Country Report 2026 from the Japan Group

Kunio ARAKI

Hiroyasu NINOMIYA

I. Introduction

This year, we highlight two developments of particular importance to Japanese patent practice. The first relates to revisions to the JPO Examination Guidelines for Patents and Utility Models, including clarification of the criteria for assessing inventive step and the extent to which disclaimer amendments are permissible, in relation to the addition of new matter. The second relates to an IP High Court decision on the requirements for divisional applications and the loss of the benefit of an earlier filing date. A brief overview of each is provided below.

II. Overview of Revision to the Examination Guidelines for Patents and Utility Models (July 2026 Revision)

The revision aims to improve the clarity and consistency of patent examination and to provide more concrete guidance for practical decision-making by examiners.
The revised Examination Guidelines apply to examinations conducted on or after **July 1, 2026**.

1. Areas of Revision

- Determination of the claimed invention
- Inventive step
- Earlier-filed applications under the expanded prior application provision
- Secret Prior Art
- Amendments introducing new matter
- Foreign-language applications
- Examination of foreign-language applications
- Alignment amendments relating to international applications (PCT applications)

2. Specific Revisions

2.1 Determination of the Claimed Invention

The revised Guidelines expressly state that examiners must, in all cases, confirm the filing date (or, where relevant, the filing time) of a patent application when determining the claimed invention.
In particular, for specific types of applications, such as divisional applications, examiners are required to first determine whether the applicable statutory requirements have been satisfied and, based on that determination, confirm the filing date (or filing time) to be

accorded to the application.

2.2 Inventive Step

The revised Guidelines clarify the framework for assessing factors relevant to inventive step, including factors supporting and militating against a finding of inventive step.

(1) In assessing inventive step, examiners are required to consider not only the existence or absence of factors that support a conclusion of lack of inventive step (e.g., a motivation to combine prior-art teachings) and factors that support a conclusion of inventive step (e.g., teaching-away considerations or other discouraging factors), but also the relative strength or weight of such factors.

(2) When considering factors such as routine design modifications or teaching-away considerations, examiners should not place undue emphasis on the technical problem explicitly stated in a cited reference. The Guidelines clarify that consideration may also be given to technical problems that would have been readily apparent to a person skilled in the art, as well as problems that such a person could have easily conceived based on common general knowledge at the time of filing after reviewing the cited invention.

(3) The Guidelines further clarify that factors impeding the reasoning leading to the claimed invention (i.e., teaching-away factors or other discouraging considerations) may vary in their significance as indicators supporting the presence of inventive step. Such factors are not to be evaluated in isolation but rather in a holistic manner together with other relevant considerations, including motivation to combine and the possibility of routine design modifications.

Comment:

A notable aspect of this revision is that the JPO expressly adopts a more nuanced and holistic assessment of inventive step. Rather than treating factors such as motivation to combine or teaching away as merely present or absent, examiners are instructed to evaluate their relative weight and to balance them against one another when determining whether a claimed invention would have been easily conceived to the skilled person.

2.3 Secret Prior Art

The expanded prior application provision (Secret Prior Art) does not apply where, at the time of filing the patent application, the applicant of that application is the same as the applicant of the prior application.

The revised Guidelines clarify that, when determining whether the applicants of two applications are identical for the purposes of the expanded prior application provision, the assessment should be made on a substantive basis, taking into account circumstances such as changes in the applicant's name or ownership transfers.

Accordingly, the determination of applicant identity is not based solely on the formal

applicant information appearing in the records at a particular point in time. Rather, examiners are instructed to consider whether the applicants should be regarded as substantively identical in light of the relevant legal succession or recordal history.

2.4 Prior Application Provisions

The revised Guidelines clarify the handling of situations involving competing applications filed on the same date.

Specifically, where a conflicting application filed on the same date has not been subjected to a request for examination, an examiner may proceed to issue a final rejection if other grounds for refusal remain unresolved, even though the applicability of the prior application provision cannot yet be conclusively determined.

This clarification is intended to avoid unnecessary delays in examination by making clear that examination need not be suspended solely because a same-day competing application remains pending without a request for examination, provided that independent grounds for refusal continue to exist.

2.5 Amendments Introducing New Matter

The revised Guidelines clarify the criteria for determining whether an amendment in the form of a disclaimer (i.e., an amendment converting a claim into an exclusionary claim) introduces new matter. The purpose of the revision is to dispel the misconception that any amendment merely excluding overlap with a cited invention is automatically allowable.

(1) The Guidelines expressly state that a disclaimer amendment is permissible where it excludes only the portion overlapping with the cited invention and does not result in the claim encompassing an invention that is markedly different in technical concept from the originally claimed invention.

