

**Chapter 1 Extension of a Patent Term as Compensation for
the Curtailment of the Term
(Patent Act Article 67(2))**

1. Overview

The objective of the patent system is to protect and encourage invention by allowing an inventor to have exclusive rights to his/her invention for a certain period of time as compensation for disclosing the technology related to the invention and thereby contribute to industrial development.

A patent right is registered after examination, which is expected to take a certain period of time. In most cases, examination will be completed within such period of time. However, in some cases, longer time than such expected period of time is required to complete the process of filing an application, making an examiner's decision to grant a patent, and registering the patent right.

The term of a patent right expires after a period of 20 years from the filing date of the patent application (Article 67(1)).

On the other hand, it will become possible to seek an injunction based on a patent right and to exercise the right to demand payment of damages, etc. only after the applicant obtains a patent right upon registration of the right. Thus, if the registration of a patent right takes longer than such expected period of time, the period during which the patentee is entitled to exercise his/her rights would be shorter.

It will be beneficial for the patentee to have the term of his/her patent right extended in order to offset the time during which the patentee is unable to exercise his/her rights. On the other hand, from the viewpoint of third parties against which a patent right may be exercised, an extension of a patent term could threaten the stability, etc. of their business.

In order to solve this problem, the Patent Act gives a patentee sufficient time to exercise his/her rights and, in consideration of various factors such as the maintenance of fairness to all applicants and the possible consequences to third parties after an extension of the patent term, permits an extension of the patent term for an applicant who files an application to register a patent term extension if the patent right has been registered after either of the following dates, whichever is later: the date five years after the filing of the patent application or the date three years after the filing of a request for examination of the application (the "reference date") (Article 67(2)). The Patent Act specifies that, if such extension is permitted, the length of the extended period should not exceed the length of the period calculated by extracting the total length of the

periods specified in the items of Article 67(3) from the length of the period starting from the reference date and ending on the registration date of the patent right (the maximum permissible length of extension period) (Article 67(3)).

2. Application to register a patent term extension as compensation for the curtailment of the term (Article 67(2))

2.1 Applicant

Only a patentee may file an application to register a patent term extension as compensation for the curtailment of the term (in this Part, it is sometimes referred to as an "application to register a patent term extension as compensation for the curtailment of the term") (Article 67ter (1)(iii)).

If a patent right is jointly owned, none of the joint owners may file an application to register a patent term extension as compensation for the curtailment of the term unless doing so jointly with all the other joint owners (Article 67bis (4)).

2.2 Period during which an application may be filed

An application to register a patent term extension as compensation for the curtailment of the term must be filed within the period of three months starting from the registration date of the patent right. However, if a person who is responsible for filing an application to register a patent term extension as compensation for the curtailment of the term fails to file an application within such period for any reason not attributable to him/her, he/she must file such application within the period of 14 days (or two months in the case of a person living outside Japan) from the date on which said reason ceased to exist (within the period of nine months if such period exceeds nine months) (Article 67bis (3)). After the expiration of the term of a patent right, an application to register a patent term extension as compensation for the curtailment of the term may not be filed.

2.3 Patent right for which an application may be filed

An application to register a patent term extension as compensation for the curtailment of the term may be filed for a patent right that was registered after the reference date (Article 67(2)).

(1) Reference date

The reference date is the date five years after the filing of the patent application or the date three years after the filing of a request for examination of the application, whichever is later (Article 67(2)).

(2) Filing date of a patent application used to calculate the reference date

Usually, the filing date of a patent application means the actual filing date of a patent application. In the case of certain types of patent application, namely, a divisional application, a converted application, or a patent application based on a utility model registration, or an application claiming to refer to an earlier patent application, a patent right will be registered if the formality requirements are satisfied. For this reason, the filing date of such application will be found based on whether the substantive requirements are satisfied or not as follows.

In the case of a divisional application, if the substantive requirements included in the requirements for division of a patent application are satisfied, the filing date of the original application will be found as the filing date of the patent application. On the other hand, if the substantive requirements are not satisfied, the actual filing date will be found as the filing date of the patent application.

In the case of a converted application, if the substantive requirements included in the requirements for conversion of a patent application are satisfied, the filing date of the original application will be found as the filing date of the patent application. On the other hand, if the substantive requirements are not satisfied, the actual filing date will be found as the filing date of the patent application.

