

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

Part IV: Priority

Chapter 1 Priority under the Paris Convention

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Chapter 1 Priority under the Paris Convention

Patent Act Article 43 (1)

A person desiring to take advantage of the priority under Article 4.D(1) of the Paris Convention regarding a patent application shall, along with the patent application, submit to the Commissioner of the Patent Office a document stating thereof, and specify the country of the Union of the Paris Convention in which the application was first filed, deemed to have been first filed under C(4) of the said Article, or recognized to have been first filed under A(2) of the said Article, and the date of filing of the said application.

Paris Convention Article 4

A (1) Any person who has duly filed an application for a patent, or for the registration of a utility model, or of an industrial design, or of a trademark, in one of the countries of the Union, or his successor in title, shall enjoy, for the purpose of filing in the other countries, a right of priority during the periods hereinafter fixed.

(2) Any filing that is equivalent to a regular national filing under the domestic legislation of any country of the Union or under bilateral or multilateral treaties concluded between countries of the Union shall be recognized as giving rise to the right of priority.

(3) By a regular national filing is meant any filing that is adequate to establish the date on which the application was filed in the country concerned, whatever may be the subsequent fate of the application.

B. Consequently, any subsequent filing in any of the other countries of the Union before the expiration of the periods referred to above shall not be invalidated by reason of any acts accomplished in the interval, in particular, another filing, the publication or exploitation of the invention, the putting on sale of copies of the design, or the use of the mark, and such acts cannot give rise to any third-party right or any right of personal possession. Rights acquired by third parties before the date of the first application that serves as the basis for the right of priority are reserved in accordance with the domestic legislation of each country of the Union.

C. (1) The periods of priority referred to above A (1) shall be twelve months for patents and utility models, and six months for industrial designs and trademarks.

(2) These periods shall start from the date of filing of the first application; the day of filing shall not be included in the period.

(3) If the last day of the period is an official holiday, or a day when the Office is not open for the filing of applications in the country where protection is claimed, the period shall be extended until the first following working day.

- (4) A subsequent application concerning the same subject as a previous first application within the meaning of paragraph (2), above, filed in the same country of the Union shall be considered as the first application, of which the filing date shall be the starting point of the period of priority, if, at the time of filing the subsequent application, the said previous application has been withdrawn, abandoned, or refused, without having been laid open to public inspection and without leaving any rights outstanding, and if it has not yet served as a basis for claiming a right of priority. The previous application may not thereafter serve as a basis for claiming a right of priority.**
- D. (1) Any person desiring to take advantage of the priority of a previous filing shall be required to make a declaration indicating the date of such filing and the country in which it was made. Each country shall determine the latest date on which such declaration must be made.**
- (2) These particulars shall be mentioned in the publications issued by the competent authority, and in particular in the patents and the specifications relating thereto.**
- (3) The countries of the Union may require any person making a declaration of priority to produce a copy of the application (descriptions, drawings, etc.) previously filed. The copy, certified as correct by the authority that received such application, shall not require any authentication, and may in any case be filed, without fee, at any time within three months of the filing of the subsequent application. They may require it to be accompanied by a certificate from the same authority showing the date of filing, and by a translation.**
- (4) No other formalities may be required for the declaration of priority at the time of filing the application. Each country of the Union shall determine the consequences of failure to comply with the formalities prescribed by this Article, but such consequences shall in no case go beyond the loss of the right of priority.**
- (5) Subsequently, further proof may be required. Any person who avails himself of the priority of a previous application shall be required to specify the number of that application; this number shall be published as provided for by paragraph (2), above.**
- E. (1) Where an industrial design is filed in a country by virtue of a right of priority based on the filing of a utility model, the period of priority shall be the same as that fixed for industrial designs.**
- (2) Furthermore, it is permissible to file a utility model in a country by virtue of a right of priority based on the filing of a patent application, and vice versa.**

F. No country of the Union may refuse a priority or a patent application on the ground that the applicant claims multiple priorities, even if they originate indifferent countries, or on the ground that an application claiming one or more priorities contains one or more elements that were not included in the application or applications whose priority is claimed, provided that, in both cases, there is unity of invention within the meaning of the law of the country.

With respect to the elements not included in the application or applications whose priority is claimed, the filing of the subsequent application shall give rise to a right of priority under ordinary conditions.

G. (1) If the examination reveals that an application for a patent contains more than one invention, the applicant may divide the application into a certain number of divisional applications and preserve as the date of each the date of the initial application and the benefit of the right of priority, if any.

