

# **SELF-COLLISION**

**How to avoid shooting your client in the foot !**

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# **1 . Introduction**

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**Self-collision in a Japanese Patent application**

## When does “self-collision” occur?

### Double-patent type self-collision :

- Only a first-filed patent application can be granted.

If claimed inventions of both a first patent application and a second (later) patent application are identical or substantially identical, a double patent rejection (**Art.39**) is issued to the second (later) application.

- The double-patent rejection is applied **even if the applicants of both the first and the second applications are identical.**

(self-collision can arise).

- **However, when the first application is withdrawn, this rejection to the later application is cancelled.**
  - When either of claims is amended to make them different, this rejection is also cancelled.
- This rejection is kept as long as the claimed inventions are **valid and substantially identical.**

## When does “self-collision” occur?

### Novelty type self-collision (Art.29) :

- If a claimed invention is publicly known when filed, the claim is rejected based on **Art.29**. (normal novelty requirement)

### Exception of normal novelty requirement (Art.29-bis) :

- Even if the claimed invention is not publicly known when filed, it may be rejected.
- When a claimed invention of the second patent application B is disclosed in the publication of the first patent application A, which was **published after filing of the second application B**, the claims of application B are rejected based on **Art. 29-bis**.
  - “disclosed in the publication” means to be disclosed in any part of the publication, including not only claims but the specification and drawings.
- **However, when the applicants or the inventors of both applications A and B are identical, this rejection is not issued.**  
(self-collision does not arise)

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## **2. Double patent type self-collision**

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## Double-patent prohibition (Art.39)

- **Art.39** defines “first-to-file” rule.
  1. When two (or more) patent applications having **claims of identical or substantially identical inventions** are filed, only the first-filed application can be granted (Prov.1).
  2. When the two applications are filed **on the same day**, only one **application** out of the two applications can be granted (Prov.2).
- **Art.39** rejection (double-patent rejection) is issued even though **the applicants of the two applications are identical**.  
(Self-collision can arise)
- **This rejection is cancelled ;**
  - **when the first application is withdrawn, or**
  - **when either of claims is amended to make them different.**

## Double-patent prohibition (Art.39)

- What “**substantially identical**” means :
  - When the difference exists **only in mere well-known or commonly-known element(s) without giving new advantageous effect(s)**, (addition, deletion or change of the well-known or commonly-known element(s) only)
  - When the second application’s invention is **broader than the first application’s invention**, ( when **the second invention is generic**)
  - When the difference exists **only in the category of inventions**, such as **product claim vs. method claim having the same features.**

## Double-patent type self-collision (2)

- The rejection under Art.39 is issued only when both of the inventions are identical or substantially identical.
  - Inventive step or obviousness is not considered to apply the Art.39 rejection to later filed claims.
  - Only whether they are identical or substantially identical or not is examined.
- **No “obviousness type double patent rule” exists in the Japanese Patent Law.**
- **No terminal disclaimer rule exists either.**





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## **3. Novelty type self-collision**

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## Normal novelty requirement under Art.29

- Novelty is required at the time of filing (Art.29)
- Basically, novelty is denied ;
  - if the claimed invention is publically known **when the patent application is filed**,
  - if the claimed invention has already been manufactured, sold, or used **when filed**.
  - if the claimed invention is disclosed in a published document **when filed**.

## Exceptional novelty requirement under Art.29-bis (1)

- A patent application is automatically published in about 1.5 years after filing (from the priority date).
  - A novelty issue based on the publication comes out 1.5 years later.
- Even if an early filed patent application (earlier application A) has **not been published** when a patent application (later application B) is filed, novelty of the claimed invention of the later application B **may be denied based on disclosures in the entire published documents of the earlier application A** (Art.29-bis).
- In Art.29-bis, only a novelty rejection is applied, no inventive-step rejection (obviousness rejection) is applied.

## Exceptional novelty requirement under Art.29-bis (2)

- Regarding “Novelty” under Art.29-bis :
  - When the claimed invention of the second application B is **disclosed in the entire documents** (the specification, claims or drawings) of the first application, the claims(s) of the second application is rejected.
- What “**disclosed in the entire documents**” means :
  - When only a tiny difference exists, it is considered that the claimed invention is disclosed.
  - When the claimed invention of the second application B can be easily conceived by a person skilled in the art from the disclosure of the published entire documents of the first application A.
  - **In the Examination standard, there is no examples such as shown in Art.39. But, the similar way will be used in evaluating whether the claimed invention is disclosed or not.**

## Exceptional novelty requirement under Art.29-bis(3)

- Art.29-bis prescribes **an exception of applying the novelty rejection.**
- If either **the applicants or the inventors** of the earlier and the later patent applications A and B are identical, no novelty rejection based on Art.29-bis is applied.

**No self-collision issue arises**

- **The applicants or the inventors must be identical at the time of filing the later application B.**
- **The applicants must be completely identical.**
  - For example, if the earlier application A was filed in the name of co-applicants X and Y and the later application B was filed in the name of the applicant X only, the exception is not applied. The same rule is applied to the inventors.

