

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

Chapter 1 Priority under the Paris Convention

1. Overview

The priority under the Paris Convention is a right of a person who has filed a patent application in a country of the Union of the Paris Convention (the first country). Such a person may enjoy a benefit for his/her patent application in another country of the Union (the second country), for the purpose of determination of novelty, inventive step, etc., to be treated as filed on the filing date of the application in the first country (hereinafter referred to as "priority date"), as far as the contents were described in the application documents of the application in the first country.

On a person who would like to file patent applications etc. in multiple countries for the same invention, simultaneous filing of patent applications etc. would place a great burden because he/she needs to prepare translation etc. and/or follow different procedures for each country. To reduce such a burden, the Paris Convention provides a system of the priority (Paris Convention Article 4A to D).

The Patent Act Article 43 prescribes the procedures in Japan for claiming the priority under the Paris Convention.

In this Chapter, an application filed in Japan as the second country may be referred to just as an "application filed in Japan."

2. Requirements and Effects of Priority Claim under the Paris Convention

2.1 Person entitled to claim the priority under the Paris Convention

A person who claims the priority under the Paris Convention shall be the national of a country of the Union of the Paris Convention (including a person who is treated as the national of a country of the Union under the Paris Convention Article 3) who has regularly filed a patent application in a country of the Union, or his/her successor (Paris Convention Article 4A(1)).

A person who has assigned his/her right to obtain a patent to others and has not filed a patent application in the first country by himself/herself may file a regular patent application in the second country, but he/she may not claim the priority under Paris Convention based on a patent application filed by the assignee.

2.2 Priority period

The period for filing an application filed in Japan with a claim of the priority under the Paris Convention (the priority period) shall be 12 months from the priority date (Paris Convention Article 4C(1) and (2)).

2.3 Application entitled to serve as a basis for priority claim under the Paris Convention

2.3.1 Regular national application

The application that serves as a basis for the priority claim under the Paris Convention shall be a regular national application filed in a country of the Union of the Paris Convention (Paris Convention Article 4A(1) and (3)).

2.3.2 First application

The application that serves as a basis for the priority claim under the Paris Convention shall be the first application in a country of the Union of the Paris Convention (Paris Convention Articles 4C(2) and(4)). This is because the priority period would be substantively extended if the right of priority were recognized again based on subsequent applications (i.e., cumulatively) for the invention disclosed in the first application.

2.4 Effects of priority claim under the Paris Convention

Any subsequent application shall not be invalidated by reason of any acts accomplished in the period from the priority date to the date of filing in Japan, in particular, (1) another filing, (ii) the publication or exploitation of the invention, or (iii) other acts. Moreover, such acts cannot give rise to any third-party right (Paris Convention Article 4B).

Since the priority under the Paris Convention has such effects, when the effect is recognized, the priority date shall be treated as the date based on which the following requirements (i) to (v) will be determined (hereinafter, that date is referred to as the "relevant date" in this Chapter).

- (i) Novelty (Article 29(1))
- (ii) Inventive step (Article 29(2))
- (iii) Secret Prior Art (Main clause of Article 29bis)
- (iv) Prior application (Articles 39(1) to (4))

- (v) Requirements for independent patentability concerning (i) to (iv) above (Article 126(7) applied as mutatis mutandis under Article 17bis(6))

However, determination of other requirements (for example, Articles 32 and 36) on the patent application claiming priority under the Paris Convention shall be made based on the filing date of the patent application concerned.

In a case of determination of the requirement under Article 29bis (secret prior art) with the patent application claiming priority under the Paris Convention as "another application" prescribed in the article, see "Part III Chapter 3 Secret Prior Art" 6.1.2".

3. Determination of Effect of Priority Claim under the Paris Convention

3.1 Basic idea

3.1.1 Need of determination of the effect of the priority claim under the Paris Convention

The examiner needs to determine whether or not the effect of the priority claim is recognized only when he/she finds prior art and the like which would be a basis of a reason for refusal and has been made available to the public on or after the priority date claimed and before the filing date of the application filed in Japan. Only in such a case, determination of novelty, inventive step, and the like may be changed according to whether the effect of the priority claim under the Paris Convention is recognized.

