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SONODA & KOBAYASHI
INTELLECTUAL PROPERTY LAW



Japan IP News Bulletin

December 2019

Dear Valued Clients and Colleagues,

Thank you for subscribing to our bi-monthly Newsletter!

We are here to provide all of the latest news, experts' views and our suggestions on the top stories affecting the IP landscape in Japan.

We wish you a good reading!

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1. Webinar- "Utility Models–Overview of Requirements, Procedures and Tactical Use in Europe and Japan" is Now Available in Japanese

The Japanese version of the webinar "Utility Models – Overview of Requirements, Procedures and Tactical Use in Europe and Japan" is now available on our YouTube channel.

This webinar covers the following topics:

1. Basics about filing utility model applications at the different national patent offices (procedure, time frame, requirements, costs etc.)
2. How utility rights can be used in enforcement
3. How to reduce costs by tactical use of utility models in your company`s IP strategy (Japan)
4. How to branch off a utility model from a pending patent application (e.g., in Germany)

Organizer: EU-Japan Centre for Industrial Cooperation - Brussels Office

[Watch the Webinar here](#)

2. Seminar: Exploring New IP Landscapes and Trends in the EU and Japan Concluded

On October 28th, Sonoda & Kobayashi co-hosted a seminar together with the EU-Japan Technology Transfer Helpdesk and IAM Media at the Delegation of the European Union to Japan.

This seminar explored trends, opportunities, and challenges faced by IP professionals, especially in in-house positions, when dealing with strategy-related topics about the IPRs they manage such as international patent filings in the EU and Japan.

- Latest IP News in Japan -

1. The Revised Patent Act to be Implemented on April 1, 2020

Ministry for Economy, Trade and Industry (METI), November 1, 2019

The Ministry of Economy, Trade and Industry (METI) has announced on its website that the Cabinet has approved the Cabinet Order for Stipulating the Enforcement Date of the Act for Partial Revision of the Patent Act, etc. The Revised Act will be implemented since April 1, 2020.

The Revised Act was established at the 198th ordinary session of the Diet in May, aiming at review of the method of calculating compensations for damages, expansion of the scope of designs subject to protection under the Design Act, improvement of the related design system and other purposes.

[Read the full article here](#)

2. The JPO Announces Revision of International Search Fees

Japan Patent Office (JPO), December 2, 2019

On December 2, the JPO has announced a revision of fees related to international applications to take effect from January 1, 2020. In particular, the search fee where the designated ISA is the EPO will be reduced from 209,000 JPY to 208,800 JPY, while the search fee where the designated ISA is the IPOS (Intellectual Property Office of Singapore) will be

adjusted from 171,100 JPY to 173,600.

[Read the full article here](#)

3. Nissan Appoints Makoto Uchida as its New CEO

The New York Time, October 8, 2019

Nissan Motor Co. named the head of its China joint venture as chief executive officer, picking a new CEO known for close ties to top shareholder Renault and for a frank, straight-talking manner that has marked him as an outsider.

The new chief, Makoto Uchida, 53, has worked at the company since 2003 and was leading Nissan's operations in China last year, which is considered a key market for Nissan.

Known for his unflagging work ethic and relentless focus on cost control, Uchida was described by one long-time associate who spoke on condition of anonymity as a "foreigner with a Japanese face" - direct and to the point in conversations.

"We expect Mr. Uchida to lead the company as a team, immediately focus on the recovery of the business and revitalize the company to make a new Nissan," Nissan's chairman, Yasushi Kimura, told the New York Time.

[Read the full article here](#)

4. WIPO: Asia is the Hub of Global Patent Filings

World Intellectual Property Organization (WIPO), October 16, 2019

WIPO's annual World Intellectual Property Indicators (WIPI) report reveals that 3.3 million patent applications were filed in 2018 globally, up 5.2% for a ninth straight yearly increase. Global trademark filing activity rose to 14.3 million, while industrial designs reached 1.3 million.

