

Note: When any ambiguity of interpretation is found in this provisional translation, the Japanese text shall prevail.

## **Chapter 4 Patent Act Article 39**

[Provisions applied to applications filed on and before December 31, 1998]

Patent Act Article 39 reads:

- (1) Where two or more patent applications relating to the same invention are filed on different dates, only the first applicant may obtain a patent for the invention.
- (2) Where two or more patent applications relating to the same invention are filed on the same date, only one such applicant, agreed upon after mutual consultation among all the applicants, may obtain a patent for the invention. If no agreement is reached or no consultation is possible, none of the applicants shall obtain a patent for the invention.
- (3) Where an invention claimed in a patent application is the same as a device claimed in a utility model application and the applications are filed on different dates, the patent applicant may obtain a patent only if his application was filed before the utility model application.
- (4) Where an invention claimed in a patent application is the same as a device claimed in a utility model application and the applications are filed on the same date, only one applicant, agreed upon after mutual consultation between the applicants, may obtain a patent or a utility model registration. If no agreement is reached or no consultation is possible, the patent applicant shall not obtain a patent for the invention.
- (5) Where a patent application or a utility model application is withdrawn or dismissed, such application shall, for the purpose of the four preceding Paragraph, be deemed never to have been made.
- (6) A patent application or a utility model application filed by a person who is neither the inventor nor the creator nor the successor in title to the right to obtain a patent or utility model registration shall, for the purpose of Paragraphs (1) to (4), be deemed not to be a patent application or a utility model application.
- (7) The Commissioner of the Patent Office shall, in the case of Paragraph (2) or (4), order the applicants to hold consultation for an agreement under Paragraph (2) or (4) and to report the result thereof, within an adequate time limit.
- (8) Where the report under the preceding Paragraph is not made within the time limit designated in accordance with that Paragraph, the Commissioner of the Patent Office may deem that no agreement under Paragraph (2) or (4) has been reached.

[Provisions applied to applications filed on or after January 1, 1999]

Patent Act Article 39 reads:

- (1)-(4) are omitted
- (5) Where a patent application or a utility model application is abandoned, withdrawn or dismissed, or where an examiner's decision or trial decision that a patent application is to be refused has become final and conclusive, such application shall, for the purposes of Paragraphs (1) to (4), be deemed never to have been made. However, this provision shall not apply where an examiner's decision or a trial decision that the patent application is to be refused under the provision of the last sentence of Paragraph (2) or (4) becomes final and conclusive.
- (6)-(8) are omitted

[Provisions applied to applications filed on or after April 1, 2005]

(March 2005)

Patent Act Article 39 reads:

(1)-(3) are omitted

(4) Where an invention and a device claimed in applications for a patent and a utility model registration are identical (excluding the case where an invention claimed in a patent application based on a utility model registration under Article 46bis (1) (including a patent application that is deemed to have been filed at the time of filing of the said patent application under Article 44(2) (including its mutatis mutandis application under Article 46(5)) and a device relating to the said utility model registration are identical) and the applications for a patent and a utility model registration are filed on the same date, only one of the applicants, selected by consultations between the applicants, shall be entitled to obtain a patent or a utility model registration. Where no agreement is reached by consultations or no consultations are able to be held, the applicant for a patent shall not be entitled to obtain a patent for the invention claimed therein.

(5) Where an application for a patent or a utility model registration has been waived, withdrawn or dismissed, or where the examiner's decision or trial decision to the effect that a patent application is to be refused has become final and binding, the application for a patent or a utility model registration shall, for the purpose of paragraphs (1) to (4) , be deemed never to have been filed; provided, however, that this shall not apply to the case where the examiner's decision or trial decision to the effect that the patent application is to be refused has become final and binding on the basis that the latter sentence of paragraph (2) or (4) is applicable to the said patent application.

(6)-(8) are omitted

## **1. Purport of the Provision of Patent Act Article 39**

The patent system is one to grant an exclusive right to a patentee for a limited term as a reward for disclosure to the public of an invention which is a creation of technical ideas.

Therefore, two or more such rights shall not be granted for one invention. The provision of Patent Act Article 39 makes the principle "one patent for one invention" clear so as to exclude such double patenting, and also makes it clear that, where two or more applications relating to one and the same invention are filed, only the first applicant may obtain a patent for the invention.

## **2. Patent Act Article 39**

### **2.1 Patent Act Article 39(1)**

#### **2.1.1 Invention Ruled by Article 39**

(1) It is "claimed inventions" that are subject to determination as to being the same or not under Patent Act Article 39.

