



## Revisions to the Japan Patent Law as Preparations for the Patent Law Treaty (PLT)

- Summary of the 2015 revision (effective from April 1, 2016) -

Seiwa Patent & Law  
IP Information Section  
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A new revision (hereinafter the “2015-revision”) to the Japan Patent Law (hereinafter “JPL”) was announced in 2015, and brought into effect on April 1, 2016. This 2015 revision includes several law changes in preparation for the Patent Law Treaty (hereinafter “PLT”), which is scheduled to become effective on June 1, 2016. We summarize hereinbelow the PLT-related changes in the JPL effected by the 2015-revision as well as the relevant changes in the Regulations and the Orders for Implementing the JPL (hereinafter “Regulations” and “Orders”, respectively).

### 1. Changes Relating to Establishment of Filing Date

#### (1) Requirements for establishing a filing date < PLT: Art. 5(1) >

➤ Before Revision:

\*The JPO Commissioner may not provide that a patent application is valid if the application involves any missing parts. The applicant is not able to supplement the missing parts of the application.

➤ After Revision: **[NEW] JPL: Article 38-2**

\* The JPO Commissioner shall provide that the filing date of the patent application is the date of submission of a request for a patent application except for the following cases. <[New] JPL: Art. 38-2(1)>

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| <p>(i) When an intention to obtain a patent is not clearly expressed.</p> <p>(ii) When the name or identity of an applicant is not indicated or not sufficiently legible to identify the applicant.</p> <p>(iii) When a specification (in the case of a foreign language patent application, a foreign language specification) is not attached (except for a patent application by reference of a previously-filed application).</p> |
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\*When the application does not satisfy the requirements for establishing the filing date, the JPO Commissioner shall issue a notification that the applicant can supplement the missing parts of the application. <[New] JPL: Art. 38-2(2)>

\*The applicant can supplement the missing part of the application within a period designated by ministerial ordinance (2 months from the notification). <[New] JPL: Art. 38-2(3)> {[New] Regulations: Art. 27-7}

\*When the applicant submits the missing parts of the application, the date of submission of the missing part shall be the filing date of the application. <NEW: JPL: Art. 38-2(6)>

**(2) Requirements for a foreign language application** < PLT: Art. 5(2)(b), 6(3) >

➤ Before Revision:

- \* A foreign language patent application must be written in English.
- \* A translation of a foreign language patent application must be submitted within a period of 1 year and 2 months from the filing date/priority date.

➤ **After Revision:**

- \* A foreign language patent application may be written in **English or any other foreign language**. {[Revised] Regulations: Art. 25-4}
- \* A translation of a foreign language patent application must be submitted within a period of **1 year and 4 months** from the filing date/priority date. <[Revised] JPL: Art. 36-2(2) >

**(3) Application with reference to a previously-filed application** < PLT: Art. 5(7) >

➤ Before Revision: No such provision.

➤ **After Revision: [NEW] JPL: Article 38-3**

- \* A patent application can be filed without a specification and drawings, by indicating in the application request the filing number of a previously-filed patent application, and then submitting the specification and drawings later. In this case, the filing date of the application shall be the date of submission of the application request.
- \* However, if the matters described in the later-submitted specification and drawings of the patent application are beyond the scope of matters described in the specification, claims, and drawings of the previously-filed patent application, then the filing date of the application shall be the date of submission of the specification and drawings.
- \* This provision does not apply to foreign language patent applications, divisional applications, converted patent applications, and patent applications based on utility model registration.

**(4) Supplementation of missing parts of a specification or drawings** <PLT: Art. 5(5)(6)>

➤ Before Revision:

- \* The JPO Commissioner does not notify the patent applicant even if a patent application lacks a part of the specification or the drawings. The applicant is not able to supplement the missing parts of the application.

➤ **After Revision: [NEW] JPL: Article 38-4**

- \* The JPO Commissioner shall notify the patent applicant if a patent application lacks a part of the specification or the drawings.
- \* The applicant who received the notification can supplement the missing part of the specification or the drawings within a period designated by the ministerial ordinance (2 months from the notification) {[New] Regulations: Art. 27-11 }
- \* When the applicant submits the missing part of the specification or the drawings, the date of submission of the missing part shall be the filing date of the application.

## 2. Changes Relating to Notification of Defect in Form and/or Content of Application or Submission <PLT: Art. 6(7), 8(7)>

### ➤ Before Revision:

\*When a patent application or a submission filed at the JPO includes a defect, the applicant may not be notified of the defect or offered an opportunity to remedy the defect, even if the defect is disadvantageous to the applicant.