IPOs in Asia received two-thirds (66.8%) of all patent applications filed worldwide in 2018 – a considerable increase from 50.8% in 2008 – primarily driven by growth in China. Offices located in North America accounted for just under one-fifth (19%) of the 2018 world total, while those in Europe accounted for just over one-tenth (10.9%).

In terms of filing abroad, which is an indication of a desire to expand in new markets, U.S. residents continue to lead with 230,085 equivalent patent applications filed abroad in 2018. The U.S. was followed by Japan (206,739), Germany (106,753), the Republic of Korea (69,459) and China (66,429).

[Read the full article here](#)

5. Japan Strengthens Intellectual Property Partnership with Singapore

Industrial Property Cooperation Center (IPCC), November 15, 2019

Japan's Industrial Property Cooperation Center (IPCC) has signed a memorandum of understanding (MoU) with IPOS International, a subsidiary of the Intellectual Property Office of Singapore (IPOS).

The MoU was signed on November 14, allowing IPCC and IPOS to have access to patent search and analysis expertise in both Japanese and Chinese languages. In addition, IPOS International and IPCC will appoint each other as a branch office in its respective country.

Japanese firms will have access to patent search and analysis services in Chinese provided by IPOS International through IPCC. Similarly, various services such as prior art search in the Japanese language provided by IPCC will be available for firms in Singapore through IPOS International.

[Read the full article here](#)

6. Government of Japan to Submit Candidature of Mr. NATSUME Kenichiro for Director General of the World Intellectual Property Organization (WIPO)

Ministry for Economy, Trade and Industry (METI), October 29, 2019

The Government of Japan has decided to submit the candidature of Mr. Natsume Kenichiro for the next election of the Director General of WIPO, which will take place in Geneva, Switzerland on March 5 and 6 in 2020.

As the Senior Director of the PCT Legal and International Affairs Department of WIPO, Mr. Natsume is well-versed in information and communication technology (ICT). He is skilled in supporting emerging countries through intellectual property and is experienced in responding to rapid advances being made in ICT and driving economic growth in emerging countries through innovation.

The Government of Japan is committed to making every effort to gain the support from all member states to ensure Mr. Natsume is elected to the position.

[Read the full article here](#)

7. India and Japan Signed a Pilot Programme for Expeditious Grant of Patents

Ministry of Commerce & Industry, November 21, 2019

On 20th November 2019, the patent offices of India and Japan have inked a bilateral Patent Prosecution Highway (PPH) Programme on a pilot basis for a three-year period, the Ministry of Commerce & Industry announced on its websites.

"PPH will lead to benefits like reduction in disposal time and pendency of patent applications, consistency in quality of granted patents and an opportunity for Indian inventors including MSMEs and Start-ups of India to get accelerated examination of their patent applications in Japan," the Ministry said in the statement.

Under this pilot programme on PPH, Japanese inventors seeking patent protection in India will now be able to take the benefits of expedited examination in India. It will also help Indian startups in patenting in Japan.

[Read the full article here](#)

8. Japan's Yoshino Wins Nobel for Lithium-ion Battery Breakthrough

Nikkei Asian Review, October 09, 2019

The 2019 Nobel Prize in chemistry has been awarded to a trio of scientists for the development of lithium-ion batteries, which is an important technology in creating a rechargeable world and reducing reliance on fossil fuels that contribute to global warming.

Japan's Akira Yoshino, a 71-year-old honorary fellow with Asahi Kasei Corporation and a professor at Meijo University in Nagoya, has been credited as one of the pioneers in developing the widely used power source along with American John Goodenough and Briton Stanley Whittingham.

The three each had a set of unique breakthroughs that cumulatively laid the foundation for the development of a commercial rechargeable battery.

