

Chapter 4 Prior Application (Patent Act Article 39)

1. Overview

Article 39 of the Patent Act is a provision elucidating the principle of one patent for one invention and also a system (the first-to-file system) in which only the first applicant is granted a patent when a plurality of applications are filed for one invention.

A patent system grants an exclusive right to a patentee for a given period in indemnification for laying open an invention that is creativity of a technical idea. Therefore, two or more rights should not be granted for one invention. This article is provided on the basis of such a purpose to eliminate a double patenting.

Under this article, where two or more patent applications relating to the same invention are filed on different days, only the first patent applicant may be granted a patent for the invention (Article 39(1)).

Where an invention claimed in the patent application is identical with a device claimed in an application for a utility model registration and where the applications are filed on different days, the patent applicant may be granted a patent for an invention only if the applicant filed the application earlier than the applicant of the application for the utility model registration (Article 39(3)).

Where two or more patent applications relating to the same invention are filed on the same date, only one applicant, agreed upon through consideration between the applicants, can be granted a patent (the first sentence of Article 39(2)). If an agreement fails to be reached through consultation or if consultation was impossible, none of the applicants can be granted a patent for the invention (the second sentence of Article 39(2)).

Where two or more patent applications relating to the same invention are filed on the same date, the Director-General of the Patent Office shall order the applicants to hold consultations for an agreement and to report the result thereof, within a designated time limit (Article 39(6)). Where the report is not made, the Director-General of the Patent Office may deem that no agreement has been reached (Article 39(7)).

The same shall apply to the case where an invention relating to a patent application is identical with a device relating to an application for a utility model

registration and where the applications are filed on the same date (Article 39(4), (6), and (7)).

In this chapter, a patent application to be examined is hereinafter referred to as an "application concerned." In relation to application of Article 39(1) to (4), an application other than the application concerned is hereinafter referred to as "another application" or "other application." Further, with regard to Article 39(1) or (3), an earlier filed application, among a plurality of applications filed on different days, is referred to as an "earlier application," and applications filed later than the earlier application are hereinafter referred to as "later applications." With regard to Article 39(2) or (4), the other applications filed on the same date when the application concerned was filed are hereinafter referred to as "co-pending applications filed on the same date." Moreover, an invention or device is hereinafter referred to as "an/the invention, etc."

2. Requirements for Article 39

Requirements for yielding an effect of refusal of the application concerned after application of Article 39 to the application concerned are as follows:

(1) Formal requirements to be fulfilled by the other applications.

- (i) The other application shall be filed earlier than or on the same date as the application concerned is filed.
- (ii) The other application shall not be one deemed not to exist from the beginning under the provision of Article 39(1) to (4) (Article 39(5)).

(2) An invention relating to the application concerned and an invention, etc. relating to the other application shall be the same (substantial requirements).

The invention relating to the application concerned herein means an invention claimed in claims of the application concerned (hereinafter referred to as "claimed invention" in this chapter). Further, an invention, etc. relating to the other application shall be an invention, etc. claimed in a claim of the other application.

3. Interpretation on Requirements for Article 39

The examiner shall interpret whether or not the other application fulfills

the formal requirements of Article 39 (see 2.(1)).

The examiner shall interpret whether or not the substantial requirements of Article 39 (see 2.(2)) are fulfilled, on the basis of whether or not both inventions are the same, as a result of a comparison between the claimed invention with the invention, etc. claimed in a claim of the other application fulfilling the formal requirements of Article 39.

When two or more claims are in the claims of the application concerned, the examiner shall make an interpretation for each claim.

3.1 Interpretation on whether or not the other application fulfills the formal requirements provided in Article 39

The examiner shall interpret whether or not the other application fulfills both requirements (i) and (ii) of 2.(1). When the other application fails to fulfill even one of the requirements, the examiner shall not be able to refuse the application concerned by applying the provision of Article 39 to the application concerned on the basis of the other application.

3.1.1 The other application shall not be one deemed not to exist from the beginning under the provision of Article 39(5) (2.(1)(ii))

In the case of (i) or (ii) provided below, the other application shall be deemed not to exist from the beginning under the provision of Article 39(1) to (4). Therefore, when the other application does not fall under either of (i) and (ii) provided below, the examiner shall interpret that the other application fulfills the requirement referred to in 2.(1)(ii).

