



(Provisional Translation)

Patent Law*
(Law No. 121 of April 13, 1959 ,
as amended by Law No. 220 of December 22, 1999)

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CHAPTER I GENERAL PROVISIONS

Purpose

1. The purpose of this Law shall be to encourage inventions by promoting their protection and utilization so as to contribute to the development of industry.

Definitions

2.—(1) “Invention” in this Law means the highly advanced creation of technical ideas by which a law of nature is utilized.

(2) “Patented invention” in this Law means an invention for which a patent has been granted.

(3) “Working” of an invention in this Law means the following acts:

(i) in the case of an invention of a product, acts of manufacturing, using, assigning, leasing, importing or offering for assignment or lease (including displaying for the purpose of assignment or lease — hereinafter the same) of the product;

(ii) in the case of an invention of a process, acts of using the process;

(iii) in the case of an invention of a process of manufacturing a product, acts of using, assigning, leasing, importing or offering for assignment or lease of the product manufactured by the process, in addition to the acts mentioned in the preceding paragraph.

Computation of Time Limits

3.—(1) Time limits fixed in this Law or an order or ordinance under this Law shall be computed according to the following provisions:

(i) the first day of the period shall not be included. However, this provision shall not apply when the period begins from 00.00 a.m.;

(ii) when the period is expressed in months or years, it shall be counted according to the calendar. When the period is not computed from the beginning of a month or year, it shall expire on the day preceding the day of the last month or year corresponding to the day on which the computation begins. However, where there is no corresponding day in the last month, it shall expire on the last day of that month.

(2) Where the last day of a period prescribed for the filing of a patent application or demand for any other procedure relating to a patent (hereinafter referred to as “procedure”) falls on a Sunday, a holiday referred to in each of the paragraphs of Section 1(1) of the Law concerning holidays of administrative organizations (Law No. 91 of 1988), the last day of the period shall be the day following such holiday or holidays.

Extension of Time Limits

4. The Commissioner of the Patent Office may, for the benefit of a person residing in a place that is remote or difficult to access, extend upon request *ex officio* the period prescribed in Section 108(1), 121(1) or 173(1).

5.—(1) The Commissioner of the Patent Office, the trial examiner-in-chief for the examiner may, where he has designated a time limit for a procedure to be initiated under this Law, extend the time limit upon request *ex officio*.

(2) The trial examiner-in-chief may, where he has designated a date under this Law, change the date upon request *ex officio*.

Capacity of Associations, etc. which are not Legal Entities to Proceed Before the Office

6. Capacity of associations, etc. which are not legal entities to proceed before the Office

(1) An association or foundation which is not a legal entity but for which an officer representing it or an administrator has been designated may, in its name:

(i) make a request for examination;

(ii) file an opposition to the patent;

(iii) demand a trial under Section 123(1) or 125 *bis*(1);

(iv) demand a retrial against a final and conclusive retrial decision under Section 123(1) or 125 *bis*(1), in accordance with Section 171(1).

(2) An association or foundation which is not a legal entity but for which an officer representing it or an administrator has been designated may be made a party in its name to a retrial against a final and conclusive retrial decision under Section 123(1) or 125 *bis*(1).

*Capacity of Minors or Majors under Guardianship, etc.
to Proceed before the Office*

7.—(1) Minors and majors placed under guardianship may proceed before the Office only through their legal representatives. However, this provision shall not apply where a minor can perform a legal act independently.

(2) Where a person under curatorship proceeds before the Office, he shall obtain the consent of his curator.

(3) Where a legal representative proceeds before the Office and there is a supervisor of the guardian, the former shall obtain the consent of the latter.

(4) Where a person placed under curatorship or a legal representative takes part in a procedure with regard to an opposition to the patent, a retrial or retrial demanded by an adverse party, the two preceding subsections shall not apply.

Patent Administrator for Residents Abroad

8.—(1) A person who has neither his domicile nor residence (nor, in the case of a legal entity, its establishment) in Japan (hereinafter referred to as “resident abroad”) may not, except where prescribed by Cabinet Order, proceed before the Office or institute a suit against any measure taken by an administrative agency in accordance with this Law or an order or ordinance thereunder, except through his representative with respect to his patent who has his domicile or residence in Japan (hereinafter referred to as “patent administrator”).

(2) The patent administrator shall represent the principal in all procedures and in a suit instituted against a measure taken by an administrative agency in accordance with this Law or an order or ordinance thereunder. However, this provision shall not apply where a resident abroad restricts the scope of power of attorney of his patent administrator.

Scope of Powers of Attorney

9. A representative of a person who is domiciled or a resident (or, in the case of a legal entity, established) in Japan and who is proceeding before the Office shall not, unless expressly so empowered, convert, abandon or withdraw a patent application, withdraw an application for registration of an extension of the term of a patent right, withdraw a demand, request for motion, make or withdraw a priority claim under Section 41(1), make a request for laying open of an application, demand a trial under Section 121(1), surrender a patent right or appoint a substitute-representative.

Proof of Powers of Attorney

10. [Deleted]

Non-Extinguishment of Powers of Attorney

11. The power of attorney of a representative of a person proceeding before the Office shall not become extinguished on the principal's death or on merger in the case of a legal entity, or on the termination of the duty of trust, where a trustee is the principal, or on the death of a legal representative or on the modification or extinguishment of his power of attorney.

Independent Representation

12. Where a person proceeding before the Office has two or more representatives, each of them shall represent the principal.

Replacement of Representatives, etc.

13.—(1) The Commissioner of the Patent Office or the trial examiner-in-chief may, if he considers a person proceeding before the Office to be incompetent, order a representative to act.

(2) The Commissioner of the Patent Office or the trial examiner-in-chief may, if he considers the representative of a person proceeding before the Office to be incompetent, order him to be replaced.

(3) In the case of the preceding two subsections, the Commissioner of the Patent Office or the trial examiner-in-chief may order that a patent attorney be the representative.

(4) The Commissioner of the Patent Office or the trial examiner-in-chief may dismiss any action taken before the Office by a person or representative referred to respectively in Subsection (1) or (2) after the issuance of an order under Subsection (1) or (2).

Mutual Representation of Parties

14. Where two or more persons are jointly proceeding before the Office, each of them shall represent the other or others with respect to a procedure other than the conversion, surrender and withdrawal of a patent application, the withdrawal of an application for registration of an extension of the term of a patent right, the withdrawal of a demand, request, or motion, the making and withdrawal of a priority claim under Section 41(1), the making of a request for laying open of an application, and the demand for a trial under Section 121(1). However, this provision shall not apply where they have appointed a representative for both or all of them and have notified the Office accordingly.

Venue of Court for Residents Abroad

15. With respect to a patent right or other right relating to a patent of a resident abroad, the domicile or residence of his patent administrator or, where there is no such administrator, the location of the Patent Office shall be the place of the property under Section 5(iv) of the Code of Civil Procedure (Law No. 109 of 1996).

Ratification of Acts of Persons Lacking Capacity

16.—(1) The acts of a minor (other than one who has independent capacity to perform legal acts) or of a minor placed under guardianship may be ratified by his legal representative (or by the principal when he has gained capacity to proceed before the Office).

(2) The acts of a person who has no power of attorney may be ratified by the principal when he has capacity to proceed before the Office or by his legal representative.

(3) The acts of a person placed under curatorship taken without this curator's consent may be ratified by such person with his curator's consent.

(4) The acts of a legal representative taken without the consent of a supervisor of the guardian, where there is such a supervisor, may be ratified by the legal representative when he has obtained the supervisor's consent or by the principal when he has gained capacity to proceed before the Office.

Amendment of Proceedings

17.—(1) A person who is proceeding before the Office may make amendments only during the pendency of the case before the Office. However, subject to the subsequent Section 17bis, he may not amend the specification, the drawings or the abstract attached to the request as well as the corrected specification or drawings attached to the written demand under Section 126(1), Section 134(2) or 120bis(2).

(2) Notwithstanding the principal sentence of Subsection (1), an applicant of a foreign language file application referred to in Section 36bis(2) may not amend the foreign language file and foreign language abstract referred to in Section 36bis(1).

(3) The Commissioner of the Patent Office may invite amendment, designating an adequate time limit, in the following cases:

- (i) when the requirements of Section 7(1) to (3) or 9 have not been complied with;
- (ii) when the formal requirements specified in this Law or in an order or ordinance thereunder have not been complied with;
- (iii) when the fees due to be paid under Section 195(1) to (3) have not been paid with respect to a procedure.

(4) Subject to Section 17 *bis*(2), any amendment under the principal sentence of Subsection (1) of this Section (except in the case of the payment of fees) shall be submitted in writing.

Amendment of Specification or Drawings Attached to Request

17bis.—(1) An applicant for a patent may, before the transmittal of the copy of an examiner's decision that a patent is to be granted, amend the specification or drawings attached to the request. However, after the receipt of the notification under Section 50, the amendment may be made only in the following cases:

(i) where the applicant has received a first notification (referred to in this Section as "notification of reasons for refusal") under Section 50 [including its application under Section 159(2) (including its application under Section 174(2) and under Section 163(2)) (hereinafter referred to in this paragraph as "Section 50")] and an amendment is made within the time limit designated in accordance with Section 50;

(ii) where the applicant has received a notification of refusal and an amendment is made within the time limit designated in accordance with Section 50 with respect to the final notification of reasons for refusal;

(iii) where the applicant demands a trial under Section 121(1) and an amendment is made within 30 days of such demand.

(2) Where the applicant of a foreign language file application under Section 36 *bis*(2) amends the specification or drawings under Subsection (1) for the object of the correction of an incorrect translation, he shall submit a written correction of an incorrect translation stating the grounds thereof.

(3) An amendment of the specification or drawings under Subsection (1) shall, except in the case of submission of the written correction of an incorrect translation, remain within the scope of the features disclosed in the specification or drawings originally attached to the request [in the case of a foreign language file application under Section 36 *bis*(2), the translation of the foreign language file referred to in said Subsection (2) is considered to be a specification and drawings by virtue of the provisions of said Section (4) (in the case where the applicant amended the specification or drawings by submitting of the written correction of an incorrect translation, said translation, the specification or drawings as amended)].

(4) Subject to the provisions of the preceding subsection, in the case of Subsection (1)(ii) and (iii) of this Section, the amendment of the claim or claims shall be limited to the following:

(i) the cancellation of the claim or claims referred to in Section 36(5);

(ii) the restriction of the claim or claims (only the restriction of all or some of the matters necessary to define the invention claimed in the claim or claims under Section 36(5) and the industrial applicability and the problem to be solved of the invention claimed in the amended claim or claims are the same as those of the invention claimed in the claim or claims prior to the amendment);

(iii) the correction of errors in the description;

(iv) the clarification of an ambiguous description (only the amendment with respect to the matters mentioned in the reasons for the refusal concerned in the notification of the reasons for the refusal).

(5) Section 126(4) shall apply *mutatis mutandis* to the case of the preceding subsection.

Amendment of Abstract

17ter. An applicant for a patent may amend the abstract within one year and three months from the filing date of his patent application (excluding the period after a request made for laying open of an application) [or— in the case of a patent application containing a priority claim under Section 41(1) —the filing date of the earlier application referred to in Section 41(1), —in the case of a patent application containing a priority claim under Section 43(1) or 43 bis(1) or (2) —the filing date of the first application or the application considered to be the first application in accordance with Article 4C(4) of the Paris Convention (meaning the Paris Convention for the Protection of Industrial Property of March 20, 1883, as revised at Brussels on December 14, 1900, at Washington on June 2, 1911, at Hague on November 6, 1925, at London on June 2, 1934, at Lisbon on October 31, 1958, and at Stockholm on July 14, 1967—hereinafter the same) or of an application recognized as the first application in accordance with 4A(2) of the Paris Convention; and in the case of a patent application containing two or more priority claims under 41(1), 43(1) or 43 bis(1) or (2), from the earliest date amongst the filing dates of the applications whose priorities are so claimed —the same meaning as Section 64(1)].

Amendment of Corrected Specification or Drawings

17quater.—(1) A patentee may amend the corrected specification or drawings attached to the writtendemand for a correction under Section 120 bis(2), only within the time limit designated under Section 165 as applied under Section 120 bis(1) or (3).

(2) The defendant of a trial under Section 123(1) may amend the specification or drawings attached to the writtendemand for a correction under Section 134(2), only within

the time limit designated under Section 134(1), under Section 165 as applied under Section 134(5) or under Section 153(2).

(3) The demandant of a trial under Section 126(1) may amend the specification or drawings attached to the writtendemand for a trial under Section 126(1), only before he is notified under Section 156(1) (in the case where the trial has been reopened under Section 156(2), before he is notified again under Section 156(1)).

Dismissal of Procedure

18.—(1) The Commissioner of the Patent Office may dismiss a procedure when a person whom he has invited to make an amendment in accordance with Section 17(3) fails to do so within the time limit designated in accordance with that subsection or when a person who is to obtain registration of the establishment of a patent right fails to pay the annual fees within the time limit fixed in Section 108(1).

(2) The Commissioner of the Patent Office may dismiss an application for a patent where he has invited the applicant, in accordance with Section 17(3), to pay the fee under Section 195(3) and the applicant fails to do so within the time limit designated in accordance with Section 17(3).

Dismissal of an Irregular Procedure

18bis.—(1) The Commissioner of the Patent Office shall dismiss an irregular procedure which cannot be amended.

(2) Where the Commissioner of the Patent Office intends to dismiss a procedure under the preceding subsection, he shall notify the person who is proceeding of the reasons for dismissal designating an adequate time limit and give him an opportunity to submit a statement describing an explanation (hereinafter referred to as “explanatory statement”).

Time of Submission of Request, etc.

19. Where a request, document or any other matter to be submitted to the Patent Office in accordance with this Law, or an order or ordinance thereunder, within a specified time limit is sent by mail, the request, document or matters shall be deemed to have reached the Office at the date and time when it was handed into a post office, if such date and time are proved by the receipt of the mail, or at the date and time on the postmark if they are clearly indicated, or at 12.00 p.m. on the date indicated on the postmark if only the date is clear.

Succession to Effect of Procedure

20. The effects of a procedure regarding a patent right or other right relating to a patent shall extend to a successor in title.

Continuation of Procedure

21. Where a patent right or other right relating to a patent is transferred while the case is pending in the Patent Office, the Commissioner of the Patent Office or the trial examiner in-chief may continue the procedure concerned on behalf of his successor in title.

Interruption or Suspension of Procedure

22.—(1) The Commissioner of the Patent Office or the trial examiners shall, in regard to a motion for the resumption of a procedure interrupted after the transmittal of a ruling, an examiner's decision or a trial decision, render a ruling as to whether the procedure may be resumed.

(2) Such a ruling shall be in writing and state the reason therefor.

23.—(1) Where a person who is to resume the procedure for an examination or a trial examination of the opposition to the patent and ruling thereon, a trial or retrial which has been interrupted fails to do so, the Commissioner of the Patent Office or the trial examiners shall, upon a motion *ex officio*, order such person to resume the procedure and designate an adequate time limit for this purpose.

(2) Where the procedure is not resumed within the time limit designated in accordance with the preceding subsection, the resumption may be deemed by the Commissioner of the Patent Office or the trial examiner to have commenced on the date when the time limit expired.

(3) When the resumption is deemed to have taken place, in accordance with the preceding subsection, the Commissioner of the Patent Office or the trial examiner in-chief shall notify the parties accordingly.

24. Sections 124 (excluding Subsection (1)(iv)), 125 to 127, 128(1), 130, 131 and 132(2) (interruption or suspension of litigation) of the Code of Civil Procedure shall apply *mutatis mutandis* to a procedure with respect to an examination, a trial examination of an opposition to the patent and ruling thereon, a trial or retrial. In such a case, a "process attorney" in Section 124(2), "court" in Section 127, "court" in Section 128(1) and 131, and "court" in Section 130 of the said Code shall read, respectively, "representative entrusted with the examination, trial examination of an opposition to the patent and ruling thereon, a trial or retrial," "Commissioner of the Patent Office or the trial examination in-chief," "Commissioner of the Patent Office or the trial examiner," and "Patent Office."

Enjoyment of Rights by Aliens

25. An alien who is neither domiciled nor a resident (not established, in the case of a legal entity) in Japan shall not enjoy a patent right or other right relating to a patent, except in any one of the following cases:

(i) where his country allows Japanese nationals to enjoy patent rights or other rights relating to a patent under the same conditions as its own nationals;

(ii) where his country allows Japanese nationals to enjoy patent rights or other rights relating to a patent under the same conditions as its own nationals provided that Japan allows his country's nationals to enjoy such rights;

(iii) where there are specific provisions in a treaty.

Effect of Treaty

26. Where there are specific provisions relating to patents in a treaty, such provisions shall prevail.

Registration in Patent Register

27.—(1) The following matters shall be registered in the Patent Register kept in the Patent Office:

(i) the establishment, extension of the term, transfer, extinguishment, restoration or restriction on disposal, of a patent right;

(ii) the establishment, maintenance, transfer, modification, extinguishment or restriction on disposal, of an exclusive or non-exclusive license;

(iii) the establishment, transfer, modification, extinguishment or restriction on disposal, of rights in a pledge upon a patent right or an exclusive or non-exclusive license.

(2) The Patent Register, either in whole or in part, may be prepared by means of magnetic tapes (including other materials on which matters can be accurately recorded by an equivalent method—hereinafter referred to as “magnetic tapes”).

(3) Other matters relating to registration that are not provided for in this Law shall be prescribed by Cabinet Order.

Issuance of Certificate of Patent

28.—(1) When the establishment of a patent right has been registered or when a ruling or trial decision to the effect that the specification or drawings attached to the request are to be corrected has become final and conclusive and such decision has been registered, the Commissioner of the Patent Office shall issue the certificate of patent to the patentee.

(2) The issuance of the certificate of patent shall be prescribed by an ordinance of the Ministry of Economy, Trade and Industry.

CHAPTER II PATENTS AND APPLICATIONS FOR PATENTS

Patentability of Inventions

29.—(1) Any person who has made an invention which is industrially applicable may obtain a patent therefor, except in the case of the following inventions:

(i) inventions which were publicly known in Japan or elsewhere prior to the filing of the patent application;

(ii) inventions which were publicly worked in Japan or elsewhere prior to the filing of the patent application;

(iii) inventions which were described in a distributed publication or made available to the public through electric telecommunication lines in Japan or elsewhere prior to the filing of the patent application.

(2) Where an invention could easily have been made, prior to the filing of the patent application, by a person with ordinary skill in the art to which the invention pertains, on the basis of an invention or inventions referred to in any of the paragraphs of Subsection (1), a patent shall not be granted for such an invention notwithstanding Subsection (1).

29bis. Where an invention claimed in a patent application is identical with an invention or device (excluding an invention or device made by the same person as the inventor of the invention claimed in the patent application) disclosed in the specification or drawings originally attached to the request of another application for a patent (in the case of a foreign language file application referred to in Section 36 *bis*(2) of this Law, the foreign language file referred to in Section 36 *bis*(1) of the said Law) or of an application for a utility model registration which was filed prior to the filing date of the patent application and for which the Patent Gazette which states the matter referred to in each paragraph of Section 66(3) of the said Law (hereinafter referred to as “the Gazette containing the Patent”) was published under the said subsection or the laying open for public inspection (*Kôkai*) was effected or the Utility Model Gazette which states the matter referred to in each paragraph of Section 14(3) of Utility Model Law (No. 123 of 1959) (hereinafter referred to as “the Gazette containing the Utility Model”) was published under the said subsection after the filing of the patent application, a patent shall not be granted for the invention notwithstanding Section 29(1). However, this provision shall not apply where, at the time of filing of the patent application, the applicant of the patent application and the applicant of the other application for a patent or the application for a utility model registration are the same person.

Exceptions to Lack of Novelty of Invention

30.—(1) In the case of an invention which has fallen under any of the paragraphs of Section 29(1) by reason of the fact that the person having the right to obtain a patent has conducted an experiment, has made a presentation in a printed publication, has made a presentation through electric telecommunication lines, or has made a presentation in writing at a study meeting held by a scientific body designated by the Commissioner of the Patent Office, such inventions shall be deemed not to have fallen under any of the paragraphs of Section 29(1) for the purposes of Section 29(1) and (2) to the invention claimed in the patent application which has been filed by such person within six months from the date on which the invention first fell under those paragraphs.

(2) In the case of an invention which has fallen under any of the paragraphs of Section 29(1) against the will of the person having the right to obtain a patent, the preceding subsections shall also apply for the purposes of Section 29(1) and (2) to the invention claimed in the patent application which has been filed by such person within six months from the date on which the invention first fell under any of those paragraphs.

