

Revision of Patent and Trademark Laws

As of 1 April 2016.

ESAKI & ASSOCIATES

TORANOMON DENKI BLDG.

8-1, TORANOMON 2-CHOME,

MINATO-KU, TOKYO, JAPAN

FAX: 81-3-3503-9577

81-3-3503-0238

TEL: 81-3-3502-1476

E-mail: reception@esakipat.co.jp

URL: <http://www.esakipat.co.jp>

Revision of Patent and Trademark Laws

The Patent Law and the Trademark Law have been revised and these went into effect on 1 April 2016.

We previously informed you about the revision of Article 35 of the Patent Law (revision of the Employee Invention System) in our circular E-195. Our summary of the other parts of the revision is as follows.

Revision of the Patent Law

The following procedures have been introduced by the revision of the Patent Law and the related regulations, practice and so on.

(1) Clarification of requirements for the according of filing date, and invitation to correct (Patent Law, Article 38-2)

Through this revision, the requirements for the according of the filing date of a patent application have been clarified. If these requirements are not fulfilled, the applicant will be invited to submit the required correction.

Excluding situations corresponding to any of the following: (i) where it is deemed that the indication of the intention to receive a patent is unclear, (ii) where it is deemed that there is no description of the name of the applicant or the description is unclear to the extent that the applicant cannot be identified, or (iii) when no Specification is submitted with the Request for Application, the date when the Request for Application for a patent is filed will be accorded as the filing date. However, even in the case of (iii), if, for example, a research paper is submitted with the Request for Application, the research paper will be treated as the Specification and thus the date of said filing will be accorded as the filing date, provided that the Request for Application describes other necessary information.

The JPO will notify the applicant in situations corresponding to any of (i) to (iii). The applicant can correct the situation within two months of the notification date (or the arrival date at the JPO of the application if the applicant voluntarily files a correction before receiving such a notification).

In principle, if corrected, the correction date will be accorded as the filing date. In addition, regardless of whether there was a notification, if no correction is made, the application will be dismissed.

(2) Patent application referring to a prior application (Patent Law Article 38-3)

A system has been introduced wherein the filing date is accorded, under certain conditions, if a patent application referring to one's own prior application is filed, even if a Specification is not filed.

It is possible to imagine the emergency use of an application with reference to a previous application in an emergency where an application must be filed without including the Specification in the application. For example, when it is necessary to secure the filing date before the deadline for claiming priority but the deadline for asserting the priority based on the Paris Convention is approaching in a few hours and an urgent order from abroad to file an application is received but the Specification is not available due to a fault in an email server.

(3) Correction of a missing part of the Specification or Drawings (Patent Law, Article 38-4)

A system has been introduced wherein it is possible to file a correction of a missing part of the Specification or Drawings included in a patent application within two months of the date of notification thereof by the JPO (or within two months of the arrival date at the JPO of the application if the applicant voluntarily files a correction before receiving such a notification).

(4) Relief in respect to designated time limits (Patent Law, Article 5, Paragraph 3)

It is now possible to request an extension of time limits designated by the provisions of the Patent Law (Article 5, Paragraph 1) even after the time limit has lapsed, within a certain time period.

(5) Notification after lapse of the time limit for submission of a translation of a foreign language application (Patent Law, Article 36-2, Paragraphs 3 and 4)

The current revision changes the submission deadline for translations of foreign language applications to within 1 year and 4 months from the filing date (or the priority date when a priority is claimed). (Before the revision: 1 year and 2 months from the filing date (or the priority date when a priority was claimed)).

The JPO will now notify the applicant if the translation of a foreign language application was not submitted by said submission deadline. The applicant can submit the translation within 2 months from the date of notification.

(6) Notification after lapse of the time limit for the submission of the priority certificate (Patent Law, Article 43, Paragraph 6 and 7)

It is now possible to submit the priority certificate for a patent application even after the lapse of the time limit for submission thereof within a given time period (2 months following the date of notification from the JPO).

※ A similar procedure has been introduced for utility model applications.

(7) Notification after lapse of time limit for notification of appointment of the patent administrator for an international patent application (Patent Law, Article 184-11, Paragraph 3, 4 and 6)

When an overseas resident does not appoint a patent administrator within a predetermined period of time for a PCT patent application which has entered the national phase, they will receive notification thereof from the JPO. The applicant can file the appointment within 2 months from the date of notification.

※ A similar procedure has been introduced for utility model applications.

(8) Direct procedures by overseas residents

Patent applications (excluding special applications, such as divisional applications etc.) can be filed even by overseas residents directly without depending on a patent administrator.

