

<Relevant Provisions>

Patent Act

(Amendment of proceedings)

Article 17

(Omitted)

(2) Notwithstanding the main clause of the preceding paragraph, an applicant of a foreign language written application as provided in Article 36bis(2) may not amend foreign language documents as provided in Article 36bis(1).

(3) to (4) (Omitted)

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

Article 17bis

(1) An applicant for a patent may amend the description, scope of claims, or drawings attached to the application, before the service of the certified copy of the examiner's decision notifying that a patent is to be granted; provided, however, that following the receipt of a notice provided under Article 50, an amendment may only be made in the following cases:

- (i) where the applicant has received the first notice (hereinafter referred to in this Article as the "notice of reasons for refusal") under Article 50 (including the cases where it is applied mutatis mutandis pursuant to Article 159(2) (including the cases where it is applied mutatis mutandis pursuant to Article 174(1)) and Article 163(2), hereinafter the same shall apply in this paragraph) and said amendment is made within the designated time limit under Article 50;
- (ii) where, following the receipt of the notice of reasons for refusal, the applicant has received a notice under Article 48septies and said amendment is made within the designated time limit under said Article;
- (iii) where, following the receipt of the notice of reasons for refusal, the applicant has received a further notice of reasons for refusal and said amendment is made within the designated time limit under Article 50 with regard to the final notice of reasons for refusal; and
- (iv) where the applicant files a request for a trial against an examiner's decision of refusal and said amendment is made at the same time as said request for said trial.

(2) Where an applicant of a foreign language written application as provided in Article 36bis(2) amends the description, scope of claims or drawings under the preceding paragraph for the purpose of correcting an incorrect translation, the

applicant shall submit the statement of correction of the incorrect translation, stating the grounds thereof.

(3) to (6) (Omitted)

(Patent application based on international application)

Article 184ter

(1) An international application (a patent application only) to which the international application date is accorded under Article 11(1), 11(2)(b) or 14(2) of the Patent Cooperation Treaty signed in Washington on June 19, 1970 (hereinafter referred to as the "Treaty" in this Chapter) and which specifies Japan as a designated State under Article 4(1)(ii) of the Treaty shall be deemed to be a patent application filed on said international application date.

(2) Article 43 (including its mutatis mutandis application under Article 43bis(3)) shall not apply to the international application deemed to be a patent application under the preceding paragraph (hereinafter referred to as "international patent application").

(Translations of international patent application in foreign language)

Article 184quater

(1) An applicant of an international patent application in foreign language (hereinafter referred to as a "patent application in foreign language") shall submit to the Commissioner of the Patent Office Japanese translations of the description, scope of claims, drawings (limited to the descriptive text in such drawings, hereinafter the same shall apply in this article), and the abstract, as provided in Article 3(2) of the Treaty, as of the international application date as provided in paragraph (1) of the preceding Article (hereinafter referred to as the "international application date") within the period from the priority date under Article 2 (xi) of the Treaty (hereinafter referred to as the "priority date"), to two years and six months (hereinafter referred to as the "Time Limit for the Submission of National Documents") therefrom; provided, however, that the applicant of a patent application in foreign language who has submitted the document under paragraph (1) of the following Article during the period from two months before the expiration of the Time Limit for the Submission of National Documents to the expiry date thereof (excluding the case where said translations have been submitted prior to the submission of said documents) may submit said translations within two months from the date of submission of said document (hereinafter referred to as the "special time limit for the submission of translations").

(2) In the case of the preceding paragraph, where the applicant of the patent application in foreign language has made an amendment under Article 19(1) of the Treaty, the applicant may, in lieu of the translation of the scope of claim(s) as provided in the preceding paragraph, submit a translation of the amended scope of claim(s).

(3) Where the translation of the description as provided in paragraph (1) and the translation of the scope of claim(s) as provided in the preceding two paragraphs (hereinafter referred to as the "translations of the description, etc.") have not been submitted within the Time Limit for the Submission of National Documents (in the case of a patent application in foreign language under the proviso to paragraph (1), the Special Time Limit for the Submission of Translations, hereinafter the same shall apply in this article), the international patent application shall be deemed to have been withdrawn.

