

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

## **Chapter 1 Division of Application**

### **Section 1 Requirements for Division of Application**

\* In the case where transmission of a certified copy of decision of refusal to the original patent application is made on or before March 31, 2009, please refer to “Requirements for Division of Application”(pp 9-17) in the 2008 Patent Act before the revision

#### **Patent Act Article 44**

**1 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 cases:**

- (i) at the time for or within the allowable time limit for amendments of the description, scope of claims or drawings attached to the application;**
- (ii) within 30 days from the date on which 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)) has been served; and**
- (iii) within 3 months from the date on which a certified copy of the examiner’s initial decision to the effect that the application is to be refused has been served.**

**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, this shall not apply for the purpose of applications of Article 29bis of the Patent Act where the new patent application falls under another patent application in the said Article; Article 3bis of the Utility Model Law where the new patent application falls under a patent application in the said Article; and Articles 30(3) of the Patent Act.**

**3-7 (omitted.)**

(Note) The above Article 44 (1)-(6) applies to applications filed on or after April 1, 2012. As for an application of Article 44 (7), see supplementary provisions of the Act on the Partial Revision of the Patent Act and Other Acts (Act No. 36 on May 14, 2014) Article 2 (9). See page 18(reference) for the history of amendments to Article 44.

#### **1. Purpose of the Provisions for Division of Application**

Even when a patent application includes two or more inventions which do not satisfy the requirement for unity of the application, or when a patent application includes an invention which is not defined in the original claims but is described in the detailed description of the invention or drawings, such inventions are also disclosed to the public by filing of the application. Thus, considering the object of the patent system where inventions are patented as a reward for such disclosure, an opportunity for protection should be extended to such inventions. This is the purport of stipulating the provisions for division of application.

The provisions for division of application enable an applicant to extract one or more new patent applications out of a patent application concerning two or more inventions. When the

new application satisfies the requirements mentioned hereafter, it shall be deemed to have been filed at the time of filing of the original application (see Note).

**(Note)** Hereinafter, the original application from which new applications are divided is referred to as “the original application,” and irrespectively as to whether or not the new application is valid, the new application is referred to as “the divisional application,” in so far as there is no particular remarks otherwise stated.

## **2. Requirements for Division of Application**

The requirements for division of application are those under which division of an application is considered to be valid, and consist of formal requirements and substantive requirements.

### **2.1 Formal Requirements**

#### **2.1.1 Persons who may Divide an Application**

As Article 44(1) provides that “An applicant for a patent may extract one or more new patent application...,” the applicant of the divisional application must be identical to that of the original application at the time of division.

#### **2.1.2 Time Requirements**

Division of an application may be made only at the time of or within the period in (1) below for applications filed on or before March 31, 2007 and only within the period as mentioned in (1) to (3) below for applications filed on or after April 1, 2007.

(1) Within the time limit by which the description, claims or drawings attached to the request may be amended (Article 44(1)(i))

The time limit for amendments of the description, claims or drawings attached to the request is the period as mentioned in ① to ② below.

- ① Before the transmittal of a certified copy of an examiner’s decision that a patent is to be granted (except after the applicant receives the first notice of reasons for refusal)(main text of Article 17bis (1))
- ② Designated period of time where the applicant receives the notice of reasons for refusal from the examiner (including the appeal for examiner after a trial is demanded)(Article 17bis (1) (i) and (iii))
- ③ Designated period of time where the applicant receives the notice under Article 48septies after receiving a notice of reasons for refusal (Article 17bis (1)(ii))
- ④ Simultaneously with the demand for trial under Article 121(1)(Article 17bis(1)(iv))

(2) Within 30 days from the date on which a certified copy of an examiner’s decision that a patent is to be granted has been transmitted (excluding such decisions listed in □ and □ below) (Article 44(1)(ii)) (See Note)

- ① A decision that a patent is to be granted made in reconsideration by the examiner before appeal (provision of Article 51, as applied *mutatis mutandis* pursuant to Article 163(3))
- ② A decision that a patent is to be granted in the case where an application was put into further examination based on an appeal decision (Article 160(1))

However, even within 30 days from the date on which a certified copy of an examiner's decision that a patent is to be granted has been transmitted, division of an application cannot be made after registration that establishes a patent right. This is because a patent application is not pending before the Patent Office through such registration.

Where the period as provided in Article 108(1) is extended under Article 4 or Article 108(3), the period mentioned in (2) shall be deemed to have been extended only for that period as extended (Article 44(5)).

(3) Within 3 months from the date on which a certified copy of an examiner's initial decision of refusal has been transmitted (Article 44(1)(iii)) (See Note)

Where the period as provided in Article 121(1) is extended under Article 4, the period mentioned in (3) shall be deemed to have been extended only for that period as extended (Article 44(6)).

(Note) The period mentioned in (2) and (3) does not include the period after the transmittal of a certified copy of an appeal decision since an appeal decision on an appeal against an examiner's decision of refusal is neither a decision that a patent is to be granted nor a decision that the patent application is to be refused.

## **2.2 Substantive Requirements**

In order to be deemed to have been filed at the time that the original application was filed, a divisional application needs to meet the following substantive requirements depending on whether or not it is filed within the time limit for amendments, in addition to the formal requirements described under 2.1.

(1) Where division of an application is made within the time limit for amendments (Article 44(1)(i))

- (i) The claimed inventions of the divisional application shall not comprise all of the inventions described in the description, claims or drawings of the original application immediately prior to being divided.
- (ii) Matters described in the description, claims or drawings of the divisional application shall be within the scope of matters described in the description, claims or drawings of the original application as of the filing.

(2) Where division of an application is made within 30 days after transmittal of a certified copy of an examiner's decision to grant a patent, or within 3 months after transmittal of certified copy of a an examiner's decision of refusal. These periods must be at the time of or within the period in which amendments can be made (simultaneously with the demand for trial or the designated period under the provisions of Article 50 in a notification of reasons for refusal (Article 44(1)(ii) and (iii))

- (i) The claimed inventions of the divisional application shall not comprise all of the inventions described in the description, claims or drawings of the original application immediately prior to being divided

- (ii) Matters described in the description, claims or drawings of the divisional application shall be within the scope of matters described in the description, claims or drawings of the original application as of the filing
- (iii) Matters described in the description, claims or drawings of the divisional application shall be within the scope of matters described in the description, claims or drawings of the original application immediately prior to being divided

Whether or not matters described in the description, claims or drawings of a divisional application are within the scope of matters described in “the description, claims or drawings of the original application immediately prior to being divided” or in the “description, claims or drawings of the original application as of the filing” shall be determined in the same way as determination on new matter (Regarding determination on new matter, refer to “Part III: Section I. New Matter.”)

In the case of either (1) or (2), since the description, claims or drawings generally contains two or more inventions, the requirement (i) is satisfied except in very unusual cases wherein all of the two or more inventions described in the description, claims or drawings of the original application are considered to have been made to be the claimed inventions of its divisional application.

(Explanation)

According to the provisions of Article 44(1), in order to be deemed to have been filed at the time that the original application was filed, a divisional application is required to meet both of the following two requirements ① and ②:

- ① Two or more inventions shall be described in the description, claims or drawings of the original application immediately prior to being divided
- ② The claimed inventions of the divisional application shall be derived from a part of the inventions described in the description, claims or drawings of the original application immediately prior to being divided

Requirement ② can be divided into the following two separate requirements:

- ②-1 The claimed inventions of the divisional application shall be inventions described in the description, claims or drawings of the original application immediately prior to being divided
- ②-2 The claimed inventions of the divisional application shall not comprise all of the inventions described in the description, claims or drawings of the original application immediately prior to being divided

In this regard, matters described in the description or drawings of the divisional application can be made to be the claimed inventions of the divisional application by describing them in the claims of the divisional application through amendments after the division. In consideration of this, not only the claimed inventions of the divisional application but also matters described in the description or drawings of the divisional application are limited to fit within the scope of matters described in the description, claims and drawings of the original application immediately prior to being divided. Combining this point and the requirement ②-1, the following requirement ②-3 arises.

