

Current Practice on Divisional Application Under the Revision of 2006 and 2008

1. Summary

The revised Japanese Patent Law of 2006 and 2008 for Divisional Application became effective from April 1, 2007 and April 1, 2009, respectively. The revision of 2006 is applicable only to applications filed on or after April 1, 2007 and is not applied to divisional applications whose parent application (including International Application) was filed on or before March 31, 2007. The revision of 2008 is applicable only to applications in which a final decision has been issued on or after April 1, 2009.

There are two main points in these revisions.

- (1) Applicants are given more opportunities to file a divisional application (Article 44 (1) of Japanese Patent Law).
- (2) An additional limitation is imposed on amendments to be filed in response to an office action (Article 17-2 (5), Article 50-2 of Japanese Patent Law).

The explanation discussed below is applicable to applications filed under the Revision of 2008.

2. Opportunities for Divisional Application

Please refer to Table 1 and FIG.1 which illustrate the following (1) – (5).

2.1. A divisional application can be filed:

- (1) at anytime prior to the first office action,
- (2) while there is an outstanding office action (final or non final),
- (3) at the time of filing an appeal and within 4 months from the issue date that is on or after April 1, 2009.

2.2. In the case of the Revision of 2006, in addition to the above opportunities, a

divisional application can further be filed (Article 44 (1));

(4) within 4 months from the first notification of the final decision of rejection, even if the applicant does not file an appeal,

(5) within 30 days from the Notice of Allowance and prior to the issuance of a patent.

【Table 1】

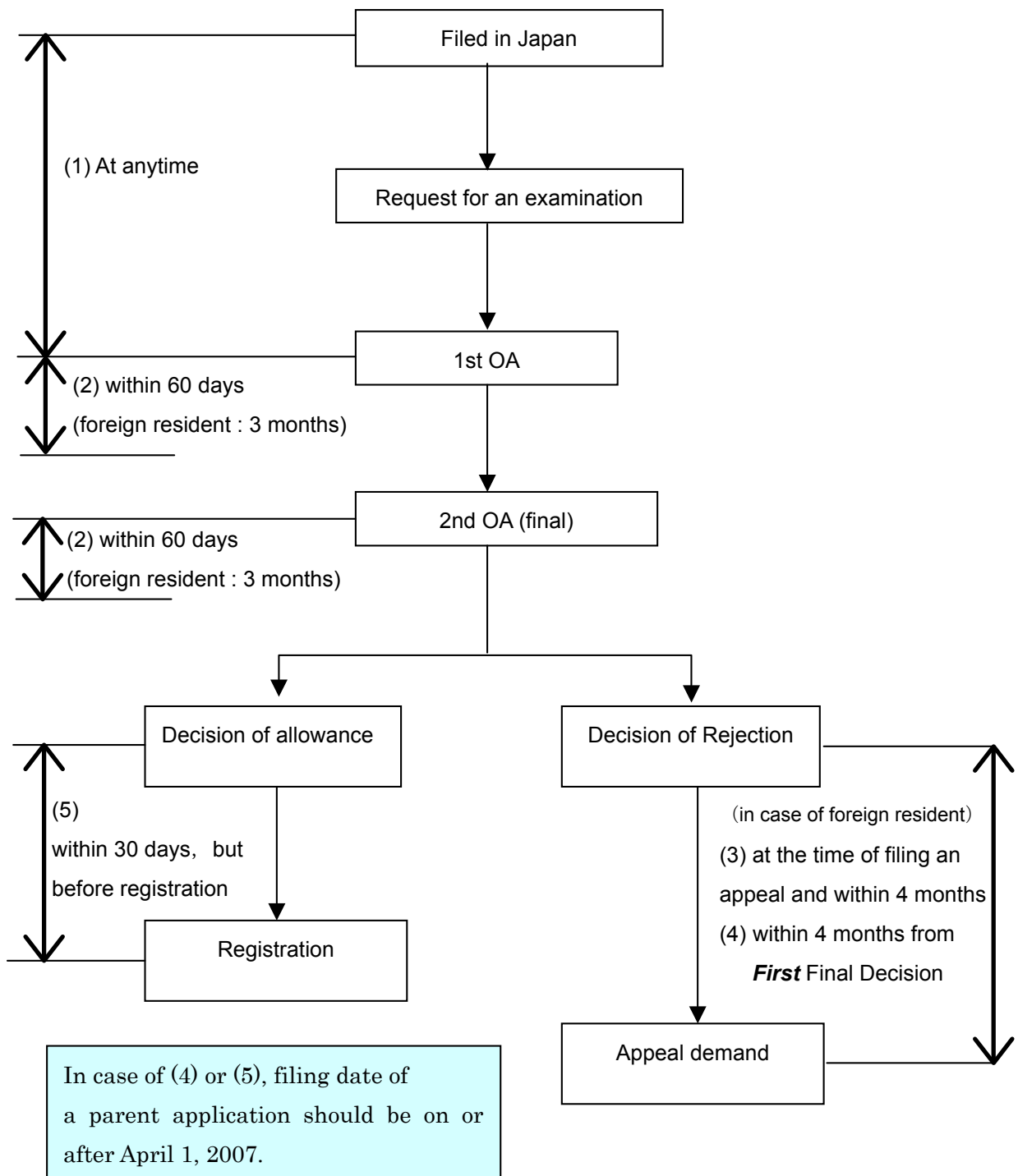
	Official Notice	Applications filed on/before March 31, 2007	Applications filed on/after April 1, 2007
Before Final Decision		Divisional applications can be filed; (1) at anytime prior to the first office action, (2) while there is an outstanding office action(final or non final).	
Issued on/after April 1, 2009.	Final Decision of rejection	Divisional applications can be filed; (3) at the time of filing an appeal and within 4 months from the issue date of Final decision of rejection*.	
		Not approved.	Divisional applications can be filed; (4) within 4 months from the issue date of First Final decision of rejection, without filing an appeal.*
	Allowance	Not approved.	Divisional applications can be filed; (5) within 30 days from the date of issuing Allowance.**

