

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

## Part V Priority

### Contents

#### Chapter 1 Priority under the Paris Convention

5101 The Case Where There is a Due Reason Why an Applicant Fails to File a Patent Application Claiming Priority under the Paris Convention within 12 Months from an Application Filed in a First Country .....	1 -
5102 Regular National Application Filed in a Member Country of the Union of the Paris Convention .....	2 -
5103 The Case Where a Subsequently Filed Application is Deemed to be the First Application .....	3 -
5104 Reason Why a Determination on the Effect of Claiming the Priority under the Paris Convention is Made Dependent on Whether There is Any Addition of a New Matter .....	4 -
5105 Example Where the Claimed Invention Filed in Japan is Converted within the Scope of the Matters Stated in the Application Documents as a Whole Filed in a First Country .....	5 -
5106 Example Where, with the Invention Stated in the Application Documents as a Whole Filed in a First Country, Another Matter Specifying the Invention not Stated Therein is Combined .....	6 -
5107 Determination on Whether or not the Claimed Invention Filed in Japan is Enabled or Not .....	7 -
5108 The Case Where the Application Documents as a Whole Filed in the First Country States Only a Part of the Claimed Invention Filed in Japan .....	10 -
5109 Example Where Matters Stated in the Application Documents Filed in the First Country are Stated in Separate Claims Filed in Japan .....	11 -
5110 Example Where Matters Specifying the Invention Stated in the Claim Filed in Japan are Stated in the Applications Filed in a First Country in Common .....	12 -

#### Chapter 2 Internal Priority

5201 The Case Where There is a Due Reason Why an Applicant Fails to File a Sequent Patent Application Claiming Internal Priority within One Year from an	
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Earlier Application.....- 1 -

## Chapter 1 Priority under the Paris Convention

### 5101 The Case Where There is a Due Reason Why an Applicant Fails to File a Patent Application Claiming Priority under the Paris Convention within 12 Months from an Application Filed in a First Country

An applicant who fails to file a patent application claiming priority under the Paris Convention within the period of priority may claim such priority for the same patent application pursuant to the Paris Convention even after a lapse of such period if there is a due reason why the applicant fails to do so (Note) and the applicant files the application within 2 months from the date of expiry of the period of priority (Article 27-4-2 (2) of Regulations under the Patent Act) (Article 43-2 (1) of the Patent Act). Such a case shall be handled in accordance with 3. and 4. of "Part V Chapter 1 Priority under the Paris Convention" of the Examination Guidelines as in the case of an application claiming priority under the Paris Convention.

An applicant claiming priority under the Paris Convention shall submit the documents stating the matters specified in Article 43 (1) of the Patent Act to the JPO Commissioner within the period of time specified in the Ordinance of the Ministry of Economy, Trade and Industry (i.e. Article 27-4-2 (3) (i), (ii) and (iv) of Regulations under the Patent Act).

(Note) The examiner needs not make a determination on the "due reason". Such determination is made through formality checks.

## 5102 Regular National Application Filed in a Member Country of the Union of the Paris Convention

Regular national application filed in a member country of the Union of the Paris Convention means an application filed under national laws and regulations of a member country of the Union of the Paris Convention or an application deemed to be a regular national application under a bilateral or multilateral treaty concluded between member countries of the Union of the Paris Convention that meets the requirements to establish a filing date of the application. Even an application withdrawn, abandoned, or refused by a decision after filing of the patent application, therefore, may be a basis of the claim of priority under the Paris Convention so far as it satisfies the above (Article 4 A (3) of the Paris Convention).

### 5103 The Case Where a Subsequently Filed Application is Deemed to be the First Application

Even if two applications are filed for the same subject in the same member country of the Union of the Paris Convention, a subsequently filed application is deemed to be the first application so far as both of the following requirements are met:

- (i) when the earlier patent application is withdrawn, abandoned or refused by a decision before the filing date of the subsequently filed application, without becoming open to public inspection and without any rights remaining; and
- (ii) when the earlier patent application does not constitute a basis of the claim of priority under the Paris Convention.

### 5104 Reason Why a Determination on the Effect of Claiming the Priority under the Paris Convention is Made Dependent on Whether There is Any Addition of a New Matter

The Paris Convention establishes that "elements of the invention" shall be specifically disclosed by the application documents as a whole filed in a first country in order that the claim of priority under the Paris Convention takes effect. (Article 4 H of the Paris Convention). It is understood that, in order to meet the above requirement, the claimed invention grasped from statements in the application documents as a whole filed in Japan needs to be within the scope of the matters stated in the application documents as a whole filed in the first country.