②-3 Matters described in the description, claims or drawings of the divisional application shall be within the scope of matters described in the description, claims or drawings of the original application immediately prior to being divided.

Considering the effect of division of an application as stipulated in Article 44(2), that is, a divisional application is deemed to have been filed at the time that the original application was filed, a divisional application must be permissible within the scope of the valid amendment of the original application. Therefore, the following condition ③ also becomes another requirement:

③ Matters described in the description, claims or drawings of the divisional application shall be within the scope of matters described in the description, claims or drawings of the original application as of the filing.

As mentioned above, regarding the substantive requirements for division of an application, assessment has to be made for four requirements, specifically, the requirements ①, ②-2, ②-3 and ③. However, if the requirement ②-2 is satisfied, then the requirement ① is also satisfied, as mentioned below.

Regarding the requirement ①

If an applicant intends to file a divisional application in the case where the description, claims or drawings of the original application describe only one invention, the divisional application inevitably contains the whole invention described in the description, claims or drawings of the original application.

Therefore, if a part of the inventions described in the description, claims or drawings of the original application had been divided into a divisional application, there had to be two or more inventions described in the description, claims or drawings of the original application. Thus, if requirement ②-2 is satisfied, then requirement ① is also satisfied.

In addition, in the case of division of an application within the time limit for amendments of the original application, if the requirement ③ is satisfied, then the requirement ②-3 shall also be satisfied, as follows.

Regarding the requirement ②-3

At the time of or within the time limit for amendments of the original application, it is possible to file a divisional application for matters that are not described in the description, claims or drawings of the original application immediately prior to being divided, by describing them in the description, claims or drawings of the original application through amendment, if they are described in the description, claims or drawings of the original application as of the filing.

Therefore, taking into consideration that an amendment as mentioned above may be made to the original application at the time that the application is divided where the application was divided within the time limit for amendments of the original application, if matters described in the description, claims or drawings of the divisional application do not exceed the scope of matters described in the description, claims or drawings of the original application as of the filing (that is, if requirement ③ is satisfied), then requirement ②-3 shall also be satisfied.

Consequently, regarding the substantive requirements for division of an application, (1) it is

sufficient to make assessment on the requirements ②-2 and ③ in the case where division of an application was made at the time of or within the time limit for amendments (Article 44(1)(i)), while (2) it is sufficient to make assessment on the requirements ②-2, ②-3 and ③ in the case where division of an application was submitted outside of such time limit (Article 44(1)(ii) and (iii)).

### **3. Other Remarks**

#### **3.1 Examiner's Approach where Claimed Invention of Divisional Application is the Same as Claimed Invention of Original Application after Division**

Where a divisional application is made legally and a claimed invention of a divisional application is identical to a claimed invention of the original application after the division, the applications shall be subject to the provision of the Patent Act Article 39(2).

Determination whether the applications fall under the provision of Article 39(2) shall be made in accordance with "Part II: Chapter 4. Patent Act Article 39."

(Explanation)

Granting patents to both a divisional application and its original application runs counter to the doctrine of "one patent for one invention" when both contain the same claimed invention. Thus, the approach as described above is taken.

#### **3.2 Examiner's Approach where a Divisional Application is Filed on the Same Date on which a Request for an Appeal Against an Examiner's Decision of Refusal is Made**

Where a divisional application is filed on the same date on which a request is made for an appeal against an examiner's decision that the original application is to be refused, the fulfillment of the substantive requirements for the division of an application shall be assessed deeming that the divisional application was filed pursuant to the provision of Article 44(1)(i), except where it is clear that the divisional application was not filed simultaneously with the said request for the appeal against an examiner's decision was made.

#### **3.3 Amendments of Divisional Application**

If the amendment of the description, claims or drawings of a divisional application is made, whether the amendment is legal or not is determined first. And where the amendment is legal, the requirements for divisional application are assessed on the assumption that the amended description, claims or drawings are attached to the application at the time of filing of the divisional application.

#### **3.4 Divisional Application whose Original Application is also Divisional Application**

Where an original application (hereinafter referred to as "the parent application") is divided into a divisional application (hereinafter referred to as "the child application") and the child application is divided into another divisional application (hereinafter referred to as "the grandchild application"), the grandchild application is deemed to have been filed at the time of filing of the parent application, provided that the child application meets all the requirements for division as to the parent application, and that the grandchild application meets all the requirements for division as to the child application, and that the grandchild

application meets all the substantive requirements for division as to the parent application.

(Explanation)

There are no particular provisions which prohibit making a further divisional application (a grandchild application) on the basis of a divisional application (a child application) as an original application. Further, in certain situations, an applicant has no choice but to undertake repeated procedures for division (e.g., where a parent application cannot be divided due to the time limit but only the child application can be divided). Thus, insofar as both the child and the grandchild applications satisfy the prescribed requirements, the grandchild application is deemed to have been filed at the time of filing of the parent application.

### **3.5 Conversion of Divisional Application**

Where a divisional patent application is validly converted into an application for utility model registration, the converted application is deemed to be a divisional application and the requirements for division described above are assessed on the converted application.

### **4. The Proviso of Patent Act Article 44(2)**

The proviso of Patent Act Article 44(2) is stipulated to eliminate inconsistencies caused by deeming that a divisional application is filed simultaneously with the original application. In the following cases, therefore, the time of filing of the divisional application shall be the actual time of filing the divisional application.

- ① Where a divisional application falls under Patent Act Article 29bis or as “another application for a patent” or under Utility Model Act 3bis as “an application for a patent.”
- ② Where an applicant is to submit a written statement to the Commissioner of the Patent Office for the application of the stipulation under Patent Act Article 30(1) or (2) for his divisional application, or where an applicant is to submit a document that proves that the claimed invention of his divisional application is an invention stipulated under Article 30(1) or (2)
- ③ Where an applicant declares an internal priority claim for the divisional application, submitting to the Commissioner of the Patent Office a document stating to that effect and indicating the earlier application
- ④ Where an applicant declares a priority claim under the Paris Convention for his divisional application, submitting to the Commissioner of the Patent Office a document stating to that effect and indicating the name of a member party to the Paris Convention where the earlier application was first filed, and where the applicant submits to the Commissioner a certified document issued by the government of the country indicating the filing date of the earlier application, and a copy of the description, claims of patent or claims of utility model, and drawings of the earlier application, or an official gazette or a certificate containing the same contents thereof, issued by that government.

Also in the case of submitting the translations of a foreign language document and of a foreign language abstract for a divisional application in a foreign language that was divided from a patent application filed on or before March 31, 2007, the time of filing of the divisional application shall be the actual time of filing of the divisional application.

### **5. Request for Submission of Explanatory Documents Necessary for Examination on a Divisional Application**

(1) When filing a divisional application, the applicant is required to explain in a written statement that the divisional application meets the substantive requirements for division and that the claimed inventions of the divisional application are not identical to the claimed inventions of the original application or of other divisional applications, as well as required to clearly indicate changes from the description, claims or drawings of the original application immediately prior to being divided, which were made in the divisional application, by underlining relevant parts after transcribing the description, claims or drawings of the divisional application.

(Explanation)

The applicant knows well descriptions in the description, claims or drawings of the original application that were changed in the divisional application, matters described in the description, claims or drawings of the original application from which the claimed inventions of the divisional application were derived, and the difference between the claimed inventions of the divisional application and the claimed inventions of the original application or other divisional applications. Such information is quite helpful in promptly and precisely determining whether or not a divisional application meets the substantive requirements for division and the requirements for patentability. Therefore, in dividing an application, the applicant is requested to sufficiently explain such information in a written document.

(2) In examination on a divisional application, where a written statement based on (1) above has not been submitted and the examiner cannot easily determine whether or not the divisional application meets the substantive requirements for division or where it requires considerable time to determine whether or not the claimed inventions of the divisional application are identical to the claimed inventions of the original application or other divisional applications, the examiner may request, pursuant to Article 194(1), that the applicant submit a document explaining the descriptions in the description, claims or drawings of the original application that were changed, and matters described in the description, claims or drawings of the original application as of the filing from which the claimed inventions of the divisional application were derived, as well as the fact that the claimed inventions of the divisional application are not identical to the claimed inventions of the original application or other divisional application.