- (i) When the other application is abandoned, withdrawn, or dismissed.
- (ii) When a decision of refusal or a trial decision of refusal is determined (excluding the case where the decision of refusal or a trial decision of refusal becomes final and conclusive because other co-pending applications filed on the same date are present in connection with the other application (the second sentence of Article 39(2) or the second sentence of Article 39(4).))

3.2 Interpretation on whether or not the claimed invention and the invention claimed in the claim of the other application, etc., are the same

3.2.1 Where the other application is an earlier application

When considering that (i) or (ii) provided below is applicable as a result of a comparison between the claimed invention and an invention, etc. claimed in the claim of the earlier application (hereinafter referred to as "prior invention" in 3.), the examiner shall interpret that the two inventions are the same.

- (i) Where no difference exists between the claimed invention and the prior invention.**
- (ii) Where the claimed invention and the prior invention share the substantial identity even when a difference exists there.**

"Substantial identity" herein means a case where any one of (i) to (iii) provided below is applicable.

- (ii-1) Where the difference is a very minor difference (an addition, deletion, conversion, etc., of common general knowledge or commonly-used art (Note 1), which does not yield any new effect) in embodying means for resolving a problem.
- (ii-2) Where the difference is caused as a result of the matter specifying the prior invention being expressed by a generic concept (Note 2) in the claimed invention.
- (ii-3) Where the difference is a mere difference in categorical expressions (for example, a difference between expression forms, or an invention of "product" or an invention of "method")

(Note 1) For "Common general knowledge" and "Commonly-used art," see 2. (Note1) in "Chapter 2 Section 2 Inventive Step."

(Note 2) For a generic concept, see 3.2 (Note1) in "Chapter 2 Section 3 Procedure of Determining Novelty and Inventive Step."

3.2.2 Where the other application is a co-pending

When an invention A and an invention B are applied on the same day and are the same (means "same" referred to in 3.2.1. This shall apply to corresponding counterparts in this paragraph hereunder) in the both cases of (i) and (ii) provided below, the examiner shall identify that the claimed invention and inventions claimed in the claims of the co-pending applications filed on the same

date (hereinafter referred to as "co-pending inventions" in this chapter).

(i) Where the invention A is presumed to be an earlier application and where the invention B is presumed to be a later application

(ii) Where the invention B is presumed to be an earlier application and where the invention A is presumed to be a later application

In the meantime, even in a case where the invention B of the later application and the invention A of the earlier application are the same provided that the invention A is taken as an earlier application and that the invention B is taken as a later application, when the invention A of the later application and the invention B of the earlier application are not the same provided that the invention B is taken as an earlier application and that the invention A is taken as a later application, the examiner shall interpret that the claimed invention and the co-pending inventions are not the "same" (e.g., the invention A is a "spring," and the invention B is an "elastic member").

4. Procedures of Examination under Article 39

Article 39 shall apply to a case where the claimed invention and the prior invention or the co-pending invention are the same. There is a possibility that details of the prior invention or details of the co-pending invention will be changed by an amendment to the claims of the other application. On the other hand, a cited invention employed when Article 29 (novelty and inventive step) applies to the application concerned is not subjected to such a possible change. The scope where the application concerned can be eliminated under Article 29bis (secret prior art) corresponds to the description, the claims, or the drawings originally attached to the earlier application and is broader than the scope referred in Article 39 and not changed by the amendment. Therefore, as in the case of (1) or (2) provided below, when the provision of Article 29 or the provision of Article 29bis can be applied to the application concerned, the examiner shall apply these provisions to the application concerned without applying the provision of Article 39 to the application concerned.

(1) Where an unexamined patent application, a gazette containing the patent, or a gazette containing the utility models, which are relevant to laying-open of the earlier application, has been published before filing of the application concerned, the inventions stated or included in the gazettes correspond to the invention stipulated in Article 29(1)(iii). Hence, the examiner applies the provision of Article 29 to the application concerned without applying the provision of Article 39.

