documents (Article 184quater(1)). However, the applicant of a patent application in foreign language who has submitted

the national documents during the period from two months before the expiration of the Time Limit for the Submission of National Documents to the expiry date thereof may submit said translations within two months from the date of submission of said national documents (the proviso to Article 184quater(1)). (Hereinafter, in this Part, time provided in the main clause and proviso of Article 184quater(1) is in general referred to as the "time limit for the submission of translations." )

Relating to a patent application in foreign language, in the case where the translation has not been submitted, see 3. .

(Note1) An applicant of a foreign language written application shall submit Japanese translation of the drawings, not limited to the description text in such drawings (Article 36bis(1) and (2)).

(2) The translations of the description, claims, and drawings (excluding the descriptive text in such drawings), and the translation of the descriptive text in such drawings of a patent application in foreign language as of the international application date shall be deemed to be the description etc. submitted with the application (Note2), and the translation of the abstract of a patent application in foreign language shall be deemed to be the abstract submitted with the application (Article 184sexies(2)).

(Note2) If the translation of a written amendment under PCT Article 19 has been submitted, said translation shall be deemed to be the claims submitted with the application under Article 36(2) (see 2.5.2).

## 2.5 Written amendment under PCT Article 19

### 2.5.1 Patent application in Japanese language

(1) If an applicant of a patent application in Japanese language has made an amendment under PCT Article 19(1) (hereinafter, in this Part, referred to as "amendment under Article 19"), such applicant shall submit a copy of the written amendment by the amendment under Article 19 on or before the date on which the National Processing Standard Time (Note) falls (Article 184septies(1)).

(Note) The National Processing Standard Time of a patent application in Japanese language means the earlier time of the following (i) and (ii) (Article 184quater(6)).

(i) the date on which the Time Limit for the Submission of National Documents expires

(ii) the time of requesting where the applicant requests the examination of the application within the Time Limit for the Submission of National Documents

(2) (i) If a copy of a written amendment by an amendment under Article 19 has been submitted, an amendment to the claims attached to the application shall be deemed to have been made under Article 17bis(1) by said copy of the written amendment, or (ii) if a written amendment has been served by the International Bureau under PCT Article 20 on or before the date on which the National Processing Standard Time falls, an amendment to the claims attached to the application shall be deemed to have been made under Article 17bis(1) by said written amendment (Article 184septies(2)).

(3) If (i) a copy of a written amendment by an amendment under Article 19 has not been submitted, and (ii) the written amendment of (2)(ii) above has not been served on or before the date on which the National Processing Standard Time falls, no amendment under Article 19 shall be deemed to have been made (Article 184septies(3)).

#### 2.5.2 Patent application in foreign language

(1) If an applicant of a patent application in foreign language has made an amendment under Article 19, the applicant may, in lieu of the translation of the claims as of the international application date, submit a translation of the claims after the amendment under Article 19 (Article 184quater(2)).

Even if the applicant of the patent application in foreign language has submitted the translation of the claims as of the international application date, the applicant may submit a translation of the claims after the amendment under Article 19 on or before the date on which the National Processing Standard Time (Note) falls (Article 184quater(6)).

(Note) The National Processing Standard Time of a patent application in foreign language means the earlier time of the following (i) and (ii) (Article 184quater(3) and (6)).

(i) the date on which the time limit for the submission of translations (see 2.4(1)) expires

(ii) the time of requesting where the applicant requests the examination of the application within the time limit for the submission of translations

(2) If a translation of the claims after an amendment under Article 19 has been submitted, said translation of the claims after an amendment under Article 19 shall be

deemed to be the claims submitted with the application under Article 36(2) (Article 184sexies(3)).

(3) If the procedure of (1) above has not been taken, no amendment under Article 19 shall be deemed to have been made (Article 184quater(7)).

## 2.6 Written amendment under PCT Article 34

### 2.6.1 Patent application in Japanese language

(1) If an applicant of a patent application in Japanese language has made an amendment under PCT Article 34(2)(b) (hereinafter, in this Part, referred to as "amendment under Article 34"), such applicant shall submit a copy of the written amendment by the amendment under Article 34 on or before the date on which the National Processing Standard Time falls (Article 184octies(1)).

(2) (i) If a copy of a written amendment by an amendment under Article 34 has been submitted, an amendment to the description, etc. shall be deemed to have been made under Article 17bis(1) by said copy of the written amendment, or (ii) if a written amendment has been served by the International Bureau under PCT Article 36(3)(a) on or before the date which the National Processing Standard Time falls into, an amendment to the description, etc. shall be deemed to have been made under Article 17bis(1) by said written amendment (Article 184octies(2)).

