

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

## ***Chapter 2 Internal Priority***

### **Patent Act Article 41**

**1** A person requesting the grant of a patent may make a priority claim for an invention claimed in the patent application, based on an invention disclosed in the description or scope of claims for a patent or utility model registration, or drawings in the case where the earlier application was a foreign language written application, foreign language documents originally attached to the application of an earlier application filed for a patent or utility model registration which the said person has the right to obtain hereinafter referred to as "earlier application", except in the following cases:

(i) where the said patent application is not filed within one year from the date of the filing of the earlier application (excluding the cases where there is a reasonable ground for failing to file the said patent application within one year from the filing date of the earlier application, and the said patent application is filed within the time limit designated in Ordinance of the Ministry of Economy, Trade and Industry);

(ii) where the earlier application is a new divisional patent application extracted from a patent application ... , a converted patent application... or a patent application based on a utility model registration... , or a new divisional utility model registration application extracted from a utility model registration application ... or a utility model registration application converted from a utility model registration application ... ;

(iii) where at the time of the filing of the said patent application, the earlier application had been waived, withdrawn or dismissed;

(iv) where, at the time of the filing of the said patent application, the examiner's decision or the trial decision on the earlier application had become final and binding; and

(v) where, at the time of the filing of the said patent application, the registration establishing a utility model right under Article 14 2 of the Utility Model Act with respect to the earlier application had been effected.

**2** For inventions among those claimed in a patent application containing a priority claim under paragraph 1, for those that are stated in the description, scope of claims for a patent or utility model registration or drawings (in the case where the earlier application was a foreign language written application, foreign language documents) originally attached to the application of the earlier application on which the priority claim is based (...), the said patent application shall be deemed to have been filed at the time when the earlier application was filed, in the case of the application of Article 29, the main clause of Article 29bis, Articles 30(1) and (2) , 39 (1) to (4) , 69(2)(ii) , 72, 79, 81, 82(1) , 104 (...) and 126(7) (...), ... .

**3-4 (omitted)**

(Note) The above Patent Act Article 41 (1) and (4) applies to priority claimed along with a patent application filed on or after April 1, 2015.

### **1. Purport of internal priority**

In the priority system based on a patent application prescribed by the provision of

Patent Act Article 41 (so-called, “internal priority”. Hereinafter referred to as “priority” in this chapter), in cases where the patent application claiming priority is filed as a comprehensive invention (hereinafter referred to as “later application”) containing the invention of its own patent application or application for utility model registration that has been already filed (hereinafter referred to as “earlier application”), for inventions stated in the description, scope of claims or drawings (hereinafter referred to as “description etc.”) of the earlier application among the later application, prioritized treatment to deem the later application to have been filed at the time when the earlier application was filed, in the case of the application of Article 29 etc.

The system brought about the following results; 1) a patent application can be filed as a comprehensive invention collecting the content of the invention concerned and later invention of improvement so that the results of technical development can be easily and smoothly protected as a patent right in a complete form; 2) the effects of designation are recognized also in Japan even where the priority is claimed based on a patent application or application for utility model registration that has been filed earlier and Japan is designated in the international application based on the Patent Cooperation Treaty (PCT) (so-called, “self designation”).

## **2. Requirements of claim of internal priority**

### **2.1 Person who can claim priority**

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

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

Moreover, in case of the application by multiple applicants (joint application), the applicant of the earlier application and the applicant of the later application shall be completely the same.

### **2.2 Period when priority can be claimed**

The period when priority can be claimed shall be one year from the filing date of the earlier application (Patent Act Article 41 (1)(i)).

(Note 1) Where there is a reasonable ground for failing to file a patent application within one year from the filing date of the earlier application, a person may claim internal priority within one year and two months (Article 27quater-bis (1) of Ordinance for Enforcement of the Patent Act) from the filing date of the earlier application (The parenthesis of Article 41 (1) (i) of Patent Act).

(Note 2) In case that a person claims internal priority, the person shall submit to the Commissioner of the Patent Office a document stating thereof and the indication of the earlier application within the time limit designated in Ordinance of the Ministry of Economy, Trade and Industry (Article 27quater-bis (3) (i)-(iii) of Ordinance for Enforcement of the Patent Act).

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

The earlier patent application or application for utility model registration, except in

the following cases of (1) to (4), can serve as a basis of claim of internal priority.

However, the application that can be a basis of claim of internal priority is only a patent application or an application for utility model registration, and an application for design registration cannot serve as a basis of claim of internal priority (Patent Act Article 41 (1)).

