



July 2018

JAPAN

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WORLD PATENT & TRADEMARK
INTELLECTUAL PROPERTY LAW FIRM







#### TOPIC

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Bill Partially Revising Unfair Competition Prevention Law, etc. 不正競争防止法等の一部を改正する法律

A bill partially revising the Unfair Competition Prevention Law, etc. was promulgated on May 30, 2018. With the exception of some stipulations, the bill will be enacted within 18 months from the date of promulgation. Please refer to the following for an outline of the major revisions.

#### 1. Patent Law

- (1) Extension of Period for Exception to Lack of Novelty
- (2) Expansion of Patent Fee Reduction Measures for Small and Medium-sized Enterprises

  Owners of small and medium-sized enterprises, research and testing institutes etc. (summarized in Art. 109bis) and other persons stipulated by government ordinance may receive reductions to or exemptions from examination fees.



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Also, said persons may similarly receive fee reductions or exemptions, or postponements to payment of patent fees from the first up to the tenth year. For an outline of the simplifications made to procedures, please see our April 2018 Newsletter.

#### (3) Undisclosed Procedures

In order to judge whether or not documents are necessary as evidence of infringement etc. in infringement lawsuits, the court is able to demand the submission of said documents by their owner. If required, the court is also able to disclose said documents to expert committee members with the consent of the person(s) concerned.

(4) Restrictions on Viewing of Documents in Connection with the Judgment System of the JPO that Contain Industrial Secrets

If person(s) concerned submit a statement in which it is written that documents in connection with a judgement contain industrial secrets, and the JPO concludes that it is necessary to maintain those secrets, it will not be possible to request issuance of said documents in connection with the judgement.

#### 2. Design Law

- (1) Extension of Period for Exception to Lack of Novelty
- (2) Introduction of Electronic Exchange System for Priority Documents

  It will be possible to use the electronic exchange system in the case of design applications. The same will be true for design applications under the Hague Agreement.
- (3) Restrictions on Viewing of Documents in Connection with the Judgment System of the JPO that Contain Industrial Secrets

Identical to point (4) above concerning patents.

#### 3. Trademark Law

- (1) Normalization of Application Procedures for Trademarks
- (2) Restrictions on Viewing of Documents in Connection with the Judgment System of the JPO that Contain Industrial Secrets

Identical to point (4) above concerning patents.

#### 4. International Application Law

Persons who make international applications in the Japanese language and who are owners of small or medium-sized enterprises or research and testing institutes etc. (see Art. 109bis) and other persons stipulated by government ordinance may receive reductions to or exemptions from international filing fees.

#### 5. Unfair Competition Prevention Law

(1) Undisclosed Procedures

Identical to point (3) above concerning patents.



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#### (2) Expansion of types of unfair competition

The illicit acquisition, use or publication of data provided to a limited audience (data that is amassed in sufficient quantities on a computer etc. and provided professionally to specific persons, but which is not handled as secret) has been added to types of unfair competition activities, and can be made subject to civil redress such as injunctions.

Also, the handing over of devices, storage media containing programs or machinery that prevents the effectiveness of technical restrictions methods such as encryption, as well as the provision of such programs via the internet are made unfair competition. This revision to the law also makes the provision of services that prevent the effectiveness of such restrictions unfair competition.

#### 6. Industrial Standardization Law

- (1) The name of law will be changed to Industrial Standardization Law.
- (2) The maximum fine for entities etc. that display uncertified JIS marks will be raised to 100,000,000 yen.

#### 7. Patent Attorney Law

- (1) Addition of work as representative etc. in out-of-court dispute resolution procedures in specified unfair competition cases regarding technical data
- (2) Addition of work as representative etc. regarding finalization of sales contacts regarding technical data
- (3) Addition of work concerning consultations and involvement in drafting proposals for Japanese industrial standards, etc.

不正競争防止法等の一部を改正する法律が、2018年5月30日に公布された。一部の規定を除き、公布の日から18か月以内に施行される。主な改正概要は下記のとおりである。

#### 1. 特許法

- (1) 新規性喪失の例外期間の延長
- (2) 中小企業の特許料軽減措置の拡大

中小企業者、試験研究機関等(109条の2に集約)その他政令で定める者は、審査請求料の軽減または免除の対象となり得る。

また、同様に、1~10年分までの特許料の軽減、免除または納付猶予の対象となり得る(なお、手続の簡素 化の概要については当所ニュースレター2018年4月号に掲載しています)。

#### (3)インカメラ手続

侵害訴訟において侵害行為の立証等のため必要な書類か否かを判断するために、判所は書類の所持者にその提示を求めることができる。裁判所は、必要があれば当事者の同意を得て、提示された書類を専門委員に開示できる。

