

JPO Introduces New Practice to Suspend Examination of Divisional Patent Applications whose Parent Patent Application is Pending at Appeal Trial

- Started from April 1, 2023 -

May 8, 2023

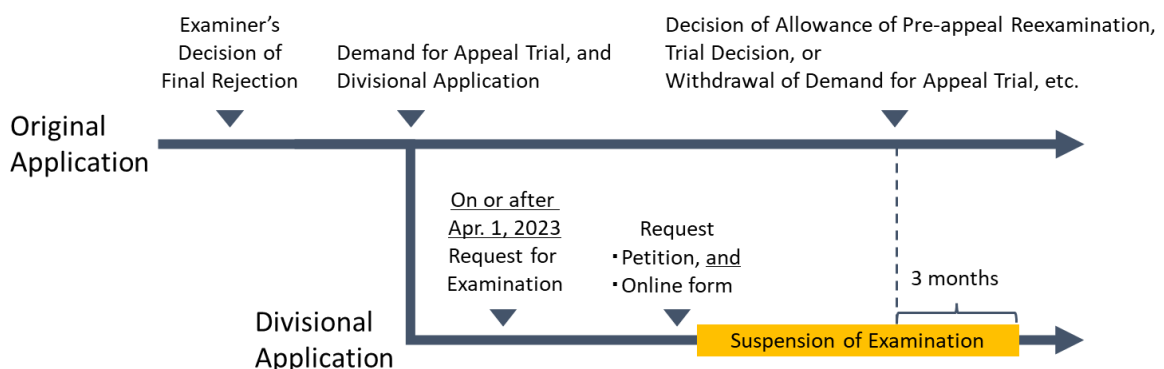
Seiwa Patent & Law (Tokyo, Japan)

Abstract

On April 1, 2023, the Japan Patent Office (JPO) introduced a new practice to suspend, upon the applicant’s request, substantial examination of a divisional patent application whose parent application is pending at an Appeal Trial, until three months after a result of pre-appeal reexamination or trial examination of the parent application is obtained. The new practice applies to divisional applications for which a Request for Examination is filed on or after April 1, 2023.

1. Overview

Under the new practice, upon request by the applicant or their representative, substantial examination of a divisional patent application (hereinafter “divisional application”) that was divided after issuance of a Decision of Final Rejection relating to the parent patent application (hereinafter “parent application”) will be suspended, under the provisions of Patent Law Article 54, paragraph 1¹. The substantial examination of the divisional application will be resumed three months after a result of pre-appeal reexamination or trial examination of the parent application is obtained.



¹ Patent Law Article 54, paragraph 1 prescribes that “Examination procedure can be suspended, if necessary, until a decision of Post-Grant Opposition or a trial decision is finalized, or until court proceedings are finished.”

2. Applications to which the new practice applies

The new practice applies to divisional applications for which *a Request for Examination is filed on or after April 1, 2023*.

In order for substantial examination to be suspended, a divisional application must satisfy all of the following requirements (a) to (c).

- (a) The divisional application² was filed after the issuance³ of a Decision of Final Rejection relating to the parent application.
- (b) A Demand for Appeal Trial was filed for the parent application, and the parent application is pending at pre-appeal reexamination or appeal examination⁴.
- (c) It is convenient to await a result of the pre-appeal reexamination or appeal examination of the parent application⁵.

3. Necessary steps for requesting suspension

In order to request suspension of examination of a divisional application, the applicant or their representative *must submit both items (1) and (2) below within 5 working days of the JPO from the date of filing a Request for Examination of the divisional application*. If either one of items (1) and (2) is not submitted by the due date, the divisional application will not be subject to the new practice.

- (1) Submit a petition explaining that the provisions of Patent Law Article 54, paragraph 1 apply to the divisional application.
- (2) Submit an online form explaining that the provisions of Patent Law Article 54, paragraph 1 apply to the divisional application.

² Only divisional applications directly divided from the parent application are eligible under the new practice, and further divisional applications divided from a divisional application are not. Incidentally, even further divisional applications divided from a divisional application are eligible under the new practice, when they are divided after the issuance of a Decision of Final Rejection relating to the divisional application (the original application from the standpoint of the further divisional applications), so long as the other requirements (b) and (c) are also satisfied.

