

Meeting of US Patent Bar/JPO Liaison Council, October 15th, 2007

Revision of the Patent Act

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Revision of the Patent Act

■ Outline of Revision of Patent Act (as in force from April 1, 2007)

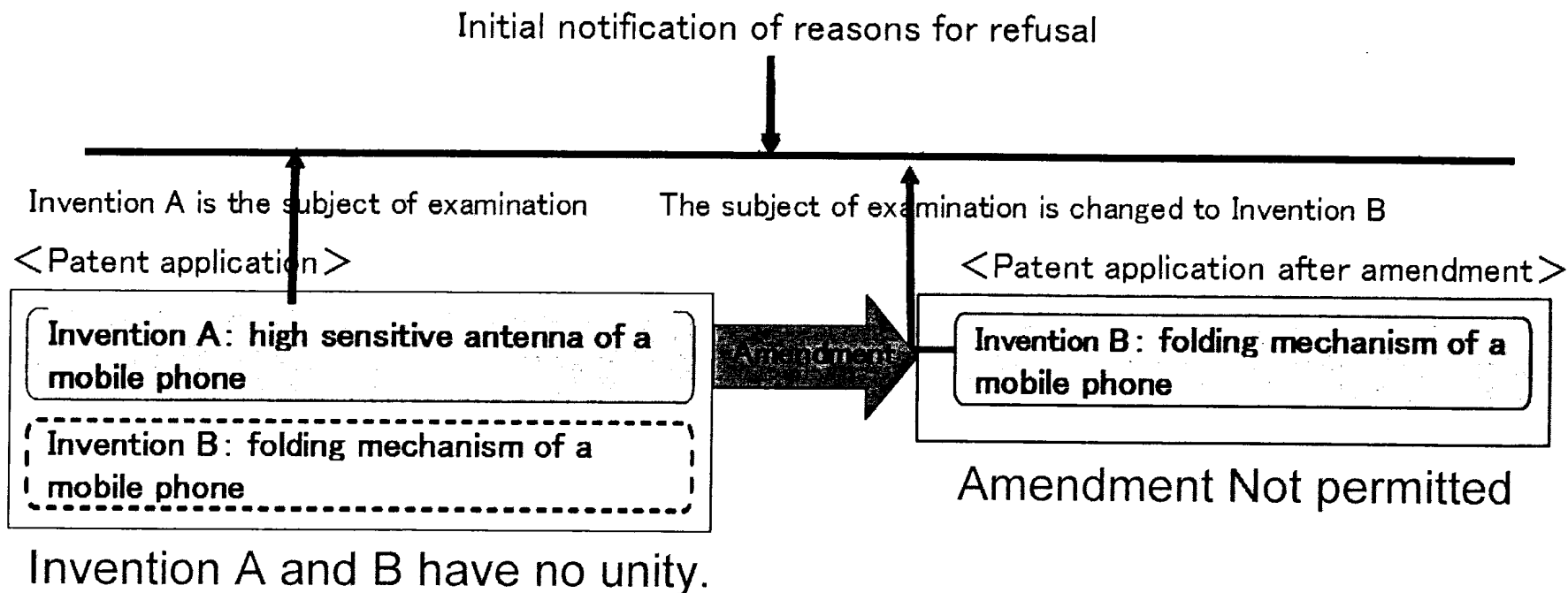
- **Change of the Amendment Rule**
(Article 17-2 (4) of the Patent Act)
- **Change of the Divisional Application System**
(Article 44, 50-2 of the Patent Act)
- **Change of the Time Limit for Submitting Japanese Translation Documents**
(Article 36-2 (2) of the Patent Act)

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- **Change of the Amendment Rule**

(Article 17-2 (4) of the Patent Act)

After a notice of reasons for refusal is received, it is prohibited to amend claims so as to change the subject matters of claimed inventions to different inventions with different technical features.