(2) Where the provision of Article 29bis is applied to the application concerned, the examiner shall apply the provision of Article 29bis to the application concerned without applying the provision of Article 39 to the application concerned.

Where the filing date of the other application and the filing date of the application concerned are the same, where the applicants are the same, or where the inventors (creators of devices) are the same, Article 29bis shall not apply to the application concerned. Therefore, the examiner shall make deliberations on application of Article 39 to the application concerned.

In this chapter, the followings are based on the presumption that an unexamined patent application, a gazette containing the patent, or a gazette containing the utility models, which are relevant to laying-open of the earlier application, has not been published before filing of the application concerned.

4.1 Finding of the claimed invention and the prior invention or the co-pending invention

The examiner shall find the claimed invention.

Also, the examiner shall find a prior invention or a co-pending invention (Notes 1, 2) claimed in another application fulfilling the formal requirements of 2.(1). The finding technique is the same as the technique referred to in 2. in “Chapter 2 Section 3 Procedure of Determining Novelty and Inventive Step.”

(Note 1) Where the prior invention or the co-pending invention comes to include a matter (new matter) not falling within the scope of the matters stated in the originally-filed description, the claims, or the drawings, as a result of amendments, the examiner shall not find the invention as the prior invention nor the co-pending invention. The reason for this is that imparting an effect of excluding a later application or co-pending applications filed on the same date to the invention claimed in the claim including a new matter goes against the principle of the first-to-file system.

Further, on the basis of the same principle, where the prior invention or the co-pending invention includes a new matter as to the original text in a foreign language written application, a patent application in foreign language or an utility model registration application in foreign language, the examiner shall not find the invention as a prior invention or as a co-pending invention. However, even when the application includes a new matter as to the translation but not a new matter as to the original text, the examiner shall find the invention as a prior

invention or a co-pending invention.

(Note 2) When the prior invention or the co-pending invention cannot be taken as a cited invention in accordance with 3.1.1(1)b in “Chapter 2, Section 3 Procedure of Determining Novelty and Inventive Step”, the examiner shall not find the invention as the prior invention or the co-pending invention. However, in 3.1.1(1)b in “Chapter 2 Section 3 Procedure of Determining Novelty and Inventive Step”, "an invention which a person skilled in the art can grasp from matters stated in publications and matters nearly stated" shall read "an invention claimed in the claim of another application"; "stated in the publications" shall read "stated in the description and drawings of another application"; and "common general knowledge as of filing" shall read "common general knowledge at the time of filing of another application."

4.2 Contradistinction between the claimed invention and the prior invention or the co-pending invention

The examiner shall compare the found claimed invention with the found prior invention or co-pending invention.

The examiner shall perform a comparison in accordance with the technique referred to in 4 in “Chapter 2, Section 3 Procedure of Determining Novelty and Inventive Step” (one of "claimed invention" and "cited invention" shall read "claimed invention," and the other shall read "prior invention or co-pending invention").

4.3 Interpretation on whether or not the claimed invention is unpatentable under Article 39

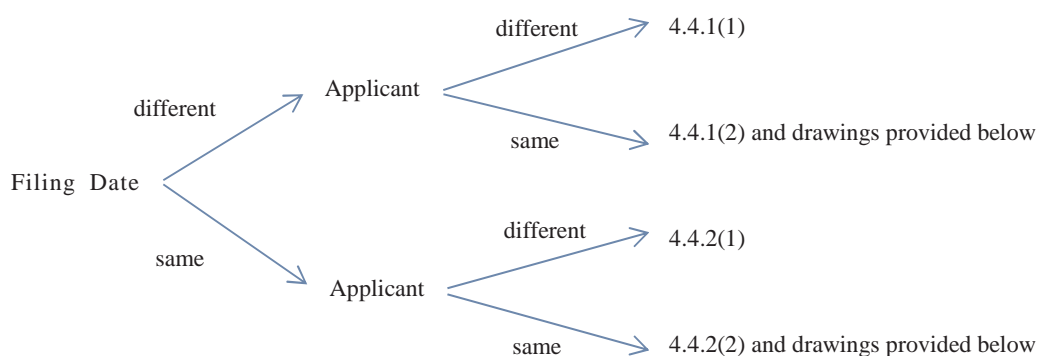
The examiner shall compare the claimed invention with the prior invention or the co-pending invention. When interpreting that the two inventions are the same in accordance with 3.2, the examiner shall interpret that the claimed invention is unpatentable under Article 39.