(2) The applicant may also, on his own initiative, divide a patent application and preserve as the date of each divisional application the date of the initial application and the benefit of the right of priority, if any. Each country of the Union shall have the right to determine the conditions under which such division shall be authorized.

H. Priority may not be refused on the ground that certain elements of the invention for which priority is claimed do not appear among the claims formulated in the application in the country of origin, provided that the application documents as a whole specifically disclose such elements.

(I. is omitted.)

1. Purport of priority under the Paris Convention

Where patent applications etc. are filed in multiple countries for the same invention, simultaneous filing of patent applications etc. places a great burden on an applicant because preparation of translation etc. or different procedures for each country are required.

To reduce the burden of an applicant, the Paris Convention (meaning the Paris Convention for the Protection of Industrial Property of March 20, 1883, as revised at Brussels on December 14, 1900, at Washington on June 2, 1911, at Hague on November 6, 1925, at London on June 2, 1934, at Lisbon on October 31, 1958, and at Stockholm on July 14, 1967 — hereinafter referred to as “Paris Convention”) prescribes the priority.

The priority for patent application (Note) under the Paris Convention (hereinafter referred to as the “priority” in this chapter) is the right of a person who has filed a patent application in one of the member countries of the Paris Convention (the first country) to receive the same treatment as that at the time when the patent application has been filed in the first country in determination of novelty, inventive step, etc. for patent applications in another member country of the Paris Convention (the second country) regarding the content described in the filing documents of the first patent application, provided that the period ranging from the date of filing of the first patent application to

the first country to the date of filing of the patent application to the second country is within 12 months, and in response to the above, Patent Act Article 43 prescribes the cases where priority is claimed under the Paris Convention.

(Note) Though this chapter describes the typical cases where both the first and second applications are patent applications, priority can be claimed also where patent application is filed to the second country, based on an application for utility model registration to the first country, and where an application for utility model registration is filed to the second country, based on a patent application or an application for utility model registration to the first country (Paris Convention Article 4 E).

2. Requirements of priority claim under the Paris Convention

2.1 Person who can claim priority

A person who can claim priority under the Paris Convention shall be the national of one of the member countries of the Paris Convention (including a person who is recognized as the national of one of the member countries by the provision of Paris Convention Article 3) and who has regularly filed a patent application to one of the member countries of the Paris Convention or his/her successor (Paris Convention Article 4 A (1)).

Therefore, a person who assigns his/her right to obtain a patent to others and has not filed the patent application by himself/herself may file the regular patent application in the second country, but he/she may not claim priority based on the patent application assigned to others even if he/she is an inventor.

2.2 Period when priority can be claimed

The period when priority can be claimed under the Paris Convention (the period of priority) shall be 12 months from the date of filing of the first application to the first country (Paris Convention Article 4 C (1)).

This period shall start from the date of filing of the first application and the day of filing shall not be included in the period (Paris Convention Article 4 C (2)).

In addition, if the last day of the period is an official holiday, or a day when the Office is not open for the filing of applications in the second country, the period shall be extended until the first following working day (Paris Convention Article 4 C (3)).

2.3 Application that can serve as a basis of priority claim

(1) Regular application

An application claiming priority under the Paris Convention, regularly filed in one of the member countries, shall be an application that is equivalent to a national application under the domestic legislation of any country of the Union or a regular national application under bilateral or multilateral treaties concluded between countries of the Union and that is adequate to establish the date on which the application was filed (requirements to establish the date of filing is satisfied), whatever may be the subsequent fate of the application.

Therefore, even applications withdrawn, abandoned or rejected after filing of the patent application can serve as a basis for claiming a right of priority (Paris Convention Article 4 A (3)).

(2) First application

Only the first application in one of the member countries of the Paris Convention can serve as a basis of priority claim under the Paris Convention (Paris Convention Article 4C (2)).

This is because the period of priority will be substantively extended if the right of priority is recognized again (that means cumulatively) for the invention disclosed in the first application.

However, even if two applications for the same subject in the same member country are filed, where the previous application has been withdrawn, abandoned, or refused at the time of filing the subsequent application, without having been laid open to public inspection and without leaving any rights outstanding, and if it has not yet served as a basis for claiming a right of priority, the subsequent application will be considered to be the first application (Paris Convention Article 4 C (4)).

