

# Revised Japanese Patent Law

Brief overview of practical changes  
effective from April 1, 2007

# Revised Japanese Patent Law

- Increased opportunities for filing a divisional application
- Additional limitation for claim amendment of a divisional application
- Prohibition of a shift amendment
- Revised Examination Guidelines for unity of applications

# Increased opportunities for a divisional application

- You can file a divisional application after receiving a Notice of Rejection without demanding an appeal trial.
- You can file a divisional application even after receiving a Notice of Allowance within 30 days from the service of Notice of allowance and prior to registration

# Increased opportunities for a divisional application

- Applied to applications filed on and after April 1, 2007
- A divisional application derived from a parent application filed before April 1, 2007

--> **Not Applied**

# Increased opportunities for a divisional application

- Decision to grant a patent  
After the decision, you can file a divisional application.  
We will ask you whether you need to file a divisional application
- Decision of Rejection  
You have 3 options
  1. appeal
  2. appeal and divisional application in parallel
  3. divisional application without filing an appeal (New!)

# Revised Japanese Patent Law

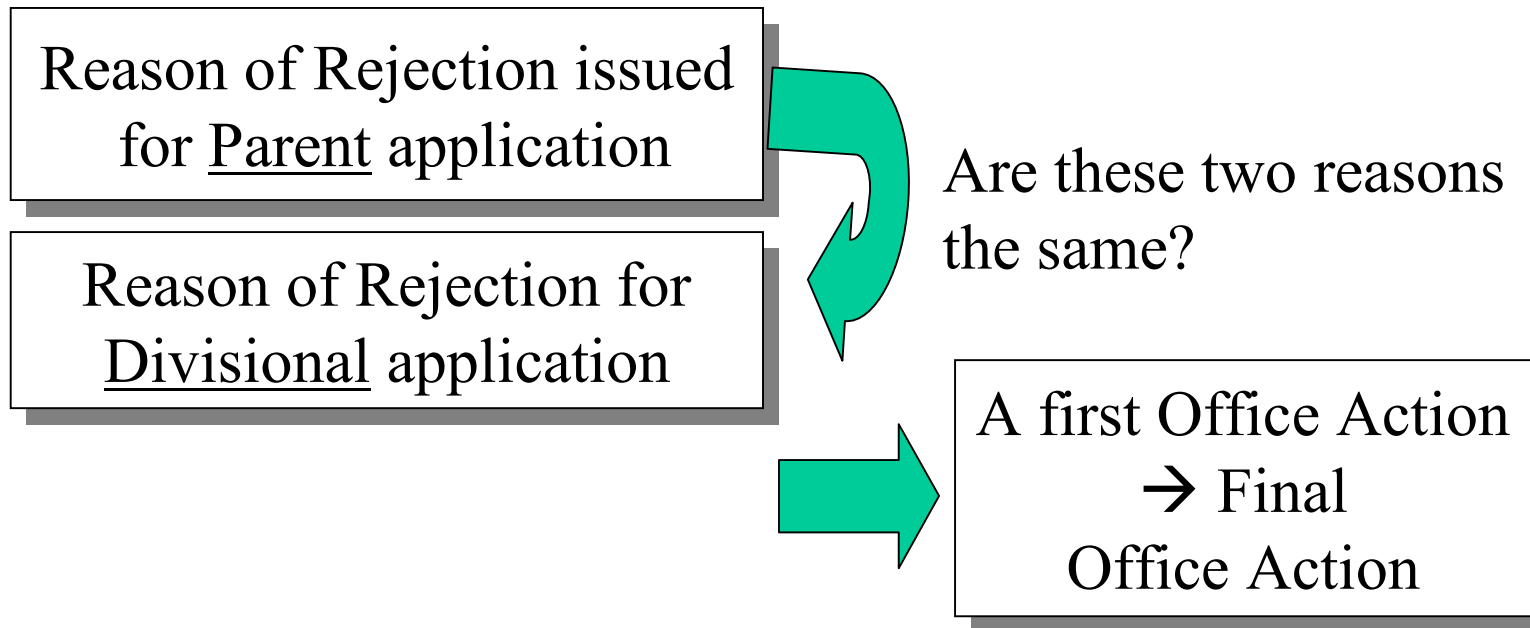
- Increased opportunities for filing a divisional application
- ➡ Additional limitation to claim amendment of a divisional application
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# Additional limitation to claim amendment

