

TOPIC

Regarding the revision of the Japanese Industrial Property Law to take effect on April 1, 2009
2009年4月1日施行の改正特許法等について

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Introduction

はじめに

Japanese Industrial Property Law was revised in 2008 concerning the following five items. While items 4 and 5 have already been enforced (item 4 on June 1, 2008 and item 5 on January 1, 2009), items 1 to 3 are scheduled to take effect on April 1, 2009. We would like to introduce them briefly.

Revised items:

1. Reconsideration of the registration system for non-exclusive license (Patent Law, Utility Model law).
2. Extension of the period to file a request for appeal (Patent Law, Design law, Trademark Law).
3. Expansion to additional countries of the electronic exchange system of priority documents (Patent Law, Utility Model Law).
4. Reduction of the official fees for patent and trademark (Patent Law, Trademark Law).
5. Introduction of a bank transfer system for the payment of official fees (Law concerning the Special Provisions to the Procedure related to Industrial Property Rights).

2008年度特許法等の一部を改正する法律により、下記5項目について改正が行われました。今回は、下記1～3が2009年4月1日に施行されることに伴い、これら3つの事項に関する概略を掲載致します。

なお、下記4については2008年6月1日に、下記5については2009年1月1日より施行されております。

改正項目

1. 通常実施権等登録制度の見直し(特許法・実用新案法)
2. 不服審判請求期間の拡大(特許法・意匠法・商標法)
3. 優先権書類の電子的交換の対象国の拡大(特許法・実用新案法)
4. 特許関係料金・商標関係料金の引下げ(特許法・商標法)
5. 料金納付の口座振替制度の導入(工業所有権に関する手続等の特例に関する法律)

Reconsideration of the registration system for non-exclusive license 通常実施権等登録制度の見直し

1. Issues with the current system

(1) Under the current system, exclusive and non-exclusive licenses can only be registered in relation to a patent right; they cannot be registered during the application stage.

(2) Under the current system, the particulars of all registered non-exclusive licenses are made public.

Accordingly, it is not possible to keep confidential the particulars of a non-exclusive license that relate to trade secrets.

2. Outline of the revision

(1) The possibility to register provisional exclusive and non-exclusive licenses during the application stage will be introduced. Further, a registration system of the rights related to provisional licenses will be established, thus making it possible to exert a countervailing effect on third parties by registering a license in relation to a patent application (Articles 27(1)(iV), 34-2 and 34-3 of the Patent Act).

(2) The revision will also make it possible to limit the level of disclosure of the particulars of non-exclusive licenses. In concrete terms, the registered particulars of a non-exclusive or provisional non-exclusive license likely to cause damage to the non-exclusive licensee if disclosed to third parties will only be disclosed to the parties concerned (Article 186(3) of the Patent Act, Article 55(1) of the Utility Model Act). In the case of exclusive licenses and provisional exclusive licenses, however, the totality of the registered particulars will be disclosed, in line with previous practice.

1. 現行制度の問題

(1)現行制度では、特許権を対象とする専用実施権及び通常実施権のみ登録が可能であり、出願段階におけるライセンスは登録できない。

(2)現行制度では、登録された通常実施権等はその登録事項が公示される。そのため、営業秘密等に関する登録事項を秘匿することができない。

2. 改正の概要

(1)出願段階におけるライセンスを対象とする仮専用実施権及び仮通常実施権を設ける。また、これらの権利の登録制度を設け、登録により第三者対抗力を備えることとする(特許法第27条第1項第4号、第34条の2及び第34条の3等)。

(2)通常実施権等に係る登録事項の開示制限を可能とする。具体的には、通常実施権及び仮通常実施権に係る登録事項のうち、それを対外的に開示することで通常実施権者等の利害を害するおそれがある事項について、利害関係人へのみ開示する制度を設ける(特許法第186条第3項、実用新案法第55条第1項)。

なお、専用実施権及び仮専用実施権についてはすべての登録事項が対外的に開示される。

Extension of the period for demanding an appeal
拒絶査定不服審判請求期間の拡大

1. Scope of the revision

This extension will apply to all cases regarding which the certified copy of a Decision of refusal was sent by the JPO on or after April 1, 2009.

2. Issues with the current system

Under the current system, appeals against a Decision of refusal may be filed within 30 days after the sending date of the Decision of refusal. However, the term of 30 days has been judged too short to enable applicants to study sufficiently whether the filing of an appeal is pertinent or not, which results in a number of appeals being filed in a last-minute rush.

Further, in the case of patent, it has been judged that the possibility to amend the application documents within the 30 days following the filing of an appeal against a Decision of refusal also results in the filing of a number of appeals in a last-minute rush.