### ➤ After Revision:

**\*The applicant will be notified of a defect specified in items (1) to (3) below, and will be offered an opportunity to remedy the defect.**

### (1) When the applicant of a foreign language patent application fails to file a translation of the specification, etc., by the due date ...

Before Revision	After Revision: <[Revised] JPL: Arts. 36-2 and 43>
<p>* When a translation of a foreign language specification, drawings and abstract is not submitted within a submission period of 1 year and 2 months from the filing date/priority date ...</p> <p>=&gt; The foreign language patent application is deemed to be withdrawn &lt;JPL: Art. 36-2 (3)&gt;</p> <p>* However, if the applicant has any legitimate reason for failing to submit the translation, within the submission period, then the applicant can supplement the translation within 2 months after the reason is resolved, but only within 1 year from the expiry of the submission period.</p>	<p>* When a translation of a foreign language specification, drawings and abstract is not submitted within a submission period of 1 year and <b>4 months</b> from the filing date/priority date ...</p> <p>=&gt; The JPO Commissioner shall notify the applicant that the translation was not submitted within the submission period &lt;[New] JPL: Art. 43(6)&gt;</p> <p>* The applicant can supplement the translation within a supplementation period designated by ministerial ordinance (2 months from the notification) &lt;[New] JPL: Art. 36-2(4)&gt; {[New] Regulations: Art. 25-7(4)}</p> <p>=&gt; If the translation is not supplemented, the foreign language patent application is deemed to have been withdrawn at the expiry date of the supplementation period of 1 year and 4 months from the filing date/priority date &lt;[New] JPL: Art. 36-2(5)&gt;</p> <p>* However, if the applicant has any legitimate reason for failing to supplement the translation within the supplementation period, then the applicant can supplement it within 14 days after the reason is resolved, but only within 1 year from the expiry of the submission period. &lt;[New] JPL: Art. 36-2(6) &gt; {[New] Regulations: Art. 25-7(6)}</p>

### (2) When the applicant of a patent application claiming priority under the Paris Convention fails to file a priority document by the due date ...

Before Revision	After Revision: <[Revised] JPL: Art. 43>
<p>* When a priority document is not filed for a patent application claiming priority under the Paris Convention within a submission period of 1 year and 4 months from the priority date...</p>	<p>* When a priority document is not filed for a patent application claiming priority under the Paris Convention within a submission period of 1 year and 4 months from the priority date...</p> <p>=&gt; The JPO Commissioner shall notify the applicant that the priority document was not submitted within the submission period &lt;[New] JPL: Art. 43(6)&gt;</p> <p>* The applicant can supplement the priority document</p>

<p>=&gt; The priority claim shall lapse &lt;JPL: Art. 43(4)&gt;</p> <p>* However, if the applicant has any reason outside his control for failing to submit the priority document within the submission period, then the applicant can supplement the priority document within 14 days after the reason is resolved, but only within 6 months from the expiry of the submission period. &lt;JPL: Art. 43(6)&gt;</p> <p>=&gt; If the priority document is supplemented, the priority claim shall be valid &lt;JPL: Art. 43(7)&gt;</p>	<p>within a supplementation period designated by ministerial ordinance (2 months from the notification) &lt;[New] JPL: Art. 43(7) &gt; {[New] Regulations: Art. 27-3-3(5)}</p> <p>=&gt; If not, the priority shall lapse &lt;JPL: Art. 43(4)&gt;</p> <p>* However, if the applicant has any reason outside his control for failing to submit the priority document within the submission period, then the applicant can supplement it within a period designated by ministerial ordinance, which is:</p> <p>(i) when the reason is due to the delay of issuance of the priority document by the government of the country in which the priority application was filed, then within 1 month (within 2 months for a non-Japanese resident applicant) from the receipt of the priority document; or</p> <p>(ii) otherwise, within 14 days after the reason is resolved, but only within 6 months from the expiry of the submission period. &lt;[New] JPL: Art. 43(8) &gt; {[New] Regulations: Art. 27-3-3(6)}</p> <p>=&gt; If the priority document is supplemented, the priority claim shall be valid &lt;[New] JPL: Art. 43(9)&gt;</p>
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**(3) When a non-Japanese resident filing a Japanese-entry PCT application fails to inform the JPO of his Japanese agent**