(4) 特許庁による判定制度の関係書類に営業秘密が記載されている場合の閲覧制限 当事者から判定関係書類に営業秘密が記載されているとの申出があった場合で、特許庁が秘密を保持する



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必要があると判断する場合は、判定関係書類の交付請求ができない。

#### 2. 意匠法

- (1) 新規性喪失の例外期間の延長
- (2)優先権証明書の電子交換制度の導入 意匠出願においても電子交換制度が利用できるようになる。ハーグ協定に基づく意匠出願についても同様
- (3) 特許庁による判定制度の関係書類に営業秘密が記載されている場合の閲覧制限 上記「特許法」と同様。

#### 3. 商標法

- (1) 商標出願手続きの適正化
- (2) 特許庁による判定制度の関係書類に営業秘密が記載されている場合の閲覧制限 上記「特許法」と同様。

#### 4. 国際出願法

日本語でされた国際出願をする者で、中小企業者、試験研究機関等(特許法109条の2) その他政令で定める者は、国際出願手数料の軽減または免除の対象となり得る。

#### 5. 不正競争防止法

(1)インカメラ手続

上記「特許法」と同様。

(2) 不正競争類型の拡大

限定提供データ(業として特定者に提供する情報としてコンピュータ等に相当量蓄積され管理された情報で、 秘密管理されていないもの)の不正取得、使用、開示を不正競争行為に追加し、差止め等の民事上の救済対 象とする。

また、暗号等の技術的制限手段による効果を妨げる装置・プログラムの記録媒体・機器の譲渡やプログラ ムのネット提供行為は不正競争とされていた。今回の改正では、これに加え、同効果を妨げる役務の提供 も不正競争に加えられた。

#### 6. 産業標準化法

- (1)工業標準化法を産業標準化法に改める。
- (2) 認証をうけずJISマーク表示を行った法人等に対する罰金刑を1億円へ引き上げる。

#### 7. 弁理士法

- (1)技術上のデータに係る特定不正競争事件の裁判外紛争解決手続きの代理等の業務追加
- (2)技術上のデータの売買契約締結代理等の業務追加
- (3)日本産業規格案等の規格案作成関与、相談業務の追加







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## Change to Period for Exception to Lack of Novelty for Invention 発明の新規性喪失の例外期間の変更

The Bill Partially Amending the Unfair Competition Prevention Law etc. that was approved on May 23, 2018 was promulgated on May 30, 2018, and the stipulations under Article 30 of the revised Patent Law came into effect on June 9, 2018.

As a result of the revisions, the period for exception to lack of novelty has been extended from six months to one year. The Patent Law applies to the Utility Model Law, under which the period for exception to lack of novelty for utility model inventions has also been extended from six months to one year.

This change is beneficial to applicants who wish to have the stipulations regarding exceptions to lack of novelty apply to their applications, since it affords them more time to prepare. However, as Japan uses the "first to file" rule, it is still advisable to file as early as possible in order to avoid filing or publication by a third party.

The revision to Article 30 of the Patent Law only concerns the change to the period for exception, and all other points remain the same. The change applies in principle to applications with a filing date on or after June 9, 2018. However, it should be noted that the change will not apply to applications for inventions that were published on or before December 8, 2017.

2018年5月23日に可決・成立された「不正競争防止法等の一部を改正する法律案」が、同年5月30日に公布され、同年6月9日に、改正特許法第30条の規定が施行された。

本改正により、新規性喪失の例外期間は、従来の6か月から1年に延長された。また、特許法を準用している 実用新案法についても、考案の新規性喪失の例外期間が、従来の6か月から1年に延長された。

これにより、出願人は、新規性喪失の例外規定の適用を受けることを所望する出願の準備期間が増えるという利益を得ることができる。しかし、日本国では、先願主義を採用しているため、第三者が先に出願・公開するのを回避するべく、従来と同様にできるだけ早期に出願するのが望ましいことに変わりはない。

今回の特許法第30条の改正は、例外期間の変更のみに関するものであり、その他の点は従来と同様である。また、今回の改正の適用対象となる出願は、原則として、出願日が2018年6月9日以降の特許出願である(但し、2017年12月8日までに公開された発明について特許出願する場合には、改正後の特許法第30条の適用対象とならないので、注意が必要である。)。





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## Period for Exception to Lack of Novelty for Designs Extended to One Year

意匠の新規性喪失の例外期間が6か月から1年に延長

Under the Japanese design system, as a rule, designs that were published prior to application cannot be registered. However, taking into account that the purpose of the Design Law is to contribute to industrial development, a stipulation had been established by which, under certain conditions, designs that are applied for after publication may be treated as exceptions to lack of novelty due to publication. This is the stipulation on exception to lack of novelty for designs (Design Law Article 4).