In the case of a patent application based on a utility model registration, if the substantive requirements included in the requirements for the filing of a patent application based on a utility model registration are satisfied, the filing date of a utility model application related to the utility model registration will be found as the filing date of the patent application. On the other hand, if the substantive requirements are not satisfied, the actual filing date will be found as the filing date of the patent application.

In the case of an application claiming to refer to an earlier patent application, if the substantive requirements included in the requirements for the filing of an application claiming to refer to an earlier patent application are satisfied, the filing date of an application claiming to refer to an earlier patent application will be found as the filing date of the patent application. On the other hand, if the substantive requirements are not satisfied, the date of submission of the description or drawings will be found as the filing date of the patent application.

2.4 Information that must be presented in an application

Any person who files an application to register a patent term extension as compensation for the curtailment of the term must submit to the JPO Commissioner an application containing the following information (Article 67bis (1) and Article 38quaterdecies-ter (1) of the Regulation for Enforcement of the Patent Act):

- (i) Name and domicile or residence of the applicant;
- (ii) Patent number
- (iii) Length of the requested extension period;
- (iv) Application number and the filing date of the patent application;
- (v) Date on which a request for examination of the application was filed.

2.5 Information that must be presented in a document describing the grounds for calculation of the length of the requested extension period

The application must be accompanied by a document describing the grounds for calculation of the length of the requested extension period (Article 67bis (2)). If an applicant includes all the necessary information in an application, the applicant may omit the attachment of a document describing the grounds for calculation of the length of the requested extension period (Article 38quaterdecies-quarter (2) of the Regulation for Enforcement of the Patent Act). When an applicant attaches a document describing the grounds for calculation of the length of the requested extension period to the application, the applicant must state the following matters in the document (Article 38quaterdecies-quarter of the Regulation for Enforcement of the Patent Act):

- (i) Filing date of the patent application;
- (ii) Date on which a request for examination of the application was filed;
- (iii) Reference date;
- (iv) Registration date of the patent right;
- (v) Period from the reference date to the registration date of the patent right;
- (vi) Details concerning the periods that can be regarded as the periods specified in the items of Article 67(3) (Note) and the starting date and the ending date of each of those periods;
- (vii) Total length of the periods specified in the items of Article 67(3) (if those periods overlap with each other, the total length of the overlap periods should be deducted); and
- (viii) Maximum permissible length of extension period.

(Note) The "details concerning the periods that can be regarded as the periods specified in the items of Article 67(3)" means information showing which of the items of Article 67(3) each of those periods falls under and on what dates the period starts and ends.

2.6 Effects of the application

When an application to register a patent term extension as compensation for the curtailment of the term is filed, the term will be deemed to be extended until the time when an examiner's decision to reject such an application becomes final and binding or when a patent term extension is registered (Article 67bis (5)).

2.7 Publication of information in a patent gazette

When an application to register a patent term extension as compensation for the curtailment of the term is filed, the information specified in the items of Article 67bis (1) must be published in a patent gazette (Article 67bis (6)).

When a patent term extension is registered under Article 67ter (3), the information specified in the items of paragraph (4) of said Article must be published in a patent gazette (Article 67ter (4)).

3. Examination of an application to register a patent term extension as compensation for the curtailment of the term

3.1 Examiner's determination as to whether an application to register a patent term extension as compensation for the curtailment of the term satisfies the requirements or not

When an examiner examines an application to register a patent term extension as compensation for the curtailment of the term, the examiner must determine whether the application to register a patent term extension as compensation for the curtailment of the term falls under any of the items of Article 67ter (1), which are listed in the following items (1) to (4). If an application to register a patent term extension as compensation for the curtailment of the term falls under any of the following items (1) to (4), the grounds for rejection can be considered to exist:

- (1) The registration date of the patent right is not on or after the reference date (Article 67ter (1)(i));

- (2) The length of the requested extension period is longer than the maximum permissible length of extension period (Article 67ter (1)(ii));
- (3) The person filing the application is not the patentee (Article 67ter (1)(iii)); or
- (4) The application does not satisfy the requirement specified in Article 67bis (4) (Article 67ter (1)(iv)).

3.1.1 In the case where the registration date of the patent right is not on or after the reference date (Article 67ter (1)(i))

If the registration date of the patent right is earlier than the reference date, the grounds for rejection specified in Article 67ter (1)(i) can be considered to exist.

3.1.2 In the case where the length of the requested extension period is longer than the maximum permissible length of extension period (Article 67ter (1)(ii))

(1) Maximum permissible length of extension period

The maximum permissible length of extension period means the length of period calculated by deducting the total length of the periods specified in the items of Article 67(3) from the length of period starting from the reference date and ending on the registration date of the patent right (Article 67(3)).

