

## **ESAKI & ASSOCIATES**

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Tokyo, December 2021

### **Newsletter E-201**

We would like to inform you about the following changes in Japanese IP practice.

#### **I. Powers of Attorney**

Previously, only hand-signed powers of attorney in original were accepted by the JPO. Powers of attorney without a signature can now also be used, but the following should be noted:

1. Instead of a signature, the full name of an authorised representative must be indicated.
2. The date of issue must be stated in the power of attorney.
3. The JPO still requires the original of the power of attorney in paper form. Therefore, please enter the details mentioned in 1 and 2 above in an electronically editable form (MS-Word etc.) and then send it to us by e-mail. We will then print out the power of attorney here and submit this as the "original".

Please note that scans of powers of attorney that include stamps, handwritten changes (e.g. of names, dates, addresses, deletion of incorrect items, etc.) will not be accepted as "original" by the JPO and will be rejected.

#### **II. Confirmation of the identity of the signatories in assignment declarations etc.**

For assignment declarations, equity certificates, declarations of consent to assignments and other documents whose forgery would have a significant impact for the use in formalities carried out on or after 1 January 2022, only documents that allow a "confirmation of the identity of the signatories" are acceptable. (Hand-signed originals of these documents are required).

For this purpose, it is possible a) to indicate on the respective application form to be submitted to the JPO that a verification of the signatory's intentions has been carried out, b) to provide an assignment declaration with certification of the authenticity of the signature, or c) to provide another certification of the signature.

For options b) and c), notarial or other official certification is required, whereas in the case of a) official certification is not required.

Once we have received the client's confirmation in this regard, we would, in the case of option a), state in the application that "Mr. Koushi Esaki, Patent Attorney, as the Japanese representative, has ascertained (if necessary, through the representative there (name)) the intention in signing the transfer declaration etc. of (date), signed by (name)", which would validate the use of the transfer declaration etc. in the formalities.

### **III. Registration fees and annuities/renewal fees for patents and trademarks**

For registration fees and annuities/renewal fees for patents and trademarks paid on or after 1 April 2022, an increase of the official fees is intended, as shown in the attached list.

For payments made by 31 March 2022, the current fees will still apply.

#### Concerning the registration fees and annuities for patents:

It is possible to pay the fees for several years collectively.

In this case, we would reduce our usual fee of JPY20,000/year (charged if annuities are paid annually) for the additional years to JPY10,000/year.

#### Concerning the renewal of trademarks:

If the period within which renewal formalities are possible (=six months before the expiry date of the trademark) starts before or on 31 March 2022 and renewal is requested by 31 March 2022, the current official fees would apply for said renewal.

In this case, our fees will be JPY65,000 for one class and JPY10,000 for each additional class.

(If one or more classes are cancelled on renewal, we take the liberty of charging an additional JPY20,000 for this, irrespective of the number of classes to be cancelled).

In order to be able to pay registration fees, annuities for patents or apply for renewal of trade marks at the current more favourable official fees, should this be desired, please send us your instructions **by 21 March 2022**.

#### **IV. Further changes**

Please refer to the attached leaflet from the JPO.

If you have any questions, please do not hesitate to contact us.

## Revised Official Fees for payments made on or after 1 April 2022

### Patents

	Current Fee	Revised Fee
Registration fee (annuities for 1st – 3rd year)	JPY2,100 + (JPY200/claim)	JPY4,300 + (JPY300/claim)
Annuities for 4th – 6th year, per year	JPY6,400 + (JPY500/claim)	JPY10,300 + (JPY800/claim)
Annuities for 7th – 9th year, per year	JPY19,300 + (JPY1,500/claim)	JPY24,800 + (JPY1,900/claim)
Annuities 10th – 25th year, per year	JPY55,400 + (JPY4,300/claim)	JPY59,400 + (JPY4,600/claim)

### Trademarks

	Current Fee	Revised Fee
Registration fee	JPY28,200/class	JPY32,900/class
Installment payment (1 <sup>st</sup> half/ 2 <sup>nd</sup> half)	JPY16,400/class	JPY17,200/class
Renewal fee	JPY38,800/class	JPY43,600/class
Installment payment (1 <sup>st</sup> half/ 2 <sup>nd</sup> half)	JPY22,600/class	JPY22,800/class
Registration fee for defensive mark	JPY28,200/class	JPY32,900/class
Renewal fee for defensive mark	JPY33,400/class	JPY37,500/class