The term *"an invention markedly different in technical concept"* is defined as an invention that differs to such an extent that a person skilled in the art would understand that it could not reasonably have been contemplated as being encompassed, from the outset, within the technical concept of the invention as originally claimed.

(2) The Guidelines further clarify that it is not sufficient for an applicant merely to assert that the excluded subject matter is “markedly different in technical concept.” Rather, the applicant is expected to explain why, in light of factors such as the technical problem addressed by the claimed invention and the common general knowledge at the filing date, the excluded subject matter would be understood by a person skilled in the art as something that could never reasonably have been considered part of the technical concept of the invention as originally claimed.

Comment:

This revision narrows the focus from the formal question of whether the disclaimer merely removes overlap with prior art to a substantive assessment of the technical relationship

between the remaining claimed subject matter and the invention as originally disclosed. The key issue is whether the post-amendment claim still remains within the technical concept that a skilled person would have understood from the application as filed. Mere exclusion of the cited embodiment is therefore not, by itself, sufficient to avoid an objection for added matter.

2.6 Foreign-Language Applications

The revised Guidelines clarify the substantive requirements applicable to divisional applications and related procedures where the parent application was filed as a foreign-language application.

(1) The Guidelines expressly state that, before a Japanese translation has been filed, the specification, claims, and drawings of a foreign-language application are not deemed to exist for procedural purposes. Consequently, because the application is not yet in a stage where amendments may be made, a divisional application cannot be validly filed during that period.

(2) The Guidelines further clarify the criteria for determining whether the subject matter of a divisional application remains "within the scope of the original application as filed." Specifically, the subject matter of the divisional application must be:

- within the scope of the foreign-language text originally filed for the parent application; and
- within the scope of the matters described in the Japanese translation thereof, including any matters that may be introduced through permissible correction of translation errors.

(3) In addition, where the parent application contained a mistranslation immediately prior to the filing of the divisional application, the divisional application will be regarded as valid only if any amendment intended to correct that mistranslation falls within the scope of corrections that would have been allowable as a correction of a translation error in the parent foreign-language application itself.

2.7 Examination of Foreign-Language Applications

The revised Guidelines clarify the treatment of amendments filed through a Request for Correction of Translation Errors where it is evident that the amendment is not genuinely intended to correct a translation error.

(1) For a foreign-language application, a Japanese translation must, in principle, be filed within 16 months from the filing date (or priority date). The Guidelines expressly state that applicants may not circumvent this requirement by filing only a small portion of the translation within the prescribed period and subsequently adding the remaining substantial portions of the translation through a purported correction of translation errors.

(2) Such an attempt will be treated in the same manner as an ordinary amendment. Consequently, where the later-submitted text introduces matter that was not contained in the originally filed Japanese translation, it will be regarded as the addition of new matter to the translation and may give rise to a ground for refusal.

2.8 Alignment Amendments relating to International Applications

The revised Guidelines expressly state that, for international patent applications (PCT applications), particularly those filed in a foreign language, the same standards as those introduced for foreign-language applications will apply.

III. Vehicle Guidance System" Case: IP High Court Judgment (Violation of the Requirements for Divisional Applications)

Summary:

The IP High Court rendered a judgment in a suit seeking revocation of a decision of the Japan Patent Office (JPO) that had dismissed a request for invalidation of a patent for a "vehicle guidance system." The issue was whether the fifth-generation divisional application, an upstream divisional application of the seventh-generation divisional application on which the patent was granted, violated the requirements for divisional applications by removing features deemed essential in the parent application and generalizing the invention, and thereby lost the benefit of the retroactive filing date. The court held that the fifth-generation application, which generalized the essential features without limitation, introduced new technical matter and did not satisfy the requirements for divisional applications, and revoked the JPO decision on the ground that the patent lacked novelty over the publication of the earliest original application.

[Overview]

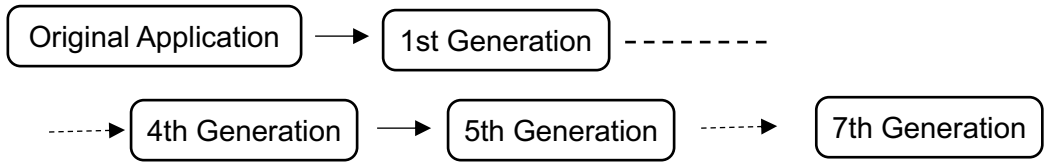
This is a suit seeking revocation of a decision of the Japan Patent Office (JPO). In an invalidation trial requested against Japanese Patent No. 6159845 for a "vehicle guidance system" (the "Patent"), the JPO rendered a decision dismissing the request (the "JPO decision"), and the demandant of the invalidation trial (the "Plaintiff") filed suit against the patentee (the "Defendant") seeking revocation of the JPO decision.