## 5105 Example Where the Claimed Invention Filed in Japan is Converted within the Scope of the Matters Stated in the Application Documents as a Whole Filed in a First Country

[Application filed in a first country]

The claimed invention filed in the first country is related to a specific compound, and the application documents as a whole state an embodiment of an anticancer agent containing the compound as an active ingredient.

[Application filed in Japan]

The claimed invention filed in Japan is related to the anticancer agent containing the compound as an active ingredient while detailed descriptions of the invention and drawings are stated in the application documents as a whole filed in the first country.

(Determination on the priority)

Using the specific compound for the anticancer agent is stated in the application documents as a whole filed in the first country, and does not fall under the addition of new matter in relation to the matters stated therein. The claim of priority under the Paris Convention, therefore, takes effect.

5106 Example Where, with the Invention Stated in the Application Documents as a Whole Filed in a First Country, Another Matter Specifying the Invention not Stated Therein is Combined

[Application filed in a first country]

The application documents as a whole filed in the first country only state "vibration control structure that connects the lower story part and the upper story part of the structure with the vibration control device."

[Application filed in Japan]

It is claimed that the claimed invention filed in Japan is related to "vibration control structure that connects the lower story part and the upper story part of the structure with the vibration control device, and is equipped with means to control the connection".

(Determination on the priority)

The claimed invention filed in Japan has combined, with the invention stated in the application documents as a whole filed in the first country, another matter specifying the invention not stated therein. In other words, since the claimed invention falls under the addition of new matter in relation to the matters stated in the application documents as a whole filed in the first country, the claim of priority under the Paris Convention does not take effect.



## 5107 Determination on Whether or not the Claimed Invention Filed in Japan is Enabled or Not

Determination on whether or not the claimed invention filed in Japan is enabled or not is similar to that on enablement requirement of requirements for description. (See "Part II Chapter 1 Section 1 Enablement Requirement" of the Examination Guidelines for specific methods of determination)

Please see 1.1.4(4) of "Appendix B Chapter 2 Biological Inventions" for the case of claiming priority for which the deposit of biological material is necessary.

Example 1: The claimed invention filed in Japan becomes enabled after addition of an embodiment.

[Application filed in a first country]

No embodiment is stated in the application documents as a whole filed in the first country, and the claimed invention filed therein is not considered to be enabled.

[Application filed in Japan]

While the wording of the claimed invention filed in Japan is the same as that of the claimed invention filed in the first country, an embodiment is added in the detailed description of the invention or drawings, which makes the former invention enabled.

(Determination on the priority)

Since such addition of the embodiment makes the claimed invention filed in Japan go beyond the scope of the matters stated in the application documents as a whole filed in the first country, the claim of priority under the Paris Convention does not take effect.

(Explanation)

If the statement of an embodiment is added to the application documents filed in the first country, and the application is filed in Japan, which makes the claimed invention filed in Japan enabled, it will mean that new matter is added in relation to the matters stated in the application documents as a whole filed in the first country. With regard to the claimed invention filed in Japan, therefore, the claim of priority under the Paris Convention does not take effect.

Example 2: The claimed invention filed in Japan becomes enabled after the additional statement of experiment results showing usability.

[Application filed in a first country]

The claimed invention filed in the first country is a gene, and the application documents as a whole state that the gene can be made, but fail to clarify its function. So, the claimed invention filed therein is not considered to be enabled.

[Application filed in Japan]

The claimed invention filed in Japan is the same gene as that in the claimed invention filed in the first country. The statement of its function based on experiment results is added to the application documents as a whole filed in Japan, which makes the invention of the gene enabled.

(Determination on the priority)

Since the invention of the gene for which the application is filed in Japan does not fall within the scope of the matters stated in the application documents as a whole filed in the first country, the claim of priority under the Paris Convention does not take effect.

(Explanation)

If, in filing the application in Japan, the statement of usability of the invention is added to the statements in the application documents filed in the first country, which makes the claimed invention filed in Japan enabled, it will mean that new matter is added in relation to the matters stated in the application documents as a whole filed in the first country. With regard to the claimed invention filed in Japan, therefore, the claim of priority under the Paris Convention does not take effect.

Example 3: The claimed invention filed in Japan becomes enabled due to a change in the common general knowledge.

[Application filed in a first country]

The claimed invention filed in the first country is a transgenic plant, and the application documents as a whole filed there states a dicotyledonous plant alone as the embodiment. It is recognized that no monocotyledonous plant could be made as a transgenic plant in view of the statement and the common general knowledge at the time of filing.

