Divisional Application Strategies for Building a Flexible and Robust Patent Portfolio

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Scope of This Presentation

1. Fundamentals of Divisional Applications in Japan
2. Building a Patent Portfolio Through Divisional Applications
3. Practical Strategies and Key Considerations
4. Case Studies

What Is a Divisional Application?

- A divisional application is a system that allows an applicant to extract part of the inventions contained in a patent application and file it as a separate application. (Article 44 of the Japanese Patent Act)
- If a patent application is lawfully divided, the divisional application is deemed to have been filed at the time of filing of the original application.

- Therefore, documents published after the filing date of the original application but before the filing of the divisional application **do not constitute prior art** against the divisional application.

However, certain requirements must be satisfied.

- The claims of the divisional application must remain **within the scope of the disclosure in the description, claims, and drawings of the original application** as originally filed.
- A divisional application may be filed **only during the statutorily prescribed periods.**

Key Points of Divisional Applications

Retroactive effect of the original filing date

Prohibition against the introduction of new matter

Restrictions on the timing of filing

Building a Patent Portfolio Through Divisional Applications

Why Are They Important?

It is impossible to identify the optimal claims from the outset.

- At the time of filing, it is impossible to know precisely which claims will be enforceable against future competing products.

Competitors may design their products to avoid the claims of granted patents.

- During patent prosecution, the relevant prior art and the configurations of the products to be covered may become clearer.
- A single patent application may not adequately cover all aspects of an invention.

Role of Divisional Applications

Divisional applications enable an applicant to obtain claims directed to different aspects of an invention at a later stage while retaining the filing date of the original application.

Building a Flexible and Robust Patent Portfolio

1. Building a network of patent rights in preparation for future developments
2. Obtaining patents that cover later-developed products after such products have entered the market

Strong Deterrent Effect Against Competitors

1. Strong Deterrent Effect

Reviewing granted patents alone is not sufficient.
As long as a chain of divisional applications remains pending, additional divisional patents with different claims may subsequently be granted within the scope of the disclosure in the original application as originally filed.

2. Scope of a Competitor's Freedom-to-Operate Analysis

A competitor's freedom-to-operate, or FTO, analysis should cover:

1. Granted patents
2. Published pending patent applications
3. Ultimately, the entire scope of the disclosure in the original application as originally filed

3. Building a Robust Patent Family in Japan and the United States

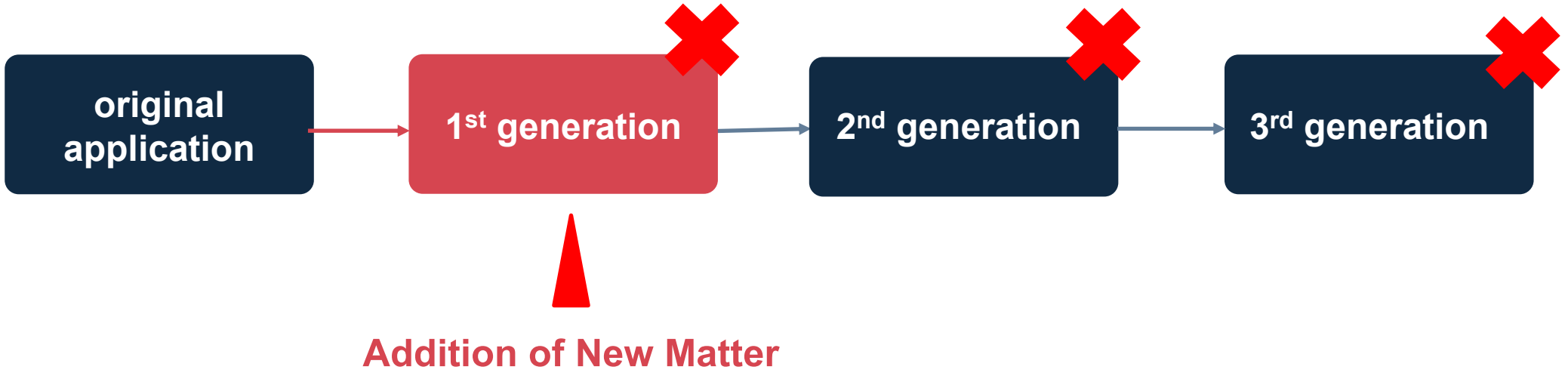
Continuation applications are widely used in the United States.
By filing divisional applications in the corresponding Japanese family, a robust patent family can be developed in both Japan and the United States.