3. Effects of priority claim under the Paris Convention

Any subsequent filing shall not be invalidated by reason of any acts accomplished in the period from the date of filing of the first application to one of the member countries of the Paris Convention to the date of filing of a subsequent application claiming priority to one of other member countries, in particular, another filing, the publication or exploitation of the invention. And such acts cannot give rise to any third-party right (Paris Convention Article 4B).

Since the priority under the Paris Convention has such effects, among inventions relating to a patent application in Japan claiming priority under the Paris Convention (hereinafter referred to as “the application in Japan”), for the inventions disclosed in the whole filing documents (description, scope of claims and drawings) of the application in the country of the Union which served as a basis of priority claim concerned (hereinafter referred to as “the patent application in the first country” or “the first application”), the patent application concerned shall be treated as if it has been filed on the date of filing of the first application, in applying the following provisions of the Patent Act in connection with substantive examination (hereinafter the date of filing of the first application in these cases is referred to as “priority date”).

(1) Article 29 (novelty, inventive step)

(2) The principle sentence of Article 29bis (what is called, prior art effect)

(3) Article 39 (1) to (4) (precedent application)

(4) Article 126 (5) (requirements for independent patentability of correction trial (except for requirements prescribed in Article 36)) (including its application under Article 17bis(5))

However, in application of the provisions of the other clauses in connection with substantive examination (for example, Article 36) on patent application claiming priority under the Paris Convention, determination shall be made, based on the date of filing of the patent application concerned. And in the case of application of the provisions of 29bis as precedent application prescribed in the clause concerned on patent application claiming priority under the Paris Convention, see “Part II, Chapter 3, 2.2(3)”.

4. Determination on effects of priority claim under the Paris Convention

4.1 Basic idea

The Paris Convention defines that the “certain elements of the invention” shall be disclosed by the application documents as a whole relating to the first application for recognition of the effects of priority claim (Paris Convention Article 4H).

For saying that the claimed invention of the application claiming priority in Japan is disclosed by the whole application documents of the first application, the claimed invention of the application in Japan understood by consideration of the whole description of the application documents of the application in Japan shall be within the scope of the matters disclosed in the whole filing documents of the first application.

It shall be determined whether the claimed invention of the application in Japan is within the scope of the matters disclosed in the whole filing documents of the first application or not, depending on the examples of new matters (for determination of new matter, see “Part III, Section I New Matter”).

The effects of priority claim shall be determined on a claim-by-claim basis in principle. Also where the matters for defining the invention in one claim (hereinafter referred to as “Invention-defining matters”) are expressed by formal or actual alternatives (hereinafter referred to as “alternatives”. For “formal alternatives” and “actual alternatives”, see “Part II, Chapter 2, 1.5.5 Determining whether a Claimed Invention is Novel (Note1)”), the effects of priority claim shall be determined by each alternative. Furthermore where modes for carrying out the claimed invention are newly added, the effects of priority claim shall be determined by each newly added part.

Typical cases where the claimed invention of the application in Japan is not considered to be within the scope of the matters disclosed in the whole filing documents of the first application are shown as follows;

- (1) Where matters which are not disclosed in the whole filing documents of the first application are disclosed as invention-defining matters in the claims of the application in Japan

Where the claimed invention of the application in Japan is not disclosed in the whole filing documents of the first application by disclosing invention-defining matters that were not disclosed in the whole filing documents of the first application, the effects of priority claim cannot be recognized. For example, the cases where a patent application for a combined invention that combines structural elements disclosed in the filing documents of the first application with those newly added to the application in Japan or selection invention that selects the elements of more specific concept from the invention of generic concept disclosed in the filing documents of the first application is claimed in the application in Japan correspond to the above (Reference: Decision of Tokyo High Court, November 27, 1986, 1983 (Gyo Ke), No.54, Suit against appeal “Manufacturing method of texture yarn”).

- (2) Where parts beyond the scope of the matters disclosed in the whole filing documents of the first application are included in the claimed invention of the application in Japan (the cases where modes for carrying out the invention are added to the application in Japan etc.)

Where parts beyond the scope of the matters disclosed in the whole filing documents of the first application are included in the claimed invention of the application in Japan by disclosing the matters that were not disclosed in the whole filing documents of the first application (new modes for carrying out the invention etc.) or deleting the described matters (partial deletion of the invention-defining matters etc.), the effects of priority claim cannot be recognized for the parts concerned (Reference: Decision of Tokyo High Court, October 8, 2003, 2002 (Gyo ke) No.539, Suit against appeal “artificial nipple”).

