

❖ DIVISIONAL APPLICATIONS UNDER JAPANESE PATENT PRACTICE

An applicant is eligible to file new patent applications based on a patent application (original application) containing two or more inventions. If the new applications satisfy certain requirements, the filing date of the divisional applications is deemed to be the same date as that of the parent application. This retroactive effect regarding filing date has significant meaning in the Japanese Patent Law which adopts a first-to-file patent system.

❖ REQUIREMENTS FOR DIVISIONAL APPLICATIONS

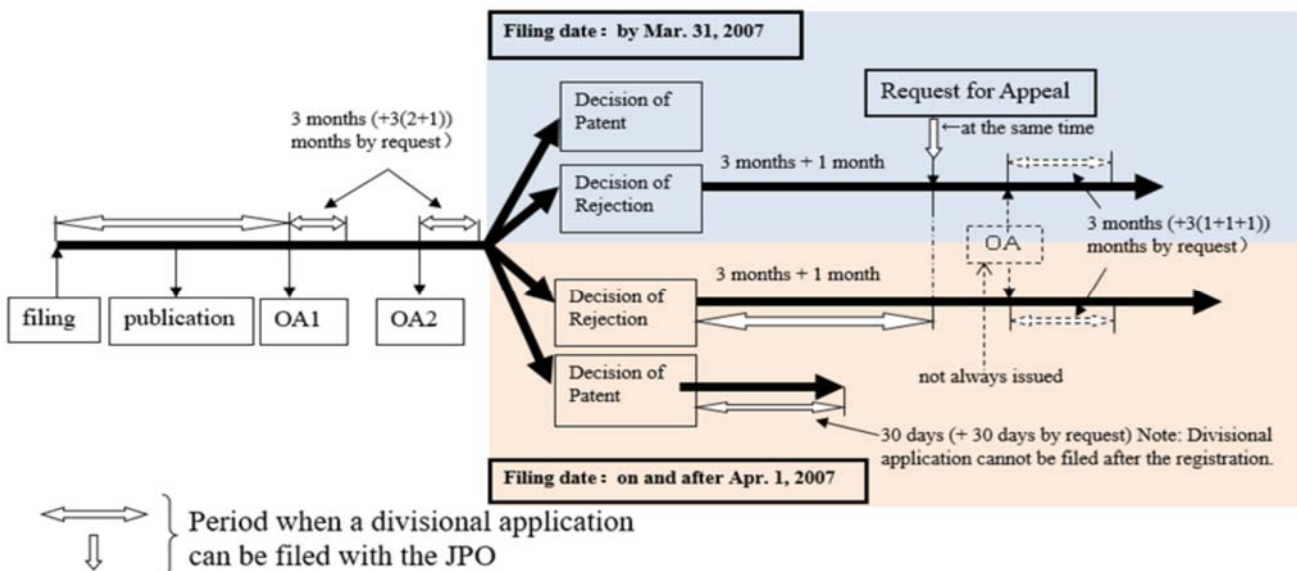
A) Only the applicant of the parent application is eligible to file a divisional application. (In the case of joint applications, the joint applicants of the parent application are eligible to file divisional applications)

B) Allowable period during which divisional applications may be filed:

–Within the allowable period for filing amendments (allowable period shown by white arrow in the below chart)

–Within 30 days from the issuance of a Decision of Patent

–Within 4 months from the issuance of a Decision of Rejection



C) Substantive requirements (scope of divisional applications)

The scope of the divisional application should be limited to fall within the scope of the original (parent) application.

D) Advantage of filing divisional applications

1) Response to a violation of the requirement of unity of invention

If an Office Action (OA) is issued due to a violation of the requirements for unity of invention, it may be possible for the applicant to obtain a patent by separating claims which do not satisfy the requirements for unity of invention from the parent application by filing them as divisional applications.

2) Providing a fallback to the parent application

Filing divisional applications leaves open the possibility that applicants may obtain a patent granted partially, even though the parent application is ultimately rejected by the JPO.

DIVISIONAL APPLICATIONS

3) Obtaining patents for inventions described only in the specification

Patents can also be obtained for inventions that are described only in the specification of the original application, but not described in the claims, by filing one or more divisional applications for the desired inventions.

4) Issuing a warning against competitors by keeping applications pending for an extended period of time

The application pendency period can be prolonged by filing divisional applications. This urges competitors to observe the status of the existence of divisional applications. It is effective to put pressure and restrictions on competitors designing their products and so forth.