

## Revision of Japanese Patent Law, Design Law, and Trademark Law 『日本の特許法・意匠法・商標法の改正について』

The "Act of Partial Revision of the Design Law and Other Laws" will come into effect on April, 1, 2007. The "Act of Partial Revision of the Design Law and Other Laws" was promulgated on June 7, 2006 for reinforcement of intellectual property right protection and reinforcement of regulation of counterfeit goods. The following will briefly explain major changes of Patent Law, Design Law, and Trademark Law.

権利保護の強化及び模倣品対策の強化を改正の趣旨として、平成18年6月7日に公布された「意匠法等の一部を改正する法律」が、平成19年4月1日から施行されます。以下に挙げるのは、特許法・意匠法・商標法それぞれについての主な改正点の概略です。

### TOPIC

- I. Patent Law 『特許法』
- II. Design Law 『意匠法』
- III. Trademark Law 『商標法』
- IV. Revisions Common to Patent Law, Design Law, and Trademark Law 『共通項目』

#### I. Patent Law 『特許法』

1. Prohibition of Amendment that Changes to Another Invention of Different Technical Features (The revision will be applicable to applications filed on or after April 1, 2007)

An amendment that changes a claimed invention to another invention of different technical features shall be prohibited once a notice of reasons for refusal is issued. If such an amendment is filed, the Examiner will issue another notice of reasons for refusal (or decline the amendment if it is filed in response to a final notice of reasons for refusal).

On the other hand, even if a claimed invention is significantly changed by amendment, it shall not be grounds for invalidation. This is because the claimed invention is not virtually defective and will not directly harm interest of a third party even if the claimed invention is granted a patent.

2. Prevention of Abuse of Divisional Applications (The revision will be applicable to applications filed on or after April 1, 2007)

If reasons for refusal already notified against a parent application are also applied to a divisional application, the same limitation that is imposed on an amendment to be filed in response to a final notice of the reasons for refusal shall be imposed on an amendment to the divisional application even though a notice of the reasons for refusal issued against the divisional application is first one. (In such cases, the number of times a notice of the reasons for refusal is issued is once as a general rule).

3. Easing of a Time Limit for Filing a Divisional Application (The revision will be applicable to applications filed on or after April 1, 2007)

From the viewpoint of aiding in effective right obtainment and eliminating needless procedures, filing of a divisional application is permitted not only within "allowable time limit for amendments" but also within a set time period after a decision to grant a patent or a decision of refusal. It should be noted that only if a notice of reasons for refusal is issued after Applicant demands an appeal trial, filing of a divisional application is permitted within a time limit for a response to the notice of reasons for refusal, as is conventionally done.

4. Extension of a Time Limit for Submission of Japanese Translation of a Foreign Language Application (The revision will be applicable to applications filed on or after April 1, 2007)

A time limit for submission of Japanese translation of a foreign language application shall be extended so that the workload of Applicant who files a foreign language application as a first application with the Japanese Patent Office can be reduced in preparing Japanese translation thereof (It is to be noted that only a foreign language application in English is accepted by the Japanese Patent Office, and a foreign language application in any other languages including German is not accepted).

More specifically, Japanese translation of a foreign language application shall be submitted within one year and two months from the priority date thereof.

In cases of a foreign language application arising from the division of a patent application or the conversion of an application or a foreign language application based on a utility model registration, Japanese translation thereof shall be submitted within one year and two months from a filing date of its original application. This is because the foreign language application is laid open with its Japanese translation after one year and six months from a filing date of its original application. If a foreign language application arising from the division of a patent application or the conversion of an application or a foreign language application based on a utility model registration is filed after one year or more from a filing date of the original application, Japanese translation thereof shall be submitted within two months from a filing date of the foreign language application.