(3) In the case of an invention which has fallen under any of the paragraphs of Section 29(1) by reason of the fact that the person having the right to obtain a patent has exhibited the invention at an exhibition held by the Government or by any local public entity (hereinafter referred to as the "Government, etc.") or at one which is not held by the Government, etc. but is designated by the Commissioner of the Patent Office, or at an international exhibition held in the territory of a country party to the Paris Convention or of a Member of the World Trade Organization by its government, etc. or by a person authorized thereby, or at an international exhibition held in the territory of a country not party to the Paris Convention nor a member of the World Trade Organization by its government, etc. or by a person authorized thereby where such exhibition has been designated by the Commissioner of the Patent Office, Subsection (1) shall also apply for the purposes of Section 29(1) and (2) to the invention claimed in the patent application which has been filed by such person within six months from the date on which the invention first fell under those paragraphs.

(4) Any person who desires the application of Subsection (1) or the preceding subsections shall submit a written statement to that effect to the Commissioner of the Patent Office simultaneously with the patent application and within 30 days of the filing of the patent application, he shall also submit to the Commissioner of the Patent Office a document proving that the invention that has fallen under any of the paragraphs of Section 29(1) is the invention for which the provision of Subsection (1) or the preceding subsection may be applicable.

31. [Deleted]

Unpatentable Inventions

32. The inventions liable to contravene public order, morality or public health shall not be patented, notwithstanding Section 29.

Right to Obtain Patent

33.—(1) The right to obtain a patent may be transferred.

(2) The right to obtain a patent may not be the subject of a pledge.

(3) A joint owner of the right to obtain a patent may not assign his share without the consent of all the other joint owners.

34.—(1) The succession to the right to obtain a patent before the filing of the patent application shall not be effective against third persons unless the successor in title files the patent application.

(2) Where two or more applications for a patent are filed on the same date, on the basis of the same right to obtain a patent that has been derived by succession from the same person, the succession by any person other than the one agreed upon by the patent applicants shall not be effective against third persons.

(3) The preceding subsections shall also apply where a patent application and a utility model application are filed on the same date, on the basis of a right to obtain a patent and a utility model registration for the same invention and device which has been derived by succession from the same person.

(4) The succession to the right to obtain a patent after the filing of the patent applications shall not take effect unless the Commissioner of the Patent Office is notified accordingly, except in the case of inheritance or other general succession.

(5) Upon inheritance or other general succession with respect to a right to obtain a patent, the successor in title shall notify the Commissioner of the Patent Office accordingly without delay.

(6) Where two or more notifications are made on the same date, on the basis of the same right to obtain a patent that has been derived by succession from the same person, a notification made by any person other than the one agreed upon after mutual consultation among the persons making the notifications shall not take effect.

(7) Section 39(7) and (8) shall apply *mutatis mutandis* to the cases under Subsections (2), (3) and (6).

Employees' Inventions

35.—(1) An employer, a legal entity or a state or local public entity (hereinafter referred to as the “employer, etc.”) shall have an non-exclusive license on the patent right concerned, where an employee, an executive officer of a legal entity or a national or local public official (hereinafter referred to as the “employee, etc.”) has obtained a patent for an invention which by reason of its nature falls within the scope of the business of the employer, etc. and an act or acts resulting in the invention were part of the present or past duties of the employee, etc. performed on behalf of the employer, etc. (hereinafter referred to as an “employee’s invention”) or where a successor in title to the right to obtain a patent for an employee’s invention has obtained a patent therefor.

(2) In the case of an employee’s invention made by an employee, etc. which is not an employee’s invention, any contractual provision, service regulation or other stipulation providing in advance that the right to obtain a patent or the patent right shall pass to the employer, etc. or that the employer, etc. shall have an exclusive license on such inventions shall be null and void.

(3) The employee, etc. shall have the right to a reasonable remuneration when he has enabled the right to obtain a patent or the patent right with respect to an employee’s invention to pass to the employer, etc. or has given the employer, etc. an exclusive right to such invention in accordance with the contract, service regulations or other stipulations.

(4) The amount of such remunerations shall be decided by reference to the profits that the employer, etc. will make from the invention and to the amount of contribution the employer, etc. made to the making of the invention.

Applications for Patent

36.—(1) Any person desiring a patent shall submit a request to the Commissioner of the Patent Office stating the following:

- (i) the name and the domicile or residence of the applicant for the patent;
- (ii) the name and the domicile or residence of the inventor.

(2) The request shall be accompanied by the specification, any drawings necessary and the abstract.

(3) The specification under Subsection (2) shall state the following:

- (i) the title of the invention;
- (ii) a brief explanation of the drawings;
- (iii) a detailed explanation of the invention;
- (iv) patent claim(s).

(4) The detailed explanation of the invention under the preceding Subsection (iii) shall state the invention, as provided for in an ordinance of the Ministry of Economy, Trade and Industry, in a manner sufficiently clear and complete for the invention to be carried out by a person having ordinary skill in the art to which the invention pertains.

(5) In the patent claim under Subsection (3)(iv), there shall be set forth, by statements separated on a claim-by-claim basis, all matters which an applicant for a patent considers necessary in defining an invention for which a patent is sought. In such a case, it shall not preclude the statements of the patent claim(s) to be such that an invention claimed in one claim is the same as an invention claimed in another claim.

(6) The statement of the patent claim(s) under Subsection (3)(iv) shall comply with each of the following paragraphs:

- (i) statements setting forth the invention(s) for which patent is sought and which is described in the detailed explanation of the invention;
- (ii) statements setting forth the invention(s) for which a patent is sought and which is clear;
- (iii) statements setting forth the claim(s) which is concise;
- (iv) statements which are as provided for in an ordinance of the Ministry of Economy, Trade and Industry.

(7) The abstract under Subsection (2) shall state the summary of the invention disclosed in the specification or drawings and other matters provided for in an ordinance of the Ministry of Economy, Trade and Industry.

36bis.—(1) Any person desiring a patent may, in lieu of the specification, drawings necessary and abstract under the preceding Section (2), attach to the request a paper stating the matter to be stated in the specification under the preceding Section (3) to (6) in a foreign language specified in an ordinance of the Ministry of Economy, Trade and Industry and any text matter of the drawings in the foreign language (hereinafter referred to as the “foreign language file”) and a paper stating the matter to be stated in the abstract under the preceding Section (7) in the foreign language (hereinafter referred to as the “foreign language abstract”).

(2) The applicant of an application for a patent to which he has attached the foreign language file and foreign language abstract to the request under the preceding subsection (hereinafter referred to as the “foreign language file application”) shall furnish to the Commissioner of the Patent Office a translation into Japanese of the foreign language file and foreign language abstract within two months from the filing date of the application for a patent.

(3) Where the translation of the foreign language file (excluding the drawings) referred to in the preceding subsection has not been furnished within the time limit prescribed in that subsection, the application for a patent shall be deemed withdrawn.

(4) The translation of the foreign language file referred to in Subsection (2) is deemed to be the specification and drawings as submitted attached to the request under the preceding Section (2) and the translation of the foreign language abstract referred to in Subsection (2) is deemed to be the abstract as submitted attached to the request under the preceding Section (2).

37. Where there are two or more inventions, they may be the subject of a patent application in the same request provided that these inventions are of an invention claimed in one claim (hereinafter referred to as “the specified invention”) and of another or other inventions having the relationship as indicated below with respect to such specified invention:

(i) inventions of which the industrial applicability and the problem to be solved are the same as those of the specified invention;

(ii) inventions of which the industrial applicability and the substantial part of the features stated in the claim are the same as those of the specified invention;

(iii) where the specified invention relates to a product, inventions of process of manufacturing the product, inventions of process of using the product, inventions of process used for handling the product, inventions of machines, instruments, equipment or other things used for manufacturing the product, inventions of products solely utilizing the specific properties of the product, or inventions of things used for handling the product;

(iv) where the specified invention relates to a process, inventions of machines, instruments, equipment or other things used directly in the working of the specified invention;

(v) inventions having a relationship as provided for in Cabinet Order.

Joint Applications

38. Where the right to obtain a patent is owned jointly, the patent may only be applied for jointly by all the joint owners.

First-to-File Rule

39.—(1) Where two or more patent applications relating to the same invention are filed on different dates, only the first applicant may obtain a patent for the invention.

(2) Where two or more patent applications relating to the same invention are filed on the same date, only one such applicant, agreed upon after mutual consultation among all the applicants, may obtain a patent for the invention. If no agreement is reached or no consultation is possible, none of the applicants shall obtain a patent for the invention.

(3) Where an invention claimed in a patent application is the same as a device claimed in a utility model application and the applications are filed on different dates, the patent applicant may obtain a patent only if his application was filed before the utility model application.

(4) Where an invention claimed in a patent application is the same as a device claimed in a utility model application and the applications are filed on the same date, only one applicant, agreed upon after mutual consultation between the applicants, may obtain the patent or the utility model registration. If no agreement is reached or no consultation is possible, the patent applicant shall not obtain a patent for the invention.

(5) Where a patent application or a utility model application is abandoned, withdrawn or dismissed, or where an examiner's decision or trial decision that a patent application is to be refused has become final and conclusive, such applications shall, for the purposes of Subsections (1) to (4), be deemed never to have been made. However, this provision shall not apply where an examiner's decision or a trial decision that the patent application is to be refused under the provision of the last sentence of Subsection (2) or (4) becomes final and conclusive.

(6) A patent application or a utility model application filed by a person who is neither the inventor nor the creator nor the successor in title to the right to obtain a patent or utility model registration shall, for the purposes of Subsections (1) to (4), be deemed not to be a patent application or a utility model application.

(7) The Commissioner of the Patent Office shall, in the case of Subsection (2) or (4), order the applicant to hold consultations for an agreement under Subsection (2) or (4) and to report the result thereof, within an adequate time limit.

(8) Where the report under the preceding subsection is not made within the time limit designated in accordance with that subsection, the Commissioner of the Patent Office may deem that no agreement under Subsection (2) or (4) has been reached.

40. [Deleted]

Priority Claim Based on Patent Application, etc.

41.—(1) Any person desiring a patent may declare a priority claim for the invention claimed in a patent application on the basis of the invention which has been disclosed in the specification or drawings originally attached to the request (in the case where the earlier application is a foreign language file application, the foreign language file) of a patent or utility model application in which he has the right to obtain a patent or utility model registration and which has been filed earlier (hereinafter referred to as an “earlier application”) except in the following cases:

(i) the patent application concerned is not one filed within one year from the filing date of the earlier application;

(ii) the earlier application is a new patent application divided out from a patent application under Section 44(1), a patent application converted from an application under Section 46(1) or (2), or a new utility model application divided out from a utility model application under Section 44(1) of this Law as applied under Section 11(1) of the Utility Model Law or a utility model application converted from an application under Section 10(1) or (2) of the Utility Model Law;

(iii) at the time when the patent application concerned is filed, the earlier application has been abandoned, withdrawn or dismissed;

(iv) at the time when the patent application concerned is filed, the examiner’s decision or the trial decision on the earlier application has become final and conclusive;

(v) at the time when the patent application concerned is filed, the registration of establishment referred to in Section 14(2) of the Utility Model Law with respect to the earlier application has been effected.

(2) For inventions which are among those claimed in a patent application containing a priority claim under Subsection (1) and which are disclosed in the specification or drawings (in the case where the earlier application is a foreign language file application, the foreign language file) originally attached to the request of an earlier application whose priority is so claimed [in the case where the earlier application contains a priority claim under Subsection (1) or under Section 8(1) of the Utility Model Law or a priority claim under Section 43(1) or Section 43*bis* (1) or (2) of this Law (including its application under Section 11(1) of the Utility Model Law), excluding the inventions disclosed in the document (limited to those equivalent to the specification and drawings) submitted at the time of the filing of the application whose priority is claimed for the earlier application], the patent application concerned shall be deemed to have been filed at the time when the earlier application was filed, for the purposes of Section 29, the principal sentence of Section 29 *bis* and Sections 30(1) to (3), 39(1) to (4), 69(2)(ii), 72, 79, 81, 82(1), 104 [including its application under Section 65(5) (including its application under Section 184 *decies*(2))], and 126(4) (including its application under Sections 17*bis*(5), 120 *bis*(3) and 134(5)) of this Law, for the purposes of Sections 7(3) and 17 of the Utility Model Law, for the purposes of Sections 26, 31(2), and 32(2) of the Design Law (Law No. 125 of 1959) and for the purposes of Section 29, 33 *bis*(1) and 33 *ter*(1) (including its

application under Section 68(3) of the Trademark Law) of the Trademark Law (Law No. 127 of 1959).

(3) For inventions which are amongst those disclosed in the specification or drawings (in the case of a foreign language file application, in the foreign language file) originally attached to the request of a patent application containing a priority claim under Subsection (1) and which are disclosed in the specification or drawings (in the case where the earlier application is a foreign language file application, the foreign language file) originally attached to the request of an earlier application whose priority is so claimed [in the case where the earlier application contains a priority claim under that subsection or Section 8(1) of the Utility Model Law or a priority claim under Section 43(1) or 43 *bis*(1) or (2) of this Law (including its application under Section 11(1) of the Utility Model Law), excluding the inventions disclosed in the documents (limited to those equivalent to the specification and drawings) submitted at the time of the filing of the application whose priority is claimed for the earlier application], the laying open for public inspection or the Gazette containing the Utility Model relating to the earlier applications shall be deemed to have been effected or published at the time when the publication of the Gazette containing the Patent or the laying open for public inspection relating to the patent application concerned was published or effected, for the purposes of the principal sentence of Section 29 *bis* of this Law or the principal sentence of Section 3 *bis* of the Utility Model Law.

(4) A person desiring to declare a priority claim under Subsection (1) shall, simultaneously with the patent application, submit to the Commissioner of the Patent Office a document setting forth that statement to that effect and an identification of the earlier application.

Withdrawal, etc. of Earlier Application

42.—(1) The earlier application whose priority is claimed under Section 41(1) shall be deemed to have been withdrawn at the expiration of one year and three months from the filing date of that earlier application. However, where that earlier application has been abandoned, withdrawn or dismissed, where the examiner's decision or trial decision on that earlier application has become final and conclusive, where the registration of establishment referred to in Section 14(2) of the Utility Model Law with respect to the earlier application has been effected, or where all of the priority claims based on that earlier application have been withdrawn, this provision shall not apply.

(2) The applicant of a patent application containing a priority claim under Section 41(1) shall not withdraw the priority claim after the expiration of one year and three months from the filing date of the earlier application.

(3) Where the patent application containing a priority claim under Section 41(1) is withdrawn within one year and three months from the filing date of the earlier application, the priority claim shall be deemed to have been withdrawn simultaneously.

Priority Claim under the Paris Convention

43.—(1) A person desiring to declare a priority claim in respect of a patent application under D(1) of Article 4 of the Paris Convention shall, simultaneously with the patent application, submit to the Commissioner of the Patent Office a document setting forth a statement to that effect and specifying the country party to the Paris Convention in which the application was first filed, or considered under C(4) of the said Article to have been first filed, or recognized under A(2) of the said Article to have been first filed, as well as the filing date of such application.

(2) A person who has declared a priority claim or priority claims by virtue of the preceding subsections shall submit a written statement to the Commissioner of the Patent Office setting forth the filing date or dates of the application or applications, certified by the country party to the Paris Convention in which the application or applications were first filed, or considered under C(4) of Article 4 of the Paris Convention to have been first filed, or recognized under A(2) of the said Article to have been first filed, as well as a certified copy of each of the specifications and drawings of the inventions or a copy of each of the official gazettes or certificates having the same contents which have been issued by the government of the member country concerned, within one year and four months from the earliest of the following filing dates:

(i) the filing date of said application first filed, or of the said application considered under C(4) of Article 4 of the Paris Convention to have been first filed or of the said application recognized under A(2) of the said Article to have been first filed;

(ii) the filing date or dates of the said application or applications whose priority or priorities are claimed in the case where the patent application contains a priority claim or priority claims under Section 41(1);

(iii) the filing date or dates of the application whose priority is so claimed, where the patent application concerned contains other priority claim under Subsection (1) or Section 43*bis*(1) or (2).

(3) A person who has declared a priority claim by virtue of Subsection (1) shall, together with the documents referred to in the preceding subsection, submit a document to the Commissioner of the Patent Office specifying the number of the first application, or the application considered under C(4) of Article 4 of the Paris Convention or recognized under A(2) of the said Article to be the first application. However, when the number is not available before the submission of the documents referred to in that subsection, he shall submit a document setting forth the reason therefor instead of the document referred to and shall submit a document specifying the number as soon as it becomes available.

(4) Where a person who has declared a priority claim by virtue of Subsection (1) fails to submit the documents referred to in Subsection (2) within the time limit prescribed therein, the priority claim concerned shall lose its effect.

(5) Where a person claiming a priority under Subsection (1) specifying matters written in the documents as referred to in Subsection (2) with the number of the application based on the application which was filed in a country fixed by an ordinance of the Ministry of Economy, Trade and Industry and which can be converted by electromagnetic means (that is,

electronic, magnetic and other means which cannot be perceived by human perception) has submitted a paper setting forth the number of the application to the Commissioner of the Patent Office within a time limit prescribed in Subsection (2), the documents as referred to in Subsection (2) shall be deemed to have been filed for the purposes of the preceding two subsections.

Priority Claim Declared as Governed by the Paris Convention

43bis.—(1) A priority claim based on an application which a person specified in the left-hand column of the following table has filed in or for any country specified in the right-hand column of the following table may be declared as governed by the provision in Article 4 of the Paris Convention for a patent application:

Japanese national or national of a country party to the Paris Convention (including nationals deemed to be the nationals of the country party in accordance with Article 3 of the Paris Convention—hereinafter the same in Subsection (2)).	Member of the World Trade Organization
Nationals of a Member of the World Trade Organization (meaning the nationals of Members provided for in paragraph 3 of Article 1 of the Annex 1 C to the Marrakesh Agreement Establishing the World Trade Organization—hereinafter the same in Subsection (2)).	Country party to the Paris Convention or Member of the World Trade Organization

(2) A priority claim based on an application which the nationals of a country which is neither a party to the Paris Convention nor a Member of the World Trade Organization (limited to the country which allows Japanese nationals to declare a priority claim under the same condition as in Japan and which the Commissioner of the Patent Office designates—hereinafter referred to as the “specified country” in this subsection) and a priority claim based on an application which Japanese nationals or the nationals of a country party to the Paris Convention or a Member of the World Trade Organization have filed in or for any specified country may be declared as governed by the provisions in Article 4 of the Paris Convention for a patent application.

(3) Section 43 shall apply *mutatis mutandis* to the declaration of a priority claim under Subsection (1) or (2).

Division of Patent Applications

44.—(1) An applicant for a patent may divide a patent application comprising two or more inventions into one or more new patent applications only within the time limit by which the specification or drawings attached to the request may be amended.

(2) In such a case, the new patent applications shall be deemed to have been filed at the time of filing of the original application. However, this provision shall not apply where the new patent application is either another application for a patent as referred to in Section 29 *bis* of this Law or an application for a patent as referred to in Section 3 *bis* of the Utility Model Law for the purposes of those sections and of Sections 30(4), 36 *bis* (2), 41(4) and 43(1) (including its application under Section 43 *bis*(3)).

(3) For the purpose of Section 43(2) (including its application in Subsection (3) of the preceding section) where a new application is filed under the provision of Subsection (1), “within one year and four months from the earliest of the filing dates” in Section 43(2) shall read “within one year and four months from the earliest of the filing dates or within three months from the filing date of the new patent application, whichever is later.”

(4) Where the new patent application under Subsection (1) is filed, any statements or documents which have been submitted with respect to the original patent application and which shall be submitted with respect to the new patent application in accordance with Section 30(4), Section 41(4) or Section 43(1) and (2) (including its application under 43 *bis*(3)), shall be deemed to have been submitted to the Commissioner of the Patent Office simultaneously with the said new patent application.

45. [Deleted]

Conversion of Applications

46.—(1) An applicant for a utility model registration may convert this application into a patent application. However, this provision shall not apply after three years from the filing date of the application for a utility model registration.

(2) An applicant for a design registration may convert this application into a patent application. However, this provision shall not apply after 30 days from the transmittal of the examiner's first decision that the design application is to be refused or after lapse of three years from the filing date of the design application (excluding the 30-day period counted from the transmittal of the examiner's first decision that the application is to be refused).

(3) The 30-day period prescribed in the proviso to Subsection (2) shall, when the time limit prescribed in Section 46(1) of the Design Law has been extended in accordance with Section 4 of this Law as applied under Section 68(1) of the Design Law, be deemed to have been extended only for that period as extended.

(4) Where the conversion of an application under Subsection (1) or (2) has been made, the original application shall be deemed to have been withdrawn.

(5) Section 44(2) to (4) shall apply *mutatis mutandis* to the conversion of an application under Subsection (1) or (2).

CHAPTER III THE EXAMINATION

Examination by Examiner

47.—(1) The Commissioner of the Patent Office shall have applications for patent examined by an examiner.

(2) The qualifications of examiners shall be prescribed by Cabinet Order.

Exclusion of Examiners

48. Section 139(i) to (v) and (vii) shall apply *mutatis mutandis* to examiners.

Examination of Patent Applications

48bis. The examination of patent applications shall be carried out upon a request for examination.

