

OVERVIEW OF THE REVISION OF JAPANESE PATENT LAW AND DESIGN LAW

Partial Revision of Patent Law

(1) Introduction of new system (inspection) which allows impartial technical expert to conduct on-site investigation (inspection)

By use of this system, when there is a high possibility of patent right infringement, an impartial technical expert may enter a factory or the like of an alleged infringer, may conduct an investigation necessary for proving the infringement of the patent right, and may submit a report to a court.

(2) Reconsideration of method of calculating damages incurred by infringement

(i) When an infringer obtains a profit by an infringement, under the existing patent law, damages are not permitted with respect to a portion of the infringement when the portion of the infringement exceeds the production capacity of the patentee. Under the revised patent law, with respect to the portion of the infringement where damages are not permitted, it is regarded that a license agreement is concluded between a patentee and the infringer, and the patentee can claim damages also with respect to the portion of the infringement.

(ii) In calculating the damages based on an amount corresponding to a license fee, the damages may be calculated by taking into account an amount which will be decided upon when negotiations are undertaken on the premise that the infringement of the patent right actually exists.

With respect to the paragraph (2), the revised articles are applied mutatis mutandis to the Utility Model Law, the Design Law and the Trademark Law.

Partial Revision of Design Law

(1) Expansion of articles protected by Design Law

An image which is neither recorded nor displayed on an article and a design of an exterior or an interior of a building are protected under the newly revised Design Law.

(2) Reconsideration of related design system

The related design system is a system which permits the registration of a design similar to a design for which a design application is filed by the design right owner or a registered design (principal design) of the design right owner.

The following revisions are made with respect to the related design system for expanding the protection by the Design Law to designs which are developed based on a consistent concept.

(i) Under the existing Design Law, a related design

application can be filed until the date on which the registration of a principal design is published (approximately 8 months). Under the revised Design Law, the period during which a related design application can be filed is extended to **a period within 10 years from the filing date of the principal design application.**

(ii) The registration of a design similar to just a related design is permitted.

(3) Amendment of duration of design right

The duration of a design right is amended from "20 years from the date of registration" to **"25 years from the filing date"**.

(4) Simplification of procedure for filing design application

(i) A collective application covering a plurality of designs is permitted.

(ii) Classification of Articles is abolished to allow an applicant to flexibly select and describe the name of an article.

(5) Expansion of provisions on indirect infringement

The indirect infringement is a system where a provisional or assisting behavior which has high probability of inducing an infringement is regarded as an infringement.

Under the revised design law, a subjective element such as "an alleged infringer knows that an article or the like is used for carrying out the design" is prescribed. With the introduction of this provision, it is possible to control the behavior where an infringing article is manufactured and imported in the form of disassembled constitutional parts for the purpose of avoiding control.

Other revisions

Some other systems are also introduced including a system which allows a public entity (a local government, a university or the like) who is the owner of a trademark right for an extremely famous registered trademark indicative of the public entity itself to grant a license to a third party based on the trademark right.

DATE OF ENFORCEMENT

This revision of the laws excluding some provisions shall come into force as from the date specified by a Cabinet Order no later than one year from the date of promulgation.