On this occasion, Article 4 of the Design Law has been revised, extending the period for exception to lack of novelty from six months to one year.

However, the revised stipulation will not apply to designs that were published on or earlier than December 8, 2017, even if applications for said designs are filed on or after June 9, 2018. These applications will be handled under the former stipulation and will not be treated as exceptions to lack of novelty unless an application is filed within six months from the date of publication. In other words, in order to be handled under the revised law, a case must fulfil the two following criteria:

- (1) The application must be filed on or after June 9, 2018
- (2) The application must have been published after December 8, 2017.

The stipulation on exception to lack of novelty for designs is ultimately a stipulation of an exception to a rule. Therefore, if for example you wish to register a design but a third party has formulated the same design independently and made an application/publication of it first, it would not be possible to register your design even if the stipulation were applied. Therefore, it is advisable to file an application as early as possible.

Also, when planning to file applications abroad, care should be taken as the laws of each country determine whether or not it is possible to register a design there based on your publication thereof.

日本の意匠制度では、出願より前に公開された意匠は、原則として意匠登録を受けることができない。しかし、産業の発達への寄与という意匠法の趣旨に鑑みて、特定の条件の下で意匠を公開後に出願した場合には、 先の公開によって新規性が喪失しないものとして取り扱う規定、すなわち意匠の新規性喪失の例外規定(意匠 法第4条)が設けられている。





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この度、意匠法第4条が改正され、意匠の新規性喪失の例外期間が6か月から1年に延長された。

ただし、2017年12月8日以前に公開された意匠については、2018年6月9日以降に出願しても、改正法の規定は適用されず、従来通り公開日から6か月以内に出願しなければ新規性喪失の例外の適用は受けられない。つまり、改正法の適用を受けるためには、①2018年6月9日以降に出願、②2017年12月8日より後に公開、の2つの要件を満たす必要がある。

意匠の新規性喪失の例外規定は、あくまでも原則に対する例外規定であるため、仮にこの規定の適用を受けたとしても、例えば、第三者が同じ意匠を独自に創作して先に出願または公開した場合は、意匠登録を受けることができなくなるので、なるべく早く出願することが重要である。

また、海外への出願を予定している場合には、各国の国内法令によっては、自らの公開により、その国において意匠登録を受けることができなくなる可能性もあるので注意が必要だ。

# Strengthening of Requirements for Divisionals of Trademarks Applications 商標登録出願の分割要件が強化

Recently, some applicants have filed large numbers of applications for the trademarks of third parties, preempting applications made by said third parties. However, in most cases application fees for these applications are unpaid, meaning the applications have procedural defects.

It is possible for applicants to keep these types of trademark applications pending after decisions to dismiss the original applications have been made by repeatedly filing divisional applications, which are effective retroactive to the filing date of the original application. The divisional application then remains pending until it too receives a decision of dismissal. Thus, when a third party later files an application for such a trademark, registration will be delayed until after a decision of dismissal has been issued regarding the divisional application, making it difficult in some cases to obtain rights quickly.

Due to the above, the Trademark Law has been revised so that divisionals of applications that receive decisions of dismissal due to non-payment of application fees will no longer have an application date retroactive to that of the original application.

As a result of this revision, a third party that makes an application for a trademark between the dismissal date of the original application and the filing date of the divisional application may be registered when the decision of dismissal is issued regarding the original application, allowing rights to be acquired at an earlier stage.



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The revised stipulations apply to divisional applications made on or after June 9, 2018.

<Requirements for divisionals of trademark applications>%Newly added requirement marked in **bold**.

- (1) The parent application is undergoing examination, trial or retrial.
- (2) Trademark of the child application and the parent application are identical.
- (3) Designated goods/services of the child application are included in the designated goods/services of the parent application immediately prior to the filing of a divisional.
- (4) Designated goods/services of the child application are deleted from designated goods/services of the parent application by filing an amendment concurrent with filing the child application.
- (5) Application fees for the parent application have been paid.

