

日本特許庁(JPO): 拒絶査定がされた出願を親出願とする分割出願の審査中止申請について

特許庁リンク「原出願が審判係属中の分割出願に対する審査中止の運用について」(日本語のみ)

https://www.jpo.go.jp/system/patent/shinsa/general/bunkatu-shutugan_chushi.html

拒絶査定を受けた親出願から分割出願をする場合に、親出願の拒絶査定不服審判の結果が判明するまで当該分割出願の審査を中止する申請ができるようになりました。

拒絶査定を受けた出願人が審判請求時に分割出願をすることはよくありますが、審判手続の進行は、一般に分割出願の審査の進行より遅いため、親出願の審判手続きの展開を見る前に分割出願の拒絶理由通知への対応を余儀なくされてしまいます。

そこでJPOは、(1)分割出願が、その分割がされた直前の親出願の拒絶査定後に出願され、(2)その親出願について拒絶査定不服審判請求がされて現に前置審査又は拒絶査定不服審判に係属中であり、(3)具体的な発明特定事項を含む請求項について2023年4月1日以降に分割出願の審査請求がされ、その審査請求日から5開庁日以内に審査中止の申請がされた場合に、分割出願の審査を中止する新たな運用を開始しました。

なお、具体的な手続上の留意点として、申請時に加えて、中止の終了時にも上申書の提出が必要となり、親出願の審判の結果(前置審査による特許査定を送達、審決を送達、または審判請求／出願の取下げのいずれか)を踏まえた分割出願の対応を説明する必要があります。

分割出願の審査中止申請は、不服審判請求人の標準的選択肢として活用が見込まれます。

Japan Patent Office (JPO): Request for deferral of examination on a divisional application filed after a decision of refusal on a patent application

JPO website link (Japanese only):

https://www.jpo.go.jp/system/patent/shinsa/general/bunkatu-shutugan_chushi.html

The JPO started a new practice that, on request of the applicant, it may defer the examination of a divisional application filed after issuance of a decision of refusal on its direct parent application until a certain result of the appeal examination comes up, provided that the examination request on the divisional application is filed on or after April 1, 2023.

An applicant who received a decision of refusal often files a precautionary divisional application in case of unsuccessful appeal, but the appeal proceedings take more time than the examination of a divisional application. The applicant generally receives a notice of reasons for refusal (office action) against the divisional application much earlier than the result of the appeal in the parent application and thus is compelled to respond to it at an unexpectedly earlier timing.

Under the new JPO practice, examination of the divisional application may be deferred when the following three requirements are met: (1) the divisional application is filed after the issuance of a decision of refusal against its direct parent application; (2) an appeal against the decision of refusal has been filed for the parent application and is pending; and (3) a request for examination is filed for the divisional application on or after April 1, 2023 with substantial claims and the request for deferral is filed within 5 working days from the date of the examination request.

When the deferral request is granted, the examination will not be started unless the applicant receives a decision to grant a patent issued by the prosecution examiner who conducted the "pre-appeal review", receives an appeal decision, or withdraws the appeal or the parent application. Then, upon occurrence of any of these events, the applicant is required to submit the applicant's comments on the divisional application in view of the details of such event.

This new practice of deferral of examination of a divisional application is expected to be utilized as a standard option for many applicants who file an appeal against a decision of refusal.