Practical Strategies and Key Considerations

Requirements for a Divisional Application

1. The description or drawings of the original application must have contained two or more inventions.
2. The invention claimed in the divisional application must constitute part of the inventions described in the description or drawings of the original application.
3. The invention claimed in the divisional application must remain within the scope of the matters disclosed in the description, claims, and drawings of the original application as originally filed.
4. The divisional application must be filed within a statutorily prescribed period.
5. Each generation in the chain, including the parent, child, and grandchild applications, must independently satisfy the requirements for division.

Risk of Introducing New Matter

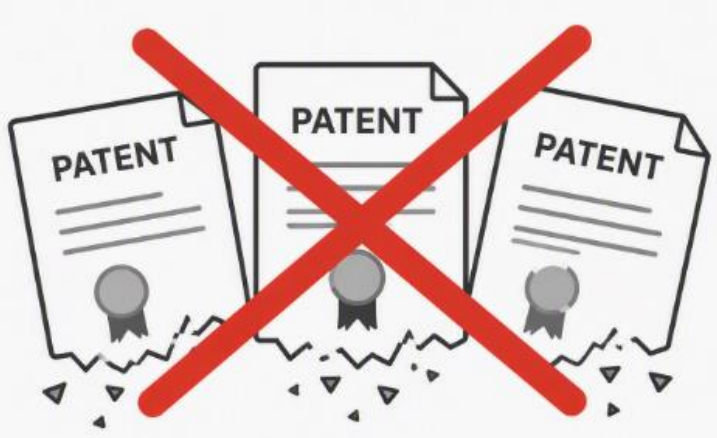


- The divisional application may lose the benefit of the filing date of the original application.
- As a result, the published patent application for the original application may constitute prior art against the divisional application.

This may also have serious consequences for applications filed in subsequent generations.

All Later-Generation Divisional Patents May be Invalidated

If an intermediate application in a chain fails to satisfy the requirements for division, a subsequent application will be unable to claim the benefit of the filing date of the first original application, even if the subsequent application satisfies the requirements for division in relation to its immediate parent application. As a result, the patent based on the subsequent application may be held invalid.



Point 1: Preparing a Comprehensive Original Specification

The original specification serves as an “arsenal” for future divisional applications.

- The scope of future divisional applications is largely determined by the extent and detail of the disclosure included in the original specification.

- For important inventions, the original specification should be prepared comprehensively with future divisional applications in mind.

Examples

1. Include multiple working examples and reference examples.
2. Specifically disclose alternative configurations and variations.
3. Explain the functions and effects of different combinations of elements.
4. Do not merely describe elements A, B, and C separately. If the applicant may wish to pursue an “A + C” combination in the future, that combination should also be disclosed.
5. Clearly describe in words any elements that appear only in the drawings.

Point 2: Managing the Timing of Divisional Applications

Periods During Which a Divisional Application May Be Filed

- During a period in which amendments to the description, claims, or drawings are permitted
- Within 30 days after service of a certified copy of the decision to grant a patent, provided that the patent right has not yet been registered
- Within three months after service of a certified copy of the examiner's initial decision of refusal

Practical Docketing and Management Point

- Establish a workflow that requires consideration of a divisional application whenever a certified copy of a decision to grant a patent is received.

- If a divisional application is to be filed, complete the filing before paying the registration fees for the parent application. If the registration fees are paid first and the establishment of the patent right is registered, it will no longer be possible to file a divisional application during this post-allowance period.