The examiner may make a determination in advance of the prior art search in cases when determination of the effect of the priority claim under the Paris Convention can be made easily. Determination in advance of the prior art search sometimes contributes to effective examination as it may restrict the target time range of the prior art search.

3.1.2 Subject to be determined

The examiner determines the effect of the priority claim under the Paris Convention on a claim-by-claim basis, in principle. When the claimed elements are expressed by alternatives in a claim, the examiner determines the effect for each invention identified from each alternative. Furthermore, when an embodiment of the claimed invention is newly added in relation to the application in the first country, the effect is determined based on each part, i.e., the added part and the others, respectively.

3.1.3 Comparison with the matter stated in the application documents as a whole of the application filed in the first country

(1) Basic ideas of the comparison

Assume that the description, claims and drawings of the application filed in Japan are amendments of the application filed in the first country (Note). If the claimed invention of the application filed in Japan introduces any new technical matter in relation to the "matters stated in the application documents as a whole of the application filed in the first country," the effect of the priority claim of the Paris Convention shall not be recognized.

Here, the "matters stated in the application document as a whole of the application filed in the first country" mean technical matters that a person skilled in the art understands from the whole description in the application documents of the application filed in the first country, and hereinafter may be referred to as the "matters stated in the application filed in the first country."

(Note) The examiner should note that the application filed in the first country shall be the "first application" (see 2.3.2). See the 3.3, 5.4.1, and 5.4.2 for examples in which whether an application concerned is the "first application" is an issue.

(2) Typical cases where the claimed invention in the application filed in Japan is not considered to be within the scope of the matters stated in the application filed in the first country

a Recitation of matters not stated in the application filed in the first country

When a claimed invention in an application filed in Japan adds any new matter in relation to the matters stated in the application filed in the first country due to recitation of elements which were not stated in the application filed in the first country, the effect of the priority claim under the Paris Convention shall not be recognized. The following cases correspond thereto.

- (i) A case where the structural element stated in the application filed in the first country are combined with a structural element which is newly added to be the claimed invention
- (ii) A case where a selection invention is claimed in the application filed in Japan,

wherein the invention selects a more specific element from an invention of generic concept stated in application filed in the first country

b Addition of an embodiment, deletion of a part of claimed elements, or the like

When the claimed invention in the application filed in Japan is regarded as addition of any new part due to statement of matters which were not stated in the application filed in the first country, e.g., addition of new embodiments etc., or due to deletion of matters stated in the application filed in the first country, e.g., partial deletion of the claimed elements etc., the effect of priority claim under the Paris Convention shall not be recognized for the part concerned.

Concerning these cases, the examiner should note the following points.

(i) When a part of the claimed invention in the application filed in Japan is recognized to be within the scope of the matters stated in the application filed in the first country, the effect of the priority claim under the Paris Convention can be recognized for the part concerned (see 3.2.1).

(ii) Even though the effect of the priority claim under the Paris Convention is not partially recognized because of the addition of new embodiments, if, due to the deletion of the embodiments by an amendment, the claimed invention in the application filed in Japan falls within the scope of the matters stated in the application filed in the first country, the effect of the priority claim under the Paris Convention will be recognized.

Example: a case where a part that goes beyond the scope of the matters stated in the application filed in the first country is added, by adding a new embodiment, to the claimed invention in the application filed in Japan, but the claimed invention could be carried out based on the whole description of the application documents of the application filed in the first country without any embodiment

[Application filed in the first country] The claimed invention is a light scanning system comprising mirror angle adjusting means, and only the light scanning system wherein the mirror angle is adjusted by a screw is stated as an embodiment.

[Application filed in Japan] Although the expression of the claimed invention is the same as that in the first application, an embodiment of a light scanning system that automatically adjusts the mirror with a piezoelectric element is newly added.

(Determination of the effect of the priority claim) For the claimed invention in the application filed in Japan, the effect of the priority claim for the part corresponding to the light scanning system that automatically adjusts the mirror with a piezoelectric element is not recognized, but the effect of the priority claim are recognized for the matters within the scope of the matters stated in the application filed in the first country.

