Japan Report Q193
in the name of the Japanese Group
by Katsuomi ISOGAI

Divisional, Continuation and Continuation in Part Patent Applications

Questions

1) Analysis of the current law

1) Are divisional, continuation or continuation-in-part applications, respectively, available under your national or regional law?

Divisional applications, as defined under the Guidelines, are available. Continuation applications, as defined under the Guidelines, are available in Japan as one type of divisional applications. With regard to the same invention, however, a patent is only granted for one application, i.e., either the original (parent) application or a divisional application (double patenting is prevented). Continuation-in-part applications are not available.

2) What is the justification behind allowing the filing of divisional, continuation and continuation-in-part applications in your law?

The justification is as follows:

Even when a patent application includes two or more inventions which do not satisfy the requirement of unity of application (invention), or when a patent application includes an invention which is not defined in the original claims but is described in the detailed description (specification) of the invention or drawings, such inventions are disclosed to the public by filing of the application. Thus, considering the role of the patent system where inventions are patented as a reward for such disclosure, an opportunity for protection should be extended to such inventions. (Cited from the JPO Examination Guidelines)

3) Under what circumstances and conditions may divisional, continuation and continuation-in-part applications (or combinations thereof) be filed in your national or regional patent system?

1. Requirements concerning the applicant

The applicant of the original application and that of a divisional application must be the same at the time of division of the original application (at the time of filing the divisional application) [Article 44, paragraph 1 of the Patent Act]. However, a divisional application may be transferred independently after it has been filed. In principle, it is not allowed to satisfy this requirement ex post facto when the applicant of a divisional application is different from that of the original application at the time of division of the application (at the time of filing the divisional application).
II. Time requirements

Division of an application is allowed only within the following periods:

i) Within the allowable time limit for amendments of the description, claims or drawings attached to the application (Article 44, paragraph 1, item 1)

ii) Within 30 days from the date that the certified copy of the examiner’s decision notifying to the effect that a patent is to be granted (not including the same after filing a request for a trial against an examiner’s decision of refusal) has been served (Article 44, paragraph 1, item 2)

(However, division of an application is not allowed after registration establishing a patent right has been effected, even if it is within said 30 days. The 30-day period may be extended for applicants residing overseas.)

iii) Within 30 days from the date that the certified copy of the examiner’s initial decision to the effect that the application is to be refused has been served (Article 44, paragraph 1, item 3)

(However, the 30-day period may be extended for applicants residing overseas.)

III. Subject matter requirements

A. In the case where an application is divided within the allowable time limit for amendments (Article 44, paragraph 1, item 1)

i) The claimed invention of the divisional application shall not be identical to the unique invention disclosed in the description, claims or drawings of the original application immediately prior to being divided.

ii) The matters disclosed in the description, claims or drawings of the divisional application shall be within the scope of the matters originally disclosed in the description, claims or drawings of the original application as filed.

B. In the case where an application is divided after the examiner’s decision to the effect that a patent is to be granted or after the examiner’s decision of refusal without filing a request for a trial against an examiner’s decision of refusal (Article 44, paragraph 1, item 2 and item 3)

i) The claimed invention of the divisional application shall not be identical to the unique invention disclosed in the description, claims or drawings of the original application immediately prior to being divided.

ii) The matters disclosed in the description, claims or drawings of the divisional application shall be within the scope of the matters originally disclosed in the description, claims or drawings of the original application as filed.

iii) The matters disclosed in the description, claims or drawings of the divisional application shall be within the scope of the matters disclosed in the description, claims or drawings of the original application immediately prior to being divided.

Requirement i) is usually determined to be satisfied (JPO Examination Guidelines).

Requirements ii) and iii) are determined in the same manner as the determination of whether or not an amendment contains new matter.

The applicant of a divisional application is sometimes requested to submit a written statement explaining matters including the relationship of the inventions claimed in the divisional application to the original application.
4) Are cascades of divisional, continuation and continuation–in–part applications allowed, i.e. is it possible to file a divisional, continuation or continuation–in–part application on the basis of another divisional, continuation or continuation–in–part application?

It is allowed to file a divisional application based on another divisional application.

5) At what time during the prosecution of the parent application may divisional, continuation or continuation–in–part applications be filed?

See “II. Time requirements” in our answer to 3) above.

6) Is it a requirement for filing an application that is a divisional, continuation or continuation–in–part of an original application (or of another divisional, continuation or continuation–in–part thereof) that the original application (or the direct parent application, or both) is still pending at the time of filing of the divisional, continuation or continuation–in–part application?