* As of April 1, 2009, an applicant (foreign resident) can file an appeal against the final decision of rejection within 4 months from the issue date. **Please note that if the applicant desires to file an amendment at the time of appeal, the amendment has to be filed together with the appeal, not within 30 days from the filing date of an appeal.**

** Divisional applications can be filed within **30 days** from the date of issuing Allowance **but prior to the issuance of a patent.** Another 30days period is given in addition to the period set forth in the above (5), when the 30 days period for payment of issue fees is extended by the request.

【FIG.1】

Possible Opportunities for divisional application



3. Additional limitation to claim amendment

Although there is more opportunities to file a divisional application, attention should be paid to additional limitations imposed on claim amendments in a divisional application. The additional limitations are applicable to a divisional application **filed on or after April 1, 2007**. The limitations are not applicable to a divisional application derived from a parent application filed on or before March 31, 2007.

The same limitations that are applicable to applications under final office action are imposed on an amendment to a divisional application, if a divisional application has the same reason for rejection as the parent application (Article 50-2). This practice is similar to MPEP 706.07(b).

More specifically, claim amendments are permitted only for the following purposes:

- (a) cancellation of the claim(s),
- (b) limiting the scope of the claim(s),
- (c) correcting typographical errors, or
- (d) clarifying an ambiguous description

For example, when an Official Notice of Final Decision of Rejection has been issued, a broader claim scope is permitted by filing a divisional application. However, the amended claims of the divisional application should be responsive to all reasons for Rejection issued in the parent application. More simply said, the divisional application should not be filed with the identical claims which had been rejected in the parent application. If an Examiner of the divisional application finds that the same Reasons for rejection which were issued in the parent application can be applied to the claims of the divisional application, a first Official Notice of Rejection for the divisional application can be a Final Official Notice. (Article 50-2) This means that the limitations on claim amendments, discussed above, can be immediately applied to the first response.

In short, when filing a divisional application with claims identical to those of the parent application, you have to file a voluntary claim amendment preferably when filing a request for examination of a divisional application, but at the latest by the time the actual examination for the divisional application starts.

(Reference)

MPEP 706.07(b) Final Rejection, When Proper on First Action [R-1]

The claims of a new application may be finally rejected in the first Office action in those situations where (A) the new application is a continuing application of, or a substitute for, an earlier application, and (B) all claims of the new application (1) are drawn to the same invention claimed in the earlier application, and (2) would have been properly finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application.

Hirokazu FUJIWARA
Katsuhide AKAZAWA