In addition, the yearly patent fees for the fourth year onwards can be paid directly even for overseas residents without depending on a patent administrator.

(9) Single application for patent transfer registration by one of the parties (Patent Registration Ordinance, Articles 18, 38)

On the condition that the prescribed documents are included, a single application by any one of the parties will be accepted for applications for registration of transfer etc. of patent rights.

In addition, the following procedures have changed.

(10) Languages for foreign language applications

Until now, only English has been recognized as a language for foreign language applications. After the revision, it is possible to make a foreign language application in “English and other foreign languages”. (Enforcement Regulations of the Patent Law, Article 25-4.)

(11) Term extensions for response to a Notification of Reasons for Refusal

Pre-revision: Single requests for one month term extensions were approvable and a maximum of three such requests could be made (the maximum extension hence being three months). These requests had to be made before the lapse of the response term.

Post-revision: Even after the lapsing of the term, it is possible to request a term extension.

(a) If a term extension request is made within the term

One request for a term extension of two months is approvable, and a further one month extension is approvable with a second request (both may be filed simultaneously).

(b) If a term extension request is made after the response term lapses

A two month term extension is approvable even after the lapsing of the term for response to the Notification of Reasons for Refusal, if the request is made within two months (in this case, a further one month term extension is not possible). However, the Official Fees for this are extremely expensive relative to a term extension made before the lapsing of the term.

Please note that the revision does not apply to terms for responding to a Notification of Reasons for Refusal subsequent to a request for appeal against a Decision of Rejection, in which case the pre-revision system will continue to apply.

Revision of Trademark Law

The summary of the procedures introduced by the current revision are as follows.

(1) Designated terms (Trademark Law, Article 5, Paragraph 3 applied mutatis mutandis to Article 77, Paragraph 1)

It is now possible to request an extension of terms designated by the provisions of the Trademark Law, even after the term has lapsed, within a certain period of time.

Pre-revision: Only a one month extension was possible (it was necessary to request the extension within the designated term).

Post-revision:

- (i) As before, a one month extension is possible if requested within the designated term.
- (ii) A two month extension of the designated term is possible within two months after the original designated term has lapsed (designated term + two months).
- (iii) If a one month extension as per (i) has been requested, an additional two month extension is possible if a request is made within two months after the lapsing of the one month extended term (in other words, in addition to the designated term, a

maximum extension of three months using a total of two extension requests is possible (designated term + one month + two months).

The new system is also applicable to international registrations using the Madrid Protocol. However, it is not applicable to designated terms for procedures regarding appeals or oppositions to registrations.

(2) Periods for various procedures

Even if the following designated terms for procedures cannot be complied with, the procedures are now possible within two months following said term.

- (i) For submission of certificate to have special provisions concerning time of filing applied (Trademark Law, Article 9, Paragraph 3)
- (ii) For submission of priority certificate (Trademark Law, Article 13)
- (iii) Relating to payment of registration fees (Trademark Law, Article 41, Paragraph 3)
- (iv) Relating to payment of first registration fee installment (Trademark Law, Article 41-2, Paragraph 3)
- (v) Relating to payment of defensive mark registration fee (Trademark Law, Article 65-8, Paragraph 4)

(3) Recovery of a trademark right after term for payment of second registration fee installment (Trademark Law, Article 41-3)

Even if it was not possible to comply with the term for making a delayed payment of the second installment of the registration fee and surcharge, if there is a legitimate reason for the non-compliance it is possible to recover the trademark right within two months of the day when the legitimate reason is no longer applicable and within 6 months following the lapse of the term for the delayed payment of the second installment with surcharge.

(4) Revision of Examination Guidelines for Trademarks

As of 1 April 2016, the Examination Guidelines for Trademarks have been extensively revised. For example, in addition to evaluation criteria for catchphrases, regarding trademarks whose distinctiveness has been acquired through use such as three dimensional trademarks which consist solely of shape etc., more moderate criteria relative to previously have been indicated for the determination of the identicalness of the trademark which is being applied for and of the trademark which has been used.

Please contact us if you require any clarification regarding the above described revision.

ESAKI & ASSOCIATES

TORANOMON DENKI BLDG.

8-1, TORANOMON 2-CHOME,

MINATO-KU, TOKYO, JAPAN

FAX: 81-3-3503-9577
81-3-3503-0238

TEL: 81-3-3502-1476

E-mail: reception@esakipat.co.jp

URL: <http://www.esakipat.co.jp>