

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

Chapter 4 Article 39 of the Patent Act

Patent Act 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 was selected by consultations between the applicants who filed the 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 46bis(1) (including a patent application that is deemed to have been filed at the time of filing of the said patent application under Article 44(2) (including its mutatis mutandis application under Article 46(6)) and a device relating to the 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(5) Where an application for a patent or a utility model registration has been waived, withdrawn or dismissed, or where the examiner's decision or trial decision to the effect that a patent application is to be refused has become final and binding, the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 the 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, designating an adequate time limit.

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

(note) The above Article applies to applications filed on or after April 1, 2012. See page 16(reference) for the history of amendments to Article 39.

1. Purpose of the provision of Article 39

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English translation was updated in 4.2015

A patent system grants an exclusive right to a patentee for a predetermined period in compensation for disclosure of an invention that is a creation of technical ideas. Therefore, two or more rights shall not be granted to one invention. Article 39 intends to exclude such overlapped patents and thus explicitly provides a rule of one patent granted to one invention and explicitly provides that where a plurality of applications were filed for one invention, only the earliest applicant may obtain a patent.

2. Each item of Article 39

2.1 Article 39(1)

2.1.1 The subject of determination of Article 39

(1) Inventions of the subject of determination whether inventions are the same or not pursuant to Article 39 are “the claimed invention.”

Pursuant to Article 2, an invention is defined as a highly advanced creation of technical ideas utilizing the laws of nature. Thus, whether inventions are the same or not is determined by determining identicalness of the technical ideas. Even if embodiments partly overlap, inventions whose technical ideas are different are not determined to be identical inventions. (Reference: Decision by the Tokyo High Court, December 11, 1956 [Showa 30 (Gyo Na) 39], Decision by the Supreme Court, First Petty Bench, July 10, 1975 [Showa 42 (Gyo Tsu) 29])

(2) When there are two or more claims in the scope of claims, the requirements of Article 39 are determined for each claim.

2.1.2 Patent Applications filed on different dates, Earlier Patent Application

Whether applications were filed on different dates or on the same date and whether one of them is the earliest application are determined as follows.

(1) An application without a claim for priority is determined based on the filing date^(Note).

(Note) If it is an international application, the filing date shall be replaced with an international filing date.

(2) For an application claiming a priority under the Paris Convention, an invention stated in the complete filing documents of an application (description, the scope of claims, and drawings) as a basis for a priority claim shall be determined based on the first filing date in a country of the Union. (When a plurality of priorities is claimed, the filing date of an application in which a claimed invention that is the subject of determination is stated among applications as a basis for priority claims.)

(3) An invention stated in the description, the scope of claims, or drawings originally attached to an application form of an earlier application as a basis for a domestic priority in an application claiming a domestic priority is determined based on the filing date of an earlier application. (When a plurality of priorities is claimed, the filing date of an application in which a claimed invention that is the subject of determination is stated among applications as a basis for priority claims.)

2.2 Article 39(2)

2.2.1 One applicant determined through consultation of applicants

When two or more patent applications for the same invention have been filed on the same date, consultation shall be ordered to an applicant of each application in the name of the Commissioner of the Patent Office.

When applicants are the same, consultation shall be ordered according to a case of different applicants.

In this case, see 2.7.1 as for details of consultation.

2.2.2 When consultation is not established or consultation cannot be held

When two or more patent applications for the same invention were filed on the same date and the consultation is not established or cannot be held, none of the applicants can obtain a patent for the invention.

“The consultation cannot be held” refers to a case where consultation cannot be held because, for example, the other party does not accept the consultation or any of the applications has already been patented.

Where any of the applications has already been patented and because of this consultation cannot be held, the consultation cannot be ordered and notice will be issued of reasons for refusal based on Article 39(2) for other applications.

(note) For applications filed on or before December 31, 1998, when any of the applications has already been abandoned or a decision or trial decision of rejection of any of the applications has become final and binding, this also falls under a case where the consultation cannot be held.