[Application filed in Japan]

The statement in the application documents as a whole filed in Japan is the same as that in the documents filed in the first country. Thanks to advancement in the gene recombination technology after the filing in the first country, the common general knowledge at the time of filing in Japan is that it is possible to genetically

modify monocotyledonous plants as long as dicotyledonous plants can be modified genetically. The claimed invention filed in Japan for the gene recombination of the monocotyledonous plant, therefore, becomes enabled as well.

(Determination on the priority)

Since the part of the monocotyledonous plant goes beyond the scope of the matters stated in the application documents as a whole filed in the first country due to the change in the common general knowledge, the claim of priority under the Paris Convention takes effect only for the part of the dicotyledonous plant, and does not for the part of the monocotyledonous plant.

(Explanation)

With regard to the part of the monocotyledonous plant in the claimed invention filed in Japan, the change in the common general knowledge means addition of new matter in relation to the matters stated in the application documents as a whole filed in the first country. Hence, the claim of priority under the Paris Convention takes effect only for the part of the dicotyledonous plant in the claimed invention, and does not for the part of the monocotyledonous plant.

## 5108 The Case Where the Application Documents as a Whole Filed in the First Country States Only a Part of the Claimed Invention Filed in Japan

[Application filed in a first country]

The application documents as a whole filed in the first country only state corrosion resistant steel containing chromium.

[Application filed in Japan]

The invention in one claim filed in Japan refers to the corrosion resistant steel containing chromium, and the invention in the other claim refers to the corrosion resistant steel containing chromium and aluminum.

(Determination on the priority)

With regard to the corrosion resistant steel containing chromium, the invention of one claim filed in Japan, the claim of priority takes effect because it is stated in the application documents as a whole filed in the first country. On the other hand, with regard to the corrosion resistant steel containing chromium and aluminum, the invention in the other claim, the claim of priority under the Paris Convention does not take effect because it means addition of new matter in relation to the matters stated in the application documents as a whole filed in the first country.

## 5109 Example Where Matters Stated in the Application Documents Filed in the First Country are Stated in Separate Claims Filed in Japan

[Application filed in a first country]

The application documents "A" as a whole filed in the first country state corrosion resistant steel containing chromium, and the application documents "B" as a whole filed in the first country state the corrosion resistant steel containing chromium and aluminum.

[Application filed in Japan]

One of the claimed invention filed in Japan claiming priority based on both of the application documents "A" and "B" as a whole filed in the first country is the corrosion resistant steel containing chromium, and another of the claimed invention so filed is the corrosion resistant steel containing chromium and aluminum.

(Determination on the priority)

With regard to one of the claimed invention filed in Japan, the priority claim takes effect based on the application "A" filed in the first country. With regard to another of the claimed invention filed in Japan, the priority claim under the Paris Convention takes effect based on the application "B" filed in the first country.

## 5110 Example Where Matters Specifying the Invention Stated in the Claim Filed in Japan are Stated in the Applications Filed in a First Country in Common

[Application filed in a first country]

The applications (earlier application "A" and later application "B") documents as a whole filed in the first country state a digital camera equipped with an image pickup element of certain construction and an automatic focus device. The claimed invention in the application "A" is a digital camera equipped with an image pickup element of certain construction, and the invention in the claim in the application "B" is a digital camera equipped with an automatic focus device.

[Application filed in Japan]

The claimed invention filed in Japan claiming priority based on both of the applications "A" and "B" filed in the first country is a digital camera equipped with an image pickup element of certain construction and an automatic focus device.

(Determination on the priority)

This case is examined with the filing date in the application "A" in the first country, the earlier application, regarded as the base date because the claimed invention filed in Japan is stated in the applications (both of the application "A" and the application "B") documents as a whole filed in the first country.

## Chapter 2 Internal Priority

### 5201 The Case Where There is a Due Reason Why an Applicant Fails to File a Sequent Patent Application Claiming Internal Priority within One Year from an Earlier Application

In the case where there is a due reason (Note) why an applicant fails to file a sequent patent application claiming internal priority within one year from the filing date of an earlier application, the applicant may claim internal priority within the period of one year and two months (Article 27-4-2 (1) of Regulations under the Patent Act ) from the filing date of the earlier application. (Article 41 (1) parentheses in (i) of the Patent Act)

If the applicant claims internal priority, he/she shall submit to the JPO Commissioner a document stating thereof and the indication of the earlier application within the period of time specified in the Ordinance of the Ministry of Economy, Trade and Industry (Article 27-4-2 (3)(i) to (iii) of the Regulations under the Patent Act).

(Note) The examiner needs not make a determination on the "due reason". Such determination is made through formality checks.