Chapter 2 Internal Priority

1. Overview

In the system of priority based on a patent application etc. prescribed by the provision of Patent Act Article 41 (hereinafter referred to as "internal priority" in this chapter), in cases where a patent application claiming priority is filed for content consolidated as a comprehensive invention (hereinafter referred to as "later application" in this chapter) containing invention(s) of its own patent application or application for utility model registration that has been already filed (hereinafter referred to as "earlier application" in this chapter), amongst the comprehensively claimed inventions, for invention(s) stated in the originally attached description, claims or drawings (hereinafter referred to as "originally attached description etc." in this chapter) of the earlier application a prioritized treatment is allowed to deem the later application to have been filed at the time when the earlier application was filed, with respect to determination on whether the requirements of novelty, inventive step etc. are met.

According to this system, where an application for basic invention(s) has already been filed, a subsequent patent application can be filed as a comprehensive invention bringing the content of such basic invention(s) and later invention(s) of improvement together so that the results of technical development can be easily and smoothly protected as a patent right in a complete form. The system also allows the effects of claim of priority be recognized in Japan, for an international application under the Patent Cooperation Treaty (PCT) claiming priority based on an earlier application and including Japan as a designated country (PCT Article 8 (2) (b), so-called, "self designation").

2. Requirements and Effects of Claim of Internal Priority

2.1 Person who can claim internal priority

A person who can claim internal priority is the one who desires a patent and the applicant of the earlier application (Patent Act Article 41(1) main paragraph).

Therefore the applicant of the earlier application and the applicant of the later application shall be the same at the time when the later application is filed.

Where there is a person who holds a provisional exclusive license on the earlier application, the applicant of the later application needs to obtain consent from the

person before the filing date of the later application (Article 41(1) proviso).

2.2 Period when a later application claiming internal priority can be filed

The period when a later application claiming internal priority can be filed (priority period) shall in principle be one year from the filing date of the earlier application (Patent Act Article 41 (1)(i)).

2.3 Earlier application that can serve as a basis of claim of internal priority

Except where any of the following cases of (i) to (iv) is applicable, an earlier application can serve as a basis of claim of internal priority. However, an application for design registration cannot serve as a basis of claim of internal priority (Patent Act Article 41 (1)).

(i) Where the earlier application is a new application divided out from or converted from an application, or a new patent application based on a utility model registration (Patent Act Article 41(1) (ii));
(ii) Where the earlier application has been abandoned, withdrawn or dismissed as oft the time when the later application claiming internal priority is filed (Patent Act Article 41(1) (iii));
(iii) Where the examiner's decision or the trial decision on the earlier application has become final and binding as of the time when the later application claiming internal priority is filed (Patent Act Article 41(1)(iv)); or
(iv) Where the registration of establishment of the utility model right has been effected with respect to the earlier application, as of the time when the later application claiming internal priority is filed (Patent Act Article 41(1) (v)).

In contrast to the priority system under the Paris Convention under which only the first application in one of the member countries of the Paris Convention can serve as the basis of priority claim (see 2.3.2 in "Chapter 1 Priority under the Paris Convention"), an earlier application serving as the basis of internal priority shall not be limited to the first application in Japan.

2.4 Effects of claim of internal priority

For inventions amongst those claimed in a later application claiming internal priority, for inventions that are stated in the originally attached descriptions etc. to an earlier application on which the internal priority claim is based, the later application shall be deemed to have been filed at the time when the earlier application was filed, in application of the following provisions of (i) to (vi) in connection with substantive examination (Patent Act Article 41(2)). Note that, regarding a later application claiming internal priority, if an earlier application on which the internal priority claim is based has been dismissed under the provisions of the Economic Security Promotion Act, the relevant priority claim is to cease to be effective (Economic Security Promotion Act, Article 82(1)).

(i) Novelty (Article 29(1))
(ii) Inventive step (Article 29(2));
(iii) Secret prior art (Article 29bis main paragraph);
(iv) Exceptions to lack of novelty of invention (Article 30(1) to (2));
(v) Prior application (Article 39(1) to (4));
(vi) Requirements for independent patentability on the above-mentioned (i) to (v) (Article 126 (7) as applied mutatis mutandis under Article 17bis(6)).