(2) Periods specified in the items of Article 67(3)

The periods specified in the items of Article 67(3) can be considered to be the periods specified in the following items (i) to (x) with regard to the patent application.

(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.

Article 67(3)(i) specifies that, 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 of Procedures, etc. concerning 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 can be found to start from the date on which such notice or order is made and to end on the date on which such procedure is completed (including the case where the period during which such procedure should be carried out is extended).

As described above, the aforementioned notice or order does not include a notice of the grounds for rejection made under Article 50 and an instruction made under the name of the JPO Commissioner based on the results of consultations under Article 39(6). Thus, even if it takes time to take a necessary procedure upon receipt of such notice or instruction, such time may not be deducted.

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

Article 67(3)(ii) specifies that, in the case where 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 can be found to start from the date on which the period during which the procedure should be carried out expires and to end on the date on which the procedure is completed.

As mentioned in (i) above, even if it takes time to take a necessary procedure upon receipt of a notice of the grounds for rejection made under Article 50 and an instruction made under the name of the JPO Commissioner based on the results of consultations under Article 39(6), such time may not be deducted. However, the length of the period consumed as a result of an extension of the period during which such procedure should be carried out may be deducted.

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

Article 67(3)(iii) specifies that, even 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 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 can be found to start from the date on which the period during which the procedure should be carried out expires and to end on the date on which the procedure is completed.

(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

Article 67(3)(iv) specifies that, in the case of the suspension of an administrative disposition or notification specified in the Patent Act, the Act on Special Provisions of Procedures, etc. concerning 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 (Note), the deductible period can be found to start from the date of such request or act and to end on the date on which the reasons for suspending such disposition or notification ceases to exist.

(Note) The "request or any other act of the applicant" includes not only an explicit request from the applicant but also any act of the applicant that would cause suspension of the disposition or notification.

Example: An applicant made an amendment to the description containing an error prior to the receipt of a notice of the grounds for rejection. Despite the JPO Commissioner's order to amend the proceedings with regard to the aforementioned amendment (Article 17(3)(ii)), the applicant failed to carry out the procedure that should be followed upon receipt of such order and saw the aforementioned amendment dismissed (Article 18(1)). In the course of these proceedings, a notice of the grounds for rejection was suspended. In this case, the deductible period can be found to start from the date on which the aforementioned amendment was made and to end on the date on which the amendment was dismissed.

(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

Article 67(3)(v) specifies that, 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 can be found to start 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 to end on the date on which such decision is made.

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

Article 67(3)(vi) specifies that, if a written supplement for the description, etc. is withdrawn under Article 38quater (7), the deductible period can be found to start from the date on which a written supplement for the description, etc. is submitted under Article 38quater (3) and to end on the date on which the written supplement for the description, etc. is withdrawn under Article 38quater (7).

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

Article 67(3)(vii) specifies that, if an appeal against an examiner's decision of rejection is filed, the deductible period can be found to be the periods specified in (vii-1) to (vii-3) below for the classifications described in (vii-1) to (vii-3) respectively.

(vii-1) In an appeal against an examiner's decision of rejection (including a re-appeal against the final JPO decision concerning an appeal against an examiner's decision of rejection), 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 rejection is served and ending on the date on which a certified copy of the JPO decision is served (item (vii) a)

(vii-2) In the case where an examiner's decision is rescinded in an appeal against an examiner's decision of rejection (including a re-appeal against the final JPO decision concerning an appeal against an examiner's decision of rejection), 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 rejection is served and ending on the date on which a certified copy of the JPO decision is served (item (vii) b)

(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 (item (vii) c)

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

Article 67(3)(viii) specifies that, 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 can be found to start from the date of the request for review and to end on the date on which a certified copy of the administrative determination is served.

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

Article 67(3)(ix) specifies that, 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 can be found to start from the date of the filing of the action and to end on the date on which the judgment concerning the action is finalized.

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

Article 67(3)(x) specifies that, if a procedure specified in the Patent Act and regulations is suspended or discontinued, the deductible period can be found to be the same as the period of suspension or discontinuation.

Note that, as for the periods listed in each item of Article 67(3), an additional period (xi) is provided as follows by being replaced in Article 82(4) of the Economic Security Promotion Act.

- (xi) Period consumed as a result of a security designation

The period from the date of receipt of a notification under the provisions of Article 70(1) of the Economic Security Promotion Act through the date of receipt of a notification under Article 77(2) of the said Act.

