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Determination on a change of the gist in a case where an application for design registration containing a priority claim under the Paris Convention, etc. is amended

A determination on a change of the gist in the case where an application for design registration containing a priority claim under the Paris Convention, etc. has been amended should be made based on the statements in the application for design registration filed in Japan and the drawings, etc. attached to the application.

(Explanation)

A “priority certificate, etc.” (Patent Act 43(2) [m.m.] Design Act 15(1)) for the application for design registration filed in the first country is, even if such application contains a priority claim, merely a material for considering the effect of the priority claim. Therefore, the certificate itself does not have any nature or effect equivalent to that of the application for design registration filed in Japan or the drawings attached to the application. In accordance with this, a determination on whether or not the amendment changes the gist of the application should be made based only on the statements in the application for design registration filed in Japan and the drawings, etc. attached to the application.

Court decision for reference: Court decision of the Tokyo High Court, 1969 (Gyo-ke) 128, “Digital Calculation System”; Date of the decision: October 13, 1981

(The preceding sentences are omitted.) A priority certificate does not have any nature or effect equivalent to that of the description or drawings of the patent application filed in Japan. (The following sentences are omitted.)

Court decision for reference: Court decision of the Tokyo High Court, 1977 (Gyo-ke) 46; Date of the decision: June 27, 1978

(The preceding sentences are omitted.) Since the Paris Convention is based on the principle of territoriality and the principle of independence of patents in each country, it goes without saying that even if an application is based on a priority claim under the Paris Convention, the success or failure of a patent application in Japan depends on the application under its domestic law. Moreover, the description of the application filed in the first country is merely a so-called priority certificate which is a material for examining the effect of the priority claim, i.e., the presence of the retroactive effect of the filing date. Accordingly, the certificate itself or a translation thereof does not have a nature or effect equivalent to that of the description of the patent application filed in Japan. (The sentences between the paragraphs are omitted.) In the end, a determination on whether or not the present amendment changes the gist must be made based solely on the description originally attached to the application filed in Japan, examining whether or not the amendment lies within the scope of the statements in the application. (The following sentences are omitted.)