Requests for Examination

48ter.—(1) When a patent application has been filed, any person may, within three years from the date thereof, make a request for examination to the Commissioner of the Patent Office.

(2) With respect to a new patent application resulting from the division of a patent application under Section 44(1) or a patent application resulting from the conversion of an application under Section 46(1) or (2), a request for examination may be made even after the period prescribed in the preceding Subsection (1), but only within 30 days from the division of the patent application, or the conversion of the application.

(3) A request for examination may not be withdrawn.

(4) When a request for examination has not been made within the time limit prescribed therefor in Subsection (1) or (2), the patent application concerned shall be deemed withdrawn.

48quater. Any person desiring to make a request for examination shall submit a written request to the Commissioner of the Patent Office stating the following:

(i) the name and the domicile or residence of the person making the request;

(ii) the patent application in respect of which the request for examination is made.

48quinquies.—(1) The Commissioner of the Patent Office shall, where a request for examination has been made before the laying open of the application, publish such fact in the Patent Gazette at the time when the application is laid open or as soon as possible thereafter; where a request for examination has been made after the laying open of the application, he shall publish such fact in the Patent Gazette without delay.

(2) Where a request for examination has been made by a person other than the applicant, the Commissioner of the Patent Office shall notify the applicant accordingly.

Preferential Examination

48sexies. When the Commissioner of the Patent Office recognizes that a person other than the applicant is commercially working the invention claimed in a patent application after the laying open of the application, he may, if necessary, direct the examiner to examine the application in preference to other patent applications.

Examiner's Decision of Refusal

49. The examiners shall make a decision that a patent application is to be refused where it falls under any of the following paragraphs:

- (i) the amendment to the specification or drawings attached to the request does not comply with the requirements under Section 17 bis(3);
- (ii) the invention claimed in the patent application is not patentable under Section 25, 29, 29bis, 32, 38 or 39(1) to (4);
- (iii) the invention claimed in the patent application is not patentable in accordance with the provisions of a treaty;
- (iv) the patent application does not comply with the requirements under Section 36(4) or (6), or Section 37;
- (v) when the patent application concerned is a foreign language file application, the features disclosed in the specification or drawings attached to the request of the patent application do not remain within the scope of the features disclosed in the foreign language document;
- (vi) the applicant for a patent who is not the inventor has not succeeded to the right to obtain a patent for the invention concerned.

Notification of Reasons for Refusal

50. When the examiner intends to render a decision that an application is to be refused, he shall notify the applicant for the patent of the reasons for refusal and give him an opportunity to submit a statement of his arguments, designating an adequate time limit. However, in the case of Section 17 bis(1)(ii), this provision shall not apply to the case of a ruling to decline an application under Section 53(1).

Examiner's Decision that a Patent is to be Granted

51. When the examiner finds no reasons for refusal with respect to the patent application, he shall render a decision that a patent is to be granted.

Formal Requirements of Decision

52.—(1) The examiner's decision shall be in writing and shall state the reasons therefor.

(2) When the examiner's decision has been rendered, the Commissioner of the Patent Office shall transmit a copy of the decision to the applicant.

Declining of Amendments

53.—(1) In the case of Section 17 *bis*(1)(ii), where, prior to the transmittal of the examiner's decision that a patent is to be granted, it is found that an amendment to the specification or drawings attached to the request does not comply with Section 17 *bis*(3) to (5), the examiner shall decline the amendment by a ruling.

(2) The ruling to decline an amendment under the preceding subsection shall be in writing and shall state the reasons therefor.

(3) No appeal shall lie from a ruling to decline an amendment under Subsection (1). However, this provision shall not apply to the examination in a trial demanded under Section 121(1).

Relationship with Litigation

54.—(1) The examination procedure may, if necessary, be suspended, until the ruling on the opposition to the patent or the trial decision has become final and conclusive or litigation procedure has been concluded.

(2) Where a suit or motion for provisional attachment or provisional disposal has been filed, the court may, if necessary, suspend the litigation procedure until the examiner's decision or the trial decision becomes final and conclusive.

55 to 63. [Deleted]

CHAPTER III *BIS*
LAYING OPEN OF APPLICATIONS

Laying Open of Applications

64.—(1) After one year and six months from the filing date of an application, the Commissioner of the Patent Office shall lay the patent application open for public inspection, unless the Gazette containing the Patent has already been published. This provision shall also apply where the request for laying open of an application under Section 64 *bis*(1) is made.

(2) The laying open for public inspection of a patent application shall be effected by publishing the following particulars in the Patent Gazette. However, this provision shall not apply to the particulars referred to in Paragraphs (iv) to (vi) where the Commissioner of the

Patent Officer recognizes that the publication of those particulars in the Patent Gazette is liable to contravene public order or morality:

- (i) the name and the domicile or residence of the applicant;
- (ii) the number and date of the application;
- (iii) the name and the domicile or residence of the inventor;
- (iv) the particulars of the specification and the contents of the drawings attached to the request;
- (v) the particulars stated in the abstract attached to the request;
- (vi) in the case of a foreign language file application, the particulars stated in the foreign language file and foreign language abstract;
- (vii) the number and the date of the laying open;
- (viii) other necessary particulars.

(3) In the case where the Commissioner of the Patent Office recognizes that a statement of the abstract attached to the request does not comply with Section 36(7) or, in other cases where he recognizes it necessary, he may, in lieu of the particulars stated in the abstract under Subsection (2)(v), publish those prepared by himself.

Request for Laying Open of Applications

64bis.—(1) An applicant for patent may request the Commissioner of the Patent Office to lay his application for patent open for public inspection, except the following cases:

- (i) where the patent application has already been laid open for public inspection;
- (ii) where the patent application is the application which has declared the priority claim referred to in Section 43(1) or Section 43 bis(1) or (2) and for which the documents under Section 43(2) (including its application under 43 bis(3)) and the statements under Section 43(5) (including its application under 43 bis(3)) have not been submitted to the Commissioner of the Patent Office;
- (iii) where the patent application is the foreign language file application for which the translation into Japanese of the foreign language file under Section 36 bis(2) has not been submitted to the Commissioner of the Patent Office.

(2) The request for laying open of an application may not be withdrawn.

64ter. An applicant for a patent who desires to request for laying open of the application, shall submit the written request to the Commissioner of the Patent Office, stating the following matters:

- (i) the name and the domicile or residence of the person making the request;

(ii) the patent application in respect of which the request for laying open is made .

Effects of Laying Open of Applications

65.—(1) When an applicant for a patent has, after the laying open of his patent application, given a warning with a written statement setting forth the contents of the invention claimed in the application, he may claim, against a person who has commercially worked the invention, after the warning but before the registration of the establishment of the patent right, the payment of compensation in a sum of money equivalent to what he would be entitled to receive for the working of the invention if the invention were patented. Even in the absence of the warning, the same shall apply to a person who commercially worked the invention before the registration of the establishment of the patent right, knowing that the invention was claimed in the patent application laid open for public inspection.

(2) The right to claim the compensation under the preceding subsection may not be exercised until after the establishment of the patent right is registered.

(3) The exercise of the right to claim the compensation under Subsection (1) shall not preclude the exercise of the patent right.

(4) Where a patent application has been abandoned, withdrawn or dismissed after the laying open of the patent application, or where the examiner's decision or a trial decision that the patent application is to be refused has become final and conclusive, or where the patent right has been deemed never to have existed under Section 112(6) (except where, thereafter, the patent right has been deemed to have existed from the beginning under Section 112 *bis*(2)), or where the ruling or revocation of the patent under Section 114(2) has become final and conclusive, or where, with exception of the cases coming within the proviso to Section 125, a trial decision that the patent is to be invalidated has become final and conclusive, the right under Subsection (1) shall be deemed never to have arisen.

(5) Sections 101 and 104 to 105 *bis* of this Law and Sections 719 and 724 (tort) of the Civil Code (Law No. 89 of 1896) shall apply *mutatis mutandis* to the exercise of the right to claim the compensation under Subsection (1). In such a case, where a person having the right to claim the compensation has become aware, before the registration of the establishment of the patent right, of the fact that the invention claimed in the patent application was being worked and of the person working the invention, "the time when the injured party or his legal representative became aware of such damage and of the person causing it" in Section 724 of the said Code shall read "the date of the registration of the establishment of the patent right."

CHAPTER IV THE PATENT RIGHT

1. The Patent Right

Registration of Establishment of Patent Right

66.—(1) A patent right shall come into force upon registration of its establishment.

(2) The establishment of a patent right shall be registered when the annual fees for the first to the third years under Section 107(1) have been paid or exemption or deferment of such payment has been granted.

(3) Upon registration under the preceding subsection, the following particulars shall be published in the Patent Gazette. However, this provision shall not apply to the particulars listed in Paragraph (v) where the patent application has already been laid open for public inspection:

(i) the name and the domicile or residence of the patentee;

(ii) the number and the filing date of the patent application;

(iii) the name and the domicile or residence of the inventor;

(iv) the particulars stated in the specification and the contents of the drawings attached to the request of the application;

(v) the particulars stated in the abstract attached to the request;

(vi) the patent number and the date of registration of the establishment;

(vii) other necessary particulars.

(4) Section 64(3) shall apply *mutatis mutandis* where the particulars stated in the abstract listed in Section 64(3)(v) are published in the Patent Gazette under Subsection (3).

(5) During five months after the date of publication of the Gazette containing the Patent, the Commissioner of the Patent Office shall make the application file and their attachments available for public inspection at the Patent Office. However, this provision shall not apply to documents or articles liable to injure the reputation or peaceful existence of an individual or documents and articles liable to contravenes public order or morality, which the Commissioner of the Patent Office considers it necessary to keep secret.

(6) Where the Commissioner of the Patent Office is to lay open for public inspection documents or articles other than those liable to injure the reputation or peaceful existence of an individual or documents or articles liable to contravenes public order or morality, which the Commissioner of the Patent Office considers it necessary to keep secret, the Commissioner shall notify a person who has submitted the documents or articles to that effect with a reason therefor.

Term of Patent Right

67.—(1) The term of the patent right shall be 20 years from the filing date of the patent application.

(2) The term of the patent right may be extended, upon application for registration of an extension, by a period not exceeding five years if, because of the necessity of obtaining an

approval or other disposition which is governed by provisions in laws intended to ensure safety, etc. in the working of the patented invention, and which is provided for in Cabinet Order as being such that, in view of the object of the relevant disposition, proceedings, etc., a considerable period of time is required for the proper action for the disposition, there was a period in which it was not possible to work the patented invention.

Registration of Extension of Term of Patent Right

67bis.—(1) A person desiring to apply for registration of an extension of the term of a patent right shall submit to the Commissioner of the Patent Office an application stating the following matters:

- (i) the name and the domicile or residence of the applicant;
- (ii) the Patent Number;
- (iii) the term of the extension applied for (limited to a period not exceeding five years)
- (iv) particular soft disposition as provided for in Cabinet Order referred to in Section 67(2).

(2) The application under the preceding subsections shall be accompanied by materials which give reasons for the extension, as provided for in an ordinance of the Ministry of Economy, Trade and Industry.

(3) The application for registration of an extension of the term of a patent right shall be made within the time limit prescribed by Cabinet Order counting from the date of obtaining the disposition provided for in Cabinet Order referred to in Section 67(2). However, the applications shall not be made after the expiration of the term of a patent right provided for in Section 67(1).

(4) Where a patent is owned jointly, each of the joint owners may not, except jointly with the other owners, apply for registration of an extension of the term of a patent right.

(5) Where an application for registration of an extension of the term of a patent right is filed, the term of the patent right shall be deemed to have been extended. However, this provision shall not apply when the examiner's decision that the application is to be refused has become final and conclusive or when an extension of the term of the patent right has been registered.

(6) When an application for registration of an extension of the term of a patent right is filed, the matters set forth under each of the paragraphs in Subsection (1) and the number and the filing date of the applications shall be published in the Patent Gazette.

67bis-bis.—(1) When it is anticipated impossible to obtain the disposition as provided for in Cabinet Order referred to in Section 67(2) by the day before six months prior to the date of expiration of the term of a patent right as provided for in Section 67(1), a person desiring to apply for registration of an extension of the term of a patent right shall submit by that day to the Commissioner of the Patent Office a document stating the following matters:

(i) the name and the domicile or residence of the person desiring the application;

(ii) the patent number;

(iii) the disposition as provided for in Cabinet Order referred to in Section 67(2).

(2) Where the document required to be submitted under the provision of the preceding subsection is not submitted, application for the registration of an extension of the term of a patent right may not be made for after six months prior to the date of expiration of the term of a patent right as provided for in Section 67(1).

(3) When the document referred to in Subsection (1) is submitted, the matters set forth under each of the paragraphs in Subsection (1) shall be published in the Patent Gazette.

67ter.—(1) The examiners shall make a decision that an application for registration of an extension of a patent right is to be refused where it falls under any of the following paragraphs:

(i) where it is not deemed that the obtaining of the disposition as provided for in Cabinet Order referred to in Section 67(2) was necessary for the working of the patented invention;

(ii) where the disposition as provided for in Cabinet Order referred to in Section 67(2) was not obtained by the patentee, or an exclusive licensee or a registered non-exclusive licensee under the patent;

(iii) where the term for which an extension is applied exceeds the period of time during which the patented invention could not be worked;

(iv) where the person applying for an extension is not the patentee concerned;

(v) where the application does not comply with the requirements of Section 67 *bis*(4).

(2) When the examiner finds no reasons for refusing an application for registration of an extension of the term of a patent right, he shall render a decision that the registration of the extension is to be made.

(3) When the examiner's decision or the trial decision is rendered to the effect that the registration of an extension of the term of the patent right is to be made, the registration is made to the effect that the term of the patent right has been extended.

(4) When the registration under the preceding paragraph is made, the following particulars shall be published in the Patent Gazette:

(i) the name and the domicile or residence of the patentee;

(ii) the Patent Number;

(iii) the number and the filing date of the application for registration of the extension of the patent right;

(iv) the date of the registration of the extension;

(v) the term of the extension;

(vi) particulars of the disposition as provided for in Cabinet Order referred to in Section 67(2).

67^{quater}. Sections 47(1), 48, 50 and 52 shall apply *mutatis mutandis* to the examination of an application for registration of an extension of the term of a patent right.

Effects of Patent Right

68. A patentee shall have an exclusive right to commercially work the patented invention. However, where the patent right is the subject of an exclusive license, this provision shall not apply to the extent that the exclusive licensee exclusively possesses the right to work the patented invention.

Effects of the Term Extended Patent Right

68^{bis}. The effects of the patent right of which the term has been extended (including cases in which the term is deemed to be extended under Section 67^{bis}(5)) shall not extend to acts other than the working of the patented invention concerned in respect of the product (where, in the disposition concerned, any specific use of such product to be used was specified, the product used for such specific use) which was the subject of the disposition as provided for in Cabinet Order referred to in Section 67(2) and as being the ground for the registration of the extension.

Limit of Patent Right

69.—(1) The effects of the patent right shall not extend to the working of the patent right for the purposes of experiment or research.

(2) The effects of the patent right shall not extend to the following:

(i) vessels or aircraft merely passing through Japan or machines, instruments, equipment or other accessories used therein;

(ii) products existing in Japan prior to the filing of the patent application.

(3) The effects of the patent right for inventions of medicines (namely, products used for the diagnosis, cure, medical treatment or prevention of human diseases—hereinafter referred to as “medicines” in this subsection) to be manufactured by mixing two or more medicines or for inventions of processes for manufacturing medicines by mixing two or more medicines shall not extend to acts of preparing medicines in accordance with the prescriptions of physicians or dentists or to medicines prepared in accordance with the prescriptions of physicians or dentists.

Technical Scope of Patented Inventions

70.—(1) The technical scope of a patented invention shall be determined on the basis of the statements of the patent claim(s) in the specification attached to the request.

(2) In the case of the preceding subsection, the meaning of a term or terms of the patent claim(s) shall be interpreted in the light of the specification excluding the patent claim(s) and the drawings.

(3) In the case of Subsections (1) and (2), no statements of the abstract attached to the request shall be taken into account for such purpose.

71.—(1) A request for interpretation may be made to the Patent Office with respect to the technical scope of a patented invention.

(2) Where such a request is made, the Commissioner of the Patent Office shall designate three trial examiners to give the requested interpretation.

(3) Sections 131(1) and the principal sentence of (2), 132(1) and (2), 133, 133 *bis*, 134(1), (3) and (4), 135, 136(1) and (2), 137(2), 138, 139 (excluding (vi)), 140 to 144, 144 *bis* (1) and (3) to (5), 145(2) to (5), 146, 147(1) and (2), 150(1) to (5), 151 to 154, 155(1), 157 and 169(3), (4) and (6) shall apply *mutatis mutandis* to the interpretation under Subsection (1). In such a case, “a trial decision” in Section 135 shall read “a ruling”, “a trial other than the trial under the preceding subsection” in Section 145(2) shall read “a trial examination of interpretation”, “where public order or morality is liable to be injured thereby” in the proviso to Section 145(5) shall read “where the trial examiner-in-chief considers it necessary”, “Section 147” in Section 151 shall read “Section 147(1) and (2)”, “before a trial decision becomes final and conclusive” in Section 155(1) shall read “before the written interpretation is transmitted” respectively.

(4) No appeal shall lie from the ruling under Section 135 as applied under the preceding subsection.

71bis.—(1) Where the Commissioner of the Patent Office is commissioned by a court to give an expert opinion with respect to the technical scope of a patented invention, he shall appoint three trial examiners to give the opinion.

(2) Sections 136(1) and (2), 137(2) and 138 shall apply *mutatis mutandis* to the commission therefor under the preceding subsection.

Relationship with Another's Patented Invention, etc.

72. When a patented invention would utilize another person's patented invention, registered utility model or registered design or designs similar thereto under an application filed prior to the filing date of the patent application concerned, or when the patent right conflicts with another person's design right or trademark right under an application for registration of a design filed prior to the filing date of the patent application concerned, the patentee, exclusive licensee or non-exclusive licensee shall not commercially work the patented invention.

Joint Patent Rights

73.—(1) Each of the joint owners of a patent right may neither transfer his share nor establish a pledge upon it without the consent of all the other joint owners.

(2) Each of the joint owners may, except as otherwise prescribed by contract, work the patented invention without the consent of the other joint owners.

(3) Each of the joint owners may grant neither an exclusive license nor a non-exclusive license without the consent of all the other joint owners.

74. [Deleted]

75. [Deleted]

Extinguishment of Patent Right in Absence of Heir

76. A patent right shall be extinguished when there is no person claiming to be an heir within the period prescribed by Section 958 of the Civil Code.

Exclusive Licenses

77.—(1) A patentee may grant an exclusive license on his patent right.

(2) An exclusive licensee shall have an exclusive right to commercially work the patented invention to the extent laid down in the license contract.

(3) An exclusive license may be transferred only together with the business in which it is worked, or only with the consent of the patentee or in the case of inheritance or other general succession.

(4) An exclusive licensee may establish a pledge or grant a non-exclusive license on the exclusive license only with the consent of the patentee.

(5) Section 73 shall apply *mutatis mutandis* to exclusive licenses.

Non-Exclusive Licenses

78.—(1) A patentee may grant a non-exclusive license on his patent right.

(2) A non-exclusive licensee shall have the right to commercially work the patented invention to the extent prescribed in this Law or laid down by the license contract.

Non-Exclusive License by virtue of Prior Use

79. Where, without knowledge of the contents of a patent application, a person has made the invention by himself, without knowledge of the invention in the patent application, has learnt the invention from another person who has made the invention, and has been commercially working the invention or has been making

preparations therefor in Japan at the time of filing of the patent application, such persons shall have a non-exclusive license on the patent right limited to the extent of the patent which is being worked or for which preparations for working are being made and to the purpose of such working or the preparation therefor.

*Non-Exclusive License due to Working
prior to Registration of Demand for Invalidation Trial*

80.—(1) A person who falls under any of the following paragraphs and who is running a business working an invention in Japan or preparing the business before the registration of a demand for a trial under Section 123(1) without knowing that the patent falls under the requirements of any of the paragraphs of that section, shall have a non-exclusive license on the invalidated patent right or on the exclusive license existing at the time of the invalidation within the scope of the invention which is worked or prepared to be worked and within the scope of the purposes of the business:

(i) where one of two or more patents granted for the same invention has been invalidated, the original patentee;

(ii) where his patent has been invalidated and a patent for the same invention has been granted to the person entitled to obtain the patent, the original patentee;

(iii) in the case referred to in Paragraphs (i) and (ii), a person who, at the time of the registration of the demand for a trial under Section 123(1), has an exclusive license on the patent that has been invalidated or a non-exclusive license which is effective under Section 99(1) on the patent or exclusive right.

(2) The patentee or the exclusive licensee shall have a right to receive a reasonable remuneration as consideration for the non-exclusive license under the preceding subsection.

