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SONODA & KOBAYASHI
INTELLECTUAL PROPERTY LAW



May 2020

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1. Awards

We are proud to announce that Sonoda & Kobayashi Intellectual Property Law has been named the Intellectual Property Firm of the Year in Japan by the KMH Media Group!



2. Publications

Dr. Toshiyasu Ishioka, a partner in our bio-pharma group, recently wrote an article published by IAM Media on patent term extension in Japan:

[Read the full article here](#)

Dr. Yoshitaka Sonoda, our founding partner, and Alison Santino of our International Affairs Department recently wrote an article published by Patent Lawyer Magazine on comparing patent validity standards in invalidation actions at the EPO and JPO:

[Read the full article here](#)

- Coronavirus Responses by the JPO-

1. The JPO Announces Potential Relief for Late Submissions

On April 3rd, the JPO announced that patent, trademark, design, and utility model

applicants who have missed a deadline will be allowed to make a written submission (the “relief procedure”) explaining the circumstances behind the failure to meet the deadline in response to the coronavirus crisis. If the circumstances as explained by the applicant are recognized by the JPO as valid, then the JPO will treat the untimely submission as timely submitted.

Applicants should be aware that the JPO retains full discretion to determine whether the circumstances surrounding the failure to meet a deadline are to be accepted. Moreover, there is significant legal precedent under similar standards where the JPO has rejected the vast majority of requests for relief (such as a missed PCT national entry deadline).

However, materials released by the JPO on potential circumstances in which relief may be granted seem to indicate the JPO will employ a relatively relaxed standard for accepting submissions that could not be timely filed due to the coronavirus crisis.

The JPO lists sample circumstances in which relief may be granted, including:

Where the applicant, their attorney, etc. has contracted COVID-19 and was unable to timely perform the procedure;

When the office of the applicant, their attorney, etc. was closed due to an outbreak of COVID-19, and the procedure could not be timely performed;

When an order or request for restriction of movement was issued by the government of the region in which the applicant, their attorney, etc. resides due to COVID-19, and the applicant, their attorney, etc. was restricted from working at the office, and was unable to timely perform the procedure.

There is no requirement that documentary evidence be submitted in conjunction with the relief procedure.

Details regarding the new relief procedure can be seen here:

https://www.jpo.go.jp/e/news/koho/saigai/covid19_procedures.html

https://www.jpo.go.jp/news/koho/saigai/covid19_tetsuzuki_kyusai.html (in Japanese)

2. The JPO Will Accept Requests for Extensions for Prosecution Appeals, Invalidation Actions, and Oppositions

On April 21st, the JPO announced that in response to the coronavirus crisis, parties may request extensions to deadlines designated by the JPO in connection with appeals to decisions of rejections, invalidation proceedings, and oppositions in cases where the extension is necessitated by the spread of the coronavirus (the JPO has separately announced potential relief from missed deadlines designated by law; see 1. above).

The JPO requests that parties that make such a deadline extension request state with specificity the reason(s) why the spread of the coronavirus has necessitated an extensions. Valid reasons noted by the JPO include closure of a company office due to the coronavirus, inability to gather experimental data due to the coronavirus, etc. With respect to deadlines designated by the JPO, the longest extension that can be requested is one month, though if a further extension is required due to the coronavirus, a second extension may be requested.

Further information can be found here (Japanese):

https://www.jpo.go.jp/news/koho/saigai/covid19_sinpan.html

3. The JPO Will Accept Untimely Submitted Original Signatures in Conjunction with Exception to Lack of Novelty Submission

In order to be eligible for the exception to the lack of novelty of an invention under Article 30(2) of the Patent Act, a patent applicant must submit evidence (a document certifying that the requirements for the application of the exception to the lack of novelty of an invention are met) within 30 days of the filing of the application. The document required to be submitted is an original certificate bearing the applicant's seal or signature (the JPO does not accept photocopies, scanned documents, etc.).

However, due to the spread of COVID-19, the JPO announced that as of April, 2020, the applicant may submit a certificate without seal or signature within the period so long as the certificate states the cause of the failure to submit the seal or signature is the coronavirus crisis, and that the seal or signature will be submitted in due course.

It should be noted that this relief procedure is in addition to the relief procedure under Section 30(4) of the Patent Law which may allow for relief in cases where the certificate regarding the loss of novelty exception could not be timely submitted due to the COVID-19

pandemic.

Furthermore, please note the JPO announced a substantially similar measure regarding exception to lack of novelty submissions for designs.

Further information can be found here (Japanese):

https://www.jpo.go.jp/system/laws/rule/guideline/patent/hatumei_reigai.html

<https://www.jpo.go.jp/system/design/shutugan/tetuzuki/ishou-reigai-tetsuduki/index.html>

4. The JPO Suspends Examiner Interviews

The JPO announced on April 9th that face-to-face interviews will be suspended temporarily and that video interviews should be requested instead if necessary.

