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Tokyo, March 2009

Circular No. E-187

Revision of the Japanese Patent Law, Utility Model Law, Design Law and Trademark Law

On **1 April 2009** the below stated changes will come into force in Japan.

1. Patent Law:

Change of the term for filing an Appeal after receipt of a Decision of Rejection

(Effective for applications against which a Decision of Rejection is delivered on or after 1 April 2009)

For foreign applicants, the term for filing an Appeal is extended from the current 90 days to **four months from the date of the receipt of the Decision of Rejection** (Japanese applicants: from 30 days to three months).

As a result, the applicant has more time for consideration, and the payment of the official fees is postponed.

However, with the aforementioned change, **amendments of the text and divisional applications***, currently possible within 30 days after the filing date of the Appeal, **have to be filed along with the Appeal**.

Therefore, the term for considering possible amendments essentially does not change.

As to the various terms, please also refer to the attached chart.

*Divisional applications whose original applications were filed on or after 1 April 2007 (including international application date) can be filed within four months (Japanese applicants: three months) from the date of the receipt of the Decision of Rejection without having to file an Appeal against said Decision. In this regard, please also refer to our circular E-185 of March 2007.

Please be aware that the Amendment that can be filed along with the Appeal should be considered as the **last chance** to amend the application documents, since further Notices of Reasons for Rejection during appeal proceedings do not occur so frequently.

Therefore, in the case of a Decision of Rejection, we would like to receive your instructions regarding the filing of an Appeal, and also regarding filing an Amendment, after your careful reconsideration, preferably one month before the deadline.

2. Design Law, Trademark Law:

Change of the term for filing an Appeal after receipt of a Decision of Rejection or a Ruling dismissing an Amendment

(Effective for applications, against which a Decision of Rejection/Ruling is received on or after 1 April 2009)

The above-mentioned term is changed from the current 90 days to **three months from the date of the receipt of the Decision of Rejection/Dismissal** (Japanese applicants: from 30 days to three months).

As before, amendments can be filed at any time while the Appeal is pending.

3. Patent Law:

Establishment of a system of registration of provisional exclusive licenses and provisional non-exclusive licenses

In order to support the granting of licenses and for the protection of licensees, the JPO has established a system of provisional exclusive/non-exclusive licenses, and of registering said licenses.

If such a license is registered with the JPO, the licensee can assert the contents of said license against a third party even when the object of a license contract is a still pending patent application. Further, in the case of bankruptcy of the licensor, the trustee in a bankruptcy cannot cancel the license contract.

Said provisional exclusive/non-exclusive licenses can be granted for the scope stated in the originally-filed description, patent claims, or figures.

When a patent, granted for the application in question has been registered, said provisional exclusive/non-exclusive licenses are considered as exclusive/non-exclusive licenses for the granted patent right.

The registration of an exclusive/provisional exclusive license at the JPO is a condition for its validity.

In case of a non-exclusive/provisional non-exclusive license, its registration is a condition for its assertability against third parties.

Applications for the registration of said provisional exclusive/non-exclusive licenses can be filed with the JPO from 1 April 2009 on.

For a normal case, the cost is JPY 65,000 (Official fees: JPY15,000, Attorneys fees: JPY 50,000).

4. Patent Law, Utility Model Law:

Restriction of access to the registered data of non-exclusive licenses, etc.

The existence and the contents of license agreements provide some hints regarding the research and development activities of companies, and are closely related to their business secrets and strategies.

In order to meet the growing need to not reveal such data externally, or to keep said data secret, the access to registered data of non-exclusive/provisional non-exclusive licenses, as it could be used to damage the interests of a licensee, will be restricted.

To be more precise, from 1 April 2009 on, registered information concerning the scope of a license, names of licensees, etc. can only be accessed by certain parties concerned, such as a successor to the corresponding right, an attaching creditor, the trustee in a bankruptcy of the licensor.

However, registered information as to licensee, scope etc. of exclusive/provisional exclusive licenses is, as before, completely available, since, due to the resulting strong right, bestowing exclusivity, this availability is regarded as being necessary.

5. Patent Law, Utility Model Law:

Increasing the number of Patent offices participating in the electronic exchange of priority documents

In this regard, the Japanese Patent Office is currently cooperating with the EPO (since January 1999), the Korean Patent Office (since October 2001) and the USPTO (since July 2007).

As a result, for applications claiming the priority of a European, Korean, or US* application it is not necessary to submit the priority document to the JPO when filing an application in Japan.

*only applicable if the US application has been published or form PTO/SB/39 has been submitted to the USPTO

The WIPO having agreed to an expansion of the structures for the international exchange of priority documents, in order to improve the administrative efficiency and convenience for applicants, Japan will, by 1 April 2009, extend the list of countries cooperating in the electronic exchange of priority documents.

We expect the JPO to announce more specific details by the end of March 2009.

We will inform you then in a subsequent letter.

6. Others:

Written Inquiries from the Board of Appeal

If an Amendment is filed along with (previously: within 30 days after) the Appeal against a Decision of Refusal, the amended application will be re-examined preliminarily by the former Examiner. If the refusal reasons are resolved the Examiner will then grant a patent. Only when the Examiner thinks that the amendment is not yet sufficient to overcome the refusal reasons, will he send the appeal case, along with his report, to the Department of Appeal. Said report will then be considered in the further examination by the Appeal Examiners.