(3) If (i) a copy of a written amendment by an amendment under Article 34 has not been submitted, and (ii) the written amendment of (2)(ii) above has not been served on or before the date on which the National Processing Standard Time falls into, no amendment under Article 34 shall be deemed to have been made (Article 184octies(3)).

### 2.6.2 Patent application in foreign language

(1) If an applicant of a patent application in foreign language has made an amendment under Article 34, the applicant shall submit a translation of the written amendment by the amendment under Article 34 on or before the date on which the National Processing Standard Time falls. (Article 184octies(1)).

(2) If a translation of the written amendment by the amendment under Article 34 has been submitted, an amendment to the description, etc. shall be deemed to have been made under Article 17bis(1) by the translation of the written amendment (Article 184octies(2)).

In this case, said amendment shall be deemed to have been made by submitting the statement of correction of the incorrect translation (Article 184octies(4)).

(3) If a translation of the written amendment by the amendment under Article 34 has not been submitted on or before the date which the National Processing Standard Time falls into, no amendment under Article 34 shall be deemed to have been made (Article 184octies(3)).

## 2.7 Statement of correction of an incorrect translation

(1) If an applicant of a patent application in foreign language amends the description, etc. for the purpose of correcting an incorrect translation, the applicant shall submit not the written amendment but the statement of correction of the incorrect translation, stating the grounds thereof (Article 17bis(2) replaced with Article 184duodecies(2)).

(2) If an applicant of a patent application in foreign language amends the description, etc. for the purpose of correcting an incorrect translation and the description, etc. excluding said purpose (hereinafter, in this Part, referred to as "regular amendment"), matters of amendment corresponding to said regular amendment may be included in the statement of correction of the incorrect translation.

<h2>3. Treatment in the case where a Translation relating to Patent Application in Foreign Language has not been submitted</h2>
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### 3.1 In the case where translations of the description and claims have not been submitted

In a case where translations of the description and claims have not been submitted within the time limit for the submission of translations (see 2.4(1)), the patent application in foreign language shall be deemed to have been withdrawn (Article 184quater(3)).

3.2 In a case where a translation of the descriptive text in drawings has not been submitted

In a case where a translation of the descriptive text in drawings has not been submitted, the drawings as of the international application date excluding the descriptive text in the drawings shall be deemed to be the drawings submitted with the application, and the descriptive text in the drawings shall be treated as if the descriptive text does not exist (Article 184sexies(2)).

3.3 In a case where a translation of the abstract has not been submitted

Even if a translation of the abstract has not been submitted within the time limit for the submission of translations, the patent application shall not be deemed to have been withdrawn. However, if the translation of the abstract has not been submitted, the Commissioner of the Patent Office may order the amendment and dismiss the patent application (Article 184quinquies(2)(iv) and (3)).

4. Amendment of the Description, etc. of International Patent Application
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4.1 Documents to be amended

4.1.1 Patent application in Japanese language

For patent applications in Japanese language, the description, etc. (see 2.2.1) are to be amended.

4.1.2 Patent application in foreign language

For patent applications in foreign language, the description, etc. (see 2.4(2)) are to be amended.

4.2 Timing at which description, etc. may be amended

4.2.1 Timing at which the description, etc. of a patent application in Japanese

language may be amended

It is basically the same as a regular national patent application, however an amendment (Note) may be made only after executing all of the following (i) and (ii) (Article 184duodecies(1)).

- (i) submission of national documents (see 2.3)
- (ii) payment of prescribed fee

(Note) Amendments under Article 184septies(2) (see 2.5.1(2)) and Article 184octies(2) (see 2.6.1(2)) are excluded.

#### 4.2.2 Timing at which the description, etc. of a patent application in foreign language may be amended

It is basically the same as a regular national patent application however amendment (Note) may be made only after executing all of the following (i) to (iv) (Article 184duodecies(1)).

- (i) submission of translations
- (ii) submission of national documents (see "2.3 Documents under Article 184quinqies(1)")
- (iii) payment of prescribed fee
- (iv) after a lapse of the National Processing Standard Time

(Note) An amendment under Article 184octies(2) (see 2.6.2(2)) is excluded.

## 5. Examination of International Patent Application

### 5.1 Patent application in Japanese language

Examination of a patent application in Japanese language is the same as that of a regular national patent application.

However, if an amendment under Article 19 or Article 34 has been made, the examiner shall consider the following point.