Further to the above official announcement, JPO examiners have unofficially commented to us that they will probably be told soon (or may have been told already) to mainly work from home. However, since they have yet to be equipped with means for communication with applicants such as telephones or faxes they have been using for telephone interviews, they are reluctant to have telephone interviews from home. Some examiners have requested that applicants officially submit amendments and/or remarks instead of interviews and implied that he/she will issue more OAs if necessary rather than conduct an interview.

Further information can be found here (Japanese):

https://www.jpo.go.jp/news/koho/info/covid19_shutsugan.html

- Latest IP News in Japan -

1. Patent Invalidation Actions – Pilot Program Trial Procedure Expands Number, Role of Non-Public Oral Hearings

From April, 2020, aiming to further improve the conduct of patent invalidation actions, the JPO Trial Division has begun a "Dialogical Trial Procedure" (hereinafter the "Procedure"). This Procedure will increase the number and scope of non-public oral hearings for selected patent invalidation actions on a trial basis.

According to the JPO, the Procedure aims to secure an opportunity for the parties to fully assert their arguments and proof at an early stage, and if necessary, allow the Appeals Board hearing the case the opportunity to communicate their tentative views on the case to the parties. The Procedure will apply to cases upon request by a party, designated for the Procedure by the Head Trial Examiner, and consented to by the opposing party. However, there may also be cases without a request from a party where the Head Trial Examiner designates a case for the Procedure with the consent of both parties.

In the current procedure, the oral hearing typically takes place approximately 8 months after the initial demand (near the end of the trial procedure). While in general patent invalidation trials include an oral hearing allowing parties to supplement their assertions regarding the points at issue in the case, there are cases in which having only one oral hearing leaves parties unable to fully express their arguments, requiring a second hearing on the points at issue.

In the Procedure, while the schedule for particular cases may vary, it is currently envisioned that in a standard case, a first non-public oral hearing will take place after the filing and delivery of the demand. This hearing will primarily involve the creation of a schedule and plan for the trial. A second non-public hearing will take place after the reply brief of the respondent is filed and primarily concern the assertions of the parties and the points of difference in the case. A third non-public hearing will serve as a final confirmation of the points of difference between the parties.

This Procedure will allow parties to directly explain their assertions to the Appeals Board during the oral hearings. In order to allow for a frank exchange of views, oral statements made by a party during an oral hearing and not recorded will not be taken as an assertion of that party (the “no commitment rule”). The assertions of both parties during oral examination will only be recorded when determined necessary by the Appeals Board and with the consent of both parties. Unrecorded assertions made during an oral hearing are not to form the basis for the final ruling.

Importantly, in the example case Procedure provided by the JPO, while each party is only asked to provide an “explanation” with respect to the questions of the Appeals Board at each oral hearing, they are to provide their written “replies” to the questions after the hearing which will presumably serve as the assertions of the parties with respect to the questions.

If the Procedure is eventually adopted by the JPO for invalidation actions, whether as standard procedure or as one possible procedure, it will represent a significant change in Japanese practice. For invalidation actions employing the Procedure, one might expect that (1) professional fees for invalidation proceedings will increase along with the number of oral hearings and written submissions, and (2) the Appeals Board will have more opportunity to communicate its views on the case as well as direct the arguments of the parties towards the points the Appeals Board feels are crucial. At the present time, however, the JPO only intends to apply the Procedure to a limited number of cases on a trial basis. We will keep close watch for further developments.

Further information can be found here (Japanese):

https://www.jpo.go.jp/system/trial_appeal/shubetu-muko/keikaku_taiwa_200325.html

2. Extension of Design Protection to 25 years

The JPO will now allow design protection to be extended to 25 years for design applications filed on or after April 1, 2020. Previously, protection was limited to 20 years. Yearly annuities for years 4 – 25 of will be 16,900 yen per year.

Further information can be found here (Japanese):

https://www.jpo.go.jp/system/process/tesuryo/kaisei/2020_ishoryokinkaisei.html

3. The JPO has released the English version of the 2020 status report

The JPO has released the English version of the 2020 status report, which can be found here:

<https://www.jpo.go.jp/e/resources/report/statusreport/2020/index.html>

4. The JPO has released a Handbook for Trial and Appeal System in Japan

The JPO has released a Handbook for Trial and Appeal System in Japan, which can be found here:

https://www.jpo.go.jp/resources/report/sonota-info/document/panhu/shinpan_gaiyo_e.pdf

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

1. Changes to Japanese Design Law from April 1, 2020

Harumi Kokaji, a partner, wrote a commentary on the recent changes to Japanese Design Law.

[Read the full article here](#)

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 thoroughness and reliability.

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