



Request for Suspending Examination of Divisional Application filed while Parent Application is Pending Appeal

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1. Background and updates

- When both an appeal and a divisional application are filed against the decision of refusal of the original application (“parent application” of the divisional application), it is sometimes convenient to have the divisional application examined after the outcome of the appeal is obtained.
- The recent updates made it possible:
 - to request suspending the examination of the divisional application filed while the parent application is pending an Appeal (update in 2023), and
 - to request the resumption of the examination (update in 2024).

2. Benefits

- The JPO can examine the divisional application with the result of the Appeal case taken into consideration, by suspending the examination of the divisional application.
- The Applicant can consider an effective claim scope for the divisional application, or even abandon the same, with the result of the Appeal case taken into consideration.

3. Requirements for suspending an examination of divisional application

The request for suspending the examination is applicable to the divisional application for which the following conditions apply:

- (i) The request for examination was filed on or after Apr. 1, 2023, and
 - (ii) The examination has not yet been started.
- The suspension is applicable only to a first-generation divisional application.

3. Requirements for suspending an examination of divisional application

For the request to suspend the examination, the following requirements must be satisfied:

- (1) the divisional application was filed after the Decision of Refusal was made for the parent application,
- (2) an appeal was filed against the Decision of Refusal and the appeal examination is still pending, and
- (3) it is considered convenient to get the outcome of the appeal earlier than proceeding with the examination on the divisional application.

➤ Requirement (3) is considered satisfactory for most cases.

4. How to request a suspension

For formalities:

(1) A first statement for requesting the suspension must be filed through the JPO electronic filing system (or by post), and

(2) A second statement for requesting the suspension must be filed through an electronic form on the JPO website :

https://mm-enquete-cnt.jpo.go.jp/form/pub/jpo20/bunkatsu_chushi

4. How to request a suspension

- The submission of both statements (1) and (2) must be completed within 5 working days from the date of request for examination for the divisional application.
- Statements (1) and (2) are to explain that the above-mentioned requirements (i), (ii) and (1) to (3) are satisfied.
- Unless both statements (1) and (2) are submitted as the specified manner, the request is not acceptable.

5. Period of suspension

The examination will be suspended until a day that is 3 months after any of the following events:

- (1) Delivery of Notice of Allowance by the Examiner (if the case went through a pre-appeal stage) to the Applicant.
 - (2) Delivery of Appeal Decision to the Applicant.
 - (3) Withdrawal or dismissal of the appeal.
- The JPO will notify the Applicant/Attorney of the end of the suspension period via e-mail.

6. Request to resume the examination

The applicant of the divisional application, of which examination is being suspended by the request, can request resumption of the examination before the end of the suspension period.

7. How to request the resumption

To request resumption of the suspended examination, the applicant must file two statements by the end of the previously mentioned suspension period:

(1) A first statement requesting the resumption of the examination, including the reasons why the divisional application should be prosecuted, through a regular filing method (JPO electronic filing system or by post), and

(2) A second statement for requesting the resumption filed through an electronic form on the JPO website:

[〈特許法第54条第1項の適用による審査中止がなされている分割出願の審査再開の申請用フォーム〉](#)（外部サイトへリンク）

7. Tips

- If the divisional application becomes unnecessary after the “parent” application is granted, it is recommended to file a written withdrawal or abandonment, and to request a refund of the examination fee.

7. Tips

- When the divisional application is to be prosecuted, a voluntary amendment should be considered, before the examination is started:
 - (i) To make the claim scope of the divisional application different from that of the parent application.
 - (ii) To avoid Art 50bis notification.

- An Art. 50bis notification is issued if the rejection for the divisional application is the same as that reported for the parent application. If the Art 50bis notification is given, an admissible amendment after the first OA would be restricted to the same extent as that for the final OA.



Thank you for your attention!!



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