



**Sonderhoff & Einsel News Update:
IP Newsletter (April 2023)**

Suspension of Examination for Divisional Applications during the Review of the Parent Application

Effective April 1, 2023, the Japan Patent Office (JPO) has introduced a new practice to suspend examination of certain divisional applications filed with the appeal (or thereafter) of the parent application. This change aims to provide more efficient and effective application strategies for applicants.

1. Overview

Starting April 1, 2023, the JPO applies Article 54(1) of the Patent Law to suspend the examination of eligible divisional applications, upon request by the applicant, until a grant of a patent is rendered in the reconsideration stage by an examiner or the results of the appeal is determined for the parent application.

2. Eligible Applications

Eligible applications are those for which examination requests are filed on or after April 1, 2023, and meet all of the following criteria:

- (1) The divisional application was filed after decision of refusal of the parent application,
- (2) The parent application is undergoing an appeal (including a reconsideration procedure) against the decision of refusal, and
- (3) It is advantageous to wait for the results of the appeal (or the reconsideration procedure).

3. Required Procedures

To apply for this practice, the applicant must submit a petition for applying Article 54(1) of the Patent Law to the divisional application and send corresponding information through a

dedicated online form within five working days from the examination request date of the eligible divisional application.

4. Effect

After determining whether the divisional application is eligible for this practice, the JPO will notify the applicant by email and create a response record. When the application is deemed eligible, the examination will be suspended for up to three months following one of the following events:

- (1) A certified copy of the decision of grant is delivered to the applicant as a result of a reconsideration procedure,
- (2) A certified copy of the first appeal's decision is delivered to the applicant, or
- (3) The appeal is withdrawn or dismissed.

Once the suspension period ends, the examination will proceed in the usual order. Even during the suspension period, the applicant may amend the documents of the divisional application based on Article 17(2) of the Patent Law.

5. Our Recommendation

For important applications, we highly recommend utilizing this new practice when the applicant receives a decision of refusal and decides to file an appeal. In our view, this new practice is very useful because it further enhances the backup function of such divisional applications. For example, the applicant can get at least a three-month period to amend the divisional application by taking the results of the appeal into consideration and try to obtain further IP rights for patentable inventions which the applicant missed in the parent application even after receiving the appeal's

decision or after receiving the decision of grant as a result of a reconsideration procedure.

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