最近、一部の出願人から他人の商標の先取りとなるような商標登録出願が大量に行われている。しかもこれらのほとんどが、出願手数料の支払いのない手続上の瑕疵ある出願となっている。

そして、このような商標登録出願は、分割出願を繰り返すことによって出願日の遡及効を得つつ元の出願が 却下処分となった後も分割出願は残ることから、分割出願の却下処分があるまで出願を係属させることが可能 である。よって、後に出願された他人の出願は分割出願の却下処分を待って登録されるため、早期に登録を得 ることが難しい場合があった。

そこで、改正にて、元の出願が手数料未納により却下されたときは、分割出願の出願日は元の出願の出願日には遡及しないこととした。

当該改正により、元の出願から分割出願の間に出願された他人の出願について、元の出願の出願却下処分をもって登録となり、早い段階で登録を得ることが可能となった。

当該改正の規定は、2018年6月9日以降の分割出願に適用されている。

<商標登録出願の分割要件>※太文字部分は今回の改正にて追加された要件

- (1) 親出願が審査、審判若しくは再審に継続していること
- (2) 子出願が親出願の商標と同一であること
- (3) 子出願に係る指定商品/役務が分割出願直前親出願に係る指定商品/役務の一部であること
- (4) 子出願に係る指定商品/役務が子出願と同時に手続補正書によって親出願から削除されていること
- (5) 親出願の出願手数料が納付されていること





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### Cooperative International Search Reports by "Big Five" Patent Offices 五大特許庁協働の国際調査報告

Following an agreement made in June 2016 at a meeting between the directors of the "Big Five" patent offices, a trial program carrying out cooperative international searches for PCT international applications has been begun between the "Big Five" patent offices on July 1, 2018.

PCT cooperative searches are carried out with the aim of producing high-quality results in the case of PCT international applications. In a collaborative search, a main patent office responsible works together with a secondary patent office to judge the patentability of a single PCT application, ultimately producing a single international search report that is provided to the applicant.

The trial program will apply to applications that the applicant has requested be included. Those applications to which the program applies will be handled according to a universal standard of quality and handling method between all patent offices.

At first, only applications made in English will be accepted for inclusion in the program, but the "Big Five" patent offices are currently considering making receipt of applications in languages other than English possible, depending on the specific language the applications are written in (in the case of the JPO, applications in Japanese may be accepted).

By participating in the trial program, applicants will be able to obtain higher-quality examinations results at the international stage, which provide useful information when determining the need for entering the national phase in each country and the selection of countries in which to enter the national phase.

2016年6月に行われた五大特許庁長官会合における合意に基づき、五大特許庁は、2018年7月1日より、PCT国際出願の国際調査を試験的に協働で行う試行プログラムを開始している。

PCT協働調査は、PCT国際出願における質の高い成果物の作成を目的として、一つのPCT出願について、主担当の特許庁が副担当の特許庁と協働して、特許可能性に関する判断を行い、最終的に一つの国際調査報告を作成し、出願人に提供するものである。

本試行プログラムにおいては、出願人が参加を申請した出願が対象とされ、対象とされた出願は、すべての 参加庁により共通の品質および運用基準を用いて処理される。

当初は英語出願のみの受け付けとなるが、五大特許庁は、英語以外の言語(日本国特許庁においては日本





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語)による出願を受理することも検討中である。

本試行プログラムに参加することにより、出願人は、国際段階においてより品質の高い審査結果を得ることが期待できるため、各国移行の要否や、移行国の選定などにおいて判断材料となり得る有用な情報を得ることができる。

#### Support Program Subsidizes Half of Foreign Filing Fees 外国出願費用の半額補助

With the globalization of the economy, not only large enterprises but small and medium-sized enterprises also are carrying out active development overseas. At this time, it is necessary to carry out overseas development based firmly on an IP strategy. However, as it is necessary to obtain patent rights etc. in each country individually, carrying out intellectual property activities overseas can often be expensive, leading to a large burden being placed on small and medium-sized enterprises.

In view of this situation, the JPO is engaging in a project to subsidize half of the fees for the foreign applications by small and medium-sized Japanese enterprises etc. that are planning to carry out expansion of operations etc. in other countries. This project will allow operators of small and medium-sized enterprises or groups of such operators to receive subsidies for half their foreign filing costs, so long as they meet certain selective criteria such as (i) the possibility of acquisition of rights will not be clearly denied, and (ii) there is a plan for business expansion based on use of said rights once they have been established etc.

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経済のグローバル化に伴い、大企業のみならず中小企業の海外展開が活発に行われるようになっている。その際、知財戦略も見据えて海外展開する必要がある。しかし、各国ごとに特許権等を取得する必要があるため、海外での知的財産活動費は高額となることが多く、中小企業にとっては大きな負担となっている。

このような状況に鑑み、特許庁は、外国への事業展開等を計画している日本の中小企業等に対して、外国出願にかかる費用の半額を助成する事業を行っている。本事業では、中小企業者や、中小企業者で構成されるグループは、外国での権利取得の可能性が明らかに否定されないことや、外国で権利が成立した場合等に、当該権利を活用した事業展開を計画している等の一定の選定基準を満たすことにより、外国出願費用の半額補助を受けることができる。



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