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Sonoda & Kobayashi IP Group is pleased to present this inaugural issue of the Japan IP News Bulletin. The Japan IP News Bulletin will be published bimonthly with brief summaries of the latest IP news from Japan. Please email us at newsletter@patents.jp for details about any topic.

IP PROSECUTION AND PROCEDURES

Summary of New Procedures with Accession to New Treaties for Applicants domiciled outside Japan

In preparation for Japan's accession to the Patent Law Treaty (PLT) and the Singapore Treaty on the Law of Trademarks (STLT) in 2016, the Act to Partially Amend the Patent Act etc. will take effect on April 1, 2016. Major changes are described below. Other details to follow.

Patents If no specification is attached to a patent application, the filing date will be recognized if a statement is made in the application that a prior patent application (including a foreign application), *filed by the same applicant*, is to be referenced. The specification and any necessary drawings must be submitted within 4 months from the filing date with an additional fee of JPY 14,000.

Patents The period for response to a Notice of Reasons for Rejection will be extendable even *after* the original deadline. As long as no other extension has been obtained, request for extension may be made within 2 months after the original deadline, and the extension is for 2 months from the original deadline. No further extension is possible.

Trademarks The period for response to a Notice of Reasons for Rejection will be extendable even *after* the original deadline. Request for extension may be made within 2 months after the original deadline, and the extension is for 2 months from the original deadline.

Patents A translation of a foreign-language application can be submitted even *after* the

deadline. The translation must be submitted within 2 months from the date of receipt of a JPO notice to submit the translation.

Patents Utility Models A priority document can be submitted even *after* the deadline. The priority document must be submitted within 2 months from the date of receipt of a JPO notice to submit the priority document.

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

Third Party Can Confirm Patent Opposition

The “Patent Opposition Q&A” published by the JPO has been updated. According to the Q&A, a third party may confirm whether or not documents such as a Patent Opposition have been submitted in connection with a patent, by performing a history information search on J-PlatPat (although updates about submitted documents may take three weeks). In order to view the contents of submitted documents, a browsing request must be submitted to the JPO.

[Original Announcement (in Japanese): JPO Website, Feb. 22, 2016]

Statistics on JPO Applications and Registrations

Monthly statistical data are updated at the JPO website with a delay of a few months, including the numbers of patent, utility model, design and trademark applications filed, the numbers of registrations, the numbers of trials and appeals etc.

Data for December 2015 is [here](#).

[Original Announcement: JPO Website, Feb. 16, 2016]

LITIGATION

Japanese Company Takes a Bite Out of Apple – “US Jurisdiction” Agreement Invalid, Case to be Tried in Japan

Apple component supplier Shimano Manufacturing sued Apple for approximately JPY 10 billion (about USD 88 million) for violation of the Anti-monopoly Act and patent infringement, the Tokyo District Court ruled, in an interlocutory judgment on jurisdiction, that “the agreement between the companies that ‘disputes will be resolved in US courts’ is invalid”, and that the case would continue to be handled by the Tokyo District Court. The Tokyo District Court will now judge whether or not Apple is liable for damages.

The Japanese Code of Civil Procedure provides that agreements regarding dispute venues must be defined separately for each transaction agreement, but the agreement in question appears to have been a general agreement to the effect that the state of California would have jurisdiction. This is the first time an agreement between companies pertaining to international court jurisdiction has been found invalid.

[Feb. 16, 2016]

Body Fat Analyzer Trademark – Tanita v. Omron IP High Court Finds for Omron

Omron Healthcare holds the trademark “DualScan” for a medical visceral fat measurer and sued for invalidation of a later-registered Tanita trademark for a household weighing machine with a body fat measurer. The IP High Court found the Tanita trademark to be invalid (*Heisei 27 (gyo-ke) 10134*).

Omron initially filed a trial for invalidation at the JPO on the grounds that the designated goods of the Tanita trademark are similar. However, the JPO dismissed Omron’s complaint, stating that “medical and household devices differ in their manner of use and those needing to use them”. Omron then appealed to the IP High Court for cancellation of the JPO trial decision. The IP High Court canceled the JPO trial decision which had held the Tanita trademark to be valid, stating that “medical and household functions are in the process of converging, and there is risk of confusion”.

