

15. 06

Handling of the period of priority in a case where an application for design registration is a result from conversion of a patent application or an application for utility model registration containing a priority claim under the Paris Convention, etc.

If a new application for design registration is a result from conversion of a patent application or an application for utility model registration which contains a priority claim, the priority claim is found to be effective only when the original patent application or the original application for utility model registration was filed within six months from the filing date of the earliest application in the first country.

(Explanation)

Article 4, paragraph C, item (1) of the Paris Convention stipulates the period of priority for designs as six months, while Article 4, paragraph E, item (1) of the Paris Convention stipulates the period of priority for designs as six months in a case where the application for design registration is filed in the second country by claiming priority based on the application for utility model registration filed in the first country. Meanwhile, Japan prescribes the period of priority for an application for utility model registration as 12 months. In accordance with this provision, in a case where an application for utility model registration has been filed in Japan based on the application for utility model registration filed in the first country after six months from the filing date in the first country and the procedure for a priority claim has been undertaken, if the application is later converted into an application for design registration and the effect of the priority claim is permitted, then the period of priority, i.e., six months, for the application for design registration would be extended. To avoid this, the period of priority should be treated as mentioned above, taking into consideration the consistency with the purposes of Article 4, paragraph C, item (1) and Article 4, paragraph E, item (1) of the Paris Convention.

Court decision for reference: Court decision of the Tokyo High Court, 1996 (Gyo-ke) 34, "Whistle Caramel Candy"; Date of the decision: July 16, 1997

(The preceding sentences are omitted.) Article 4, paragraph C, item (1) of the Paris Convention stipulates the period of priority as 12 months for utility models and as six months for designs. Meanwhile, Article 4, paragraph E, item (1) of the Paris Convention stipulates to the effect that if a design is registered in any member state by claiming priority based on the application for utility model registration, the period of priority should be that stipulated for designs (i.e., six months) and the said provision establishes that such period of priority should start from the filing date of the earliest application (Paris Convention 4(C)2).

Nevertheless, no special provisions are stipulated regarding the period of priority for the case where, as in the present case, an application for utility model registration is filed in the second country claiming priority based on an application for utility model registration filed in the first country and, after that, converted to an application for design registration.

However, the purpose of the provisions of Article 4, paragraph E, item (1) of the Paris Convention can be understood that Article 4, paragraph C, item (1) of the Paris Convention stipulates that the period of priority should be basically determined in accordance with whether or not the application filed in the first country involves a patent, a utility model, a design or a trademark; but that if the application filed in the second country, which was filed to enjoy the effect of a priority claim based on the application filed in the first country, is an application seeking the effect of design protection, it is reasonable that the period of priority should be the period of priority for designs as provided for in Article 4, paragraph C, item (1) of the Paris Convention as a principle. For the purpose of this provision, it is reasonable to understand that: even if the application with a priority claim which is filed in the second country is initially an application for utility model registration, –as far as the application is converted to an application for design registration and the effect of design protection is sought– the period of priority which the application can enjoy should be reasonably understood as the period of priority for designs as provided for in Article 4, paragraph C, item (1) of the Paris Convention as a principle.

In view of this, it should be said that: in order for the new application for design registration resulting from conversion in the present case to succeed the effect of the priority claim based on the original application for utility model registration, the original application for utility model registration must have been filed within six months from the filing date of the application for utility model registration in Spain (the first country). In the present case, the period of time between the filing date of the application for utility model registration which the plaintiff filed in Spain and the filing date of the original application for utility model registration exceeded six months. Accordingly, it must be said that the new application for design registration resulting from conversion cannot succeed the effect of the priority claim of the original application for utility model registration. (The following sentences are omitted.)