In this case, an invention recognized to be within the scope of the matters disclosed in the whole filing documents of the first application is included in the claimed invention of the application in Japan, the effects of priority claim can be recognized for the parts concerned (partial priority) (for details, see “4.3 Treatment of partial priority or multiple priorities” that is mentioned later).

- (3) Where the claimed invention of the application in Japan come to be carried out and not to be disclosed in the whole filing documents of the first application by the addition of modes for carrying out the claimed invention and so on, though the first application describes the invention so that a person skilled in the art cannot carry it out.

Where the invention that was impossible to be carried out by a person skilled in the art based on the matters disclosed in the whole filing documents of the first application comes to be carried out by the addition of modes for carrying out the claimed invention, the effects of priority claim cannot be recognized because the claimed invention of the application in Japan come not to be within the scope of the matters disclosed in the whole filing documents of the first application (Reference: Decision of Tokyo High Court, October 20, 1993, 1992 (Gyo ke) No.100, Suit against appeal, “MB-530A derivative”, Decision of Tokyo High Court, March 15, 2001, 1998,(Gyo ke) No.180, Suit against appeal, “Immunoassay”).

(Cases where the claimed invention of the application in Japan comes to be carried out by changing common general technical knowledge shall be dealt with in the same manner as above.)

Here, it shall be determined whether the claimed invention of the application in Japan is applicable or not, depending on the examples of enablement requirement (for specific determining methods, see “Part I, Chapter 1, 3.2 Enablement requirement”).

4.2 Examples of determination of the effects of priority claim

[Example 1] Where the claimed invention of the application in Japan is changed within the scope of the matters disclosed in the whole filing documents of the first application

The first application: The claimed invention of the first application concerns a specified compound, and the mode of operation of an anticancer drug containing this compound as an effective ingredient is disclosed in the whole filing documents.

The application in Japan: The claimed invention of the application in Japan was considered to concern the anticancer drug containing the relevant compound as an effective ingredient, but the detailed description and description of drawings of the

invention are within the scope of matters disclosed in the whole filing documents of the first application.

Determination of priority: Since it is described in the whole filing documents of the first application that the specified compound is used as an anticancer drug, the effects of priority claim are recognized.

[Example 2] Where the invention disclosed in the whole filing documents of the first application is combined with other specified matters of invention that are not disclosed in the above

The first application: Only a “damping structure that combines low and upper layers of the structure by a damping system” is disclosed in the whole filing documents of the first application.

The application in Japan: The claimed invention of the application in Japan is considered to concern the “damping structure that combines the low and upper layers of the structure by a damping system and sets up the control means to control the combination”.

Determination of priority: Since the claimed invention of the application in Japan is not within the scope of the matters disclosed in the whole filing documents of the first application by combining the invention disclosed in the whole filing documents of the first application with other invention-defining matters that were not disclosed in the whole filing documents of the first application, the effects of priority claim are not recognized.

[Example3] Where a mode for carrying out the invention is newly added to the invention that can be carried out from the description of the whole filing documents of the first application

The first application: The claimed invention of the first application is a light scanning system containing mirror angle adjustability, and only the light scanning system adjusting the mirror angle by a screw is disclosed as a mode for carrying out the invention.

The application in Japan: Though the expression of the claimed invention of the application in Japan is the same light scanning system with mirror angle adjustability as that of the first application, a light scanning system that adjusts automatically the mirror with a piezoelectric element is newly added as a mode for carrying out the invention.

Determination of priority: In the claimed invention of the application in Japan, the effects of priority claim on the part corresponding to the light scanning system that adjusts automatically the mirror with a piezoelectric element are not recognized, and the effects of priority claim are recognized for only matters within the scope of the matters disclosed in the whole filing documents of the first application.

(Explanation)

In the case of this example, since the mode of carrying out adjusting automatically the mirror with a piezoelectric element is not disclosed in the whole filing documents of the first application, meaning that the parts in the claimed invention of the application in Japan corresponding to the mode of carrying out the invention is not recognized to be within the scope of matters disclosed in the whole filing documents of the first application, the effects of priority claim are not recognized for the parts.

[Example 4] Where the claimed invention of the application in Japan becomes

applicable by addition of the mode of carrying out the invention

The first application: Since a mode of operation is not disclosed in the whole filing documents of the first application, the claimed invention of the first application is not recognized to be applicable.

The application in Japan: Though the expression of the claimed invention of the application in Japan is the same as that of the first application, the claimed invention of the application in Japan comes to be carried out by addition of the mode carrying out the invention to the detailed description or drawings of the invention.

