

<Relevant Provisions>

Patent Act

(Requirements for Patentability)

Article 29(1)

Any person who has made an invention which is industrially applicable may obtain a patent for said invention, except in the case of the following inventions:

- (i) inventions that were publicly known in Japan or a foreign country, prior to the filing of the patent application;
- (ii) inventions that were publicly worked in Japan or a foreign country, prior to the filing of the patent application; or
- (iii) inventions that were described in a distributed publication, or inventions that were made publicly available through an electric telecommunication line in Japan or a foreign country, prior to the filing of the patent applications.

(2) Where an invention could easily have been made, prior to the filing of the patent application, by a person with ordinary skill in the art to which the invention pertains, on the basis of an invention or inventions referred to in any of the paragraphs of subsection (1), a patent shall not be granted for such an invention notwithstanding subsection (1).

Article 29-2

Where an invention claimed in a patent application is identical with an invention or device (excluding an invention or device made by the same person as the inventor of the invention claimed in the patent application) stated in the description, the scope of claims or drawings (in the case of the foreign language written application under Article 36-2(2), foreign language documents as provided in Article 36-2(1)) originally attached to the request of another patent application or application for a registration of a utility model which was filed earlier than the filing date and for which the patent gazette containing a matter provided by the provision of Article 66(3) (hereinafter referred to as "gazette containing the patent") was issued or laid open for public inspection, or a utility model gazette (hereinafter referred to as "gazette containing the utility model") containing a matter provided in Article 14(3) of the Utility Model Act (Act No. 123 of 1959) under the provision of the same was published after filing of the patent application, shall not be granted a patent notwithstanding Article 29(1). However, this provision shall not apply where, at the time of filing of the patent application, the applicant of the patent application and the applicant of the other application for a patent or the application for a utility model registration are the same person.

(Exceptions to Lack of Novelty of Invention)

Article 30(1)

In the case of an invention which has fallen under any of the items of Article 29 (1) against the will of the person having the right to obtain a patent, such invention

shall be deemed not to have fallen under any of the items of Article 29 (1) for the purpose of Article 29 (1) and (2) for the invention claimed in a patent application which has been filed by the said person within one year from the date on which the invention first fell under any of said items.

(2) In the case of an invention which has fallen under any of the items of Article 29 (1) as a result of an act of the person having the right to obtain a patent (excluding those which have fallen under any of the items of the preceding paragraph by being contained in gazette relating to an invention, utility model, design or trademark), the preceding paragraph shall also apply for the purposes of Article 29 (1) and (2) the invention claimed in the patent application which has been filed by the said person within one year from the date on which the invention first fell under any of those items.

(3) Any person seeking the application of the preceding paragraph shall submit to the Commissioner of the Patent Office, at the time of filing of the patent application, a document stating the same and, within thirty days from the filing date of the patent application, a document proving the fact that the invention which has otherwise fallen under any of the items of Article 29(1) is an invention to which the preceding paragraph may be applicable (referred to as "proving document" in the following paragraph).

(4) (Omitted)

(Unpatentable inventions)

Article 32

Notwithstanding Article 29, any invention that is liable to injure public order, morality or public health shall not be patented.

(Prior application)

Article 39(1)

Where two or more patent applications claiming identical inventions have been filed on different dates, only the applicant who filed the patent application on the earliest date shall be entitled to obtain a patent for the invention claimed.

(2) Where two or more patent applications claiming identical inventions have been filed on the same date, only one applicant, who has been selected by consultations between the applicants who filed said applications, shall be entitled to obtain a patent for the invention claimed. Where no agreement is reached by consultations or consultations are unable to be held, none of the applicants shall be entitled to obtain a patent for the invention claimed.

(3) Where an invention and a device claimed in applications for a patent and a utility model registration are identical and the applications for a patent and a utility model registration are filed on different dates, the applicant for a patent may obtain a patent for the invention claimed therein, only if the application for a patent is filed prior to the application for a utility model registration.

(4) Where an invention and a device claimed in applications for a patent and a utility model registration are identical (excluding the case where an invention claimed in a patent application based on a utility model registration under Article 46-2(1) (including a patent application that is deemed to have been filed at the time of filing of said patent application under Article 44(2) (including its *mutatis mutandis* application under Article 46(6)) and a device relating to said utility model registration are identical) and the applications for a patent and a utility model registration are filed on the same date, only one of the applicants, selected by consultations between the applicants, shall be entitled to obtain a patent or a utility model registration. Where no agreement is reached by consultations or no consultations are able to be held, the applicant for a patent shall not be entitled to obtain a patent for the invention claimed therein.

(5) Where an application for a patent or a utility model registration has been waived, withdrawn or dismissed, or where the examiner's decision or trial decision to the effect that a patent application is to be refused has become final and binding, the application for a patent or a utility model registration shall, for the purpose of paragraphs (1) to (4), be deemed never to have been filed; provided, however, that this shall not apply to the case where the examiner's decision or trial decision to the effect that the patent application is to be refused has become final and binding on the basis that the latter sentence of paragraph (2) or (4) is applicable to said patent application.

