

# Recent Changes in Japanese Patent Practice



**PAK/JPAA Closed meeting in  
Tokyo**

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# Recent Changes in Japanese Patent Practice

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**Japanese Patent Practice was changed on April 1, 2007 and on April 1, 2009.**

**The major changes are related to:**

- 1. Appeal to Appeal Board;**
- 2. Divisional Application;**
- 3. Amendment to Specification;**
- 4. Foreign Language Application; and**
- 5. Fee Payment for Request for Substantial Examination.**

# 1. Appeal to Appeal Board

2008 Revision of Patent Law

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**Time periods for a Notice of Appeal and an accompanying Amendment to a Specification have been changed.**

**-- The new periods are applied to an Examiner's Decision of Rejection received on or after April 1, 2009.**

**(before April 1, 2009)**

**(on or after April 1, 2009)**

**Examiner's Decision  
of Rejection**



**30 days  
+60 days ex-officio extension**



**Notice of Appeal**



**30 days**



**Amendment to Specification**

**Examiner's Decision  
of Rejection**



**3 months  
+1 month ex-officio extension**



**Notice of Appeal**



**the same time**



**Amendment to Specification**

## 2. Divisional Application (1)

No change in Patent Law

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**(1) An applicant can file a Divisional Patent Application during time periods for submission of Amendments.**

**The periods are:**

- (i) a period from the filing date to an examiner's Notification of Reasons for Rejection;**
- (ii) a period for response to an examiner's Notification of Reasons for Rejection;**
- (iii) a period for responding to an examiner's Notification of Lack of Information on prior art documents; and**
- (iv) a time of or a period following appeal to the Appeal Board (see “2. Appeal to Appeal Board”).**

**--In case (1), the Divisional Application should not include new matter beyond its Original Application as filed.**

## 2. Divisional Application (2)

2006 & 2008 Revision of Patent Law

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**(2) For an Original Patent Application filed on or after April 1, 2007, further periods are given for filing its Divisional Application as follows.**

- **For an Examiner's Decision received before April 1, 2009;**
    - **Within 30 days from a Decision of Allowance.**
      - **30-day Extension is given by petition.**
    - **Within 90 days from the first Decision of Rejection.**  
**(without appeal to Appeal Board)**
  
  - **For an Examiner's Decision received on or after April 1, 2009;**
    - **Within 30 days from a Decision of Allowance.**
      - **30-day Extension is given by petition.**
    - **Within 4 months from the first Decision of Rejection.**  
**(without appeal to Appeal Board)**
- In case (2), the Divisional Application should not include a new matter beyond its Original Application either as filed or immediately before division.**

# 3. Amendment to Specification (1)

2008 Revision of Patent Law

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**(1) For an application filed on or after April 1, 2007, such an amendment (“shift amendment”) that replaces a claimed invention with another one beyond the Unity of Invention after receiving a Notification of Reasons for Rejection is prohibited.**

**-- The “shift amendment” constitutes a reason for rejection.**

**--(Ref.) Unity of Invention is fulfilled by such inventions sharing the same or corresponding particular technical characteristic exhibiting a contribution to prior art as to form a single general inventive concept. (from Rule § 25<sup>octies</sup>)**

# 3. Amendment to Specification (2)

2008 Revision of Patent Law

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**(2) For a Divisional Application, an examiner's first Notification of Reasons for Rejection is the Final N. R. R. if the reasons for rejection already notified against its Original Application have not been eliminated.**

- The amendment responding to the Final Notification of Reasons for Rejection is more restrictive than to the First one.**
- If the amendment does not comply with the restriction, the examiner shall decline the amendment.**
- This new practice applies to an Original Application filed on or after April 1, 2007.**

# 4. Foreign Language Patent Application

2008 Revision of Patent Law

**A new time period for submitting Translation is applied to a Foreign Language Patent Application filed on or after April 1, 2007.**

**(before April 1, 2007)**

**Filing date of Foreign  
Language Patent Application**



**2 months**



**Submission of Translation**

**(on or after April 1, 2007)**

**Priority date of Foreign  
Language Patent Application**



**1 year and 2 months**



**Submission of Translation**



# 5. Fee Payment for Request for Substantial Examination (1)

Change in JPO's Practice without change in Patent Law

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**Fee Payment for a Request for Examination can be postponed.**

**-- This postponement applies to the Request for Examination submitted by an Applicant on or after April 1, 2009.**

**(before April 1, 2009)**

**Submission of Request  
for Examination**



**the same time**



**Paying fee for the Request**

**(on or after April 1, 2009)**

**Submission of Request  
for Examination**



**1 year**



**Paying fee for the Request**

# 5. Fee Payment for Request for Substantial Examination (2)

Change in JPO's Practice without change in Patent Law

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- Overseas applicants also can enjoy this postponement.**
- To enjoy the postponement, the applicant has to indicate its intension to do so in the Request for Examination.**
- Note that the applicant should submit the Request for Examination within 3 years after the Filing Date as before whether it intends to enjoy the postponement or not.**
- The postponement of the payment has no effect on the examination queue.**
- This new practice is introduced in view of the current economic recession, and therefore planed to be effective only for two years from April 1, 2009.**