Determination of priority: Since the claimed invention of the application in Japan is not within the scope of matters disclosed in the whole filing documents of the first application by addition of a new mode for carrying out the invention, the effects of priority claim are not recognized.

(Explanation)

Where the description of a new mode for carrying out the invention is added to the whole filing documents of the first application to make the application in Japan, resulting that the claimed invention of the application in Japan comes to be newly carried out, the effects of priority claim are not recognized for the claimed invention of the application in Japan because the invention is not within the scope of the matters disclosed in the whole filing documents of the first application.

[Example 5] Where the addition of description of the experiment results showing that the invention is usable makes it possible to carry out the claimed invention of the application in Japan

The first application: The claimed invention of the first application is a gene, and since the functions of the gene concerned are unknown though it can be produced according to the description of the whole filing documents, the claimed invention of the first application is recognized impossible to be carried out.

The application in Japan: Though the claimed invention of the application in Japan is the same gene as the claimed invention of the first application, the claimed invention of the application in Japan is made it possible to be carried out by adding for the first time the description of the functions based on the experiment results on the gene concerned to the whole filing documents of the second application.

Determination of priority: Since the invention relating to the gene of the application in Japan is not within the scope of matters disclosed in the whole filing documents of the first application, the effects of priority claim are not recognized.

(Explanation)

Where the description of a new mode for carrying out the invention is added to the whole filing documents of the first application to make the application in Japan, resulting that it becomes possible to carry out the claimed invention of the application in Japan, the effects of priority claim are not recognized for the claimed invention of the application in Japan because the invention is not within the scope of the matters disclosed in the whole filing documents of the first application.

[Example 6] Where it becomes possible to carry out the invention by changes in common general technical knowledge

The first application: The claimed invention of the first application is a genetically modified plant, and only a dicotyledonous plant is disclosed as a mode of operation in the whole filing documents of the first application. It cannot be said that a genetically

modified plant could be produced with respect to monocotyledons from the description of the whole filing documents concerned and common general technical knowledge at the time when the first application was filed.

The application in Japan: Though the description of the whole filing documents of the application in Japan is the same as the description of the whole filing documents of the first application, technical improvement in gene recombination after filing of the first application enabled the gene recombination of monocotyledons, if it is possible for dicotyledonous plants, which becomes a common general technical knowledge now, resulting that the invention relating to the genetically-engineered plant of the application in Japan was applicable also with respect to monocotyledons.

Determination of priority: Since the parts relating to the monocotyledons come not to be within the scope of matters disclosed in the whole filing documents of the first application without changes in common general technical knowledge, the effects of priority claim are not recognized, and only with respect to the parts relating to dicotyledonous plants, the effects of priority claim are recognized.

(Explanation)

While the description of the whole filing documents of the application in Japan was the same as the description of the whole filing documents of the first application, the parts of the application in Japan which it becomes possible to carry out by further changes in common general technical knowledge is not within the scope of the matters disclosed in the whole filing documents of the first application, so the effect of priority claim relating to the part is not recognized.

4.3 Treatment of partial priority or multiple priorities

The application in Japan sometimes contains one or more elements that were not included in the first application, and in this case, the Paris Convention recognizes the claim of priority (Article 4F). In addition, the priority under the Paris Convention can be claimed and filed, based on the multiple first applications (including the applications filed in two or more countries), respectively (Article 4F). In this case, the effects of priority claim shall be determined as follows;

- (1) Where the application in Japan claims the priority under the Paris Convention based on the first application, and the invention relating to a part of claims or alternatives of the application in Japan is disclosed in the first application (partial priority), presence/absence of the effects of priority claim based on the first application corresponding to the parts concerned shall be determined.

[Example 1] Where only the invention relating to a part of claims of the application in Japan is disclosed in the whole filing documents of the first application

The first application: Only corrosion-resisting steel containing chrome is disclosed in the whole filing documents of the first application.

The application in Japan: The claimed invention of the application in Japan is considered to be corrosion-resisting steel containing chrome, and the invention related to other claims considered to be corrosion-resisting steel containing chrome and aluminum.

Determination of priority: Since the invention regarding one claim of the application in Japan, corrosion-resisting steel containing chrome, is disclosed in the whole filing documents of the first application, the effects of priority claim are recognized.

On the other hand, for the other claimed invention, corrosion-resisting steel containing chrome and aluminum, is not within the scope of the matters disclosed in the whole filing documents of the first application, the effects of priority claim are not recognized.

