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Revisions to Japanese Patent, Trademark, and Design Law

There have been several revisions made to the Japanese Patent, Trademark and Design Law.

Said revisions set forth below will mainly become effective on or after April 1, 2007.

Patent

1. Easing of Limitations Regarding the Timing for Filing a Divisional Application

(Effective for Patent applications filed on or after April 1, 2007)

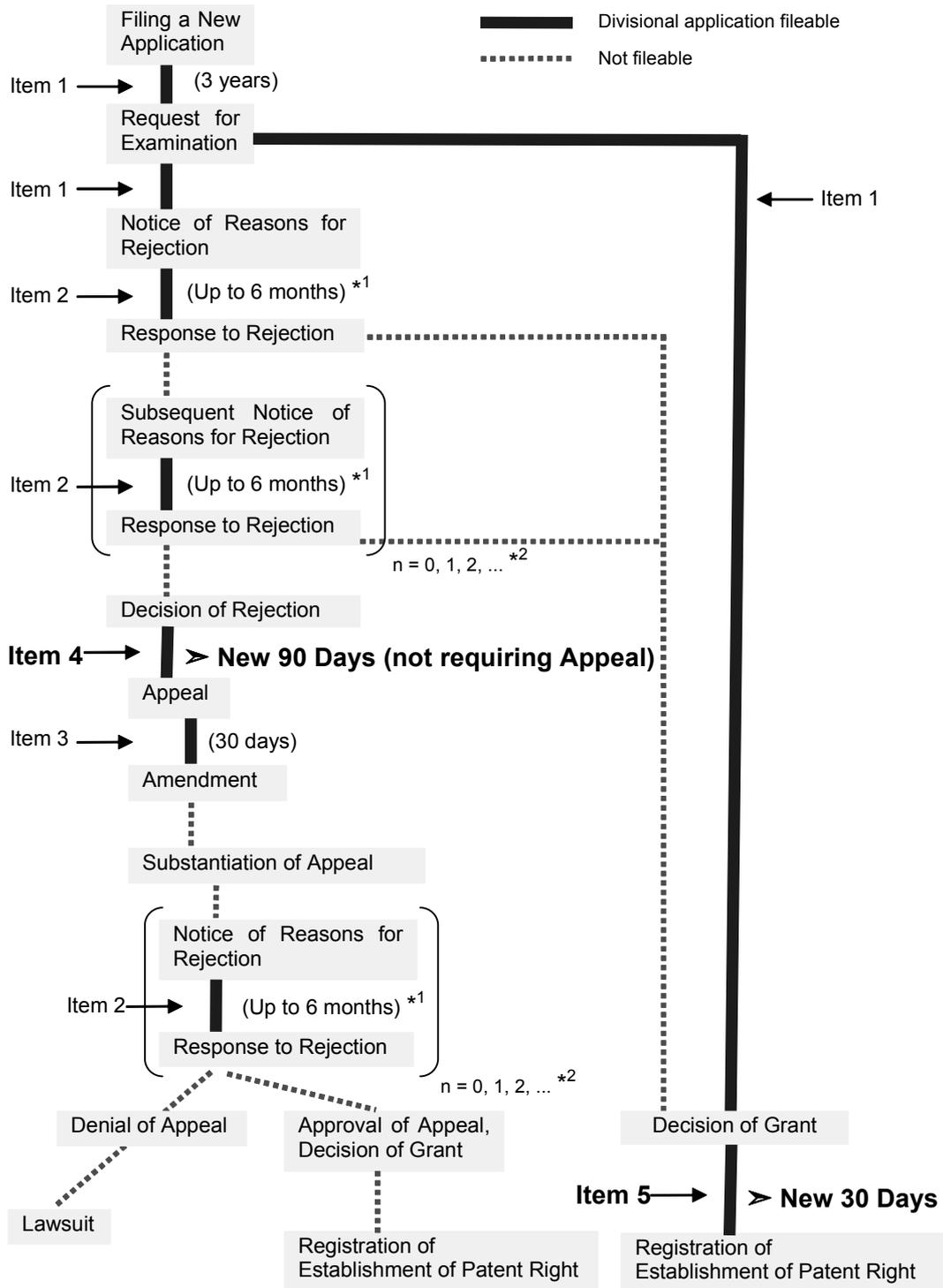
It will become additionally permissible to file a divisional application within a defined period even after a Decision to Grant a Patent, and after a Decision of Rejection without having to file an Appeal against said Decision. Accordingly, besides the timing now in effect, and stated in the below-mentioned Items (1) to (3), additional timing, as set forth under Items (4) and (5) below will come into effect:

1. At any time before the first communication from the Japan Patent Office (JPO) issued as a result of the substantive examination, i.e., before the JPO dispatches a Notice of Decision of Grant, and before applicants first receive a Notice of Reasons for Rejection;
2. Within the designated time limit for responding to a Notice of Reasons for Rejection;
3. Within 30 days after filing an Appeal against the Decision of Rejection;
4. (New) Within 30 days (or 90 days for applicants residing overseas) after the dispatch of the Decision of Rejection and without having to file an Appeal against said Decision;
5. (New) Within 30 days after the dispatch of the Decision of Grant, but before the registration of the establishment of a patent right.

