

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

Chapter 3 Patent Application Based on Utility Model Registration

Patent Act Article 46bis

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

- (i) where 3 years have lapsed from the date of filing of an application for the said utility model registration;
- (ii) where a petition requesting the examiner's technical opinion as to the registrability of the utility model claimed in the utility model registration application or of the utility model registration, in the following paragraph simply referred to as "utility model technical opinion" , is filed by the applicant of the utility model registration or the utility model right holder;
- (iii) where 30 days have lapsed from the date of receipt of initial notice under Article 13(2) of the Utility Model Act pertaining to a petition requesting the utility model technical opinion on the application for the utility model registration, or on the utility model registration filed by a person who is neither the applicant of the said utility model registration nor the said holder of Utility Model right;
- (iv) where the time limit initially designated under Article 39(1) of the Utility Model Act for a utility model registration invalidation trial filed against the said utility model registration under Article 37(1) of the Utility Model Act has expired.

(2) A patent application under the preceding paragraph shall be deemed to have been filed at the time of filing of the application for the said utility model registration, provided that matters stated in the description, scope of claims or drawings attached to the application in the said patent application are within the scope of the matters stated in the description, scope of claims or drawings attached to the application in the said utility model registration application on which the said patent application is based; provided, however, that this shall not apply for the purpose of application of Article 29bis of the Patent Act or Article 3bis of the Utility Model Act, where the patent application falls under another patent application under the said Article of the Patent Act or the patent application under the said Article of the Utility Model Act, or for the purpose of application of Articles 30(3), the proviso to 36bis(2)proviso and 48ter(2).

(3) Notwithstanding item (i) or (iii) of paragraph (1), where, due to reasons beyond the control of the applicant for a patent under paragraph (1), the applicant is unable to file an application for a patent within the time limit as provided in the said item, the applicant may file a patent application within 14 days (where overseas resident, within two months) from the date on which the reasons ceased to be applicable, but not later than six months following the expiration of the time limit as provided in the said item.

(4) Where there is an exclusive licensee, a pledgee or, in the case where Article 35(1) of the Patent Act as applied under Article 11(3) of the Utility Model Act or Article 77(4) of the Patent Act as applied under Article 18(3) of the Utility Model Act or Article 19(1) of the Utility Model Act is applicable, a non-exclusive licensee, the holder of a utility model right may file

a patent application under paragraph (1), provided that the consent of the said exclusive licensee, pledgee or non-exclusive licensee is obtained.

(5) Articles 44(3) and 44(4) shall apply mutatis mutandis to the case where a patent application is filed under paragraph (1).

1. Purport of the provisions for patent applications based on utility model registration

Although an application for utility model registration is permitted to be converted to a patent application, the application for utility model registration is registered without going through substantive examination. Therefore, the period in which an application can be actually converted is very short. Patent application based on that registration is permitted after the utility model registration under certain requirements, because opportunities for conversion are limited even if one wishes to convert to a patent due to changes in the technical trend.

2. Requirements for patent applications based on the utility model registration

2.1 Formal Requirements

2.1.1 Persons who may file applications for patent based on utility model registration

An owner of utility model right may file a patent application based on utility model registration (Article 46bis (1)).

However, the owner of utility model right has to obtain consent of an exclusive licensee, a pledgee, or a non-exclusive licensee, if any.

2.1.2 Time Requirements

A patent application based on utility model registration can be filed except for the following cases.

- (1) where 3 years have lapsed from the date of filing of an application for the said utility model registration. (Article 46bis(1) (i))
- (2) where a petition requesting the examiner's technical opinion as to the registrability of the utility model is filed by the applicant of the utility model registration or the utility model right holder. (Article 46bis(1) (ii)).
- (3) where 30 days have lapsed from the date of receipt of initial notice pertaining to a petition requesting the utility model technical opinion by a person who is neither the applicant of the said utility model registration nor the said holder of Utility Model right. (Article 46bis(1) (iii)).
- (4) where the time limit initially designated for a utility model registration invalidation trial filed against the said utility model registration has expired. (Article 46bis(1) (iv)).

2.1.3 Abandonment of utility model right

Where a patent application is filed based on utility model registration, that utility model right must be abandoned (Article 46bis (1), Regulations 27(6)).

2.2 Substantive Requirements

In order for a patent application based on utility model registration to be deemed to have been filed at the time of application for the utility model registration of the registration, the following two substantive requirements must be met.

- (1) Matters described in the description, claims or drawings attached to the patent application shall

be within the scope of matters described in the description, claims of utility model or drawings attached to the request for utility model registration on which the said patent application is based (Article 46bis(2)).

- (2) Matters described in the description, claims or drawings attached to the patent application shall be within the scope of matters described in the description, claims of utility model or drawings as of the filing of the application for utility model registration of the utility model registration on which the said patent application is based.

Determination of whether or not matters described in the description, claims or drawings attached to the patent application are within the scope of matters described in “the description, claims of utility model or drawings attached to the request for utility model registration” or “the description, claims of utility model or drawings as of the filing of the application for utility model registration” will be made in the same way as determination on new matter (regarding determination on new matter, refer to “Part III Section I New Matter”).

In the requirement (1), where a correction is made to the description, claims of utility model or drawings after the utility model registration, the description, claims of utility model or drawings “after the correction” shall be the description, claims of utility model or drawings attached to the request for utility model registration.

(Explanation)

Considering the effect as stipulated in Article 46bis(2), that is, a patent application based on utility model registration of the utility model registration is deemed to have been filed at the time of filing of the application for utility model registration, the requirement (2) as well as the requirement (1) above have to be met.

3. Other Remarks

3.1 The Proviso of Patent Act Article 46bis(2)

A patent application based on utility model registration which meets “2. Requirements for Patent Application Based on Utility Model Registration” is deemed to have been filed at the time of filing of the application for utility model registration (Article 46bis(2)). However, it is dealt as if it has been filed at the actual time of filing in the following cases (the proviso of Article 46bis(2)).

- (1) Application as “Another patent application” as stipulated in the Patent Act Article 29-2 or “Patent Application” as stipulated in the Utility Model Act Article 3-2.
(2) Application of the stipulations of Article 30(3), Article 36bis(2), Article 41(4), Article 43(1) and Article 48ter(2).

3.2 Relationship between claimed invention of patent application based on utility model registration and claimed device of the based utility model registration on which the patent application is based

A patent application based on utility model registration shall not be reasons for refusal stipulated in Article 39(4) of the Patent Act even if the claimed invention of patent application based on utility model registration is identical to the claimed device of utility model registration (remarks in the bracket of Article 39(4) of the Patent Act).