[Example 2] Where only a part of alternatives of the claimed invention of the application in Japan are described in the whole filing documents of the first application

The first application: The claimed invention of the first application is the one containing the condition where the carbon number of alcohol is 1-5, and only the mode of operation of 1-5 of carbon number of alcohol is disclosed in the whole filing documents.

The application in Japan: The claimed invention of the application in Japan contains the condition where the number of alcohol is 1-10 (actual alternative).

Determination of priority: Since the invention regarding one claim of the application in Japan, the condition where the carbon number of alcohol is 1-5, is disclosed in the whole filing documents of the first application, the effects of priority claim are recognized.

On the other hand, since the condition where the carbon number of alcohol is 6-10 is not within the scope of the matters disclosed in the whole filing documents of the first application, the effects of priority claim are not recognized.

- (2) Where the application in Japan claims the priority under the Paris Convention based on two or more first applications (multiple priorities), the invention relating to a part of claims or alternatives of the application in Japan is disclosed in the first application and the invention relating to another part of claims or alternatives is disclosed in the first application, presence/absence of the effects of priority claim based on the first application corresponding to each part shall be determined.

[Example 3] Where the matters disclosed in the first multiple applications are disclosed in the individual claim of the application in Japan, respectively

The first application: The corrosion-resisting steel containing chrome is disclosed in the whole filing documents of the first application A, while the corrosion-resisting steel containing chrome and aluminum is disclosed in the whole filing documents of the first application B.

The application in Japan: The invention regarding one claim of the application in Japan claiming priority based on both of the first applications A and B is the corrosion-resisting steel containing chrome and the another claimed invention is the corrosion-resisting steel containing chrome and aluminum.

Determination of priority: For one claimed invention of the application in Japan, the effects of priority claim based on the first application A are recognized, while for another claimed invention, the effects of priority claim based on the first application B are recognized.

[Example 4] Where the matters described in the multiple first applications are combined and described in one claim of the application in Japan

The first application: The condition where the carbon number of alcohol is 1-5 is disclosed in the whole filing documents of the first application A, while the condition where the carbon number of alcohol is 6-10 is disclosed in the whole filing documents of

the first application B.

The application in Japan: The invention filed to Japan, claiming priority based on the first application A and B, contains the condition where the carbon number of alcohol is 1-10 (actual alternative).

Determination of priority: Since the invention relating to the patent application in Japan has actual alternatives, determination shall be made by each alternative, and for the condition where the carbon number of alcohol is 1-5, the effects of priority claim based on the first application A are recognized, while for the condition where the carbon number of alcohol is 6-10, the effects of priority claim based on the first application B are recognized.

- (3) Where the application in Japan claims the priority under the Paris Convention based on two or more first applications (multiple priorities), and invention-defining matters of the application in Japan are commonly disclosed in the first applications, the examination should be made, considering the date of filing of the earliest application that discloses the invention-defining matters of the invention as the priority date.

[Example 5] Where the invention-defining matters of the application in Japan are commonly disclosed in multiple first applications

The first application: A digital camera equipped with a specially structured image pickup device and auto-focusing device is disclosed in each of the whole filing documents of the first application A and the first application B filed later than the first application A, and the claimed invention of the first application A is the digital camera equipped with a specially structured image pickup device, while the claimed invention of another first application B is a digital camera equipped with an auto-focusing device.

The application in Japan: The claimed invention filed, claiming priority based on both the first application A and B, is the digital camera equipped with a specially structured image pickup device and auto-focusing device.

Determination of priority: The claimed invention of the application in Japan concerned is disclosed in both of the whole filing documents of the first application A and B, examination shall be performed, considering the date of filing of the first application A that is the earlier one of the first application A and B as the priority date.

- (4) Where the claimed invention of the application claiming the priority under the Paris Convention based on two or more first applications is a combination of the matters disclosed in the whole filing documents of the first applications, and the combination is not disclosed in either of the whole filing documents of the first applications, the effects of priority claim based on either of the applications are not recognized.

[Example 6] Where the claimed invention of the application in Japan is not disclosed in either of the first applications

The first application: A “greenhouse equipped with a temperature sensor and shading curtain opening/shutting system that opens/shuts the shading curtain in response to the signals from the temperature sensor” is disclosed in the whole filing documents of the first application A, and a “greenhouse equipped with a humidity sensor and ventilating window opening/shutting system that opens/shuts the ventilating window in response to the signals from the humidity sensor” is disclosed in the whole filing documents of the

other first application B.