Where the examiner cannot easily determine whether or not a divisional application meets the substantive requirements for division or where it requires considerable time to determine whether or not the claimed inventions of the divisional application are identical to the claimed inventions of the original application or of other divisional applications, even after careful examination of the content of a written statement submitted based on (1), the examiner may request, pursuant to Article 194(1), that the applicant submits another explanatory document.

(3) Where an applicant does not give any substantive explanation in response to a request from the examiner based on (2) above and it is thus considerably difficult to determine that a divisional application meets the substantive requirements for division, the examiner may conduct examination deeming that said divisional application does not meet the substantive requirements for division.



## **Chapter 1 Division of Application**

### **Section 1 Requirements for Division of Application**

\* The requirements in this Section are applicable where the transmission of a certified copy of decision of refusal to the original patent application is made on or before March 31, 2009 (See p.19, (Reference) Case1,2).

[Provisions applicable to applications filed on or before March 31, 2007]

#### **Patent Act Article 44**

**1 An applicant for a patent may divide a patent application comprising two or more inventions into one or more new patent applications only within the time limit by which the description, claims or drawings attached to the request may be amended.**

**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 application. However, this provision shall not apply where the new application is either another application for a patent as referred to in Article 29bis of this Act or an application for a patent as referred to in Article 3bis of the Utility Model Act for the purposes of those Articles and of Articles 30(4), 36bis(2), 41(4) and 43(1) (including its application under Article 43bis(3)).**

**3-4(omitted.)**

[Provisions applicable to applications filed on or after April 1, 2007]

#### **Patent Act Article 44**

**1 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) within the allowable time limit for amendments of the description, scope of claims or drawings attached to the application;**
- (ii) within 30 days from the date on which 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)) has been served; and**
- (iii) within 30 days from the date on which a certified copy of the examiner's initial decision to the effect that the application is to be refused has been served.**

**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 applications of: Article 29bis of the Patent Act where the new patent application falls under another patent application in the said Article; Article 3bis of the Utility Model Act where the new patent application falls under a patent application in the said Article; and Articles 30(4), 41(4) and 43(1) of the Patent Act (including its mutatis mutandis application under paragraph (3) of the preceding Article).**

**3-4(omitted.)**

**5 Where 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 Where the period as provided in Article 121(1) is extended under Article 4, the 30-day period as provided in paragraph (1)(iii) shall be deemed to have been extended only for that period as extended.**

Hereinafter in this section, the provisions of Article 44 shall be represented by the provisions applicable to applications filed on or after April 1, 2007.

**1. Purport of the Provisions for Division of Application**

Even when a patent application includes two or more inventions which do not satisfy the requirement of unity of application, or when a patent application includes an invention which is not defined in the original claims but is described in the detailed description of the invention or drawings, such inventions are disclosed to the public by filing of the application. Thus, considering the object of the patent system where inventions are patented as a reward for such disclosure, an opportunity for protection should be extended to such inventions. This is the purport of stipulating the provisions for division of application.

The provisions for division of application enable an applicant to extract one or more new patent applications out of a patent application containing two or more inventions. When the new application satisfies the requirements mentioned hereafter, it shall be deemed to have been filed at the time of filing of the original application. (see Note)

**(Note)** Hereinafter, the original application from which new applications are divided is referred to as “the original application,” and, irrespectively as to whether or not the new application is valid, the new application is referred to as “the divisional application,” insofar as there is no particular remarks otherwise stated.

**2. Requirements for Division of Application**

The requirements for division of application are those under which division of an application is considered as valid, and consist of formal requirements and substantive requirements.

**2.1 Formal Requirements**

**2.1.1 Persons who may Divide an Application**

As Article 44(1) provides that “An applicant for a patent may extract one or more new patent applications...,” the applicant of the divisional application must be identical to that of the original application at the time of division.

**2.1.2 Time Requirements**

Division of an application may be made only within the period as mentioned in (1) below for applications filed on or before March 31, 2007 and only within the period as mentioned in (1) to (3) below for applications filed on or after April 1, 2007.

(1) Within the time limit by which the description, claims or drawings attached to the request may be amended (Article 44(1)(i))

The time limit for amendments of the description, claims or drawings attached to the request is the period as mentioned in ① to ④ below.

- ① Before the transmittal of a certified copy of an examiner's decision that a patent is to be granted (except after the applicant receives the first notice of reasons for refusal)(main text of Article 17bis (1))
- ② Within the designated time limit where the applicant receives the notice of reasons for refusal from the examiner (including the appeal examiner after a trial is demanded)(Article 17bis(1)(i) and (iii))
- ③ Within the designated time limit where the applicant receives a notice under Article 48septies after receiving a notice of reasons for refusal (Article 17bis(1)(ii))
- ④ Within 30 days of such demand where the applicant demands a trial under Article 121(1)(Article 17bis (1)(iv)).

(2) Within 30 days from the date on which a certified copy of an examiner's decision that a patent is to be granted has been transmitted (excluding such decisions listed in ① and ② below) (Article 44(1)(ii)) (see, Note)

- ① A decision that a patent is to be granted made in reconsideration by the examiner before appeal (provision of Article 51, as applied mutatis mutandis pursuant to Article 163(3))
- ② A decision that a patent is to be granted in the case where an application was put into further examination based on an appeal decision (Article 160(1))

However, even within 30 days from the date on which a certified copy of an examiner's decision that a patent is to be granted has been transmitted, division of an application cannot be made after registration that establishes a patent right. This is because a patent application is not pending before the Patent Office through such registration.

Where the period as provided in Article 108(1) is extended under Article 4 or Article 108(3), the period mentioned in (2) shall be deemed to have been extended only for that period as extended (Article 44(5)).

(3) Within 30 days from the date on which a certified copy of an examiner's initial decision of refusal has been transmitted (Article 44(1)(iii)) (see, Note)

Where the period as provided in Article 121(1) is extended under Article 4, the period mentioned in (3) shall be deemed to have been extended only for that period as extended (Article 44(6)).

**(Note)** The period mentioned in (2) and (3) does not include the period after the transmittal of a certified copy of an appeal decision since an appeal decision on an appeal against an examiner's decision of refusal is neither a decision that a patent is to be granted nor a decision that the patent application is to be refused.

## 2.2 Substantive Requirements

In order to be deemed to have been filed at the time that the original application was filed, a divisional application needs to meet the following substantive requirements depending on whether or not it is filed within the time limit for amendments, in addition to the formal requirements described under 2.1.

(1) Where division of an application is made within the time limit for amendments (Article 44(1)(i))

- (i) The claimed inventions of the divisional application shall not comprise all of the inventions described in the description, claims or drawings of the original application immediately prior to being divided.
- (ii) Matters described in the description, claims or drawings of the divisional application shall be within the scope of matters described in the description, claims or drawings of the original application as of the filing.

(2) Where division of an application is made after a decision that a patent is to be granted is made (that is, not within the time limit for amendments) or during the period after a decision of refusal is made but before a request for an appeal against an examiner's decision of refusal is made (Article 44(1)(ii) and (iii))

- (i) The claimed inventions of the divisional application shall not comprise all of the inventions described in the description, claims or drawings of the original application immediately prior to being divided.
- (ii) Matters described in the description, claims or drawings of the divisional application shall be within the scope of matters described in the description, claims or drawings of the original application as of the filing.
- (iii) Matters described in the description, claims or drawings of the divisional application shall be within the scope of matters described in the description, claims or drawings of the original application immediately prior to being divided.

Whether or not matters described in the description, claims or drawings of a divisional application is within the scope of matters described in the "description, claims or drawings of the original application immediately prior to being divided" or in the "description, claims or drawings of the original application as of the filing" shall be determined in the same way as determination on new matter. (Regarding determination on new matter, refer to "Part III: Section I. New Matter.")

In the case of either (1) or (2), since the description, claims or drawings generally contains two or more inventions, requirement (i) is satisfied except in very unusual cases wherein all of the two or more inventions described in the description, claims or drawings of the original application are considered to have been made to be the claimed inventions of its divisional application.

