

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

Hiroshi Suga, Hitomi Iwase and Yoko Kasai
Nishimura & Asahi

global.practicallaw.com/5-501-5659

PATENTS

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

The requirements are:

- Novelty.
- Inventive step.
- Susceptible to industrial application.
- Not claimed in a prior application.

2. What categories are excluded from patent protection?

Exclusions include:

- Ideas in which the laws of nature are not used (excluding the laws of nature themselves).
- Techniques.
- Unfinished inventions.
- Medical operation processes, 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) (*see box, The regulatory authority*). For guidance, see www.jpo.go.jp/.

A patent application may be refused by the JPO on the following grounds:

- 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.
- Falsification of inventorship.

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

Any person can anonymously provide information to oppose an application with the JPO.

Under the Patent Act (amended in May 2014), any party can file an opposition to granted patents within six months after issuance of the official gazette for the patent with the JPO. The grounds for opposition include all of the grounds of refusal listed in *Question 3*, except falsification of inventorship.

A party can file an application for an invalidation trial at any time. However, only interested parties have standing under the amended 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 field of pharmaceuticals and agrochemicals, the patent term can be extended by a period not exceeding five years.

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

The grounds are:

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

7. Which courts deal with patent infringement actions?

The courts dealing with patent infringements are:

- The Tokyo/Osaka District Court in the first instance.
- The Intellectual Property High Court as the appeal court.
- The Supreme Court in the last instance.

8. What are the defences to patent infringement actions?

Defences include:

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

9. What are the remedies in patent infringement actions?

Remedies include:

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

10. Is there a fast-track and/or a small-claims procedure for patent infringement actions?

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

TRADE MARKS

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

The mark may be any character(s), figure(s), sign(s), three-dimensional shape(s), colour(s) or any combination of them, or sound(s) or any other form as provided by Cabinet Order, as recognised by a person's perception, that is used in connection with the goods or services for commercial purposes.

The mark must not be identical or similar to any previously filed mark.

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

Although unregistered marks can be protected under the Unfair Competition Prevention Law and/or the Civil Code if it is widely-recognised or well-known, registration is necessary and advisable for protection under the Trademark Act.

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

The JPO registers trade marks. Guidance can be found on its website (*see www.jpo.go.jp*).

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

Grounds for refusal include:

- No distinctive character.
- Identical or similar to the mark of a national or international organisation.
- Identical or confusingly similar to a registered or well-known mark.

15. 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. After the trade mark has been registered, any person can file a request for an invalidation trial.

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

Protection under the Trademark Act arises on registration and lasts ten years. Registrations can be renewed any number of times, by filing a renewal application and paying a fee.

17. On what grounds can a trade mark infringement action be made?

Infringing actions include:

- Using a mark that is identical or similar to a registered trade mark, for a person's 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, and so on.
- Possessing or importing articles affixed with a mark that is identical/similar to a registered trade mark.

18. Which courts deal with trade mark infringement actions?

The courts dealing with trade mark infringements are:

- The District Courts related to the case and the Tokyo/Osaka District Court 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.

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

Defences include:

- Using a person's own name, famous abbreviations, and so on.
- Right is invalid.
- Prior user's right.
- Denial of infringement.
- Exhaustion of the right.

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

Remedies include:

- Injunctions.
- Compensation for damage.
- Measures to restore credibility.

21. Is there a fast-track and/or a small-claims procedure for trade mark infringement actions?

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

COPYRIGHT

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

Copyright arises automatically on a production of thoughts or sentiments that are expressed in a creative way, and which fall in the literary, scientific, artistic or musical category.

23. Can copyright be registered?

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

Registration must be made to 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.

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

The duration starts at the time of creation of the work, and continues for 50 years following the death of the author (for a cinematographic work, 70 years from publication).

25. On what grounds can a copyright infringement action be made?

Grounds include:

- Infringement of rights of reproduction, recitation, exhibition, and so on.
- Infringement of the author's moral rights.
- Deemed infringement, such as importing goods made by an infringing act supposedly when it occurred for commercial purposes, and so on.

26. Which courts deal with copyright infringement actions?

For computer programs, see *Question 18*.

27. What are the defences to copyright infringement actions?

Defences include:

- Reproduction for private or citation use, non-profit making purposes, reporting a current event, judicial proceedings, and so on.
- The copyright is not infringed.
- Exhaustion of the right.

28. What are the remedies in copyright infringement actions?

Remedies include:

- Injunctions.
- Compensation for damage.
- Measures to restore credibility.

29. Is there a fast-track and/or a small-claims procedure for copyright infringement actions?

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

REGISTERED DESIGNS

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

The conditions are:

- Industrial applicability.
- Novelty.
- Creativity.
- Not identical or similar to any design previously filed.

31. Which authority registers designs?

The JPO registers designs. Guidance can be found on its website (*see www.jpo.go.jp*).

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

Any person can anonymously provide information to oppose an application with the JPO. After the design has been registered, any person can file a request with the JPO for a right invalidation trial.

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

The protection arises on registration, and lasts 20 years.