(Explanation) In case of this example, the embodiment of automatically adjusting the mirror with a piezoelectric element is not stated in the application filed in the first country. Because of addition of such an embodiment, the claimed invention in the application filed in Japan contains a newly added matter in relation to the matter stated in the application filed in the first country. Therefore, the effect of the priority claim is not recognized for the part added.

c Invention which could not be carried out as of the priority date claimed

When an invention could not be carried out by a person skilled in the art based on the whole description of the application documents of the application filed in the first country and it has become possible for the invention, which is claimed in the application filed in Japan, to be carried out by such a person due to addition of an embodiment or deposition of a biological material and the like, the application filed in Japan contains a newly added matter in relation to the matters stated in the application filed in the first country. Therefore, the effect of the priority claim under the Paris Convention is not recognized in such a case. When the changes in the common general knowledge have made it possible for a person skilled in the art to carry out the invention claimed in the application filed in Japan, the same is applied thereto.

3.2 Partial priority and multiple priorities

An application filed in Japan sometimes contains one or more elements that were not included in the application filed in the first country. The Paris Convention recognizes the claim of priority for the elements included in the application filed in the first country in this case (Paris Convention Article 4F; So-called "partial priority").

In addition, the priority under the Paris Convention can be claimed based on multiple applications filed in the first countries respectively to file an application (Paris Convention Article 4F; So-called "multiple priorities"). The multiple applications filed in the first countries include not only a case where all of them are filed in the same

country, but also a case where they originate from different countries.

In these cases, the effects of the priority claims under the Paris Convention are determined according to 3.2.1 and 3.2.2.

3.2.1 Partial priority

The examiner determines that, only for a part of claimed inventions or a part of alternatives in a claimed invention in the application filed in Japan, which is stated in the application filed in the first country, the priority under the Paris Convention claimed based on the application filed in the first country is recognized.

Example: a case where only a part of alternatives among the claimed invention in the application filed in Japan is stated in the application documents as a whole of the application filed in the first country

[Application filed in the first country] What is claimed is an invention wherein the carbon number of an alcohol is 1 to 5, and only an embodiment wherein the carbon number of the alcohol is 1 to 5 is stated in the application documents as a whole.

[Application filed in Japan] An invention claimed is one wherein the carbon number of the alcohol is 1 to 10.

(Determination of the effect of the priority claim) Since a part of the claimed invention in the application filed in Japan, wherein the carbon number of the alcohol is 1 to 5, is stated in the application filed in the first country, the effect of priority claim is recognized for the part concerned. On the other hand, since the other part of the invention, wherein the carbon number of the alcohol is 6 to 10, corresponds to the addition of new matter in relation to the matters stated in the application filed in the first country, the effect of priority claim is not recognized for that part.

3.2.2 Multiple priorities

(1) Cases when a part of claimed inventions or a part of alternatives in a claimed invention in the application filed in Japan is stated in one of the applications filed in the first countries, and another part of the claimed inventions or another part of alternatives in the claimed invention in the application filed in Japan is stated in another application filed in the first countries

In this case, the examiner determines whether or not the effect of the priority under the Paris Convention claimed is recognized based on the corresponding application filed in the first country on a claim-by-claim basis or an alternative-by-alternative basis.

Example: a case where the matters stated in the multiple applications filed in the first countries are recited in combination in a claim in the application filed in Japan

[Applications filed in the first countries] An invention, wherein the carbon number of an alcohol is 1 to 5, is stated in an application A filed in a first country. Also, another invention, wherein the carbon number of the alcohol is 6 to 10, is stated in another application B filed in a first country.

[Application filed in Japan] With priority claims based on the both applications A and B, an invention, wherein the carbon number of the alcohol is 1 to 10, (substantial alternative) (Note) is claimed.

(Determination of the effect of the priority claim) Since the claimed invention in the application filed in Japan has substantial alternatives, determination is made for each alternative. For a part of the invention, wherein the carbon number of alcohol is 1 to 5, the effect of the priority claim based on the application A is recognized. For the other part, wherein the carbon number of alcohol is 6 to 10, the effect based on the application B is recognized.