According to Patent Act Article 2, an invention is defined as a highly advanced creation of technical ideas by which a Act of nature is utilized. Therefore, whether inventions are the same or not is determined by judging whether or not the technical ideas concerned are the same.

Even if certain embodiments could be common to the inventions to be judged, so

long as the technical ideas concerned are different, the inventions are not deemed to be the same.

(Reference: Sho 30 (Gyo Na) 39, Sho 42 (Gyo Tsu) 29)

(2) When an application has two or more claims, the examination under Article 39 should be made for each of the claims.

### **2.1.2 Two or More Patent Applications Filed on Different Dates; the First Patent Application**

The determination of whether two or more applications are filed on the same date or different dates, and the determination of which application is the first one, are made as follows.

(1) In the case where such an application has no priority claim, such determination is made based on the filing date (Note).

**(Note)** In the case where such an application is an international application, its international filing date is considered to be the filing date.

(2) In the case where such an application has a priority claim under the Paris Convention, as to the invention disclosed in the specification or drawings of the application which is the basis of the priority claim, such determination is made based on the priority date (In the case where two or more priorities are claimed, such determination is made based on the filing date of the application which is one of the basis of the priority claims and discloses the claimed invention to be determined.).

(3) In the case where an application has an internal priority claim, as to the invention disclosed in the original specification or drawings of the earlier application which is the basis of the internal priority claim, such determination is made based on the filing date of the earlier application (In the case where two or more priorities are claimed, such determination is made based on the filing date of the application which is one of the basis of the priority claims and discloses the claimed invention to be determined.).

## **2.2 Patent Act Article 39(2)**

### **2.2.1 One Applicant Agreed upon after Mutual Consultation among all the Applicants**

Where two or more patent applications relating to the same invention are filed on the same date, the Commissioner of the Patent Office orders the applicants to hold consultation.

Even where such patent applications are filed by one and the same applicant, such consultation is ordered in the same way as in the case where such applicants are not the same.

As to details of consultation, refer to 2.7.1

### **2.2.2 Where No Agreement Is Reached or No Consultation Is Possible**

Where two or more patent applications relating to the same invention are filed on

the same date, and if no agreement is reached or no consultation is possible, none of the applicants shall obtain a patent for the invention.

The cases where no consultation is possible are the following; where consultation cannot be held, for example because one of the applicants refuses to participate in the consultation; or where one of the applications has already been abandoned, refused finally and conclusively or patented.

In the case where one of the applications has already been abandoned, refused finally and conclusively or patented and therefore consultation cannot be held, orders to hold consultations are not to be issued and a reason for refusal under Patent Act Article 39(2) is to be notified to the other application(s).

**(Note)** In applications filed on or after January 1, 1999, where one of the applications has already been abandoned, or refused finally and conclusively, such application is deemed never to have been made, and therefore consultation cannot be held. As to the treatment in the case where one of applications has already been patented, refer to 2.7.1.

## **2.3 Patent Act Article 39(3)**

### **2.3.1 Where an Invention Claimed in a Patent Application Is the Same as a Device Claimed in a Utility Model Application**

A device, similar to an invention, is defined as a creation of technical ideas by which a law of nature is utilized. Therefore, the determination of whether an invention claimed in a patent application and a device claimed in a utility model application are the same or not is made in the same way as in the determination of whether two inventions are the same or not.

## **2.4 Patent Act Article 39(4)**

### **2.4.1 Where No Agreement Is Reached or No Consultation Is Possible**

Where an invention claimed in a patent application is the same as a device claimed in a utility model application (excluding the case the invention of the patent application based on the registered utility model and the device of the registered utility model are identical) and the applications are filed on the same date, and if no agreement is reached or no consultation is possible, the patent applicant cannot obtain a patent for the invention.

The cases where no consultation is possible are the following; where consultation cannot be held, for example, because the applicant of the utility model refuses to participate in the consultation; or where the utility model application has already been abandoned, rejected finally and conclusively or registered.

In the case where the utility model application has already been abandoned, refused finally and conclusively or registered and therefore, consultation cannot be held, no order to hold consultation is to be issued and a reason for refusal under Patent Act Article 39(4) is notified to the patent applicant.

**(Note)** In applications filed on or after January 1, 1999, where one of the applications has already been abandoned, or refused finally and conclusively, such application is deemed never to have been made, and therefore consultation cannot be held. As to treatment in the case where the utility model application has already been registered, refer to 2.7.1.

