

**61-10 P D T****Handling of Cases When an Application Is Converted After, or  
at the Same Time, a Request for Appeal Against Examiner's  
Decision of Refusal Is Filed**

When after filing an appeal against examiner's decision of refusal within the statutory period and a converting an application (for example, in a case where a patent application is converted into a utility model application), it is handled that there is a lawful conversion of the application and at the same time the application for said appeal case is deemed to be withdrawn.

The same applies when an appeal against examiner's decision of refusal is filed within the statutory period and a conversion of application is filed on the same day.

(Handling of a request for appeal when an application is withdrawn. →61-05 9.)

**1. When an Application Is Converted After Filing an Appeal Against Examiner's Decision of Refusal**

There is a court precedent for handling of this case ((1959 (Gyo-na) 61) Judgment of Tokyo High Curt, Sept 15, 1960).

This court precedent is related to a conversion of application under Old Utility Model Act Article 5, if a decision indicated therein applies to the current law, it is roughly as follows.

**(1) Possibility of conversion of application after requesting an appeal**

According to Utility Model Act Article 10, when a patent application is converted to a utility model application, for obtaining a benefit regarding the priority of the application date provided in Utility Model Act Article 10(3),

it is apparent that it is required the conversion of application should be made within the statutory period.

However, the law does not provide any other requirements, for example, when an appeal is filed against a decision of refusal, it does not stipulate any matters that may be conducted only after conclusion of the appeal procedures. Substantially, even if an appeal, claim rights of the original application such as a right for obtaining a patent is a purpose (a subject) of the proceedings, and it is not essentially different from the original application, and therefore it should be interpreted whether an appeal is pending or not does not give any effect on the possibility of conversion of application under Utility Model Act Article 10.

Then, a conversion of application filed within the statutory period from the date on which a certified copy of a decision of refusal is served is lawful and valid regardless of filing an appeal.

(2) Possibility of coexistence of an application of utility model registration and a request for appeal

The question is what will happen to the appeal according to (1), or whether they may coexist, but there are no regulations in the law whether both should coexist. However, Utility Model Act Article 10(5) states “when a conversion of application is filed under the provision of paragraph (1) or (2), the patent application or the application of design registration is deemed to be withdrawn.” Thus, a patent application with respect to an appeal is deemed to be withdrawn, and it is interpreted that the legal matters related to said patent application is extinguished. Therefore, it is interpreted that the appeal naturally ends due to a loss of a subject of appeal and only an application of utility model registration after conversion of application remains.

2. When an Application Is Converted in Filing an Appeal Against Examiner’s Decision of Refusal

In this case, see (1964 (Gyo-ke) 52) Judgement of Tokyo High Court, Nov 10, 1964.

This court precedent has the same effect as an item 1.

(Revised Feb 2015)