34. On what grounds can a registered design infringement action be made?

The grounds are:

- **Direct infringement.** Manufacturing, selling and so on of a registered design or any similar design for commercial purposes.
- **Indirect infringement.** Producing, assigning and so on any product to be used exclusively for the production of a product, using a registered or similar design for commercial purposes. Possessing a product using a registered or similar design for the purpose of assigning, leasing or exporting it for commercial purposes.

35. Which courts deal with registered design infringement actions?

See *Question 18*.

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

Defences include:

- Use for experimental or research purposes.
- Use of vessels or aircraft merely passing through Japan and products existing in Japan before filing of the patent application.
- Right is invalid.
- Prior user's right.
- No infringement.
- Exhaustion of the right.

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

Remedies include:

- Injunctions.
- Compensation for damage.

38. Is there a fast-track and/or a small-claims procedure for registered design infringement actions?

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

UNREGISTERED DESIGNS

39. 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.

If a design is very distinctive and well-known, it can also be protected under the Copyright Act.

40. 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 time the relevant item is first sold in Japan.

41. On what grounds can an unregistered design infringement action be made?

Acquiring, leasing, displaying for the purpose of assigning or leasing, and exporting or importing goods which imitate the configuration of another person's goods.

42. 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.

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

Remedies include:

- Injunctions.
- Compensation for damage.

CONFIDENTIAL INFORMATION

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

A trade secret that is technical or business information useful for commercial activities (such as manufacturing or marketing methods) that is kept secret and not publicly known is protected under the Unfair Competition Prevention Act. If confidential information falls within the category of a trade secret, it can be protected as a trade secret under the Unfair Competition Prevention Act.

45. On what grounds can an action for unauthorised use of confidential information be made?

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 wrongful means.
- Using or disclosing and knowing after acquisition or being grossly negligent of the fact that the secret was acquired through wrongful means.
- Using or disclosing a trade secret, disclosed by the business operator holding the trade secret, for the purpose of unfair

business competition or otherwise acquiring illicit gains, or causing injury to the holder.

- Using or disclosing and knowing after acquisition or being grossly negligent of the fact that the secret was disclosed through wrongful means.
- Using or disclosing in breach of a contractual obligation.

46. Which courts deal with actions for unauthorised use of confidential information?

See *Question 18*.

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

Defences include:

- The alleged trade secret does not meet the requirements (*see Question 44*).

- No infringement.
- The trade secret was used or disclosed under of a right acquired by the defendant.

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

Remedies include:

- Injunctions.
- Compensation for damage.

49. Is there a fast-track and/or a small-claims procedure for actions for unauthorised use of confidential information?

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

THE REGULATORY AUTHORITY

Japan Patent Office (JPO)

W www.jpo.go.jp

Main areas of responsibility. Patents, utility models, designs and trade marks.

Guidance on application procedure. The following is available:

- Outline of right acquisition.
- Free access to IPR Gazettes in the Patent Office database.
- Summary of IP laws.
- Schedule of fees.
- Examination guidelines.

Practical Law Contributor profiles



Hiroshi Suga

Nishimura & Asahi

T +81 3 5562 9017

F +81 3 5561 9711

E h_suga@jurists.co.jp

W www.jurists.co.jp/en

Professional qualifications. Japan, Attorney-at-Law (*bengoshi*), 1993

Areas of practice. General corporate; IP disputes; IP licences; anti-trust; M&A start-up businesses; labour law; civil and commercial disputes.

Recent transactions

- Successfully represented a household equipment manufacturer, a software manufacturer and an electronic device manufacturer in litigations and disputes regarding patent validity and infringement.
- Representing an international software company and a social game manufacturer in litigations regarding program copyright infringement.
- Represented and won various infringement litigations regarding software patents, copyrights in picture books and famous unregistered trademarks, including the first case adjudicated by the Grand Panel of the IP High Court of Japan (www.ip.courts.go.jp/eng/documents/pdf/g_panel/decision_summary2005ne10040.pdf).

Languages. Japanese and English

Professional associations/memberships. Daini Tokyo Bar Association.

Publications. Intellectual Property Law Guide 2013/14, LexisNexis Jan 2014; International eCommerce Business and Legal Issues, CH Japan Limited Mar 2001.



Yoko Kasai

Nishimura & Asahi

T +81 3 5562 8871

F +81 3 5561 9711

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; pharmaceutical regulatory issues; privacy/data security; international transactions; general corporate.

Recent transactions. Advising international pharmaceutical and medical device companies on patent licensing transactions.

Languages. Japanese and English

Professional associations/memberships. Daini Tokyo Bar Association.



Hitomi Iwase

Nishimura & Asahi

T +81 3 5562 8518

F +81 3 5561 9711

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 transactions; IP disputes; IP Finance; venture capital/entrepreneurial services; privacy/data security; international transactions; general corporate; start-up businesses.

Recent transactions

- Advising one of the major Japanese publishing companies on licensing transactions in various countries.
- Assisting and advising domestic and international companies, including start-up and mid-sized venture companies, on financing using their IPRs as well as development of IP portfolios and prosecution strategies.

Languages. Japanese and English

Professional associations/memberships. Daiichi Tokyo Bar Association.