[Issues]

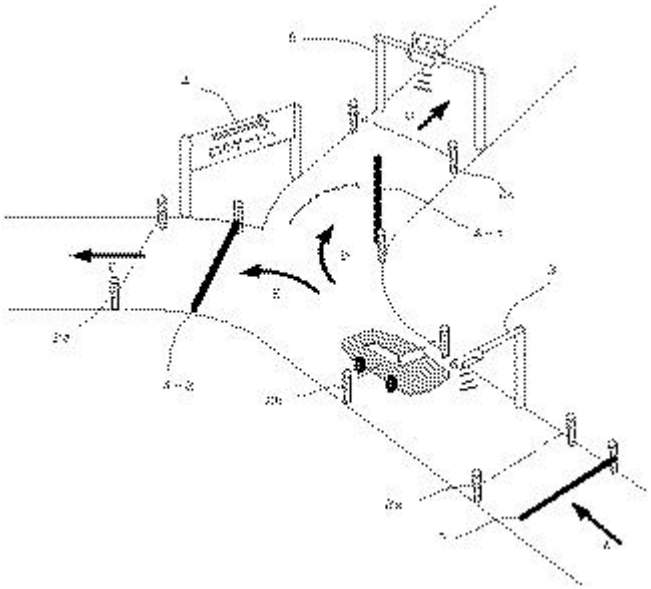
The issue was whether the fifth-generation divisional application, an upstream divisional application of the seventh-generation divisional application on which the Patent was granted, satisfied the requirements for divisional applications (Article 44(1) of the Patent Act) such that it would be deemed to have been filed on the filing date of the earliest original application (September 13, 2004) (the "Original Application"), and, consequently, whether the Patent lacked novelty over the publication of the Original Application (JP 2006-79580 A). Although lack of

inventive step was also argued as a ground for invalidation, this report focuses on the court's findings regarding the requirements for divisional applications.

[Divisional Application Family]



[Invention of the Patent (Invention Recited in Claim 1 of the Patent)]



A system for guiding vehicles entering and exiting through an ETC-only entrance/exit installed at a toll road tollgate, service area, or parking area, the system comprising:
a first detection means for detecting a vehicle entering or exiting the toll road tollgate, service area, or parking area;
a first barrier installed corresponding to the first detection means;
a communication means for communicating data with an ETC on-board unit mounted on a vehicle;
a determination means for recognizing data received by the communication means and determining whether toll collection by ETC is possible; and
a guidance means for, according to a result of the determination by the determination means, guiding a vehicle for which toll collection by ETC is possible to a first lane leading to a route that passes through an ETC gate and enters the toll road tollgate, service area, or parking area, or exits the toll road tollgate, service area, or parking area, and guiding a vehicle for which toll collection by ETC is not possible to a second lane leading to a route returning again to a point in front of the ETC-only entrance/exit or to a general vehicle entrance/exit,
wherein the guidance means includes a second barrier provided in the first lane and a third barrier provided in the second lane,
the system further comprising a second detection means for detecting a vehicle that has passed the second barrier, and a third detection means for detecting a vehicle that has passed the third

barrier,
wherein, when entry of a vehicle is detected by the first detection means, the first barrier is lowered after the vehicle has passed, and when passage of a vehicle is detected by the second detection means, the second barrier is lowered after the vehicle has passed.

*ETC: Electronic Toll Collection

[Claims of the Fifth-Generation Divisional Application]
(Only Claim 1 is shown for reference. The text is as amended by the written amendment dated February 4, 2016.)
[Claim 1]
A smart interchange having an ETC-only entrance tollgate provided in an entrance-side lane leading from a general road to a parking area or service area of a toll road, wherein, as a means by which a vehicle can leave the entrance tollgate, a lane that branches off partway along the entrance-side lane and returns to the general road is provided, thereby making the entrance-side lane a three-forked lane; a barrier is provided at each of one location before the branch point and two locations, left and right, beyond the branch point in the three-forked lane; and, triggered by detection of a vehicle by a vehicle detection device provided in the entrance-side lane before the branch point, one of the barriers at the two left and right locations beyond the branch point, which had been closed until then, remains closed while the other opens.