(Note: see “Part III, Chapter 2, Section 3 Procedure of Determining Novelty and Inventive Step,” 4.1.1 (Note 1).)

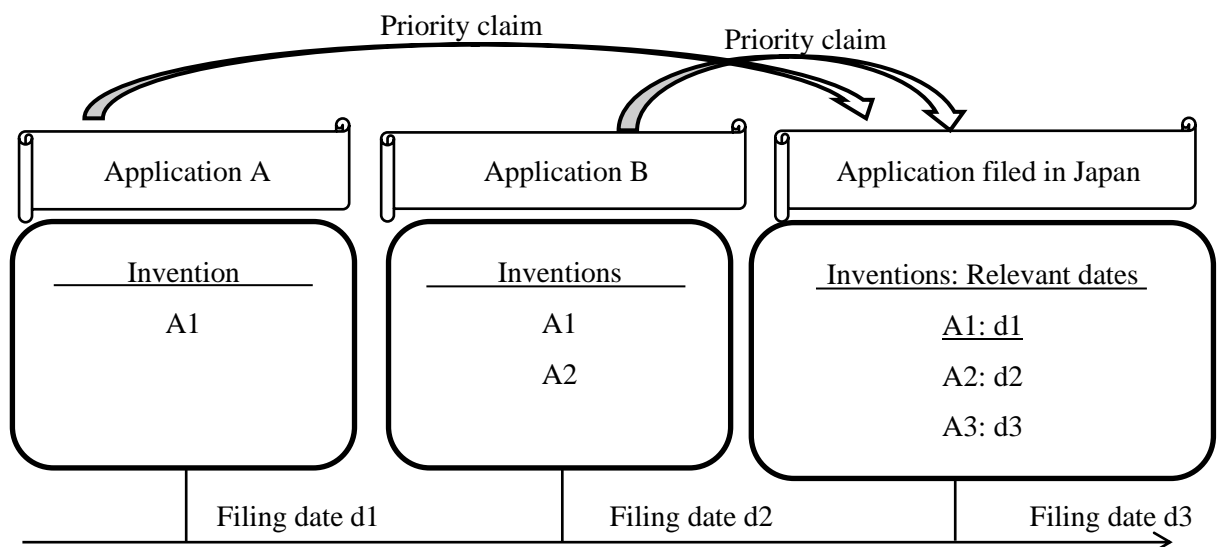


Figure 1 Relevant dates in a case where multiple priorities are claimed

- (2) Cases where the application filed in Japan claims the priorities under the Paris Convention based on two or more applications filed in first countries (multiple priorities), and claimed elements in the application filed in Japan are commonly stated in multiple applications based on which priorities are claimed

In this case, the examiner treats the filing date of the earliest application, in which the claimed elements are stated, as the relevant date (See 3.3 in a case where no priority under the Paris Convention is claimed based on the first application).

- (3) Cases where the claimed invention in the application filed in Japan, which claims the priority under the Paris Convention based on two or more applications filed in first countries, is a combination of the matters stated in the application documents as a whole of multiple applications based on which priorities are claimed, and the combination is not stated in either of the application documents as a whole of those applications

In this case, the effect of the priority claims based on either of the applications is not recognized.

Example: a case where the claimed invention in the application filed in Japan is not stated in either of the applications based on which priorities are claimed

[Application filed in the first countries] A "greenhouse comprising a temperature sensor and a shading curtain opening/shutting system that opens/shuts the shading curtain in response to signals from the temperature sensor" is stated in the application documents as a whole of an application A, and a "greenhouse comprising a humidity sensor and a ventilating window opening/shutting system that opens/shuts the ventilating window in response to signals from the humidity sensor" is stated in the application documents as a whole of another application B.

[Application filed in Japan] The claimed invention in the application filed in Japan, which claims priorities based on both of the applications A and B, is a "greenhouse comprising a temperature sensor and a ventilating window opening/shutting system that opens/shuts the ventilating window in response to signals from the temperature sensor".

