

## **Request for Resuming Substantial Examination of Divisional Application under Suspension of Substantial Examination**

**- Commenced on April 1, 2024 -**

April 3, 2024

Seiwa Patent & Law (Tokyo, Japan)

- Under the practice of suspension of substantial examination of divisional applications (Patent Law Article 54, paragraph 1), substantial examination of a divisional application subject to the suspension will be suspended until three months after any of the following events (i) to (iii) concerning the parent application, and it was not possible to request resuming of substantial examination.
  - (i) A Decision of Allowance from pre-appeal reexamination is mailed to the applicant.
  - (ii) A first Trial Decision from the Appeal Trial is mailed to the applicant.
  - (iii) The Demand for Appeal Trial is withdrawn or dismissed.

After the suspension ends, substantial examination of the divisional application will be actually initiated after the same waiting period as in regular divisional applications from the time of any one of above events (i) to (iii).

- *As of April 1, 2024*, the JPO has begun a new practice, under which, upon request by the applicant or their representative, the JPO will resume substantial examination of divisional applications which is under the suspension.

In order to request resuming substantial examination of a divisional application that has been the subject of the suspension, the applicant or their representative ***must submit both items (1) and (2) below, before any one of above events (i) to (iii).***

- (1) Submit a petition requesting resuming of substantial examination of the divisional application
- (2) Submit an online form requesting resuming of substantial examination of the divisional application

Upon request, the JPO will send an email to the requester to notify whether the request has been accepted, and if so, the substantial examination of the divisional application will be actually initiated after the same waiting period as in regular divisional applications from the mailing date.

If a request for resuming substantial examination is filed within the three-month period after any of above events (i) to (iii), the JPO will not accept the request. In such cases, the substantial examination will be initiated after the same waiting period as in regular

divisional applications from the time of any one of above events (i) to (iii), as in the cases where no request was submitted.

It should also be noted that once a request for resuming substantial examination is accepted by the JPO, it is not possible to request suspension of substantial examination again.

- The new practice provides improved convenience for the applicant, since it can be used, for example, in cases where the applicant has decided a concrete set of claims to be examined in a divisional application which is under suspension of substantial examination, and wishes to resume substantial examination of the divisional application before obtaining a result in the pre-appeal reexamination or appeal trial of the parent application.

END

[Links]

JPO's website: [Request for Resuming Substantial Examination of Divisional Applications under Suspension of Substantial Examination \(Japanese\)](#)

Our website: [SEIWA IP NEWS dated May 8, 2023](#)