In addition, as for handling of a case where any of the applications have been patented, and a patent applicant is not a patentee, see 2.7.1.

2.3 Article 39(3)

2.3.1 An invention according to a patent application and a device according to a utility model application are the same

As a device is a creation of technical ideas utilizing the laws of nature, much like an invention, whether an invention according to a patent application and a device according to a utility model application are the same or not is determined similarly to determining whether inventions are identical to each other or not.

2.4 Article 39(4)

2.4.1 If consultation is not established or cannot be held

When an invention according to a patent application and a device according to a utility model application are the same (excluding cases where an invention according to a patent application based on utility model registration and a device according to the utility model registration are the same) and the patent application and the utility model application were filed on

the same date and consultation is not established or consultation cannot be held, a patent applicant cannot obtain a patent for the invention.

“The consultation cannot be held” refers to cases where consultation cannot be held because the other party does not accept the consultation, etc. or cases where a utility model application has already been registered as a utility model.

When a utility model application has already been registered as a utility model, and thus consultation cannot be held, the consultation is not ordered and a notice of reasons for refusal under Article 39(4) shall be rendered against the utility model application.

(note) For applications filed on or before December 31, 1998, when any of the applications has already been abandoned, this also falls under a case where the consultation cannot be held.

In addition, as for handling of cases where a utility model application has been registered as a utility model, and a patent applicant and a utility model right holder becomes different, see 2.7.1.

2.5 Article 39(5)

2.5.1 Where a patent application or a utility model application is abandoned, withdrawn or dismissed or a decision or a trial decision of refusal of the patent application has become final and binding

Where a patent application or a utility model application is abandoned, withdrawn or dismissed or a decision or a trial decision of refusal of the patent application has become final and binding, the patent application or the utility model application shall be deemed not to have been filed from the beginning for the purpose of applicability of Article 39(1) to (4). However, this shall not apply when a decision or trial decision of refusal of the patent application has become final and binding because the patent application falls under the latter part of paragraph 2 or the latter part of paragraph 4 of Article 39.

(note) For applications filed on or before December 31, 1998, where a patent application or a utility model application is withdrawn or dismissed, the patent application or the utility model application shall be deemed not to have been filed from the beginning for the purpose of applicability of Article 39(1) to (4).

With regard to applications for which a decision of refusal has become final and binding and applications that have been abandoned, Article 39(1) to (4) applies, except when the application falls under Article 39(6).

2.6 Article 39(6) (prior to the revision by the Act of 2011) (which only applies to applications filed on or before March 31, 2012)

2.6.1 A person who is not an inventor or a designer and has not succeeded a right to obtain a patent or a right to obtain a utility model registration

A so-called usurped patent application or utility model application shall be deemed not to be a patent application or a utility model application for the purpose of applicability of Article 39(1) to (4).

2.7 Article 39(6) (which applies to applications filed on or after April 1, 2012. For applications filed

on or before March 31, 2012, these provisions apply mutatis mutandis by replacing “Article 39(6)” with “Article 39(7)” and replacing “Article 39(7)” with “Article 39(8).”

2.7.1 Consultation

(1) When each application is pending before the JPO

i) When applicants are different

(i) When a request for substantive examination of each application is made

Each applicant is ordered in the name of the commissioner to hold a consultation.

(a) When a result of consultation has been reported within a designated period, and when there are no other reasons for refusal, the patent will be granted for the application that was filed by the applicant determined through the consultation. When other applications are not withdrawn or abandoned, a notice of reasons for refusal pursuant to Article 39(2) or (4) shall be rendered against the application.

(b) When a result of consultation has not been reported within a designated period, the consultation shall be deemed not have been established (Article 39(7)), and a notice of reasons for refusal pursuant to Article 39(2) or (4) shall be rendered to each applicant.

