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Effect of Priority Right under Article 4F of the Paris Convention in Patent Invalidation Trial

Intellectual Property High Court (IPHC)

2019 (Gyo-Ke) No. 10132: Case regarding request for revocation of trial decision

Judgment date: November 5, 2020

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Case Summary

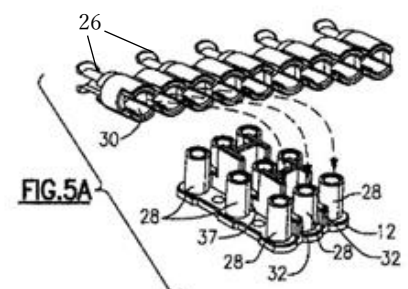
Defendant X possesses [JP5575340B2](#) (“the ‘340 patent”) entitled “BRUNNIAN LINK MAKING DEVICE AND KIT”. The ‘340 patent matured from the Japanese patent application 2013-537663, which is divided from another Japanese application that is based on the PCT application PCT/US2011/041553 claiming the right of priority to U.S. provisional application No. 61/410399 (“the ‘399 application”) under Article 4F of the Paris Convention. After filing the ‘399 application and prior to filing the PCT application claiming the priority right based on the ‘399 application, a video (“the video A1”) disclosing an invention similar to the ‘340 patent was posted on a video sharing site.

Hanayama Co. Ltd. (“Hanayama”) filed a request for an invalidation trial citing the video A1 against the ‘340 patent before the JPO on February 23, 2018, but the trial decision upheld the patent. Hanayama then appealed to the IPHC on October 4, 2019, requesting a revocation of the decision, but the request was dismissed.

Among the multiple reasons for invalidity asserted by Hanayama before the IPHC, the effect of priority right under Article 4F of the Paris Convention, for which the court dismissed Hanayama’s request, is explained below.

Claim 1 of the ‘340 patent:

A device for creating an item consisting of a series of links,
the links being Brunnian links,
the item being a Brunnian link item, and
the device comprising:



a base (12); and
at plurality of pins (26) supported on the base,
wherein each of the plurality of pins includes an upper portion for holding the links in a desired orientation and an opening in each of the plurality of pins located at a front side in the direction of a row of pins, and the plurality of pins are arranged in a plurality of rows, separated from each other and extending upward from the base. See FIG. 5A.

Hanayama's Assertions

The priority claim under the Paris convention should be denied because the '340 patent invention includes the following four features that are not disclosed in the '399 application:

- (a) A pin includes a plurality of grooves;
- (b) A pin bar and a base are integrally molded;
- (c) The pin bar fits onto a convex portion on the base instead of the groove on the base; and
- (d) The pin includes a gap instead of a groove, the gap penetrating through the pin.

Therefore, the '340 patent lacks novelty and inventive step over the video A1 and should be invalid.

Determinations by the Court

Interpretation of Article 4F of the Paris Convention

The court interpreted Article 4F of the Paris Convention to mean that a priority claim under the Paris convention is only denied for those features that are not supported in a prior patent application on which the priority is based, and it stated that in order to invalidate the '340 patent, "*those features should be found to lack novelty or inventive step in light of the cited prior art references*". In other words, it stated that it was necessary to determine whether features (a) to (d) lack novelty or inventive step over the video A1.

Determination of Novelty and Inventive Step for Features (a), (b), and (d)

The court determined that the features (a), (b), and (d) were novel over the video A1 and held that "*there is no sufficient assertion or proof to determine that these features lack inventive step over the invention according to the video A1*". Thus, the court held that it was unnecessary to determine whether these features are supported in the '399 application.

Determination of Novelty for Feature (c)

The court found that because it is clear that the invention according to the video A1 includes feature (c) and the '340 patent also includes feature (c), the '340 patent lacks novelty over the video A1, and

held that “*in order to determine whether a priority claim under the Paris convention can be admitted, it is further necessary to determine whether feature (c) is not supported in the ‘399 application’*”.

Determination of Support for Feature (c) in the ‘399 Application

The court found that the embodiment described in the ‘399 application is configured with a recess provided on a base and a pin bar fitted into the recess, while the feature (c) is configured with a convex portion provided on a base and a pin bar fitted onto the convex portion. However, the court held that “*because it is common knowledge that if one of these is conceived, the other is naturally conceived, as long as the feature of providing a recess on a base is described, the feature of providing a convex portion on a base should be within the scope of the assumption about this description even if there is no explicit description*”. Consequently, the court determined that the feature (c) was supported by the ‘399 application, and Hanayama’s assertions regarding this reason for invalidity were dismissed.

Analysis

The court determined whether the feature (c) was supported by the ‘399 application, but did not determine whether features (a), (b), and (d) were supported by the ‘399 application on the grounds that there was no assertion or proof to show that any of these features lacks inventive step over the video A1. Therefore, it is considered that, when denying the effect of priority in an invalidation trial or in an appeal in relation thereto, it is necessary to submit sufficient assertion or proof for lack of inventive step over prior art references as well as arguments asserting that features are not supported by a basic application of the priority claim.

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This article is only meant to provide a general introduction to a Japanese IP case in an easy-to-read format for our audience outside of Japan.