[Read the full article here](#)

- IP Law Updates in Japan : Insights from Sonoda & Kobayashi -

1.The JPO Further Clarifies Some Procedures in "Opposition to Grant of Patent Proceeding

November 28, 2019

Author: [Akira Fujii](#)

1. Recent Updates in the Manual for Trial and Appeal Proceedings

Three years have passed since the installation of the new Opposition, and the JPO has reviewed the practice and updated their "[Manual for Trial and Appeal Proceedings](#)" so as to meet users' demands for procedures with timeliness and reliability.

The update includes the following three points:

- Improvement of contents in Notice of Reasons for Revocation (Chapter 67-05.1).
- In principle, the second Notice of Reasons for Revocation is the Advance Notice of Trial Decision (Chapter 67-05.5).
- Adjustments in Ex Officio Proceedings (Chapter 67-05).

The users' demands in consideration include:

- Further clarification of the reasons for revocation;
- An early indication of the decision; and
- Opportunity for Opponent's opinions even when Patentee does not file Request for Correction.

In this article, the updates related to Ex Officio Proceedings will be explained.

2. Adjustments in Ex Officio Proceedings

The scope of proceedings is specified as follows.

(1) Subject of Proceedings

The subject of a proceedings is restricted to claims against which the Opposition has been filed (Article 120bis (2)).

(2) Proceedings Based on Reasons and Evidence for Opposition

The Opposition shall be examined based on reasons and evidence pleaded by the Opponent.

(3) Ex Officio Proceedings

Reasons that have not been pleaded by the Opponent may also be examined Ex Officio (Article 120bis (1)) and evidence that has not been pleaded by the Opponent may also be adopted by the Panel.

The Panel should determine whether or not to implement Ex Officio proceedings, taking into account the public interest, a possible delay due to Ex Officio examination of evidence, a possible finding of the truth as a result of the Ex Officio examination of evidence, etc.

Examples of using, by Ex Officio proceedings, reasons and evidence that have not been

pleaded by the Opponent include: a combination of evidence, adoption of evidence that has not been submitted by the Opponent; and a change of applicable provisions, etc.

When the Panel is about to adopt evidence that has not been submitted by the Opponent, the evidence must be very easily obtained by the Panel, such as:

- Examination in the other jurisdiction;
- Observation; and
- Evidence searched by the Panel (as long as the ease thereof is taken into account).

Meanwhile, the period for filing an Opposition is restricted to within six months from the publication date of the patent, the Opposition has to contain a description of Reasons for Request for Opposition, and Amendments to the Opposition are restricted. Therefore, any document submitted with an Observation after the expiration of the period for filing an Opposition shall not be used as evidence except in the case where it is evident at a glance that the document constitutes appropriate reasons for revocation.

As before, when the Remarks submitted by the Opponent substantially present new reasons or evidence, said substantially new reasons or evidence shall not be adopted except for the cases: where the reasons arise pertaining to contents of the Request for Correction; or where it is at a glance obvious that the reasons constitute appropriate reasons for revocation.

Finally, when Remarks without a Request for Correction have been submitted in response to a notified Reasons for Revocation, proceedings shall be conducted without giving the Opponent an opportunity to submit Remarks, i.e. an opportunity to submit Remarks shall be given to the Opponent when a Request for Correction has been filed.

However, when the Patentee's arguments give rise to any question from the Panel regarding the Reasons for Revocation, Interrogatory can be made to the Opponent.

3. Our Advice

(1) Even after filing an Opposition, Observation including additional evidence is possible. However, the Panel can take into account such evidence only when the evidence is easily accessible and obviously constitutes an appropriate reason for revocation. This rule is also applied for the evidence or reasoning argued in the Remarks that the Opponent submits in response to the Request for Correction by the Patentee. Therefore, it should be necessary for

the Observation and Remarks to indicate the satisfaction of these conditions.

If new evidence or reasoning is indicated in the Advanced Notice of Decision, i.e. the final Notice of Reasons for Revocation, it may be recommendable for the Patentee to argue that the Observation or Remarks from the Opponent includes the evidence that is not easily accessible or does not obviously constitute the appropriate reason for revocation.