(ii) When a request for substantive examination of a part of applications is made

As the consultation cannot be ordered, an applicant of an application for which substantive examination is requested is noticed that substantive examination for other applications are not requested, and thus examination for the application cannot be forwarded.

After the notice, examination for the application is not forwarded until a request for substantive examination for the application is made and consultation can be ordered or other applications are withdrawn (including expiration of the period for substantive examination) or abandoned.

ii) When applicants are the same person

When applicants are the same person, Article 39(2) or (4) is applied in accordance with cases where applicants are different, and handling as described in i)(i)(ii) is applied.

However, if handling as described in i)(i) is applied, the consultation is ordered in the name of the Commissioner of the Patent Office and a notice of reasons for refusal is rendered at the same time.

(Explanation)

The provision of Article 39(2) intends to establish one right on one invention and is thus applied to cases where applicants are the same person.

Moreover, when applicants are the same person, time for consultation is not necessary and handling as described above is applied.

(2) When one application is patented or registered as a utility model

When one application is patented or registered as a utility model, only if the patent applicant and patentee or utility model right holder are different, the patentee or the utility model right holder is notified when a notice of reasons for refusal pursuant to Article 39(2) or (4) is given to the patent applicant.

In addition, when the patent applicant and the patentee or the utility model right holder are the same person, a reason for refusal can be appropriately responded to upon notification, and thus handling as described above is not applied.

(Explanation)

When one application is patented or registered as a utility model registration, consultation

cannot be held (see 2.2.2 and 2.4.1). Holding substantial consultation between a patent applicant and a patentee or a utility model right holder is considered to be useful for avoiding a reason for refusal or a reason for invalidation and obtaining appropriate protection. Therefore, handling as described above is applied.

Hereinafter, cases where an earlier application or other application filed on the same date is a patent application will be explained, but this shall also apply to cases where an earlier application or other application filed on the same date is a utility model application.

3. Method of determining whether the claimed inventions are identical or not

3.1 Finding of a claimed invention

A way of determining the claimed invention is common to “Chapter 2, 1.5 Method of Determining Novelty.”

3.2 Comparison of the claimed inventions

A claimed invention of a certain application and a claimed invention of another application are compared basically by finding the similarities and differences of matters specifying both inventions.

3.3 Way of determining whether the claimed inventions are identical or not when filing dates are different

(1) When the matters used to specify the invention according to a claim of a later application (hereinafter referred to as “a later application invention”) and the matters used to specify the invention according to a claim of an earlier application (hereinafter referred to as “an earlier application invention”) are not different, both are identical.

(2) Even if both are different in matters used to specify the inventions, they are found to be identical (substantially the same) when they fall under the following i) to iii).

i) When the matter defining the later application invention falls under addition/removal/ conversion, etc. of well-known art and commonly used art^(Note 1) to/from/into the earlier application invention, which does not produce any new effect

ii) When a difference is found because the later application invention expresses the matter defining the earlier application invention that has a more specific concept as a generic concept^(Note 2)

iii) When the later application invention and the earlier application invention are different merely in expression of a category

(Note 1) “The well-known art” refers to the art generally known in the technical field. For example, the art is so well-known that there are quite a lot of publicly known documents on this, or this is widely known in the industrial field, or necessity of exemplifying this is eliminated. “The commonly used art” refers to well-known art and frequently used art.

(Note 2) “The generic concept” refers to a combined concept of collecting tribal or allied matters or a combined concept of a plurality of matters based on certain common nature.

(3) When matters used to specify an invention of an earlier application invention or a later application invention have two or more alternatives

i) When a claim of an earlier application invention has a formal or substantial alternative for matters used to specify an invention^(Note 1), any differences in matters for defining the invention are determined if an invention when assuming that any one of said alternatives is the matter for defining the invention is compared to the later application invention, and even if there is any difference, they are determined to be the same if they are substantially the same (the above-described (1) (2)).