## **2.5 Patent Act Article 39(5)**

### **2.5.1 Where a Patent Application or an Utility Model Application Is Withdrawn or Dismissed**

Where a patent application or a utility model application is withdrawn or dismissed, such application is, for the purpose of Patent Act Article 39(1) to (4), deemed never to have been made.

Patent Act Article (1) to (4) is applied to an application abandoned or refused finally and conclusively, except the case where the application falls under Patent Act Article 39(6).

**(Note)** As for applications on or after January 1, 1999, where a patent application or a utility model application is abandoned, withdrawn or dismissed, or where the patent application is refused finally and conclusively, such patent application or such utility model application is deemed never to have been made. However, where the patent application is refused finally and conclusively, because of falling under the provision of the second sentence of Article 39 (2) or (4), such a case is not restricted by this paragraph.

## **2.6 Patent Act Article 39(6)**

### **2.6.1 A Person Who Is Neither the Inventor Nor the Creator Nor the Successor in Title to the Right to Obtain a Patent or a Utility Model Registration**

A patent application or a utility model application by an unauthorized applicant is, for the purpose of Patent Act Article (1) to (4), deemed not to be a patent application or a utility model application.

## **2.7 Patent Act Article 39(7)**

### **2.7.1 Consultation**

[1] Where All Applications Are Pending at the Patent Office

① Where the Applicants Are not the Same

(i) Where a request for examination has been made for each application

Consultation is ordered to the applicants in the name of the Commissioner of the Patent Office.

(a) Where the report of the result of the consultation is submitted within the designated time limit, the decision to grant a patent is made on the application of the applicant agreed upon after the consultation, unless there are no other reasons for refusal.

If the other application(s) was not withdrawn or abandoned at the time of such

decision, a reason for refusal under the Patent Act 39(2) or (4) is notified to the applicant(s) of such application(s).

(b) Where the report of the result of the consultation is not submitted within the designated time limit, it is deemed that no agreement has been reached (Patent Act Article 39(8)), and a reason for refusal under the Patent Act 39(2) or (4) is notified to all the applicants.

(ii) Where a request for examination has not been made for at least one application

In this case, no order to hold consultation is possible. Therefore, the applicant who has requested examination is notified to the effect that examination of the application is not to be conducted because a request for examination has not been made for other application(s) concerned.

After the notification, the examination is not conducted until a request for examination on the other application(s) is made and it becomes possible to order to hold consultation, or until the other application is withdrawn (including the case of expiry of the period for request for examination) or abandoned.

② Where the Applicants Are the Same

Where the applicants are the same, Patent Act Article 39(2) or (4) is also applied in the same way as the above case where the applicants are not the same, and treatment is made according to ①(i) and (ii) mentioned above.

However, when treating according to ①(i) above, the order to hold consultation in the name of the Commissioner of the Patent Office and a notice of reasons for refusal under Patent Act Article 39(2) or (4) are issued simultaneously.

(Explanation)

The purport of the provision of Patent Act Article 39(2) is that one right is granted for one invention. Therefore, this provision is also applied to the case where the applicants are the same.

In the case where the applicants are the same, the treatment is ruled as mentioned above, because the applicant does not need to have the time for holding consultation.

[2] Where One of the Applications Has Already Been Granted a Patent or a Utility Model Right

Where one of the applications has already been granted a patent or a utility model right, so long as the applicant of the pending patent application(s) is different from such patentee or the owner of the utility model right, a reason for refusal under Patent Act Article 39(2) or (4) is notified to the applicant(s) of the pending application(s) and, the fact that such a reason for refusal has been notified to such applicant(s) is communicated to the patentee or the owner of the utility model right.

However, where the patent applicant and the patentee or the owners of the utility model right are the same in the above case, such communication is not given, since such applicant can take appropriate measures by receiving the said reason for refusal.

(Explanation)

Where one of the applications has already been granted a patent or a utility model right, it is not possible to hold consultation (refer to 2.2.2 and 2.4.1). However, holding an opportunity of substantial consultation between the patent applicant and the patentee or the owner of the utility model right is considered to be useful for avoiding a possible reason for refusal or invalidation and obtaining appropriate protection. Therefore, the treatment is made as described above.

Hereinafter, explanation will be made on the case where the first application or the other application filed in the same date is a patent application, but this also applies to the

case where the first application or the other application filed in the same date is a utility model application.