Triggered by the spread of the COVID-19 pandemic, ideal approaches to economic activities have dramatically changed as seen in digitalization, remote work and contact-less services. To address these changes, the Japan Patent Office (JPO) decided to revise the Patent Act and other Acts,\* placing emphasis on the following: **(1) developing new procedures (e.g., digitalization of procedures) to address the spread of the COVID-19 pandemic, (2) reviewing the protection of rights to address changes in corporate activities that accompany the advancement of digitalization and other technologies and (3) enhancing the foundation of the intellectual property systems, including reviews of procedures for litigation or fee structures.**

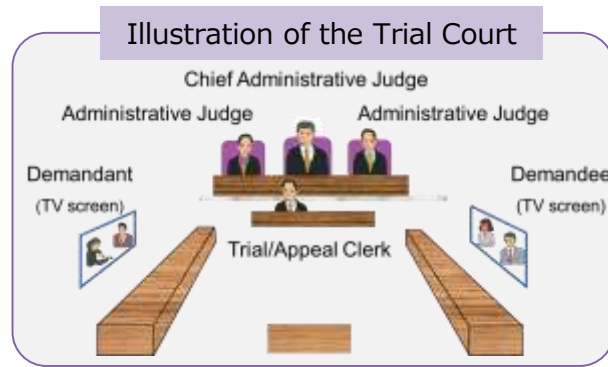
\* Patent Act (Patent), Utility Model Act (Utility), Design Act (Design), Trademark Act (Trademark), Act on Special Provisions of Procedures, etc. Concerning Industrial Property Rights (Industrial), Act on International Applications under the Patent Cooperation Treaty (International), Patent Attorney Act (Attorney)

## (1) Developing new procedures (e.g., digitalization of procedures) to address the spread of the COVID-19 pandemic

### ① Oral proceedings for trials or appeals by video conferencing

[Patent·Utility·Design·Trademark]

- ✓ In trials for invalidation of patents, etc., oral proceedings have been conducted by appearing in person in the Trial Court. This will become possible via **a video conference system** at the decision of the chief administrative judge.



### ② Abolition of the depositing of patent revenue stamps and the introduction of alternative means of fee payment

[Property]

- ✓ Allowing users to pay patent and other fees **in advance using bank transfers and other transfer methods (abolishment of advance payment by revenue stamps)** or using credit card and other means of payment at specific service counters

### ③ Digitization of international design and trademark applications

[Design·Trademark]

- ✓ Simplifying the procedures for informing applicants of the decisions on registration of their designs or trademarks filed as international applications (e.g., **allowing the JPO to electronically send** such notifications via the International Bureau instead of sending them by postal mail which may stop in response to the spread of the COVID-19 pandemic)

### ④ Exemption from surcharges due to processing periods expiring as a result of a disaster, etc.

[Patent·Utility·Design·Trademark]

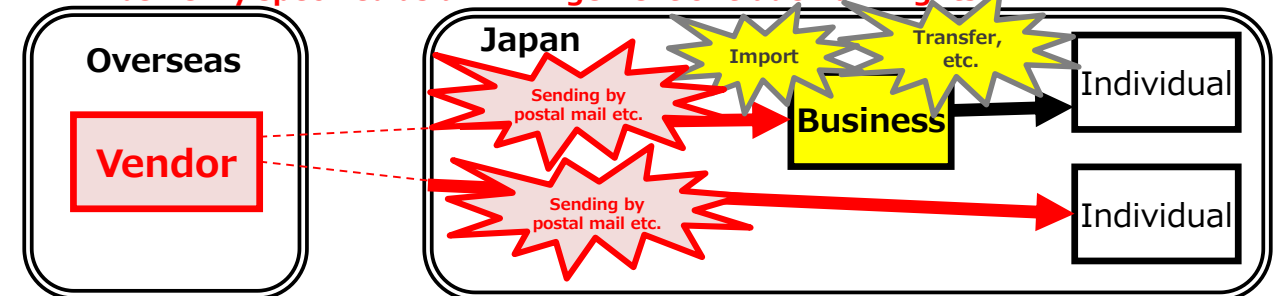
- ✓ If the payment for patent fees is overdue due to the spread of infectious diseases or a disaster, **additional surcharges will be exempted for the relevant period of time.**

