

Recent Developments at the JPO

Post Grant Opposition System

A post-grant opposition may be filed by anyone (including a “straw man” or a “non-interested” third party) within 6 (six) months from date on which the patent was issued. The official cost for filing an opposition is ¥16,500 (\$150) plus ¥2400 (\$22) per claim which is to be opposed*.

Reasons for which an Opposition may be Undertaken

- 1) The scope of the description, claims, and/or drawings of the amendment exceeds the range of the contents described in the application.
- 2) The patent violates a treaty
- 3) The translated Japanese document does not remain within the scope of matters described in the original foreign language application.
- 4) The patent violates Article 25 (Enjoyment of Rights by Foreign Nationals), Article 29 (Industrial Applicability, Novelty, and Inventive Step), Article 32 (Inventions Liable to Injure Public Order, Morality or Public Health), Article 36(4)(i) (Enablement Requirements), Article 36(6) (Description Requirements), or Article 39 (Prior Application – First-to-file) of the Patent Law.

The opposition will be examined by a collegial body of three to five Examiners at the JPO and oral proceedings will not be performed. If Reasons for Revocation are issued by the collegial body, the applicant may respond to the revocation and make amendments to the patent. If the Reasons for Revocation are unovercome by the amendment, the owner of the patent may appeal the decision to the Intellectual Property High Court.

Post Grant Invalidation Trial

An invalidation trial against a patent may only be filed by an interested party, who may not remain anonymous. The official cost for filing an invalidation trial is ¥49,500 (\$450) + ¥5500 (\$50) per claim which is to be invalidated*.

*Based on ¥110 = \$1 (Rate as of May 2018).

In addition to the aforementioned reasons for which an opposition may be undertaken, the case when the patent has been granted for the non-entitled person or granted in noncompliance with the requirements for joint application may also be

included as a reason for initiating an invalidation trial against a granted patent.

Invalidation trials may be presented orally or through documentary evidence.

“Non-traditional Trademarks” (Starting from April 2015)

The scope of trademark protection has been expanded to include sounds, color marks, motion marks, hologram marks, and position marks.

Examples:

Sound: The notes used by the Hisamitsu Corporation in their “jingle” may now be trademarked



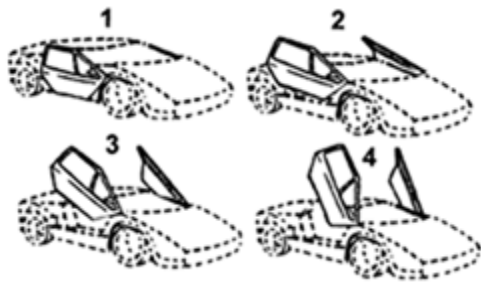
The music, voice or natural sound(s) is recognized by the sound itself. The musical notes or a sonogram of the music, voice or natural sound(s) are submitted along with the trademark application, and while they may not be readily understood visually, the sound they indicate would be readily understood and identified with a particular company or product.

Color marks:



Color marks consist of colors (generally defined by the RGB Color Chart or other color charts used in the market) and a detailed description of the physical positioning and arrangement of the colors in association with each other is required. The secondary meaning (distinctive, well-known product or logo) of the arrangement and design of the color(s) must be described by the applicant.

Motion marks:



A motion mark is a mark in which a two- or three-dimensional spatial change of the figure occurs over time, giving the impression of movement or demonstrating how a particular object may move, i.e., in the above example, the motion indicates the direction and manner in which the vehicle's doors may open.

Hologram marks:



A hologram mark has a different image when viewed at different angles. The shape and/or the color change visually.

Position mark:



A position mark consists of figures and the positions of the figure. The figurative element in the mark may not be in itself distinctive, however, when attached to a product or other object, the mark becomes distinct and obvious in a particular position. The black dot in the above example indicates the cursor control of a keyboard, although, alone it would simply be seen as a black dot.

Regional Collective Trademarks

In order to promote regional brands, focusing on their unique characteristics, flavors, tradition, culture, etc., and distinguishing them from similar products from other geographical regions, trademarks are now permitted based on the geographical name/location from where the product is produced/derived. The regional name is often combined with the product name in some manner.

The application for the registration of trademarks has been revised to include commerce and industry associations, chambers of commerce and industry, and NPOs.

In numerous cases, locally produced products have generations-long history in a specific geographical location, but have not been able to protect their product or prevent unauthorized use of their product's/locality's name by third parties.

A regional collective trademark is warranted if the following are satisfied:

- (i) The applicant or its members are using the trademark in an application.
- (ii) The trademark is well known among consumers as indicating the goods or services pertaining to the business of the applicant or its members (Article 7-2).