However, after filing an Appeal Against the Decision of Rejection and the time period set forth under item 3) has passed, the opportunity to file a divisional application is only restricted to such cases where a further Notice of Reasons for Rejection is issued during the appeal proceedings. The issuance of said further Notice of Reasons for Rejection during appeal proceedings does not occur so frequently. Therefore, once the Decision of Rejection is issued, the time period set forth under Item 3) or 4) would be practically the last chance to file a divisional application.

The above-mentioned revision is applicable to patent applications filed on or after April 1, 2007, except divisional applications filed on or after said enforcement date whose original applications were filed before that date.

The following is a flow chart including some typical examination proceeding procedures, simplified for easy reference, where the solid bold lines indicate the time periods during which a divisional application can be filed.



*1. After the initial 3-month term, it is possible to receive a subsequent extension of up to 3 months.

*2. "n" indicates the number of received Notices of Reasons for Rejection.

2. Restrictions to Amendments to Divisional Patent Applications

(Effective for Patent applications filed on or after April 1, 2007)

A divisional application, which still has reasons for rejection notified against the original application remaining, will be subjected to additional amendment restrictions. In this case, a Notice of Reasons for Rejection, which is first issued against the Divisional Application, will be a “Final” Notice of Reasons for Rejection.

There are two types of Notice of Reasons for Rejection, one is called a “First” Notice of Reasons for Rejection”, and the other is called a “Final” Notice of Reasons for Rejection. The former is an Examiner’s rejection, which is usually first issued when Examiners find reasons for rejection during the substantive examination. The latter is, on the other hand, only issued when the Amendment filed as a response to said “First” Notice of Reasons for Rejection causes new reasons for rejection.

As a response to a “First” Notice of Reasons for Rejection, any amendments are allowed provided that they are obvious from the specification and drawings as initially filed, but amendments to claims as a response to a “Final” Notice of Reasons for Rejection are additionally limited to:

- 1) canceling claims;
- 2) narrowing the scope of existing claims by using narrower limits for matters already pertaining to the definition of the scope, while not changing the industrial applicability and object of the claimed invention;
- 3) correcting typographical errors, and
- 4) clarifying unclear or ambiguous language objected to by the Examiner in the Notice of Reasons for Rejection.

For example, as amendments to a “Final” Notice, addition of new claims, change of category of the existing claims, addition of new elements into the existing claims, which have an influence on the industrial applicability and object of the claimed invention, and enlargement of the claimed scope, are not allowed, even if these are supported by the specification as initially filed. Therefore, it is very disadvantageous to receive a “Final” Notice of Reasons for Rejection as the first examination report from the Examiner.

Therefore, when filing a divisional application from a patent application, which has been subjected to substantive examination and has received a Notice of Reasons for Rejection, it is recommended to formulate the claims and description of the divisional application in such a way that they are already free from the reasons for rejection notified against the original application, if necessary together with filing a written explanation to convey your opinion to the Examiner regarding said freedom from the reasons for rejection.

The above-mentioned revision is applicable to patent applications filed on or after April 1, 2007, except divisional applications filed on or after said enforcement date whose original applications were filed before that date.

3. Prohibition of Amendments to Make the Claimed Invention Different in View of Unity of Invention

(Effective for Patent applications filed on or after April 1, 2007)

It will no longer be permissible to file an Amendment to formulate or modify a new or existing claim after receiving a Notice of Reasons for Rejection, in such a way that the invention thus claimed lacks Unity of Invention relative to that before the Amendment.

Such an amendment will be regarded as constituting a reason for rejection, or dismissed when it is filed as a response to a Final Notice of Reasons for Rejection. However, this will not represent a ground for invalidation.

Therefore, if, after receiving a Notice of Reasons for Rejection, an applicant wishes to seek a patent relating to a different invention, which lacks Unity of Invention relative to the existing claimed invention, it will be necessary to file a divisional application.

4. Time Extension for Submitting Foreign Language Patent Applications

(Effective for Patent applications filed on or after April 1, 2007)

If an application is filed in a language other than Japanese (such a language is actually limited to English), the time limit for filing the Japanese translation will be prolonged up to 14 months, calculated from the earlier of the filing or priority date.

Other Revisions

New Term Extension System

In the past, for patent applications, a 3-month extension of the term for responding to a Notice of Reasons for Rejection was allowed for overseas residents, if they filed a single written request. Now, only a one-month extension is allowed per request. The request for a term extension can, however, be filed three times; therefore, as before, applicants may receive a maximum 3-month extension. Two or three requests can be filed individually at different times, or filed simultaneously, within the designated time limit.

Said new system is applicable to a request for a term extension filed on or after April 1, 2007.

Trademark

1. Acceptance of Retail Services

Starting on April 1, 2007, retail services (including Internet retailing and mail-order sales) will be considered as “services”, and become registerable in Class 35 under the Trademark Law.

