

Requirements for Divisional Applications

Since the subject matter cannot be shifted after the examination under the new law enacted in 2007, divisional applications are important in Japan.

1. When can divisional applications be filed?

Divisional applications can be filed whenever an amendment can be filed, as shown by lighter dots in Figs. 1A. If the parent application was filed on or after April 1, 2007, the new law applies and a divisional application can also be filed within 30 days (extendible for 30 days) after an allowance and four months after a decision of rejection as shown by darker dots in Figs. 1A and Figs. 1B.

It should be noted, however, that no divisional application can be filed after the patent issuance, which is typically a few days after the issue fee is paid. Furthermore, once an appeal is filed, no divisional application can be filed after an allowance or decision of rejection, as shown in Fig. 1B.

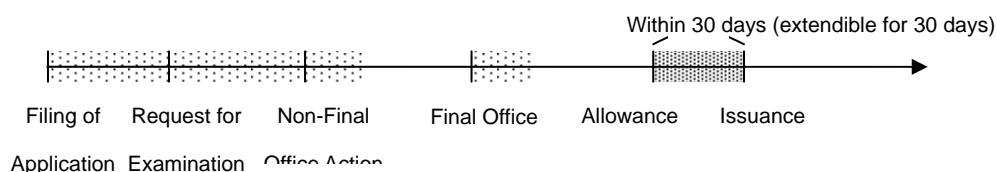


Fig. 1A

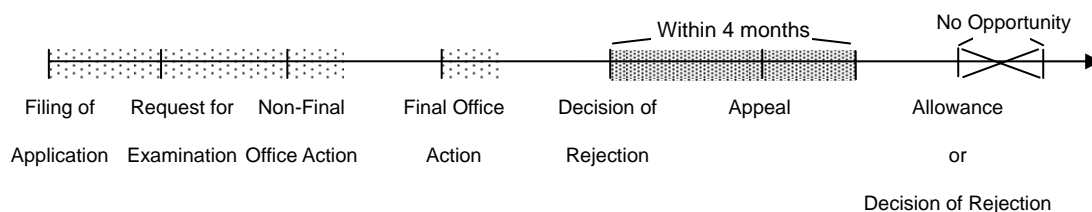


Fig. 1B

2. Contents of divisional application

Under the new law, a divisional application must be made within the contents of the parent application as pending, if the divisional application is filed after an allowance. We would suggest that a copy of deleted claims be kept within specification for dividing deleted claims after an allowance.

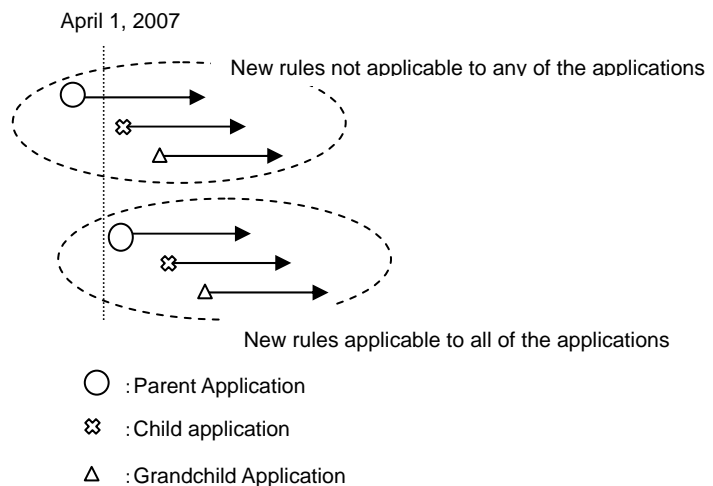
After the divisional application is filed, no new matter can be added even if the new matter was described in the parent application. Accordingly, we would advise that a divisional application be the same as the pending parent application and a preliminary amendment be filed thereafter.

3. Amendment requirements in divisional applications

Under the new law, if a notice of reasons for rejection was issued for one patent application that belongs to the same parent and divisional family, the reasons for rejection must be cured in each other application of the same family before the first official action is issued for that application. Otherwise, the amendment requirements for responding to a final office action are imposed on the other applications, even if the office action is not made final.

4. Applications to which the new law applies

The new law applies to any applications, where earliest parent of which was filed on or after April 1, 2007.



If you have any question, please feel free to contact us at cases_to_jp@ryuka.com.

Thank you

Aki Ryuka
Goichi Morikawa
April 16, 2009