3. Outline of the revision

(1) Regarding Patent Law

The period for requesting an appeal against a Decision of refusal will be extended to "within 3 months from the sending date of the certified copy of the Decision of refusal" for applicants residing in Japan, and to "within 4 months from the sending date of the certified copy of the Decision of refusal" for applicant residing outside Japan (Article 121(1) of the Patent Act).

It will only be possible to make amendments to the application documents at the time of filing of the appeal against the Decision of refusal, as described above (Article 17-2(1)(iv) of the Patent Act).

(2) Regarding Design Law and Trademark Law

The period for demanding an appeal against a Decision of refusal will be extended to "within 3 months from the sending date of the certified copy of the Decision of refusal", both for applicants residing in Japan and for applicants residing outside Japan (Article 46(1) of the Design Act, Article 44(1) of the Trademark Act).

Also, the period for requesting an appeal against a Decision to dismiss the amendment will be extended to "within 3 months from the sending date of the certified copy of the Decision of refusal", both for applicants residing in Japan and for applicants residing outside Japan (Article 47(1) of the Design Act, Article 45(1) of the Trademark Act).

Contrary to the patent system, the period in which the applicant can amend a design or trademark application has not been revised. As such, amendments can be made when the case is pending, as provided by the related laws (Article 60-3 of the Design Act, Article 68-40 of the Trademark Act)

1. 適用対象

2009年4月1日以降に拒絶査定謄本が送達された案件について適用される。

2. 現行制度の問題点

現行制度では、拒絶査定不服審判は、拒絶査定謄本の送達日から30日以内に請求できる。しかし、30日との期間が短く、審判請求の当否について十分な検討ができないまま、駆け込み的な審判請求も行われていると考えられる。

さらに、特許の場合には、拒絶査定不服審判請求後30日以内に明細書等の補正が可能であることも、上記駆け込み的な審判請求をより助長しているとも考えられる。

3. 改正の概要

(1)特許法について

拒絶査定不服審判の請求期間を、拒絶査定謄本の送達日から3月(在外者の場合は4月)以内とする(特許法第121条第1項)。

拒絶査定不服審判請求に伴う明細書等の補正時期を、上記審判請求と同時のみ可能とする(特許法第17条の2第1項第4号)。

(2)意匠法・商標法について

拒絶査定不服審判の審判請求期間を拒絶査定謄本の送達日から3月(在外者の場合も3月)以内とする(意匠法第46条第1項、商標法第44条第1項)。

また、補正却下不服審判の請求期間も補正却下決定謄本の送達日から3月(在外者の場合も3月)以内とする(意匠法第47条第1項、商標法第45条第1項)。

補正期間については特許と異なり改正されず、法の定める事件の係属中は補正が可能である(意匠法第60条の3、商標法第68条の40)。

Expansion to additional countries of the electronic exchange system of priority documents 優先権書類の電子的交換の対象国の拡大

1. Scope of the revision

This revision will apply to all patent or utility model applications filed on or after April 1, 2009.

2. Issues with the current system

When claiming a priority under the Paris convention, the applicant must submit the related priority documents in countries other than the country where the first application was filed (priority country).

Following the development of information and communications technology, the exchange of priority documents in electronic format has become possible. In this regard, however, the priority documents accepted in electronic format by the JPO under the current system are restricted to the priority documents that have been digitized in the priority country.



3. Outline of the revision

With the ambition to contribute to the establishment of a worldwide electronic exchange system of priority documents, the Japan Patent Office will, thanks to the revision, be able under certain conditions to handle from April 1, 2009 the electronic data of priority documents digitized by international organizations or in a country other than the priority country (Patent Act Section 43(5)), in addition to the electronic data of priority documents digitized in the priority country.

1. 適用対象

2009年4月1日以降に特許出願又は実用新案登録出願を行った案件について適用される。

2. 現行制度の問題点

出願人が、パリ条約による優先権を主張する場合、その優先権書類を、最初に出願した国(第一国)以外の国に提供する必要がある。そして、情報通信技術の発展に伴い、この優先権書類の電子的な交換(優先権書類データの交換)が可能となっている。

これに関し、現行制度では、優先権書類データの取得は、第一国等で電子化された優先権書類データのみ限定されている。

3. 改正の概要

優先権書類の電子的な交換を世界的に実現するために、第一国等のみならず、その他の国や国際機関で電子化された優先権書類データも取得可能とする(特許法第43条第5項)。



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Please contact us if you have any comments or require any information.

Please acknowledge that the purpose of our column is to provide general information on the field of intellectual property, and that the description here does not represent our legal opinion on a specific theme.

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