However, it is required that the invention when assuming this is understood from a claim by a person skilled in the art based on the description and drawings of the earlier application as well as common general knowledge at the filing date. Therefore, it is necessary to study whether some of the alternatives may be understood by a person skilled in the art in case of the Markush-type claim.

ii) When a claim of the later application invention has a formal or substantial alternative for matters for defining the invention, if an invention when assuming that any one of said alternatives is the matter for defining the invention is compared to the earlier application invention^(Note 2), it is determined whether they are different or not. But even if a difference is found, they are determined to be the same if they are substantially the same.

In addition, this handling does not relate to cases in which the prior art search can be terminated. See “Part IX How to proceed with the examination,” etc. for this point.

(Note 1) As for “a formal or substantial alternative,” see Chapter 2, 1.5.5(Note 1).

(Note 2) When a claim of the earlier application invention has an alternative for a formal or substantial alternative for the matter for defining the invention, only one of said alternatives is assumed to be the matter for defining the invention, and the earlier application invention is identified.

(Remarks)

In the above-described (1) to (3), the invention according to the claim of the earlier application is not stated so that a person skilled in the art may evidently produce the product (in the case of a product invention) based on the description or drawings of the earlier application as well as the common general knowledge at the filing date of the earlier application, and he/she may use the method in the case of a method invention, the invention cannot be found as “the earlier application invention.”

Therefore, for example, when the chemical substance is represented by the chemical substance name or the chemical structure formula as part of alternatives in the Markush-type claim of the earlier application, and the claim is not stated such that a person skilled in the art may produce said chemical substance, considering the common general knowledge at the filing date of the earlier application, and said chemical substance is not “the earlier application invention.” (In addition, this does not mean that the invention according to the claim of the earlier application breaches enablement provided in Article 36(4)(i).)

3.4 Method of determining whether inventions of respective claims of two applications filed on the same date are identical or not

(1) If invention A is determined to be the earlier application and invention B is determined to be the later application invention, and the later application invention B is found to be identical to

the earlier application invention A (“identical” refers to that stated in the above 3.3, hereinafter the same applies in this section), and if invention B is determined to be the earlier application and invention A is determined to be the later application, and the later application invention A is found to be identical to the earlier application invention B, both inventions are regarded as falling under “the same inventions.”

(2) Even if invention A is determined to be the earlier application and invention B is determined to be the later application, and the later application invention B is found to be identical to the earlier application invention A, if invention B is determined to be the earlier application and invention A is determined to be the later application, and the later application invention A is not found to be identical to the earlier application invention B, both are regarded as not falling under “the same inventions.”

(Explanation)

As an example, take the case where invention A is an invention of a more specific concept, and invention B is an invention of a generic concept. If invention A is an earlier application and invention B is a later application, the later application invention B is found to be identical to the earlier application invention A. But if invention B is an earlier application and invention A is a later application, the later application invention A is not found to be identical to the earlier application invention B. But if A and B were filed on the same date, finding both inventions to be the same is not appropriate in view of the fact that the later application invention A is not found to be identical to the earlier application invention B in the case of a prior and later application relation. Moreover, Article 39(2) is applied on the premise that two applications were filed for the same invention, and it should not be handled in such a way that only one application has a reason for refusal provided in Article 39(2). Giving notification of a reason for refusal only to invention B is not thus appropriate. Therefore, the judgment as described above is made.

(Note) Handling in cases where matters for defining the inventions of two applications filed on the same date have two or more alternatives is in accordance with handling in 3.3(3).

(3) Determining whether applicants are identical or different and inventions are identical or not

Determining whether inventions are identical or not when applicants are the same person is no different from determining a difference in applicants.