(Explanation)

According to Article 44(1), in order to be deemed to have been filed at the time that the original application was filed, a divisional application is required to meet both of the following two requirements ① and ②:

- ① Two or more inventions shall be described in the description, claims or drawings of the original application immediately prior to being divided
- ② The claimed inventions of the divisional application shall be derived from a part of the inventions described in the description, claims or drawings of the original application immediately prior to being divided.

Requirement ② can be divided into the following two separate requirements:

- ②-1 The claimed inventions of the divisional application shall be inventions described in the description, claims or drawings of the original application immediately prior to being divided
- ②-2 The claimed inventions of the divisional application shall not comprise all of the inventions described in the description, claims or drawings of the original application immediately prior to being divided.

In this regard, matters described in the description or drawings of a divisional application can be made to be the claimed inventions of the divisional application by describing them in the claims of the divisional application through amendment after the division. In consideration of this, not only the claimed inventions of the divisional application but also matters described in the description or drawings of the divisional application are limited to fit within the scope of matters described in the description, claims and drawings of the original application immediately prior to being divided. Combining this point and requirement ②-1 together, the following requirement ②-3 arises.

- ②-3 Matters described in the description, claims or drawings of the divisional application shall be within the scope of matters described in the description, claims or drawings of the original application immediately prior to being divided.

Considering the effect of division of an application as stipulated in Article 44(2), that is, a divisional application is deemed to have been filed at the time that the original application was filed, a divisional application must be permissible within the scope of the valid amendment of the original application. Therefore, the following condition ③ also becomes another requirement:

- ③ Matters described in the description, claims or drawings of the divisional application shall be within the scope of matters described in the description, claims or drawings of the original application as of the filing.

As mentioned above, regarding substantive requirements for division of an application, assessment has to be made for four requirements, specifically, requirements ①, ②-2, ②-3, and ③. However, if requirement ②-2 is satisfied, then requirement ① is also satisfied, as mentioned below.

Regarding requirement ①

If an applicant intends to file a divisional application in the case where the description, claims or drawings of the original application describe only one invention, the divisional application inevitably contains the whole invention described in the description, claims or drawings of the original application.

Therefore, if a part of the inventions described in the description, claims or drawings of the original application had been divided into a divisional application, there had to be two or more inventions described in the description, claims or drawings of the original application. Thus, if requirement ②-2 is satisfied, then requirement ① is also satisfied.

In addition, in the case of division of an application within the time limit for amendments of the original application, if requirement ③ is satisfied, then requirement ②-3 shall also be satisfied, as follows.

#### Regarding requirement ②-3

Within the time limit for amendments of the original application, it is possible to file a divisional application for matters that are not described in the description, claims or drawings of the original application immediately prior to being divided, by describing them in the description, claims or drawings of the original application through amendment, if they are described in the description, claims or drawings of the original application as of the filing.

Therefore, taking into consideration that an amendment as mentioned above may be made to the original application at the time that the application is divided where the application was divided within the time limit for amendments of the original application, if matters described in the description, claims or drawings of the divisional application do not exceed the scope of matters described in the description, claims or drawings of the original application as of the filing (that is, if requirement ③ is satisfied), then requirement ②-3 shall also be satisfied.

Consequently, regarding substantive requirements for division of an application, (1) it is sufficient to make assessments on requirements ②-2 and ③ in the case where division of an application was made within the time limit for amendments (Article 44(1)(i)), while (2) it is sufficient to make assessments on requirements ②-2, ②-3 and ③ in the case where division of an application was submitted outside of such time limit (Article 44(1)(ii) and (iii)).

### 3. Other Remarks

#### 3.1 Examiner's Approach where Claimed Invention of Divisional Application is the Same as Claimed Invention of Original Application after Division

Where the division of application is made legally and a claimed invention of a divisional application is identical to a claimed invention of the original application after the division, the applications shall be subject to the provision of Patent Act Article 39(2).

Determining whether the applications fall under the provision of Article 39(2) shall be made in accordance with "Part II : Chapter 4. Patent Act Article 39."

(Explanation)

Granting patents to both a divisional application and its original application runs counter to the doctrine of "one patent for one invention" when both contain the same claimed invention. Thus, the approach as described above is taken.

#### 3.2 Examiner's Approach Where a Divisional Application Is Filed on the Same Date on

### **Which a Request for an Appeal Against an Examiner's Decision of Refusal Is Made**

Where a divisional application is filed on the same date on which a request is made for an appeal against an examiner's decision that the original application is to be refused, the fulfillment of the substantive requirements for division of an application shall be assessed deeming that the divisional application was filed pursuant to the provision of Article 44(1)(i), except where it is clear that the divisional application was filed before said request for an appeal against an examiner's decision was made.

### **3.3 Amendments of Divisional Application**

If the amendment of the description, claims or drawings of a divisional application is made, whether the amendment is legal or not is determined first. And where the amendment is legal, the requirements for divisional application is assessed on the assumption that the amended description, claims or drawings is attached to the application at the time of filing of the divisional application.

### **3.4 Divisional Application whose Original Application is also Divisional Application**

Where an original application (hereinafter referred to as "the parent application") is divided into a divisional application (hereinafter referred to as "the child application") and the child application is divided into another divisional application (hereinafter referred to as "the grandchild application"), the grandchild application is deemed to have been filed at the time of filing of the parent application, provided that the child application meets all the requirements for division as to the parent application, and that the grandchild application meets all the requirements for division as to the child application, and that the grandchild application meets all the substantive requirements for division as to the parent application.

(Explanation)

There are no particular provisions which prohibit making a further divisional application (a grandchild application) on the basis of a divisional application (a child application) as an original application. Further, in certain situations, an applicant has no choice but to undertake repeated procedures for division (e.g., where a parent application cannot be divided due to the time limit but only the child application can be divided). Thus, insofar as both the child and the grandchild application satisfy the prescribed requirements, the grandchild application is deemed to have been filed at the time of filing of the parent application.

### **3.5 Conversion of Divisional Application**

Where a divisional patent application is validly converted into an application for utility model registration, the converted application is deemed to be a divisional application and the requirements for division described above are assessed on the converted application.

## **4. The Proviso of Patent Act Article 44(2)**

The proviso of Patent Act Article 44(2) is stipulated to eliminate inconsistencies caused by deeming that a divisional application is filed simultaneously with the original application. In the following cases, the time of filing of the divisional application shall be the actual time of filing the divisional application.

- ① Where a divisional application falls under Patent Act Article 29bis as “another application for a patent” or under Utility Model Act Article 3bis as “an application for a patent.”
- ② Where an applicant is to submit a written statement to the Commissioner of the Patent Office for the application of the stipulation under Patent Act Article 30(1) or (3) for his divisional application, or where an applicant is to submit a document that proves that the claimed invention of his divisional application is an invention under Article 30(1) or (3).
- ③ Where an applicant declares a internal priority claim for the divisional application, submitting to the Commissioner of the Patent Office a document stating to that effect and indicating the earlier application.
- ④ Where an applicant declares a priority claim under the Paris Convention for his divisional application, submitting to the Commissioner of the Patent Office a document stating to that effect and indicating the name of the country party to the Paris Convention where the earlier application was first filed, and where the applicant submits to the Commissioner a certified document issued by the government of the country indicating the filing date of the earlier application, and a copy of the description, claims of patent or claims of utility model, and drawings of the earlier application or an official gazette or a certificate containing the same contents thereof, issued by that government.

Also in the case of submitting the translations of a foreign language document and of a foreign language abstract for a divisional application in foreign language that was divided from a patent application filed on or before March 31, 2007, the time of filing of the divisional application shall be the actual time of filing of the divisional application.

## **5. Request for Submission of Explanatory Documents Necessary for Examination on a Divisional Application**

(1) When filing a divisional application, the applicant is required to explain in a written statement that the divisional application meets the substantive requirements for division and that the claimed inventions of the divisional application are not identical to the claimed inventions of the original application or of other divisional applications, as well as required to clearly indicate changes from the description, claims or drawings of the original application immediately prior to being divided, which were made in the divisional application, by underlining relevant parts after transcribing the description, claims or drawings of the divisional application.