To give the applicant another chance to express his opinion, and to make the work of the Appeal Examiners (who are confronted with an increasing number of Appeal trials) easier, the Appeal Examiners send the applicants the report of the former Examiner in a Written Inquiry, and ask for his opinion. In principle, such Written Inquiries shall be issued for all cases in which the Appeal Examination has begun by October 2008. Excluded are Applications for which an Accelerated Appeal Examination was requested, and cases in which an Inquiry is considered unnecessary because of the contents of the Examiner's report.

After receiving said Inquiry, the applicant can, in a Written Reply, express his arguments, said arguments being considered in the further Examination. It is, however, not possible to file an Amendment.

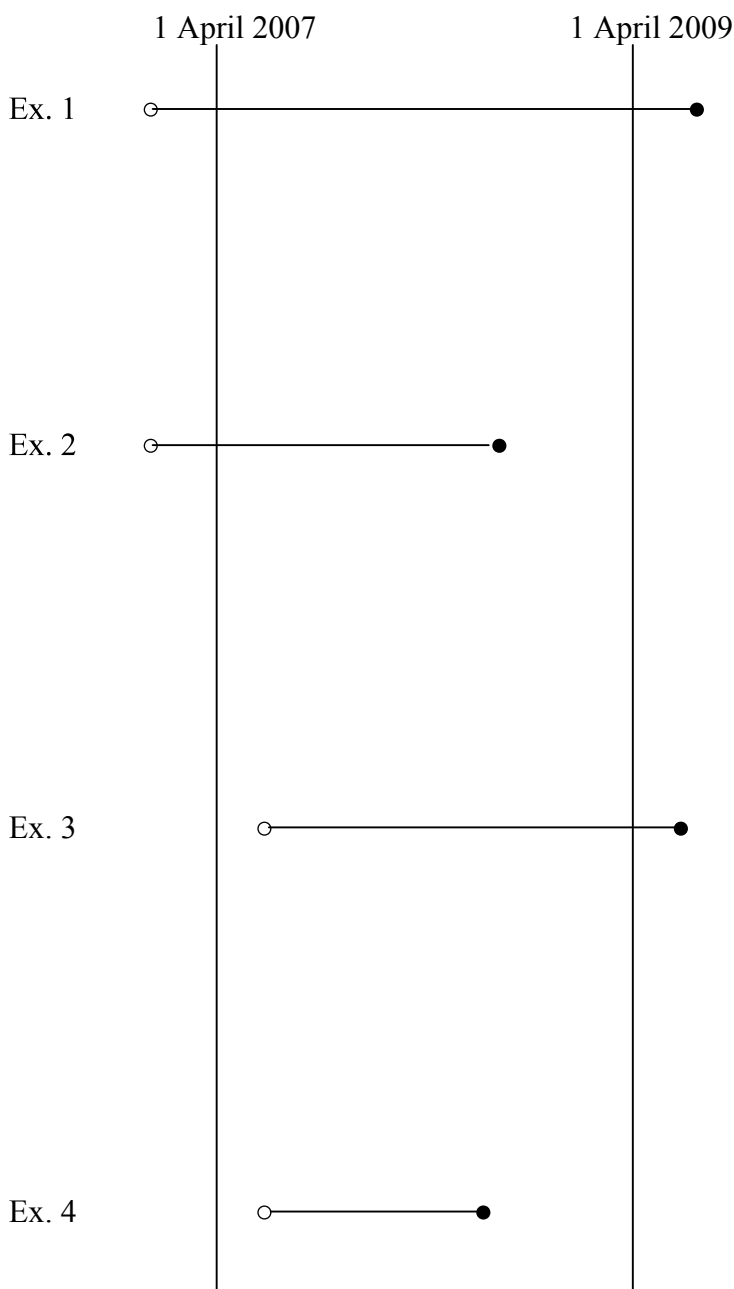
Draft amendments, provided with the Written Reply will not necessarily be considered in the further examination, but the Appeal Examiners will consider them at their discretion, if it is clear that a patent can be granted when a corresponding Amendment is filed.

If no Written Reply is filed, this fact itself shall be disadvantageous to the applicant.

If the Applicant, after considering the contents of the Inquiry, is of the opinion that it is not worthwhile to maintain the Appeal, the applicant is expected to withdraw the Appeal.

Terms for the filing of Appeals, Amendments, and Divisional Applications of **Patent Applications**
(for foreign applicants)

- Filing of the Application
- Receipt of a Decision of Refusal



Filing of an Appeal:
within 4 months from ●

Amendment:
only simultaneously with the Appeal (the next possibility would then be within the term to reply to a possible further Office Action* = 3 months (extendable for another 3 months))

Divisional Application:
same as Amendment

Filing of an Appeal:
within 90 days from ●

Amendment:
within 30 days after the Appeal (the next possibility would then be within the term to reply to a possible further Office Action* = 3 months (extendable for another 3 months))

Divisional Application:
same as Amendment

Filing of an Appeal:
within 4 months from ●

Amendment:
only simultaneously with the Appeal (the next possibility would be within the term to reply to a possible further Office Action* = 3 months (extendable for another 3 months))

Divisional Application:
within 4 months from ● (Appeal not necessary)

Filing of an Appeal:
within 90 days from ●

Amendment:
within 30 days after the Appeal (the next possibility would then be within the term to reply to a possible further Office Action* = 3 months (extendable for another 3 months))

Divisional Application:
same as Amendment, OR
if an Appeal is not filed, within 90 days from ●

*Since there is no guarantee that a further Office Action will be issued in the Appeal stage, we strongly recommend filing necessary Amendments/Divisional Applications along with the Appeal.