### **3. Method of Determining the Identity of Claimed Inventions**

#### **3.1 Finding of a Claimed Invention**

The method of finding a claimed invention set forth in "Part II : Chapter 2. 1.5 Method of Determining whether a Claimed Invention is Novel" is also applied to the examination under Article 39.

#### **3.2 Comparison of Claimed Inventions**

The finding of the identicalness and difference between a claimed invention of one application and a claimed invention of the other application is conducted by comparing between the matters defining the claimed inventions.

#### **3.3 Method of Determining the Identity of Claimed Inventions of Two or More Patent Applications Filed on Different Dates**

(1) Where there is found no difference in matters defining an invention between an invention claimed in a later filed application (hereinafter referred to as "later invention") and an invention claimed in an earlier filed application (hereinafter referred to as "earlier invention"), the two inventions are identical.

(2) Even where there is a difference between the matters defining the later invention and the matters defining the earlier invention, the two inventions are deemed identical (substantially identical) in the following cases:

- ① in the case where the later invention can be induced from the earlier invention by such a minor change as an addition of well-known or commonly used art (Note1) to the matters defining earlier invention, a deletion of well-known or commonly used art from the matters defining earlier invention, or a replacement of any of the matters defining earlier invention with well-known or commonly used art, and where those changes generate no new effects;
- ② in the case where a difference between the two inventions resides only in that the later invention is expressed in more generic concept (Note2) which encompasses the matters defining earlier invention of a specific concept; and
- ③ in the case where a difference between the two inventions is mere difference in category expressed.

**(Note1)** "Well-known art" means technologies generally known in the relevant technical field, e.g., many prior art documents, those widely known throughout the industry, or those well-known to the extent needless to present examples.  
"Commonly used art" means well-known art which is used widely.

**(Note2)** "Generic concept" is defined as a concept integrating matters in the same family or the same genus, or a concept integrating a plurality of matters with common characteristic.

(3) Matters defining the earlier invention or the later invention are expressed by two or more alternatives

① If matters defining the earlier invention are expressed by alternatives in form or de facto (Note1), and if a later invention has no difference from or is substantially identical (the above (1)(2)) with any one of inventions each of which is identified by supposing that each of the alternatives is a matter to define each of such inventions, then, the later invention shall be deemed identical with the earlier invention as a whole.

Such an invention, however, must be able to be identified by a person skilled in the art from the claim, taking into consideration the specification (excluding claims) (hereinafter referred to as "specification" in the explanation on Article 39) and drawings of the earlier application and common general knowledge as of the filing of the earlier application. If a claim of earlier application is expressed in Markush-type formula, therefore, attention should be paid to whether or not a person skilled in the art can identify such an invention from each of the alternatives.

② If matters defining the later invention are expressed by alternatives in form or de facto (Note1), and if any one of inventions each of which is identified by supposing that each of the alternatives is a matter to define each of such inventions has no difference from or is substantially identical with an earlier invention (Note 2), then, the later invention as a whole shall be deemed identical with the earlier invention.

This handling does not relate to the issue of when a prior art search is to be finalized. See "Part IV: Procedure of Examination" in this regard.

**(Note 1)** With regard to "alternatives in form or de facto," see "Chapter 2. 1.5.5 (Note1)."

**(Note 2)** If matters defining an invention with respect to "an earlier invention" are expressed by alternatives in form or de facto, the "earlier invention" should be identified by supposing that each of the alternatives is a matter to define each of the inventions.

(Remarks)

An invention shall not be deemed as "the earlier invention" under the handling mentioned in (1) to (3) above, unless it is clear that a claimed invention of the earlier application is described in the specification and drawings in such a manner that a person skilled in the art can make the product in case of a product invention or can use the process in case of a process invention, taking into consideration the common general knowledge as of the filing of the earlier application.

For example, if a chemical substance is expressed merely by a name or a chemical formula as one of alternatives of a Markush-type claim of an earlier application and if it is not clear that a person skilled in the art can produce the chemical substance on the basis of the specification and drawings, even taking into consideration the common general knowledge as of the filing of the application, then, the chemical substance does not fall under an "earlier invention" under Article 39. (Note that this does not mean that the claimed invention of the earlier application violates the enablement requirement under Article 36(4).)

### **3.4 Method of Determining the Identity of Claimed Inventions of Two or More Applications Filed on the Same Date**

(1) Only if invention B is deemed "identical" with invention A (within the meaning of "identical" under the above-mentioned practice in 3.3(2) concerning applications filed on different dates) on the assumption of invention A being an earlier invention and invention B being a later invention, and invention A is deemed identical with invention B on the assumption of invention B being an earlier invention and invention A being a later invention, then, the two inventions filed on the same date should be considered identical.

