



EXCO MEETING, CAPE TOWN 13 & 18 APRIL 2015

COUNTRY REPORT

TITLE:	Country report for Japan JP	
DRAWN UP BY:	<i>Mr. Yoshikazu Tani, an ExCo delegate, Mr. Shogo Ohnishi, an alternate delegate</i>	
TABLED TO:	FICPI delegates	
PURPOSE:	For information and consideration	
SNIPPET:	News from and activities of the FICPI national group in <i>Japan</i> since the Barcelona ExCo in November 2014.	

SECTION A: ACTIVITIES OF FICPI ASSOCIATION/SECTION

The information supplied in Section A will remain confidential on FICPI's website after the ExCo (will require a password).

SECTION B: CHANGES IN LAW

Information supplied under Sections B and C will be published on FICPI's website after the ExCo and will be available to the public.

B1. LEGISLATION

1. Please provide details of any changes to IP legislation (patent, trade mark, design and other) in your country implemented or due to be implemented since you reported last in October 2014.

Revisions of Patent Act, Design Act, Trademark Act, The Act on International Applications under the PCT and Patent Attorney Act will become effective as from April 1, 2015.

The details of these revisions were explained in the country report JP submitted in ExCo Meeting in Kyoto, 6-10 April 2014.

B2. MAJOR CASES

1. Please provide brief details of any new case law in the field of patents, trademarks, design or other IP of general interest.

(1) Patent eligibility:

Heisei 26 (Gyoke) 10014 (decided September 24, 2014):

The decision discussed the patent eligibility from viewpoints of abstract idea or human-made rule itself is not patentable. Mere addition of storage media to such an abstract idea human-made rule is not patentable as well.

Heisei26 (Gyoke) 10101 (decided January 22, 2014):

Even if the claim recites some technical means, if the essence of the claimed invention is directed to the abstract idea or human-made rule itself, then the claim as a whole is not patentable.

(2) Divisional Application:

Heisei25 (Ne) 10296 (decided January 29, 2014):

The technical matters defined in the claim in the divisional application are derived from more comprehensive conception obtained by making the concrete structure disclosed in the original application more abstract. Thus, this more generalized conception was not disclosed in the original



disclosure and does not satisfy the requirements for divisional application.

(3) Doctrine of Equivalent:

Heisei25 (Wa) 4040 (decided December 24):

The substantial value of the patented invention is that the solution means based upon special technical feature not found in the prior art is disclosed in terms of concrete structure to the public. Thus, the feature showing the core of the technical idea forming the basis of the special solution means of the patented invention in the claimed structure should be understood as the essential feature of the patented invention. Prosecution history estoppel is applied when the applicant intentionally excluded the accused device in the course of prosecution. Thus, the argument that the claim should have been excluded the accused device does not constitute the prosecution history estoppel. Then, the doctrine of equivalent was admitted.

B3. OFFICIAL PRACTICE

2. Please provide details of any changes in official patent and trade mark office practice which would be of general interest to other members.

As from April, 2014, JPO reduced the fee for request for examination to 1/3 and annuity to 1/3 for a micro small entity (less than 20 employees) as well as some fees for PCT application to 1/3. .

Those fees for SME were already reduced to 1/2 before this revision.

FA11 project (First Office Action should be completed within 11 months after the request for examination) was attained in April, 2014. Thus, prosecution by JPO examiners are very much expedited. If you file a patent application in Japan, you can sense the possibility that the application will be allowed for patent in other countries.

Chinese and Korean patent literature can be searched in Japanese by the new search system which started its operation in January, 2014.

B4. PROPOSALS FOR CHANGES

3. Please provide details of any proposed changes in IP laws or practice and indicate if your National Association/Section is involved in providing comments to such changes.
Would it be of assistance to have input from the CET on any proposed changes?

No proposed change at present.

SECTION C: OTHER INFORMATION

Please provide details of any other information pertaining to your country or region that would be of general interest to FICPI members and other IP practitioners browsing FICPI's website.

C1. QUALIFICATION AND THE RIGHT TO REPRESENT CLIENTS BEFORE A COURT

- 1.1 Please describe the qualification process for becoming a patent attorney in your country/region.

We have the patent bar examination once every year. The examination comprises 3 stages of examination.

The first stage is a mark sheet test and then the second stage is an essay test. Final stage is an interview test. After passing the three stage examination, there is a six-month training



curriculum, which is compulsory.

