

Chapter 3 Secret Prior Art (Patent Act Article 29bis)

1. Overview

Patent Act Article 29bis provides that a patent application (hereinafter referred to as an "application" in this chapter) to be examined shall be unpatentable when fulfilling all (i) to (iv) given below:

- (i) Where an invention claimed in the application concerned is identical with an invention or a device (the invention or the device is hereinafter referred to as "an/the invention, etc." in this chapter) stated in the originally-filed description, the claims or an application for a utility model registration, or drawings (hereinafter referred to as "originally-filed description, etc." in this chapter) of another patent application or an application for a utility model registration which was filed earlier than the patent application concerned (another patent application or an application for utility model registration is hereinafter referred to as "another application" in this chapter).
- (ii) Where issuance of a gazette containing the patent, laying-open of an unexamined application (Article 64), or issuance of a Utility Model Bulletin (Article 14(3) of the Utility Model Act) (hereinafter referred to as "laying-open or the like" in this chapter) was conducted in connection with the other application after filing of the application concerned.
- (iii) The person who made the invention claimed in the other application (hereinafter referred to as "inventor of the other application" in this chapter) is not identical with the invention claimed in application concerned.
- (iv) The applicant of the application concerned is not identical with the applicant of the other application at the time at which the application concerned was filed.

In this chapter, among applications filed on different dates, applications filed earlier are hereinafter referred to as "earlier applications," and applications filed later are hereinafter referred to as "later applications."

Even when a later application was filed before laying-open of the earlier application, if the invention claimed in the later application is identical with the invention stated in the originally-filed description, etc., of the earlier application, new techniques are not laid open in the later application which is laid open. The reason why this article provides the above is that granting the patent right to the invention

claimed in such a later application is not reasonable in view of the spirit of the patent system which protects an invention in indemnification for laying a new invention open.

When this article is compared with Article 39 (see “Chapter 4 Prior Application”) with regard to a range where the earlier application can preclude the later application, the range is an invention, etc., stated in (i) mentioned above in this article. However, in Article 39, the range is limited to an invention, etc., claimed in the claims of the patent or utility model registration. In this regard, the range where the earlier application can preclude the later application is broader in this article than that provided in Article 39. For this reason, the earlier application of this article is what is called "secret prior art."

2. Requirements for Article 29bis

The followings are requirements for yielding an effect of refusing the application concerned as a result of applying Article 29bis to the application concerned.

(1) Formal requirements to be fulfilled by another application

- (i) Another application is filed on the day earlier than the filing date of application concerned.
- (ii) The laying-open or the like of another application was made after the filing date of the application concerned. (Note)
- (iii) The inventor of another application was not identical with the inventor of the invention claimed in the application concerned.
- (iv) The applicant of the other application is not identical with the applicant of application concerned as of the filing date of the application concerned.

(Note) When the laying-open or the like of the other application was made before filing of application concerned, Article 29bis shall not apply to the other application. The invention laid open by the official gazette pertaining to the laying-open or the like of application concerned is taken as an invention falling under Article 29(1)(iii), and Article 29(1) or (2) shall apply to application concerned.

(2) The invention of the application shall be identical with the invention stated in the originally-filed description, etc. of another application (a substantive requirement).

The invention of the application concerned herein means an invention

claimed in the application concerned.

3. Interpretation on Requirements for Article 29bis

An invention to be interpreted as to the requirements for Article 29bis is a claimed invention.

The examiner shall interpret whether or not the other application fulfills the formal requirements (see 2.(1)) for Article 29bis.

Further, the examiner shall interpret whether or not the substantive requirements (see 2.(2)) for Article 29bis are fulfilled, on the basis of whether or not the invention claimed in the application concerned and the invention, etc. claimed in the originally-filed description of the other application fulfilling the formal requirements for Article 29bis (hereinafter referred to as the "cited invention" in this chapter) are identical by contradistinction therebetween. When interpreting that the claimed invention and the cited invention are identical with each other, the examiner shall interpret that the claimed invention shall not be granted a patent under the provision of Article 29bis.

When two or more claims are included in the claims of the application concerned, the examiner shall make an interpretation on the requirements for Article 29bis on a per-claim basis.

