



Issue #2 March 31, 2016

IP PROSECUTION AND PROCEDURES

Revised Design Examination Guidelines for Designs with Images

The JPO has revised the design examination guidelines for designs including images. The scope of designs including images that can be registered has been expanded, and the guidelines concerning the judgment of creative difficulty has been clarified.

Until now, in Japan, “images recorded *ex post facto* on articles” such as images displayed due to an update of an electronic instrument’s preinstalled functions, and images displayed by functions that were added by installing software on computers, could not be registered, but from now, they can be. However, images displayed by signals from outside the article in question (e.g. the internet) and images of content (such as games) independent of the article in question will continue to be non-registerable. The revised design examination guidelines will apply to the following:

- (1) For “creative difficulty”: applications for design registration *examined* on or after April 1, 2016; and
- (2) For requirements other than “creative difficulty”: applications for design registration *filed* on or after April 1, 2016.

For details, see Chapter 4 of Part 7 of the design examination guidelines [here](#).

[[Original Announcement](#): JPO Website, Mar. 11, 2016]

Japan to Become Party to the “Patent Law Treaty” and the “Singapore Treaty on the Law of Trademarks”

On March 11, 2016, the Japanese government formally submitted documentation to become party to the Patent Law Treaty (PLT) and the Singapore Treaty on the Law of Trademarks (STLT) to

the World Intellectual Property Organization (WIPO). Effective June 11, 2016, Japan will formally become party to these treaties.

Prior to this, effective April 1, 2016, it will be possible to use the various relief measures as stipulated in these treaties (see the previous issue of this newsletter). Details to follow.

[[Original Announcement](#): METI Website, Mar. 14, 2016]

No Change in Response Period for Notices of Reasons for Rejection Issued after Filing Appeal of Decisions of Rejection for Foreign Applicants

From April 1, 2016, while revisions for extensions of the response period for Notices of Reasons for Rejection issued for patent applications and trademark applications will be implemented, the JPO issued the following advisory: “There will be no revisions concerning this implementation for Notices of Reasons for Rejection issued *after* filing an appeal against Decisions of Rejection.” That is, this will not be changed:

*Requests for extension must be made *within* the time period for responding;

*For patents, a maximum extension of three months, in one-month increments, is possible;

*For trademarks, a maximum extension of one month is possible;

*The official fee for a one-month extension is JPY 2,100.

[[Original Announcement](#) (in Japanese): JPO Website, Mar. 10, 2016]

English Translations of Decisions for Reference

The JPO provides English translations made by human translators for decisions (appeal decisions, opposition decisions, and JPO advisory opinions) that can be referred to for legal interpretation and understanding of JPO practice as a part of its efforts to disseminate information internationally regarding industrial property rights in Japan. The English translations are available [here](#).

[[Original Announcement](#): JPO Website, Mar. 31, 2016]

LITIGATION

Generic Anti-Cancer Drug Infringes Patented Manufacturing Method - Tokyo District Court Recognizes Brand-Name Drug Maker's Argument

In the case of an anti-cancer drug that has already been approved and sold in Japan as a generic drug, in a patent infringement lawsuit filed by Debiopharm International SA (*Heisei 27 (wa) 12416*), a pharmaceutical company that has Japanese patents for manufacturing methods for brand-name drugs, against Nippon Kayaku Co. Ltd., a generic drug maker and seller, the plaintiff Debiopharm was successful in a first hearing at the Tokyo District Court.

The drug is the anti-cancer drug oxaliplatin for rectal cancer. The defendant Nippon Kayaku, argued the following: “Debiopharm’s patented manufacturing method for the anti-cancer drug lacks novelty and should be invalidated.” However, the Tokyo District Court ruled that, “Nippon Kayaku’s anti-cancer drug is within the technical scope of Debiopharm’s invention,” and ordered

Nippon Kayaku to suspend the manufacturing and sale of the drug in question and to destroy the product. Debiopharm has similarly filed suit against 12 other generic drug makers.

[\[Original Court Decision\]](#) (in Japanese): Tokyo District Court, Mar. 3, 2016]

[\[Original Press Release\]](#): Debiopharm Website, Mar. 4, 2016]

OTHER IP-RELATED NEWS

Second Highest Number of Import Seizures Ever - Number of Cases of Articles Violating Intellectual Property Rights in 2015

The Ministry of Finance of Japan announced that there were 29,274 cases of customs officials seizing articles that violate intellectual property rights such as counterfeit brand name goods in 2015. This was the second highest number of such cases following the highest number ever in 2014. Of these 26,670, or 91.1% of all cases, involved imports from China.

Articles violating registered trademarks, such as counterfeit brand name articles including selfie sticks emblazoned with counterfeit logos like “Chanel”, accounted for more than 90% of the total number of cases and articles. The number of seized articles violating copyrights, such as counterfeit character merchandise having forged popular characters such as “Hello Kitty”, increased roughly three fold when compared to the previous year.

[Original Press Release (in Japanese): MOFJ Website, Mar. 4, 2016]

Opposing “Fraudulent Trademark Applications” Abroad - JPO Subsidies for Legal Fees

From fiscal 2016, the JPO is expected to start subsidizing small and medium-size Japanese companies for legal fees as a policy against fraudulent trademark applications abroad.

With the proliferation of the internet, it has become easy to obtain information concerning foreign merchandise, so “fraudulent trademark applications” abroad are increasing (fraudulent trademark applications refer to making use of the fact that a trademark of another party is not registered in one’s territory or country so as to, for dishonest purposes, register said trademark as one’s own). As part of its intellectual infringement prevention policy abroad from fiscal 2014, the JPO also plans to expand its legal fee subsidy program to include “fraudulent trademark applications” and plans to cap its support at JPY 5 million (USD 44,000) for 2/3 of related costs such as consultation with attorneys and lawsuit preparations from this year.

[Mar. 8, 2016]

NEWS ABOUT SONODA & KOBAYASHI

We attended the following event:

[IP Law Summit Spring 2016](#)

March 20-22, 2016; Red Rock Resort & Spa; Las Vegas, NV (USA)

Our Firm

SONODA & KOBAYASHI, an intellectual property law firm, offers dependable legal services for intellectual property in Japan. Our multinational team of 80 experts in technology, law, languages and international communication has served companies from around the world and has gained a reputation for thoroughness and reliability. Our high standards, expertise and team work have defined us since the founding of our firm in 1998.

Visit Us

Sonoda & Kobayashi is located in Shinjuku, one of the main business districts in Tokyo. We welcome visitors and look forward to seeing you at [our office](#).



Website



LinkedIn



Twitter

Copyright © 2016 Sonoda & Kobayashi Intellectual Property Law, All rights reserved.

All statements in this News Bulletin are for informational purposes only and do not constitute legal advice. All comments herein are the opinions of the authors and do not necessarily reflect the opinions of Sonoda & Kobayashi Intellectual Property Law. Please contact us for specific legal advice.

If you have any questions regarding this News Bulletin,
please contact Sayaka Tamura or Toshiyasu Ishioka at newsletter@patents.jp.

Our mailing address is:
Sonoda & Kobayashi Intellectual Property Law
Shinjuku Mitsui Building, Suite 3401
2-1-1 Nishi-Shinjuku
Shinjuku-ku, Tokyo 161-0434
Japan

[Add us to your address book](#)

MailChimp