(2) Even when the Patentee files Remarks without a Request for Correction in response to the Notice of Reasons for Revocation, the Opponent may be entitled to submit a Petition to Interrogatory if the Patentee's arguments in the Remarks give rise to any question from the Panel regarding the Reasons for Revocation. The Interrogatory may be aimed to clarify the relationship between the reasoning in the Opposition Brief from the Opponent and the arguments in the Remarks from the Patentee. However, both Patentee and Opponent should carefully consider this possibility.

2. How Effective are Examiner Interviews in Japan?

November 28, 2019

Author: [Paul Tokeshi](#)

In Japan, it is commonly understood that patent prosecution is to be conducted through the submission of documents. In the interest of contributing to timely and accurate prosecution, however, the JPO allows private interviews and telephone conferences between patent applicants and examiners.

Lately, as some of our clients have inquired into the pervasiveness and effectiveness of examiner interviews/calls, we investigated the academic literature and found a study from February 2014 from the National Graduate Institute for Policy Studies by Mr. Wataru Higuchi that provides some data on this question. Mr. Higuchi investigated patent applications filed in April, 2003 that eventually resulted in a final decision of grant or rejection.

First of all, Mr. Higuchi found that the prosecution of the vast majority of the applications studied did not involve an examiner interview/call, as only 2.1% of applications had a record of an examiner interview, and 4.6% of applications had a record of an examiner call:

April 2003 ²	Record of interview ²	Record of telephone consultation ²
Applications eventually receiving a final decision of rejection (7,950) ²	60 (0.7%) ²	96 (1.2%) ²
Applications eventually receiving a final decision of grant (11,658) ²	342 (2.9%) ²	804 (6.9%) ²
Total (19608)²	402 (2.1%)²	900 (4.6%)²

Second, Mr. Higuchi found that examiner interviews and calls are correlated with a reduction in the number of applications that receive a final examiner rejection but are eventually granted upon appeal:

April 2003 ²	Record of interview/telephone consultation ²	No record of interview/telephone consultation ²
Among applications that received an OA before eventually receiving a final decision of grant (10,207) ²	806 ²	9401 ²
Received a final decision of rejection before grant (1,320) ²	45 (5.6%) ²	1275 (13.6%) ²
Did not receive a final decision of rejection before grant (8,887) ²	761 (94.4%) ²	8126 (84.3%) ²

Mr. Higuchi found that conducting an interview/call after the first office action is correlated with more office actions/rejections. For example, he found that for the population of applications that were eventually granted, it took more office actions for the applications to be granted:

# OAs before prosecution ended	Total		Cases in which interview/call occurred		Cases in which interview/call did not occur	
	Cases	Success rate	Cases	Grant rate	Cases	Grant rate
1	6877	67.4%	304	58.2%	6573	67.9%
2	2814	27.6%	193	37.0%	2621	27.1%
3	453	4.4%	22	4.2%	431	4.5%
4	57	0.6%	3	0.6%	54	.06%
5	6	0.1%	0	0.0%	6	0.1%
Total	10207	100%	522	100%	9685	100%

While this result may seem counterintuitive, Mr. Higuchi theorizes that interviews/calls are correlated with more office actions because (1) the increase in office actions is partially caused by the decrease in final examiner rejections in cases that eventually receive a grant (see above), and (2) applicants may be behaving strategically in cases involving interviews/calls to obtain the broadest claim scope possible such that more office actions are issued.

Finally, based on the results of his study and input on average costs from the Japan Patent Attorney Association and the JPO, Mr. Higuchi estimated that conducting an interview/call after the first office action is associated with a savings of 8,000 yen (~ \$73 USD).

About

SONODA & KOBAYASHI is a law firm offering dependable legal services for intellectual property. Our multinational team of about 90 experts in technology, law, languages and international communication has served companies worldwide and gained a reputation for

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