3.1 Interpretation on whether or not another application fulfills the formal requirements provided in Article 29bis

The examiner shall interpret whether or not another application fulfills all of the requirements (i) to (iv) stated in 2.(1). When any one of the requirements is not fulfilled, the examiner cannot apply the provision of Article 29bis to application concerned on the basis of the other application.

3.1.1 Inventor of another application is not identical with the inventor of the invention claimed in the application concerned (2.(1)(iii))

(1) When neither (i) nor (ii) provided below applies to the other application, the examiner shall interpret that the inventor of the other application is not identical (hereinafter referred to as "inventor is not same" in this chapter) with the inventor of the

invention of the claim of the application concerned.

- (i) Where all inventors stated in respective requests are completely the same in writing.
- (ii) Where all inventors are completely the same as a result of being substantially interpreted even when all of the inventors stated in the respective requests are not completely the same in writing (example: when a discrepancy between the inventors in writing is attributable to the alteration of the inventor's family name, and the inventors are interpreted to be the same).

(2) In principle, the examiner shall presume the inventor stated in request to be the inventor of the invention claimed in the application concerned. The examiner shall also make a like presumption for the inventors of the other applications. However, for instance, in such a case where another inventor is stated in a description, the examiner presumes that a person other than the inventor stated in the request is an inventor.

(3) The examiner should note that the presumption that the inventor is not the same may be overturned if the applicant submits evidence (an oath of an inventor of the other application, etc.) for proving that the inventor is the same.

3.1.2 Inventor of another application is not identical with the applicant of the application concerned at the time at which application concerned was filed
(2.(1)(iv))

(1) The examiner shall interpret whether or not the applicant of another application and the applicant of application concerned are the same (hereinafter referred to as "applicant is same" in this chapter) at the filing date of application concerned.

(2) The examiner shall interpret that the applicant is not the same when neither the case (i) nor (ii) provided below is applicable.

- (i) Where all applicants stated in respective requests are completely the same in writing.
- (ii) Where all applicants are completely the same as a result of being substantially interpreted even when all of the applicants stated in the respective requests are not completely the same in writing (example: when the applicant of the application does not match in writing the applicant of another application as a result of the applicant having undergone alteration of the applicant's name, inheritance (succession), or merger & acquisition).

3.2 Interpretation on whether or not the invention claimed in the application concerned and the cited invention are identical.

The examiner shall interpret that the invention claimed in the application concerned and the cited invention are the "same" in this chapter when the inventions fall under (i) or (ii) provided below as a result of contradistinction therebetween.

(i) Where the invention claimed in the application concerned and the cited invention have no difference.

(ii) Where the invention claimed in the application concerned and the cited invention are different but share substantial identity.

Substantial identity referred to herein means a case where a difference between the invention claimed in the application concerned and the cited invention is a very minor difference (an addition, deletion, conversion, etc., of common general knowledge or commonly used art (note), which does not yield any new effect) in embodying means for resolving a problem.

(Note) For "common general knowledge" and "commonly used art," see 2 (Note1) in "Chapter 2 Section 2 Inventive Step."

4. Procedures of Examination under Article 29bis

4.1 Finding of Invention claimed in application concerned

The examiner shall find an invention claimed in the application concerned. The finding technique is similar to that referred to in 2. in "Chapter 2, Section 3 Procedure of Determining Novelty and Inventive Step."

4.2 Finding of Cited Invention

The examiner shall find a cited invention on the basis of the originally-filed description, etc. of another application fulfilling the formal requirements of 2.(1). The examiner shall find an invention stated in the originally-filed description, etc., in accordance with the finding of the invention stated in a publication defined in 3.1.1(1)

in “Chapter 2 Section 3 Procedure of Determining Novelty and Inventive Step.” However, the "publication" shall read "originally-filed description, etc.," and "the time at which the application concerned was filed" shall read "the time at which another application was filed."

The examiner shall handle an invention in accordance with 3.2 in “Chapter 2, Section 3 Procedure of Determining Novelty and Inventive Step” when the invention is expressed in a generic or specific concept in the originally-filed description, etc. of another application. Further, the examiner must pay attention to hind-sight, etc., in accordance with 3.3 in “Chapter 2, Section 3 Procedure of Determining Novelty and Inventive Step.”