When a matter specifying the invention of the claim of the application has alternatives, the invention of the claim of the application which would be obtained when only one of the alternatives is taken as a matter specifying the invention shall be compared with the invention claimed in the claim of the other application. When a comparison result shows that the two inventions are the "same" in this chapter, the examiner shall interpret that the claimed invention is unpatentable under Article 39.

4.4 Procedures of examination pertaining to whether or not the claimed invention is unpatentable under Article 39

When gaining a belief that the claimed invention is unpatentable under Article 39(1) to (4) on the basis of 4.3, the examiner shall proceed with examination in accordance with handling of the respective cases which will be hereinafter referred to in 4.4.1 and 4.4.2 (See drawings provided at the end of this chapter for a case of a plurality of patent applications related to one applicant, which often causes problems in actual practice. An interpretation on whether or not applicants are the same is performed in relation to an applicant at a point in time of each examination. The interpretation technique is the same as that referred to in 3.1.2(2) in “Chapter 3 Secret Prior Art”).

Moreover, the examiner shall comply with 4.4.3 in relation to handling performed after issuing a notice of reasons for refusal under Article 39.



4.4.1 Where another application is an earlier application

(1) Where an applicant of the application concerned is different from an applicant of another application

Where an inventor of the application concerned is different from an inventor of another application, the examiner shall apply Article 29bis to the case (see “Chapter 3 Secret Prior Art”)

On the other hand, when the two inventors are the same, the examiner shall issue a notice of reasons for refusal to the application concerned under the provision of Article 39(1) or (3). However, when issuing a decision of refusal on the basis of

the reasons for refusal, the examiner shall not proceed with examination until the earlier application becomes final and conclusive.

- (2) Where an applicant of the application concerned and an applicant of another application are the same

The examiner shall proceed with examination by issuing a notice of reasons for refusal to the application concerned under Article 39(1) or (3) regardless of whether or not the earlier application becomes final and conclusive. When issuing a notice of reasons for refusal to the application concerned under Article 39(1) or (3) on the basis of the earlier application which is not yet final or conclusive (including an application for which a request for examination is not yet filed), the examiner shall append, to the notice of reasons for refusal, a comment to the effect that a decision of refusal will be issued unless the reasons for refusal are dissolved even when the earlier application is not yet final or conclusive.

There is a case where examination of the earlier application has not yet commenced at the time of a response to the notice of reasons for refusal to the application concerned, although a request for examination of the earlier application has already been filed. In this case, if a proposal to the effect that the applicant is willing to make an amendment to the earlier application is offered in response to the notice of reasons for refusal to the application concerned, the examiner shall handle the case as follows.

- a Where the earlier application includes reasons for refusal

The examiner shall issue a notice of reasons for refusal to the earlier application and shall not proceed with examination, after lapse of a designated period, until confirming whether or not an amendment is made to the earlier application and details of the amendment.

- b Where the earlier application does not include reasons for refusal

The examiner shall not proceed with examination until a decision to grant a patent is issued for the earlier application.

4.4.2 Where another application is a co-pending application filed on the same date

- (1) Where the applicant of the claimed application is different from the applicant of another application

- a Where respective applications are pending in the Patent Office

The examiner shall handle the case as follows depending on whether or not a

request for examination has been filed for all of the co-pending applications.

(a) Where a request for examination has been filed for all of the co-pending applications

The examiner shall invite the applicants of all the applications to have consultation under the name of the Director-General of the Patent Office. When the application concerned includes reasons for refusal other than those based on Article 39(2) or (4), the examiner shall send a notice of the reasons for refusal when inviting the applicant of the application to have consultation. The reason for this is that, as a result of the notice of reasons for refusal other than those based on Article 39(2) or (4) being issued at the time of inviting the applicants to have the consultations, the applicant shall be able to know substantially all the reasons for refusal at the same time and take an appropriate response.