(4) The applicant filing an international patent application that is deemed to be withdrawn pursuant to the preceding paragraph may submit the translation of the description, etc. and translations of the drawings and abstracts provided to in paragraph (1) to the Commissioner of the Japan Patent Office pursuant to Ordinance of the Ministry of Economy, Trade and Industry only within the time limit provided by Ordinance of the Ministry of Economy, Trade and Industry; provided, however, that this does not apply if the applicant is found to have intentionally failed to submit the translation of the description, etc. within the time limit for submitting national documents.

(5) The translations submitted under the preceding paragraph shall be deemed to have been submitted to the Commissioner of the Patent Office at the time of expiration of the Time Limit for the Submission of National Documents.

(6) Where an amendment under Article 19(1) of the Treaty has been made, an applicant who has submitted the translation of the scope of claim(s) as provided in paragraph (1) may further submit a Japanese translation of said amended scope of claim(s) no later than the date on which the Time Limit for the Submission of National Documents expires (the time of requesting where the applicant requests the examination of the application within the Time Limit for the Submission of National Documents, hereinafter referred to as the "National Processing Standard Time").

(7) The main clause of Article 184septies(3) shall apply mutatis mutandis to the case where the translation under paragraph (2) or the preceding paragraph has not been submitted.

(Submission of documents and order to amend procedures)

Article 184quinquies

(1) An applicant of an international patent application shall submit a document to the Commissioner of the Patent Office within the Time Limit for the Submission of National Documents stating the following:

- (i) the name, and the domicile or residence of the applicant;
- (ii) the name, and the domicile or residence of the inventor; and
- (iii) matters as provided by Ordinance of the Ministry of Economy, Trade and Industry, including the international application number.

(2) The Commissioner of the Patent Office may order the amendment of procedures for an applicant, designating an adequate time limit, in the following cases:

- (i) where the document to be submitted under the preceding paragraph is not submitted within the Time Limit for the Submission of National Documents;
- (ii) where the procedure as provided in the preceding paragraph does not comply with paragraphs (1) to (3) of Article 7 or Article 9;
- (iii) where the procedure as provided in the preceding paragraph does not comply with the formal requirements as provided by Ordinance of the Ministry of Economy, Trade and Industry;
- (iv) where a translation of the abstract to be submitted under paragraph (1) of the preceding Article is not submitted within the Time Limit for the Submission of National Documents (in the case of a patent application in foreign language under the proviso to paragraph (1) of the preceding Article, the Special Time Limit for the Submission of Translations); and
- (v) where the fees payable under Article 195(2) are not paid within the Time Limit for the Submission of National Documents.

(3) Where the person ordered to amend a procedure under the preceding paragraph does not make the amendment within the designated time limit under said paragraph, the Commissioner of the Patent Office may dismiss said international patent application.

(Effect, etc. of application, description, etc. of international application)

Article 184sexies

(1) The application of an international patent application as of the international application date shall be deemed to be an application submitted under Article 36(1).

(2) The description of an international patent application in the Japanese language (hereinafter referred to as a "patent application in Japanese language") as of the international application date and translations of the description of a patent application in foreign language as of the international application date shall be deemed to be the description submitted with the application under Article 36(2); scope of claim(s) of a patent application in Japanese language as of the international application date and a translation of the scope of claim(s) of a patent application in foreign language as of the international application date shall be deemed to be the scope of claim(s) submitted with the application under said paragraph; drawing(s) of a patent application in Japanese language as of the international application date, drawing(s) of a patent application in foreign language as of the international application date (excluding the descriptive text in the drawing(s)) and a translation of the descriptive text in the drawing(s) shall be deemed to be the drawing(s) submitted with the application under said paragraph; and, the abstract of a patent application in Japanese language and a translation of the abstract of a patent application in foreign language shall be deemed to be the abstract submitted with the application under said paragraph.