When filing a divisional application of an original application, the original application has to be still pending before the JPO at the time of the division of application. (See “II. Time requirements” in our answer to 3) above.)

When filing a divisional application (a child application) of an original application (the parent application) and further filing a divisional application (a grandchild application) of the child application, the parent application does not need to be pending before the JPO at the time of filing the grandchild application.

7) Is it a requirement that the original application (or the direct parent application, or both) is still pending throughout the prosecution of a divisional, continuation or continuation–in–part application derived therefrom?

No, it is not a requirement.

8) Are there any restrictions as to what may be included in a divisional, continuation or continuation–in–part application?

See “II. Subject matter requirements” in our answer to 3) above.

It is generally accepted that these subject matter requirements may be retroactively satisfied (remedied) by making amendments after filing the divisional application.

There is a question as to whether a divisional application whose description, claims and drawings are respectively identical to the description, claims and drawings of the original application would be determined as failing to satisfy Subject Matter Requirement i) mentioned above (an illegitimate divisional application) or if it would be determined to satisfy Subject Matter Requirement i) (a legitimate divisional application) but would be affected by the provisions for preventing double patenting (Article 39, paragraph 2). However, because there are no such actual cases, we cannot derive a conclusive answer to this question. In any case, a notice of the reason for refusal would be given for such divisional application (the reason for refusal may be remedied through amendments).

9) In particular, may the description and/or claims contain or claim matter that was not contained or claimed in the original application, or other application from which the divisional, continuation or continuation–in–part application derives?

See “II. Subject matter requirements” in our answer to 3) above.

There is no problem in disclosing (claiming) in the claims of a divisional application an invention that was not disclosed (claimed) in the claims of the original application but was disclosed in the specification or the drawings of the original application.
10) Is it possible to extend the patent term in respect of matter contained in the original application by filing divisional, continuation or continuation-in-part applications, including divisional, continuation or continuation-in-part applications containing added matter, to the extent the addition of new matter is allowed?

Since any legitimate divisional application would be deemed to have been filed at the time of filing of the original application (the main clause of Article 44, paragraph 2), it is not possible to extend the patent term with respect to matter contained in the original application by filing a legitimate divisional application.

11) Is double-patenting permitted or must the matter claimed in divisional, continuation or continuation-in-part applications be deleted from the claims of the original application, or other application from which the divisional, continuation or continuation-in-part application derives?

When an invention claimed in a divisional application and an invention claimed in the original application are the same, the provisions for preventing double patenting (Article 39, paragraph 2) would be applied, similar to such situation between two ordinary applications (applications that are not divisional). Thus, the invention needs to be deleted from either the claims of the original application or the claims of the divisional application.

It should be noted that, under the current JPO Examination Guidelines, the scope of invention determined to be identical under the provisions of Article 39, paragraph 2 is broader than the scope of identical invention in Europe and the United States. Nevertheless, there is also a Tokyo High Court decision that is found to have adopted an idea similar to that of Europe or the United States. Here, we will not go into the argument of how identical invention should be determined.

Overlapping disclosure in the description does not pose a problem in itself, but if it makes the contents of the invention unclear, the applicant may be asked to delete the overlapping portion.

12) Does it matter in this respect whether the divisional, continuation or continuation-in-part application was filed in response to a restriction requirement issued by the patent granting authority?

No, it does not matter.

II) Proposals for adoption of uniform rules

1) In the opinion of your National or Regional Group, what are the advantages, for applicants and third parties, of allowing the filing of divisional, continuation or continuation-in-part patent applications?

**Divisional applications:**

Applicants can enjoy the advantage of acquiring patents for their divisional applications by having it deemed that they have been filed on the filing date of the original application, while avoiding violating unity of invention.

Third parties can enjoy advantages including impartiality in burden of filing fees and easier searches as a result of the scope of each application or patent becoming more reasonable.

**Continuation applications:**

Applicants would be able to acquire a patent of a more precise and thorough scope (a multi-faceted and exhaustive patent) as a result of undergoing examination many times concerning the extent to which they can expand the scope of protection.

Third parties would find it easier to avoid disputes since the demarcation of the patent rights become clearer.
Continuation-in-part applications:
Applicants may find it easier to acquire patents for improvement inventions cumulatively and securely.
Third parties may be able to predict the directions of applicants’ technology development.

2) In the opinion of your National or Regional Group, what are the disadvantages, for applicants and third parties, of allowing the filing of divisional, continuation or continuation-in-part patent applications?

Divisional applications and continuation applications (common):
Applicants would find management of their applications more complicated since divisional and continuation applications are treated as new separate applications.
Third parties would have to monitor applications for a longer time span.