Non-Exclusive License after Expiration of Design Right

81. Where a design right under an application for a design registration filed prior to or on the filing date of a patent application conflicts with the patent right under the patent application and the term of the design right has expired, the owner of the expired design right shall, to the extent of such design right, have a non-exclusive license on the patent right or the exclusive license existing at the time when the design right expired.

82.—(1) Where a design right under an application for a design registration filed prior to or on the filing date of a patent application conflicts with the patent right under the patent application and the term of the design right has expired, a person who, at the time of expiration, has an exclusive license on the expired design right or a non-exclusive license which is effective under Section 99(1), as applied under Section 28(3) of the Design Law, against the design right or the exclusive license, shall, to the extent of the expired right, have a non-exclusive license on the patent right concerned or on the exclusive license existing at the time when the design right expired.

(2) The patentee or the exclusive licensee shall have a right to a reasonable remuneration as considered for the non-exclusive license under the preceding subsection.

Arbitration Decision on Grant of Non-Exclusive License in Case of Non-Working

83.—(1) Where a patented invention has not been sufficiently and continuously worked during a period of three years or more in Japan, a person who intends to work the patented invention may request the patentee or the exclusive licensee to hold consultations on the grant of a non-exclusive license thereon. However, this provision shall not apply unless four years have elapsed since the filing date of the application corresponding to the patented invention.

(2) If no agreement is reached or no consultation is possible under the preceding subsection, a person who intends to work the patented invention may request the Commissioner of the Patent Office for an arbitration decision.

Submission of Written Reply

84. Where a request has been made for arbitration under Section 83(2), the Commissioner of the Patent Office shall transmit a copy of the written request to the patentee or exclusive licensee mentioned in the request to other persons having any registered rights relating to the patent and shall give them an opportunity to submit a written reply, designating an adequate time limit.

Hearing of Industrial Property Council, etc.

85.—(1) Before rendering an arbitration decision under Section 83(2), the Commissioner of the Patent Office shall hear the views of the Council and the like (referring to the organ prescribed in Section 8 of National Government Organization Law (Law No. 120 of 1948)) which is to be set up by Cabinet Order.

(2) Where there is a legitimate reason for the failure to sufficiently work the patented invention, the Commissioner of the Patent Office shall not render an arbitration decision ordering a non-exclusive license to be granted.

Formal Requirements of Arbitration

86.—(1) The arbitration decision under Section 83(2) shall be in writing and shall state the reasons therefor.

(2) An arbitration decision ordering a non-exclusive license to be granted shall set forth the following:

- (i) the scope of the non-exclusive license;
- (ii) the consideration for the license and the method and time of payment.

Transmittal of Copy of Arbitration Decision

87.—(1) A copy of an arbitration decision rendered under Section 83(2) shall be transmitted by the Commissioner of the Patent Office to the parties and other persons having any registered rights relating to the patent.

(2) When a copy of an arbitration decision ordering an non-exclusive license to be granted has been transmitted to the parties under the preceding subsection, an agreement in the terms of the arbitration decision shall be deemed to have been reached by the parties.

Deposit of Consideration

88. A person who is to pay remuneration as consideration under Section 86(2)(ii) shall make a deposit of it in the following case:

(i) where the person to receive the remuneration is unwilling or unable to receive it;

(ii) where an action under Section 183(1) has been instituted with respect to the remuneration;

(iii) where the patent right or the exclusive license is the subject of a pledge. However, this provision shall not apply where the consent of the pledgee has been obtained.

Lapse of Arbitration Decision

89. Where a person who desires an non-exclusive license fails to pay or deposit the remuneration (or the first installment thereof where repayment is to be made periodically or by installments) within the time prescribed in the arbitration decision under Section 83(2), the arbitration decision ordering the non-exclusive license to be granted shall lose its effect.

Cancellation of Arbitration Decision

90.—(1) After rendering an arbitration decision ordering an non-exclusive license to be granted under Section 83(2), when the reason for the arbitration decision is no longer applicable or circumstances have otherwise changed and it has become impossible to sufficiently support the arbitration decision or a person who has obtained an non-exclusive license under the arbitration decision fails to work the patented inventions sufficiently, the Commissioner of the Patent Office may cancel the arbitration decision upon the request of the interested person or ex officio.

(2) Sections 84, 85(1), 86(1) and 87(1) shall apply *mutatis mutandis* to the cancellation of the arbitration decision under the preceding subsection and Section 85(2) shall apply *mutatis mutandis* to the cancellation of the arbitration decision under the preceding subsection when the person who has obtained an non-exclusive license under the arbitration decision fails to work the patented inventions sufficiently.

91. When an arbitration decision has been cancelled under Section 90(1), then non-exclusive licenses shall be extinguished.

Restriction on Objection to Arbitration Decision

91bis. Objections to the remuneration fixed in an arbitration decision under Section 83(2) may not be made a ground for a request for reconsideration of the decision under the Administrative Appeal Law (Law No. 160 of 1962).

*Arbitration Decision on Grant of Non-Exclusive License
on one's own Patented Invention*

92.—(1) Where a patented invention falls under any of the cases provided for in Section 72, the patentee or the exclusive licensee may request the other person referred to in that section to hold consultations on the grant of a non-exclusive license to work the patented invention or of a non-exclusive license on the utility model right or the design right.

(2) The other person referred to in Section 72 who has been requested to hold the consultations under the preceding subsection may request the patentee or the exclusive licensee having requested the consultation to hold consultations on the grant of a non-exclusive license within the scope of the patented invention which the patentee or exclusive licensee desires to work by obtaining the non-exclusive license on the patent right, the utility model right or the design right through the consultations requested by the patentee or the exclusive licensee.

(3) If no agreement is reached or no consultation is possible under Subsection (1), the patentee or the exclusive licensee may request the Commissioner of the Patent Office for an arbitration decision.

(4) If no agreement is reached or no consultation is possible under Subsection (2) and an arbitration under the preceding subsection is requested, the other person referred to in Section 72 may request the Commissioner of the Patent Office for an arbitration decision only within the time limit which the Commissioner of the Patent Office designates as the time limit for the other person to submit a written reply in accordance with Section 84 as applied under Subsection (7).

(5) If, in the case of Subsection (3) or the preceding subsection, the grant of a non-exclusive license would unduly injure the interests of the other person referred to in Section 72 or the patentee or exclusive licensee, the Commissioner of the Patent Office shall not render an arbitration decision ordering a non-exclusive license to be granted.

(6) In the case of Subsection (4) in addition to the case provided for in the preceding subsection, the Commissioner of the Patent Office shall not render an arbitration decision ordering a non-exclusive license to be granted if an arbitration decision ordering a non-exclusive license to be granted is not rendered with respect to the request for the arbitration decision under Subsection (3).

(7) Sections 84, 85(1) and 86 to 91 *bis* shall apply *mutatis mutandis* to the arbitration under Subsection (3) or (4).

Arbitration Decision on Grant of Non -Exclusive License in Public Interest

93.—(1) Where the working of a patented invention is particularly necessary in the public interest, a person who intends to work the invention may request the patentee or the exclusive licensee to hold consultations on the grant of a non -exclusive license.

(2) If no agreement is reached or no consultation is possible under the preceding subsection, a person who intends to work the patented invention may request the Minister of Economy, Trade and Industry for an arbitration decision.

(3) Sections 84, 85(1) and 86 to 91 *bis* shall apply *mutatis mutandis* to the arbitration under the preceding subsection.

Transfer, etc. of Non -Exclusive License

94.—(1) A non -exclusive license, with the exception of one which results from an arbitration decision under Section 83(2), 92(3) or (4) or Section 93(2) of this Law, Section 22(3) of the Utility Model Law or Section 33(3) of the Design Law, may be transferred, but only together with the business in which it is worked or only with the consent of the patentee (or the patentee and the exclusive licensee in the case of a non -exclusive license on an exclusive license).

(2) A non -exclusive license may, except in the case of a non -exclusive license resulting from an arbitration decision under Section 83(2), 92(3) or (4) or 93(2) of this Law, Section 22(3) of the Utility Model Law or Section 33(3) of the Design Law, establish a pledge on the non -exclusive license, but only with the consent of the patentee (or the patentee and exclusive licensee in the case of a non -exclusive license on an exclusive license).

(3) A non -exclusive license resulting from an arbitration decision under Section 83(2) or 93(2) may be transferred only together with the business in which it is worked.

(4) A non -exclusive license resulting from an arbitration decision under Section 92(3) of this Law, Section 22(3) of the Utility Model Law or Section 33(3) of the Design Law shall be transferred together with the patent, utility model or design right to which the non -exclusive license is entitled, and if such right has been transferred independently from the business in which it is worked or extinguished, then the non -exclusive license shall be extinguished simultaneously.

(5) A non -exclusive license resulting from an arbitration decision under Section 92(4) shall be transferred together with the patent, utility model or design right to which the non -exclusive license is entitled and shall be extinguished at the same time as the patent, utility model or design right.

(6) Section 73(1) shall apply *mutatis mutandis* to a non -exclusive license.

Pledges



95. Where a patent right or an exclusive or non-exclusive license is the subject of a pledge, the pledge may not work the patented invention unless otherwise prescribed by contract.

96. A pledge on a patent right or an exclusive or non-exclusive license may be exercised against the remuneration received as consideration for the patent right or the license or against money or goods that the patentee or exclusive licensee would be entitled to receive for the working of the patented invention. However, an attachment order shall be obtained prior to the payment or delivery of the money or property.

Surrender of Patent Right, etc.

97.—(1) Where there is an exclusive licensee, pledgee or non-exclusive licensee under Section 35(1), 77(4) or 78(1), a patentee may surrender his patent right only with the consent of such person.

(2) Where there is a pledgee or non-exclusive licensee under Section 77(4), an exclusive licensee may surrender his license only with the consent of such person.

(3) Where there is a pledgee, an non-exclusive licensee may surrender his license only with the pledgee's consent.

Effects of Registration

98.—(1) The following shall be of no effect unless they are registered:

(i) transfers (except those by inheritance or other general succession), extinguishment by surrender or restrictions on disposal of a patent right;

(ii) the grant, transfer (except those by inheritance or other general succession), modification or extinguishment (except those resulting from a merger or the extinguishment of the patent right) of an exclusive license, or a restriction on the disposal thereof;

(iii) the grant, transfer (except those by inheritance or other general succession), modification or extinguishment (except those resulting from a merger or the extinguishment of a secured credit) of a pledge on a patent right or exclusive license, or a restriction on the disposal thereof.

(2) Inheritance or other general succession under any of the preceding paragraphs shall be notified to the Commissioner of the Patent Office without delay.

99.—(1) Once an non-exclusive license has been registered, it shall also be effective against anyone subsequently acquiring the patent right or the exclusive license or an exclusive license on such a patent right.

(2) An non-exclusive license under Section 35(1), 79, 80(1), 81, 82(1) or 176 shall be effective as under the preceding subsection without registration.

(3) The transfer, modification, extinguishment or restriction on disposal of an exclusive license or the grant, transfer, modification, extinguishment or restriction on disposal of a pledged relating to an exclusive license shall not be effective against any third party unless it is registered.

2. Infringement

Injunction

100.—(1) A patentee or exclusive licensee may require a person who is infringing or is likely to infringe the patent right or exclusive license to discontinue or refrain from such infringement.

(2) A patentee or an exclusive licensee who is acting under the preceding subsection may demand the destruction of articles by which an act of infringement was committed (including articles manufactured by an act of infringement in the case of a patented invention of a process of manufacture; the same in Section 102(1)), the removal of the facilities used for the act of infringement, or other measures necessary to prevent the infringement.

Acts Deemed to be Infringement

101. The following acts shall be deemed to be an infringement of a patent right or exclusive license:

(i) in the case of a patent for an invention of a product, acts of manufacturing, assigning, leasing, importing or offering for assignment or lease of, in the course of trade, articles to be used exclusively for the manufacture of the product;

(ii) in the case of a patent for an invention of a process, acts of manufacturing, assigning, leasing, importing or offering for assignment or lease of, in the course of trade, articles to be used exclusively for the working of such invention.

Presumption, etc. of Amount of Damage

102.—(1) Where a patentee or exclusive licensee claims, from a person who has intentionally or negligently infringed the patent right or exclusive license, compensation for damage caused to him by the infringement, and the person's act is the assignment of articles by which the act of the infringement was committed, the sum of money with the profit per unit of such articles multiplied by the number of articles (hereinafter referred to in this paragraph as the "number of assigned articles") which the patentee or exclusive licensee could have sold in the absence of the infringement may be estimated as the amount of damage suffered by the patentee or exclusive licensee within a limit not exceeding an amount attainable depending on working capability of the patentee or exclusive licensee. Where there is any circumstance that prevents the patentee or exclusive licensee from selling part or the whole of the number of assigned articles, a sum equivalent to the number of assigned articles subject to that circumstance shall be deducted.

(2) Where a patentee or exclusive licensee claims, from a person who has intentionally or negligently infringed the patent right or exclusive license, compensation for damage caused to him by the infringement, the profits gained by the infringer through the infringement shall be presumed to be the amount of damages suffered by the patentee or exclusive licensee.

(3) A patentee or exclusive licensee may claim, from a person who has intentionally or negligently infringed the patent right or exclusive license, an amount of money which he would be entitled to receive for the working of the patented invention, as the amount of damages suffered by him.

(4) The preceding subsections shall not preclude a claim to damages exceeding the amount referred to therein. In such a case, where there has been either willfulness or gross negligence on the part of the person who has infringed the patent right or the exclusive license, the court may take this into consideration when awarding damages.

Presumption of Negligence

103. A person who has infringed a patent right or exclusive license of another person shall be presumed to have been negligent as far as the act of infringement is concerned.

Presumption of Manufacture by Patented Process

104. In the case of a patent for an invention of a process of manufacturing a product, where such product was not publicly known in Japan prior to the filing of the patent application concerned, any identical product shall be presumed to have been manufactured by that process.

Obligation to Clarify Relevant Act in Concrete Manner

104bis. In a litigation directed to the infringement of a patent right or exclusive license, where denying the material allegation made by a patentee or an exclusive licensee to the effect that an act of infringement is committed with reference to an article or process, the other party shall clarify his relevant act in concrete manner. However, this provision shall not apply when the other party has an adequate reason for preventing him from disclosing the same.

Production of Documents, etc.

105.—(1) In a litigation relating to the infringement of a patent right or exclusive license, the court may, upon the request of a party, order the other party to produce documents necessary for the proof of alleged infringement or the assessment of the damages caused by the infringement. However, this provision shall not apply when the person possessing the documents has a legitimate reason for refusing to produce them.

(2) Where deemed necessary in deciding whether there is a good reason referred to in the provision to the preceding subsection, the court may invite the person possessing the

documents to make its presentation. In such a case, no person may request the disclosure of the document presented.

(3) The preceding two subsections shall apply *mutatis mutandis* to the presentation of the subject-matter for the inspection necessary for the proof of the alleged infringement in a litigation relating to the infringement of a patent right or exclusive license.

Expert Opinion for Proof of Damage

105bis. In a litigation relating to the infringement of a patent right or exclusive license, where the court orders, upon the request from a party, the expert opinion to be given with respect to the matters necessary for the proof of the damage caused by the infringement, the other party shall explain to the expert the matters necessary for the expert opinion to be given.

Award of Reasonable Damages

105ter. Where it is recognized that the damage was caused in a litigation relating to the infringement of a patent right or exclusive license, the court may award the reasonable amount of damages, based on the entire purport of the oral argument and the result of the taking of evidence when it is extremely difficult to prove facts necessary for the proof of damages from the nature of such relevant facts.

Measures for Recovery of Reputation

106. Upon the request of a patentee or exclusive licensee, the court may, in lieu of damages or in addition thereto, order a person who has injured the business reputation of the patentee or exclusive licensee by infringing the patent right or exclusive license, whether intentionally or negligently, to take the measures necessary for the recovery of the business reputation.

3. Annual Fees

Annual Fees

107.—(1) A person who obtains registration of the establishment of a patent right or a patentee shall pay, as annual fees, the amounts specified in the right-hand column of the following table corresponding to the relevant period in the left-hand column, for each case and for each year from the date of the registration of the establishment of the patent right to the expiration of the term (where the term is extended by virtue of Section 67(2), the added extension term) under Section 67(1):

<i>Division of year</i>	<i>Amounts</i>
First to third year	Annually, ¥13,000 plus ¥1,100 per claim



Fourth to sixth year	Annually, ¥20,300 plus ¥1,600 per claim
Seventh to ninth year	Annually, ¥40,600 plus ¥3,200 per claim
Tenth to twenty-fifth year	Annually, ¥81,200 plus ¥6,400 per claim

(2) The preceding subsections shall not apply to patent rights belonging to the State or independent administrative institutions (referring to the independent administrative institutions prescribed in Section 2(1) of the Law concerning the General Provisions of Independent Administrative Institutions (Law No. 103 of 1999), hereinafter the same) which are to be set up by Cabinet Order by taking into consideration the substance of their business and other circumstances.

(3) The provision of Subsection (1) shall not apply to patent right owned jointly by the State and the independent administrative institutions prescribed by Cabinet Order in the preceding subsection or owned jointly by the independent administrative institutions prescribed by Cabinet Order in the same subsection.

(4) Where the State and the like (referring to the State or the independent administrative institutions prescribed by Cabinet Order in Subsection (2), the same in Section 195(4) and (6)) and the person other than the State and the like (referring to the person other than the State and the independent administrative institutions prescribed by Cabinet Order in Subsection (2), hereinafter the same in this subsection and the same section (6)) jointly own a patent and there is an agreement with respect to their shares of the right, the annual fee under Subsection (1) shall be a sum with the prescribed annual fees under Subsection (1) multiplied by the ratio of the share of the person other than the State and the like, and the person other than the State and the like shall pay such sum, notwithstanding the provision of Subsection (1).

(5) Where the amount of the annual fee is calculated in accordance with the provision of the preceding subsection has a fractional figure less than 10 yen, that fractional figure shall be discarded.

(6) The payment of the annual fees under Subsection (1) shall be made by patent revenue stamps as prescribed by an ordinance of the Ministry of Economy, Trade and Industry. However, where so prescribed by an ordinance of the Ministry of Economy, Trade and Industry, such payment may be made in cash.

Time Limit for Payment of Annual Fees

108.—(1) The annual fee for each year from the first to third year under Section 107(1) shall be paid in lump sum within 30 days from the date of transmittal of the examiner's decision or the trial decision that the patent is to be granted.

(2) The annual fee for each year from the fourth and subsequent years under Section 107(1) shall be paid during the preceding year or prior thereto. However, where the date of transmittal of the examiner's decision or trial decision that the registration of an extension of the term of a patent right is to be made (hereinafter referred to in this subsection as the "date of transmittal") is later than a date which is thirty days prior to the last day of the year in which the day of the expiration of the patent right would fall if there had been no registration of an extension, the annual fees shall be paid in lump sum, for each year from the year following that year to the year in which the date of transmittal falls (where there are less than thirty days from the date of transmittal to the last day of the year in which the day of transmittal falls, to the year following that year in which the date of transmittal falls).

(3) Upon the request of a person liable to pay an annual fee, the Commissioner of the Patent Office may extend the period prescribed in Subsection (1) by a period not exceeding 30 days.

Reduction or Deferment of Payment of Annual Fees or Exemption Therefrom

109. Where the Commissioner of the Patent Office recognizes that a person who is mentioned below and falls under the requirement prescribed by Cabinet Order for a person to be short of funds cannot afford to pay the annual fees, he may reduce the annual fees for each year from the first to the third year under Section 107(1), exempt him therefrom or grant him a deferment of payment thereof as prescribed by Cabinet Order:

(i) the inventor of the patented invention or the inventor's heir;

(ii) the employer etc., who has succeeded to the right to obtain a patent from the employee, etc., where the patent invention is an employee's invention made by the employee, etc., as referred to in Section 35(1) and where it is provided in advance in a contractual provision, service regulation or other stipulation that the right to obtain a patent shall pass to the employer, etc..

Payment of Annual Fees by an Interested Person

110.—(1) An interested person may pay an annual fee even against the will of the person liable to pay.

(2) An interested person who has paid an annual fee in accordance with the preceding subsection may demand reimbursement of the expenditure to the extent that the person liable to pay is actually making a profit.

Refund of Annual Fees

111.—(1) Annual fees shall be refunded, upon the request of the person who paid them, only in the following cases:

(i) annual fees paid by mistake or in excess;

(ii) the annual fees for the year following the year in which a ruling to revoke the patent under Section 114(2) or a trial decision that the patent is to be invalidated became final and conclusive and subsequent years;

(iii) The annual fee for the year following the year in which the trial decision that the registration of an extension of the term of a patent right is to be invalidated became final and conclusive, and subsequent years (limited to that for the year following the year in which the day of the expiration of the term of the patent right would fall if there had been no registration of the extension and subsequent years).

(2) No refund of annual fees under the preceding subsection may be requested after one year from the date of payment in the case of annual fees under Paragraph (i) above, or after six months from the date on which a ruling to revoke the patent under Section 114(2) or a trial decision became final and conclusive in the case of annual fees under Paragraphs (ii) and (iii) above.