(6) The Commissioner of the Patent Office shall, in the case of paragraph (2) or (4), order the applicant to hold consultations as specified under paragraph (2) or (4) and to report the result thereof, while designating an adequate time limit.

(7) Where no report under the preceding paragraph is submitted within the time limited designated under said paragraph, the Commissioner of the Patent Office may deem that no agreement under paragraph (2) or (4) has been reached.

Article 41

(omitted)

(2) With regard to application of the provision of ... the main clause of Article 29-2 ... of the Patent Act to, among the inventions claimed in the patent application with the priority claim provided by the provision of Article 41(1) of the Patent Act, the invention (excluding an invention stated in a document (limited to one equivalent to the description, the scope of claims or the scope of application for a registration of a utility model, or the drawings) used at the time of filing of the application on which the priority claim of an earlier application was based when the earlier application was one claiming priority under the provision of Article 41(2) of the Patent Act or Article 8(1) of the Utility Model Act or priority under the provision Article 43(1) or Article 43-2(1) or (2) of the Patent Act (including the case where Article 11(1) of the Utility Model Act shall apply *mutatis mutandis*)) stated in the description, scope of claims or the scope of application for a registration of a utility model, or the drawings originally

attached to the request of the earlier application on which the priority claim is based (a document written in foreign language when the earlier application is a foreign application), the patent application is deemed to be filed at the time of the earlier application.

(3) Among the inventions stated in the description, scope of claims, or drawings originally attached to the request of a patent application claiming priority under Article 41(1) of the Patent Act (a document written in foreign language in the case of a foreign application), an invention (excluding an invention stated in a document (limited to one equivalent to the description, scope of claims or the scope of application for a registration of a utility model, or drawings) used at the time of filing of an application on which an earlier application claimed priority is based, when the earlier application is one claiming priority under Article 41(1) of the Patent Act or Article 8(1) of the Utility Model Act or priority under Article 43(1) or Article 43-2(1) or (2) of the Patent Act (including a case where Article 11(1) of the Utility Model Act shall apply *mutatis mutandis*)) stated in the description, the scope of claims or the scope of application for a registration of a utility model, or the drawings originally attached to the request of the earlier application on which the priority claim is based (a document written in foreign language when the earlier application is a foreign application) shall be subject to application of the provision of the main clause of Article 29-2 of the Patent Act or the main clause of Article 3-2 of the Utility Model Act while the earlier application is deemed to be laid open or a utility model registration for the earlier application is deemed to be published when the patent application was laid open or the gazette containing the patent was published for the patent application.

(4) (omitted)

(Division of Patent Applications)

Article 44

(omitted)

(2) In the case referred to in the preceding paragraph, the new patent application shall be deemed to have been filed at the time of filing of the original application. However, where the new patent application is either another patent application as referred to in Article 29-2 of the Patent Act or a patent application as referred to in Article 3-2 of the Utility Model Act, this provision and the provision of Article 30(3), 41(4) and 43(1) of the Patent Act (including the case where Article 44(3) of the Patent Act shall apply *mutatis mutandis*) shall not apply.

(3) to (6) (omitted)

(Special Provision for Patentability Requirements)

Article 184-13

With regard to application of the provision of Article 29-2 of the Patent Act performed when another patent application provided in Article 29-2 or an application

for a utility model registration is an international patent application or an international application for a utility model registration under Article 48-3(2) of the Utility Model Act, "another patent application or an application for a utility model registration" referred to in Article 29-2 shall read "another patent application or an application for a utility model registration (excluding a foreign patent application referred to in Article 184-4(1) of the Patent Act regarded to have been withdrawn under the provision of Article 184-4(3) of the Patent Act or Article 48-4(3) of the Utility Model Act, or a foreign application for a utility model registration referred to in Article 48-4(1) of the Utility Model Act)"; "laid-open or" shall read "laid-open"; "issued" shall read "issuance or the international publication referred to in Article 21 of the Patent Corporation Treaty ratified at Washington DC on June 19, 1970"; and "the description, the scope of claims or the request for a utility model registration, or drawings originally attached to the request" shall read "the description, the scope of claims, or the drawings of the international application on the international filing date referred to in Article 184-4(1) of the Patent Act or Article 48-4(1) of the Utility Model Act."

Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS agreement)

Article 27 Patentable Subject Matter

(1) (Omitted)

(2) Members may exclude from patentability inventions, for which it is necessary to prevent commercial exploitation within their territory in order to protect public order or morality, including to protect human, animal or plant life or health or to avoid serious prejudice to the environment, provided that such exclusion is not made merely because the exploitation is prohibited by their law.

(3) (Omitted)

Paris Convention for the Protection of Industrial Property

Article 4quater

Patents: Patentability in Case of Restrictions of Sale by Law

The grant of a patent shall not be refused and a patent shall not be invalidated on the ground that the sale of the patented product or of a product obtained by means of a patented process is subject to restrictions or limitations resulting from the domestic law.