(2) Even where invention B is identical with invention A on the assumption of invention A being an earlier invention and invention B being a later invention, the two inventions filed on the same date should not be considered identical if invention A is not identical with invention B on the assumption that invention B being an earlier invention and invention A being a later invention.

(Explanation)

In the case where such inventions A and B are filed on the same date, such inventions that the invention A is an invention of specific disclosure type and the invention B is an invention of generic concept type, and on the assumption that the invention A is an earlier invention and the invention B is a later invention, the invention B is deemed the same as the invention A, but on the assumption that the invention B is an earlier invention and invention A is a later invention, the invention A is not deemed the same as the invention B, it is not proper to consider the two inventions A and B to be identical, taking into account that, where the invention B is an earlier invention and the invention A is a later invention, the later invention A is not deemed to be the same as the earlier invention B. Further, since the provision of Patent Act Article 39(2) is one which is formulated on the premise that there are two or more applications relating to the same invention and therefore such treatment should not be made that only one of the applications has a reason for refusal under Patent Act Article 39(2), it is also not proper to send a notice of reasons for refusal only to the applicant of the invention B. Consequently, treatment is made as described above.

**(Note)** The handling 3.3(3) applies to matters defining inventions of two applications filed on the same date expressed in two or more alternatives.

(3)The relation between the identity of applicants and the identity of inventions

Whether applicants are the same or not makes no effects on the determination of whether the inventions are the same or not.

### **3.5 Handling of a Claim with Statements Defining a Product by Its Function or Characteristic, etc.**

(1) Where a claim includes statements defining a product by its function or characteristic, etc. and it falls under either the following ① or ②, there may be cases where it is difficult to compare the claimed invention with the earlier invention. In the above circumstances, if the examiner has a reason to suspect that the claimed product would be prima facie identical with the product of the earlier invention without making a strict comparison of the

claimed product with the product of the earlier invention, the examiner may send the notice of reasons for refusal under Article 39. Then an applicant may argue or clarify by putting forth a written argument or a certificate of experimental results, etc. against the notice of reasons for refusal. The reason for refusal is to be dissolved if the applicant's argument succeeds in changing the examiner's evaluation at least to the extent that it is unclear that the claimed product is prima facie identical with the product of the earlier invention. Where the applicant's argument, which is, for example, abstract or general, does not change the examiner's evaluation to that extent, the examiner may render a decision of refusal under Article 39.

The above-mentioned handling shall not be applied, if matters defining the earlier invention fall under either the following ① or ②. However, in the case where two inventions filed on the same date are subject to determine the identity, it can be applied thereto only if, at least, the matters defining either of the inventions fall under the following ① or ②:

- ① a case where the function or characteristic, etc. is neither standard, commonly used by a person skilled in the art in the relevant technical field nor comprehensible of its relation to a commonly used function or characteristic, etc. to a person skilled in the art if the function or characteristic is not commonly used; or
- ② a case where plural of functions or characteristics, etc. each of which is either standard, commonly used by a person skilled in the art in the relevant technical field or comprehensible of its relation to a commonly used function or characteristic, etc. to a person skilled in the art if the function or characteristic is not commonly used, are combined in a claim so that the claim statements as a whole fall under ①.

**(Note)** Function or characteristic, etc. should be deemed to be standard if it is either defined by JIS (Japanese Industrial Standards), ISO-standards (International Organization for Standardization-standards) or IEC-standards (International Electrotechnical Commission-standards), or if it can be determined quantitatively by a method for testing or measuring which is provided in those standards. Function or characteristic, etc. should be deemed to be commonly used by a person skilled in the art if it is commonly used by a person skilled in the art in the relevant technical field as well as its definition or the method for testing or measuring can be understood by a person skilled in the art.