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## **4. Case study with a hypothetical model**

### **Patent Applications A & B**

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## Hypothetical model (Case study)

Let's think about model cases that two patent applications A and B have been filed as shown in the time chart of next page.

At first, the first patent application A was filed, and then the second patent application B was filed. Then the first application A was published.

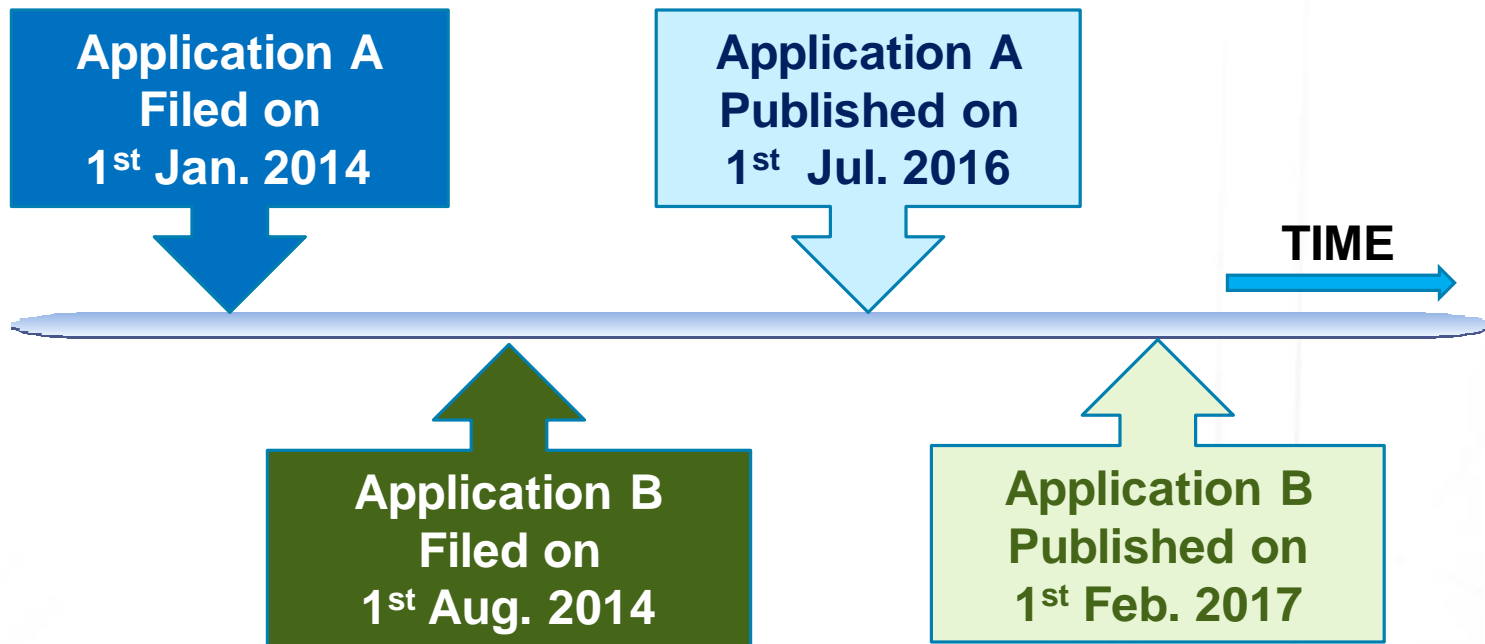
**Case 1 :** Claim “a” of the application A is substantially identical with claim “b” of the application B.

**Both of the applicants are identical.**

**Case 2 :** Claim “a” is different from claim “b”, but the substantially identical invention (idea) with claim “b” is disclosed in the specification of the Application A.

**Both of the applicants are identical.**

# Hypothetical model (Case study) Time-chart





## Double-patent issue under Art.39

### Case 1 :

- **The later application's claim "b" is rejected under Art.39.**
  - Even if the applicant of the claim "a" is the same as of the claim "b", the claim "b" is rejected.
- Self-collision can happen in this case.

### Case 2 :

- No rejection under on Art.39 based on the application A is issued in the application B, since claims are different.

## Novelty issue under Art.29

### Case 1 & Case 2 :

- Novelty under Art.29 is required at a time of filing.
- Novelty under Art.29 of the later application B is not denied by the publication of application A, since the publication of application A did not exist when application B was filed.
  - Only the publication date is important. Namely, it is important whether application A had already **published or not at the time of filing application B.**

## Novelty issue under Art.29-bis

### Case 1 :

- The application B is not rejected based on Art.29-bis, since the applicants are identical. (But it will be rejected based on Art.39)
  - If **the inventor(s)** of these two applications A and B **are identical**, no rejection based on Art.29-bis is issued.

### Case 2 :

- The application B is not rejected based on Art.29-bis, since the applicants are identical. (If applicants are different, it will be rejected based on Art.29-bis)
  - If **the inventor(s)** of these two applications A and B **are identical**, no rejection based on Art.29-bis is issued.

# Thank you !

Closing of Presentation



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