

Patents, trade marks, copyright and designs in Japan: overview

Hitomi Iwase, Yoko Kasai and Satoshi Yumura, Nishimura & Asahi

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PATENTS

1. What are the legal requirements to obtain a patent?

The requirements are:

- Novelty.
- Inventive step.
- Susceptibility to industrial application.
- Non-existence of a claim under a prior application.

2. What categories are excluded from patent protection?

Exclusions include:

- Ideas that do not use the laws of nature.
- Laws of nature themselves.
- Techniques.
- Unfinished inventions.
- Medical operation processes, and methods for the treatment or diagnosis of human beings.
- Matters liable to adversely affect public order, morality or public health.

3. Which authority registers patents? Does its website provide guidance on the application procedure?

The Japan Patent Office (JPO) registers patents. For guidance, see: www.jpo.go.jp.

4. On what grounds and when can third parties oppose a patent application?

Any person can anonymously provide information to the JPO to oppose an application. The grounds for providing information include:

- Lack of novelty or inventive step.
- Interference with another patent application that has an earlier priority date.
- Violation of claim clarity, enablement or written description requirements.
- Violation of conditions for an amendment during prosecution.

Under the Patent Act, any party can file with the JPO an opposition to a granted patent within six months after publication of the patent in the *Official Gazette*.

A party can file for an invalidation trial at any time. However, only interested parties have standing under the Patent Act.

5. When does patent protection start and how long does it last?

A patent is effective on registration and expires 20 years from the patent application filing date.

In the fields of pharmaceuticals and agrochemicals, the patent term can be extended by up to five years.

In addition, regardless of whether the patent is in the fields of pharmaceuticals and agrochemicals, the patent term can be extended for up to the period that it was unreasonably delayed by a JPO examination if either (and whichever is later):

- The patent is registered on or after five years from the date the patent application was submitted.
- Three years have elapsed from the date on which the request for examination of an application was filed.

6. On what grounds can a patent infringement action be brought?

The grounds include:

- **Direct infringement.** Producing, using, or assigning patented products or using patented methods.
- **Indirect infringement.** Producing or assigning products exclusively used for patented products or patented methods for commercial purposes.

7. Which courts deal with patent infringement actions? Is there a fast-track and/or a small-claims procedure?

The courts dealing with patent infringement are:

- The Tokyo and Osaka District Courts in the first instance.
- The Intellectual Property High Court as the appellate court.
- The Supreme Court in the last instance.

There is no fast-track or small-claims procedure for patent infringement actions.

8. What are the defences to patent infringement actions?

Defences include:

- Use for experimental or research purposes.
- Patent invalidity.
- Prior user's right.
- No infringement.
- Patent exhaustion.

9. What are the remedies in patent infringement actions?

Remedies include:

- Injunctions (including measures necessary to suspend and prevent infringement).
- Compensation for damage.
- Measures to restore credibility.

UTILITY MODELS

10. What are the legal conditions to obtain utility model protection?

See *Question 1*.

The level of technical complexity required for utility models is lower than that required for patents.

11. Which authority grants utility model protection? Does its website provide guidance on the application procedure?

The JPO registers utility models. For guidance, see: www.jpo.go.jp.

12. On what grounds and when can third parties oppose a utility model application?

Any person can anonymously provide information to oppose an application with the JPO. The grounds for providing information include:

- Lack of novelty or inventive step.
- Interference with another application that has an earlier priority date.

13. When does utility model protection start and how long does it last?

A utility model is effective on registration and expires ten years from the utility model application filing date.

14. On what grounds can a utility model infringement action be brought?

The grounds include:

- **Direct infringement.** Producing, using, or assigning products protected by a utility model.
- **Indirect infringement.** Producing or assigning products exclusively used for products protected by a utility model for commercial purposes.

15. Which courts deal with utility model infringement actions? Is there a fast-track and/or a small-claims procedure?

See *Question 7*.

There is no fast-track or small-claims procedure for utility model infringement actions.

16. What are the defences to utility model infringement actions?

Defences include:

- Use for experimental or research purposes.
- Utility model invalidity.
- Prior user's right.
- No infringement.
- Utility model exhaustion.

17. What are the remedies in utility model infringement actions?

See *Question 9*.

TRADE MARKS

18. What are the legal requirements to obtain a trade mark?

Any mark that consists of a character, figure, sign, three-dimensional shape, or colour, or any combination of them, or a sound, that is used in connection with goods or services for commercial purposes can be registered and protected under the Trade Mark Act.

19. Is it necessary or advisable to register trade marks?

Although unregistered marks can be protected under either or both the Unfair Competition Prevention Act and the Civil Code if they are widely recognised or well known, registration is advisable and necessary for protection under the Trade Mark Act.

20. Which authority registers trade marks? Does its website provide guidance on the application procedure?

The JPO registers trade marks. For guidance, see: www.jpo.go.jp.

21. On what grounds can the regulatory authority refuse to register a trade mark?

A trade mark can be refused registration on the grounds that it:

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- Has no distinctive character.
 - Is identical or similar to the mark of a national or international organisation.
 - Is identical or similar to a registered or well-known mark.
 - Is likely to cause confusion in connection with the goods or services pertaining to the business of another person.