If a copy of a written amendment by an amendment under Article 19 or Article 34 has been submitted, or if a written amendment has been served by the International Bureau, an amendment shall be deemed to have been made under 17bis(1) by said copy of the amendment or said amendment (see 2.5.1 and 2.6.1).

## 5.2 Patent application in foreign language

Examination of a patent application in foreign language is the same as that of a foreign language written application. The examiner shall examine a patent application in foreign language in accordance with "Part VII Chapter 2 Examination of Foreign Language Written Application". In this case, the examiner shall replace "foreign language documents" with "the description, claims or drawings as of the international application date under Article 184quater(1) ".

However, if an amendment under Article 19 or Article 34 has been made, the examiner shall consider the following point.

If a translation of the claims after amendment under Article 19 has been submitted, the translation shall be deemed to be the claims submitted with the application under Article 36(2) (see 2.5.2). Therefore, the translation becomes the claims which is a standard for determination on new matters beyond a translation.

If a translation of a written amendment by an amendment under Article 34 has been submitted, an amendment to the description, etc. shall be deemed to have been made by the translation of the written amendment, and the amendment is deemed to have been made by submitting the statement of correction of an incorrect translation (see 2.6.2). Therefore, the provision of new matters beyond a translation shall not be applied to the amendment. The description, etc. in which the amendment has been made becomes the description, etc. which is a standard for determination on new matters beyond a translation.

## 6. Treatment of Various Patent Applications

An international patent application to which the international application date is accorded shall have effect as a regular patent application. Therefore, a divisional application, converted application and application claiming priority based on an international patent application are recognized in the same way as a regular patent application.

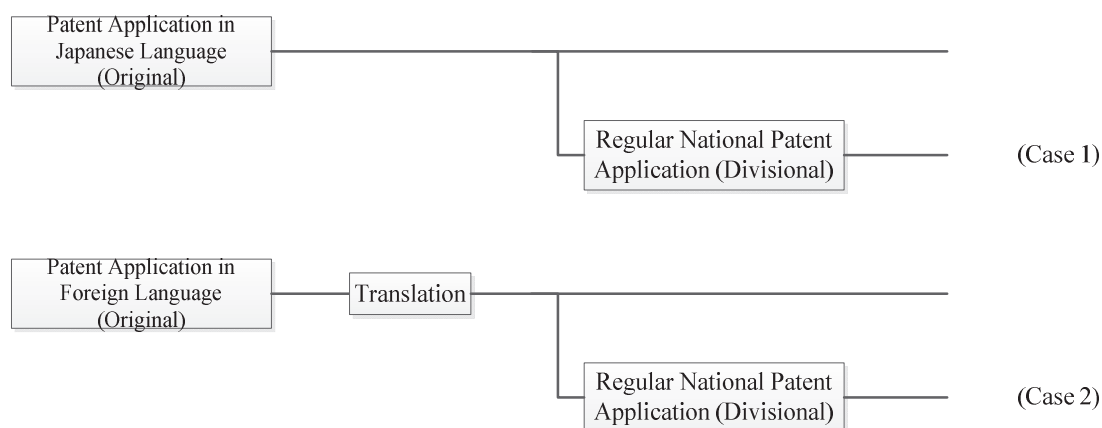
Conversion of an international application under the Patent Cooperation Treaty which is in a national phase and related to an application for utility model registration (hereinafter, in this Part, referred to as an "international utility model registration application") to a patent application, and conversion of an international application under Geneva Act of the Hague Agreement concerning the International Registration of Industrial Designs in which Japan is a designated Contracting Party and which is internationally published (hereinafter, in this Part, referred to as an "international design registration application") to a patent application are recognized.

A patent application based on utility model registration with regard to an international utility model registration application (hereinafter, in this Part, referred to as "international utility model registration") is also recognized.

## 6.1 Treatment of a divisional application in the case where the original application is an international patent application

### 6.1.1 Cases of divisional application

Possible cases of a divisional application in which the original application is an international patent application are as follows.



\*"Regular National Patent Application" means a patent application provided by Article 36 or 36bis.

### 6.1.2 When a divisional application is allowed

In Cases of a patent application in Japanese language (Case 1) and a patent application in foreign language (Case 2), the period during which a divisional application can be filed is provided in Article 44(1) (see "Part VI Chapter 1 Section 1

Requirements for Division of Patent Application"). For the period during which an amendment can be made, see 4.2.