- (3) Case where overlapping periods are included in the periods specified in the items of Article 67(3)

If overlapping periods are included in the periods specified in the items of Article 67(3), the total of such periods should be deducted from the total length of the periods specified in the items of Article 67(3).

Example 1: In the case where orders for amendment of proceedings are made one after another under Article 17(3) with regard to the amendment of the description and the amendments to the scope of claims respectively, if the applicant makes an amendment in response to each of the orders, which would result in overlapping periods (Article 67(3)(i)).

Example 2: In the case where any of the periods specified in the items of Article 67(3) is included in the prescribed period related to an appeal against an examiner's decision of rejection (Article 67(3)(vii))

- (4) Determination made based on a comparison between the length of the requested extension period and the maximum permissible length of extension period

An examiner must examine the information presented in a document describing the grounds for calculation of the length of the requested extension period and calculate the maximum permissible length of extension period (the period indicated by date,

month, year) with reference to a calendar, and make a comparison between the length of the requested extension period stated in the application (the period indicated by date, month, year) and the calculated maximum permissible length of extension period, and make a determination as to whether the requested extension period exceeds the maximum permissible length of extension period.

(5) Note

If an examiner examines the information presented in a document describing the grounds for calculation of the length of the requested extension period and determines that the extension period requested by the applicant exceeds the maximum permissible length of extension period, the examiner must reject the extension under Article 67ter (1)(ii).

The length of the requested extension period does not have to be the same as the maximum permissible length of extension period as long as the requested extension period does not exceed the maximum permissible length of extension period.

If the total of the periods specified in the items of Article 67(3) is longer than the period starting from the reference date and ending on the date on which the patent right is registered, no extension may be permitted. In such case, an extension would be rejected under Article 67ter (1) (ii).

3.1.3 In the case where the applicant is not the patentee (Article 67ter (1) (iii))

If any person other than the patentee files an application to register a patent term extension as compensation for the curtailment of the term, the grounds for rejection can be considered to exist under Article 67ter (1) (iii).

3.1.4 In the case where the patent application does not satisfy the requirement specified in Article 67bis (4) (Article 67ter (1) (iv))

In the case of a joint application, if only some of the applicants file an application to register a patent term extension as compensation for the curtailment of the term, the grounds for rejection can be considered to exist under Article 67ter (1) (iv).

3.2 How to examine an application to register a patent term extension as compensation for the curtailment of the term

3.2.1 Notice of the grounds for rejection

If an examiner finds an application to register a patent term extension as compensation for the curtailment of the term falls under any of the items of Article 67ter

(1), the examiner must send the applicant a notice of the grounds for rejection and give an opportunity to submit a written opinion (Article 50 applied mutatis mutandis under Article 67quater).

3.2.2 Response from the applicant

(1) Period during which an amendment may be made

A person who has undertaken a procedure may make an amendment only while the relevant case is pending before the JPO (Article 17(1)). Thus, a person who filed an application to register a patent term extension as compensation for the curtailment of the term may amend the application as long as it is pending before the JPO.

(2) Allowable scope of amendment

In the case where an examiner examines an application to register a patent term extension as compensation for the curtailment of the term, the most important checking point is which patent right will be subject to the patent term extension. Thus, if the matters specifying a patent right (such as the patent number) are stated in the application or a document describing the grounds for calculation of the length of the requested extension as of the time of the filing of the application, an amendment may be made to correct the application or the document describing the grounds for calculation of the length of the requested extension within the scope of information that can be obtained from those matters stated therein.

3.2.3 Examiner's decision of rejection

If an examiner finds that an application to register a patent term extension as compensation for the curtailment of the term falls under any of the items of Article 67ter (1) even after taking a written opinion, etc. into consideration, the examiner must make a decision to reject the application (Article 67ter (1)).

3.2.4 Examiner's decision of registration

If an examiner does not find any grounds to reject an application to register a patent term extension as compensation for the curtailment of the term, the examiner must make a decision to register the extension (Article 67ter (2)).

If such decision is made, the JPO will register the extension (Article 67ter (3)) and publish the following information in a patent gazette (Article 67ter (4)):

- (i) Name and domicile or residence of the patentee;
- (ii) Patent number;
- (iii) Application number and filing date of the application to register a patent term extension specified in Article 67(2);
- (iv) Registration date of the extension;
- (v) Length of the extension period;
- (vi) Application number and the filing date of the patent application; and
- (vii) Date on which a request for examination of the application was made.