Before Revision	After Revision: <[Revised] JPL: Art. 184-11>
<p>* When a non-Japanese resident filing a Japanese-entry PCT application fails to inform the JPO of his Japanese agent for the application (patent administrator) at the time of filing...</p> <p>=&gt; The Japanese-entry PCT application is deemed to be withdrawn &lt;JPL: Art. 184-11(3)&gt;</p>	<p>* When a non-Japanese resident filing a Japanese-entry PCT application fails to inform the JPO of his Japanese agent for the application (patent administrator) at the time of filing...</p> <p>=&gt; The JPO Commissioner shall notify the applicant that the JPO was not informed of the Japanese agent &lt;[New] JPL: Art. 184-11(3)&gt;</p> <p>* The applicant can inform the JPO of the Japanese agent within a period designated by ministerial ordinance (2 months from the notification) &lt;[New] JPL: Art. 184-11(4)&gt; {[New] Regulations: Art. 38-6-2(2)}</p> <p>=&gt; If the JPO is not informed of the Japanese agent, the Japanese-entry PCT application is deemed to be withdrawn &lt;JPL: Art. 184-11(3)&gt;</p> <p>* However, if the applicant has any legitimate reason for failing to inform the JPO of the agent within the designated period, then the applicant can inform the JPO thereof within 2 months after the reason is resolved, but only within 1 year from the expiry of the designated period. &lt;[New] JPL: Art. 184-11(6) &gt; {[New] Regulations: Art. 38-6-2(3)}</p>

### 3. Changes Relating to Procedures for which Non-Japanese Resident Can Act without Patent Administrator <PLT: Art. 7(2)>

#### ➤ Before Revision:

- \* In principle, a non-Japanese resident cannot act before the JPO on his/her own <JPL: Art. 8>.
- \* However, a non-Japanese resident (or a representative of a non-Japanese resident legal entity) who is an applicant of a Japanese patent application or a proprietor of a Japanese patent and has a patent administrator (Japanese agent) can act before the JPO on his/her own during a period when he/she is staying in Japan {Orders: Art. 1}.

#### ➤ After Revision:

- \* In principle, a non-Japanese resident cannot act before the JPO on his/her own <JPL: Art. 8>.
- \* However, a non-Japanese resident can act before the JPO on his/her own only for the following procedures. {[Revised] Orders: Art. 1(1)... previous Article 1 was renumbered as Article 1, paragraph (1), while paragraphs (2) and (3) were newly added}.
- (i) A non-Japanese resident (or a representative of a non-Japanese resident legal entity) who is an applicant of a Japanese patent application or a proprietor of a Japanese patent and has a patent administrator (Japanese agent) can act before the JPO on his/her own during a period when he/she is staying in Japan.
- (ii) A non-Japanese resident can file a patent application (other than a divisional application, converted application, or patent application based on utility-model registration) or carry out other specific procedures designated by ministerial ordinance (i.e., submission of documents prescribed in Art. 27-10(4) of the Regulations {except for a translation prescribed in the same article} or submission of a copy of a priority document prescribed in Art. 27-11(7) of the Regulations {except for a translation prescribed in the same article}) {[New] Orders: Art. 1(2)} {[New] Regulations: Art. 4-4}.
- (iii) A non-Japanese resident can pay annuities for a patent for the 4th and subsequent years. {[New] Orders: Art. 1(3)}

### 4. Changes Relating to Relief for Party Failing to Comply with Designated Period

<PLT: Art. 11(1)(2)(6)>

#### ➤ Before Revision:

An extension of a period designated by the JPO can be requested only before the expiry of the designated period <JPL: Art. 5(1)>

#### ➤ After Revision: **[New] Article 5(3) of the Patent Law:**

An extension of a period designated by the JPO specified by ministerial ordinance<sup>\*1</sup> can be requested even after the expiry of the designated period, only during an additional period specified by the ministerial ordinance<sup>\*2</sup>.

\*1: JPO's designated periods specified by ministerial ordinance are as follows  
{[New] Regulations: Art. 4-2(5)}

- (i) Periods designated by the JPO Commissioner (excluding: periods designated by JPO during procedures relating to applications for registration of patent term extension, oppositions, trials, retrials, and requests for interpretation)
  - (ii) Periods designated by an Examiner (excluding: periods designated by the Examiner in an order for submission of prior art references, periods designated by the Examiner during examination of applications for registration of patent term extension, and periods designated by the pretrial examiner in a notice of new reasons for rejection)
- \*2: “2 months” {[New] Regulations: Art. 4-2(6)}

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