(Explanation)

The applicant knows well descriptions in the description, claims or drawings of the original application that were changed in the divisional application, matters described in the description, claims or drawings of the original application from which the claimed inventions of the divisional application were derived, and the difference between the claimed inventions of the divisional application and the claimed inventions of the original application or other divisional applications. Such information is quite helpful in promptly and precisely determining whether or not a divisional application meets the substantive requirements for division and the



requirements for patentability. Therefore, when dividing an application, the applicant is requested to sufficiently explain such information in a written statement.

(2) In examination on a divisional application, where a written statement based on (1) above has not been submitted and the examiner cannot easily determine whether or not the divisional application meets the substantive requirements for division or where it requires considerable time to determine whether or not the claimed inventions of the divisional application are identical to the claimed inventions of the original application or other divisional applications, the examiner may request, pursuant to Article 194(1), that the applicant submit a document explaining the descriptions in the description, claims or drawings of the original application that were changed, and matters described in the description, claims or drawings of the original application as of the filing from which the claimed inventions of the divisional application were derived, as well as the fact that the claimed inventions of the divisional application are not identical to the claimed inventions of the original application or other divisional applications.

Where the examiner cannot easily determine whether or not a divisional application meets the substantive requirements for division or where it requires considerable time to determine whether or not the claimed inventions of the divisional application are identical to the claimed inventions of the original application or of other divisional applications, even after careful examination of the content of a written statement submitted based on (1), the examiner may request, pursuant to Article 194(1), that the applicant submit another explanatory document.

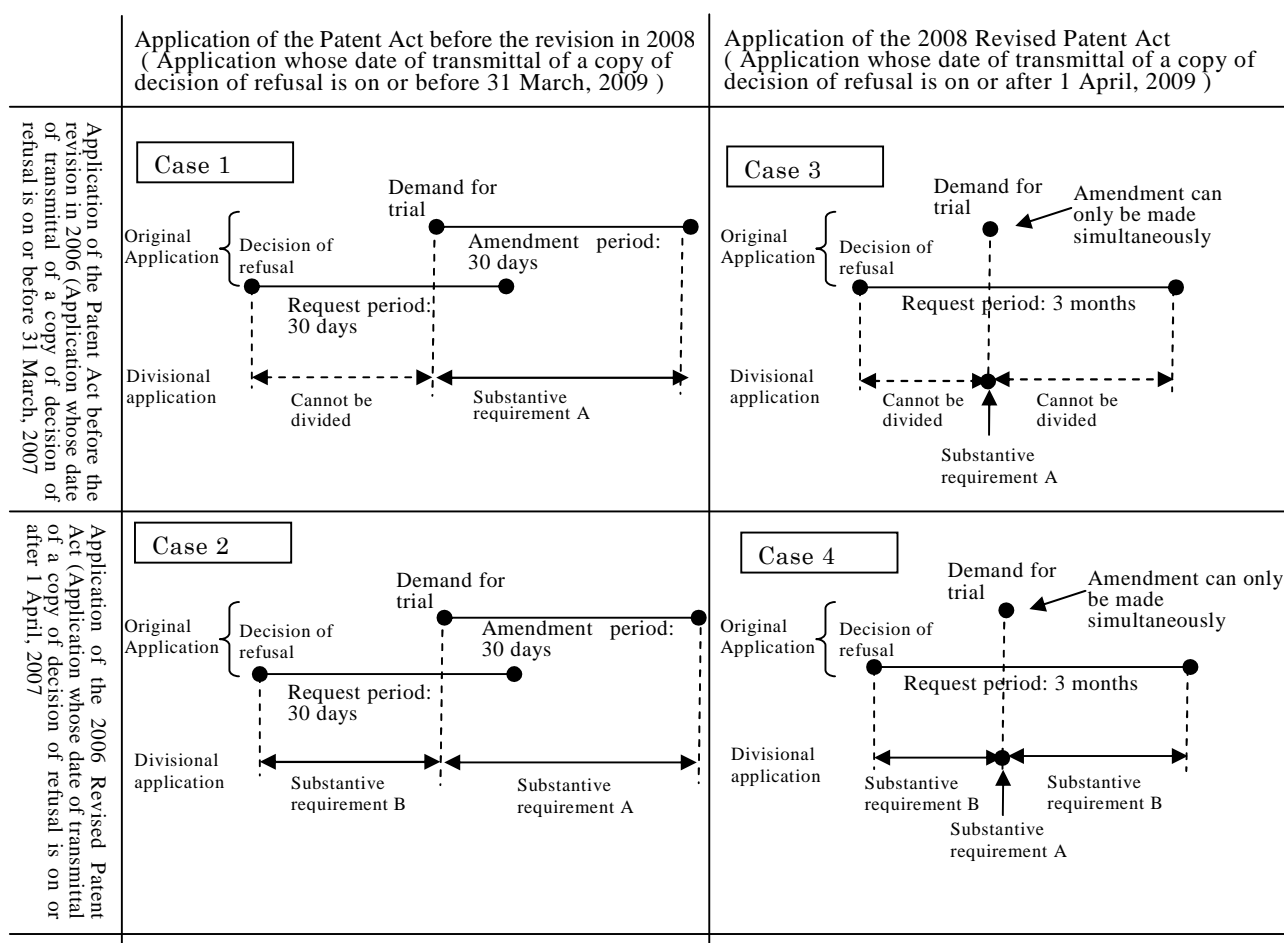
(3) Where an applicant does not give any substantive explanation in response to a request from the examiner based on (2) above and it is thus considerably difficult to determine that a divisional application meets the substantive requirements for division, the examiner may conduct examination deeming that said divisional application does not meet the substantive requirements for division.

(Reference) The history of amendments to Article 44

Filing day	Jan.1,1984 ~ June 30,1995	July 1,1995 ~ Dec.31, 1998	Jan.1,1999 ~ June 30,2003	July 1,2003 ~ Mar.31, 2007	Apr.1,2007 ~ Mar.31,2012 The date on which a certified copy of the examiner's initial decision to the effect that the application is to be refused has been served is on or before Mar.31,2009	Apr.1,2012 ~ The date on which a certified copy of the examiner's initial decision to the effect that the application is to be refused has been served is on or after Apr.1,2009
(1)	An applicant for a patent may divide a patent application comprising two or more inventions into one or more new patent applications only at the time for or within the time limit by which the description or drawings attached to the request may be amended.	An applicant for a patent may divide a patent application comprising two or more inventions into one or more new patent applications only within the time limit by which the description or drawings attached to the request may be amended.	An applicant for a patent may divide a patent application comprising two or more inventions into one or more new patent applications only within the time limit by which the description, claims or drawings attached to the request may be amended.	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) within the allowable time limit for amendments of the description, scope of claims or drawings attached to the application; (ii) within 30 days from the date on which 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)) has been served; (iii) within 3 months from the date on which a certified copy of the examiner's initial decision to the effect that the application is to be refused has been served.	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 the time for or within the allowable time limit for amendments of the description, scope of claims or drawings attached to the application; (ii) within 30 days from the date on which 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)) has been served; (iii) within 3 months from the date on which a certified copy of the examiner's initial decision to the effect that the application is to be refused has been served.	
(2)	In the case of 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 application. However, this shall not apply to the provisions where the new application is either another patent application as stipulated in Article 29bis of this Law or a patent application stipulated in Article 3bis of the Utility Model Act, and of Articles 30(4), 40(1) and 40(2).	In the case of 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 application. However, this shall not apply to the provisions where the new application is either another patent application as stipulated in Article 29bis of this Law or a patent application stipulated in Article 3bis of the Utility Model Act, and of Articles 30(4), 36bis(2), 41(4), 43(1) and 43(2) (including its application mutatis mutandis under Article 43(3)).	In the case of 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 application. However, this shall not apply to the provisions where the new application is either another patent application as stipulated in Article 29bis of this Law or a patent application stipulated in Article 3bis of the Utility Model Act, and of Articles 30(4), 36bis(2), 41(4) and 43(1) (including its application mutatis mutandis under Article 43(3)).	In the case of 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 application. However, this shall not apply to the provisions where the new application is either another patent application as stipulated in Article 29bis of this Law or a patent application stipulated in Article 3bis of the Utility Model Act, and of Articles 30(4), 41(4) and 43(1) (including its application mutatis mutandis under Article 43(3)).	In the case of 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 application. However, this shall not apply to the provisions where the new application is either another patent application as stipulated in Article 29bis of this Law or a patent application stipulated in Article 3bis of the Utility Model Act, and of Articles 30(3), 41(4) and 43(1) (including its application mutatis mutandis under Article 43(3)).	In the case of 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 application. However, this shall not apply to the provisions where the new application is either another patent application as stipulated in Article 29bis of this Law or a patent application stipulated in Article 3bis of the Utility Model Act, and of Articles 30(3), 41(4) and 43(1) (including its application mutatis mutandis under Article 43(3)).
(3)(4)	(Omitted)					
(5)	Where the period as provided in Article 108(1) is extended under Article 4 or Article 108(3), the 30-day period as stipulated in paragraph (1)(ii) shall be deemed to have been extended only for that period as extended.					
(6)	Where the period as stipulated in Article 121(1) is extended under Article 4, the 3-month period as stipulated in paragraph (1)(iii) shall be deemed to have been extended only for the period as extended.					