(2) Examples where the examiner has a reason to suspect the prima facie identity are the followings:

- (s)he reveals that a product of an earlier invention is identical with the product of the claimed invention as a result of the converting the function or characteristic, etc. into a different definition with the same meaning or a different method for testing or measuring the same;
- where both the claimed invention and the earlier invention are defined by identical or similar function or characteristic, etc. which are measured or evaluated under different measuring conditions or different evaluation methods and there is a certain relationship between them, there is a high probability that the function or characteristic, etc. defining the earlier invention, if measured or evaluated under the same measuring conditions or evaluation method as the claimed invention, is included in the function or characteristic, etc. defining the claimed invention;
- a product of the later invention has been revealed identical in structure with a certain

product after the filing and (s)he discovers the particular product is a product of an earlier invention;

- (s)he discovers a product of an earlier invention which is identical with or similar to a mode for carrying out the later invention disclosed (for example, (s)he discovers a product of an earlier invention of which starting material is similar to and of which manufacturing process is identical with those of the mode for carrying out the claimed invention, or (s)he discovers a product of an earlier invention of which starting material is identical with and of which manufacturing process is similar to those of the mode for carrying out the later invention, etc.); and
- the later invention and an earlier invention have common matters defining the invention other than those defining a product by its function or characteristic, etc. and the earlier invention has the same objective or effect as the one which the claim statements of the later invention defining a product by its function or characteristic, etc. have and there is a high probability that the function or characteristic, etc. defining the earlier invention is included in the function or characteristic, etc. defining the later invention.

The examiner should follow the ordinary method when the requirement under Article 39 can be examined without using this exceptional handling.

### **3.6 Handling of a Claim with Statements Defining a Product by Its Manufacturing Process**

① If a claim is one with statements defining a product by its manufacturing process, there may be cases where it is difficult to determine what is the product per se structurally. In such circumstances, if the examiner has a reason to suspect that the claimed product would be prima facie identical with the product of the earlier invention without conducting a strict comparison of the claimed product with the product of the earlier invention, the examiner may send the notice of reason for refusal under Article 39 as mentioned in the above 3.5.

The examiner, however, shall not cite an earlier invention under this handling if matters defining the earlier invention include a statement defining a product by its manufacturing process. In the case of two or more inventions filed on the same date, on the contrary, the examiner may follow this handling if matters defining invention with respect to at least any of the inventions include a statement defining a product by its manufacturing process.

② Examples where the examiner has a reason to suspect the prima facie identity are the followings:

- (s)he discovers an earlier invention of a product of which starting material is similar to and of which manufacturing process is identical with those of the product of the later invention;
- (s)he discovers an earlier invention of a product of which starting material is identical with and of which manufacturing process is similar to those of the product of the later invention;
- a product of the later invention has been revealed identical in structure with a certain product after the filing, and (s)he discovers the particular product is identical with an earlier invention; and
- (s)he discovers an earlier invention which is identical with or similar to a mode for carrying out the later invention.

The examiner should follow the ordinary method when the requirement under Article 39 can be determined without using this exceptional handling.

#### **4. Procedure of Examination in Cases Where There Exists a Reason for Refusal under Patent Act Article 39**

##### **4.1 Procedure for Examination of a Later Application Where There Is an Earlier Application Relating to the Same Invention**

###### **4.1.1 Where the Applicants are Not the Same**

Where neither the applicant(s) nor inventor(s) of the later application are the same as those of the earlier application, Patent Act Article 29bis is applied to the later application.

Where the applicant(s) is not the same but the inventor(s) is the same, Patent Act Article 39 is applied to the later application. However, a decision of refusal to the later application on such ground that it was filed later than another application claiming the same invention is made after a decision for the earlier application becomes final and conclusive.

###### **4.1.2 Where the Applicants are the Same**

In the case where the applicants are the same, a reason for refusal can be issued to the later application and the examination can proceed even before a decision for the earlier application becomes final and conclusive.

Where the reason for refusal under Patent Act Article 39 on the basis of the earlier application is issued to the later application before the decision for the earlier application becomes final and conclusive (including the case where a request for examination is not made on the earlier application), the remark to the effect that if the reason for refusal is not resolved, a decision of refusal is made even though the decision for the earlier application does not become final and conclusive is added to the notice of reasons for refusal. After the expiry of the time limit, if the reason for refusal is not resolved, a decision of refusal is made.

However, in the case where a request for examination on the earlier application has already been made but examination has not yet started on the application before the expiry of the time limit to respond to the reasons for refusal to the later application, and the applicant states he has an intention to amend the earlier application in the response to the reasons for refusal to the later application, examination proceeds as follows:

- ① Where there are reasons for refusal to the earlier application, the reasons for refusal are notified to the earlier application. After the expiry of the time limit, presence of any amendments to the earlier application and the content of such amendments are confirmed and then examination of the later application proceeds.
- ② Where there are no reasons for refusal to the earlier application, the examination of the later application proceeds after the decision to grant a patent on the earlier application is made.