The application in Japan: The claimed invention of the patent application claiming priority based on both of the first applications A and B concerns the “greenhouse equipped with a temperature sensor and ventilating window opening/shutting system that opens/shuts the ventilating window in response to the signals from the temperature sensor”.

Determination of priority: Since the greenhouse equipped with a temperature sensor and ventilating window opening/shutting system that opens/shuts the ventilating window in response to the signals from the temperature sensor is not disclosed in either of the whole filing documents of the first application A or B, the effects of priority claim based on either of the applications are not recognized.

4.4 Treatment of the cases where an application that serves as a basis of priority claim claims priority

Where the earlier application that served as the basis of the priority under the Paris Convention (the second application) claims the priority based on the application filed prior to the above application (the first application), for the parts disclosed in the whole filing documents of the first application among the second application, the second application cannot be “the first application” prescribed by the provision of the Paris Convention Section 4 C(2). Therefore the effects of priority claim are not recognized for the parts that have been already disclosed in the whole filing documents of the first application, and the effects of priority claim are recognized only for the parts that are not disclosed in the whole filing documents of the first application.

4.5 Deposit of microorganisms and priority claim

For treating cases where an application requiring deposit of microorganisms claims priority, see “Part VII, Chapter 2, 5.1 (iii) Application claiming priority”.

5. Treatment of priority claim under the Paris Convention in examination

5.1 Where determination on effects of priority claim is required

In application claiming priority under the Paris Convention, it is sufficient to be determined the effects of priority claim only when a prior art document that can be the ground of reasons for refusal is found during the period from the date of filing of the first application that serves as a basis of priority claim to the date of filing of the application in Japan claiming priority.

However where determination is easily made etc., it is not avoided to determine the effects of priority claim in advance of prior art search.

(Explanation)

Since determination of the effects of priority claim is required only when there is a prior art document etc. that can be a ground for a reason for refusal during the period from the date of filing of the first application to the date of filing of the application in Japan, it is sufficient for examination practices to determine the effects of priority claim only when a prior art document etc. that can be a reason for refusal is found during the period from the date of filing of the first application to the date of filing of the application in Japan.

However, since determination of the effects of priority claim in advance of prior art

search sometimes may contribute to effective examination due to restriction of the time range of prior art search, the effects of priority claim can be determined in advance of prior art search where the effects of priority claim can be easily determined etc.

5.2 Treatment of patent application for which reasons for refusal exist because effects of priority claim are not recognized

Where in the examination of the application claiming priority under the Paris Convention, a reason for refusal arises because the effects of priority claim are not recognized for the invention relating to the patent application concerned, the notification of reasons for refusal shall specify the claims, and describe that the effects of priority claim are not recognized, with their reasons. When a written opinion is submitted or correction of description, claims or drawings is made, presence/absence of the effects of priority claim shall be newly determined.

6. Other points of concern

6.1 Division or conversion of application claiming priority under the Paris Convention

For divisional or converted application claiming priority under the Paris Convention to Japan, the priority claimed at the original application can be claimed (Paris Convention, Article 4G).

(Hereinafter, applied to the divisional or converted applications filed since January 1 in 2000)

Statements or documents certifying the priority submitted with respect to the original application are considered to have been submitted simultaneously with the new patent application (Patent Act Article 44 (4), Patent Act Article 46 (5)).

6.2 Priority declared as governed by the Paris Convention

The followings can be declared as governed by the Paris Convention (Patent Act Article 43bis (i)):

- 1) The priority based on the application made by Japanese nationals or nationals of a member country of the Paris Convention (including nationals deemed to be the nationals of the member country in accordance with Article 3 of the Paris Convention) in one of the member countries of the World Trade Organization (WTO):
- 2) The priority based on the application made by the nationals of a member country of WTO in one of the member countries of the Paris Convention or WTO.

In addition, where a national of a country that is neither a country of the Union of the Paris Convention nor a member of the World Trade Organization (limited to the country allows Japanese nationals to declare a priority under the same conditions as in Japan, and is designated by the Commissioner of the Patent Office, hereinafter referred to as a "specified country") , a Japanese national, a national of a country of the Union of the Paris Convention or a national of a member of the World Trade Organization may declare a priority claim in the patent application based on the application filed in the specified country (Patent Act Article 43bis (2)).