(3) Where a translation of the amended scope of claim(s) under Article 19(1) of the Treaty is submitted as provided in Article 184quater(2) or (6), notwithstanding the preceding paragraph, a translation of said amended scope of claim(s) shall be deemed to be the scope of claim(s) submitted with the application under Article 36(2).

(Amendment under Article 19 of the Treaty with regard to patent application in Japanese language)

Article 184septies

(1) Where an applicant of a patent application in Japanese language has made an amendment under Article 19(1) of the Treaty, such applicant shall submit to the Commissioner of the Patent Office a copy of the written amendment submitted under Article 19(1) on or before the date which the National Processing Standard Time falls into.

(2) Where a copy of a written amendment has been submitted under the preceding paragraph, an amendment to the scope of claim(s) attached to the application shall be deemed to have been made under Article 17bis(1) by said copy of the written amendment; provided, however, that where the written amendment has been served to the Patent Office under Article 20 of the Treaty within the time limit under the

preceding paragraph, the amendment is deemed to have been made by said written amendment.

(3) Where the procedure under paragraph (1) has not been taken by the applicant of a patent application in Japanese language within the time limit under paragraph (1), no amendment under Article 19(1) of the Treaty shall be deemed to have been made; provided, however, that this shall not apply to the case as provided in the proviso to the preceding paragraph.

(Amendment under Article 34 of the Treaty)

Article 184octies

(1) Where an applicant of an international patent application has made an amendment under Article 34(2)(b) of the Treaty, such applicant shall submit to the Commissioner of the Patent Office, in the case of amendment with regard to a patent application in Japanese language, a copy of the written amendment submitted under Article 34(2)(b) and, in the case of amendment with regard to a patent application in foreign language, a Japanese translation of said written amendment, on or before the date which the National Processing Standard Time falls into.

(2) Where a copy of the written amendment or a translation of the written amendment has been submitted under the preceding paragraph, an amendment to the description, scope of claim(s) or drawing(s) attached to the application shall be deemed to have been made under Article 17bis(1) by the copy of the written amendment or the translation of the written amendment; provided, however, that where the written amendment with regard to a patent application in Japanese language has been served to the Patent Office under Article 36(3)(a) of the Treaty within the time limit under the preceding paragraph, the amendment is deemed to have been made by said written amendment.

(3) Where the procedure under paragraph (1) has not been taken by the applicant of an international patent application within the time limit under paragraph (1), no amendment under Article 34(2)(b) of the Treaty shall be deemed to have been made; provided, however, that this shall not apply to the case as provided in the proviso to the preceding paragraph.

(4) Where, in accordance with paragraph (2), an amendment to the description, scope of claims or drawings attached to the application with regard to a patent application in foreign language has been deemed to have been made under Article 17bis(1), such amendment shall be deemed to have been made by submitting the written correction

of incorrect translation as provided in Article 17bis(2).

(Special provisions concerning amendment)

Article 184duodecies

(1) Notwithstanding the main clause of Article 17(1), no amendment of the procedures shall be allowed (excluding those under Articles 184septies(2) and 184octies(2)) unless, in the case of a patent application in Japanese language, the procedure under Article 184quinquies(1) has been taken and the fee payable under Article 195(2) has been paid, and, in the case of a patent application in foreign language, the procedures under Articles 184quater(1) or (4) and 184quinquies(1) have been taken, the fee payable under Article 195(2) has been paid, and the National Processing Standard Time has lapsed.