- A first Office Action can be a final Office Action
- Additional limitation to claim amendment is imposed on a divisional application
- The limitation is the same as that applied to a final Office Action
- Applied to applications filed on and after April 1, 2007

# Additional limitation to claim amendment

In which case is a claim amendment of the divisional application limited?



# Additional limitation to claim amendment

- How are the so-called “same reasons” determined?

	Claims of divisional application	Same reason?
1	Exactly the same claims	Yes
2	Addition of conventional art or well-known art to the original claims, without new effect or advantages (lack of inventive step)	Yes
3	Examiner needs to cite new reference for rejection based on lack of inventive step	No, the additional limitation is not applied

# Additional limitation to claim amendment

4 types of amendment are allowed

- Canceling the claims
- Limiting the scope of the claims
- Correction of typographical errors
- Clarifying an ambiguous description

Note: The limitation above has been applied to amendment for a final office action

# Additional limitation to claim amendment

- You should attend to rejection reasons for the parent application upon filing a divisional application
- or
- You should file a voluntary amendment at the latest by the time when actual examination of the divisional application starts.

average waiting period from the date of requesting a substantial examination is 26 months (actual in 2005 by the JPO)

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- Additional limitation to claim amendment of a divisional application
- ➔ Prohibition of a shift amendment
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# Prohibition of a shift amendment

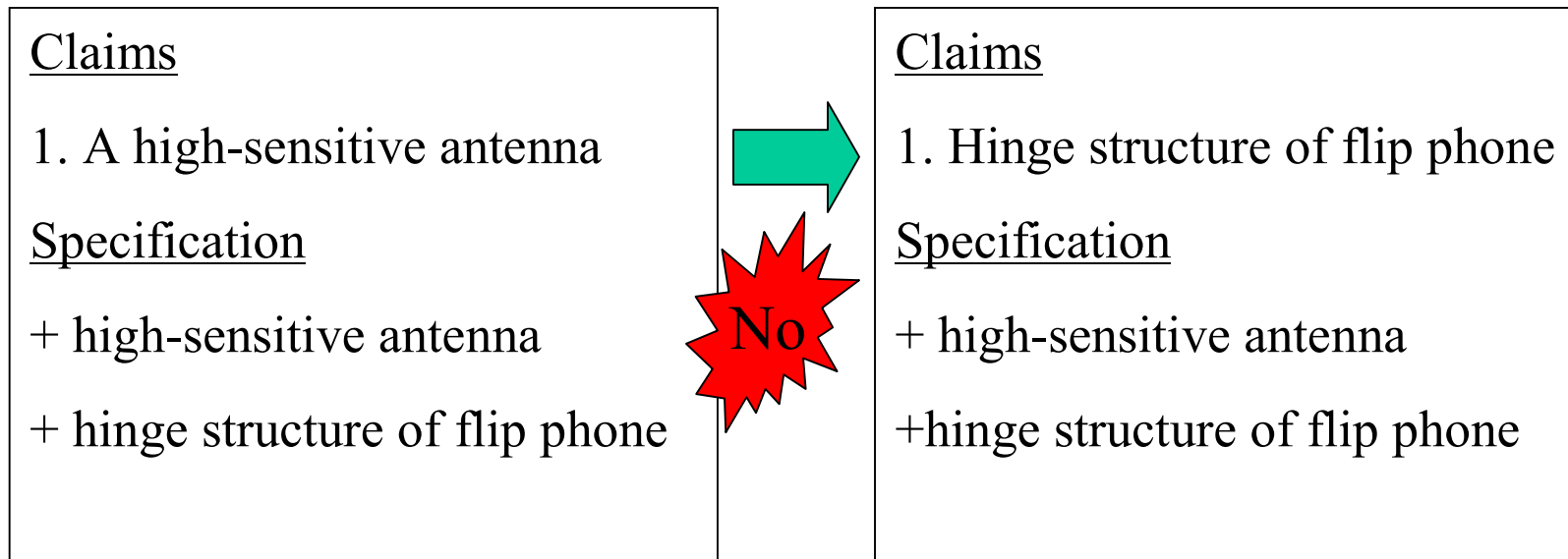
- New Article 17-2 (4)