### 6.1.3 Points to note in examination

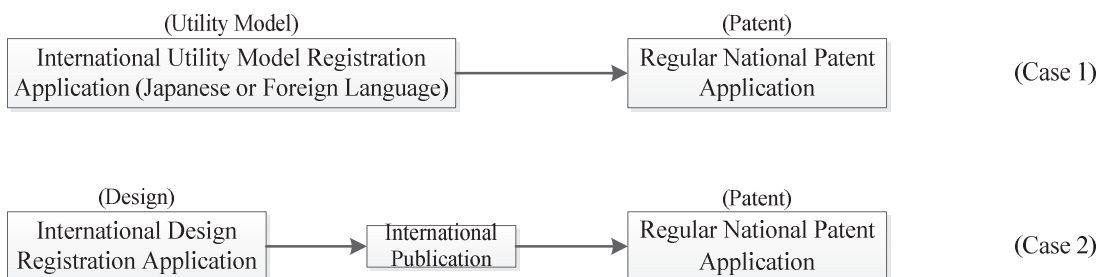
The examiner shall determine the substantive requirements of division of a patent application on the basis of the description, etc. as of the international application date of the original application and as they stand immediately prior to the division (for means for determining the substantive requirements of division of a patent application, see "Part VI Chapter 1 Section 1 Requirements for Division of Patent Application").

However, for the description, etc. as of the international application date if the original application is a patent application in foreign language, since it is highly possible that the content of said description, etc. coincides with that of the translation thereof, it is usually sufficient to determine based on the translation of the original application.

## 6.2 Treatment of a converted application in the case where the original application is an international utility model registration application, etc.

### 6.2.1 Cases of converted application

Possible cases of a converted application of an international utility model registration application or an international design registration application, to a patent application are as follows.



\*"Regular National Patent Application" means a patent application provided by Article 36 or 36bis.

## 6.2.2 When a converted application is allowed

The period during which a converted application can be filed is as follows.

(1) The period during which a converted application can be filed, for an international utility model registration application in Japanese language (Case 1)

It is basically the same as a regular national patent application, however a converted application may be filed only after executing the following (i-1) and (i-2), or (ii) (Patent Act Article 184<sup>sedecies</sup>).

(i-1) submission of documents under Utility Model Act Article 48<sup>quinquies</sup>(1)

(i-2) payment of prescribed fee

(ii) for an international application that is deemed to be a utility model application by decision under Utility Model Act Article 48<sup>sedecies</sup>(4), said decision

(2) The period during which a converted application can be filed, for an international utility model registration application in foreign language (Case 1)

It is basically the same as a regular national patent application, however a converted application may be filed only after executing all of the following (i-1) to (i-3), or (ii) (Patent Act Article 184<sup>sedecies</sup>).

(i-1) submission of translations

(i-2) submission of documents under Utility Model Act Article 48<sup>quinquies</sup>(1)

(i-3) payment of prescribed fee

(ii) for an international application that is deemed to be a utility model application by decision under Utility Model Act Article 48<sup>sedecies</sup>(4), said decision

(3) The period during which a converted application can be filed, for an international design registration application (Case 2)

It is basically the same as a regular national patent application, however a converted application may be filed only after the date of international publication (Design Act Article 60<sup>sexies</sup>).

### 6.2.3 Points to note in examination

#### (1) If an original application is an international utility model registration application (Case 1)

The examiner shall determine the substantive requirements of conversion of application on the basis of the description, etc. as of the international application date of the original application and as they stand immediately prior to the conversion (for means for determining the substantive requirements of conversion of an application, see "Part VI Chapter 2 Conversion of Application").

However, for the description, etc. as of the international application date if the original application is an international utility model registration application, since it is highly possible that the content of said description, etc. coincides with that of the translation thereof, it is usually sufficient to determine based on the translation of the original application if the translation has been submitted.

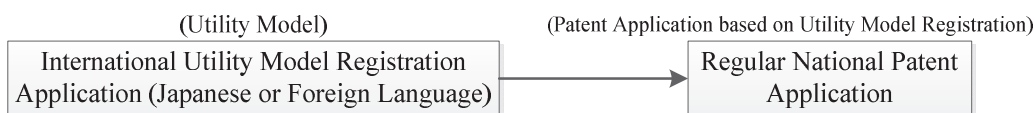
#### (2) If an original application is an international design registration application (Case 2)

The examiner shall determine the substantive requirements of conversion of application on the basis of the statement of the application or drawings, etc. attached to the application as of the dated of international registration of the original application and as they stand immediately prior to the conversion.

## 6.3 Treatment of a patent application based on international utility model registration

### 6.3.1 Cases of patent application based on international utility model registration

A possible case of a patent application based on international utility model registration is the following case.