However, in application of the provisions of the other clauses in connection with substantive examination (for example, Article 32 and Article 36) on the later application claiming internal priority, determination shall be made based on the time when the later application is filed. In the case of application of the provisions of Article 29bis on the later application claiming internal priority as a precedent application under such provision, see 6.1.3 in “Part III Chapter 3 Secret Prior Art.”

3. Determination on Effects of Claim of Internal Priority

3.1 Basic idea

3.1.1 Where determination on effects of internal priority claim is required

It is sufficient for the examiner to determine whether or not the effects of internal priority claim shall be recognized, only when the examiner finds that a prior art, etc. that can be the ground of reasons for refusal exists during the period from the filing date of the earlier application that serves as a basis of internal priority claim to the filing

date of the later application. Only in the case where the examiner finds the existence of a prior art, etc. that can be referenced to in the reason for refusal during the period between the filing dates of the earlier application and the later application, the examiner may change the determination on requirements of novelty, inventive step, etc., depending upon whether or not the effects of internal priority claim is recognized.

The examiner may also determine on the effects of internal priority claim in advance of prior art search where such effects can be easily determined or otherwise applicable, since determination of the effects of priority claim in advance of prior art search may sometimes contribute to effective examination due to restriction of the time range of prior art search.

3.1.2 Subject of determination

In principle, the examiner shall determine the effects of internal priority claim on a claim-by-claim basis. Where matters specifying the invention in one claim are expressed by alternatives, however, the examiner shall determine the effects of internal priority claim for each invention that is understood based on each alternative. Furthermore where modes for carrying out the claimed invention are newly added, the examiner shall determine the effects of internal priority claim for the newly added part within the claimed invention, separately from the remaining part.

3.1.3 Comparison with matters stated in the originally attached descriptions etc. of the earlier application and determination

(1) Basic idea

Based on the assumption that the description, claims and drawings of the later application are amended description, claims and drawings of the earlier application, if such amendment would add new matters on the claimed invention of the later application relative to the "originally attached descriptions etc. of the earlier application," the effects of internal priority claim shall not be recognized. In other words, the effects of internal priority claim shall not be recognized where such amendment introduces new technical matters to the claimed invention relative to the "matters stated in the originally attached descriptions etc."

The term "matters stated in the originally attached descriptions etc." herein means technical matters which are derived by a person skilled in the art from

comprehensive understanding of all the matters stated in the originally attached descriptions etc.

(2) Typical cases where the claimed invention of the later application is not considered to be within the scope of the matters stated in the originally attached descriptions etc. of the earlier application

Subject to 3.1.3(2) in "Chapter 1 Priority under the Paris Convention."

3.2 Partial priority or multiple priorities

Treatment of partial priority or multiple priorities is subject to 3.2 in "Chapter 1 Priority under the Paris Convention."

3.3 Treatment of cases where application that serves as a basis of claim of internal priority claims priority

Where the earlier application that serves as a basis of claim of internal priority (the second application) claims internal priority, priority under the Paris Convention or priority declared by the Paris Convention based on a prior application (the first application) which was filed in advance of the second application, among the matters stated in the originally attached description etc. of the second application, the effects of internal priority claim shall not be recognized for the invention(s) already stated in the originally attached description, etc. of the first application. Otherwise the period of priority would be substantively extended as the priority is recognized again (cumulatively) for the invention(s) stated in the first application. Thus for the second application that serves as a basis of claim of internal priority, the effects of internal priority claim shall be recognized only for the part unstated in the originally attached descriptions etc. of the first application (Article 41(2) to (3)). For a case where the first application also serves as a basis of claim of internal priority, priority under the Paris Convention or priority declared by the Paris Convention, see 3.2.2(2) in "Chapter 1 Priority under the Paris Convention."

4. Procedure of Examination for Determination on the Effects of Internal Priority Claim

The procedure of examination for determination on the effects of internal priority claim shall be subject to the procedure of examination for determination on the

effects of priority claim under the Paris Convention (see 4. in "Chapter 1 Priority under the Paris Convention").