Where a result of consultation is submitted within a designated period and when the application concerned is the application of the applicant designated by the consultations, the examiner shall issue a decision to grant a patent unless there are other reasons for refusal. If the application is not the application of the applicant specified by the consultations, the examiner shall issue a notice of reasons for refusal under Article 39(2) or (4).

Where a result of consultation is not submitted within the designated period, the consultations are deemed to have failed (Article 39(7)). The examiner shall issue a notice of reasons for refusal under Article 39(2) or (4). However, when interpreting that the provision of Article 39(2) or (4) shall not be applicable to the application concerned for reasons other than submission of the consultation result, the examiner shall not issue the notice of reasons for refusal. Cases corresponding to this are mentioned as follows: a case where the reasons based on Article 39(2) or (4) are resolved by an amendment to the claims of the application concerned, and a case where the examiner taking into account an assertion in a written opinion interprets that there are no reasons for refusal under Article 39(2) or (4).

(b) Where a request for examination is not filed for some of the co-pending applications

Where there are also reasons for refusal based on a provision other than Article 39(2) or (4), the examiner can proceed with examination based on the reasons for refusal. However, a decision of refusal based on the reasons for

refusal shall be made only when the reasons for refusal based on Article 39(2) or (4) are resolved; for instance, a case where the claimed invention and the co-pending invention become not identical with each other as a result of an amendment, etc. Where the reasons for refusal based on Article 39(2) or (4) are not resolved, the examiner shall not issue a decision of refusal based on a provision other than Article 39(2) or (4).

(Explanation)

The application for which the decision of refusal has become final and conclusive is in principle deemed to be one originally nonexistent from the beginning (an application not having so-called "status of prior application") with regard to application of the provisions of Article 39(1) to (4). However, when a decision of refusal based on Article 39(2) or (4) has become final and conclusive, the application has a prior-art effect. Therefore, where a decision of refusal based on another provision is issued when there is a possibility that a decision of refusal will be issued under Article 39(2) or (4), the prior-art effect of the application will be lost. The application will be rejected, whereas the co-pending applications will not be rejected under Article 39(2) or (4). This would go against the aim of Article 39(2) or (4) to the effect that an application, agreed upon the consultation, can be granted a patent or a utility model registration and, hence, inappropriate. Accordingly, the examiner shall handle the case as above.

In the case of (i) or (ii), the examiner shall issue, to the applicant of the application for which the request for examination has already been filed, a notice to the effect that the examiner cannot proceed with examination under Article 39(2) or (4) because a request for examination is not filed for the other applications. The reason for this is that it has not yet come to a state of being able to invite the applicant to have consultation because a request for examination has not been filed for some of the co-pending applications.

(i) Where a decision of refusal is not issued because the reasons for refusal based on Article 39(2) or (4) are not resolved, although there are reasons for refusal based on a provision other than Article 39(2) or (4) as above.

(ii) Where there are only reasons for refusal based on Article 39(2) or (4).

After issuance of the notice, the examiner shall not proceed with examination until a request for examination is issued for the other applications so that it becomes possible to invite the applicant to have consultation, or until the other applications are withdrawn (including elapse of a period of a request for

examination) or dismissed.

b Where a patent or utility model is registered for at least one of the co-pending applications

(a) This case corresponds to a case where consultations are impossible (Article 39(2) or (4)). The examiner shall not invite consultation under the name of the Director-General of the Patent Office for the applications for which a patent or utility model is not registered but shall issue a notice of reasons for refusal under Article 39(2) or (4).

(b) When issuing a notice of reasons for refusal under Article 39(2) or (4), the examiner shall notify the patentee or the owner of a utility model right of the fact.

(Explanation) Where a patent or utility model is registered for at least one of the applications, the consultation cannot be performed. However, holding an opportunity to have a substantial consultation between the patent applicant and the patentee/the owner of a utility model is conceived to be useful in order to avoid reasons for refusal or invalidation and obtain appropriate protection for invention or device. Therefore, the examiner shall handle the case as above.

