Regarding the revision of the Japanese Industrial Property Law to take effect on April 1, 2009

1. Introduction

2. Reconsideration of the registration system for non-exclusive license

3. Extension of the period for demanding an appeal

4. Expansion to additional countries of the electronic exchange system of priority documents

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).
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).
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. 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日以降に拒絶査定の Shirou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 Shirou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. 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に限定されている。

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）。
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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