## **4.2 Procedure for Examination of Applications Relating to the Same Invention Filed on the Same Date**

### **4.2.1 Where the Applicants are Not the Same**

(1) Where there are no reasons for refusal other than under Patent Act Article 39(2), an order to hold consultation is sent to each applicant.

Refer to 2.7.1 for details of consultation.

(2) Where there are any other reasons for refusal to at least one application than under Patent Act Article 39(2), such other reasons are also notified when sending the order to hold consultation.

(Explanation)

Where two or more applications relating to the same invention are filed on the same date, an order to hold consultation shall be sent. By notifying reasons for refusal other than the reason under Patent Act Article 39(2), if any, the applicant can learn substantially all of the reasons for refusal simultaneously and thus can take appropriate measures.

### **4.2.2 Where the Applicants are the Same**

Where applicants are the same, an order to hold consultation and notice of any reasons for refusal are sent simultaneously.

## **5. Remarks**

### **5.1 Where New Matter Is Included**

Where a claimed invention in an earlier application or other application filed on the same date became to include, by amendments, a matter which does not remain within the scope of the features disclosed in the specification or drawings originally attached to the request, Patent Act Articles 39(1) to (4) are not applied to such claimed inventions.

(Explanation)

It is contradictory to the first-to-file rule to give a right to exclude later applications to a claimed invention including a matter which does not remain within the scope of the features disclosed in the specification or drawings originally attached to the request (new matter).

Therefore, where the claimed invention in the earlier application or the other application filed on the same date has become to include new matter by amendment, Patent Act Articles 39(1) to (4) are not applied to such claimed invention.

### **5.2 In the Case of Conversion of Applications**

In the case of conversion of applications, since the original application is deemed to be withdrawn (Patent Act Article 46(4), Utility Model Act Article 10(5)), the original application is, for the purpose of Patent Act Article 39(1) to (4), deemed never to have been made.

When the converted application is valid, since the application is deemed to have

been filed at the time of filing of the original application, Patent Act Article 39(1) to (4) are applied to the converted application as having been filed on the filing date of the original application.

## **6. Notice of Reasons for Refusal under Patent Act Article 39**

If the examiner has a conviction that a claimed invention is unpatentable under Article 39(1) to (4), (s)he will send a notice of reasons for refusal to an applicant.

The applicant may argue or clarify by putting forth a written argument or a certificate of experimental results, etc. against the notice of reasons for refusal.

The reason for refusal is to be dissolved if the applicant's argument succeeds in changing the examiner's evaluation at least to the extent that truth or falsity becomes unclear. Where the applicant's argument does not change the examiner's evaluation to that extent, the examiner may render a decision of refusal on the ground of the reason for refusal.

### **[Case Law for Reference]**

(1) Even if certain embodiments are common to two inventions, so long as the technical ideas concerned are different, the two inventions shall not be deemed the same

Sho 30 (Gyo Na) 39, (Judgment: Dec. 11, 1956)

... As mentioned above, the present invention has different constituent features from those of the invention disclosed in the cited reference. Therefore, the two inventions must not be considered to be the same.

However,... although it seems to happen that it is difficult to distinguish the two inventions from each other in embodiments, to co-exist Vitamin C other than Vitamin B1 in the invention disclosed in the cited reference has no direct connection with ... as the object of the invention, and, therefore, such co-existing is not considered to be the indispensable constituent features of the invention. Accordingly, even if it may happen that it becomes difficult to distinguish one embodiment of the invention disclosed in the cited reference from addition of Vitamin C as a reducer which is indispensable in the present invention, this cannot be the ground for interpreting that the two inventions are the same.

Sho 42 (Gyo Tsu) 29, (Judgment: July 10, 1975)

It has already been stated above that the original judgment is justifiable, which judgment states that the invention disclosed in the cited reference is different from the invention of the present application in terms of the constituent features, and they may overlap only in their embodiments. On the other hand, the cited invention always needs a dominant carrier wave, while the present invention does not always need a dominant carrier wave. In this regard, these two inventions are different in terms of their constituent features. In the case where different technical ideas can be found in the later filed invention in the sense that the limitation of the constituent feature imposed to the cited invention is not necessary to the present invention, even if the two inventions may overlap in their embodiments if the present invention uses a dominant carrier wave, this matter cannot be the ground for determining that the two inventions are the same. Further, the previous Patent Act (Act No. 96 of 1921) Article 8 cannot be construed so as to refuse the later-filed application as being the same invention, unless the overlapped part is excluded from the later-filed application in such a case. The original judgment states that the present invention is different from the invention disclosed in the cited reference is justifiable,...