Incidentally, even when a matter stated in the originally-filed description, etc., of the other application is deleted by a subsequent amendment, the deletion of the matter shall not affect application of the provision of Article 29bis.

4.3 Contradistinction between invention claimed in application concerned and cited invention

The examiner shall compare an invention claimed in the found application with the found cited invention. The examiner performs the comparison ("the time at which the application concerned was filed" shall read "the time at which another application was filed") in accordance with the technique referred to 4. in “Chapter 2 Section 3 Procedure of Determining Novelty and Inventive Step.”

4.4 Interpretation on whether or not the invention claimed in the application concerned is unpatentable under the provision of Article 29bis and procedures of an examination pertaining to the interpretation

4.4.1 Interpretation on whether or not the invention claimed in the application concerned is unpatentable under the provision of Article 29bis

The examiner shall compare the invention claimed in application concerned with the cited invention and interprets that the invention claimed in application concerned is unpatentable under the provision of Article 29bis when interpreting that two inventions are the same, on the basis of an interpretation on 3.2.

In a case where a matter specifying a claimed invention has alternatives,

when the claimed invention, which is obtained on the assumption that only one of the alternatives is a matter specifying the invention, and the cited invention are "the same" in this chapter when compared with each other, the examiner shall interpret that the invention claimed in the application concerned is unpatentable under the provision of Article 29bis.

4.4.2 Procedures of examination pertaining to interpretation on whether or not the invention claimed in application concerned is unpatentable over the provision of article 29bis.

When gaining a belief that the invention shall be unpatentable under the provision of Article 29bis on the basis of 4.4.1, the examiner shall issue a notice of reasons for refusal under Article 29bis. In particular, when interpreting that the claimed invention and the cited invention share substantial identity (see 3.2(ii)), the notice of reasons for refusal must be one such that the applicant can grasp reasons why the examiner made such an interpretation and that the applicant can 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 29bis, the applicant can make amendments on the claims or offer a refutation or elucidation by means of a written argument, certified experiment results, etc.

When amendments, a refutation, or an elucidation makes the examiner unable to maintain the belief that the claimed invention shall be unpatentable under the provision of Article 29bis, the reasons for refusal are dissolved. When holding on to the belief, the examiner shall issue a decision of refusal on the grounds of the reasons for refusal that the claimed invention should be unpatentable under the provision of Article 29bis.

5. Dealing of Claims, etc. including Certain Expressions

When the claim of application concerned includes a specific expression falling under (i) to (vi) provided below, the finding of the claimed invention is handled in accordance with "Chapter 2, Section 4 Claims Including Specific Expressions."

- (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

6.1 Where another application is a divisional application, an application claiming priority, etc.

6.1.1 A divisional application, a converted application, or a patent application based on a utility model registration

As to 2(1)(i), the filing date of another application shall be an actual filing date without retroacting (the proviso to Article 44(2), Article 46(6) and Article 46bis (2)).

6.1.2 Application claiming priority under the Paris Convention (or priority declared as governed by the Paris Convention)

With regard to an application claiming priority under the Paris Convention (or priority declared as governed by the Paris Convention), an invention stated commonly in (i) and (ii) provided below shall be handled as one filed to Japan on the filing date of the first foreign application.

- (i) Entire filing documents of the first foreign application.
- (ii) Originally-filed description, etc., of an application to Japan

6.1.3 Application on which a claim of internal priority is based (earlier application) or application claiming internal priority (later application)

(1) With regard to inventions stated in originally-filed descriptions, etc., of the earlier

application and the later application(hereinafter referred to as "inventions stated in both" in this chapter) (Invention B in the following drawing), the provision of Article 29bis shall apply to the application concerned while the earlier application is taken as another application (Article 41(3), and the filing date of the other application is a filing date of the earlier application) (Note).

(Note) In the case of (i) provided below, the examiner shall not apply the provision of Article 29bis to the invention of (ii) provided below while taking the earlier application as another application (Article 41(3)). The reason for this is to prevent a substantial extension of a priority period on the grounds that a cumulative effect of priority claim shall not be permitted.

(i) Where the earlier application claims priority (including priority under the Paris Convention and priority declared as governed by the Paris Convention)

(ii) An invention stated in the originally-filed description, etc., of an application (the earlier application before last) on the basis of which priority was claimed for the earlier application among the inventions stated in both (Invention A in the following drawings).