(Determination of the effect of the priority claim) Since the greenhouse comprising a temperature sensor and a ventilating window opening/shutting system that opens/shuts the ventilating window in response to signals from the temperature

sensor is not stated in either of the application documents as a whole of the application A or B, it corresponds to a new matter. Accordingly, the effect of priority claim based on either of the applications is not recognized.

3.3 Cases where an application based on that the priority under the Paris Convention is claimed has a priority claim

Where an application based on that the priority under the Paris Convention is claimed (the second application) claims the priority based on another application filed prior to that application (the first application), for the parts which have already been stated in the application documents as a whole of the first application among the matters stated in the whole application documents of the second application, the effect of the priority claim is not recognized. This is because the second application is not "the first application" prescribed by Paris Convention Article 4C(2) for the parts stated in the application documents as a whole of the first application among the matters stated in the second application. Therefore, where the priority is claimed based only on the second application, the effect of the priority claim under the Paris Convention is recognized only for the parts which are not stated in the application documents as a whole of the first application among the matter stated in the whole application documents of the second application. See 3.2.2(2) for a case where the priority under the Paris Convention based on the first application is also claimed.

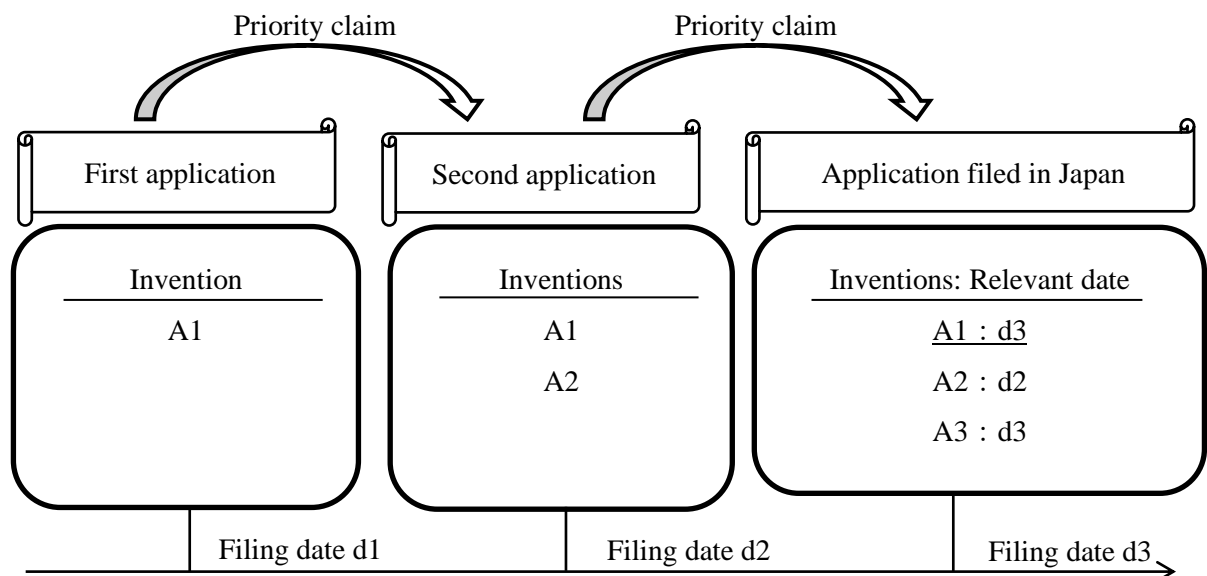


Figure 2 Relevant dates in a case where the priorities are claimed cumulatively

4. Examination Procedure for Determination of the Effect of Priority Claim under the

Paris Convention

When a reason for refusal is raised because of no recognition of the effect of the priority claim under the Paris Convention, the examiner specifies the claimed invention concerned, makes it clear that the priority claim is not effective and explains reason therefor in a notice of reasons for refusal. When a reason for refusal is raised because of no recognition of the effect of the priority claim under the Paris Convention for a part of a claim, the examiner also specifies the part concerned.

Where a written opinion is submitted or an amendment of the description, claims or drawings is made in response to the notice of reasons for refusal, the examiner re-determines whether or not the effect of the priority claim under the Paris Convention is recognized.