3.5 Handling of claims including specification of a product using function, feature, etc.

(1) A claim including the statement to specify the product using function, feature, etc. and falling under the following (i) or (ii) may be compared with a cited invention with difficulty. In such cases, if the examiner has reason to suspect that the claimed product would be prima facie similar to the cited invention, without comparison of the products between the claimed inventions and the earlier inventions, he/she notices a reason for refusal pursuant to Article 39. If an applicant may negate the examiner’s impression so that its authenticity becomes unclear by arguing against this prima-facie reasonable doubt that both are the same, and clarifying this through a written opinion, test report, etc., a reason for refusal is eliminated. If the examiner’s impression does not change because, for example, the applicant’s counterargument or clarification is abstract or general, he/she renders a decision of rejection pursuant to Article 39.

This handling should not be applied if the matter defining the earlier application invention falls under the following (i) or (ii). But when determining identity of two inventions filed on the same

date, this handling can be applied if the matter defining at least either of the inventions falls under the following i) or ii).

(i) If said function, feature, etc. are not typical, not commonly used in the technical field, or not commonly used, but related to commonly used ones so that they can be understood by a person skilled in the art

(ii) If said function, feature, etc. are typical, commonly-used in the technical field, or not commonly used, but related to commonly used ones so that they can be understood by a person skilled in the art, but a combination of these several function, feature, etc. falls under (i) as a whole

(Note) “Typical” refers to having a definition provided by JIS (Japanese Industrial Standards), IOS Standards (International Organization for Standardization) or IEC (International Electrotechnical Commission) Standards or can be defined quantitatively according to a test and measurement method provided by these standards. “Commonly used ones so that they can be understood by a person skilled in the art” refers to ones that are commonly used by a person skilled in the art in the technical field and whose definition or a test and measurement method may be understood by a person skilled in the art.

(2) Examples in which prima-facie reasonable doubts occur will be shown below.

- When function, feature, etc. of the invention according to a claim may be converted to ones having another definition or are obtained according to a test and measurement method, and an earlier application invention deemed to be identical in view of conversion results is found.
- When the invention according to the claim and an earlier application are specified in view of the same or similar function, feature, etc., but its measurement conditions or evaluation method are different and both have a predetermined relation; and if function, feature, etc. of the an earlier application invention are measured or evaluated according to measurement conditions or evaluation method, etc. of the invention according to the claim, they are likely to be included in function, feature, etc. of the invention according to the claim.
- When structure of a product found to be identical to that of the product of the invention according to the claim has been revealed after the filing date, and this has been found to be an earlier application invention.
- When an earlier application invention identical or similar to one stated in the description or drawings of the later application as an embodiment has been found (for example, when an earlier application invention with a product process identical to that stated as an embodiment or similar starting material has been found and an earlier application invention with a product process similar to that stated as an embodiment or identical starting material has been found)
- When an earlier application invention and a later application are common in the matters used to specify the invention other than those expressed by function, feature, etc., and the earlier application invention has problems or effects identical or similar to the problems or advantageous effects inherent in the matters used to specify the invention expressed by said function, feature, etc., and the function, feature, etc. of the earlier application invention are likely to be included in function, feature, etc. of the invention according to the claim

In addition, if applicability of Article 39 may be determined without using this specific method, a normal method is used.

3.6 Handling of a claim including specification of a product obtained by a production method

(1) It may be extremely difficult to decide on how a product itself is structured in a claim that includes specification of the product obtained by a production method. In that case, similarly to the above 3.5, if the examiner has reason to suspect that the claimed product would be prima facie similar to the cited invention, without comparison of the products between the claimed inventions and the earlier inventions, he/she notices a reason for refusal pursuant to Article 39.

However, this handling should not be applied to cases where matters used to specify the invention of the earlier application invention specifies a product using a product method, but may be applied to cases where the matters used to specify the invention of at least one of the inventions specifies the product using a production method when determining identity of two inventions filed on the same date.

(2) Examples in which prima-facie reasonable doubts occur will be shown below.