5. Points to Note

5.1 Division or conversion of applications claiming internal priority

A divisional application derived from a subsequent application claiming internal priority, or an application for converting a utility model registration application claiming internal priority into a patent application, is deemed to claim the same internal priority as claimed in the original application. This is because documents evidencing internal priority that were submitted for the original patent application are deemed to have been submitted to the JPO Commissioner concurrently with the new patent application (Articles 44(4) or 46(6)).

5.2 Withdrawal of the application underlying the claim for internal priority

(1) The earlier application, which is alleged to underlie the claim for internal priority, is deemed withdrawn one year and four months after the date of filing thereof except in the cases set forth in (i) to (v) below (Article 42(1), Regulations under the Patent Act, Article 28quater(2) and Economic Security Promotion Act, Article 82(2)).

(i) The earlier application was waived, withdrawn, or dismissed.

(ii) The examiner's decision or a trial decision on the earlier application became final.

(iii) Registration establishing a utility model right has been effected for the earlier application.

(iv) All internal priority claims based on the earlier application were withdrawn.

(v) The earlier application has received a security designation (Note 1).

(Note 1) In this case, the patent application is deemed withdrawn either one year and four months after the date of filing of the earlier application or upon receipt of notification under the provision of Article 77(2) of the Economic Security Promotion Act regarding the relevant earlier application, whichever is later.

(2) The applicant of the subsequent application claiming internal priority may not

withdraw such claim after one year and four months from the date of filing of the earlier application (Article 42(2) and Regulations under the Patent Act, Article 28quater(2)). If the subsequent application claiming internal priority is withdrawn within one year and four months from the date of filing of the earlier application, then such priority claim is deemed withdrawn simultaneously (Article 42(3) and Regulations under the Patent Act, Article 28quater(2)).

(3) If an internal priority claim is based on a PCT international application in which the designated states include Japan, then it is deemed withdrawn "at the standard time of national processing (in principle, at the time of expiration of the period for submission of national documents (Note 2)) or one year and four months after the date of filing of that international application, whichever is later" (Article 184quindecies(4) and Regulations under the Patent Act, Article 38sexies(5)).

(Note 2) "Period for submission of national documents" refers to the two-year-and-six-month period beginning on the priority date specified in PCT Article 2(xi) (Article 184quater(1)).

Appended table: Relationship between PCT international application and right of priority

Earlier application underlying priority claim	Subsequent application claiming priority	Claimable priority	Time when earlier application is deemed withdrawn	Period during which claim of priority may be withdrawn
National application	PCT international application in which the designated states include Japan (self-designation)	Internal priority (PCT Article 8(2)(b), Patent Act Articles 184ter(1) and 41(1))	One year and four months after date of filing of earlier application (Patent Act Article 42(1) and Regulations under the Patent Act Article 28quater(2))	Within 30 days from priority date (*) (PCT Rules 90bis.3(a) and Patent Act Article 184quindecies(1))
PCT international application in which Japan and other countries are designated	National application	Internal priority or right of priority under Paris Convention (At the applicant's option) (Patent Act Articles 184ter(1), 184quindecies(4) and 41, or Paris Convention Article 4(A))	In the case of internal priority, "at the standard time of national processing" or "one year and four months after filing of PCT international application," whichever is later (Patent Act Articles 184quindecies(4), 42(1) and Regulations under the Patent Act Article 38sexies(5)) No such time is set for priority under Paris Convention	In the case of internal priority, within one year and four months from the date of filing of earlier application (Patent Act Article 42(2), Regulations under the Patent Act Article 28quater(2)) Priority claim under Paris Convention may not be withdrawn
	PCT international application in which the designated states include Japan	Right of priority under Paris Convention PCT Article 8(2)(a) and Paris Convention Article 4(A))	No such time set	Within 30 days from priority date (PCT Rules 90bis.3(a))

* Even after one year and four months from the date of filing of the earlier application, the priority claim may still be withdrawn at any time within 30 months from the priority date; provided, however, that this will not revive the earlier application, which is already deemed withdrawn.