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1. 技術的特徴の異なる別発明への補正の禁止 (2007/4/1以降の出願から適用される)

拒絶理由を受けた後は、特許請求の範囲に記載された発明を技術的特徴の異なる別発明に変更する補正が禁止されます。また、このような補正が行われた場合は拒絶の理由(最後の拒絶理由通知後は補正却下)とされます。

一方、補正により発明が大きく変更された場合であっても、発明に実質的な瑕疵があるわけではなく、特許されたとしても直接的に第三者の利益を著しく害することにはならないので、無効の理由とはされません。

2. 分割制度の濫用防止 (2007/4/1以降の出願から適用される)

分割出願の審査において、もとの特許出願等の審査において通知済みの拒絶の理由がそのまま適用される場合には、拒絶の理由が既に通知されていることから、たとえ1回目の拒絶理由通知であっても「最後の拒絶理由通知」が通知された場合と同様の補正制限が課されます(この場合、拒絶理由通知の回数は原則1回とされます)。



### 3. 分割の時期的制限の緩和(2007/4/1以降の出願から適用される)

実効的な権利取得の支援及び手続の無駄を解消する観点から、「補正をすることができる期間内」に加えて、特許査定後及び拒絶査定後の一定期間にも、出願の分割が認められます。なお、審判請求以降は、従来どおり、拒絶理由が通知された場合に限り、その応答期間中に分割を行うことが認められます。

### 4. 外国語書面出願の日本語翻訳文提出期間の延長(2007/4/1以降の出願から適用される)

我が国に、外国語書面出願により第1国出願をする出願人の負担軽減を図るため、外国語書面出願の翻訳文提出期間が延長されます(※ちなみに、外国語書面出願は、英語での出願のみ認められており、ドイツ語等、英語以外の言語での出願は認められておりません)。

すなわち、外国語書面出願の翻訳文提出期間が「優先日から1年2月以内」とされます。

なお、特許出願の分割、若しくは出願の変更に係る外国語書面出願、又は実用新案登録に基づく外国語書面出願を行った場合においては、出願日(もとの出願又は基礎とした実用新案登録に係る実用新案登録出願(以下「もとの出願等」という。))の出願日に遡及)から1年6月経過後に速やかに翻訳文付で出願公開が行われる必要があります。そこで、翻訳文提出期間は原則として「出願日(もとの出願等の出願日に遡及)から1年2月」とされます。また、もとの出願等の出願日から1年以上経過後に特許出願の分割若しくは出願の変更に係る外国語書面出願又は実用新案登録に基づく外国語書面出願を行う場合には、分割の日、変更の日又は実用新案登録に基づく特許出願の出願日から2月間が翻訳文提出期間として設定されます。

## II. Design Law 『意匠法』

1. Extension of duration of design rights (The revision will be applicable to applications filed on or after April 1, 2007)

Duration of design rights is extended from 15 years to 20 years from the date of registration. Accordingly, duration of related design rights is extended from 15 years to 20 years from the date of registration.

2. Expansion of Protection of Screen Design (The revision will be applicable to applications filed on or after April 1, 2007)

The revised Design Law shall protect screen designs (screen images) used for necessary operation in activating an intrinsic function of an article, as articles of a shape, pattern or color or any combination thereof. Additionally, the revised Design Law protects not only a screen design indicated on a display of an article but also a screen design indicated on a display of another article which is used concurrently with an article to which the screen design is applied.

3. Revision of Design Registration requirements (The revision will be applicable to subsequent applications filed on or after April 1, 2007)

Under the revised Design Law (Article 3 bis), an application for a partial design identical with or similar to a design of a part of an article for which an application is filed earlier than the application for a partial design shall not be rejected, provided that both of the applications are filed by the same applicant after the filing date of the earlier design application and before an official gazette for the earlier application is published.

However, in cases where the earlier design application requests a secrecy for design, the subsequent partial design application filed before expiration of a secrecy duration for the earlier design application is rejected under Article 3 bis of Design Law even if both of the applications are filed by the same applicant.

4. Clarification of the Scope of Similarity of a Design (The revision will be applicable to applications filed on or after April 1, 2007)

It is desirable that similarity of a design is judged with consistency because judgment of similarity of a design governs registration requirements for a design, which is the essence of a design law system, and an effective scope of a design right. Therefore, for clear judgment of similarity of a design, the revised Design Law stipulates that similarity of a design is determined on the basis of visual aesthetic sense of traders and consumers indicated in decisions of supreme courts or other courts.