³ The response period to the Decision of Final Rejection, and the response period to, if any, an Office Action issued during the pre-appeal reexamination or appeal examination.

⁴ If a Demand for Appeal Trial is filed *along with an Amendment of the claims*, the application will be reexamined (pre-appeal reexamination) by a pre-trial reexaminer, who is usually the same as the Examiner as in the examination stage, before appeal examination, while if a Demand for Appeal Trial is filed *without amending the claims*, the application will be directly transferred to the appeal examination.

⁵ If it is apparent that the claim does not include any specific features of the invention, such as an omnibus claim reciting “the invention described in the specification.”, etc., requirement (c) is not satisfied. Otherwise, requirement (c) is basically satisfied.

In the petition and online form, we must briefly explain that the divisional application satisfies all of the above requirements (a) to (c).

4. Procedures, etc., after request

Upon request, the JPO will examine as to whether or not the divisional application is eligible under the new practice, and will notify the requestant of its decision via email. The correspondence will be recorded in the file wrapper and available to the public.

If the divisional application is eligible under the new practice, the substantial examination of the divisional application will be suspended **until three months after any of the following events (i) to (iii) concerning the parent application.**

- (i) A Decision of Allowance from pre-appeal reexamination is mailed to the applicant.
- (ii) A first⁶ Trial Decision from the Appeal Trial is mailed to the applicant.
- (iii) The Demand for Appeal Trial is withdrawn or dismissed.

When the suspension of substantial examination ends following any of the above events (i) to (iii), the requestant will be notified via email, and the correspondence will be recorded in the file wrapper and available to the public. The applicant must file a petition⁷ explaining the relationship between the parent application and the divisional application, etc., as already required under current practice, along with, if any, a voluntary amendment by the date on which the suspension of substantial examination ends. After the suspension ends, substantial examination of the divisional application will be resumed after the same waiting period as in regular divisional applications from the time of any one of the above events (i) to (iii).

Incidentally, the suspension period under the new practice will be deducted from the calculation of an extendable period of a patent right due to the delay caused in the patent prosecution process (Patent Law Article 67, paragraph 2 and paragraph 3, item 10).

5. Our comments

It is common under Japanese patent practice to file a divisional application *as a safeguard* at the same time as filing a Demand for Appeal Trial in response to a Decision of Final

⁶ A second Trial Decision of an Appeal Trial that has been remanded as a result of a lawsuit for rescinding a first Trial Decision of the Appeal Trial is not included.

⁷ This is required by the JPO, even under current practice, and is different from the petition for requesting the suspension of substantial examination under the new practice.

Rejection, in order to continue the prosecution regardless of the outcome of the Appeal Trial, since the response period to a Decision of Final Rejection may be substantially the last opportunity to file a divisional application.

In such a divisional application filed as a safeguard, it is usually efficient and effective to take a result of pre-appeal reexamination or appeal examination of the parent application into account when determining a course of action in the divisional application (e.g., how to amend the claims, etc.). However, due to the rapid examination process at the JPO in recent years⁸, a Notice of Reasons for Rejection relating to the divisional application may be issued before a result of the parent application is obtained. In this regard, under the new practice, the applicants are able to proceed with a divisional application more strategically, by ensuring that a result in the parent application will be obtained before the substantial examination of the divisional application begins.

Incidentally, it is common to file a divisional application at the same time as filing a Demand for Appeal Trial, with the original claims and specification, etc., in the original language, in order to maintain the entirety of the disclosure of the parent application, and then voluntarily amend the claims at the time of filing a Request for Examination. In this regard, even if specific claims to be examined in the divisional application have not been determined, it is necessary to tentatively determine the claims, by the due date of filing a Request for Examination⁹.

Under past practice before the new practice, the claims at the time of filing a Request for Examination may be, in general, either one of the following (1) to (5), considering the risk that further restrictions will be imposed on claim amendments¹⁰ upon receiving a Notice of Reasons for Rejection before obtaining a result in the case of the parent application.