## (2) Reviewing the protection of rights to address changes in corporate activities in line with the advancement of digitalization and other technologies

### ① Tightening regulations on the influx of counterfeit goods from overseas

[Design·Trademark]

- ✓ In response to increases in the importing of counterfeit goods for private use, **overseas vendors bringing counterfeit goods into Japan commercially via postal mail, etc. will be newly specified as an infringement of trademark rights.**



### ② Review of requirements for consent of non-exclusive licensees in trials for correction, etc.

[Patent·Utility·Design]

- ✓ Responding to the increasing complexity of patent-right licensing forms along with advancement of digital technologies, etc., **removing the requirement for licensors to gain consent from non-exclusive licensees (licensed persons) in correcting patent rights, etc.**

### ③ Relaxation of requirements for reinstatement of rights such as patent Rights

[Patent·Utility·Design·Trademark]

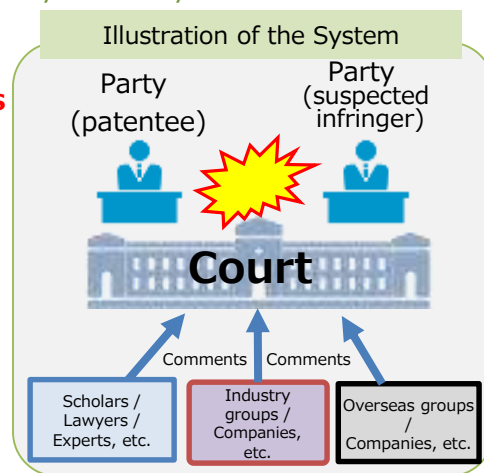
- ✓ **Relaxing the requirements for reinstatement of rights** which are lost due to the failure to comply with prescribed time limits

## (3) Enhancing the foundation of the intellectual property systems

### ① Introduction of a system for calling for third-party comments in patent infringement litigation, etc.

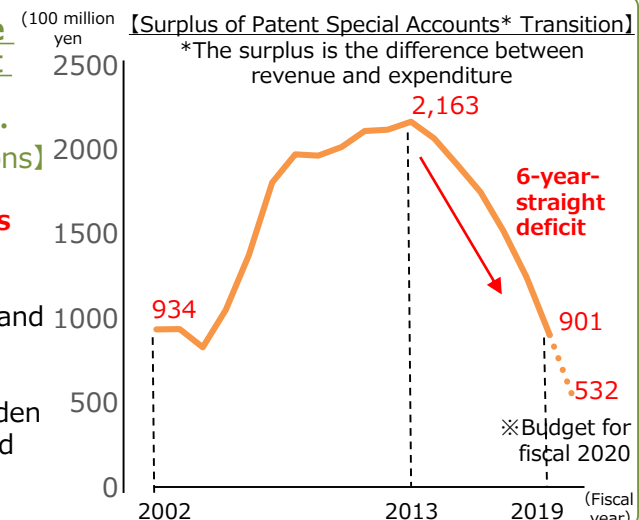
[Patent·Utility·Attorney]

- ✓ **Introduction of a system that allows courts to call for comments from a wide range of third parties** in patent infringement litigation, etc.
- ✓ Supplements of the collection of evidence by parties so that courts can make judgements based on a wide range of comments in cases which significantly impact society.
- ✓ Allows patent attorneys to respond to consultations under the system for calling for third-party comments.



### ② Review of the fee structure for patent fees, etc.

- ✓ **Revision of fee structures such as for patent fees** in order to secure the balance of income and expenditure in response to the increase in the burden of examinations and the digitization of procedures.



### ③ Review of the patent attorney system

- ✓ Addition of **the business of agriculture, forestry and fishery intellectual property** as those which can be conducted by patent attorneys
- ✓ **Change of the Japanese name of Patent Attorneys Offices to "Benrishi Hojin"**
- ✓ **Introduction of single person professional corporation system**