These applications claiming priority shall be treated, as well as the cases of the applications claiming priority under the Paris Convention, in accordance with the above 4 and 5.

6.3 International application of the Patent Cooperation Treaty and its priority

Where Japan is contained in the designated countries in the international application claiming priority based on the national application to Japan (so-called “self designation”), internal priority can be claimed for the parts relating to designation of Japan (Patent Cooperation Treaty (PCT) Article 8 (2)(b)).

On the other hand, in the international application claiming priority based on the international application having designated Japan and other PCT contracting countries, the priority under the Paris Convention can be claimed with respect to the parts relating to designation of Japan when Japan is contained in the designated country (PCT Article 8 (2) (a)).

Earlier application as a basis of priority claim	Later application claiming priority	Priority that can be claimed
National application	International application containing Japan as a specified country (self designation)	Internal priority
International application having designated Japan and other countries	National application	Internal priority or priority under the Paris Convention (Selection by applicants)
	International application containing Japan as a specified state	Priority under the Paris Convention

(For details, see the attached table)

6.4 Treatment of priority claim under the Paris Convention based on special application

6.4.1 Treatment of priority claim based on divisional or converted application

Since only the first application in one of the member countries of the Paris Convention can serve as a basis of priority claim (Paris Convention Article 4C (2)), where the application in Japan is filed claiming the priority based on a divisional or converted application, the effects of priority claim are not recognized for matters disclosed in the whole filing documents of the original application, while the matters are disclosed in the whole filing documents of the divisional or converted application concerned.

Where the priority is claimed based on both divisional or converted application and its original application, the effects of priority claim based on the original application are recognized for the matters disclosed in the description etc. of the original application, while the effects of priority claim based on the divisional or converted application are recognized for the matters disclosed only in the whole filing documents of the divisional or converted application, respectively.

In these cases, where one year has passed from the filing date of the original application, the priority cannot be claimed based on the application concerned while the priority is claimed based on the divisional or converted application of the original application.

6.4.2 Treatment of priority claim based on continuation-in-part application in the US

Since only the first application in one of the member countries of the Paris Convention can serve as a basis of priority claim (Paris Convention Article 4C(2)), where the application in Japan is filed claiming the priority based on the continuation-in-part (CIP) application in the US, the effects of priority claim are not recognized for the matters disclosed in the whole filing documents of the original application, while the matters are disclosed in the whole filing documents of CIP application.

Therefore, where the priority is claimed based on the CIP application or both of CIP application and its original application, presence/absence of the effects of priority claim shall be determined in the following manner;

- (1) Where only CIP application in the US serves as a basis of priority claim:
 - i) Where the claimed invention of a patent application claiming priority defines the matters disclosed only in the whole filing documents of the CIP application as the specified matters of invention, the effects of priority claim are recognized.
 - ii) Where the claimed invention of a patent application claiming priority defines the matters commonly disclosed in the whole filing documents of the original application in the US and in the whole filing documents of the CIP application as the specified matters of invention, the effects of priority claim are not recognized.
 - iii) Where the claimed invention of a patent application claiming priority contains both the matters commonly disclosed in the whole filing documents of the original application in the US and filing documents of the CIP application and the matters disclosed only in the whole filing documents of the CIP application, the effects of priority claim are recognized only for the matters disclosed only in the whole filing documents of the CIP application.

However, where only filing documents of the CIP application are submitted as a priority certificate, the effects of priority claim are not recognized tentatively, and when reasons for refusal is notified, the tentative recognition is added to the notification of reasons for refusal to request submission of the filing documents of the original application.

When the filing documents of the original application are submitted, presence/absence of the effects of priority claim shall be determined after reference of the above documents.

- (2) Where both of the original application in the US and CIP application based on the original application concerned serve as a basis of priority claim:

The effects of priority claim based on the original application are recognized for the matters disclosed in the whole filing documents of the original application, and the effects of priority claim based on the CIP application are recognized for the matters disclosed only in the whole filing documents of the CIP application, respectively.

However, where one year has passed from the filing date of the original application, the priority cannot be claimed based on the application concerned while the priority is

claimed based on the CIP application of the original application.

6.4.3 Treatment of priority claim based on preliminary application in the US etc.

The application that can serve as a basis of priority claim under the Paris Convention is a formal national application defined by the internal laws of each member country (Paris Convention 4A (2) and (3)).

Provisional application based on the system of provisional application or provisional specification in the US, UK and Australia can serve as a basis of priority claim because it is considered to be a normal national application in the country concerned.