Continuation-in-part applications:
Applicants would find management of their applications more complicated since continuation-in-part applications are treated as new separate applications.
Third parties would have to also determine the reference date of prior art, so their monitoring burden would increase.

3) In the opinion of your National or Regional Group, should the filing of divisional, continuation or continuation-in-part patent applications, respectively, be permissible?

Divisional applications should be permissible. This is also a requirement under the Paris Convention (Article 4G of the Paris Convention).
Continuation applications should also be permissible.
Here, we are critical of the idea of allowing a continuation application including a claim identical to that of a refused original application (allowing a request for examination of a continuation application including a claim identical to that of the original application). This is because the conclusive determination of patentability would be deferred and the meanings of period limitation for request for examination (in Japan, three years from the filing date) would be lost. However, it would be going too far to impose a penalty on such request for examination (the reasons for refusal would merely be notified in terms of procedure). We are also critical of the idea of patenting a continuation application including a claim identical to that of an already patented original application. The reason is that there would be a need to address the problem of watering (bloating) in the number of patents and the problem that applicants could take advantage of lower patent fees by switching patents. We think it important to unify the determination standards of whether or not claimed inventions are identical among countries and regions, but we will not go into the details here.

We support the idea of patenting a continuation application that claims different matter from the original application, even if the scope of the claims between the two applications were partially overlapping or if either application incorporated the other (but not vice versa at the same time). We consider that leaving room for applicants to acquire a patent of a more precise and thorough scope (a multi-faceted and exhaustive patent) deserves higher priority than other issues. Nevertheless, active consideration would also have to be given to the viewpoint of preventing abuse of the system (see our answer to 8) below) and the viewpoint of reducing the monitoring burden on third parties (see our answer to 9) below).
Continuation–in–part applications would lack sufficient significance under a system that does not grant a grace period based on the applicant’s own published patent application. Therefore, we are not actively interested in introduction of the continuation–in–part application system in Japan. Rather, we think the system should not be introduced considering the possible increase in the monitoring burden of third parties.

4) If international harmonisation were to be achieved in respect of the rules governing divisional or continuation patent applications, what should be the common rules in respect of the circumstances and conditions in which divisional, continuation or continuation–in–part applications may be filed?

With regard to the divisional application system, it would be the best to achieve international harmonization under the following requirements:

1) Requirement concerning the applicant
   The applicant of the original patent application and the applicant of a divisional application shall be the same at the time of filing the divisional application.

2) Subject matter requirement
   The invention claimed in a divisional application shall be disclosed in the specification, claims or drawings of the original patent application.
   The invention claimed in a divisional application shall not be identical to the invention claimed in the original patent application.

3) Time requirement
   Before the establishment of a patent right is registered (or before a patent is issued) or before the examiner’s decision of refusal becomes final and binding.

4) Special requirement
   The applicant shall attach a written explanation stating how the invention claimed in the divisional application is related to the original patent application, by the time of requesting examination for the divisional application at the latest.

With regard to Requirement 3 above, Japan currently adopts a more restrictive time requirement. However, a more relaxed requirement like this is expected to dramatically reduce applicants’ burden in managing applications while it is not likely to cause any major disadvantages.

Requirement 4 is to be introduced in Japan in April 2007. As this requirement is extremely significant not only for reducing the examination workload of the patent office but also for reducing the monitoring burden of third parties, it should be adopted as a requirement for a divisional application.

We are opposed to imposing a special restriction on the number of generations of applications (see our answer to 8) below).

We also think that it would be useful to include the written statement mentioned in Requirement 4 in the publication of a divisional application.

It would also be best to internationally harmonize the continuation application system under the same requirements as those for the divisional application system mentioned above. In other words, restriction should not be imposed as to the number of generations of applications. However, it would be appropriate to consider introduction of higher filing fees (or higher fees for requesting examination) in order to prevent abuse of the system (see our answer to 8) below).
5) In particular, should a harmonised system permit the addition in a divisional, continuation or continuation—in—part application of matter that was not contained in the original application as filed?

Addition of such matter should not be permitted for divisional applications and continuation applications, given the fact that they are deemed to have been filed on the filing date of the original application. We consider it favorable in terms of the protection of applicants to allow them to remedy this type of defects through amendments after the filing, as under the Japanese system.

We are opposed to introduction of the continuation—in—part application system. (However, we are not against adoption of the system by other countries.)