(2) Whether or not the inventions are the same is determined by comparing the constituent features of the inventions

Sho 45 (Gyo Ke) 76, (Judgment: Jan. 23, 1973)

... In order for two inventions to be considered as different, the difference between the two inventions must be recognized objectively. Therefore, the criterion for determining whether the two inventions are the same shall be selected in the light of the above. As the constituent features of the invention are the objective expression of the invention, this can be used as the criterion for the identity. ...On the other hand, the object of the invention is subjective intention of the inventor. And the effect is inherently subjective. However, the effect of the invention described in the specification is limited to what the inventor recognized, or to what the inventor considered to be necessary in connection with the object of the invention. Therefore, the object of the invention or the effect of the invention

cannot be the criterion to judge the identity of the inventions.

(3) Cases of addition, deletion, or replacing of well-known or commonly used art; generating no new effects

Sho 56 (Gyo Ke) 45, (Judgment: June 23, 1983)

... In the first-filed invention, the claimed invention is defined in generic concept, by the description of 'count the number of the pulse generated linearly in proportion to the intensity of the object light' and it does not specify a type of A-D converter required therefor. On the other hand, the present invention restricts to the use of a voltage-time conversion type A-D converter, by defining in the claim 'using a pulse of a constant period as a reference pulse signal to convert an analog electric signal to a digital signal representing light intensity of the object'. In this respect, a certain distinction is recognized between the two inventions,...

However,...it is recognized that before the filing of the first-filed invention, as a typical example of a so-called counting type A-D converter, both voltage-time conversion type and voltage-frequency conversion type were known as the well-known technical means exchangeable with each other, and it was also well known to apply the technology of the A-D converter to an optical field. Therefore, considering the well-known arts described above and ... the object of the first-filed invention, the description of the constituent features in the first-filed invention concerning A-D conversion recognized above shall not be restricted to the working example recognized above, but shall also include the case where voltage-time conversion type A-D converter is used for the counting type A-D converter and the usage meets the requirement.

Therefore, it shall not be recognized that the present invention constitutes a different invention from the first-filed invention by the reason that the present invention is restricted to using the voltage-time conversion type A-D converter for the counting type A-D converter,...

Sho 57 (Gyo Tsu) 51, (Judgment: Sep 7, 1982) (Sho 55 (Gyo Ke) 82 (Judgment: Jan 26, 1982))

... Consequently, in the first-filed invention, water slurry of xonotlite needle-like crystal, or composition to produce a calcium silicate mold which is prepared by adding clay to the water slurry described above is anticipated as a material of which a calcium silicate mold is made by conventional molding means. The calcium silicate mold in the present invention corresponds to water slurry of xonotlite needle-like crystal, with or without clay in the first-filed invention, which is compressed by conventional molding means. Further, it is not set forth in the present invention that other special molding means than the conventional molding means described in the specification of the first-filed application is used or clay is added in an unusual proportion.

Therefore, the first-filed invention and the present invention are considered the same, even if there is such difference that one directs the material to produce the mold and the other directs the mold per se.

(4) Where differences are due to only a difference of the category expressed in the claimed inventions

Sho 44 (Gyo Ke) 93, (Judgment: May 20, 1970)

... In the form of the expression, the former is the invention concerning 'a product' and the latter is the invention concerning of 'a process', but the substantial technical ideas are chemicals added in producing concrete, i.e. admixture for reinforcement. Both inventions are in the same technical field and the effects of the inventions are deemed the same. According to the recognition above, the original invention and the present invention are both based on finding new material to be used advantageously in the same field, and the present invention concerns a self-evident process for usage of the material relating to the original invention, along the object for the usage of the material. And the usage per se does not give patentability. Therefore, the original invention and the present invention are considered the same....

Sho 48 (Gyo Ke) 27, (Judgment: May 31, 1978)

... There is the difference whether the invention is expressed as a process or expressed as a structure of an apparatus between the two inventions, however, the technical ideas of the two inventions are the same. Therefore, the two inventions are not considered to constitute different inventions....

Sho 37 (Gyo Na) 103, (Judgment: Oct 29, 1971)

... In the cited reference, a manner which is necessarily required to implement the process of the present invention is expressed as an appliance, while, in the present invention a manner which is necessarily required to implement metallic cold-finish to be carried out by using the appliance is expressed as a process. It means that the only difference between the two inventions lies in the difference in expression, namely the same technical idea is expressed as the appliance in the cited reference and as the process in the present invention. Therefore, the two inventions are deemed to be the same...