(2) For the purpose of the allowable scope of amendment to the description, scope of claims or drawings with regard to a patent application in foreign language, the term "a foreign language written application as provided in Article 36bis(2)" in Article 17bis(2) shall be deemed to be replaced with "a patent application in foreign language as provided in Article 184quater(1)"; the term "the description, scope of claims or drawings originally attached to the application (in the case of a foreign language written application under Article 36bis(2), the translation of foreign language documents as provided in Article 36bis(2) that is deemed to be the description, scope of claims and drawings under Article 36bis(8) (in the case where the amendment to the description, scope of claims or drawing has been made through the submission of the statement of correction of incorrect translation, said translations or the amended description, scope of claim or drawings), the same shall apply to Articles 34bis(1) and 34ter(1)" in Article 17bis(3) shall be deemed to be replaced with "a translation as provided in Article 184quater(1) of the description or drawings (limited to the descriptive text in the drawings) of an international patent application as provided in Article 184ter(2) (hereinafter referred to as an "international patent application" in this paragraph) as of the international application date as provided in Article 184quater(1) (hereinafter referred to as the "international application date" in this paragraph), a translation as provided in Article 184quater(1) of the scope of claims of an international patent application as of the International Application Date (in the case where a translation of the scope of claim(s) amended under Article 19(1) of the Patent Cooperation Treaty signed in Washington on June 19, 1970 has been submitted under Article 184quater(2) or (6), said translation) or drawings (excluding the descriptive

text in the drawings) of an international patent application as of the International Application Date (hereinafter referred to as the "translations, etc." in this paragraph) (in the case where an amendment to the description, scope of claim(s) or drawing(s) has been made through the submission of the statement of correction of incorrect translation, the Translations, etc. or said amended description, scope of claims or drawings)".

(3) Notwithstanding Article 17ter, an applicant of an international patent application may amend the abstract attached to the application only within one year and three months from the priority date (in the case of a patent application in foreign language, a translation of which has been submitted under Article 184quater(1), where such application falls under an international patent application of which the applicant has requested an examination within the Time Limit for the Submission of National Documents and the international publication has been effected, excluding the time after the request for an examination of the application has been filed).

(Special provisions concerning priority claim based on a patent application, etc.)

Article 184quindecies

(1) The proviso to Article 41(1), Articles 41(4), and 42(2) shall not apply to an international patent application.

(2) For the purpose of application of Article 41(3) to a patent application in Japanese language, the term "or the laying open of the patent application" in said Article shall be deemed to be replaced with "or the international publication under Article 21 of the Patent Cooperation Treaty signed in Washington on June 19, 1970".

(3) For the purpose of the application of Article 41(3) for a patent application in foreign language, the term "the description, scope of claims or drawings originally attached to the application in a patent application" in said Article shall be deemed to be replaced with "the description, scope of claims or drawings of an international application as of the international application date under Article 184quater(1)," and the term "or the laying open of the application" shall be deemed to be replaced with "or the international publication under Article 21 of the Patent Cooperation Treaty signed in Washington on June 19, 1970".

(4) For the purpose of application of paragraphs (1) to (3) of Article 41 and 42(1), in the case where the earlier application under Article 41(1) of this Act is an international patent application or an international utility model registration application under Article 48ter(2) of the Utility Model Act, the term "the description,

scope of claims for a patent or utility model registration and drawings originally attached to the application" in Articles 41(1) and 41(2) shall be deemed to be replaced with "the description, scope of claims or drawings of an international application as of the international application date under Article 184quater(1) of this Act or Article 48quater(1) of the Utility Model Act,"; the term "the description, scope of claims for patent or utility model registration and drawings originally attached to the application in the earlier application " in Article 41(3) shall be deemed to be replaced with "the description, scope of claims or drawings of an international application of the earlier application as of the International Application Date under Article 184quater(1) of this Act or Article 48quater(1) of the Utility Model Act,"; the term "the laying open of the patent application relating to" in Article 41(3) shall be deemed to be replaced with "the international publication under Article 21 of the patent Cooperation Treaty signed in Washington on June 19, 1970 relating to,"; and the term "when one year and three months from the filing date has lapsed" in Article 42(1) shall be deemed to be replaced with "at the later of the time of the National Processing Standard Time under Article 184quater(6) of this Act or Article 48quater(6) of the Utility Model Act or the time when one year and three months has lapsed from the International Application Date under Article 184quater(1) of this Act or Article 48quater(1) of the Utility Model Act".