6) Should it be permitted to use a divisional, continuation or continuation—in—part patent application to obtain new examination and decision of an application that contains claims that are identical or essentially identical with claims finally rejected in the course of the prosecution of the parent application?

We are critical of such use in principle (see our answer to 3) above).

However, since it is often difficult to determine whether or not claims are identical, it would be more favorable in view of smooth prosecution to apply provisions for preventing double patenting, as in Japan, instead of considering it as a requirement for divisional applications. Another possible measure for releasing examiners from the determination of identical claims is to allow applicants to file a continuation application for identical invention instead of prohibiting them from transferring the continuation application independently (the purpose is the same as that of Article 36, paragraph 5). Nevertheless, as mentioned in our answer to 3) above, if we were to allow double patents claiming identical matter, we would need to address the problem of the watering in the number of patents and the problem that applicants could take advantage of lower patent fees by switching patents. In addition, if claims for which the examiner’s decision of refusal became final and binding could revive and be patented, there would also be a need to consider granting a statutory non—exclusive license similar to prior user’s right to a third party who worked the invention after the examiner’s decision of refusal became final and binding.

Should there be an exception where case—law on the substantive conditions for patent grant of the patent granting authority has changed since the parent application was rejected? Would this possibility adequately take into account the interests of third parties in legal certainty?

Such exception should not be allowed as it is very likely to injure third parties’ interests.

An act of repeatedly filing continuation applications in anticipation of such a situation could be regarded as abuse if such intention is clear, but usually it would be difficult to conclude such act to be abuse in reality. See our answer to 8) below regarding the measure to deal with an act of repeatedly filing continuation applications. With regard to a situation where a patent is granted for a continuation application including a claim whose scope is broader than that of any claim for which the examiner’s decision of refusal became final and binding, there may be a need to consider granting a statutory non—exclusive license similar to prior user’s right to a third party who worked the invention after the examiner’s decision of refusal became final and binding.

7) Should it be possible to extend the patent term in respect of matter contained in the original application by filing divisional, continuation or continuation—in—part applications, including divisional, continuation or continuation—in—part applications containing added matter?

Such extension should not be possible.
8) In the opinion of your Group, would it be justified to limit the access to filing divisional, continuation or continuation-in-part applications primarily with the object of limiting the backlog of patent granting authorities?

It would not be justified to directly limit the number, the number of generations or the filing period of divisional applications, etc. However, other measures may be taken for limiting the backlog of patent granting authorities.

If the applicants were required to attach a written explanation stating how the invention claimed in the divisional application is related to the original patent application, by the time of requesting examination for the divisional application at the latest, as we have proposed, it would be extremely effective for avoiding an increase in backlog of patent granting authorities. Specifically, it would be beneficial for patent granting authorities if the applicant clearly indicated (e.g., underlined) the parts of the divisional application, etc. that have been changed from the original application, or explained the differences in the contents of the divisional applications, etc. If multiple divisional applications, etc. have been filed based on the same original application. Such document would be beneficial for third parties as well. Furthermore, if an increase in the number of generations of divisional applications, etc. is to cause some clear hindrance, consideration should be made on measures such as increasing the costs (e.g. filing fees) as the generation of the divisional application becomes higher. Although the term of protection of a patent based on a divisional application, etc. becomes shorter due to the delay in the patent grant, the associated patent fees would normally be lower than the patent fees that would have to be paid if the divisional application had been filed as a separate application at the time of filing the original application. Therefore, we think such a measure would not be harsh for the applicants, while it is expected to be effective for restraining abusive use of the divisional application system.

9) In the opinion of your Group, would it be desirable, in the interest of legal certainty of third parties, if databases of patent granting authorities ensured that a clear link was always indicated between original patent applications and all divisional, continuation or continuation-in-part applications derived therefrom?

Yes, we think it would be desirable. Such databases would be extremely helpful for reducing the monitoring burden of third parties.

We hope that a system would be established where people can easily confirm not only the relationship between child applications and the parent application (the written statement mentioned in 4) 4. above), but also the entire status (examination results) of the group of relevant divisional applications.

National and Regional Groups are invited to make any additional comment concerning divisional, continuation and continuation in part applications which they find relevant.

We have no additional comments.

**Summary**

Divisional applications and Continuation applications should be permissible.

We support the idea of patenting a continuation application that claims different matter from the original application, even if the scope of the claims between the two applications were partially overlapping or if either application incorporated the other (but not vice versa at the same time). We consider that leaving room for applicants to acquire a patent of a more precise and thorough scope (a multi-faceted and exhaustive patent) deserves higher priority than other issues.
However, we are critical of the idea of allowing a continuation application including a claim identical to that of a refused original application. This is because the conclusive determination of patentability would be deferred and the meanings of period limitation for request for examination (in Japan, three years from the filing date) would be lost.

