

**Issue #5 June 28, 2016**

IP PROSECUTION AND PROCEDURES

Reacting to Mass Trademark Filings [Trademarks](#)

Trademark applications are being filed in large groups and might result in preemptive registration of trademarks that should be registered to others. The JPO is warning applicants “not to take hasty actions, such as giving up a trademark registration, when this happens”.

Trademark registration is examination-based in Japan. Therefore, if a trademark in an application is not used for goods or services of the applicant, or if a trademark application is for a well-known mark for another or for a public institution, the trademark is *not* registrable.

According to the JPO, most such mass applications do not even undergo substantive examination due to failure to pay filing fees.

[[Original Announcement](#) (in Japanese): JPO Website, May 17, 2016]

Regional Collective Trademark System for Overseas Residents [Trademarks](#)

The JPO has published information in English about the regional collective trademark system for overseas residents.

The regional collective trademark system protects “regional brands”, such as regional specialties, by relaxing the registration requirements on word marks consisting of “region name + goods (or service) name”. Even for goods outside Japan, trademarks such as Italy’s “PROSCIUTTO DI PARMA” and Canada’s “Canada Pork” have been registered in Japan as regional collective

trademarks. Before the system was introduced in 2006, trademarks consisting of regional and goods (service) names, except under certain conditions, were not registrable for reasons such as not being distinctive as trademarks.

For details about the system, please click [here](#).

[Original Announcement: JPO Website, May 11, 2016]

Requests to Reinstate Examination Request After Deadline [Patents](#)

The JPO regularly publishes applications for which the deadline for requesting examination has passed and for which reasons for reinstatement have been submitted.

This procedure to remedy failures to request examination by the deadline took effect on April 1, 2015. When there are “valid reasons” for not having requested examination by the deadline, it is possible to request examination with explanation of reasons the deadline could not have been met, within two months after the cause ceased and within one year after the deadline for requesting examination.

However, the JPO considers there to be a “valid reason” only “if an event that caused the deadline to be missed was not predictable, and if the applicant took appropriate measures before and after the event to undertake the request for examination”.

So far, not a single application has been confirmed to have had such a reinstatement request accepted.

[Original Announcement (in Japanese): JPO Website, May 30, 2016]

Numbers for PCT National Phase Applications in Japan to be Issued Sooner for Overseas Applicants [Patents](#) [Utility Models](#)

The JPO will issue Japanese application numbers for PCT national phase applications sooner. Previously, the JPO issued Japanese application numbers about 34 months after the priority date. From March 18, 2016, application numbers have been issued about one week after the national phase entry documents are filed.

LITIGATION

Yakult and Debiopharm Filed Lawsuit against Nippon Kayaku for Infringing Anticancer Drug Formulation Patent [Patents](#)

Yakult Honsha Co., Ltd. (Japan) and Debiopharm International SA (Switzerland) have filed a lawsuit at the Tokyo District Court against Nippon Kayaku Co., Ltd. for infringing a formulation patent (Japanese Patent No. 4430229) owned by Debiopharm and exclusively licensed to Yakult, requesting compensation for damages resulting from the generic drugs manufactured by Nippon Kayaku. The drug in question is the anti-metastatic tumor drug “Elplat” (active ingredient: oxaliplatin).

In March 2016, Debiopharm won an infringement case for the same patent against Nippon

Kayaku (see our News Bulletin [Issue #2](#)). Nippon Kayaku has appealed the case, stopping the provisional execution requested by Debiopharm, and causing rejection of a temporary injunction that was separately requested as well.

Nippon Kayaku has announced that they will continue to assert and prove that they have not infringed said patent.

[Original Press Release: Debiopharm Website, May 16, 2016]

Parody vs Original in Trademark Litigation: Franck Muller Appealed to Japanese Supreme Court [Trademarks](#)

In a case litigating the validity of the registered trademark “Frank Miura” between the Swiss high-end watch brand Franck Muller and the parody watch brand Frank Miura (see our News Bulletin [Issue #4](#)), the Japanese IP High Court decided in favor of Frank Miura. On May 23, 2016, Franck Muller appealed to the Japanese Supreme Court, and the Supreme Court’s decision on this case is being closely watched. We will inform you of the results as soon as a decision is handed down.

OTHER IP-RELATED NEWS

2015 Patent Filing Technology Trends: Overview of Technological Fields to Note [Other Matters](#)

The JPO has selected technical themes in which future growth is anticipated, focusing on technical fields to be promoted as part of national policy, and the JPO is also carrying out studies on technology trends in patent filings. An overview of recent results follows.

Wearable Computers

- The field of watch-type wearable computers is gaining attention, and the market is expected to greatly expand in the future. While the field is currently being led by US applicants, the number of filings by applicants from other countries has increased recently, and there has been a rapid rise in the number of filings by Japanese applicants (filings in 2013 tripled compared with 2012).
- Japan has been relatively focused on technology to reduce the size and weight of watch-type devices, and this is a field in which the number of filings by applicants from other countries is still low. It is possible that even US applicants, currently leading in watch-type devices, have not yet established an exhaustive patent portfolio.

Preventive Safety Technology for Automobiles

- Japanese automakers have been actively filing applications in Japan and abroad for automobile safety and accident-avoidance technology for, for example, automatic braking. There have been an overwhelmingly large number of filings by Japanese applicants for technologies to measure distances from vehicles, such as cameras and millimeter wave radar.
- In contrast, there are more patent application filings by German applicants than by Japanese applicants for communication technologies for nonvisual measuring of distances, such as communication technology to connect vehicles and pedestrians.

Satellite Positioning Systems

- Satellite positioning systems utilize signals transmitted from satellites to calculate the position, speed, direction and orientation of objects, and GPS is representative of such a system.
- The market, by industries in which the technology is applied, is mainly (91%) used by mobile phones (53%) and automobiles (38%). Moreover, Japan companies are very active in “power saving technologies” for the receiver end of mobile phones and the like, being first both in number of filings and filing ratio.

[[Original Announcement](#) (in Japanese): METI Website, May 25, 2016]

NEWS ABOUT SONODA & KOBAYASHI

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