(2) With regard to an invention stated in only the originally-filed description, etc., of the later application but not stated in the originally-filed description, etc., of the earlier application. (Invention C in the following drawing) s

The provision of Article 29bis shall apply to the application concerned (Article 41(2) and (3), the filing date of another application is an application of the later application) while the later application is taken as another application.

(3) With regard to an invention stated in only the originally-filed description, etc., of the earlier application but not in the originally-filed description, etc., of the later application (Invention D in the following drawing).

The examiner shall not apply the provision of Article 29bis to the invention while taking the earlier application or the later application as another application. This is because the invention shall not be deemed as being laid open or the like. (Article 41(3))

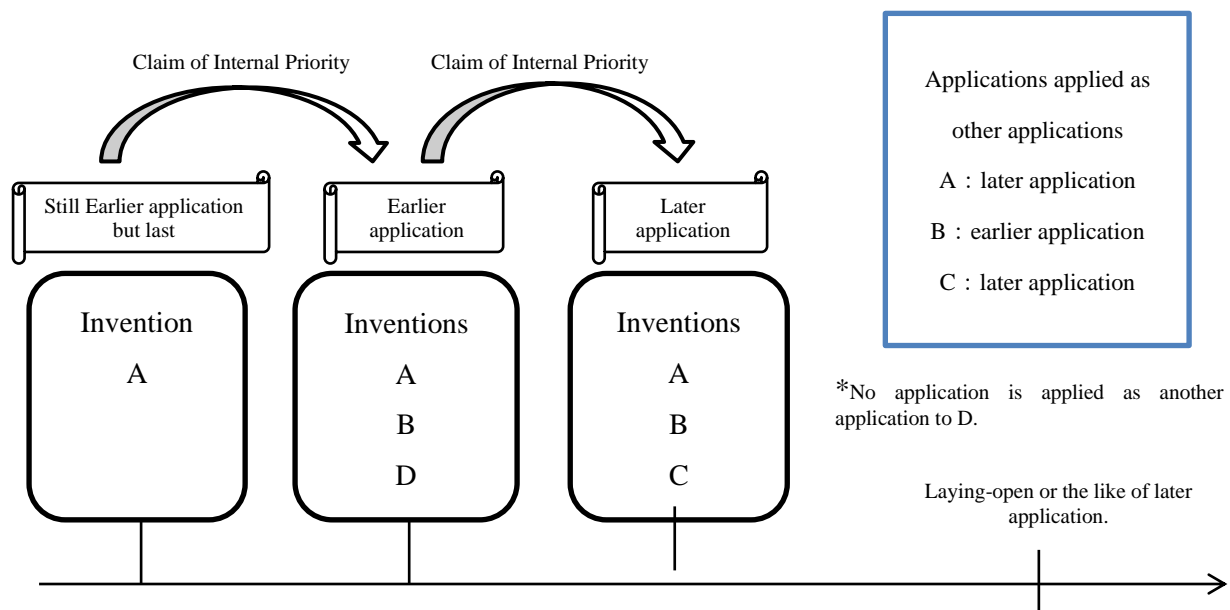


Figure Relationship between Internal Priority and Other applications under Article 29bis

6.1.4 Foreign language written application, international patent application, or international application for utility model registration

(1) Interchange of Wording

a "Another Application"

In the case of a patent application in foreign language or an utility model registration application in foreign language, "another application" shall read "another application (except an application withdrawn because a translation is not submitted)" (Article 184terdecies (184-13) and Article 184quater (3), and Article 48quater (3) of the Utility Model Act).

b "Laying-open or the like of Application"

In the case of an international patent application or an international application for a utility model registration, "laying-open or the like of an application" shall read "international publication, etc." (Article 184terdecies (184-13) and Article 184quindecies (184-15)(2) to (4)).

c "Originally-filed Description etc."

In the case of a foreign language written application, "originally-filed description, etc." shall read "document written in foreign language (original text)"

(the parenthesized provisions Article 29bis and the parenthesized provision of Article 41(3)).

In the case of an international patent application or an international application for a utility model registration, "originally-filed description, etc." shall read "description, claims, or drawings (original text) of an international application on an international filing date" (Article 184terdecies (184-13), Article 184quindecies (184-15)(3) and (4)).