Point 3: Maintaining a Secure Divisional Chain

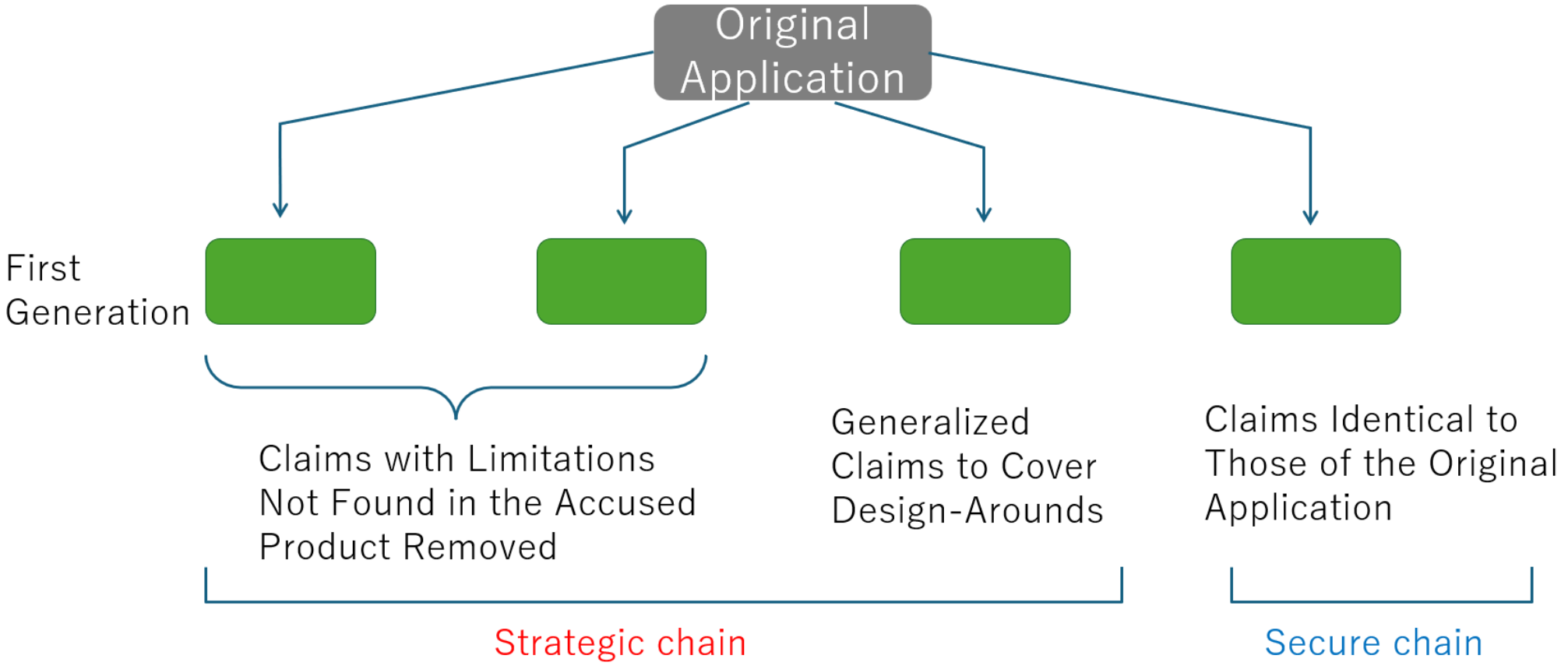
Distinguish Between a "Secure Chain" and a "Strategic Chain"

When filing a divisional application designed to cover a competitor's product, particularly where there is a risk that the claims may be found to introduce new matter, the applicant should simultaneously maintain a separate and secure divisional application that does not present such a risk.

- **Secure chain:** Maintains the original filing date and preserves the possibility of obtaining and enforcing divisional patent rights against future competing products.
- **Strategic chain:** Pursues broader or more abstract claims, based on the configuration of a competing product identified through warning-letter correspondence or litigation, by removing limitations that would otherwise result in a finding of non-infringement.