(2) Where an applicant of the application concerned and the applicant of the other application are identical with each other

a Where the applications are pending in the Patent Office

Even when the applicants are the same, the examiner shall apply the provision of Article 39(2) or (4) in conformity with the case where the applicants are different, handling as referred to in 4.4.2(1)a. The aim of Article 39(2) and (4) resides in providing one right per one invention. Therefore, even when the applicants are the same, the provision shall be applied.

However, where handling the case as referred to in 4.4.2(1)a, the examiner shall notify all reasons for refusal simultaneously with issuing invitation to consult. The reason for this is that, where the applicants are the same, a time for consultation shall be unnecessary.

b Where a patent or an utility model is registered for at least one of the co-pending applications

The examiner shall handle the case in the same way as referred to in 4.4.2(1)b(a). The reason for this is that, when the applicants are the same, the

applicant can take an appropriate response upon receipt of a notice of reasons for refusal. The examiner shall not issue a notice referred to in 4.4.2(1)b(b).

4.4.3 Handling after notification of reasons for refusal under Article 39

When gaining a belief that the claimed invention is unpatentable under the provision of Article 39(1) to (4) on the basis of 4.3, the examiner shall issue a notice of reasons for refusal based on the provision of Article 39 in light of 4.4.1 or 4.4.2. In particular, when the examiner interprets that the claimed invention and the prior invention or the co-pending invention share substantial identity (see 3.2.1(ii)), the notice of reasons for refusal must be those that make it possible for the applicant to grasp reasons so as to be able to offer a refutation or elucidation.

In response to the notice of reasons for refusal to the effect that the claimed invention is unpatentable under the provision of Article 39(1) to (4), the applicant can make an amendment to the claims by submitting an amendment or offer a refutation or elucidation by means of a written opinion, a certificate of experimental results, etc.

When the examiner has become unable to hold a belief that the claimed invention is unpatentable under the provision of Article 39(1) to (4), because of the amendment, refutation, or elucidation, the reasons for refusal are dissolved. When the belief remains unchanged, the examiner shall issue a decision of refusal on the basis of the reasons for refusal to the effect that the claimed invention is unpatentable under the provision of Article 39(1) to (4) (excluding a case where examination is not carried on as referred to in 4.4.1(1), 4.4.1(2)a and b, or 4.4.2(2)a which applies 4.4.2(1)a or 4.4.2(1)a(b) *mutatis mutandis*).

5. Dealing of Claims, etc. Including Certain Expressions

With regard to finding the claimed invention, the Examiner proceeds according to "Chapter 2, Section 4 Claims Including Specific Expressions" concerning a case that the claims of a present application have a specific expression falling under the following (i) to (vi).

- (i) an expression specifying the product by operation, function, characteristics or features
- (ii) an expression specifying the product by its use application (limitation of use)

- (iii) an expression specifying the invention of sub-combination by elements of “another sub-combination”
- (iv) an expression specifying a product by a manufacturing process
- (v) an expression specifying the invention by numerical limitation
- (vi) selection invention

6. Dealing of Various Applications

(1) Reference date for whether other application is an earlier patent application or patent application filed on the same date (the filing dates of the present application and the other application) is treated per the following table.

Kinds of application	Reference date
Divisional application, converted application or patent application based on Utility Model Registration	Filing date of the original application (Articles 44(2), 46(6) or 46bis(2))
Application claiming internal priority right (Concerning the invention stated in Description, Claims or Drawing originally attached to a request of a prior application on which a claim of the internal priority right is based)	Filing date of an application among the application(s) on which the claim of the internal priority right is based, in which the invention according to claim(s) to be determined is stated (Article 41(2))
Application with a claim of a priority under the Paris Convention (Concerning the invention stated in complete filing documents of the application on which the claim of the priority right under the Paris Convention is based (Description, Claims or Drawing))	Filing date of an application among the application(s) on which the claim of the priority right under the Paris Convention is based, in which the invention according to claim(s) to be determined is stated (Article 4(B) of the Paris Convention)
International Patent Application or International Utility Model Registration Application	International filing date (Article 184ter(1)). Provided, the above-mentioned matters are applied when the application claims the priority right.