*Smart interchange: A simplified ETC-only interchange provided at a service area (SA), parking area (PA), or the like

[Court's Decision]
<Outline of the Case>
The invention of the fifth-generation divisional application relates to a system in which a branch lane returning to the general road is provided partway along a lane leading to an ETC-only entrance at a parking area or the like of a toll road, thereby forming a three-forked lane; barriers are provided before and beyond the branch point; and vehicles are guided by opening and closing the barriers upon detection by a vehicle detection device. On the other hand, the description, claims and drawings of the fourth-generation divisional application as originally filed (the "Original Fourth-Generation Specification, etc.") described a technique for eliminating congestion and the risk of rear-end collisions when wireless communication between the roadside antenna and the on-board unit is not possible, by causing vehicles unable to use ETC to leave the ETC-only lane through a lane that branches off from it and leads either back to the tollgate for re-entry or to a general vehicle lane.
<Court's Reasoning>
The JPO found that the invention of the fifth-generation divisional application did not introduce any new technical matter and satisfied the requirements for divisional applications, accepted the

retroactive filing date, and concluded that the ground for invalidation based on lack of novelty did not hold. In contrast, the IP High Court (Judgment of September 8, 2025, Case No. 2024 (Gyo-Ke) 10086) found that the Original Fourth-Generation Specification, etc. described, as indispensable features of the vehicle guidance system invention that causes vehicles unable to use ETC to leave the ETC-only lane in order to solve the problems of congestion and the risk of collision with following vehicles, (1) that when a vehicle unable to use ETC enters the ETC-only lane, the vehicle is made to travel along the branch lane and return, and (2) that the vehicle to be returned is determined based on whether wireless communication between the ETC on-board unit and the roadside antenna is possible.

The court then held that the fifth-generation inventions contain neither a limitation on the situations in which vehicles are guided to the branch lane nor a limitation on the method of determining the target vehicles, and open and close the barriers based on any arbitrary criterion, regardless of whether a failure of wireless communication or the like is involved, thereby generalizing the above indispensable features without limitation. The court stated that "it should be said that the Original Fourth-Generation Specification, etc. does not disclose any technical idea that does not include (1) and (2) above as essential features," and that "each of the fifth-generation inventions should be regarded as introducing new technical matter in relation to the technical matters derived by integrating all of the descriptions of the Original Fourth-Generation Specification, etc." (tentative translation).

The Defendant argued that "Fifth-Generation Invention 1 was described by extracting, from the inventions described in the Original Fourth-Generation Specification, etc., only the invention relating to the guidance means that uses a vehicle detection device and barriers to guide a vehicle either to continue along the entrance-side lane or to return to the return route," and that "where the invention of the original application is a manufacturing method consisting of first and second steps, amending it to an invention consisting of only the first step does not constitute the addition of new matter; accordingly, in the present case, filing a divisional application directed only to the downstream configuration of the inventions described in the Original Fourth-Generation Specification, etc. does not constitute the addition of new matter" (tentative translation). In response, the court rejected these arguments, holding that the processing steps are interrelated and that a system omitting the main processing steps could not function as a guidance system.

Furthermore, the Defendant argued that Fifth-Generation Invention 1 was an independent invention that prevents unauthorized vehicles from entering in the reverse direction by keeping the two barriers beyond the branch point normally closed and opening one of them upon detection of a vehicle. The court also rejected this argument, holding that, because paragraph [0054] of the Original Fourth-Generation Specification, etc. expressly states that the configuration in which one of the barriers beyond the branch point remains closed while the other opens (the embodiment of FIG. 4) cannot prevent reverse entry by unauthorized vehicles, a person skilled in the art could not recognize the invention asserted by the Defendant as being described in the Original Fourth-Generation Specification, etc.

Consequently, the fifth-generation divisional application did not satisfy the requirements for

divisional applications, and it could not be deemed to have been filed earlier than its actual filing date of December 2, 2014. The application for the Patent, which descends from it, was therefore also assessed as of that date. Accordingly, the court determined that the filing date of the Patent could not be retroactive to the filing date of the Original Application (September 13, 2004), but should instead be December 2, 2014, the actual filing date of the fifth-generation divisional application. The court held that the inventions of the Patent were identical to the invention described in the publication of the Original Application and thus lacked novelty (Article 29(1)(iii) of the Patent Act), and revoked the JPO decision.

This judgment shows that, in the practice of expanding the scope of rights through successive divisional applications, a generalization that removes features deemed essential for solving the problem in the parent application may violate the requirements for divisional applications, and further that a defect in a single generation partway along a divisional family tree may cause all subsequent generations to lose the benefit of the retroactive filing date. The judgment is significant in that it may substantially affect both the explicit description of optional features at the specification drafting stage and divisional filing strategies.