\*"Regular National Patent Application" means a patent application provided by Article 36 or 36bis.

### 6.3.2 When a patent application based on international utility model registration is allowed

The period during which a patent application based on international utility model registration can be filed is the same as the period during which a patent application based on regular utility model registration (see "Part VI Chapter 3 Patent Application Based on Utility Model Registration").

### 6.3.3 Points to note in examination

The examiner shall determine the substantive requirements of a patent application based on international utility model registration, on the basis of the following (i) and (ii) (for means for determining the substantive requirements of a patent application based on utility model registration, see "Part VI Chapter 3 Patent Application Based on Utility Model Registration").

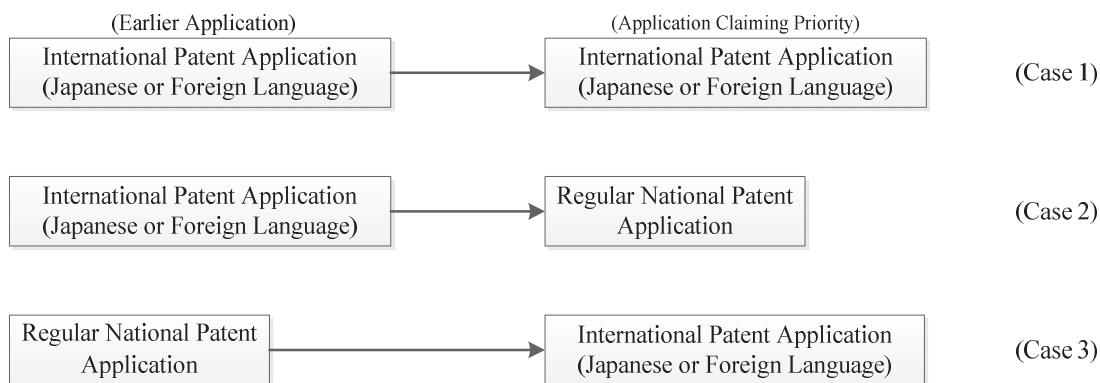
- (i) The description, etc. as of the international application date of international utility model registration application whose registration is a basis of the patent application
- (ii) The description, etc. as of the registration date of international utility model registration application whose registration is a basis of the patent application

However, for the description, etc. as of the international application date if the international utility model application is an international utility model registration application in foreign language, since it is highly possible that the content of said description, etc. coincides with that of the translation thereof, it is usually sufficient to determine based on the translation of the international utility model application.

## 6.4 Treatment of application claiming priority

### 6.4.1 Cases of application claiming priority

Possible cases of an application claiming priority to which an international patent application is related are as follows.



\*"Regular National Patent Application" means a patent application provided by Article 36 or 36bis.

#### 6.4.2 When an application claiming priority is allowed

In cases where an application claiming priority based on an international patent application is filed (Case 1 or Case 2) and in cases where an international patent application is filed as an application claiming priority (Cases 1 or Case 3), the period during which an application claiming priority can be filed is the same as the period during which an application claiming priority for a regular national patent application can be filed (see "Part V Priority").

#### 6.4.3 Points to note in examination

(1) If an earlier application as a basis of claiming priority is an international patent application (Case 1 or Case 2)

If the claimed invention of an application claiming priority is within the scope of the matters stated in the description, etc. as of the international application date of the international patent application being an earlier application, the effect of claiming priority is recognized.

However, if the earlier application is a patent application in foreign language, since it is highly possible that the content of the description, etc. as of the international application date coincides with that of the translation thereof, it is usually sufficient to determine based on the translation of the earlier application if the translation has been submitted.

(2) If an application claiming priority is an international patent application (Case 1 or Case 3)

In a case of a patent application in Japanese language, whether the effect of claiming priority is recognized shall be determined by comparing the matters stated in the description, etc. of the earlier application and the patent application in Japanese language claiming priority.

In a case of a patent application in foreign language, it is determined by comparing the matters stated in the description, etc. of the earlier application and a translation deemed to be the description, etc. of the patent application in foreign language claiming priority, or the matters stated in an amended description, etc. if the amendment has been made.

In the translation deemed to be the description, etc. or the amended description, etc. if the amendment has been made, for the matters stated in the earlier application, the effect of claiming priority is recognized.

In any cases (1) and (2), determination on the effect of claiming priority, in the same way as a case of a regular patent application claiming priority, is usually sufficient to be executed only if prior art and the like which can be a basis of the reason for refusal is found between the filing date of the earlier application and the filing date of application claiming priority.