We are also critical of the idea of patenting a continuation application including a claim identical to that of an already patented original application. The reason is that there would be a need to address the problem of watering (bloating) in the number of patents and the problem that applicants could take advantage of lower patent fees by switching patents.

The applicant shall attach a written explanation stating how the invention claimed in a divisional application or a continuation application is related to the original patent application, by the time of requesting examination for the divisional application or the continuation application at the latest. It would be extremely effective for avoiding an increase in backlog of patent granting authorities. Such document would be beneficial for third parties as well.

We are not actively interested in introduction of the continuation–in–part application system in Japan.

Résumé

Les demandes de division et demandes de continuation et de continuation–in–part devraient être autorisées.

Nous sommes favorables à l'idée de breveter une demande de continuation qui revendique une matière différente de la demande originelle, même s'il existe un chevauchement partiel de l'étendue des revendications entre les deux demandes, ou si l'une d'elles incorpore l'autre (mais pas réciproquement et simultanément). Nous considérons que le fait de laisser aux demandeurs la possibilité d'obtenir un brevet d'étendue plus précise et plus complète (un brevet exhaustif à facettes multiples) devrait bénéficier, par rapport à d'autres questions, d'une priorité plus importante.

Nous sommes toutefois critiques vis–à–vis de l'idée d'autoriser une demande de continuation qui inclut une revendication identique à celle de la demande originelle rejetée. Ceci parce que la détermination définitive de la brevetabilité serait aiguiée, et que le sens de la limitation de période pour la demande d'examen (au Japon, trois ans à partir du dépôt de demande) serait perdu.

Nous sommes également critiques vis–à–vis de l'idée de breveter une demande de continuation qui inclut une revendication identique à celle d'une demande originelle déjà brevetée. Ceci parce qu'il y aurait besoin de répondre au problème d'un nombre exagéré de brevets, et à celui de demandeurs pouvant profiter de frais de brevet réduits en interchanging les brevets.

Le demandeur devra joindre une explication écrite indiquant comment l'invention revendiquée dans une demande de division ou demande de continuation est rattachée à la demande originelle de brevet, au plus tard au moment de demander l'examen de la demande divisionnaire ou de la demande de continuation. Ceci serait extrêmement efficace pour éviter qu'augmente le retard des autorités de délivrance des brevets. Un tel document serait également utile aux tierces parties.

Nous ne sommes pas activement intéressés à introduire le système de demande de continuation–in–part au Japon.
Zusammenfassung

Abgezweigte und Fortsetzungsanmeldungen sollten zulässig sein.
Wir unterstützen die Idee der Patentierung einer Fortsetzungsanmeldung, die einen von der ursprünglichen Anmeldung abweichenden Gegenstand beansprucht, auch wenn der Umfang der Ansprüche der beiden Anmeldungen sich teilweise überlagert oder die eine Anmeldung in der anderen enthalten ist (jedoch nicht zugleich umgekehrt). Wir glauben, dass den Anmeldern Freiraum gegeben werden muss, damit sie ein Patent von präziser und klarer umrissenem Umfang (also ein facettenreiches und umfassendes Patent) erhalten können, und dass dies gegenüber anderen Fragen Vorrang haben sollte.

Allerdings stehen wir der Vorstellung skeptisch gegenüber, zuzulassen, dass eine Fortsetzungsanmeldung einen Anspruch enthält, der mit einem Anspruch der ursprünglichen Anmeldung identisch ist. Die abschließende Feststellung der Patentierbarkeit würde nämlich auf diese Weise verzögert, und die Fristenbegrenzung für einen Prüfungsantrag (in Japan drei Jahre nach der Einreichung) würde ihre Bedeutung verlieren.


Der Anmelder sollte eine schriftliche Erläuterung beifügen, die darlegt, inwiefern die in einer abgezweigten oder Fortsetzungsanmeldung beanspruchte Erfindung mit der ursprünglichen Patentanmeldung verwandt ist, und zwar spätestens zum Zeitpunkt des Prüfungsantrags für die abgezweigte Anmeldung oder die Fortsetzungsanmeldung. Dies wäre ein äußerst effektives Mittel, um einen zunehmenden Bearbeitungsrückstand der Patenterteilungsbehörden zu verhindern. Ein derartiges Dokument wäre zudem auch für Dritte nützlich.

An der Einführung eines Teilfortsetzungssystems besteht in Japan kein aktives Interesse.