**(Reference) Relationship between time and substantive requirements of a divisional application after the submittal of a copy of decision of refusal of the original application and a date on which the original application was filed and a copy of decision of refusal of the original application has been transmitted**

The time and substantive requirements for a divisional application are different according to a filing date of the original application and a date on which a copy of decision of refusal of the original application has been transmitted. The time and substantive requirements for a divisional application are described below by limiting to divisional applications after the transmittal of a copy of decision of refusal of the original application.



Substantive Requirement A: Where division of an application is made within the time limit for amendments (refer to 2.2(1))

- (i) The claimed inventions of the divisional application shall not comprise all of the inventions described in the description, claims or drawings of the original application immediately prior to being divided
- (ii) Matters described in the described in the description, claims or drawings of the divisional application shall be within the scope of matters described in the description, claims or drawings of the original application as of the filing

Substantive Requirement B: Where division of an application is made within the time limit amendments cannot be made (refer to 2.2 (2))

In addition to (i) and (ii) above, the following requirement (iii) arises.

- (iii) Matters described in the description, claims or drawings of the divisional application shall be within the scope of matters described in the description, claims or drawings of the original application immediately prior to being divided

## **(Appendix) Immediate Operation of Determination on Substantive Requirements for Division of Application**

### **1. “Requirements for division of application” corresponding to the 2008 Revised Patent Act**

In the case where an application of the original application was filed on or after April 1, 2007, a copy of decision of refusal of the original application has been transmitted on or after April 1, 2009, and the application is divided after a copy of decision of refusal of the original application has been transmitted, the substantive requirements vary depending on whether or not a request for appeal against examiner’s decision of refusal of the original application was made simultaneously with the division of application (refer to (Reference) Case 4).

Regarding the case where a request for appeal against examiner’s decision of refusal of the original application was made on the same date as division of an application, there is the following description in “3.2 Examiner’s Approach where a Divisional Application is Filed on the Same Date on which a Request for an Appeal Against an Examiner’s Decision of Refusal is Made.”

“Where a divisional application is filed on the same date on which a request is made for an appeal against an examiner’s decision that the original application is to be refused, the fulfillment of the substantive requirements for division of the application shall be assessed deeming that the divisional application was filed pursuant to the provision of Article 44(1)(i), except where it is clear that the divisional application was not filed on the same date as the said request for the appeal against an examiner’s decision was made.

Regarding this point, the requirement will be operated as follows for the time being.

Where a divisional application is submitted on the same date on which a request is made for a demand for trial of the original application, the substantive requirements for division of an application shall be assessed deeming that the divisional application was filed within the allowable time limit for amendments.

### **2. “Requirements for division of application” corresponding to the 2008 Patent Act before the revision**

In the case where the original application was filed on or after April 1, 2007, a copy of decision of refusal of the original application has been transmitted on or before March 31, 2009, and the application is divided after the copy of decision of refusal of the original application has been transmitted, the substantive requirements vary depending on whether or not a request for appeal against examiner’s decision of refusal of the original application was made simultaneously with the division of application (refer to (Reference) Case 2).

Regarding the case where a request for appeal against examiner’s decision of refusal of the original application was made on the same date as division of an application, there is the following description in “3.2 Examiner’s Approach where a Divisional Application is Filed on the Same Date on which a Request for an Appeal Against an Examiner’s Decision of Refusal is Made.”

Where a divisional application is filed on the same date on which a request is made for an

appeal against an examiner's decision that the original application is to be refused, the fulfillment of the substantive requirements for division of an application shall be assessed deeming that the divisional application was filed pursuant to the provision of Article 44(1)(i), except where it is clear that the divisional application was filed before the said request for the appeal against an examiner's decision was made.

Regarding this point, the requirement will be operated as follows for the time being.

Where a divisional application is submitted on the same date on which a request is made for a demand for trial of the original application, the substantive requirements for division of the application shall be assessed deeming that the divisional application was filed within the allowable time limit for amendments without making a judgment on which procedure was made first.

### **3. Points of concern**

The relevant operation is applicable when the substantive requirements for divisional application are assessed. Therefore, it is not deemed that the divisional application was simultaneously made with the demand for trial just because the divisional application and the written demand for trial were submitted on the same date.

## **Section 2 Notice under Article 50bis**

### **Patent Act Article 50bis**

Where the examiner intends to give a notice of reasons for refusal for a patent application under the preceding Article, and these reasons for refusal are the same as the reasons for refusal stated in the previous notice under the preceding Article (including its application mutatis mutandis under Article 159(2) (including its application mutatis mutandis under Article 174(2)) and Article 163 (2)) with regard to another patent application (limited to the case where both patent applications are deemed to have been filed simultaneously by applying the provision of Article 44(2) to either or both of them) (excluding such a notice of reasons for refusal of which the applicant of the patent application could have never known the content prior to the filing of a request for examination of the patent application), the examiner shall also give a notice to that effect.

### **Patent Act Article 17bis(5)**

In addition to the requirements provided in the preceding two paragraphs, in the cases of items (i), (iii) and iv of paragraph (1) (in the case of item (i) of the said paragraph, limited to the case where the applicant has received a notice under Article 50bis 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) are omitted)

An amendment to be made to a patent application in response to a notice under Article 50bis given along with a notice of reasons for refusal must meet the requirements prescribed in Article 17bis(3) to (6) as in the case of making an amendment in response to the final notice of reasons for refusal; an amendment that fails to meet these requirements may be dismissed (Article 53, Article 159(1), Article 163(1)).

### **1. Purport of the Provisions of Article 50bis**

The purport of the provisions of Article 50bis (and Article 17bis(5)) is to encourage an applicant to closely examine the reason for refusal notified in the examination of the original application, etc., thereby preventing him from filing a divisional application without overcoming the reason for refusal, of which he has already been notified.

### **2. Notice under Article 50bis**

#### **2.1 “Another patent application (limited to the case where both patent applications are deemed to have been filed simultaneously by applying the provision of Article 44(2) to either or both of them)”**

In the case there is any of the relationships ① to ③ below between a patent application for which the reason for refusal is to be notified (hereinafter referred to as the “application concerned”) and another patent application, the “the case where both patent applications are deemed to have been filed simultaneously by applying the provision of Article 44(2) to either or both of them.”

- ① The other patent application is included in a group of divisional applications (see, Note) based on the application concerned.
- ② The application concerned is included in a group of divisional applications based on the other patent application.
- ③ The application concerned and the other patent application are included in a group of divisional applications based on the same patent application.

**(Note)** “A group of divisional applications based on a patent application” refers to a series of divisional applications deriving from one patent application. This includes divisional applications based on the patent application, as well as divisional applications (grandchild applications) based on a divisional application (child applications).

**(Point to Consider)**

Article 44(2) shall not apply to a patent application filed as a divisional application if it fails to meet the substantive requirements for division of application. Therefore, in order to determine whether or not there are any of the relationships ① to ③ above between the application concerned and the other patent application, it is necessary to check whether either the application concerned or the other patent application, which is filed as a divisional application, meets the substantive requirements for division of application.