- (2) Points to consider in cases where an application (earlier application) on which internal priority is claimed is a foreign language written application, a patent application in foreign language or an utility model registration application in foreign language (hereinafter referred to as a "foreign language written application, etc." in this chapter.)

Handling pertinent to 6.1.3 in this case remains the same when a translation of the earlier application has already been submitted and when the translation has not been submitted (the parenthesized provision of Article 41(3), and the provisions of Article 184quindecies (3) (184-15(4)).

- (3) Points to consider pertaining to the scope of search for another application

When a foreign language written application, etc. is another application, an effect of secret prior art of the other application stems from an original text. Hence, it is finally required to be able to point out statements in the original text of the other cited application. However, since there is extremely high probability that a match exists between the original text and the translation, it is usually considered that examination of only the statements translated into Japanese will suffice.

- (4) Points to consider pertaining to a method for writing a notice of reasons for refusal when a foreign language written application etc. is cited as another application

It is usually sufficient to point out a statement in a translation and write a comment to the effect that a corresponding statement in an original text is a reason for refusal. However, if a portion of the statement in original text is known, portions of the statements in both the translation and the original text shall be pointed out.

- (5) Response to applicant's argument when another application is a foreign language written application, etc.

a Where a notice of reasons for refusal is issued while a foreign language written

application, etc. is taken as another application, when the examiner becomes unable to gain a belief that a matter pointed out by the examiner is stated in the original text as a result of the applicant alleging, in a written argument, etc., that a matter pointed out by the examiner is not stated in the original text of another application concerned, the reasons for refusal shall be dissolved. Holding on to the belief, the examiner shall issue a decision of refusal.

- b Where a new matter beyond the original text (See 2 in “Part VII Chapter 2 Examination of Foreign Language Written Application” and 5.2 in “Part VIII International Patent Application”) is found in the original in rebuttal by the applicant in connection with another application which has not yet finished being examined, a notice of reasons for refusal of the new matter in the original shall be issued by the examiner for the other application.

6.2 Case where an application is a divisional application, an application claiming priority, etc.

A filing date of an application provided in 2.(1)(i) (a date to be compared with a filing date of another application) is handled as in the following table.

Application Type	Filing Date of Application
A patent application based on a divisional application, a converted application, or an application for a utility model registration	Filing date of an original application (Article 44(2), Article 46(6) or Article 46bis(2))
Application claiming internal priority	Filing date of an earlier application (Article 41(2))
Application claiming priority under the Paris Convention (or priority declared as governed by the Paris Convention)	Filing date of the first foreign application (Article 4B of the Paris Convention)
International patent application	International filing date (Article 184ter (1)). However, when priority is claimed, it is the same as above in the upper columns.

A standard time (a time when the application concerned was filed) when an interpretation is made as to whether or not filing of application concerned is followed by laying-open or the like of another application under 2.(1)(ii) is handled as stated in the following table.

Application Type	Filing Time of Application
A patent application based on a divisional	Filing time of an original application

application, a converted application, or an application for a utility model registration	(Article 44(2), Article 46(6) or Article 46bis(2))
Application claiming internal priority	Filing time of an earlier application (Article 41(2))
Application claiming priority under the Paris Convention (or priority declared as governed by the Paris Convention)	Filing date of the first foreign application (Article 4B of the Paris Convention) (Note)
International patent application	International filing date (Article 184ter(1)) (Note). However, when priority is claimed, it is the same as above in the upper columns.

(Note) "Filing date" rather than "filing time" is exceptionally taken as a standard.

Filing time of application concerned stated in 3.1.2 (a time when an applicant of another application and the applicant of the application concerned are interpreted to have the identity) is handled as follows:

Application Type	Filing Time of Application
A patent application based on a divisional application, a converted application, or an application for a utility model registration	Filing time of an original application (Article 44(2), Article 46(6) or Article 46bis(2))
Application claiming internal priority	Filing time of a later application (Article 41(2))
Application claiming priority under the Paris Convention (or priority declared as governed by the Paris Convention)	Time at which an application is filed to Japan
International patent application	International filing date (Article 184ter(1)) (Note)

(Note) "Filing date" rather than "filing time" is exceptionally taken as a standard.