- (1) Claims identical to the original claims of the parent application.
- (2) Claims identical to the claims upon division of the parent application.
- (3) A part of the above option (1) or (2) (for example, only an independent claim(s)).

⁸ Time of pendency under normal examination from filing a Request for Examination to a first Office Action in 2022 was 10.1 months on average, according to the JPO. In our experience, the average time of pendency for divisional applications is, in general, shorter than it.

⁹ Three years from the filing date (the international filing date for PCT, and not the priority date) of the parent application, or within 30 days from the actual filing date of the divisional application, whichever later (Patent Law Article 48-3, para.2).

¹⁰ The only requirement for a voluntary amendment of the claims (an amendment made before receiving a first Office Action) is prohibition of addition of new matter (Patent Law Article 17-2, para.3). However, after receiving a first Office Action, in addition to the prohibition of addition of new matter, it will be impossible to shift the subject matter to an unexamined subject matter (Patent Law Article 17-2, para.4). Furthermore, if the first Office Action includes a notice under Article 50-bis, which indicates that the reason(s) for rejection are substantially the same as those given in the parent application, the allowable scope of claim amendment is strictly limited as in the case where a *final* Office Action is issued.

(4) Omnibus claims (claims that do not recite any specific features of the invention, for example, “the invention described in the specification.”).

(5) Claims that are unique to the divisional application.

Then, which claim set may be appropriate for a divisional application subject to the new practice of suspension of examination?

First of all, even under the new practice, it would still be advisable to file a divisional application at the same time as filing a Demand for Appeal Trial, with the original claims and specification, etc., in the original language, in order to maintain the entirety of the disclosure of the parent application.

Under the new practice, since an opportunity to voluntarily amend the claims is ensured within three months before the substantial examination begins, it is possible to flexibly reconstitute (add, extend, change, and/or delete, etc.) the claim set under the most lenient amendment requirements, regardless of what claims are used at the time of filing a Request for Examination. However, omnibus claims as in the above option (4) cannot be used, since they do not satisfy the above requirement (c) for requesting the suspension of examination (footnote 5).

Therefore, especially in the case of a divisional application filed solely as a safeguard, i.e., which may be withdrawn if the parent application is granted, it is preferable to voluntarily amend the claims at the time of filing a Request for Examination, to original claim 1 or claim 1 upon division *only* (i.e., reduce the number of claims to one, as in the above option (3)), in order to minimize the official fee¹¹, and then, after obtaining a result in the case of the parent application, to voluntarily amend the claim to the actual claims to be examined.

There may be a case where the applicant decides to proceed with the prosecution of the divisional application, regardless of whether or not the parent application will be granted, but wishes to determine the claims to be examined in the divisional application by taking a result in the case of the parent application into account. Even in this case, option (3), i.e., reducing the number of claims, can be efficient in terms of cost, as described above.

However, from the viewpoint of facilitating the Examiner’s ease in understanding the amended portions of the claims when filing a voluntary amendment before the examination

¹¹ The official fee for examination is determined based merely on the number of claims at the time of filing a Request for Examination, regardless of multiple claim dependency. However, if the number of claims has increased thereafter, it is necessary to pay an additional official fee for the increased number of claims.

begins, it may also be advisable to use a different claim set at the time of filing a Request for Examination, depending on the situation.

For example, if there is a possibility that the claims of the divisional application may be amended differently from the amendments made in the examination stage of the parent application, and the applicant wishes to revise their strategy based on the original claims, it would be preferable to use the original claims (i.e., no voluntary amendment) at the time of filing a Request for Examination, as in the above option (1).

On the other hand, if it may be necessary to amend the claims of the divisional application in the same way as the amendments made in the examination stage of the parent application, it would be preferable to voluntarily amend the claims, at the time of filing a Request for Examination, so as to be identical to the claims upon division of the parent application, as in the above option (2).

Further, in the case where the applicant has substantially determined the claims to be examined in the divisional application, but still wishes to await a result in the case of the parent application using the new practice of suspension of examination in order to tailor the claims to be examined thereafter, it would be preferable to voluntarily amend the claims, at the time of filing a Request for Examination, to be unique to the divisional application, as in the above option (5).

END