An amendment shall be made so that the present invention whose patentability has been already examined before the amendment and the amended invention shall fulfill the requirement of the unity of invention

Note: “shift amendment” is not a legal term. The above clause is not a literal translation of original Japanese prescription.

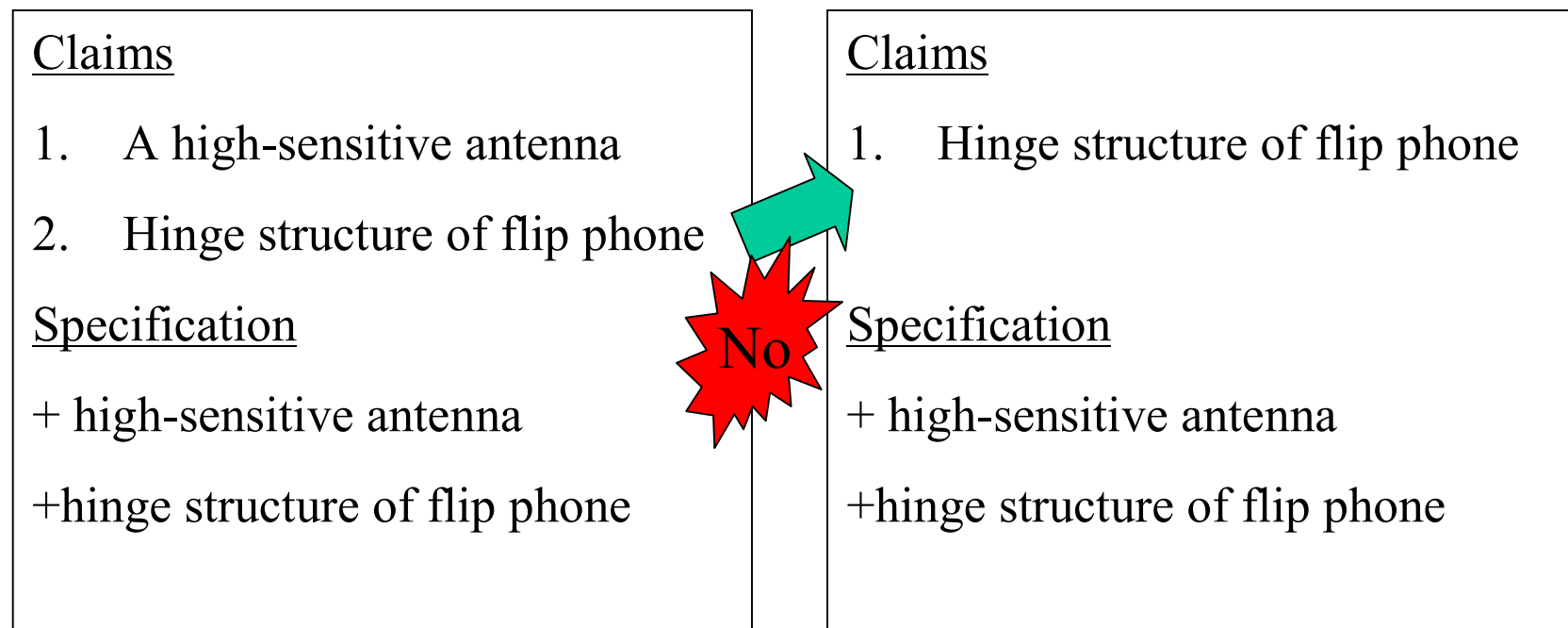
# Prohibition of a shift amendment

- Example 1



# Prohibition of a shift amendment

- Example 2

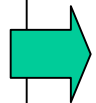


# Prohibition of a shift amendment

- Shift amendment → only Rejection reason (not grounds for invalidation)
- You are forced to file a divisional application.
- You are advised to number the claims in the order of invention which you really want to be patented.
- The more claims are examined, the wider scope of the claim amendment you obtain. → The scope of the claim amendment can depend on the practice of requirement for unity of inventions.