22. On what grounds and when can third parties oppose a trade mark application?

Any person can anonymously provide information to oppose an application with the JPO. The grounds for providing information include all of the grounds for refusal of registration listed in *Question 21*.

Any party can file with the JPO an opposition to a trade mark registration within two months after publication of the trade mark in the *Official Gazette*.

Any interested party can file for an invalidation trial.

23. When does trade mark protection start and how long does it last?

Protection under the Trade Mark Act arises on registration and lasts for ten years. Registrations can be renewed indefinitely, by filing a renewal application and paying a fee.

24. On what grounds can a trade mark infringement action be brought?

Infringements include:

- Using a mark that is identical or similar to a registered trade mark, for a person's goods or services that are identical or similar to the designated goods or services.
- Possessing goods with a mark on the goods or packaging that is identical or similar to a registered trade mark, for the purpose of assignment.

25. Which courts deal with trade mark infringement actions? Is there a fast-track and/or a small-claims procedure?

The courts dealing with trade mark infringement are:

- The District Courts related to the case and the Tokyo and Osaka District Courts in the first instance.
- The High Courts with jurisdiction over the first instance courts, and the Intellectual Property High Court instead of the Tokyo High Court as the appeal court.
- The Supreme Court in the last instance.

There is no fast-track or small-claims procedure for trade mark infringement actions.

26. What are the defences to trade mark infringement actions?

Defences include:

- Using a person's own name or famous abbreviations.

- Not using the mark as a trade mark.
- Invalid right.
- Prior user's right.
- No infringement.

27. What are the remedies in trade mark infringement actions?

See *Question 9*.

COPYRIGHT

28. What is the scope of copyright protection?

Copyright is a property right granted to the author, and is an exclusive right to use a copyrighted work.

29. What categories of subject matter are eligible for protection?

The categories eligible for protection include:

- Literary works.
- Musical works.
- Choreographic works.
- Artistic works.
- Architectural works.
- Diagrammatical works.
- Cinematographic works.
- Photographic works.
- Computer programs.

30. Are moral rights protected?

Moral rights protected under the Copyright Act include the:

- Right to make the work public.
- Right to determine the indication of the author's name.
- Right to maintain the integrity of the work.

While there is a debate over whether a waiver of moral rights is valid, covenants not to exercise moral rights are common in practice and are generally considered valid.

31. What are the legal requirements to obtain copyright protection?

Copyright arises automatically on creation of a work in which thoughts are expressed in a creative way and which falls in the literary, academic, artistic or musical domain.

32. Can copyright be registered?

The author's name and first publication date of a copyrighted work, as well as assignment of the copyright, can be registered with the Agency for Cultural Affairs (or the Software Information Center (SOFTIC) for computer program registration). An assignment of copyright cannot be asserted against a third party unless it has been registered.

Registration must be made with the Agency for Cultural Affairs (www.bunka.go.jp/english/index.html) or SOFTIC (www.softic.or.jp/en/index.html) by submitting an application with supporting information. No guidance on applications is available in English on these websites.

33. When does copyright protection start and how long does it last?

Copyright protection starts from the creation of a work and continues for 70 years after the death of the author (for a cinematographic work, 70 years from publication).

34. On what grounds can a copyright infringement action be brought?

Grounds include:

- Infringement of rights of reproduction, recitation, and exhibition.
- Infringement of the author's moral rights.
- Deemed infringement, such as importing goods produced by infringing means for commercial purposes.

35. Which courts deal with copyright infringement actions? Is there a fast-track and/or a small-claims procedure?

See *Question 7*. For computer programs, see *Question 25*.

There is no fast-track or small-claims procedure for copyright infringement actions.

36. What are the defences to copyright infringement actions?

Defences include:

- Reproduction for private or citation use, non-commercial purposes, reporting a current event, or judicial proceedings.
- Non-infringement of the copyright.
- Exhaustion of the right.

37. What are the remedies in copyright infringement actions?

See *Question 9*.

REGISTERED DESIGNS

38. What are the legal conditions to obtain a registered design?

The conditions are:

- Industrial applicability.
- Novelty.
- Creativity.
- Distinctiveness and dissimilarity with any design previously filed.

39. Which authority registers designs? Does its website provide guidance on the application procedure?

The JPO registers designs. For guidance, see: www.jpo.go.jp.

40. On what grounds and when can third parties oppose a registered design application?

After the design has been registered, any person can file a request with the JPO for an invalidation trial.

41. When does registered design protection start and how long does it last?

Design protection arises on registration and lasts for 25 years from the application date.

42. On what grounds can a registered design infringement action be brought?

The grounds include:

- **Direct infringement.** Manufacturing or selling of a registered design or any similar design for commercial purposes.
- **Indirect infringement.** Producing or assigning any product to be used exclusively for the production of a product using a registered or similar design for commercial purposes. Manufacturing or importing a component may also be deemed indirect infringement in certain circumstances.

43. Which courts deal with registered design infringement actions? Is there a fast-track and/or a small-claims procedure?

