

Japanese IP Laws revised partially in 2018

The Japanese Cabinet approved and established “Bill for the Act of Partial Revision of the Unfair Competition Prevention Act and the like” on 23rd of May 2018 and issued the bill on 30th of May 2018. The bill comprises Unfair Competition Prevention Act, Patent Law, Utility Model Law, Design Law and Trademark Law. We introduce main items of Japanese IP Laws partially revised in 2018.

Patent, Utility Model and Design Laws

Expansion of Grace period

Article about Grace period came into effect on the 9th of June 2018. With respect to Patent, Utility Model and Design applications **filed on or after 9th of June 2018**, grace periods were expanded from 6 months to 12 months. Such a new grace period is **not** applicable to applications **filed on or before 8th of June 2018**.

For this reason, when your invention, utility model or design was publicly disclosed on or before 8th of December 2017, applicant must file a patent, utility model or design application within 6 months after the date of disclosure by 8th of June 2018, because of no applicability of new grace period.

On the other hand, when your invention, utility model or design was publicly disclosed on or after 9th of December 2017, applicant must file a patent, utility model or design application within 12 months after the date of disclosure because of applicability of new grace period.

Trademark Law

Additional requirement for a divisional trademark application

Article about a divisional trademark application came into effect **on 9th of June 2018**. Until now, requirements for the divisional trademark application were as follows:

- 1) Original trademark application is under examination, appeal examination or re-examination.
- 2) Mark of the divisional trademark application is identical to the mark of the original one.
- 3) Goods or services designated in the divisional trademark application are a part of the goods or services in the original one.
- 4) The goods or services designated in the divisional trademark application are

excluded from the original one.

The additional requirement, namely fifth requirement is **to be paid a filing fee about the original trademark application**. When applicant has not paid the filing fee about the original one, the divisional trademark application deems to be improper.

Patent, Utility Model, Design and Trademark Laws

Expansion of procedure of IP dispute

The article will take effect **on 1st of July 2019**. When courts want to order to submit any documents of plaintiff or defendant, the courts can judge if the documents to be submitted after investigating the documents in non-public environment (in-camera system).

Non-disclosure of Judgement by Japan Patent Office

The article will take effect **on 1st of July 2019**. When documents about judgement by Japan Patent Office (hereinafter, "JPO") include any trade secrets, JPO can limit disclosure of the documents.

Reduction of Office Fees about small entities

The article will take effect **on 1st of April 2019**. When applicants are small entities, national organizations and Universities, following office fees are 50% or more discounted without filing any certifications. **On the other hand, fee for request for examination by no small entities will be up JPY 20000.**

- 1) Fee for request for examination
- 2) Issue fee
- 3) The 4th to 10th maintenance fees
- 4) Search, Transmittal and Preliminary examination fees about PCT application

Payment by Credit card

The article will take effect **on 1st of April 2019**. Applicants or IP rights owners can pay by using their credit cards.

Design Law

Automatic exchange system of priority document

It is unclear as of 1st of January 2019 when this article will take effect on. When a design application claiming priority is filed with a foreign IP office, applicant need to submit no priority document to the foreign IP office by requesting it to obtain electronic data on priority documents of the JPO through WIPO Digital Access Service (hereinafter referred to as "DAS"). With respect to a patent and a utility model, this system has been performed since March 2016.

Unfair Competition Prevention Act

New unfair competition prevention acts

- 1) The article will take effect on 1st of July 2019. Unfair obtaining, use and disclosure of big data or the like are positioned as acts of unfair competition. As a result, any victims can receive civil remedies by exercising the injunction claims or the like.
- 2) Until now, it has been positioned as an act of unfair competition to provide any devices capable of breaking a protective means like CODE. Providing any services capable of breaking the protective means will be also positioned as the act of unfair competition on and after 29st of November 2018.

Expansion of procedure of IP dispute

The article will take effect on 1st of July 2019. When courts want to order to submit any documents of plaintiff or defendant, the courts can judge if the documents to be submitted after investigating the documents in non-public environment (in-camera system).

Industrial Standardization Act

Expansion and strengthening of JIS

The article will take effect on 1st of July 2019. The Industrial Standardization Act was partially revised to newly categorize data and services as targets of standardization under the Japanese Industrial Standards (JIS). In addition, a paying penalty was strengthened. When any companies use mark of “JIS” without being officially certificated, they may be fined 100 million JP Yen (previously One million JP Yen) in maximum as a paying penalty.

Japanese patent attorney law

Expansion of the legal service area by Japanese patent attorney

The article will take effect on 1st of July 2019. Legal service area of Japanese patent attorney was expanded to include a legal service to support preparing the draft of Standards like “JIS” and the effective use of Data in view of intellectual properties.