(2) Points to note

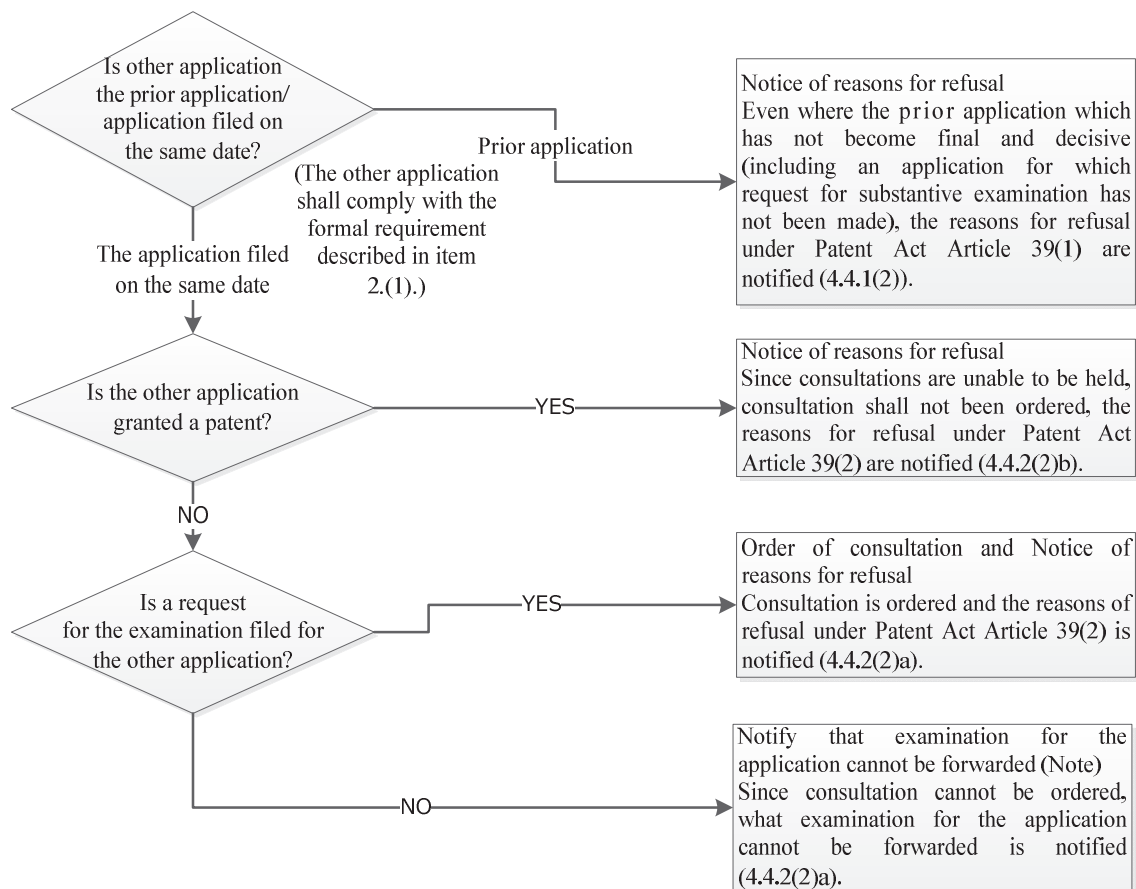
a A case in which the present application is a converted application

Since where an application is converted, the original application shall be deemed to have been withdrawn (Patent Act Article 46(4) and Utility Model Act Article 10(5)), the original application shall, for the purpose of Article 39(1) to (4), be deemed

never to have been filed (Patent Act Article 39(5)).

b A case in which the present application is a patent application based on utility model registration

Even where the invention of the patent application based on utility model registration and the device of the utility model registration are the same, the provisions of Article 39 are not applied therefor (parenthesized provision of Patent Act Article 39(4)).



(Note) In the case where the reasons of refusal other than under Article 39 exist, the examination can be proceeded in principle (see 4.4.2(2)a)

Figure Outline of treatment of violating Patent Act Article 39 in a case where several patent applications for the same invention filed by the same applicant are filed