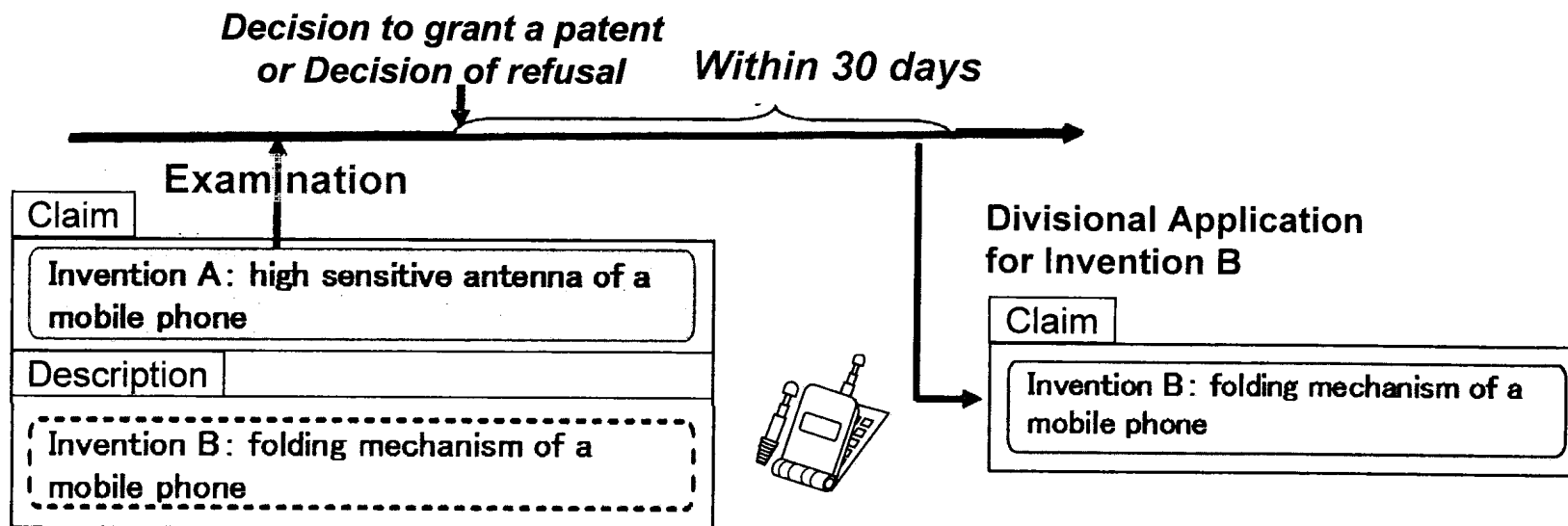


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- **Change of the Divisional Application System**
(Article 44 and 50-2 of the Patent Act)

- ***Period of Divisional Application***

It became possible for applicants to divide an application and file a divisional application also within 30 days from the decision to grant a patent or the decision of refusal.



- ***"First Action is Final" Rule***

When the reason for refusal notified for a divisional application is the same reason that was notified for the original application, the notice of the reasons for refusal of the divisional application becomes "*Final Action*" (Final notice of reasons for refusal).

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- **Change of the Time Limit for Submitting Japanese Translation Documents**
(Article 36-2 (2) of the Patent Act)

The time limit to submit the Japanese translation of an application filed in English language has been changed to 1 year and 2 months from the filing date (from the priority date for an application filed with a priority claim).

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■ Entry into Force & Transitional Arrangement

The revised provisions entered into force on April 1, 2007, and apply to applications whose filing date is on or after that date.

As for division of application, the revised provisions apply to new applications which are divided from an original application whose filing date is on or after that date.

→ In the future, applications to which the revised provisions apply will be examined increasingly.

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■ Points to Notice

In order to avoid restriction of amendment ...

- ▶ Define the claimed inventions appropriately so as to satisfy the requirement for unity of invention
 - Conduct prior art search sufficiently prior to filing an patent application
 - Make sure that the common technical feature of claimed inventions is novel over the prior art

- ▶ Look over the reasons for refusal of an original application in advance of the filing of the divisional application, and define the claimed inventions of the divisional application appropriately so as to resolve the reasons for refusal of the original application.