Late Payment of Annual Fees

112.—(1) Where a patentee is unable to pay an annual fee within the time limit prescribed in Section 108(2) or within the time limit for deferred payment under Section 109, he may pay the annual fee belatedly within six months from the expiration of that time limit.

(2) In the case of late payment of an annual fee in accordance with the preceding subsection, the patentee shall, in addition to the annual fee provided for in Section 107(1), pay a surcharge of the same amount as the annual fee.

(3) The payment of the surcharge under the preceding subsections shall be made by patent revenue stamps as prescribed by an ordinance of the Ministry of Economy, Trade and Industry. However, where so prescribed by an ordinance of the Ministry of Economy, Trade and Industry, such payment may be made in cash.

(4) Where a patentee fails to pay within the time limit for late payment under Subsection (1) an annual fee due by the time limit prescribed in the principal sentence of Section 108(2) as well as the surcharge under Subsection (2), the patent right shall be deemed to have been extinguished retroactively from the time of the expiration of the time limit prescribed in the principal sentence of Section 108(2).

(5) Where a patentee fails to pay an annual fee under Section 108(2) and the surcharge under Subsection (2) within the time limit for late payment under Subsection (1), the patent right shall be deemed to have been extinguished retroactively from the time of the lapsing of the year in which the day of the expiration of the term of the patent right would fall if there had been no registration of the extension.

(6) Where a patentee fails to pay an annual fee whose payment has been deferred under Section 109, and the surcharge under Subsection (2), within the time limit for late payment under Subsection (1), the patent right shall be deemed never to have existed.

Restoration of Patent Right by Late Payment of Annual Fees

112bis.—(1) Where the patent right is one which was deemed to have been extinguished under Section 112(4) or (5) or which was deemed never to have existed under Section 112(6) and the owner of the extinguished patent right is unable to pay an annual fee and surcharge belatedly within the time limit for late payment under Section 112(1) due to reasons outside his control, he may pay the annual fee and surcharge referred to in Section 112(4) to (6) within 14 days (where he is a resident abroad, within two months) from the date on which the reasons ceased to be applicable but not later than six months following the expiration of the said time limit.

(2) Where the annual fee and surcharge have been paid in accordance with the preceding subsection, the patent right shall be deemed to have been maintained retroactively from the time of the expiration of the time limit prescribed in the principal sentence of Section 108(2) or the lapse of the year in which the day of the expiration of the term of the patent right falls or existed from the beginning.

Restriction on Effects of Patent Right Restored

112ter.—(1) Where a patent right has been restored under the preceding Section (2), if the patent has been granted for the invention of a product, the effects of the patent right shall not extend to the product which was imported into, or manufactured or acquired in Japan after the expiration of the time limit for late payment under Section 112(1) but before the registration of the restoration of the patent right.

(2) The effects of patent rights restored under the preceding Section (2) shall not extend to the following acts after the expiration of the time limit for late payment under Section 112(1) but before the registration of the restoration of the patent right:

(i) the working of the invention;

(ii) in the case of a patent for an invention of a product, acts of manufacturing, assigning, leasing, importing or offering for assignment or lease of, articles to be used exclusively for the manufacture of the product;

(iii) in the case of a patent for an invention of a process, acts of manufacturing, assigning, leasing, importing or offering for assignment or lease of, articles to be used exclusively for the working of the invention.

CHAPTER V OPPOSITION TO THE PATENT

Opposition to the Patent

113. Only within six months from the publication of the Gazette containing the patent, any person may file with the Commissioner of the Patent Office an opposition to the patent on the grounds that the patent falls under any of the under-mentioned paragraphs. In this context, if there are two or more claims, the opposition may be filed for each claim. That is:

(i) where the patent has been granted on a patent application (excluding any foreign language file application) with an amendment which does not comply with the requirements of Section 17*bis* (3);

(ii) where the patent has been granted contrary to Section 25, 29, 29*bis*, 32 or 39(1) to (4);

(iii) where the patent has been granted contrary to the provisions of a treaty;

(iv) where the patent has been granted on a patent application which does not comply with the requirements of Section 36(4) or (6) [excluding Paragraph (iv)];

(v) where the features disclosed in the specification or drawings attached to a request with respect to the patent under a foreign language file application do not remain within the scope of the features disclosed in the foreign language file.

Ruling

114.—(1) A trial concerning an opposition and ruling thereon shall be conducted by a collegial body of three or five trial examiners.

(2) Where it is found that a patent concerned in the opposition falls under any of the paragraphs in the preceding section, the trial examiners shall render a ruling that the patent is to be revoked (hereinafter referred to as “ruling to revoke”).

(3) Where a ruling to revoke has become final and conclusive, the patent right shall be deemed never to have existed.

(4) Where it is not found that a patent concerned in the opposition falls under any of the paragraphs in the preceding section, the trial examiners shall render a ruling that the patent is to be maintained.

(5) No appeal shall lie from a ruling under Subsection (4).

Formal Requirements of a Written Opposition, etc.

115.—(1) A person filing an opposition shall submit a written opposition to the Commissioner of the Patent Office stating the following:

(i) the name and the domicile or residence of the opponent and his representative;

(ii) an identification of the patent concerned in the opposition;

(iii) the grounds of the opposition and an indication of the supporting evidence.

(2) An amendment of the written opposition submitted under the preceding subsection shall not change the gist thereof. However, this provision shall not apply to an amendment made to the matter prescribed in Paragraph (iii) of the preceding subsection before the expiration of the time limit prescribed in Section 113.

(3) The trial examiner-in-chief shall transmit a copy of the written opposition to the patentee.

(4) Section 123(3) shall apply *mutatis mutandis* where the opposition has been filed.

Designation of Trial Examiners, etc.

116. Sections 136(2) and 137 to 144 shall apply *mutatis mutandis* to the collegial body and trial examiners constituting thereof under Section 114(1).

Trial Clerk

116bis.—(1) For each opposition to the patent, the Commissioner of the Patent Office shall designate a trial clerk.

(2) Section 144 *bis*(3) to (5) shall apply *mutatis mutandis* to the trial clerk under the preceding subsection.

Conduct of Trial Examination, etc.

117.—(1) The trial examination of the opposition shall be conducted by documentary examination. However, the trial examiner-in-chief may decide to conduct the trial by oral trial on a motion by the patentee, opponent or intervenor *ex officio*.

(2) Sections 145(3) to (5), 146 and 147 shall apply *mutatis mutandis* to the oral examination in accordance with the proviso to the preceding subsection.

(3) Where there is a ground for interruption or suspension of the trial proceedings of an opposition and ruling thereon on the part of one of the joint owners of a patent right, the interruption or suspension shall have effect on all of them.

Intervention

118.—(1) Any person who has a right with respect to the patent right or any other person who has an interest in the patent right may intervene in the trial examination, in order to assist the patentee, until the ruling on the opposition.

(2) Sections 148(4) and (5) and 149 shall apply *mutatis mutandis* to the intervenor under the preceding subsection.

Taking of Evidence and Preservation Thereof

119. Sections 150 and 151 shall apply *mutatis mutandis* to the examination and preservation of evidence in a trial examination of opposition.

Trial Examination Ex Officio

120.—(1) In a trial examination of an opposition, even the grounds that have not been pleaded by a patentee, an opponent or an intervenor may be examined.

(2) In a trial examination of an opposition, only the claims sought by the opponent may be considered in the trial examination.

Combination or Separation of Trial Examination

120bis.—(1) The trial examinations of two or more oppositions concerning the same patent right shall be combined, unless the special circumstances exist.

(2) Trial examinations that have been combined under the preceding subsection may later be conducted separately.

Withdrawal of Oppositions

120ter.—(1) An opposition to the patent may not be withdrawn after the notification under Section 120 bis(1).

(2) Section 155(3) shall apply *mutatis mutandis* to the withdrawal of the opposition.

Submission of Arguments, etc.

120quater.—(1) When the trial examiner-in-chief intends to render a ruling to revoke, he shall notify the patentee and intervenor of the reasons for revocation of the patent and give them an opportunity to submit a statement of their arguments designating an adequate time limit.

(2) The patentee may demand a correction of the specification or drawings attached to the request only within the time limit designated under the preceding subsection. However, such correction is limited to the following:

- (i) the restriction of a claim or claims;
- (ii) the correction of errors in the description or incorrect translations;
- (iii) the clarification of an ambiguous description.

(3) Sections 126(2) to (4), 127, 128, 131, 132(3) and (4) and 165 shall apply *mutatis mutandis* to the case of the preceding subsection. In such a case, “In the case of Paragraphs (i) and (ii) of the proviso to Subsection (1)” in Section 126(4) shall read “In an opposition to the patent, in the case of Paragraphs (i) or (ii) of the proviso to Section 120 bis(2) which relates to the correction with respect to the claim for which an opposition is not filed”.

Formal Requirements of Ruling

120quinquies.—(1) The ruling on the opposition shall be in writing and shall state the particulars mentioned below, and the trial examiners who have rendered the ruling shall have their names and seals affixed thereto:

- (i) the number of the opposition case;
- (ii) the name and the domicile or residence of the patentee, opponent and intervenor as well as of their representatives;
- (iii) the identification of the patent relating to the ruling;
- (iv) the conclusion of the ruling and the reasons therefor;
- (v) the date of the ruling.

(2) Once the ruling has been rendered, the Commissioner of the Patent Office shall transmit it to the patentee, opponent, intervenor and persons whose demand to intervene has been refused.

Application mutatis mutandis of Provision on Trial

120sexies.—(1) Sections 133, 133 *bis*, 134(4), 135, 152, 168, 169(3) to (6) and 170 shall apply *mutatis mutandis* to the trial examination of the opposition and the ruling thereon.

(2) Section 114(5) shall apply *mutatis mutandis* to the ruling under Section 135 as applied under the preceding subsection.

CHAPTER VI TRIAL

Trial against Examiner's Decision of Refusal

121.—(1) A person who has received the examiner's decision that his application is to be refused and is dissatisfied may demand a trial thereon within 30 days from the transmittal of the examiner's decision.

(2) Where, due to reasons outside his control, a person is unable to demand a trial under the preceding subsection within the time limit prescribed therein, he may, notwithstanding that subsection, make the demand within 14 days (where he is a resident abroad, within two months) from the date when the reasons ceased to be applicable but not later than six months, following the expiration of the said time limit.

122. [Deleted]

Trial for Invalidation of Patent

123.—(1) In the following cases, a trial may be demanded for the invalidation of a patent. In this context, if there are two or more claims, a trial may be demanded for each claim. The cases referred to are:

(i) where the patent has been granted on a patent application (excluding a foreign language file application) with a name and number which does not comply with the requirements of Section 17 *bis*(3);

(ii) where the patent has been granted contrary to Section 25, 29, 29 *bis*, 32, 38 or 39(1) to(4);

(iii) where the patent has been granted contrary to the provisions of a treaty;

(iv) where the patent has been granted on a patent application which does not comply with the requirements of Section 36(4) or (6) (excluding Paragraph (iv));

(v) where the features disclosed in the specification or drawings attached to the request with respect to the patent under a foreign language file application does not remain within the scope of the features disclosed in the foreign language file;

(vi) where the patent has been granted on a patent application filed by a person who is not the inventor and has not succeeded to the right to obtain a patent for the invention concerned;

(vii) where, after the grant of the patent, the patentee has become a person who can no longer enjoy a patent right under Section 25 or the patent no longer complies with a treaty;

(viii) where the correction of the specification or drawings attached to the request with respect to the patent has been made contrary to the proviso to Section 126(1), Section 126(2) to(4) (including its application under Section 120 *bis*(3) or Section 134(5)), the proviso to Section 120 *bis*(2) or the proviso to Section 134(2).

(2) Even after the extinguishment of a patent right, a trial under the preceding subsection may be demanded.

(3) Where a trial under Subsection (1) has been demanded, the trial examiner-in-chief shall notify the exclusive licensee with respect to the patent right and other persons who have any registered rights relating to the patent.

124. [Deleted]

125. Where a trial decision that a patent is to be invalidated has become final and conclusive, the patent right shall be deemed never to have existed. However, where a patent falls under Paragraph (vii) of Section 123(1) and a trial decision that the patent is to be invalidated has become final and conclusive, the patent right shall be deemed not to have existed from the time when the patent first fell under that paragraph.

Trial for Invalidation of Registration of Extension of Term

125bis.—(1) A trial for invalidation of the registration of an extension of the term of a patent right may be demanded if the registration falls under any of the following paragraphs:

(i) where the registration of an extension has been effected in respect of an application filed in the case when it is not deemed that the obtaining of the disposition as provided for in Cabinet Order referred to in Section 67(2) was necessary for the working of the patented invention;

(ii) where the registration of an extension has been effected in respect of an application filed in the case when the disposition as provided for in Cabinet Order referred to in Section 67(2) was not obtained by the patentee, or an exclusive licensee or a registered non-exclusive licensee relating to the patent;

(iii) where the term of an extension through the registration of the extension exceeds the period of time during which the patented invention could not be worked;

(iv) where the registration of an extension has been effected on an application by a person who is not the patentee concerned;

(v) where the registration of an extension has been effected on an application which did not comply with requirements under Section 67 bis(4).

(2) Section 123(2) and (3) shall apply *mutatis mutandis* to the demand for a trial under the preceding subsection.

(3) Where a trial decision that the registration of an extension is to be invalidated has become final and conclusive, the extension of the term through the registration of the extension shall be deemed never to have existed. However, where the registration of the extension falls under Paragraph (iii) of Subsection (1) and the trial decision that the registration of the extension of the term exceeding the period of time during which the patented invention could not be worked has become final and conclusive, the extension of the term exceeding the said period of time shall be deemed not to have existed.

Trial for Correction

126.—(1) The patentee, except in the case where an opposition or a trial under Section 123(1) is pending at the Patent Office, may demand a correction of the specification or drawings attached to the request. However, such corrections shall be limited to the following:

(i) the restriction of a claim or claims;

(ii) the correction of errors in the description or of incorrect translations;

(iii) the clarification of an ambiguous description.

(2) The correction of the specification or drawings under the preceding subsections shall remain within the scope of the features disclosed in the specification or drawings originally attached to the request [in the case of the proviso (ii) to the preceding subsection, the

specification and drawings originally attached to the request (in the case of a patent granted on a foreign language file application, the foreign language file)].

(3) The correction of the specification or drawings under Subsection (1) may not be such as to substantially enlarge or modify the claim or claims.

(4) In the case of Paragraphs (i) and (ii) of the proviso to Subsection (1), an invention constituted by the features described in the corrected claim must be one which could have been patented independently at the time of filing of the patent application.

(5) A trial under Subsection (1) may be demanded even after the extinguishment of the patent right. However, this provision shall not apply after the patent has been revoked by a ruling or invalidated on a trial under Section 123(1).

127. Where there is an exclusive licensee, a pledgee or a non-exclusive licensee under Section 35(1), 77(4) or 78(1), the patentee may demand a trial under Section 126(1) only with the consent of such person.

128. Where a trial decision that the specification or drawings attached to the request are to be corrected has become final and conclusive, the patent application, the laying open of the application, the examiner's decision on the trial decision that the patent is to be granted, or the registration or establishment of the patent right shall be deemed to have been made on the basis of the corrected specification or drawings.

129. [Deleted]

130. [Deleted]

Formal Requirements of Demands for Trial

131.—(1) A person demanding a trial shall submit a written demand to the Commissioner of the Patent Office stating the following:

- (i) the name and the domicile or residence of the demandant and his representative;
- (ii) an identification of the trial case;
- (iii) the reliefs sought in the demand and the grounds therefor.

(2) An amendment of the written demand submitted under the preceding subsection shall not change the gist thereof. However, this provision shall not apply with respect to the grounds for the demand under Paragraph (iii) of the preceding subsection except in the case where a demand is made for a trial other than the trial under Section 123(1).

(3) When a trial is demanded under Section 126(1), the corrected specification or drawings shall be attached to the written demand.

Joint Trial

132.—(1) Where two or more persons demand a trial concerning the same patent right under Section 123(1) or 125 *bis*(1), the demand may be made jointly.

(2) Where a trial is demanded against any of the joint owners of a patent right, all the joint owners shall be made defendants.

(3) Where the joint owners of a patent right or a right to obtain a patent demand a trial concerning the right under joint ownership, the demand shall be made jointly by all the joint owners.

(4) Where there is a ground for interruption or suspension of the trial proceedings on the part of one of the demandants under Subsection (1) or the preceding subsection or one of the defendants under Subsection (2), the interruption or suspension shall have effect on all of them.

Dismissal by Ruling in the Case of Non-Compliance with Formal Requirements

133.—(1) Where a demand does not comply with Section 131(1) or (3), the trial examiner-in-chief shall invite the demandant to amend the demand, designating an adequate time limit.

(2) Subject to the preceding subsection, the trial examiner-in-chief may invite an amendment to a procedure relating to a trial, designating an adequate time limit in the following cases:

(i) when the requirements of Section 7(1) to (3) or 9 have not been complied with;

(ii) when the formal requirements specified in this Law or in an order or ordinance thereunder have not been complied with;

(iii) when the fees due to be paid under Section 195(1) or (2) have not been paid with respect to a procedure.

(3) The trial examiner-in-chief shall dismiss the procedure by a ruling where a person whom he has invited to make an amendment to a procedure relating to a trial fails to make the amendment within the time limit designated under the preceding subsections.

(4) A ruling under the preceding subsections shall be in writing and shall state the reasons therefor.

Dismissal of Irregular Procedure

133bis.—(1) The trial examiner-in-chief may dismiss a irregular procedure relating to a trial (excluding a demand for a trial) by a ruling which cannot be amended.

(2) When the trial examiner-in-chief intends to dismiss the procedure in accordance with the preceding subsection, he shall notify the person who is proceeding of the reasons for dismissal and give him an opportunity to submit a statement of explanation, designating an adequate time limit.

(3) A ruling under Subsection (1) shall be in writing and state the reasons therefor.

Submission of Written Reply, etc.

134.—(1) When a trial has been demanded, the trial examiner-in-chief shall transmit a copy of the written demand to the defendant, and shall give him an opportunity to submit a written reply, designating an adequate time limit.

(2) The defendant in the trial under Section 123(1) may demand a correction of the specification or drawings attached to the request only within the time limit designated under the preceding subsection or Section 153(2). However, such correction is limited to the following:

- (i) the restriction of a claim or claims;
- (ii) the correction of errors in the description or of incorrect translations;
- (iii) the clarification of an ambiguous description.

(3) Upon receipt thereof, the trial examiner-in-chief shall transmit to the demandant a copy of the written reply or the corrected specification or drawings attached to the written demand under the preceding subsection.

(4) The trial examiner-in-chief may examine the parties and intervenors with respect to the trial.

(5) Sections 126(2) to (5), 127, 128, 131, 132(3) and (4) and 165 shall apply *mutatis mutandis* to the case of Subsection (2). In such a case, “In the case of Paragraphs (i) and (ii) of the proviso to Subsection (1)” in Section 126(4) shall read “In a trial under Section 123(1), in the case of Paragraph (i) or (ii) of the proviso to the Section 134(2) which relates to the correction with respect to the claim for which a trial under the said Subsection (1) is not demanded”.

Dismissal of Irregular Demand by Trial Decision

135. An irregular demand for a trial which cannot be amended may be dismissed by a trial decision without giving the defendant an opportunity to submit a written reply.

Collegial System in Trial

136.—(1) A trial shall be conducted by a collegial body of three or five trial examiners.

(2) The collegial body referred to in Subsection (1) shall take its decisions by a majority vote.

(3) The qualification of trial examiners shall be prescribed by Cabinet Order.

Designation of Trial Examiners

137.—(1) For each trial (but in the case of a trial where the examiner examines a demand in accordance with Section 162, only when a report under Section 164(3) has been made), the Commissioner of the Patent Office shall designate the trial examiners constituting the collegial body under Section 136(1).

(2) When any trial examiner designated in accordance with the preceding subsection is unable to participate in the trial, the Commissioner of the Patent Office shall relieve him of such designation and appoint another trial examiner to take his place.

Trial Examiner -in-Chief

138.—(1) The Commissioner of the Patent Office shall designate one of the trial examiners designated under Section 137(1) as the trial examiner -in-chief.

(2) The trial examiner -in-chief shall preside over matters relating to the trial.

Exclusion of Trial Examiners

139. In any of the following cases, trial examiners shall be precluded from performing their functions:

(i) where the trial examiner or his spouse or former spouse is or was a party, an intervenor or an opponent in the case;

(ii) where the trial examiner is or was a relative by blood within the fourth degree, a relative by affinity within the third degree or a relative who is cohabiting with a party, an intervenor or an opponent in the case;

(iii) where the trial examiner is a guardian, a supervisor of the guardian, a curator, a supervisor of the curator, an assistant or a supervisor of the assistant of a party, an intervenor or an opponent in the case;

(iv) where the trial examiner has become a witness or an expert witness in the case;

(v) where the trial examiner is or was a representative of a party, an intervenor or an opponent in the case;

(vi) where the trial examiner participated as an examiner in the examiner's decision which is challenged in the case;

(vii) where the trial examiner has a direct interest in the case.