(1) Where the earlier application is a new patent application divided out from or converted from a patent application, or a new patent application based on a utility model registration. (Patent Act Article 41(1) (ii))

(2) Where the earlier application has been abandoned, withdrawn or dismissed at the time when the patent application concerned is filed (Patent Act Article 41 (1) (iii))

(3) Where the examiner's decision or the trial decision on the earlier application has become final and binding at the time when the patent application concerned is filed (Patent Act Article 41 (1)(iv))

(4) Where the registration of establishment of the utility model right has been effected at the time when the patent application concerned is filed (Patent Act Article 41 (1) (v))

### **3. Effects of claim of internal priority**

For inventions amongst those claimed in a patent application containing a priority claim, for those that are stated in the descriptions etc originally attached to the request of an earlier application on which the priority claim is based, the patent application concerned shall be deemed to have been filed at the time when the earlier application was filed, in application of the following provisions in connection with substantive examination (Patent Act Article 41bis);

(1) Article 29 (novelty, inventive step)

(2) The principle sentence of Article 29bis (so-called, prior art effect)

(3) Article 30 (1) to (2) (exceptions to lack of novelty of invention)

(4) Article 39 (1) to (4) (precedent)

(5) Article 126 (7) (requirements for independent patentability of correction trial (except requirements prescribed in for Article 36)) (including its application under Article 17bis(6))

However, in application of the provisions of the other clauses in connection with substantive examination (for example, Article 36) on patent application claiming priority, determination shall be made, setting the date of filing of the later application to be the standard. And in the case of application of the provisions of 29bis on patent application claiming priority as a precedent application, see "Part II, Chapter 3, 2.2(3)".

### **4. Determination of effects of claim of internal priority**

#### **4.1 Basic idea**

The subject of priority claim is the "invention that is disclosed in the description etc. originally attached to the request of an earlier application" (Article 41(2)).

It cannot be said that the claimed invention of the later application claiming priority is disclosed in the description etc. originally attached to the request of the earlier application unless the claimed invention of the later application, which is understood by considering what is disclosed in the description etc. of the later application, is within the scope of matters

disclosed in the description etc. originally attached to the request of the earlier application.

It is determined whether the claimed invention of the later application is within the scope of matters disclosed in the description etc. originally attached to the request of the earlier application or not, depending on the examples of new matters (for determination of new matter, see “Part III, Section I New Matter”).

The effects of priority claim shall be determined on a claim-by-claim basis in principle.

Also where the matters for defining the invention in one claim (hereinafter referred to as “Invention-defining matters”) are expressed by formal or actual alternatives (hereinafter referred to as “alternatives”. For “formal alternatives” and “actual alternatives”, see “Part II Chapter 2. 1.5.5 Determining whether a Claimed Invention is Novel (Note 1)”), the effects of priority claim shall be determined by each alternative, respectively. Furthermore where modes for carrying out the claimed invention are newly added, the effects of priority claim shall be determined by each newly added part.

For typical cases, see “Chapter 1, 4.1 Basic Idea”.

## **4.2 Treatment of partial priority or multiple priorities**

(1) Where the later application claims internal priority based on the earlier application and the invention relating to a part of claims or alternatives of the later patent application is disclosed in the earlier application, presence/absence of the effects of priority claim based on the earlier application corresponding to the parts shall be determined.

(2) Where the later application claims internal priority based on two or more earlier applications, the invention relating to a part of claims or alternatives of the later application is disclosed in one of the earlier applications and another invention relating to another part of claims or alternatives is disclosed in another earlier application, presence/absence of the effects of priority claim based on the earlier application corresponding to each part shall be determined.

(3) Where the later application claims internal priority based on two or more earlier applications and invention-defining matters of the later application are commonly disclosed in the earlier applications, the examination shall be made, setting the date of filing of the earliest one of the earliest application disclosing the invention-defining matters of the invention as the priority date.

(4) Where the claimed invention of a patent application claiming the priority based on two or more earlier applications is a combination of the matters disclosed in the description etc. of each earlier application, and the combination is not disclosed in any of description etc. of the patent applications, any of the effects of priority claim are not recognized.

For examples of determination, see “Chapter 1, 4.3 Treatment of partial priority or multiple priorities”.

## **4.3 Treatment of cases where application that serve as a basis of claim of priority claims priority**

Where the earlier application that served as a basis of claim of internal priority (the second application) claims internal priority based on the earlier application (the first

application) or priority under the Paris Convention (including priority declared by the Paris Convention. See “Chapter 1, 6.2 Priority declared as governed by the Paris Convention”), if the priority is recognized again for the invention disclosed in the first application (cumulatively), the period of priority will be substantively extended. Therefore, among the matters disclosed in the description etc. of the second application, the effects of priority claim are not recognized for the matters already disclosed in the description, etc. of the first application, and the effects of priority claim are recognized only for the parts that are not disclosed in the description, etc. of the first application (Patent Act Article 41 (2),(3)).

