

Date	October 8, 2010	Court	Tokyo District Court, 40th Civil Division
Case number	2009 (Gyo-U) 540		
<p>– A case in which the court determined that both the following disposition and the ruling by the Commissioner of the JPO cannot be regarded as illegal: [i] a disposition dismissing the procedure pertaining to a submission form for a priority certificate pursuant to the provisions of Article 68, paragraph (2) of the Design Act and Article 18-2, paragraph (1) of the Patent Act on the grounds that if the time limit for submitting a priority certificate lapses before the original priority certificate can be submitted after claiming a priority under the Paris Convention, even if there are special circumstances (e.g., where a copy of part of the priority certificate was submitted within said time limit), it is not permitted to amend the procedure by submitting the original priority certificate after said time limit has lapsed; and [ii] the ruling that dismissed an objection against said disposition.</p>			

The plaintiff (a corporation in Norway), who filed with the JPO an application for design registration claiming a priority under the Paris Convention based on an application filed with the Office for Harmonization in the Internal Market (Trade Marks and Designs) (hereinafter referred to as the "OHIM"), received a disposition dated August 29, 2008 (hereinafter referred to as the "Disposition") dismissing the procedure pertaining to a submission form for a priority certificate pursuant to the provisions of Article 68, paragraph (2) of the Design Act and Article 18-2, paragraph (1) of the Patent Act. The dismissal was based on the grounds that the plaintiff failed to submit the original priority certificate as prescribed in Article 15, paragraph (1) of the Design Act and Article 43, paragraph (2) of the Patent Act within the time limit (June 12, 2008) for submitting a priority certificate (the plaintiff submitted color copies of two pages, including the front cover, of the certified copy issued by the OHIM within the aforementioned time limit). The plaintiff then filed this action to seek revocation of the Disposition, alleging that the Disposition is illegal as it goes against the provisions of Article 68, paragraph (2) of the Design Act and Article 18-2 of the Patent Act (it was illegal to dismiss said procedure without ordering an amendment to be made despite the fact that said procedure was amendable through submission of the original priority certificate). The plaintiff also sought rescission of a ruling (dated April 27, 2009) that dismissed an objection against the Disposition, alleging that the ruling is illegal as it does not take into account the fact that the defect was already reviewed through the plaintiff's submission of the original of the priority certificate on November 4, 2008 after the Disposition was made. (However, the Commissioner of the JPO imposed a

disposition dismissing the procedure pertaining to a written amendment of procedures for the purpose of this submission of the original on March 4, 2009, and the action to seek revocation of said disposition is Case No. 2009 (Gyo-U) 597 filed with the Tokyo District Court on the same day.)

In this judgment, the court ruled as follows: in relation to a priority claim, for which the time limit for submitting a priority certificate has lapsed before a priority certificate can be submitted, if an amendment of procedures is allowed by submitting the original priority certificate after said time limit has lapsed, this would result in neglecting the purpose of the provisions of Article 15, paragraph (1) of the Design Act and Article 43, paragraphs (2) and (4) of the Patent Act, which provide for the time limit for submission of a priority certificate and stipulate that the claim of a priority loses its effect unless a priority certificate is submitted within said time limit; therefore, a defect in the procedure pertaining to the submission form in question is a defect in an important requirement in the procedure for claiming a priority, and it is not amendable any more. Based on this ruling, the court determined that the Disposition that dismissed said procedure pursuant to the provisions of Article 68, paragraph (2) of the Design Act and Article 18-2, paragraph (1) of the Patent Act cannot be regarded as illegal.

Moreover, with regard to the plaintiff's allegation to seek rescission of the ruling on the objection in question, the court ruled as follows: the plaintiff merely alleges illegality of the ruling on the objection in question based on the same reason as the reason for the illegality of the Disposition, that is, the procedure pertaining to the submission form in question does not fall under "procedure that is unlawful and is not amendable"; therefore, it is not recognized as an allegation of a reason for illegality peculiar to the determination (the ruling in question) that differs from the reason for illegality of the original disposition (the Disposition). Based on this ruling, the court dismissed the plaintiff's claim.