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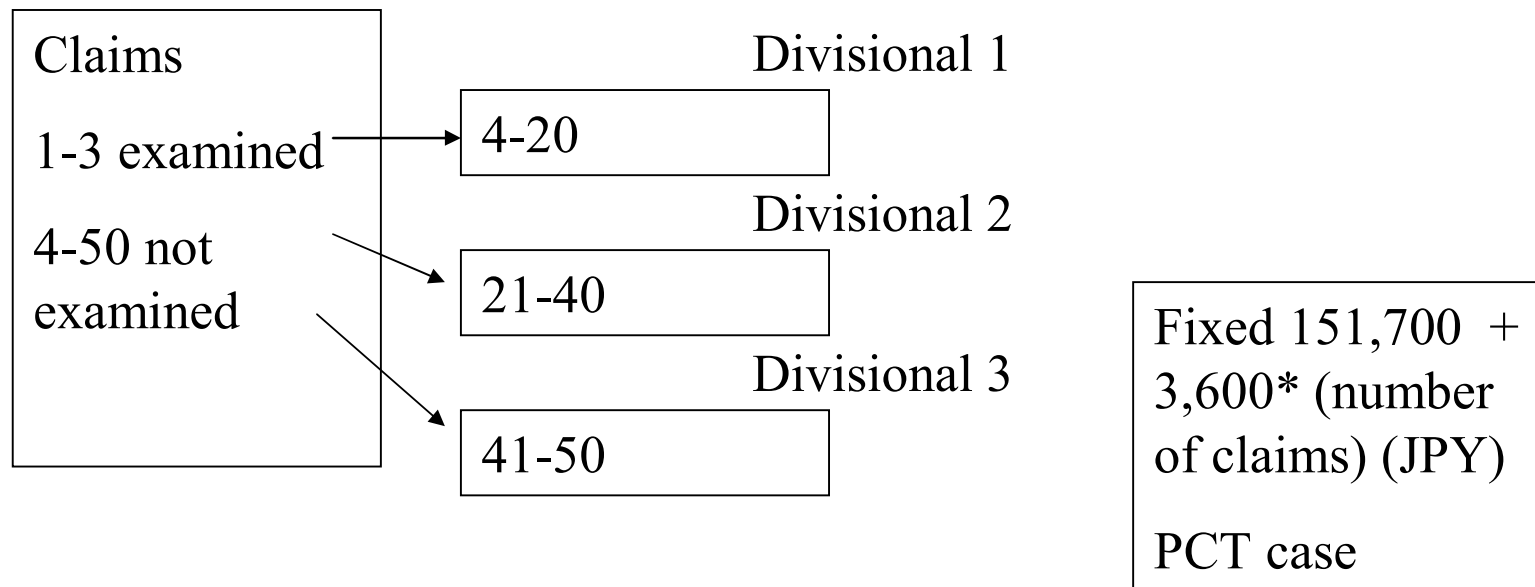
**Revised Examination Guidelines for unity of applications**

# Revised Examination Guidelines for unity of applications

- Requirement of unity of invention is almost the same as that of the PCT.
- Examination Guidelines are updated with new examples. However, the Examination Guidelines are not law. The practice is considerably left on the Examiner's discretion.
- Please remember the fact that you should pay official fee for requesting a substantive examination, even claims are not examined at all. Merging the applications is not necessarily effective to reduce total cost.
- Applied to all applications from April 1, 2007

# Revised Examination Guidelines for unity of applications

- You have to pay almost double official fee for requesting a substantive examination.



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Thank you