- When an earlier invention of a product whose starting material is similar to the starting material of the invention according to the claim and which was produced according to a production process identical to that of the invention according to a claim was found
- When an earlier invention of a product whose starting material is identical to the starting material of the invention according to the claim and which was produced according to a production process similar to that of the invention according to a claim was found
- When structure of a product found to be identical to the product of the invention according to the claim has been revealed after the filing date, and this has been found to be an earlier application
- When an earlier invention identical or similar to one stated in the description or drawings of the present application as an embodiment has been found

In addition, if applicability of Article 39 may be determined without using this specific method, a normal method is used.

4. How to proceed with examination when there is a reason for refusal pursuant to Article 39

4.1 How to proceed with a later application when an earlier application for the same invention is present

4.1.1 When applicants are different

When applicants and inventors are different, Article 29bis is applied.

When applicants are different and inventors are identical, Article 39 is applied, but when rendering a decision of rejection of an application by a reason for refusal that it is a later application of the same invention, the decision of rejection is not rendered until an earlier application has become final and decisive.

4.1.2 When applicants are identical

When applicants are identical, a notice of reasons for refusal is rendered and examination is forwarded without waiting until an earlier application has become final and decisive.

When sending notification of a reason for refusal to a later application based on an earlier application that has not become final and decisive (including an application for which request for substantive examination has not been made) pursuant to Article 39, and a reason for refusal is not eliminated, even if an earlier application has not been final and binding, the statement to the effect

that the decision of rejection is to be rendered is appended to a notice of reasons for refusal. When a notice of reasons for refusal has not been eliminated after expiration of the designated period, a decision of rejection is rendered.

However, when an earlier application for which a request for substantive examination has been requested is not examined when responding to a notice of reasons for refusal of a later application, and the intent to amend the earlier application is applied, the following handling is applied.

i) When there is a reason for refusal of an earlier application, a notice of reasons for refusal is rendered to the earlier application and after expiration of the designated period, examination of the later application is forwarded after confirming existence and nonexistence of amendment to the earlier application and contents of the amendment.

ii) When there is no reason for refusal of an earlier application, examination of a later application is forwarded after a decision to the effect that a patent to be granted to the earlier application is rendered.

4.2 How to proceed with examination of applications for the same invention filed on the same date

4.2.1 When applicants are different

(1) When there are no reasons for refusal other than a reason for refusal pursuant to Article 39(2), consultation is ordered to each applicant.

See 2.7.1 for details.

(2) When there are reasons for refusal other than a reason for refusal pursuant to Article 39(2) in at least one application, notification of the reason for refusal of the application is sent together with ordering consultation.

(Explanation)

When there are two or more patent applications for the same invention filed by different applicants on the same date, consultation is ordered. But when notifying of a reason for refusal other than Article 39(2), an applicant may substantially know all reasons for refusal at the same time and take appropriate action.

4.2.2 When applicants are identical

When applicants are identical, consultation is ordered and all reasons for refusal are rendered at the same time.

5. Remarks

5.1 When new matters are included

When an earlier application or a claimed invention includes matters that are excluded from those stated in the description, the scope of claim or drawings originally attached to an application form through amendment, Article 39(1) to (4) is not applied to the invention according to the claim.

(Explanation)

Allowing the invention according to the claim including matters not included in the description, the scope of claims or drawings originally attached to an application form (new matters) to exclude a later application is against a first-to-file system. If, therefore, claims of an earlier application or other application filed on the same date include new matters through amendment, Article 39, (1) to (4) is not applied.

5.2 When an application is converted

When an application is converted, an original application is deemed to have been withdrawn (Article 46(4) of the Patent Act, Article 10(5) of the Utility Model Act). Therefore, the original application is deemed not to have been filed from the beginning for the purpose of applicability of Article 39(1) to (4). If the converted application is legal, the application is deemed to have been filed at the filing date of the original application. Therefore, Article 39(1) to (4) is applied assuming that the application was filed on the filing date of the original application.