140. Where there is a ground for exclusion under Section 139, a party or an intervenor may present a motion of exclusion.

Challenge of Trial Examiner

141.—(1) Where there are circumstances preventing a fair trial on the part of a trial examiner, a party or an intervenor may challenge him.

(2) After he has made a written or oral statement to a trial examiner with regard to the case, a party or an intervenor may not challenge him. However, this provision shall not apply where the party or intervenor did not know that there was a ground for challenge or where a ground for challenge arose subsequently.

Formal Requirements of Motion of Exclusion or Challenge

142.—(1) A person who presents a motion of exclusion or challenge shall submit a document to the Commissioner of the Patent Office setting forth the grounds therefor. However, in the oral trial examination, this procedure may be carried out orally.

(2) The ground for exclusion or challenge shall be substantiated within three days from the date on which the motion under the preceding subsection was presented. This provision shall also apply in the case of the proviso to Section 141(2).

Ruling on Motion of Exclusion or Challenge

143.—(1) When a motion of exclusion or challenge has been made, the trial examiners other than the trial examiner concerned in the motion shall render a ruling thereon through a trial. However, the trial examiner concerned in the motion may state his opinion.

(2) The ruling under the preceding subsection shall be in writing and state the reasons therefor.

(3) No appeal shall lie from the ruling under Subsection (1).

144. When a motion of exclusion or challenge has been presented, the trial proceedings shall be suspended until a ruling thereon. However, this provision shall not apply to matters requiring urgent attention.

Trial Clerk

144bis.—(1) For each trial (but in the case of a trial where the examiner examines a demand in accordance with Section 162, only when a report under Section 164(3) has been made), the Commissioner of the Patent Office shall designate the trial clerk.

(2) The qualification of trial clerk shall be prescribed by Cabinet Order.

(3) When the trial clerk designated in accordance with Subsection (1) is unable to participate in the trial, the Commissioner of the Patent Office shall relieve him of such designation and designate another trial clerk to take his place.

(4) The trial clerk will do the office for preparing records and their transmittals as well as the other office under the direction of the trial examiner-in-chief with respect to the trial.

(5) Sections 139 (excluding Paragraph (vi)) and 140 to 144 shall apply *mutatis mutandis* to the trial clerk. In such a case, the trial clerk who is concerned in the motion of

exclusion or challenge, may not participate in the trial with respect to the exclusion or challenge.

Conduct of Trial Examination

145.—(1) The trial under Section 123(1) or 125 *bis*(1) shall be conducted by oral trial examination. However, the trial examiner-in-chief may decide to conduct the trial by documentary examination on a motion by a party or an intervenor *ex officio*.

(2) Trials other than the trial under the preceding subsections shall be conducted by documentary examination. However, the trial examiner-in-chief may decide to conduct the trial by oral examination on a motion by a party *ex officio*.

(3) Where a trial is conducted by oral examination in accordance with Subsection (1) or the proviso to the preceding subsection, the trial examiner-in-chief shall fix the date and place thereof and summon the intervenor.

(4) The provision of Section 94 of the Code of Civil Procedure (summons on a fixed date) shall apply *mutatis mutandis* to summons on a fixed date as prescribed in the preceding paragraph.

(5) The oral examination under Subsection (1) or the proviso to Subsection (2) shall be conducted in public. However, this provision shall not apply where public order or morality is liable to be injured thereby.

146. Section 154 (attendance of an interpreter, etc.) of the Code of Civil Procedure shall apply *mutatis mutandis* to the trial.

Records

147.—(1) With respect to a trial by oral examination under Section 145(1) or the proviso to Section 145(2), the trial clerk shall prepare the record setting forth the gist of the trial examination and other necessary matters whenever a trial takes place.

(2) Where the trial clerk is ordered by the trial examiner-in-chief with respect to the preparation of the record or the change in the record, if he recognizes that the preparation or the change is not legitimate, he may add his opinion.

(3) Section 160(2) and (3) (record of oral argument) of the Code of Civil Procedure shall apply *mutatis mutandis* to the record under Subsection (1).

Intervention

148.—(1) Any person whom a demand under Section 132(1) may intervene in the trial as a demandant until the conclusion of the trial.

(2) An intervenor under the preceding subsection may continue the trial proceedings even after the demand for the trial has been withdrawn by the original party.

(3) Any person who has an interest in the result of the trial may intervene in the trial, in order to assist one of the parties, until the conclusion of the trial.

(4) An intervenor under the preceding subsection may initiate and take part in any procedure relating to the trial.

(5) Where there is a ground for interruption or suspension of the trial proceedings on behalf of the intervenor under Subsection (1) or (3), the interruption or suspension shall also be effective against the original party.

149.—(1) A person desiring to intervene shall submit a written demand to intervene to the trial examiner-in-chief.

(2) The trial examiner-in-chief shall transmit the demand to intervene to the parties and the intervenors and give them an opportunity to express their opinions, designating an adequate time limit.

(3) Where a demand to intervene is made, the trial examiner in the trial concerned shall render a ruling thereon through a trial.

(4) The ruling under the preceding subsection shall be in writing and state the reasons therefor.

(5) No appeal shall lie from the ruling under Subsection (3).

Taking of Evidence and Preservation Thereof

150.—(1) With respect to a trial, evidence may be taken on a motion by a party or an intervenor, or ex officio.

(2) With respect to a trial, evidence may be preserved on a motion by an interested person, before the demand for the trial is made, and on a motion by any party or intervenor, or ex officio, during the pendency of the trial.

(3) The motion before the demand for a trial under the preceding subsection shall be presented to the Commissioner of the Patent Office.

(4) Where a motion has been presented under Subsection (2) before the demand for a trial, the Commissioner of the Patent Office shall designate the trial examiner and the trial clerk in charge of preserving the evidence.

(5) Where evidence has been taken or preserved ex officio under Subsection (1) or (2), the trial examiner-in-chief shall notify the parties and the intervenors of the result thereof and shall give them an opportunity to state their opinion, designating an adequate time limit.

(6) The taking or preservation of evidence under Subsection (1) or (2) may be entrusted to a local court or a court with summary jurisdiction in the place where the case is to be handled.

151. Section 147 of this Law and Section 93(1) (designation of a date), Section 94 (summons on a fixed date), Sections 179 to 181, Sections 183 to 186, Section 188, Section 190, Section 191, Sections 195 to 198, Section 199(1), Sections 201 to 204, Section 206, Section 207, Sections 210 to 213, Section 214(1) to (3), Section 215 to 222, Section 223(1) to (3), Sections 226 to 228, Section 229(1) to (3), Section 231, Section 232(1), Section 233, Section 234, Sections 236 to 238, Sections 240 to 242 (evidence) and Section 278 (production of a written statement in place of a hearing) shall apply *mutatis mutandis* to the taking of evidence and preparation thereof as prescribed in the preceding section. In such a case, the “facts that the party admitted in court and the obvious facts therein” in Section 179 shall read “obvious facts” and the “Supreme Court Rules” in Section 204 shall read an “ordinance of the Ministry of Economy, Trade and Industry.”

Trial Examination Ex Officio

152. Even where a party or an intervenor fails to initiate a procedure within the time limit prescribed by law or designated in accordance with the law or fails to appear in accordance with Section 145(3), the trial examiner-in-chief may proceed with the trial proceedings.

153.—(1) In a trial, even grounds that have not been pleaded by a party or an intervenor may be examined.

(2) Where in the trial examination grounds that have not been pleaded by a party or an intervenor are being examined in accordance with the preceding subsection, the trial examiner-in-chief shall notify the parties and the intervenor of the result of the trial examination and give them an opportunity to state their opinion thereon, designating an adequate time limit.

(3) In a trial, only the reliefs sought by the claimant may be considered in the trial examination.

Combination or Separation of Trials

154.—(1) When one or both of the parties to two or more trials are the same, the trial examinations may be combined.

(2) Trial examinations that have been combined under the preceding subsection may later be conducted separately.

Withdrawal of Demand for Trial

155.—(1) A demand for a trial may be withdrawn before a trial decision becomes final and conclusive.

(2) A demand for a trial may not be withdrawn, without the consent of the adverse party, after the written reply under Section 134(1) has been submitted.

(3) When a demand for a trial under Section 123(1) has been made with regard to two or more claims covered by a patent which has two or more claims, the demand may be withdrawn for any of the claims.

Notification of Conclusion of Trial Examination

156.—(1) When a case is ready for the rendering of a trial decision, the trial examiner-in-chief shall notify the parties and the intervenors of the conclusion of the trial examination.

(2) The trial examiner-in-chief may, if necessary, reopen a trial examination, upon a motion by a party or an intervenor, *ex officio*, even after the notification under the preceding subsection.

(3) The trial decisions shall be rendered within 20 days from the notification under Subsection (1). However, this provision shall not apply where the case is complicated or where there are unavoidable circumstances.

Trial Decision

157.—(1) When a trial decision has been rendered, the trial shall be closed.

(2) The trial decisions shall be in writing and state the particulars mentioned below:

(i) the number of the trial;

(ii) the name and the domicile or residence of the parties and the intervenors as well as of their representatives;

(iii) an identification of the trial case;

(iv) the conclusions of the trial decision and the reasons therefor;

(v) the date of the trial decision.

(3) Once it has been rendered, the Commissioner of the Patent Office shall transmit the trial decision to the parties, the intervenors and persons whose demand to intervene has been refused.

Special Provisions for Trials Against Examiner's Decision of Refusal

158. Any action taken during the examination procedures shall also be relevant in the trial under Section 121(1).

159.—(1) Section 53 shall apply *mutatis mutandis* to the trial under Section 121(1). In such a case, “Section 17 *bis*(1)(ii)” in Section 53(1) shall read “Section 17 *bis*(1)(ii) or (iii),” and “an amendment” in Section 53(1) shall read “an amendment (in the case of Section 17 *bis*(1)(ii), excluding the amendment made prior to the demand for the trial under Section 121(1)).”

(2) Section 50 shall apply *mutatis mutandis* where a reason for refusal which was not contained in the examiner's decision is found in the trial under Section 121(1). In such a case, "in the case of Section 17 *bis*(1)(ii)" in the provisions of the proviso to Section 50 shall read "in the case of Section 17 *bis*(1)(ii) or (iii) (in the case of Section 17 *bis*(1)(ii), excluding the amendment made prior to the demand for the trial under Section 121(1))."

(3) Sections 51 and 67 *ter*(2) shall apply *mutatis mutandis* where a demand for a trial under Section 121(1) is to be allowed.

160.—(1) Where an examiner's decision has been cancelled in a trial under Section 121(1), a trial decision may be made to order a further examination to be carried out.

(2) A judgment in the trial decision under the preceding subsections shall be binding on the examiner with respect to the case concerned.

(3) Section 159(3) shall not apply where a trial decision under Subsection (1) is rendered.

161. Sections 134(1) to (3) and (5), 148 and 149 shall not apply to a trial under Section 121(1).

162. Where, in the case of a demand for a trial under Section 121(1), an amendment has been made to the specification or drawings attached to the request in the patent application concerned within 30 days of such demand, the Commissioner of the Patent Offices shall cause the examiner to examine the demand.

163.—(1) Sections 48, 53, and 54 shall apply *mutatis mutandis* to the examination under Section 162. In such a case, "Section 17 *bis*(1)(ii)" in Section 53(1) shall read "Section 17 *bis*(1)(ii) or (iii)," and "an amendment" in Section 53(1) shall read "an amendment (in the case of Section 17 *bis*(1)(ii), excluding the amendment made prior to the demand for the trial under Section 121(1))."

(2) Section 50 shall apply *mutatis mutandis* where a reason for refusal which was not contained in the examiner's decision concerned in the demand for a trial is found in the examination under Section 162. In such a case, "in the case of Section 17 *bis*(1)(ii)" in the provisions of the proviso to Section 50 shall read "in the case of Section 17 *bis*(1)(ii) or (iii) (in the case of Section 17 *bis*(1)(ii), excluding the amendment made prior to the demand for the trial under Section 121(1))."

(3) Sections 51 and 52 shall apply *mutatis mutandis* where a demand for a trial is to be allowed in the examination under Section 162.

164.—(1) When the examiner renders a decision that a patent is to be granted in the examination under Section 162, he shall cancel his decision of refusal concerned in the demand for the trial.

(2) Except in the case provided for in the preceding subsection, the examiners shall not render a ruling to decline an amendment under Section 53(1) as applied under Section 163(1).

(3) Except in the case provided for in Subsection (1), the examiners shall make a report to the Commissioner of the Patent Office on the result of the examination without rendering a decision with respect to the demand for a trial.

Special Provisions for Trials for Correction

165. Where a demand for a trial under Section 126(1) does not relate to any of the matters in the proviso to that subsection or does not comply with Section 126(2) to (4) of that section, the trial examiner-in-chief shall notify the demandant of the reasons therefor and shall designate an adequate time limit and give him an opportunity to submit his views in writing, designating an adequate time limit.

166. Sections 134(1) to (3) and (5), 148 and 149 shall not apply to the trial under Section 126(1).

Effects of Trial Decision

167. When a final and conclusive trial decision in a trial under Section 123(1) or 125bis(1) has been registered, no one may demand a trial on the basis of the same facts and the same evidence.

Relationship with Litigation

168.—(1) The trial proceedings may, if it is deemed necessary in the trial, be suspended until the ruling on the opposition to the patent or the trial decision in another trial has become final and conclusive or litigation proceedings have been concluded.

(2) Where a suit or an application for provisional attachment or provisional disposal has been filed, if the court deems it necessary, it may suspend the proceedings until a trial decision has become final and conclusive.

(3) Where an action with respect to infringement of a patent right or an exclusive license has been instituted, the court shall accordingly notify the Commissioner of the Patent Office. The same shall apply where the litigation proceedings have been concluded.

(4) Where the Commissioner of the Patent Office receives the notification under the preceding subsection, he shall notify the court of a demand or non-demand for the trial with respect to the patent right. The same shall apply where the writ demand for a trial is ruled to be dismissed, the trial decision is rendered or the demand for the trial is withdrawn.

Costs of Trial

169.—(1) The bearing of the costs in connection with a trial under Section 123(1) or 125bis(1) shall be decided ex officio by way of the trial decision where the trial is terminated by a trial decision or by a ruling in the trial where the trial is terminated otherwise by a trial decision.

(2) Sections 61 to 66, 69(1) and (2), 70 and 71(2) (bearing of litigation costs) of the Code of Civil Procedure shall apply *mutatis mutandis* to the costs in connection with the trial under the preceding subsection. In such a case, the “Supreme Court Rules” in Section 71 of the same Code shall read an “ordinance of the Ministry of Economy, Trade and Industry.”

(3) The costs in connection with the trial under Section 121(1) or 126(1) shall be borne by the demandant or the opponent.

(4) Section 65 (costs of joint litigation) of the Code of Civil Procedure shall apply *mutatis mutandis* to the costs borne by the demandant or the opponent under the preceding subsection.

(5) The amount of costs in connection with a trial shall be decided by the Commissioner of the Patent Office, upon request, after the trial decision or the ruling has become final and conclusive.

(6) The extent, amount and payment of the costs of a trial as well as the payment necessary for procedural acts for the trial to be effected shall be governed by the provisions in the Law on Civil Procedure Costs, etc. (Law No. 40 of 1971) which relate to these matters, unless they are incompatible with their nature (with the exception of the proportions laid down in Chapter II, Parts 1 and 3 of that Law).

Executory Force of Ruling on Amount of Costs

170. A final and conclusive ruling on the costs in connection with a trial shall have the same effect as an enforceable title of liability.

CHAPTER VII RETRIAL

Demand for Retrial

171.—(1) Against a final and conclusive ruling to revoke a patent or trial decision, the party concerned or an intervenor may demand a retrial.

(2) Sections 338(1) and (2) and 339 (grounds for retrial) of the Code of Civil Procedure shall apply *mutatis mutandis* to the demand for a retrial under the preceding subsection.

172.—(1) Where the demandant and the defendant in a trial have in collusion caused a trial decision to be rendered, with the purpose of injuring the rights or interests of a third person, such person may demand a retrial against the final and conclusive trial decision.

(2) In such a retrial, the demandant and the defendant shall be made joint defendants.

Time Limit for Demand for Retrial

173.—(1) A retrial must be demanded within 30 days from the date on which the demandant became aware of the grounds for the retrial after the ruling to revoke a patent or trial decision became final and conclusive.

(2) Where, due to reasons outside his control, a person is unable to demand a retrial within the time limit prescribed in the preceding subsection, he may, notwithstanding that subsection, make the demand within 14 days (where he is a resident abroad, within two months) from the date when the reasons ceased to be applicable but not later than six months following the expiration of the said time limit.

(3) Where a retrial is demanded on the ground that the demandant was not represented in accordance with the legal provisions applicable, the time limit provided for in Subsection (1) shall be counted from the day following the date on which the demandant or his legal representative became aware that the ruling to revoke a patent or trial decision had been rendered due to the transmittal of a copy thereof.

(4) No demand for a retrial may be made after the expiration of three years from the date on which the ruling to revoke a patent or trial decision became final and conclusive.

(5) Where a ground for a retrial has arisen after the ruling to revoke a patent or trial decision became final and conclusive, the time limit prescribed in the preceding subsection shall be counted from the day following the date on which the ground first arose.

(6) Subsections (1) and (4) shall not apply to a demand for a retrial made on the ground that the trial decision conflicts with a final and conclusive trial decision previously rendered.

Application mutatis mutandis of Provision on Trial, etc.

174.—(1) Sections 114, 116 to 120, 120 *bis* to 120 *sexies*, 131, 132(3), 154, 155(1) and (3), and 156 shall apply *mutatis mutandis* to a retrial against a final and conclusive ruling to revoke a patent.

(2) Sections 131, 132(3) and (4), 133, 133 *bis*, 134(4), 135 to 147, 150 to 152, 155(1), 156 to 160, 168, 169(3) to (6), and 170 shall apply *mutatis mutandis* to a retrial against a final and conclusive trial decision in a trial under Section 121(1).

(3) Sections 131, 132(1), (2) and (4), 133, 133 *bis*, 134(1), (3) and (4), 135 to 152, 154 to 157, 167, 168, 169(1), (2), (5) and (6), and 170 shall apply *mutatis mutandis* to a retrial against a final and conclusive trial decision in a trial under Section 123(1) or 125 *bis*(1).

(4) Sections 131, 132(3) and (4), 133, 133 *bis*, 134(4), 135 to 147, 150 to 152, 155(1), 156, 157, 165, 168, 169(3) to (6), and 170 shall apply *mutatis mutandis* to a retrial against a final and conclusive trial decision in a trial under Section 126(1).

(5) Section 348(1) (scope of examination) of the Code of Civil Procedure shall apply *mutatis mutandis* to retrials.

Restriction on Effects of Patent Right Restored by Retrial

175.—(1) Where a patent right relating to a revoked or invalidated patent or a patent right relating to the invalidated registration of an extension of the term thereof has been restored through a retrial or where the establishment of a patent right or the extension of the term of a patent right with respect to a patent application or an application for registration of an extension of the term of a patent right which was refused by a retrial decision has been registered through a retrial, and where the patent has been granted for the invention of a product, the effects of the patent right shall not extend to any product imported into, or manufactured or acquired in Japan, in good faith after the time when the retrial decision became final and conclusive but before the demand for a retrial was registered.

(2) Where a patent right relating to a revoked or invalidated patent or a patent right relating to the invalidated registration of an extension of the term thereof has been restored through a retrial or where the establishment of a patent right or the extension of the term of a patent right with respect to a patent application or an application for registration of an extension of the term of a patent right which was refused by a retrial decision has been registered through a retrial, the effects of the patent right shall not extend to the following acts:

(i) the working of the invention in good faith;

(ii) in the case of a patent for an invention of a product, acts of manufacturing, assigning, leasing, importing or offering for assignment or lease of, in good faith, articles to be used exclusively for the manufacture of the product;

(iii) in the case of a patent for an invention of a process, acts of manufacturing, assigning, leasing, importing or offering for assignment or lease of, in good faith, articles to be used exclusively for the working of such invention.

176. Where a patent right relating to a revoked or invalidated patent or a patent right relating to the invalidated registration of an extension of the term thereof has been restored through a retrial or where the establishment of a patent right or the extension of the term of a patent right with respect to a patent application or an application for registration of an extension of the term of a patent right which was refused by a retrial decision has been registered through a retrial, and where a person has, in good faith, been commercially working the invention in Japan or has, in good faith, been making preparations therefor, after the retrial decision became final and conclusive but before the registration of the demand for a retrial, such persons shall have an non-exclusive license on the patent right, the license being limited to the invention which is being worked or for which preparations for working are being made and to the purpose of such working or the preparation therefor.