#### **4.4 Deposit of microorganisms and its priority claim**

For treating cases where an application requiring deposit of microorganism claims priority, see “Part VII, Chapter 2, 5.1 (iii) Application claiming priority”.

#### **5. Treatment of claim of internal priority in examination**

Claims of internal priority shall be treated in examination as in case of priority claim under the Paris Convention in examination.

For details, see “Chapter 1, 5 Treatment of priority claim under the Paris Convention in examination”.

#### **6. Other points of concern**

##### **6.1 Division or conversion of application claiming internal priority**

For divisional application of a patent application claiming internal priority or an application converted from application for utility model registration claiming internal priority to a patent application, the priority claimed at the time when original application was filed can be claimed.

(The following shall be applied to the divisional or converted application filed since January 1, 2000).

The statements or documents certifying the priority submitted with respect to the original patent application are considered to have been submitted to the Commissioner of the Patent Office simultaneously with the said new patent application (Patent Act Article 44 (4), Article 46 (6)).

##### **6.2 Withdrawal of an application that serves as a basis of claim of internal priority**

(1) The earlier application that served as a basis of claim of internal priority shall be deemed to have been withdrawn when one year and four months has lapsed from the filing date of the earlier application. However, however, that this shall not apply to the case where the earlier application has been waived, withdrawn or dismissed, where the examiner's decision or trial decision on the earlier application has become final and binding, where the registration establishing a utility model right under Article 14 2 of the Utility Model Act with respect to the earlier application has been effected or where all priority claims based on the earlier application have been withdrawn (Patent Act Article 42 (1), Article 28quater (2) of Ordinance for Enforcement of the Patent Act).

(2) The applicant of a patent application containing a priority claim may not withdraw the priority claim after the period of one year and four months has passed from the filing date of the earlier application. (Patent Act Article 42(2), Article 28quater (2) of Ordinance for Enforcement of the Patent Act). In addition, where the patent application containing a priority

claim is withdrawn within one year and four months from the filing date of the earlier application, the said priority claim shall be deemed to have been withdrawn simultaneously (Patent Act Article 42 (3), Article 28quater (2) of Ordinance for Enforcement of the Patent Act).

(3) Where the international application containing Japan as a designated country serves as a basis of claim of internal priority, the application shall be deemed to have been withdrawn at the later of the time of the National Processing Standard Time (the time of the expiration of the Time Limit for the Submission of National Documents) or the time when one year and four months has lapsed from the International Application Date (Patent Act Article 184 –15 (4), Article 38sexies-quinquies of Ordinance for Enforcement of the Patent Act).

**Attached Table: Relation of international application based on Patent Treaty Cooperation and priority**

| Earlier application that serves as the basis of priority claim  | Later application claiming priority  | Priority that can be claimed   | Withdrawal deemed time of the earlier application  | Period when priority claim can be withdrawn   |
|---|--|--|--|---|
| National application  | International application containing Japan as a specified country (self designation) | Internal priority (PCT Article 8 (2)(b), Patent Act Article 184-3 (1) and 41 (1))  | At the expiration of one year and four months from the filing date of the earlier application (Patent Act Article 42 (1), Article 28-4 (2) of Ordinance for Enforcement of the Patent Act)   | Before the expiration of 30 months from the priority date (*) (PCT regulations 90, 2.3 (a) and Patent Act Article 184-15 (1))   |
| International application designating Japan and other countries | National application   | Internal priority or priority under the Paris Convention (Selection by applicant) (Patent Act Article 184-3 (1), 184-15 (4) and 41 or Paris Convention Article 4A) | Internal priority →the later of the time of the National Processing Standard Time or the time when one year and four months has lapsed from the International Application Date (Patent Act Article 184 –15 (4) and 42 (1), Article 38-6-5 of Ordinance for Enforcement of the Patent Act)<br>Paris Convention→not specified. | Internal priority→before the expiration of one year and four months from the date of filing of the earlier application (Patent Act Article 42 (2), Article 28-4 (2) of Ordinance for Enforcement of the Patent Act)<br>Paris Convention→ withdrawal is not possible |
|   | International application containing Japan as a specified country                    | Priority under the Paris Convention (PCT Article 8 (2) (a) and Paris Convention Article 4A)  | Not specified  | Before the expiration of 30 months from the priority date (PCT regulations 90, 2.3(a))  |

\* Claim of priority can be withdrawn after the expiration of one year and four months from the filing date of the earlier application, however the earlier application never be during the pendency before the JPO again.