6. Notice of reasons for refusal pursuant to Article 39

When an impression that a claimed invention falls under Article 39(1) to (4) is obtained, a notice of reasons for refusal is rendered.

An applicant may argue or clarify against this by filing a written opinion, test report, etc.

If the examiner's impression that the invention according to the claim falls under Article 39(1) to (4) may be negated so that its authenticity becomes unclear, a reason for refusal is eliminated. If the examiner's impression is not changed, he/she renders a decision of rejection based on the reason of rejection.

Reference trial and court decisions

(1) Even if embodiments are overlapped, they are not found to be the same invention if technical ideas are different.

Decision by the Tokyo High Court, December 11, 1956 [Showa 30 (Gyo Na) 39]

... On this point, the present application invention has elements constituting an invention different from the cited patent invention and they are not the same invention.

However ... it may happen that both inventions are, with difficulty, found to be distinguishable from each other in their embodiments, but allowing vitamin B1 to coexist with vitamin C in the cited patent invention has no direct relation to ... its purpose, and cannot be thus found as an indispensable constituent element of the invention. Therefore, even if one embodiment of the cited patent invention as described above and adding vitamin C as an indispensable reducing substance in the present application invention may be accidentally distinguishable with difficulty, this cannot be a basis for finding that the inventions are the same.

Decision by the Supreme Court, First Petty Bench, July 10, 1975 [Showa 42 (Gyo Tsu) 29]

The decision of the original instance, that the cited invention and the present application invention are different in elements of inventions, and embodiments thereof may merely overlap with each other, is appropriate, as described above. And in the present case, that of the present application invention does not necessarily use a main carrier wave, while that of the cited invention necessarily uses a main carrier wave. On this point, both inventions are different in their elements. In this way, limitation added to the earlier application invention is not necessary, and on this point, if considering cases where that of the present application invention uses the main carrier wave when separate technical ideas can be found in the later application invention, there may be cases where both inventions always overlap in their embodiments, but both inventions are not the same by this reason. Moreover, it cannot be interpreted that so long as Article 8 of the prior Patent Act (Law No.98 of 1921) does not exclude parts overlapping in embodiments even in such cases, it intends to reject the later application as the same invention. The determination of the original instance that the present application invention and the cited invention are not the same invention is appropriate.

(2) Comparing identity of inventions based on the structure of invention

Decision by the Tokyo High Court, January 23, 1973 [Showa 45 (Gyo Na) 76]

... In order to find that the inventions are different, it is evident that the difference between both inventions should be distinguished objectively. The standard for determining existence or nonexistence of identicalness of inventions should be selected from the above standpoint. If so, the structure of invention is expressed objectively and existence and nonexistence of the identicalness of inventions may be determine based on this.

... On the other hand, the purpose of invention is an inventor's subjective intention, and working effects are inherently objective, but working effects stated in the description are recognized by an inventor or limited to one that an inventor finds necessary. This is merely subjective in connection with the purpose, which is also merely subjective. Therefore, determining existence and nonexistence of the identicalness of these inventions based on such purpose of an invention or working effect stated in the description should not be permitted.

(3) Addition, conversion, removal, etc. of well-known art and conventionally used means that do not produce any new effects

Decision by the Tokyo High Court June 23, 1983 [Showa 56 (Gyo Ke) 45]

... The earlier application invention expresses "counting the pulse number occurred in the linear relation to the intensity of shooting light" in the scope of claims to provide this as a generic concept. For this reason, specific types of necessary AD converters are not especially limited, while the present application invention expresses "converting a digital signal corresponding to amount of light of the subject using a pulse signal that has a predetermined cycle as a standard pulse signal" in the scope of claims to use the AD converter in the voltage-time conversion type in a limited way, which is found to be prima-facie difference.