Point 3: Maintaining a Secure Divisional Chain

Kosmek Ltd. v. Pascal Engineering Corporation
2017 (Ne) No.10094 · 2018 (Ne) No.10003



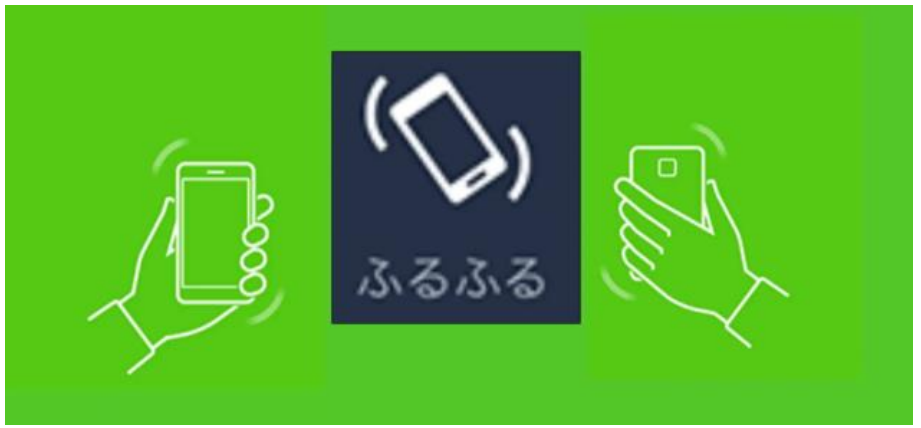
Case Study 1: The LINE “Furu-Furu” Case

Future Eye Co., Ltd. v. LINE Corporation
Tokyo District Court, Case No.2017 (Wa) 36506

- Patent: Based on a 68-page specification
- Accused feature: LINE’s “Furu-Furu”
- The patent asserted in the litigation resulted from a seventh-generation divisional application.

LINE’s “Furu-Furu”

- The “Furu-Furu” was provided in LINE, a free communications application. When nearby users shook their smartphones at the same time, their respective location information was transmitted to a server, and the users were added to each other’s “Friends” lists.
- The feature enabled users to exchange messages through the application without disclosing their telephone numbers or email addresses.



Case Study 1: The LINE “Furu-Furu” Case

Sequence of Events

(1) Warning Letter

Future Eye sends a warning letter

(2) Response

LINE argues that certain claim limitations are not met

(3) Divisional Application

Future Eye files a divisional application

(4) Litigation

Future Eye sues for infringement

(5) Decision

The court finds no infringement

(6) Another Divisional Application

Further divisional application, removing the unmet claim limitations

(7) Another Litigation

(8) Infringement Found

Infringement found under the seventh-generation patent

Case Study 2: Electrical Connector Assembly Case

Hirose Electric Co., Ltd. v. J.S.T. Mfg. Co., Ltd.

- IP High Court, Case No.2016 (Ne) 10047
- Invention: A structure designed to prevent the inadvertent disengagement of a cable connector

Sequence of Events

(1) Warning Letter

The patent owner sent a warning letter

(2) Response

Design Modification and Non-Infringement Argument

(3) Divisional Application

Broader Claims that Omitted the Modified Design Elements *(Dimensions of Locking projection and Groove Removed)*

(4) Infringement Found

Lesson from the Case Studies

- A Detailed Original Specification + Strategic Divisional Applications
- Powerful tools for both patent prosecution and litigation
- Use a divisional application to remove limitations added by a design change, or unmet claim limitations.

Summary

➢ Key Elements of an Effective Divisional Application Strategy

1. Prepare a Comprehensive Original Specification
   - Prepare the specification with future divisional applications in mind.
2. Carefully Manage the Timing of Divisional Applications
   - Build divisional review into the patent grant workflow.
3. Maintain a Secure Divisional Chain
   - Distinguish between a “secure chain” and a “strategic chain.”

Thank you!

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