5. Revision of the Related Design System (The revision will be applicable to related design applications filed on or after April 1, 2007)

Under the current Design Law (Article 10(1), in order for a design to be registered as a related design, the filing date of an application for the related design is required to be the same as the filing date of an application for a principal design. Under the revised Design Law, in order for a design to be registered as a related design, the filing date of an application for the related design shall be prior to a previous date of the publication date of an official gazette publication for a principal design.

6. Revision of Exceptions to Lack of Novelty of Design (The revision is applicable to applications filed on or after September 1, 2006)

Under the revised Design Law, a person who desires to request exceptional remedy for a design with regard to novelty is required to submit a written statement proving such fact within 30 days from the filing date, not 14 days from the filing date.

7. Revision of Secret Design System (The revision will be applicable to applications filed on or after April 1, 2007)

The revised Design Law allows applicants to request the secrecy for design not only on the filing date of the application, which is permitted under the current Design Law, but also when they pay the registration fees.

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1. 意匠権の存続期間の延長(2007/4/1以降の出願から適用される)

意匠権の存続期間が、現行の「設定登録の日から15年」から「設定登録の日から20年」に延長されます。併せて、関連意匠の存続期間についても、「設定登録の日から15年」が「設定登録の日から20年」に延長されます。

2. 画面デザインの保護対象の拡大(2007/4/1以降の出願から適用される)

物品の本来的な機能を発揮できる状態にする際に必要となる操作に使用される画面デザイン(画像)が、物品の形状、模様若しくは色彩又はこれらの結合に含まれるものとして、意匠法の保護対象として認められるようになります。また、当該画面デザイン(画像)がその物品の表示部に表示されている場合だけでなく、同時に使用される別の物品の表示部に表示される場合も保護されます。

3. 意匠登録要件の見直し((後願が)2007/4/1以降の出願から適用される))

先願意匠の一部と同一又は類似の後願意匠であっても、先願意匠の出願日の翌日からその公報発行の前日までに同一人が出願した場合は、意匠法第3条の2の規定によって、拒絶されません。

なお、先願が秘密意匠を請求している場合、その秘密期間が満了するまでの間になされた後日出願は同一出願人による場合であっても、意匠法第3条の2の規定により拒絶されます。

4. 意匠の類似範囲(判断基準)の明確化(2007/4/1以降の出願から適用される)

意匠の類否判断は、意匠制度の根幹に係る意匠の登録要件や意匠権の効力範囲を司るものであることから、統一性をもって判断されることが望まれます。したがって、意匠の類否判断について明確化するために、最高裁判例等において説示されている「意匠の類似とは取引者、需要者からみた意匠の美感の類否である」旨が規定されます。

5. 関連意匠制度の見直し((関連意匠の出願が)2007/4/1以降の出願から適用される)

関連意匠について同日出願の場合のみ登録を認めている意匠法第10条第1項が改正され、本意匠の公報発行の前日までの間に提出された関連意匠について登録が認められるようになります。

6. 新規性喪失例外適用手続きの見直し(2006/9/1以降の出願から適用される)

「出願の日から14日以内」とされている証明書の提出期間が、「出願の日から30日以内」とされます。

7. 秘密意匠制度の見直し(2007/4/1以降の出願から適用される)

秘密意匠の請求をすることができる時期的要件について、現行法において認められている出願と同時にする場合に加えて、さらに意匠登録の第1年分の登録料の納付時に秘密意匠の請求をする場合も認められるようになります。

III. Trademark Law 『商標法』

1. Protection of service trademarks related to retail sales or the like (The revision will be applicable to applications filed on or after April 1, 2007)

Protection under the Trademark Law will be extended to trademarks used to provide the benefits to customers in retail sales and wholesales. The revised Trademark Law allows individual service activities offered by retailers or the like, which are not regarded as services under the current Trademark Law, will be generally regarded as services defined under the Trademark Law. Accordingly, the revised Trademark Law will protect trademarks used by retailers or the like as services defined under the Trademark Law.