For the substantive requirements for division of application, see: “Section 1 Requirements for Division of Application”, “2.2 Substantive Requirements.”

**2.2 “The same as the reasons for refusal stated in the previous notice under the preceding Article (including its application mutatis mutandis under Article 159(2) (including its application mutatis mutandis under Article 174(1)) and Article 163 (2))”**

- (1) “Notice under the preceding Article” includes not only a notice of reasons for refusal given in the examination but also a notice of reasons for refusal given during an appeal against examiner’s decision, retrial or reconsideration by an examiner before appeal.

**(Point to Consider)**

Since a decision to dismiss the amendment and a decision of refusal cannot be deemed to be a “notice under the preceding Article” (a notice of reasons for refusal), a notice under Article 50bis shall not be given even where the reason for refusal of the application concerned is the same as that stated in the decision to dismiss the amendment or decision of refusal made to the other patent application.

- (2) In order that the reason for refusal of the application concerned is deemed to be the same as that stated in the notice given to the other patent application, the provision stipulating the reason for refusal of the application concerned (e.g. Article 29(1)(iii), Article 29(2), Article 36(4)(i), Article 36(6)(i)) shall be the same as that stated in the notice given to the other patent application and, in addition, the details of the reason for refusal of the application concerned shall substantially be the same as that stated in the notice given to the other patent application.

- (3) To determine whether the reason for refusal of the application concerned is the same

as that stated in the notice given to the other patent application, one must examine whether the description, claims or drawings (hereinafter referred to as the “description, etc.”) of the application concerned are unable to overcome the reason for refusal stated in the notice of reasons for refusal given to the other patent application on the assumption that the description, etc. of the application concerned is the description, etc. of the other patent application amended in response to the notice of reasons for refusal.

If the description, etc. of the application concerned is found to be unable to overcome the reason for refusal stated in the notice of reasons for refusal given to the other patent application, the reason for refusal of the application concerned is the same as that stated in the notice of reasons for refusal given to the other patent application. The reason for refusal of the application concerned is found to be the same as that stated in the notice given to the other patent application in the following cases.

Example 1:

On the assumption that an invention claimed in the application concerned is the invention that was amended in response to the notice of reasons for refusal indicating lack of inventive step to the other patent application, if the invention claimed in the application concerned is unable to bring about a new effect because it is made merely by adding well-known art or commonly used art to the invention claimed in the other patent application, and is therefore found to be unable to overcome the lack of inventive step, the reason for refusal of the application concerned arising from the lack of inventive step based on the same reference document is the same as that stated in the notice given to the other patent application.

However, on the assumption that an invention claimed in the application concerned is the invention that was amended in response to the notice of reasons for refusal indicating the lack of inventive step, if the invention claimed in the application concerned is made by adding any matters that do not fall under the scope of well-known art or commonly used art to the invention claimed in the other patent application and therefore it is required to notify an additional reason for refusal to indicate the lack of inventive step by citing another reference, the reason for refusal of the application concerned arising from the lack of inventive step cannot be deemed to be the same as the reason for refusal arising from the lack of inventive step stated in the notice given to the other patent application.

Example 2:

On the assumption that the description of an application concerned is the description of the other patent application that was amended in response to the notice of reasons for refusal indicating the violation of the enablement requirement. If the description of the application concerned is found to be unable to overcome the reason for refusal arising from the violation of the enablement requirement because it contains the working example due to which there was a violation of the enablement requirement, the reason for refusal of the application concerned arising from the violation of the enablement requirement is the same as the reason stated in the notice given to the other patent application.

**2.3 “Such a notice of reasons for refusal of which the applicant of the patent application could have never known the content prior to the filing of a request for examination of the patent application”**

“Such a notice of reasons for refusal that the applicant of the patent application



could have never become aware of prior to a request for examination of the patent application” means a notice of reasons for refusal that has not yet been received or made available for inspection by the applicant prior to a request for examination of the application concerned.

Where the applicant of the application concerned is different from the applicant of the other patent application, the notice of reasons for refusal given to the other patent application is not addressed to the applicant of the application concerned. However, even in such a case, the applicant of the application concerned can inspect the notice of reasons for refusal given to the other patent application if the other patent application has been published before he files a request for examination of the application concerned. Therefore, the applicant of the application concerned could have become aware of such a notice of reasons for refusal before filing a request for examination of the application concerned.

Where the notice of reasons for refusal given to the other patent application is received by the applicant of the application concerned on the same day on which a request for examination is filed with regard to the application concerned, or where the notice of reasons for refusal given to the other patent application is made available for inspection on the same day on which a request for examination is filed with regard to the application concerned, the applicant of the application concerned is deemed unable to become aware of the notice of reasons for refusal given to the other patent application before filing a request for examination of the application concerned, unless it is obvious that a request for examination of the application concerned has been filed before the notice of reasons for refusal is received or made available for inspection by the applicant of the application concerned.

### **3. Amendment Made in Response to a Notice under Article 50bis Given Along with a Notice of reasons for Refusal**

An amendment to be made to a patent application for which a notice under Article 50bis has been given along with a notice of reasons for refusal must meet the requirements prescribed in Article 17bis(3) to (6). An amendment that fails to meet these requirements may be dismissed.

For the specific practice where the requirements prescribed in Article 17bis(3) to (6) are applied, see: “Part III Amendment of Description, Claims and Drawings.”

## **4. Procedure of Examination**

### **4.1 Examination When Giving a Notice under Article 50bis**

#### **4.1.1 Determination of Whether or Not to Give a Notice under Article 50bis**

Where the application concerned is a divisional application or the original application of a divisional application, the examiner determines whether the application concerned and the other patent application meet all requirements ① to ③ below. The examiner takes into consideration a written statement, if any, that explains that the description, etc. of the application concerned successfully overcome the reason for refusal stated in the notice of reasons for refusal given to the other patent application.

- ① The application concerned and the other patent application are deemed to

have been filed simultaneously by applying Article 44(2) to either of them (either the application concerned or the other patent application, which is filed as a divisional application, meets the substantive requirements for division of application).(see, Note 1)

② The reason for refusal of the application concerned is the same as that stated in the notice of reasons for refusal given to the other patent application. (see, Note 2)

③ The applicant of the application concerned could have become aware of the notice of reasons for refusal given to the other patent application before filing a request for examination of the application concerned.

If all requirements ① to ③ above are met, the examiner shall give a notice under Article 50bis to the application concerned, along with a notice of reasons for refusal.(see, Note 3)

On the other hand, if any of these requirements is not met, the examiner shall not give a notice under Article 50bis to the application concerned.

**(Note 1)** Whether the application concerned and the other patent application are deemed to have been filed simultaneously by applying Article 44(2) to either of them shall be determined based on the contents of the description, etc. of the application concerned and those of the other patent application as of notifying the reasons for refusal to the application concerned.

**(Note 2)** In case an application concerned involves two or more reasons for refusal and the notice of reasons for refusal given to the other patent application states two or more reasons for refusal if one of the reasons for refusal of the application concerned is the same as any one of the reasons for refusal stated in the notice of reasons for refusal given to the other patent application, the reason for refusal of the application concerned deemed to be the same as that stated in the notice of reasons for refusal given to the other patent application.

**(Note 3)** It may be uncertain that the description, etc. of the application concerned are unable to overcome the reason for refusal stated in the notice of reasons for refusal given to the other patent application (e.g. it may be impossible to clearly identify the reason for refusal based on the contents of the notice of reasons for refusal given to the other patent application). Or the reason for refusal stated in the notice of reasons for refusal given to the other patent application may be a clerical error or other minor defect. In these cases, the examiner should refrain from applying Article 50bis in unnecessarily formal way.

#### **4.1.2 Points to Note When Giving a Notice under Article 50bis**

When giving a notice under Article 50bis, the examiner shall state, in the notice, the application number of the other patent application that has the same reason for refusal as well as the date of drafting of the notice of reasons for refusal given to the other patent application. If the notice of reasons for refusal given to the other patent application contains two or more reasons for refusal, the examiner shall, in addition to the application number and the date of drafting, state the information by which the relevant reason for refusal that is

found to be the same as the reason for refusal of the application concerned can be identified (e.g. the number attached to the relevant reason for refusal, the claim mentioned in the relevant reason for refusal).

