

**Artificial Nipple Case
Benefit of Domestic Priority
Tokyo High Court
Case H14 (Ne) No.539 (October 8, 2003)**

In an application claiming domestic priority, an addition of an embodiment having an advantage over its prior disclosure may negate the benefit of the domestic priority.

FACTS

The applicant filed patent application X (Application No. H10-318999, filed on October 20, 1998), and then filed patent application Y (application No. H11-288535, filed on October 8, 1999), claiming domestic priority from patent application X. Patent application X relates to an artificial nipple comprising an extensible portion of reduced thickness and a rigid portion of enhanced thickness, and discloses an embodiment in which an artificial nipple comprises a ring-shaped groove as the extensible portion (hereinafter referred to as "embodiment a1"), as shown in FIG. 1. Likewise, patent application Y claims an artificial nipple comprising an extensible portion of reduced thickness and a rigid portion of enhanced thickness in claim 1, and discloses newly-added embodiment a2 as well as embodiment a1. Embodiment a2 relates to an artificial nipple with a helical-shaped groove as the extensible portion, as shown in FIG. 2.

The scope of Claim 1 in patent application Y includes embodiment a2. The artificial nipple with a helical-shaped extensive portion according to embodiment a2 is advantageous compared to embodiment a1 because it is more elastic, and easier to manufacture.

Patent application Z was filed by another person prior to the filing of patent application Y. Patent application Z describes the same invention as embodiment a2, as shown in Fig. 3.

The Board of Appeal in the Japan Patent Office finally rejected patent application Y under Patent Law Art. 29-2 (novelty rejection by a post-published prior art), judging that it could not enjoy the benefit of domestic priority with regard to embodiment a2, and was anticipated by patent application Z. The applicant filed a lawsuit against the appeal decision.

ISSUE

Can addition of an embodiment or working example affect claiming a domestic priority?

COURT DECISION

The Tokyo High Court stated that whether a claimed invention of a later application with domestic priority is disclosed in the original specification and drawings of the earlier application should not be determined just by comparing wording or phrases of the claim in the later application with those described in the original disclosure of the earlier application, as argued by the applicant, but should be determined instead by comparing the subject matter of the claim of the later application with the subject matter of the original disclosure of the earlier application.

Embodiment a2, which was newly added to patent application Y, has an advantage compared to that of embodiment a1 and falls under the scope of claim 1 of patent application Y. Therefore, claim 1 of patent application Y should be construed as including subject matter that is beyond the original disclosure of patent application X. The

applicant cannot enjoy the advantage of domestic priority for subject matter that is beyond the scope of the original disclosure of the earlier application. Accordingly, the court held that the Board of Appeal did not err in rejecting patent application Y as being anticipated by patent application Z.

FIGURES

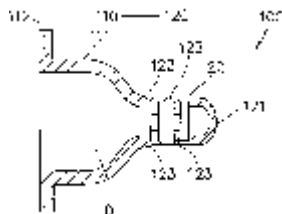


FIG. 1

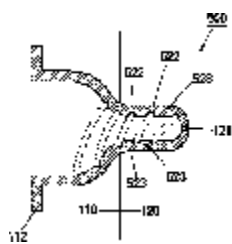


FIG. 2

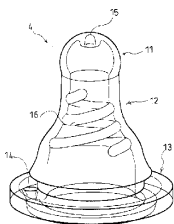


FIG. 3