2. Revision of Collective Trademarks (The revision is applicable to applications filed on or after September 1, 2006)

In addition to organizations established under the Civil Law, which are general corporations, juridical organizations (excluding companies) are added as an entity to be protected by a collective trademark registration.

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1. 小売業等の役務商標としての保護(2007/4/1以降の出願から適用される)

商標法上の保護対象として、「小売及び卸売の業務において行われる顧客に対する便益の提供」について使用される商標が追加されます。これにより、個別の行為としては商標法上の「役務」に該当しないものとされていた小売業者等によるサービス活動が総合的なサービス活動として商標法上の役務として認められるようになり、小売業者等によって使用される商標が商標法上の役務として保護されるようになります。

2. 団体商標の主体の見直し(2006/9/1以降の出願から適用される)

団体商標の主体として、民法の規定により設立された社団に加え、法人格を有する社団(会社を除く)も認められるようになります。

IV. Revisions Common to Patent Law, Design Law, and Trademark Law 『共通項目』

1. Expansion of effectiveness of intellectual property rights (Effective on January 1, 2007)

Under the new intellectual property laws, an "act of exporting" is included in the definitions of an act of working a design, an invention, and a utility model and an act of using a mark.
  2. Revision of Acts Deemed to Constitute Infringement of Intellectual Property Rights (Effective on January 1, 2007)

An "act of holding infringing articles for their export" are added to "act deemed to constitute infringement" under Article 38 of Design Law, Article 101 of Patent Law, and Article 28 of Utility Model Law.
  3. Revision of Penalty for infringement of intellectual property rights (Effective on January 1, 2007)

Upper limits of imprisonment and monetary penalty for direct infringement of a design right, a patent right, and a trademark right are increased to 10 years and 10 million yen. Also, upper limits of imprisonment and monetary penalty for infringement of a utility model right are increased to 5 years and 5 million yen.

Upper limits of imprisonment and monetary penalty for indirect infringement of intellectual property rights are 5 years and 5 million yen under all intellectual property laws. Joint imposition of those two penalties are introduced under all of the four intellectual property laws, and an upper limit of a monetary penalty on a legal entity is increased to 300 million yens under all of the four intellectual property laws.
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1. 産業財産権の効力の拡大(2007年1月1日施行)

産業財産権法上、意匠、発明及び考案の実施行為並びに標章の使用行為の定義規定に、「輸出する行為」が追加されます。

2. 産業財産権の侵害とみなす行為の見直し(2007年1月1日施行)

意匠法第38条、特許法第101条、実用新案法第28条に規定されている「侵害とみなす行為」として、「権利侵害品を輸出するために所持する行為」が追加されます。

3. 産業財産権侵害の罰則の見直し(2007年1月1日施行)

意匠権、特許権及び商標権の直接侵害に対する懲役刑の上限が10年に、罰金刑の上限が1,000万円に引き上げられるのと同時に、実用新案権の侵害罪に係る懲役刑の上限が5年に、罰金刑の上限が500万円に引き上げられます。

さらに、産業財産権の間接侵害(みなし侵害)に対する懲役刑の上限が5年に、罰金刑の上限が500万円に統一されます。さらに、産業財産権四法について懲役刑と罰金刑の併科が導入され、法人重課について、四法統一的に3億円以下の罰金に引き上げられます。



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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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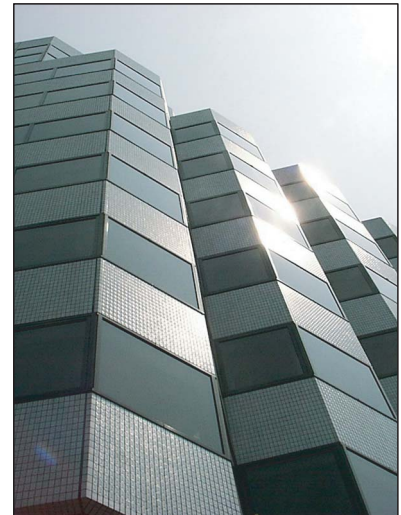
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