The two companies are also involved in a dispute over the design of weighing machines with a body fat measurer. In 2015, the Tokyo District Court found in favor of Omron, stating that Tanita had infringed the design, and in January 2016, the companies settled at the IP High Court. [[Original Court Decision](#) (in Japanese): IP High Court, Feb. 17, 2016]

Whose “Hippo”? Developer and Former Distributor Fight Over Packaging of Mouthwash

A conflict over the packaging of mouthwash which arose between Mundipharma, the US pharmaceutical company that developed Isodine, and Meiji, the longtime Japanese distributor of Isodine, has developed into a court battle. In an unusual situation, the groups have filed demands for provisional injunctions against each other at the Tokyo District Court.

Isodine is a mouthwash that has been sold by Meiji for over 30 years in a familiar package bearing the image of a hippopotamus. The manufacture/sales agreement between the two groups will lapse at the end of March 2016, and Isodine will be sold by Shionogi Healthcare beginning April 1. On February 9, Meiji filed a demand for a provisional injunction on acts of unfair competition etc. against Mundipharma at the Tokyo District Court, on the grounds that the character on the package for Isodine which Shionogi plans to use is “similar to ‘Kaba-kun’ [Mr. Hippo] for which Meiji holds the trademark”. In response, Mundipharma filed a demand for a provisional injunction against Meiji Group at the Tokyo District Court on the grounds that “the use of a package design using the same hippopotamus character that has heretofore been used by Meiji to sell Isodine in order for Meiji to sell a new mouthwash constitutes a violation of the Unfair Competition Prevention Act”.

[[Original Press Release](#) (in Japanese): Mundipharma Website, Feb. 26, 2016]

OTHER IP-RELATED NEWS

Copyright Protection Aims for US and European Standard While Preserving Tradition - Government Proposes Revisions After TPP Agreement

The Council for Cultural Affairs of the Japanese Agency for Cultural Affairs has decided on proposals for revising the Japanese copyright system in view of the Transpacific Partnership (TPP) agreement.

(1) Extending the copyright protection period for music and books from the current 50 years from author's death to 70 years

Seventy years is already common in the US and Europe, so the international standard will be adopted.

(2) Introduce “statutory damages” system allowing minimum damages to be claimed even without establishment of the amount of damages in a civil suit for copyright infringement

Concerns over the possibility of frivolous suits as in the US were addressed by not adopting an “additional damages” system such as the treble damages system in the US, and providing suggested rules for usage fees determined by copyright management companies.

(3) Introduce “non-complaint offenses” by which police would be able to control pirated works even without the author filing a complaint

In order to avoid adverse effects on Japanese “otaku culture” which includes secondary creative activity such as anime parodies, allowances were made to exclude secondary works that do not affect the income to the original author and acts of reproducing manga in part.

The Japanese government intends to amend the copyright law at the Diet in accordance with the views of the Council for Cultural Affairs and plans to enact the law with the enactment of the agreement, which is likely to occur in 2018 or later.

[Original News: Nikkei Asian Review, Feb. 25, 2016]

Grace Period for Loss of Novelty for Patents to be Extended to One Year, Patent Term Extension System for Term Compensation Also to be Introduced in Government Proposal

The Japanese government has summarized proposals for amendments to the Patent Law and Trademark Law with the general agreement on the Transpacific Partnership (TPP) agreement. The amendment would extend the grace period for loss of novelty, during which inventions that were published before a patent application was filed can be exempted from loss of novelty, from the current “6 months from disclosure of the invention to the filing of the patent application” to “12 months”, so as to ensure that the inventor has the opportunity to announce results in publications or at conferences, while making it easier to file patent applications.

Additionally, in order to compensate for “unreasonable delays”, the amendment would provide a system for extending the patent term when a patent has been registered later than 5 years from the filing date or 3 years from the request for examination, whichever is later, in order to ensure that an adequate protection term is obtained.

The government aims to make a cabinet decision, submit the proposal to the Diet, and establish the amendment within the current session.

[Original Meeting Reference (in Japanese): JPO Website, Feb. 22, 2016]

Please do contact us if you have any general questions about Japanese intellectual property. We can reply in English, French, German, Chinese or Korean by email, telephone, or videoconference.

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](#).



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