SELF-COLLISION

How to avoid shooting your client in the foot!

FICPI 17th Open Forum (in Venice)
FRIDAY, 27 OCTOBER 2017

Shogo Ohnishi
S.Ohnishi & Associates
1. Introduction

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- However, when the first application is withdrawn, this rejection to the later application is cancelled.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)
2. Double patent type self-collision
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.
• 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.
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 terminal disclaimer rule exists either.
3. Novelty type self-collision
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.
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.
4. Case study with a hypothetical model
Patent Applications A & B
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 than 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**

- **Application A**
  - Filed on 1\textsuperscript{st} Jan. 2014
  - Published on 1\textsuperscript{st} Jul. 2016

- **Application B**
  - Filed on 1\textsuperscript{st} Aug. 2014
  - Published on 1\textsuperscript{st} Feb. 2017
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.
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

Shogo Ohnishi
President of FICPI-JAPAN