See *Question 25*.

There is no fast-track or small-claims procedure for registered design infringement actions.

44. What are the defences to registered design infringement actions?

Defences include:

- Use for experimental or research purposes.

- Right is invalid.
- Prior user's right.
- Non-infringement.
- Exhaustion of the right.

45. What are the remedies in registered design infringement actions?

See *Question 9*.

UNREGISTERED DESIGNS

46. What are the legal conditions for unregistered design rights to arise?

Under the Unfair Competition Prevention Act, designs can be protected as a configuration of goods, which means the external and internal shape of goods and the pattern, colour, gloss, and texture combined with this shape, that can be perceived by consumers in normal use.

Designs in which thoughts or sentiments are expressed can also be protected under the Copyright Act. It is under discussion whether applied arts need to be more original than fine arts to be protected by the Copyright Act.

47. When does unregistered design protection start and how long does it last?

Protection under the Unfair Competition Prevention Act arises on creation and lasts for three years from the date the relevant article is first sold in Japan.

48. On what grounds can an unregistered design infringement action be brought?

An infringement action can be brought against any person acquiring, leasing or displaying for the purpose of assigning or leasing, or exporting/importing goods that imitate the configuration of another person's goods.

49. What are the defences to unregistered design infringement actions?

Defences include:

- No imitation.
- The configuration is indispensable for ensuring the function of the goods.
- Three years have passed since the goods were sold in Japan.
- Not knowing, and not being grossly negligent of, the fact that the goods imitate the configuration of another person's goods at the time the goods are acquired.

50. What are the remedies in unregistered design infringement actions?

See *Question 9*.

TRADE SECRETS AND CONFIDENTIAL INFORMATION

51. What are the legal conditions for rights in confidential information to arise?

To be protected under the Unfair Competition Prevention Act, a trade secret must be:

- Technical or business information useful for commercial activities (such as manufacturing or marketing methods).
- Kept secret.
- Not publicly available.

Confidential information that falls within the category of a trade secret can be protected as a trade secret under the Unfair Competition Prevention Act.

52. On what grounds can an action for unauthorised use of confidential information be brought?

Grounds for an action include:

- Acquiring, using or disclosing through wrongful acquisition.
- Acquiring, using or disclosing and knowing or being grossly negligent of the fact that the secret was acquired through improper means.
- Using or disclosing and knowing after acquisition or being grossly negligent of the fact that the secret was acquired through improper means.
- Using or disclosing a trade secret, disclosed by the business operator holding the trade secret, for the purpose of acquiring illicit gains or causing injury to the holder.
- Assigning, delivering, displaying for the purpose of assignment or delivery, exporting, importing or providing through a telecommunications line articles manufactured by using a technical secret that was acquired wrongfully, except when such actions are carried out by a person that did not know that the articles originated from wrongful acquisition, and was not grossly negligent in not knowing so at the time of receiving them.

53. Which courts deal with actions for unauthorised use of confidential information? Is there a fast-track and/or a small-claims procedure?

See *Question 25*.

There is no fast-track or small-claims procedure for actions for unauthorised use of confidential information.

54. What are the defences to actions for unauthorised use of confidential information?

Defences include:

- The alleged trade secret does not meet the requirements for protection (see *Question 51*).
- No unauthorised use.
- The trade secret was used or disclosed under a right acquired by the defendant.

55. What are the remedies in actions for unauthorised use of confidential information?

See *Question 9*.

Practical Law Contributor profiles

Hitomi Iwase

Nishimura & Asahi

T +81 3 6250 6218
F +81 3 6250 7200
E h_iwase@jurists.co.jp
W www.jurists.co.jp/en

Professional qualifications. Japan, Attorney-at-Law (*bengoshi*), 1997; New York State, US, Attorney-at-Law, 2004

Areas of practice. IP litigation; IP transactions; anti-counterfeiting/brand management; trade secrets/unfair competition; personal data and privacy; IT/cloud; telecommunication and media.

Languages. Japanese, English

Professional associations/memberships. Daiichi Tokyo Bar Association.

Yoko Kasai

Nishimura & Asahi

T +81 3 6250 6607
F +81 3 6250 7200
E yo_kasai@jurists.co.jp
W www.jurists.co.jp/en

Professional qualifications. Japan, Attorney-at-Law (*bengoshi*), 2009

Areas of practice. IP transactions; IP disputes; health care and life sciences regulatory issues; data security and privacy; international transactions; start-up businesses; general corporate.

Languages. Japanese, English

Professional associations/memberships. Daini Tokyo Bar Association.

Satoshi Yumura

Nishimura & Asahi

T +81 3 6250 6738
F +81 3 6250 7200
E s_yumura@jurists.co.jp
W www.jurists.co.jp/en

Professional qualifications. Japan, Attorney-at-Law (*bengoshi*), 2014

Areas of practice. IP disputes; IP transactions; health care and life sciences; civil and commercial disputes; trade secrets/unfair competition; brand management; start-up businesses; general corporate.

Languages. Japanese, English

Professional associations/memberships. Daini Tokyo Bar Association.