177. [Deleted]

CHAPTER VIII LITIGATION

Actions Against Trial Decisions, etc.

178.—(1) An action against a ruling to revoke a patent, a trial decision, or a ruling to dismiss a written opposition or a demand for a trial or retrial shall come under the exclusive jurisdiction of the Tokyo High Court.

(2) An action under Subsection (1) may be instituted only by a party, an intervenor, or a person whose application for intervention in the examination of the opposition to the grant of the patent, in the trial, or in the retrial has been refused.

(3) An action under Subsection (1) may not be instituted after 30 days from the date of transmission of the trial decision or the ruling.

(4) The time limit prescribed in the preceding subsections shall be invariable.

(5) The trial examiner-in-chief may ex officio designate a period additional to the invariable period under the preceding subsection for the benefit of a person residing in a place that is remote or difficult to access.

(6) An action with regard to the matter on which a trial may be demanded may be instituted only against a trial decision.

Defendant in the Action

179. In an action under Section 178(1), the Commissioner of the Patent Office shall be the defendant. Provided, however, that in the case of an action against a trial decision in a trial under Section 123(1) or 125 *bis*(1) or an appeal under Section 171(1) against a final and conclusive trial decision in such a trial, the demandant or the defendant in the trial or retrial shall be the defendant.

Notification of Institution of Action

180. When an action referred to in the proviso to Section 179 has been instituted, the court shall, without delay, notify the Commissioner of the Patent Office accordingly.

Annulment of the Trial Decision or Ruling

181.—(1) Where the court finds for the plaintiff in an action instituted under Section 178(1), it shall annul the trial decision or ruling.

(2) When the court's decision annulling a trial decision or ruling under the preceding subsection has become final and conclusive, the trial examiners shall carry out a further trial examination and render a trial decision or ruling.

Sending of Certified Copy of the Judgment

182. At the end of the proceedings initiated by the action referred to in the proviso to Section 179, the court shall send a certified copy of the judgment of the court concerned to the Commissioner of the Patent Office without delay.

Action on Amount of Remuneration

183.—(1) Where a person who is concerned in an arbitration decision under Section 83(2), 92(3) or (4) or 93(2) is dissatisfied with the amount of remuneration fixed in the decision, he may institute an action for the increase or decrease of the remuneration.

(2) An action under the preceding subsections shall not be instituted after three months from the transmittal of the arbitration decision.

Defendant in the Action

184. In an action under Section 183(1), the following persons shall be made the defendant:

(i) in the case of an arbitration under Section 83(2), 92(4) or 93(2), the non-exclusive licensee, patentee or exclusive licensee;

(ii) in the case of an arbitration under Section 92(3), the non-exclusive licensee or the other person referred to in Section 72.

Relationship between Administrative Appeal and Litigation

184bis. An action for the annulment of measures (with the exception of measures referred to in Section 195bis) taken under this Law or an order or ordinance thereunder may be instituted only after a request for reconsideration or a request for an administrative appeal or an arbitration decision against the measure has been dealt with by a decision or a ruling.

CHAPTER IX

SPECIAL PROVISIONS CONCERNING INTERNATIONAL APPLICATIONS
UNDER THE PATENT COOPERATION TREATY*Patent Application based on International Application*

184ter.—(1) An international application (a patent application only) for which the international filing date has been accorded in accordance with Article 11(1) or (2) (b) or Article 14(2) of the Patent Cooperation Treaty done at Washington on June 19, 1970 (hereinafter referred to as “Treaty” in this Chapter) and which contains the designation of Japan as a designated State referred to in Article 4(1)(ii) of the Treaty shall be considered to be a patent application having been filed on its international filing date.

(2) Section 43 shall not apply to the international application considered to be a patent application by virtue of the provision of the preceding subsection (hereinafter referred to as “international patent application”).

Translation of International Patent Application in Foreign Language

184quater.—(1) The applicant of an international patent application made in a foreign language (hereinafter referred to as “foreign language patent application”) shall furnish to the Commissioner of the Patent Office a translation into Japanese of the description, the claims and the drawings (limited to any text matter of the drawings) and the abstract referred to in Article 3(2) of the Treaty as of the international filing date referred to in Section 184 *ter*(1) (hereinafter referred to as “international filing date”), within one year and eight months (to as “priority date”) [in the case of an international patent application in which an international preliminary examination referred to in Article 33 of the Treaty had been demanded within one year and seven months from the priority date and, further, Japan has been elected as an elected State under Article 31(4)(a) of the Treaty — within two years and six months from the priority date (hereinafter referred to as “time limit for the submission of the national form paper”)] from the priority date referred to in Article 2(xi) of the Treaty (hereinafter referred to as “priority date”).

(2) In the case of preceding subsection, the applicant of a foreign language patent application may, where he has made an amendment under Article 19(1) of the Treaty, furnish a translation of the amended claims in lieu of the translation of the claims referred to in the preceding subsection.

(3) When the translation of the description referred to in Subsection (1) and the translation of the claims referred to in the preceding two subsections have not been furnished within the time limit for the submission of the national form paper, the international patent applications shall be deemed withdrawn.

(4) The applicant who has furnished the translation referred to in Subsection (1) may, where he has made an amendment under Article 19(1) of the Treaty, further furnish a translation into Japanese of the amended claims not only later than the date on which the expiration of the time limit for the submission of the national form paper [or where the applicant has made a request for examination within the time limit for the submission of the national form paper, the time when the said request was made (hereinafter referred to as “relevant time for the national processing”)] occurs.

(5) The principal sentence of Section 184 *septies*(3) shall apply *mutatis mutandis* where the translation referred to in Subsection (2) or (4) has not been furnished.

Submission of Papers and Invitation to Correction

184quinquies.—(1) The applicant of an international patent application shall, within the time limit for the submission of the national form paper, submit to the Commissioner of the Patent Office a paper stating the following:

- (i) the name and the domicile or residence of the applicant;
- (ii) the name and the domicile or residence of the inventor;
- (iii) the international application number and other matters provided for in an ordinance of the Ministry of Economy, Trade and Industry.



(2) The Commissioner of the Patent Office may invite correction, designating an adequate time limit, in the following cases:

(i) when the national form paper to be submitted under the preceding subsection has not been filed within the time limit for the submission of the national form paper;

(ii) when any proceeding under the preceding subsection does not comply with Section 7(1) to (3) and Section 9;

(iii) when any proceeding under the preceding subsection does not comply with the formality requirements provided for in an ordinance of the Ministry of Economy, Trade and Industry;

(iv) when the translation of the abstract to be submitted under Section 184 *bis*(1) has not been filed within the time limit for the submission of the national form paper;

(v) when the fee to be paid under Section 195(2) has not been paid within the time limit for the submission of the national form paper.

(3) Where a person who was invited to make an amendment under the preceding subsection fails to do so within the time limit designated under that subsection, the Commissioner of the Patent Office may dismiss the international patent application concerned.

Effect, etc. of Request, Description, etc., of International Application

184sexies.—(1) The request of an international patent application as of the international filing date shall be deemed to be the request submitted under Section 36(1).

(2) The description and claims of an international patent application made in the Japanese language (hereinafter referred to as “a Japanese language patent application”) as of the international filing date and the translation of the description and claims of a foreign language patent application as of the international filing date shall be deemed to be the specification as submitted attached to the request under Section 36(2), the claims of Japanese language patent application as of the international filing date and the translation of the claims of a foreign language patent application as of the international filing date shall be deemed to be the patent claims set forth in the specification as submitted attached to the request under Section 36(2), and the drawings in a Japanese language patent application as of the international filing date and the drawings (excluding any text matter of the drawings) and the translation of the text matter of the drawings in a foreign language patent application as of the international filing date shall be deemed to be the drawings as submitted attached to the request under Section 36(2), and the abstract of a Japanese language patent application and the translation of the abstract of a foreign language patent application shall be deemed to be the abstract as submitted attached to the request under Section 36(2).

(3) Where the translation of the amended claims under Article 19(1) of the Treaty has been furnished in accordance with Section 184 *bis*(2) or (4), the translation of the description as of the international filing date and the translation of the amended claims shall be deemed to



be the specification as submitted attached to the request under Section 36(2), and the translation of the amended claim shall be deemed to be the patent claim set forth in the specification as submitted attached to the request under Section 36(2) notwithstanding Subsection (2).

Amendment under Article 19 of the Treaty of the Japanese Language Patent Application

184septies.—(1) The applicant of a Japanese language patent application shall, where he has made an amendment under Article 19(1) of the Treaty, furnish to the Commissioner of the Patent Office, no later than the date on which the relevant time limit for international processing occurs, a copy of the amendment furnished under Article 19(1) of the Treaty.

(2) Where a copy of the amendment has been furnished under the preceding subsection, the patent claim set forth in the specification as submitted attached to the request shall be deemed to have been amended under Section 17 *bis*(1) by virtue of the copy of the amendment. However, where the amendment has been communicated to the Patent Office under Article 20 of the Treaty within the time limit prescribed in the preceding subsection, the patent claim shall be deemed to have been amended under Section 17 *bis*(1) by virtue of that amendment.

(3) When the proceeding under Subsection (1) has not been taken by the applicant of a Japanese language patent application within the time limit prescribed in the said subsection, no amendment under Article 19(1) of the Treaty shall be deemed to have been made. However, this shall not apply to the case in the proviso to the preceding subsection.

Amendment under Article 34 of the Treaty

184octies.—(1) The applicant of an international patent application shall, where he has made an amendment under Article 34(2)(*b*) of the Treaty, furnish to the Commissioner of the Patent Office, no later than the date on which the relevant time for international processing occurs, a copy of the amendment furnished under Article 34(2)(*b*) of the Treaty in the case of the amendment in respect of a Japanese language patent application or a translation into Japanese of the amendment in the case of the amendment in respect of a foreign language patent application.

(2) Where a copy of the amendment or a translation of the amendment has been furnished under the preceding subsection, the specification or drawings attached to the request shall be deemed to have been amended under Section 17 *bis*(1) by virtue of the copy of the amendment or the translation of the amendment. However, if, in respect of the amendment concerning a Japanese language patent application, the amendment has been communicated to the Patent Office under Article 36(3)(*a*) of the Treaty within the time limit prescribed in the preceding subsection, the specification or drawings attached to the request shall be deemed to have been amended by virtue of that amendment.

(3) When the proceeding under Subsection (1) has not been taken by the applicant of an international patent application within the time limit prescribed in the said subsection, no

amendment under Article 34(2)(b) of the Treaty shall be deemed to have been made. However, this shall not apply to the case in the proviso to the preceding subsection.

(4) Where the specification or drawings attached to the request of the foreign language patent application are deemed to have been amended under Section 17 bis(1) in the case of Subsection (2), the amendments shall be deemed to have been made by virtue of the submission of a written correction of incorrect translation under Section 17 bis(2).

National Publication of Translation, etc.

184novies.—(1) In respect of a foreign language patent application for which a translation has been furnished under Section 184 bis(1), the Commissioner of the Patent Office shall, except where the Gazette containing the Patent has already been published, effect the national publication of the translation as soon as possible after the expiration of the time limit for the submission of the national form paper [or—where the application is an international patent application for which a request for examination by the applicant has been made within the time limit for the submission of the national form paper and for which the international publication referred to in Article 21 of the Treaty (hereinafter referred to as “international publication”) has been effected—after making a request for examination].

(2) The national publication of the translation shall be effected by publishing the following in the Patent Gazette:

- (i) the name and the domicile or residence of the applicant;
- (ii) the number of the patent application;
- (iii) the international filing date;
- (iv) the name and the domicile or residence of the inventor;

(v) the matters appearing in the translation of the description and the text matter of the drawings referred to in Section 184 bis(1), the matters appearing in the translation of the claims prescribed therein (in the case where a translation has been submitted under Section 184 bis(2), the said translation) and the matters appearing in the translation referred to in Section 184 bis(4), the contents of the drawings (excluding the text matter of the drawings) as well as the matters appearing in the translation of the abstract (with the exception of those matters the publication of which in the Patent Gazette is, in the view of the Commissioner of the Patent Office, liable to contravene public order or morality);

- (vi) the number and the date of the national publication of the translation;
- (vii) other necessary particulars.

(3) Section 64(3) shall apply *mutatis mutandis* to the publication of the matters appearing in the translation of the abstract under Subsection (2)(v), in the Patent Gazette in accordance with Subsection (2).

(4) Section 64 shall not apply to an international patent application.

(5) For the purpose of an international patent application, “laying open” or “laid open” in Section 48 *quinquies*(1), Section 48 *sexies*, the proviso to Section 66(3), Section 128, Section 186(1)(i) and (ii), and Section 193(2)(i), (ii), (vi) and (ix) shall be considered to have been replaced by “the international publication under Section 184 *novies*(1)” in the case of a Japanese language patent application and shall be considered to have been replaced by “the national publication of a translation under Section 184 *novies*(1)” in the case of a foreign language patent application.

(6) For the purposes of a request for certificate, etc. concerning a foreign language patent application, “or the materials referred to in Section 67 *bis*(2)” in Section 186(1)(i) shall be considered to have been replaced by “a request, advertisement, claims, drawings or an abstract of the international application referred to in Article 3(2) of the Patent Cooperation Treaty done at Washington, June 19, 1970 (excluding such documents concerning an international patent application for which the establishment of the patent has been registered or such documents for which the international publication has been effected).”

(7) In respect of the matter to be published in the Patent Gazette concerning the international patent application, “attached to a request after the application has been laid open” in Section 193(2)(iii) shall be considered to have been replaced by “... attached to a request of an international application for which the international publication has been effected.”

Effects, etc. of International Publication and National Publication

184decies.—(1) The applicant of an international patent application may, after the international publication in the case of a Japanese language patent application and after the national publication of the translation in the case of a foreign language patent application, and following a warning by the applicant in the form of a document describing the contents of the invention claimed in the international patent application, demand of a person who has commercially worked the invention, after the warning but before the registration of the establishment of the patent right, the payment of compensation in a sum of money equivalent to what he would be entitled to receive for the working of the invention if it were patented invention. Even in the absence of the warning, in the case of a Japanese language patent application, the same shall apply to a person who commercially worked the invention before the registration of the establishment of the patent right, knowing that the invention was the one claimed in the international patent application for which the international publication has been effected, and in the case of a foreign language patent application, the same shall apply to a person who commercially worked the invention before the registration of the establishment of the patent right, knowing that the invention was the one claimed in the international patent application for which the national publication of the translation has been effected.

(2) Section 65(2) to (5) shall apply *mutatis mutandis* to the exercise of the right to demand compensation under the preceding subsection.

Special Provisions Concerning Patent Administrator for Residents Abroad



184undecies.—(1) Notwithstanding Section 8(1), an applicant of an international patent application who is a resident abroad may proceed before the Patent Office without being represented by a patent administrator until the relevant time for the national processing.

(2) The person under the preceding subsection shall appoint a patent administrator and notify the Commissioner of the Patent Office after the date on which the relevant time for the national processing occurs and within the time limit prescribed in an ordinance of the Ministry of Economy, Trade and Industry.

(3) Where the notification of the appointment of a patent administrator has not been made within the time limit under the preceding subsection, the international patent application shall be considered to have been withdrawn.

Special Provisions Concerning Amendment

184duodecies.—(1) Notwithstanding the principal sentence of Section 17(1), no amendment (except the amendment under Sections 184 *septies*(2) and 184 *octies*(2)) may be made until, in respect of a Japanese language patent application, after the proceeding has been taken under Section 184 *quinquies*(1) and the fee to be paid under Section 195(2) has been paid, and, in the case of a foreign language patent application, after the proceeding under Sections 184 *bis*(1) and 184 *quinquies*(1) and the fee to be paid under Section 195(2) and after the relevant time for the national processing has occurred.

(2) For the purposes of the scope of amendments of the specification or drawings concerning a foreign language patent application, “foreign language file application under Section 36 *bis*(2)” in Section 17 *bis*(2) shall be considered to have been replaced by “foreign language patent application referred to in Section 184 *bis*(1),” “the specification or drawings originally attached to the request [in the case of a foreign language file application under Section 36 *bis*(2), the translation of the foreign language file referred to in Section 36(2) considered to be a specification and drawings by virtue of the provisions of Section 36(4) (in the case where the specification or drawings were amended by virtue of the submission of a written correction of incorrect translation, said translation or the specification or drawings as amended)]” in Section 17 *bis*(3) shall be considered to have been replaced by “the translation referred to in Section 184 *bis*(1) of the specification or drawings (limited to any text matter of the drawings) of the international patent application referred to in Section 184 *ter*(2) (hereinafter referred to as “international patent application” in this subsection) as of the international filing date referred to in Section 184 *bis*(1) (hereinafter referred to as the “international filing date” in this subsection),” the translation referred to in Section 184 *bis*(1) of the claims of the international patent application as of the international filing date (in the case where a translation of the amended claims under Article 19(1) of the Patent Cooperation Treaty done at Washington on June 19, 1970 has been furnished under Section 184 *bis*(2) or (4), such translation), or the drawings (excluding the text matter of the drawings) of the international patent application as of the international filing date (hereinafter referred to as “translation, etc.” in this subsection) (in the case where the specification or drawings were amended by virtue of the submission of the written correction of incorrect translation, the translation, etc. or such specification or drawings as amended).

(3) The applicant of an international patent application may, notwithstanding Section 17ter, amend the abstract attached to the request only within one year and three months from the priority date (with respect to the foreign language patent application being one of the such applications as their translations were furnished in accordance with the provision of Section 184bis(1), for which, within the time limit for the submission of the national form paper, the request was made by the applicant for examination of the application and of which the international publication was effected, the period after the request was made for examination of the application, is excluded).

Special Provisions Concerning Patentability

184terdecies. For the purposes of Section 29 bis of this Law, where an international patent application referred to in Section 184 ter(2) of this Law or an international utility model application referred to in Section 48 ter(2) of the Utility Model Law is another application for a patent or an application for a utility model registration as referred to in Section 29 bis of this Law, the passage reading “the specification or drawings originally attached to the request” in Section 29 bis of this Law shall be considered to have been replaced by “the description, claims or drawings of the international application as of the international filing date referred to in Section 184 bis(1) of this Law or Section 48 bis(4) of the Utility Model Law,” and the passage reading “another application for a patent or of an application for a utility model registration which was” shall be considered to have been replaced by “another application for a patent or of an application for a utility model registration (excluding the foreign patent application referred to in Section 184 bis(1) of the Patent Law which was deemed to have been withdrawn under said Section (3) or the foreign language utility model application referred to in Section 48 bis(1) of the Utility Model Law which was deemed to have been withdrawn under said Section (3)),” and the passage reading “the laying open for public inspection (Kôkai) was effected or” in Section 29 bis of this Law shall be considered to have been replaced by “the laying open for public inspection (Kôkai) was effected,” and the passage reading “was published under said subsection after the filing of the patent application” in Section 29 bis of this Law shall be considered to have been replaced by “was published under said subsection or the international publication referred to in Article 21 of the Patent Cooperation Treaty done at Washington on June 19, 1970 was effected after the filing of the patent application.”

184quaterdecies. Notwithstanding Section 30(4), any applicant of an international patent application who desires the application of Section 30(1) or (3) may submit to the Commissioner of the Patent Office a written statement to that effect and a document proving that the invention which has fallen under one of the paragraphs of Section 29(1) is the invention to which Section 30(1) or (3) may be applied, after the date on which the relevant time for the national processing occurs and within the time limit prescribed in an ordinance of the Ministry of Economy, Trade and Industry.

Special Provisions Concerning Priority Claim Based on Patent Applications, etc.



184quindecies.—(1) Sections 41(4) and Section 42(2) shall not apply to an international patent application.

(2) For the purposes of Section 41(3) for a Japanese language patent application, “or the laying open for public inspection” in the said Sections shall be considered to have been replaced by “or the international publication referred to in Article 21 of the Patent Cooperation Treaty done at Washington on June 19, 1970.”

(3) For the purposes of Section 41(3) for a foreign language patent application, in the said Section, “the specification or drawings originally attached to the request of a patent application” shall be considered to have been replaced by “the description, the claims or the drawings of an international application as of the international filing date referred to in Section 184bis(1)” and “or the laying open for public inspection” shall be considered to have been replaced by “or the international publication referred to in Article 21 of the Patent Cooperation Treaty done at Washington on June 19, 1970.”