Examples of retail services are:

- General retail stores such as department stores and supermarkets
- Specialist stores such as shoe stores and flower shops

2. Registration Procedures

- (1) Under the Japanese practice, when filing an application for retail services, the equivalent expression for “retail services” in Japanese will be as follows:
 - a) For instance, retail services provided in general retail stores should be specified as “Providing benefits for customers in retail services or wholesale services for a variety of goods in each field of clothing, foods and beverages, and living ware, carrying all goods together”.
 - b) Specialist stores need to specify goods to be sold. Example: “Providing benefits for customers in retail services or wholesale services for footwear”.
- (2) When an applicant specifies goods which are subject to retail services, i.e., in the case of b) above, the similarity between the services and the goods would be examined. For example, in the case of b), “footwear” will be cross-searched.
- (3) Applications specifying retail services filed within three months from the enforcement of the new trademark law, i.e., from April 1, 2007 to June 30, 2007, will be regarded as being filed on the same date, and examined accordingly. Concerning an application claiming priority, even if the priority date is prior to April 1, 2007, the priority date will be deemed to be April 1, 2007.
- (4) If conflicting applications (i.e., identical/similar marks for identical/similar retail services) are filed during the aforementioned transitional period, an applicant who has been using the service mark before the date of the enactment of the new law (April 1, 2007), would be able to register the mark. An applicant who has been using the mark will have to submit evidence of use, once he/she receives an Official Action (directive for consultation). If the service marks of the conflicting applications are both used before April 1, 2007, both would be granted registration, provided that all other requirements are fulfilled.

3. Right to Continuous Use

For a service mark used in good faith for retail services prior to April 1, 2007, a user of said service mark has a right to use the mark within the original scope of business. In other words, said fact can be used as a plea against the execution of the service mark right from the other party who registered a mark for retail services.

Design

1. Extension of the Design Right Duration

The duration of a design right will be extended from 15 to 20 years from the date of registration. The duration of a related design right will be extended to 20 years from the date of registration of its principal design as well.

2. Easing of the Time Limit for Filing a Related Design and a Partial Design

1. Related Design

Under the current Design Law, when an applicant files design variations, one of the designs has to be filed as a principal design and the other designs similar to said principal design have to be filed as related designs on the same filing date (and the same priority date) as the principal design application. The new Design Law allows an applicant to file a related design application for a design similar to a filed/registered design (a principal design) from the filing date of the principal design until the day before the issue date of the Design Gazette for registration of the principal design application.

2. Designs for Components/Parts of an Article (Partial Designs)

Under the current Design Law, any design application for a component or a partial design has to be filed earlier than or at the same time as a design application for an entire design incorporating said component or partial design.

The new Design Law allows an applicant (the same applicant as the one for the entire design application) to file a design application for a component or a partial design from the filing date of the entire design application until the day before the issue date of the Design Gazette for registration of said entire design application.

3. Protection of Screen Designs

Under the current Design Law, only (a) the screen design whose article itself cannot be comprised without said screen design, such as the time display of LCD clocks, and (b) the screen design which is essential to perform the initial operation, such as the initial (main menu) screen of mobile phones, are protected as the design constituent element of the equipment within the framework of the Design Law.

The new Design Law stipulates that screen designs can be protected when said screens are used for operation of an article (only for bringing the function of said article into operation) even if said screens are not the initial (main menu) screen.

Furthermore, both screen designs displayed on an article of an application, and displayed on an article used as a unit with the article of the application can be protected as well.

However, screen designs which are displayed by installing business software and/or game software which are/is sold separately from the article, are not included.

These screen designs are protected as parts of the articles.

4. Determination of Similarity of Designs

Under the current design Law, the similarity of designs is determined by designers or consumers, which lacks consistency. The new Design Law stipulates that the similarity is determined based on an aesthetic impression from the viewpoint of consumers. Said determination of similarity is according to Supreme Court precedents. (Consumers include end users and distributors.)

5. The Request Period for Secret Designs

Under the current Design Law, an applicant can file a request to keep a design secret only at the filing date, however, the new Design Law allows an applicant to file a request at the payment of the first registration fee as well.

The revised Design Law will become effective on April 1, 2007. The revision will be applicable to applications filed on/after April 1, 2007.

However, concerning the related design applications and partial design applications in the case of 2. above, the revision will be applicable to the principal design applications and the entire design applications filed prior to April 1, 2007.

Common Revisions to Patent, Utility Model, Design and Trademark Law

All Revisions have been enforced since January 1, 2007

1. Additional Infringing Act

Exportation has been included into the Definition of “Working” under the Patent, Utility Model and Design Laws, and of “Use” under the Trademark Law, in order to strengthen border regulations. It has thus become possible to seek injunction against exportation of infringing products.

2. Additional Acts Deemed to be Infringement

It has become possible to control infringements against the possession of infringing products for the purpose of assignment, lease or export, before the products are disseminated through these acts.

3. Strengthening Criminal Penalties

Under the revised law, criminal penalties (specifically fines and imprisonment) for infringement against intellectual property rights have been made more severe.