5. Various Kinds of Applications and the Like

5.1 Division or conversion of the application claiming the priority under the Paris Convention

For a divisional application of the original application filed in Japan claiming priority under the Paris Convention, the priority claimed in the original application is deemed to be claimed (Paris Convention Article 4G). The statements or documents certifying the priority submitted with respect to the original application (including statements or documents provided by electronic or magnetic means, e.g., communication or transfer of information recorded on a recording medium) are deemed to have been submitted simultaneously to the Commissioner of the Patent Office with the divisional patent application (Patent Act Article 44(4)). This shall apply *mutatis mutandis* to the converted application (Patent Act Article 46(5)).

5.2 Priority claims recognized under the Paris Convention prescribed in Patent Act Article 43ter

Any following priorities (i) to (iv) may be claimed as the priorities recognized under the Paris Convention:

- (i) the priority based on the application made by Japanese nationals or nationals of a country of the Union of the Paris Convention (including nationals deemed to be the nationals of the country of the Union in accordance with Paris Convention Article 3) in one of the Member of the World Trade Organization (WTO) (Patent Act

Article 43ter(1));

(ii) the priority based on the application made by the nationals of a Member of the WTO in one of the countries of the Union of the Paris Convention or a Member of the WTO (Patent Act Article 43ter(1));

(iii) the priority based on an application filed in a country that is neither a country of the Union of the Paris Convention nor a Member of the WTO, allows Japanese nationals to declare a priority under the same conditions as in Japan, and is designated by the Commissioner of the Japan Patent Office (hereinafter, such a country is referred to as a "specified country" in this Chapter) made by a national of the country (Patent Act Article 43ter(2)); or

(iv) the priority based on the application filed in a specified country by a Japanese national, a national of the country of the Union of the Paris Convention or a national of a Member of the WTO (Patent Act Article 43ter(2)).

These applications claiming the priority shall be treated, as well as the cases of the applications in Japan claiming the priority under the Paris Convention, in accordance with the 3. and 4.

5.3 International application under the Patent Cooperation Treaty and priority

Where Japan is specified as a designated States by an international application claiming the priority based on a national application in Japan (so-called "self-designation"), the internal priority (the priority based on an application filed in Japan) can be claimed for the Japanese national phase (Patent Cooperation Treaty (PCT) Article 8(2)(b)). On the other hand, where an international application claiming the priority based on an earlier international application containing the designation of Japan and other PCT Contracting States, and containing the designation of Japan, the priority under the Paris Convention can be claimed for the Japanese national phase (PCT Article 8(2)(a)).

Earlier application as a basis of the priority claim	Later application claiming the priority	Priority that can be claimed
National application	International application designating Japan (Self-designation)	Internal priority
International application designating Japan and other Contracting States	National application	Internal priority or Priority under the Paris Convention (Selection by the applicant)
	International application designating Japan	Priority under the Paris Convention

(For details, see the attached table)

5.4 Priority claim under the Paris Convention based on various kinds of applications

5.4.1 Divisional application or converted application filed in the first country

Where an application filed in Japan claims the priority under the Paris Convention based on a divisional or converted application filed in the first country, the divisional or converted application is not the "first application" for matters stated in the application documents as a whole of the original application, among the matters stated in the application documents as a whole of the divisional or converted application. Where the priority is claimed based on both a divisional or converted application and its original application under the Paris Convention, the examiner determines the effect thereof according to item 3.2.2(2).

5.4.2 Continuation-in-part application in the US

Where the application filed in Japan claims the priority under the Paris Convention based on a continuation-in-part (CIP) application in the US, the continuation-in-part application is not the "first application" for the matters stated in the application documents as a whole of the original application among the matters stated in the application documents as a whole of the CIP application. Where the priority under the Paris Convention is claimed based on both of a continuation-in-part application and its original application, the examiner determines the effect thereof according to item 3.2.2(2).

5.4.3 Provisional application

A provisional application or a provisional specification under applicable systems in the US, UK, or Australia can serve as a basis of the priority claim under the Paris Convention because it is considered to be a regular national application (Paris Convention Articles 4A(2) and (3)) in the country concerned.