However ... prior to the earlier application invention, as typical examples of AD converters in so-called counting type, the voltage-time conversion type and the voltage-frequency conversion type may be listed, which are known as well-known technical means that are substituent and interchangeable with each other, and using these technologies for AD conversion for optical technology has been similarly well-known. Therefore, considering the above-described well-known matter and ... the purpose of the present application invention, it is found that the provision of element in the earlier application invention for performing a so-called AD conversion is not limited to the above-described embodiment, but includes cases of using an AD converter in the voltage-time conversion type like the present application invention. And using this satisfies requirement. Accordingly, it is not found that Cited Reference constitutes a different invention from the present application invention, focusing on the point that the present application invention is limited to using the voltage-time conversion type as the AD converter of the counting method.

Decision by the Tokyo High Court, September 7, 1982 [Showa 55 (Gyo Na)82]

... As described above, water slurry of xonotlite needle-like crystal, or composition for producing a calcium silicate mold obtained by adding clay thereto intends to produce the calcium silicate mold using this, according to a conventionally used method. And the calcium silicate mold in the present application invention compresses and molds xonotlite needle-like crystal in the earlier application invention, or one obtained by adding clay thereto according to a conventionally used method. There is no information for finding that the present application invention uses a special molding means different from the conventionally used molding means described in the description of the earlier application invention or that addition ration of clay is special. Therefore, it is appropriate to determine that the earlier application invention and the present application invention are different in raw material for producing the molding and molding itself, but are the same as an invention.

(4) If inventions are differently merely in category expression

Decision by the Tokyo High Court, May 20, 1970 [Showa 44 (Gyo Ke) 93]

... As expressive form, the former relates to "a product" invention, while the latter relates to "a method" invention; and the substance of technical ideas is chemicals added in producing concrete, namely an additive for strengthening. Both are perfectly the same in a usage region, and are the same also in working effects. In view of the above-described finding and the fact that the original application invention and present application invention are based on finding novel material that can be advantageously used for the same usage region, as well as that the present application invention is merely an obvious use according to the purpose of using such object, and it does not have any inventiveness in itself unavoidably, as a result, the original application invention and the present application invention are to be interpreted to be the same invention.

Decision by the Tokyo High Court, May 31, 1978 [Showa 48 (Gyo Ke) 27]

... Although both inventions are different in whether they are expressed as a method or expressed as structure of apparatus, they are not different as technical ideas and are not configured as individual inventions.

Decision by the Tokyo High Court, October 29, 1971 [Showa 37 (Gyo Na) 103]

... Cited Reference expresses a manner necessary for carrying out a method of the present application invention as a concrete device without modification. Moreover, the present application invention falls under a manner expressed as a method necessary for implementing metallic cold finish using the apparatus of Cited Reference, and these inventions are the same invention because they are different only in Cited Reference expressing the same technical idea as apparatus and the present application expressing this as a method. ...

(Reference) The history of amendments to Article 39

Filing date	1995.7.1~1997.3.31	1997.4.1~1998.1.2.31	1999.1.1~2005.3.31	2005.4.1~2012.3.31	2012.4.1~
(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 was selected by consultations between the applicants who filed the 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 and the 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 the said patent application under Article 44(2) (including its mutatis mutandis application under Article 46(6)) and a device relating to the 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 withdrawn or invalidated, 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.	Where an application for a patent or a utility model registration has been withdrawn or dismissed, 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.	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 the said patent application.		
(6)	An application for a patent or a utility model registration filed by a person who is neither the inventor nor designer nor the successor in title to the right to obtain a patent or a utility model registration shall, for the purpose of application of paragraphs (1) to (4), be deemed to be neither an application for a patent nor an application for a utility model registration.		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, designating an adequate time limit.		
(7)	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, designating an adequate time limit.				
(8)	Where no report under the preceding paragraph is submitted within the time limited designated under the said paragraph, the Commissioner of the Patent Office may deem that no agreement under paragraph (2) or (4) has been reached.				