(Special provision concerning conversion of application)

Article 184sedecies

An international application that has been deemed to be an application for utility model registration under Article 48ter(1) or 48sedecies(4) of the Utility Model Act may be converted to a patent application, only after the fees payable under Article 54(2) of said Act have been paid (or, in the case of an international application that is deemed to be a Utility Model registration application under Article 48sedecies(4) of said Act, after the ruling as provided in Article 48sedecies (4) has been rendered), and, in the case of a Utility Model Registration Application in Japanese Language under Article 48quinquies(4) of said Act, the procedures under Article 48quinquies(1) of said Act has been completed, or, in the case of a Utility Model Registration Application in Foreign Language under Article 48quater(1) of said Act, the procedures under Article 48quater(1) or 48quater(4) and 48quinquies(1) of said Act have been completed.

(Provisions for reasons for refusal, etc.)

Article 184duodevices

For the purpose of an examiner's decision of refusal and a trial for patent invalidation, with respect to a patent application in foreign language, the term "foreign language written application" in Articles 49(vi), and 123(1)(i) and (v) shall be deemed to be replaced with "patent application in foreign language referred to in Article 184quater(1)," and the term "foreign language documents" in Articles 49(vi) and 123(1)(v) shall be deemed to be replaced with "the description, scope of claim(s) or drawing(s) of the international application as of the international application date referred to in Article 184quater(1)".

(International application deemed to be patent application by decision)

Article 184vicies

(Omitted)

(2) and (3) (Omitted)

(4) Where the Commissioner of the Patent Office has rendered a ruling under the preceding paragraph to the effect that the refusal, declaration or finding under said paragraph was not justified under the provisions of the Treaty and the Regulations under the Patent Cooperation Treaty, the international application for which the decision is rendered shall be deemed to be a patent application filed on the day which would have been be accorded as the international application date if no such refusal, declaration or finding had been made for the international application.

(5) and (6) (Omitted)

Regulations under the Patent Act

(Matters to be stated in the documents)

Article 38ter

The matters specified by Ordinance of the Ministry of Economy, Trade and Industry set forth in Article 184quinquies(1)(iii) of the Patent Act are as follows.

(i) international application number

(ii) the name and the domicile or residence of the representative, if any

Patent Cooperation Treaty

Article 2 Definitions

For the purposes of this Treaty and the Regulations and unless expressly stated otherwise:

(i) to (viii) (Omitted)

(ix) references to a "patent" shall be construed as references to national patents and regional patents;

(x) to (xx) (Omitted)

Article 19 Amendment of the claims before the International Bureau

(1) The applicant shall, after having received the international search report, be entitled to one opportunity to amend the claims of the international application by filing amendments with the International Bureau within the prescribed time limit. He may, at the same time, file a brief statement, as provided in the Regulations, explaining the amendments and indicating any impact that such amendments might have on the description and the drawings.

(2) and (3) (Omitted)

Article 20 Communication to designated Offices

(1) (Omitted)

(2) If the claims have been amended by virtue of Article 19(1), the communication shall either contain the full text of the claims both as filed and as amended or shall contain the full text of the claims as filed and specify the amendments, and shall include the statement, if any, referred to in Article 19(1).

(3) (Omitted)

Article 34 Procedure before the international preliminary examining authority

(1) (Omitted)

(2)(a) (Omitted)

(b) The applicant shall have a right to amend the claims, the description, and the drawings, in the prescribed manner and within the prescribed time limit, before the international preliminary examination report is established. The amendment shall not go beyond the disclosure in the international application as filed.

(c) and (d) (Omitted)

(3) and (4) (Omitted)

Article 36 Transmittal, translation, and communication, of the international preliminary examination report

(1) and (2) (Omitted)

(3)(a) The international preliminary examination report, together with its translation (as prescribed) and its annexes (in the original language), shall be communicated by the International Bureau to each elected Office.

(b) (Omitted)

(4) (Omitted)