(4) For the purposes of Sections 41(1) to (3) and 42(1) of this Law in the case where the earlier application under Section 41(1) of this Law is an international patent application or an international utility model application referred to in Section 48ter(2) of the Utility Model Law, “the specification or drawings originally attached to the request” in Section 41(1) and (2) shall be considered to have been replaced by “the description, the claims or the drawings of an international application as of the international filing date referred to in Section 184bis(1) of this Law or Section 48bis(1) of the Utility Model Law,” “the specification or drawings originally attached to the request of the earlier application” and “the laying open for public inspection” in Section 41(3) shall be considered to have been replaced by “the description, the claims or the drawings of an international application as of the international filing date referred to in Section 184bis(1) of this Law or Section 48bis(1) of the Utility Model Law of the earlier application” and “the international publication referred to in Article 21 of the Patent Cooperation Treaty done at Washington on June 19, 1970,” and “at the expiration of one year and three months from the filing date” in Section 42(1) shall be considered to have been replaced by “at the expiration of the time limit for the national processing under Section 184bis(4) of this Law or Section 48bis(4) of the Utility Model Law or one year and three months from the international filing date referred to in Section 184bis(1) of this Law or Section 48bis(1) of the Utility Model Law, whichever is later”.

Special Provisions Concerning Conversion of Applications

184sedecies. Conversion into a patent application of an international application having been considered or recognized to be a utility model application under Section 48ter(1) or 48sedecies(4) of the Utility Model Law may not be made until, in respect of a Japanese language utility model application referred to in Section 48quinquies(4) of the Utility Model Law, after the proceedings under Section 48quinquies(1) of the Utility Model Law has been taken, and in respect of a foreign language utility model application referred to in Section 48bis(1) of the Utility Model Law, after the proceedings under Sections 48bis(1) and 48quinquies(1) of the Utility Model Law have been taken and, further, after the fee to be paid under Section 54(2) of the Utility Model Law has been paid (or — in respect of an international



application having been recognized as a utility model application under Section 48 *sedecies*(4) of the Utility Model Law —after the decision referred to in the said subsection has been made).

Time Limit for Making Request for Examination

184septiesdecies. The applicant of an international patent application may not make a request for examination for his international patent application until, in respect of a Japanese language patent application, after the proceeding under Section 184 *quinqüies*(1) has been taken, and in respect of a foreign language patent application, after the proceedings under Sections 184 *bis*(1) and 184 *quinqüies* (1) and have been taken and, further, after the fee to be paid under Section 195(2) has been paid, whereas, a person other than the applicant of the international patent application may not make a request for examination of the international patent application until after the expiration of the time limit for the submission of the national form paper.

Special Provisions for Reasons for Refusal, etc.

184duodecimes. For the purpose of the examiner's decision of refusal, with respect to the foreign language patent application, the opposition to the patent and trial under Section 123(1), "foreign language file application" in Sections 49(v), 113(i) and (v), and 123(1)(i) and (v) shall be replaced by "foreign language patent application referred to in Section 184 *bis*(1)," and "foreign language file" in Section 49(v), 113(v), and 123(1)(v) shall be replaced by "the specification or drawings of the international application as of the international filing date referred to in Section 184 *bis* (1)."

Special Provisions Concerning Correction

184undecimes. For the purpose of the demand for the correction under Sections 120 *bis*(2) and 134(2) and the demand for a trial under Section 126(1) with respect to a foreign language patent application, "foreign language file application" in Section 126(2) shall be replaced by "foreign language patent application referred to in Section 184 *bis*(1)" and "foreign language file" in that Section (2) shall be replaced by "the specification or drawings of the international application as of the international filing date referred to in Section 184 *bis*(1)."

International Application Recognized as Patent Application by Decision

184vicies.—(1) The applicant of an international application defined in Article 2(vii) of the Treaty may, where the receiving Office defined in Article 2(xv) of the Treaty has made a refusal referred to in Article 25(1)(a) of the Treaty or has made a declaration referred to in Article 25(1)(a) or (b) of the Treaty or the International Bureau defined in Article 2(xix) of the Treaty has made a finding referred to in Article 25(1)(a) of the Treaty in respect of the international application (only a patent application) which contains the designation of Japan as a designated State referred to in Article 4(1)(ii) of the Treaty, request the Commissioner of

the Patent Office as provided in an ordinance of the Ministry of Economy, Trade and Industry to make a decision referred to in Article 25(2)(a) of the Treaty within the time limit prescribed in an ordinance of the Ministry of Economy, Trade and Industry.

(2) A person whom a request is made under the preceding subsection in respect of the international application made in a foreign language shall furnish to the Commissioner of the Patent Office at the time of making such a request a translation into Japanese of the description, the claims, the drawings (limited to any text matter of the drawings) and the abstract as well as other documents relating to the international application provided for in an ordinance of the Ministry of Economy, Trade and Industry.

(3) Where the request under Subsection (1) has been made, the Commissioner of the Patent Office shall decide whether the refusal, declaration, or finding referred to therein was justified under the provisions of the Treaty and the Regulations under the Patent Cooperation Treaty.

(4) Where the Commissioner of the Patent Office has made a decision under the preceding subsection to the effect that the refusal, declaration, or finding referred to in the said subsection was not justified under the provisions of the Treaty and the Regulations under the Patent Cooperation Treaty, the international application concerned shall be recognized as a patent application filed on the date which would be accorded as the international filing date if said refusal, declaration, or finding were not made in respect of the said international application.

(5) For the purpose of the laying open for public inspection of an international application recognized as a patent application under the preceding subsection, "date of the application" in Section 64(1) shall be replaced by "priority date referred to in Section 184bis(1)," "foreign language file application" in Section 64(2)(vi) shall be replaced by "international application made in the foreign language," and "foreign language file and foreign language abstract" in Section 64(2)(vi) shall be replaced by "the description, the claims, drawings and abstract of the international application as of the date which would be accorded as the international filing date under Section referred to in Section 184vicies (4)."

(6) Sections 184ter(2), 184sexies(1) and (2), 184novies(6), 184duodeciesto 184bisdecies, 184quindecies(1), (3) and (4), and 184septies deciesto 184undeviciess shall apply *mutatis mutandis* to the international application deemed as a patent application under Subsection (4). In such a case, the details necessary for the application of those provisions shall be prescribed by Cabinet Order.

CHAPTER X MISCELLANEOUS PROVISIONS

Special Provisions for Patent or Patent Right Covering Two or More Claims

185. For the purposes of the provisions of Section 27(1)(i) or Section 65(4) (including its application under Section 184decies(2)), 80(1), 97(1), 98(1)(i), 111(1)(ii), 114(3) (including its application under Section 174(1)), Section 123(2), 125, 126(5) (including its

application under Section 134(5)), Section 132(1) (including its application under Section 174(3)) or Section 175, 176 or 193(2)(iv) of this Law, or of Section 20(1) of the Utility Model Law, relating to the patent or a patent right covering two or more claims, the patents shall be deemed to have been granted, or the patent rights shall be deemed to exist, for each claim.

Request for Certification, etc.

186.—(1) Any one may request the Commissioner of the Patent Office to issue a certificate, a copy or an extract of documents, to allow the inspection or copying of documents or to issue documents whose contents are recorded in the part of the Patent Register prepared by magnetic tapes, where such documents relate to patents. However, this provision shall not apply in the case of the following documents if the Commissioner of the Patent Office considers it necessary to keep them secret:

(i) a request for the specification, drawings or abstract attached to a request, or a foreign language file or foreign language abstract or documents concerning the examination of the patent application (except where the establishment of the patent right has been registered or where the patent application has been laid open), or the materials referred to in Section 67bis(2);

(ii) documents concerning a trial under Section 121(1) (except where the establishment of the patent right has been registered or where the patent application concerned has been laid open);

(iii) documents concerning a trial decision under Section 123(1) or Section 125 bis(1) or a trial of the final and conclusive trial decision, with respect to which parties or intervenors concerned have given a notice that there has been described a trade secret (trade secret as prescribed in Section 2(4) of the Unfair Competition Prevention Law (Law No. 47 of 1993)) owned by the parties or intervenors concerned;

(iv) matters liable to injure the reputation or peaceful existence of an individual;

(v) documents liable to contravene public order or morality.

(2) Where a demand made with respect to documents as prescribed in the paragraphs of the preceding subsection is accepted, the Commissioner of the Patent Office shall notify a person, who has submitted such documents to that effect with a reason therefor.

(3) The Law Concerning Access to Information held by Administrative Organs (Law No. 42 of 1999) shall not apply to the documents concerning patents and the part of the Patent Register, which have been prepared by magnetic tapes.

Indication of Existence of Patent

187. A patentee or an exclusive or non-exclusive licensee shall take steps, as prescribed in an ordinance of the Ministry of Economy, Trade and Industry, to mark the patented product or a product produced by the patented process (hereinafter referred to as a “patented product”), or the packaging thereof, with a statement to the effect that the invention of the

product or the process has been patented (hereinafter referred to as an “indication of a patent”).

Prohibition of False Marking

188. The following acts shall be unlawful:

(i) the marking of anything other than a patented product or its packaging with an indication of a patent or confusingly similar indication;

(ii) the assignment, lease or display for the purpose of assignment or lease of a product other than a patented product, where such product or its packaging is marked with an indication of a patent or confusingly similar indication;

(iii) the inclusion in an advertisement of an indication that an invention of a product has been patented or a confusingly similar indication, for the purpose of causing others to produce or use the product or of assigning or leasing the product, where it is not a patented product;

(iv) the inclusion in an advertisement of an indication that an invention of a process has been patented or a confusingly similar indication, for the purpose of causing others to use the process or of assigning or leasing the process, where it is not a patented process.

Transmittal of Documents

189. An ordinance of the Ministry of Economy, Trade and Industry shall prescribe the documents to be transmitted in addition to those provided for in this Law.

190. Sections 98(2), 99 to 103, 105, 106, 107(1) (excluding Paragraphs (ii) and (iii)) and (3) and 109 (transmittal) of the Code of Civil Procedure shall apply *mutatis mutandis* to the transmittal of documents provided for in this Law or in an ordinance of the Ministry of Economy, Trade and Industry under Section 189. In such a case, a “court clerk” in Sections 98(2) and 100 of the said Code shall read an “official or trial clerk” designated by the Commissioner of the Patent Office, a “bailiff or post” in Section 99(1) of the said Code shall read a “post”, and “in the case... the court clerk” in Section 107(1) of the said Code shall read “in the case... and in the case where documents relating to an examination are to be transmitted, an official or trial clerk” designated by the Commissioner of the Patent Office.

191.—(1) Where the domicile or residence of a person to whom transmittal is to be made or any other place to which transmittal is to be made is unknown or transmittal in accordance with Section 107(1) (excluding Paragraphs (ii) and (iii)) of the Code of Civil Procedure applied under Section 190 of this Law is not possible, transmittal may instead be effected by public notice.

(2) The transmittal by public notice shall be made by publishing a notice in the Official Gazette and the Patent Gazette to the effect that the documents to be transmitted are ready to be delivered at any time to the person entitled to receive them and by posting such notice on the bulletin board of the Patent Office.



(3) The transmittal by public notices shall take effect after the expiration of 20 days from the date on which the notice was published in the Official Gazette.

192.—(1) Where a resident abroad has a patent administrator, the transmittal shall be made to the patent administrator.

(2) Where a resident abroad has no patent administrator, the documents may be dispatched by registered airmail.

(3) Where documents have been sent by post under the preceding subsection, the transmittal shall be deemed to have been made at the time of dispatch.

Patent Gazette

193.—(1) The Patent Offices shall publish the Patent Gazette (Tokyo Kôhô).

(2) In addition to the matters provided for in this Law, the Patent Gazette shall contain:

(i) decisions of refusal, or abandonment, withdrawal or dismissal of a patent application after its laying open or withdrawal of an application for the registration of a patent or extension of the term of a patent right;

(ii) succession to the right to obtain a patent after the laying open;

(iii) amendments of the specification or drawings attached to the request under Section 17 *bis*(1) after the application has been laid open (in the case of an amendment under each paragraph of the proviso to Section 17 *bis*(1), limited to one by submitting a written correction of mistranslation);

(iv) extinguishment of patent rights (excluding that due to the expiration of a term and that under Section 112(4) or (5)) or the restoration (limited to that under Section 112 *bis*(2));

(v) opposition to the patents or demands for trials or retrials, or withdrawal thereof;

(vi) final and conclusive rulings on the opposition to the patents, trial decisions, or rulings of retrials or retrial decisions (limited to patent applications with respect to which the establishment of a patent right has been registered or which have been laid open);

(vii) particulars stated in the corrected specification and the contents of the drawings (limited to those which a final and conclusive ruling or trial decision to correct has been rendered);

(viii) requests for an arbitration decision or withdrawal thereof and arbitration decisions;

(ix) final judgments in an action under Section 178(1) (limited to patent applications with respect to which the establishment of a patent right has been registered or which have been laid open).

Production of Documents, etc.

194.—(1) The Commissioner of the Patent Office or the examiner may require a party to produce documents or other evidence necessary for a procedure other than one relating to an opposition to the patent, a trial, or a retrial.

(2) The Commissioner of the Patent Office or the examiner may entrust a related administrative organization or an educational establishment or other body with the search necessary for an examination.

Fees

195.—(1) The persons specified hereunder shall pay the fee the amount of which shall be prescribed by Cabinet Order with the actual cost taken into consideration:

- (i) person requesting an extension of the time limit under Section 4, 5(1) or 108(3), or change of date under Section 5(2);
- (ii) person requesting re-issuance of Letters Patent;
- (iii) person making notification of succession in accordance with Section 34(4);
- (iv) person requesting issuance of certificate in accordance with Section 186(1);
- (v) person requesting issuance of copy or extract of documents in accordance with Section 186(1);
- (vi) person requesting inspection or copying of documents in accordance with Section 186(1);

(vii) person requesting issuance of documents containing matters recorded in that part of the Patent Register as prepared on magnetic tapes, in accordance with Section 186(1).

(2) The persons specified in the left-hand column of the attached table shall pay the fee the amount of which shall be prescribed by Cabinet Order within the limit of the amounts specified in the right-hand column of the table.

(3) Where, after a person other than the applicant has made a request for examination, the number of claims is increased because of an amendment with respect to the specification attached to the request, the fees for the request for examination to be paid under the preceding subsections shall be paid by the applicant for the increased number of claims, notwithstanding the preceding subsection.

(4) The three preceding subsections shall not apply where the person to pay the fee in accordance with the subsections is the State and the like.

(5) The provisions of Subsections (1) to (3) shall not apply where the person to pay the fee in accordance with these provisions is the State entitled to own jointly a patent right or a right to obtain a patent and the Independent administrative institutions prescribed by Cabinet Order in Section 107(2), or the Independent administrative institutions entitled to own jointly such rights prescribed by Cabinet Order in the same subsection.

(6) Where the State and the like and person so other than the State and the like own jointly a patent right or a right to obtain a patent and there is an agreement with respect to their shares of the right, the fee under Subsection (1) or (2) (limited to the fees prescribed by Cabinet Order) shall be a sum with prescribed fees under these subsections multiplied by the ratios of the shares of the person so other than the State and the like, and person so other than the State and the like shall pay such sum, notwithstanding the provisions of these subsections.

(7) Where the amount of the fee calculated in accordance with the provision of the preceding subsection has a fractional figure less than 10 yen, that fractional figure shall be discarded.

(8) The payment of the fees under Subsections (1) to (3) shall be made by patent revenue stamps as prescribed by an ordinance of the Ministry of Economy, Trade and Industry. However, where so prescribed by an ordinance of the Ministry of Economy, Trade and Industry, such payment may be made in cash.

(9) A fee paid by mistake or in excess shall be refunded upon the request of the person making the payment.

(10) No request for a refund of a fee under the preceding subsection may be made after one year from the date of payment.

Reduction of Fee for Request for Examination, or Exemption Therefrom

195bis. Where the Commissioner of the Patent Office recognizes that a person who is mentioned below and falls under the requirement prescribed by Cabinet Order for a person to be short of funds, cannot afford to pay a fee for request for examination, he may reduce the fee for request for examination under Section 195(2) with respect to his patent application, exempt him therefrom or grant him a deferment of payment thereof as prescribed by Cabinet Order:

(i) the inventor of the patented invention or the inventor's heir;

(ii) the employer etc., who has succeeded to the right to obtain a patent from the employee, etc., where the patent invention is an employee's invention made by the employee, etc. as referred to in Section 35(1) and where it is provided in advance in a contractual provision, service regulation or other stipulation that the right to obtain a patent shall pass to the employer, etc..

Exemption of Application of Administrative Procedure Law

195ter. These second and third chapters of the Administrative Procedure Law (Law No. 88 in 1993) shall not apply to the measures under this Law or an order or ordinance thereunder this Law.

Restriction on Appeals under Administrative Appeal Law

195 *quater*. No appeal under the Administrative Appeal Law shall lie from an examiner's decision or a ruling to revoke a patent, a trial decision, and a ruling to dismiss a written opposition to the patent, or a demand for a trial or retrial nor from measures against which no appeal lies in accordance with this Law.

CHAPTER XI PENAL PROVISIONS

Offense of Infringement

196. Any person who has infringed a patent right or an exclusive license shall be liable to imprisonment with labor not exceeding five years or to a fine not exceeding 5,000,000 yen.

Offense of Fraud

197. Any person who has obtained a patent, a registration of an extension of the term of a patent right, a ruling on the opposition to the patent, or a trial decision by means of a fraudulent act shall be liable to imprisonment with labor not exceeding three years or to a fine not exceeding 3,000,000 yen.

Offense of False Marking

198. Any person infringing Section 188 shall be liable to imprisonment with labor not exceeding three years or to a fine not exceeding 3,000,000 yen.

Offense of Perjury, etc.

199.—(1) A witness, expert witness or interpreter who, having taken an oath under this Law, has made a false statement or has given a false expert opinion or has interpreted falsely before the Patent Office or a court commissioned thereby shall be liable to imprisonment with labor for a term not less than three months nor more than ten years.

(2) Where a person committing the offense in the preceding subsection has made a voluntary confession before the certified copy of the interpretation is transmitted or the ruling on the opposition to the patent or trial decision concerning the case has become final and conclusive, his sentence may be reduced or suppressed.

Offense of Divulging Secrets

200. Where any present or former official of the Patent Office has divulged or made surreptitious use of these secrets relating to an invention in a patent application to which he had access in the course of his duties, he shall be liable to imprisonment with labor not exceeding one year or a fine not exceeding 500,000 yen.

Dual Liability

201. Where an officer representing a legal entity or a representative, employee or any other servant of a legal entity or of a natural person has committed an act in violation of any of the provisions prescribed in the following paragraphs with regard to the business of the legal entity or natural person, the legal entity or the natural person shall, in addition to the offender, be liable to the fine prescribed in the following paragraphs :

- (i) Section 196, a fine not exceeding 150 million yen;
- (ii) Section 197 or 198, a fine not exceeding 100 million yen.

Administrative Penalties

202. Where a person who has taken an oath under Section 207(1) of the Code of Civil Procedure as applied under Section 151 [including its application under Sections 71(3), 119 (including its application under Section 174(1)) and 174(2) to (4) of this Law] has made a false statement before the Patent Office or a court commissioned thereby, he shall be liable to an administrative penalty not exceeding 100,000 yen.

203. Where a person who has been summoned by the Patent Office or a court commissioned thereby in accordance with this Law has failed to appear or has refused to take an oath, to make a statement, to testify, to give an expert opinion or to interpret, without a legitimate reason, he shall be liable to an administrative penalty not exceeding 100,000 yen.

204. Where a person who has been ordered by the Patent Office or a court commissioned thereby to produce or show documents or other evidence in accordance with the provisions of this Law relating to the examination or preservation of evidence has failed to comply with the order, without a legitimate reason, he shall be liable to an administrative penalty not exceeding 100,000 yen.

Attached Table (Related to Section 195)

<i>Person liable to pay</i>	<i>Amounts</i>
1. Person filing patent application (except those listed below)	¥21,000 per case
2. Person filing foreign language file application	¥35,000 per case
3. Person taking proceeding under Section 184 <i>quinquies</i> (1)	¥21,000 per case
4. Person making request under Section 184 <i>vicies</i> (1)	¥21,000 per case
5. Person making request for extension of term of patent right	¥74,000 per case
6. Person making request for examination	¥84,300 per case plus ¥2,700 per claim
7. Person amending specification or drawings by submitting written correction of incorrect translation	¥19,000 per case



8.	Person requesting interpretation in accordance with Section 71(1)	¥40,000 per case
9.	Person requesting arbitration decision	¥55,000 per case
10.	Person requesting cancellation of arbitration decision	¥27,500 per case
11.	Person filing opposition to patent	¥8,700 per case plus ¥1,000 per claim
12.	Person applying to intervene in examination of opposition to patent	¥11,000 per case
13.	Person demanding trial or retrial (except those listed below)	¥49,500 per case plus ¥5,500 per claim
14.	Person demanding trial against examiner's decision of refusal of, or trial for invalidation of, registration of extension of term of patent right or retrial against any of these final and conclusive trial decisions	¥55,000 per case
15.	Person demanding amendment of specification or drawings	¥49,500 per case plus ¥5,500 per claim
16.	Person demanding intervention in trial or retrial	¥55,000 per case

* Entry into force: January 6, 2001 (The proviso of Section 46(1),(2) and amendment in Section 48 *ter.*(1) shall enter into force as of October 1, 2001, and Section 186(3) shall enter into force as of April 1, 2001.)