Once someone completes the training curriculum, he or she can apply for registration as a patent attorney. Then, the board of the JPAA decides to approve the registration or not according to the record as a whole.

Please note in Japan, we do not have a separate registration for patent and trademark attorneys. A patent attorney or “Benrishi” in Japanese means a comprehensive qualification as an IP attorney and thus a patent attorney can practice not only patent but also trademark.

- 1.2 Has the patent attorney qualification process changed in any way in the past 5 years?

No change.

- 1.3 Does qualification as a patent attorney permit you any right of representation before any Court in your country?

The qualification as a patent attorney automatically permits us to represent our client before the IP High Court in the case of an appeal from the appeal/trial board decision before the JPO. In contrast, in the case of an IP infringement litigation, the qualification does not automatically permit us to represent our client before an infringement court.

We have a supplemental registration for infringement litigation. That registration is referred to as “Fuki-Benrishi”. Once a patent attorney passes the examination for representative right of IP infringement litigation after intensive judicial training, he or she can apply for this supplemental registration. “Benrishi” means a patent attorney and “Fuki” means a supplemental note to be added in the register to certify that the patent attorney is also qualified to represent a client before an infringement court.

- 1.4 If so are there any special requirements or restrictions?

In general, a Fuki-Benrishi or a patent attorney with supplemental note jointly represent a client with an attorney-at-law before an infringement court. A Fuki-Benrishi cannot represent a client solely before an infringement court unless the court admits him or her to do so solely according to the judge’s discretion, for example, in an unusual case where it is not possible for an attorney-at-law to attend the court. In this case, a Fuki-Benrishi receives an authorization from a client.

Please note in the case of an employee invention litigation, a Fuki-Benrishi cannot represent a client before a court. In this case, like a regular patent attorney,

Fuki-Benrishi is merely a patent counsel or an assistant to an attorney-at-law. In this case, a regular patent attorney or a Fuki-Benrishi receives an authorization from an attorney-at-law.

- 1.5 Are qualified lawyers in your country permitted to work in the patent field without any further qualification?

Yes, any lawyers are permitted to practice patent without registration as a patent attorney.

If so are there any restrictions on what they may do?

No restriction.

If so, please describe those restrictions.

- 1.6 Please describe what privilege attaches to patent attorney communications including any restrictions.

In general, Articles 197 and 220, the Civil Procedure Act prescribe that the attorney-client



privilege is applicable to a patent attorney in general. More specifically, a patent attorney can refuse deposition before the court or can refuse to submit written documents to the court.

- 1.7 Please describe the qualification process for becoming a trade mark attorney in your country/region.
There is no separate qualification system for a trademark attorney. A patent attorney or Benrishi can practice either patent or trademark or both.
- 1.8 Has the trade mark attorney qualification process changed in any way in the past 5 years?
No answer, because we do not have a separate qualification system.
- 1.9 Does qualification as a trade mark attorney permit you any right of representation before any Court in your country?
No answer, because we do not have a separate qualification system.
If so are there any special requirements or restrictions?
No answer, because we do not have a separate qualification system.
- 1.10 Are qualified lawyers in your country permitted to work in the trade mark field without any further qualification?
Yes, they can practice trademark.
If so are there any restrictions on what they may do?
There is no restriction.
If so, please describe those restrictions.
- 1.11 Please describe what privilege attaches to trade mark attorney client communications including any restrictions.
Please see our answer at 1.6.

C.2 CET AND PEC SPEAKERS

- 2.1 Would your National Section/Association be interested in obtaining assistance from FICPI, through either the CET Work and Study Group or the Professional Excellence Commission (PEC), in providing speakers for seminars organized by your national group in your country?
Yes, we are interested in obtaining assistance from FICPI in receiving a speaker for our seminar.
- 2.2 If your group does, or in the future might, require such assistance, please identify topics that might be of interest to your members, with a view to raising FICPI's profile and providing added value from membership of FICPI in your country.
In the future, when we require a speaker, we may ask FICPI for a speaker in the field of national patent laws, EPO practice, licensing, standard related matters, patent eligibility, infringement litigation including multiple entity issues, etc. However, please note that we have not fixed our future plan, so that the above is just our examples of topics of interest.

C.3 TOPICS OF INTEREST

- 3.1 Please list three IP topics that are of particular interest to you and/or your national section members.
I am interested in standard related matters, patent eligibility, infringement litigation involving multiple entity issues



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