**(Point to Consider)**

In the notice of reasons for refusal to be given to the application concerned along with a notice under Article 50bis, the examiner shall point out the reason for refusal specifically so that the applicant will be able to clearly understand the gist of the reason for refusal. (See “Part IX Procedure of Examination, Section 2, 4.2”) The examiner shall not omit the details of the reason for refusal by only indicating the information necessary for identifying the relevant reason for refusal stated in the notice of reasons for refusal given to the other patent application.

**4.2 Examination Where an Amendment Is Made in Response to the Notice of reasons for Refusal Given Along with a Notice under Article 50bis**

**4.2.1 Where the Notice of reasons for Refusal Is the “First Notice of reasons for Refusal”**

Where an amendment is made in response to the “first notice of reasons for refusal” given along with a notice under Article 50bis, the examiner shall reconsider whether or not it was appropriate to give a notice under Article 50bis, while taking into account the applicant’s assertion stated in the written opinion. (see, Note)

**(Note)** Where the notice under Article 50bis indicates that two or more reasons for refusal of the application concerned are the same as the reason for refusal stated in the notice of reasons for refusal given to the other patent application, the examiner shall determine that it was appropriate to give a notice under Article 50bis if at least one of the reasons for refusal indicated is appropriate.

(1) Where it was appropriate to give a notice under Article 50bis

Where it was appropriate to give a notice under Article 50bis, the examiner shall consider whether the amendment made in response to the notice of reasons for refusal given along with the notice under Article 50bis complies with the provisions of Article 17bis(3) to (6). If the amendment is found to be in violation of any of these provisions, the examiner shall decide to dismiss it (Article 53).

**(Point to Consider)**

Where it was appropriate to give a notice under Article 50bis as of giving a notice under Article 50bis, any amendment subsequently made to the application concerned must comply with the provisions of Article 17bis(3) to (6). This applies even if, due to the amendment, the application concerned no longer meets the substantive requirements for division of application and therefore the application concerned and the other patent application are no longer deemed to have been filed simultaneously.

The same shall apply where the other patent application no longer meets the substantive requirements for division of application and therefore the application concerned and the other patent application are no longer deemed to have been filed simultaneously,

due to any amendment made to the other patent application after a notice under Article 50bis was given to the application concerned.

The determination on an amendment, the approach to an application where an amendment is dismissed, and the approach to an application where an amendment is accepted shall be subject to the respective provisions of 6.2, 6.3, 6.4 in Section 2 of “Part IX Procedure of Examination” replacing the phrase “final notice of reasons for refusal” with “first notice of reasons for refusal given along with a notice under Article 50bis.”

Where an additional reason for refusal is notified by following 6.3 (3) or 6.4 (3) in Section 2 of “Part IX Procedure of Examination,” the examiner shall consider whether or not to give a notice under Article 50bis by following “4.1 Examination When Giving a Notice Under Article 50bis.”

(2) Where it was inappropriate to give a notice under Article 50bis

Where it was inappropriate to give a notice under Article 50bis, Article 53 cannot be applied. Therefore, the examiner shall not make a decision to dismiss the amendment but accept it. Even where the application after the amendment is unable to overcome the reason for refusal stated in the previous notice, the examiner shall not immediately make a decision of refusal but give the “first notice of reasons for refusal” again. Also, even when notifying only additional reasons for refusal caused by the amendment, the examiner shall give the “first notice of reasons for refusal” instead of the “final notice of reasons for refusal.” Furthermore, even when notifying the same reason for refusal as the reason stated in a notice of reasons for refusal given to the other patent application, the examiner shall not give a notice under Article 50bis.

**(Point to Consider)**

However, where the applicant asserts that the notice under Article 50bis should not have been given on the grounds that the reason for refusal of the application concerned is not the same as the reason for refusal of the other patent application, and it is found that it made the amendment based on such an assertion, the notice under Article 50 shall be deemed to have never been given. It follows that if the amendment is unable to overcome the reason for refusal, the examiner shall make a decision of refusal, and if the amendment has caused an additional reason for refusal, the examiner shall give the “final notice of reasons for refusal” to notify only such an additional reason for refusal. Furthermore, when notifying the same reason for refusal as the reason stated in the notice of reasons for refusal given to the other patent application, the examiner shall also give a notice under Article 50bis.

**4.2.2 Where the Notice of reasons for Refusal Is the “Final Notice of reasons for Refusal”**

Where an amendment is made in response to the “final notice of reasons for refusal” given along with a notice under Article 50bis, the examiner shall reconsider whether or not it was appropriate to give a notice under Article 50bis and to give the “final notice of reasons for refusal,” while taking into account the applicant’s assertion stated in the written opinion. (See the note in 4.2.1.)

Whether it was appropriate to give a notice under Article 50bis shall be determined by following “4.2.1 Where the Notice of reasons for Refusal Is the “First Notice of reasons for Refusal”.”

Whether it was appropriate to give the “final notice of reasons for refusal” shall be determined by following “Part IX Procedure of Examination, 4.3.3.1.”

(1) Where it was appropriate at least either to give a notice under Article 50bis or to give the “final notice of reasons for refusal”

Where it was appropriate at least either to give a notice under Article 50bis or to give the “final notice of reasons for refusal,” the examiner shall consider whether the amendment made in response to the notice of reasons for refusal given along with the notice under Article 50bis complies with the provisions of Article 17bis(3) to (6). If the amendment is found to be in violation of any of these provisions, the examiner shall decide the dismissal of amendment (Article 53).

Where it was appropriate at least either to give a notice under Article 50bis or to give the “final notice of reasons for refusal,” the determination on an amendment, the approach to an application where an amendment is dismissed, and the approach to an application where an amendment is accepted shall be subject to the respective provisions of 6.2, 6.3, 6.4 in Section 2 of “Part IX Procedure of Examination” replacing the phrase “final notice of reasons for refusal” with “final notice of reasons for refusal given along with a notice under Article 50bis.”

Where an additional reason for refusal is notified by following 6.3 (3) or 6.4 (3) in Section 2 of “Part IX Procedure of Examination,” the examiner shall consider whether or not to give the “final notice of reasons for refusal,” and shall also consider whether or not to give a notice under Article 50bis along with the notice of reasons for refusal by following “4.1 Examination When Giving a Notice Under Article 50bis.”

(2) Where it was inappropriate both to give a notice under Article 50bis and to give the “final notice of reasons for refusal”

Where it was inappropriate both to give a notice under Article 50bis and to give the “final notice of reasons for refusal,” Article 53 cannot be applied. Therefore, the examiner shall not decide the dismissal of amendment but accept it. Even where the application as amended is unable to overcome the reason for refusal stated in the previous notice, the examiner shall not immediately make a decision of refusal but give the “first notice of reasons for refusal” again. Also, even when notifying only additional reasons for refusal caused by the amendment, the examiner shall give the “first notice of reasons for refusal” instead of the “final notice of reasons for refusal.” Furthermore, even notifying the same reason for refusal as the reason stated in a notice of reasons for refusal given to the other patent application, the examiner shall not give a notice under Article 50bis.

**(Point to Consider)**

However, where the applicant asserts that the notice under Article 50bis should not have been given on the grounds that the reason for refusal of the application concerned is not the same as that of the other patent application and also asserts that the “first notice of reasons for refusal” should have been given, and it is found that it made the amendment

based on such an assertion, the notice under Article 50bis shall be deemed to have never been given, and the notice of reasons for refusal actually given shall be deemed to be the “first notice of reasons for refusal.” It follows that if the amendment is unable to overcome the reason for refusal, the examiner shall make a decision of refusal, and if the amendment has caused an additional reason for refusal, the examiner shall give the “final notice of reasons for refusal” to notify only such an additional reason for refusal. Furthermore, when notifying the same reason for refusal as the reason stated in the notice of reasons for refusal given to the other patent application, the examiner shall also give a notice under Article 50bis.