

Utility Model Act

(Act No. 123 of April 13, 1959)

Chapter I General Provisions

(Purpose)

Article 1 The purpose of this Act is to encourage devices by promoting the protection and the utilization of devices relating to the shape or structure of an article or combination of articles, and thereby to contribute to the development of industry.

(Definitions)

Article 2 (1) "Device" in this Act means the creation of technical ideas utilizing the laws of nature.

(2) "Registered utility model" in this Act means a device for which a utility model registration has been granted.

(3) "Working" of a device in this Act means making, using, assigning, leasing, exporting, importing or offering for assignment or lease (including displaying for the purpose of assignment or lease, the same shall apply hereinafter) an article which embodies the device.

(Amendment procedures)

Article 2-2 (1) A person undertaking procedures relating to a utility model registration (hereinafter simply referred to as "procedures") including filing an application for a utility model registration and a request before the Patent Office may make amendments only while the case is pending; provided, however, that the person may not amend the description, scope of claims, drawing(s) or the abstract attached to the application, after the expiration of the time limit prescribed by the Cabinet Order from the filing date of the application for a utility model registration.

(2) Any amendment of the description, scope of claims or drawings under the main clause of paragraph (1) shall be made within the scope of the matters described in the description, scope of claims or drawing(s) originally attached to the application.

(3) Notwithstanding paragraph (1), the corrected description, scope of claims, drawing(s) or the abstract attached to the written request for correction under Article 14-2(1) may not be amended.

(4) The Commissioner of the Patent Office may order an amendment by the applicant, designating an adequate time limit, in the following cases:

(i) where the procedure does not comply with the requirements of Articles 7 (1) to (3) or Article 9 of the Patent Act (Act No. 121 of 1959) as applied mutatis mutandis pursuant to Article 2-5(2);

(ii) where the procedure does not comply with the formal requirements prescribed by this Act or an order thereunder;

- (iii) where the fees relating to the procedure payable under Article 32(1) have not been paid;
and
 - (iv) where the fees relating to the procedure payable under Article 54(1) or (ii) have not been paid.
- (5) Any amendment, except in the case of the payment of registration fee or other fees, shall be submitted in writing.

(Dismissal of procedures)

Article 2-3 The Commissioner of the Patent Office may dismiss the procedures where a person ordered to make an amendment under Article 2-2(4), 6-2 or 14-3 fails to make such amendment within the designated time limit under the said provisions.

(Capacity of associations, etc. which are not juridical persons to undertake procedures)

Article 2-4 (1) An association or foundation which is not a juridical person but for which a representative or an administrator has been designated may, in its name:

- (i) file a request for Utility Model Technical Opinion under Article 12(1);
 - (ii) file a request for a trial; and
 - (iii) file a request for a retrial against a final and binding decision in a trial.
- (2) An association or foundation which is not a juridical person but for which a representative or an administrator has been designated may be named as a claimant in a request filed for a retrial against a final and binding decision in a trial.

(Mutatis mutandis application of Patent Act)

Article 2-5 (1) Articles 3 and 5 of the Patent Act shall apply mutatis mutandis to periods and dates provided for in this Act.

- (2) Articles 7 to 9, 11 to 16 and 18-2 to 24 of the Patent Act shall apply mutatis mutandis to procedures.
- (3) Article 25 of the Patent Act shall apply mutatis mutandis to utility model rights and other rights relating to utility model registrations.
- (4) Article 26 of the Patent Act shall apply mutatis mutandis to utility model registrations.

Chapter II Utility Model Registration and Applications for a Utility Model Registration

(Conditions for Utility Model Registration)

Article 3 (1) A creator of a device that relates to the shape or structure of an article or combination of articles and is industrially applicable may be entitled to obtain a utility model registration for said device, except when the following applies:

- (i) the device was publicly known in Japan or a foreign country, prior to the filing of the application for a utility model registration therefor;
- (ii) the device was publicly worked in Japan or a foreign country, prior to the filing of the

- application for a utility model registration therefor; or
- (iii) the device was described in a distributed publication, or a device that was made publicly available through an electric telecommunication line in Japan or a foreign country, prior to the filing of the application for a utility model registration therefor.
- (2) Where, prior to the filing of the application for a utility model registration, a person ordinarily skilled in the art of the device would have been exceedingly easy to create the device based on a device prescribed in any of the items of the preceding paragraph, a utility model registration shall not be granted for such a device notwithstanding the preceding paragraph.

Article 3-2 Where a device claimed in an application for a utility model registration is identical with a device or invention (excluding a device created or an invention made by the creator of the device claimed in the said application for a utility model registration) disclosed in the description, scope of claims or drawings (in the case of the written application in foreign language under Article 36-2(2) of the Patent Act, the document in foreign language as provided in Article 36-2(1)) originally attached to the written application of another application for a utility model registration or for a patent which has been filed prior to the date of filing of the said application for a utility model registration and published after the filing of the said application for a utility model registration in the utility model bulletin under Article 14(3) (hereinafter the "Utility Model Bulletin") or in the patent bulletin under Article 66(3) of the Patent Act describing matters provided for in each of the paragraphs of the respective Article or for which the publication of the patent application has been effected, a utility model registration shall not be granted for such a device notwithstanding paragraph (1) of the preceding Article; provided, however, that this shall not apply where, at the time of the filing of the said application for a utility model registration, the applicant of the said application and the applicant of the other application for a utility model registration or for a patent are the same person.

(Unregistrable devices)

Article 4 Notwithstanding Article 3(1), any device that is liable to injure public order, morality or public health shall not be granted a utility model registration.

(Applications for a utility model registration)

- Article 5 (1) A person requesting the grant of a utility model registration shall submit an application to the Commissioner of the Patent Office stating the following:
- (i) the name and domicile or residence of the applicant(s) for utility model registration; and
- (ii) the name and domicile or residence of the creator(s) of the device.
- (2) The description, scope of claims, drawing(s) and abstract shall be attached to the application.
- (3) The description as provided in the preceding paragraph shall state the following:
- (i) the title of the device;
- (ii) a brief explanation of the drawing(s) ; and

- (iii) a detailed explanation of the device.
- (4) The detailed explanation of the device as provided in item (iii) of the preceding paragraph shall be stated clearly and sufficiently so as to enable a person ordinarily skilled in the art to which the device pertains to work the device, in accordance with the relevant Ordinance of the Ministry of Economy, Trade and Industry,.
- (5) The scope of claims as provided in paragraph (2) shall state a claim or claims and state for each claim all matters necessary to specify the device for which the applicant requests the grant of a utility model registration. In such case, a device specified by a statement in one claim may be the same device specified by a statement in another claim.
- (6) The statement of the scope of claims as provided in paragraph (2) shall comply with each of the following items:
 - (i) the device for which a utility model registration is sought is stated in the detailed explanation of the device;
 - (ii) the device for which a utility model is sought is clear;
 - (iii) the statement for each claim is concise; and
 - (iv) the statement is composed in accordance with the relevant Ordinance of the Ministry of Economy, Trade and Industry.
- (7) The abstract as provided in paragraph (2) shall state a summary of the device disclosed in the description, scope of claims or drawing(s), and any other matters as provided by the relevant Ordinance of the Ministry of Economy, Trade and Industry.

Article 6 Two or more devices may be the subject of a single application for a utility model registration in the same application provided that these devices are of a group of devices recognized as fulfilling the requirements of unity of device based on their technical relationship designated in the relevant Ordinance of the Ministry of Economy, Trade and Industry.

(Order to amend)

- Article 6-2 The Commissioner of the Patent Office may order the applicant to amend the description, scope of claims or drawing(s) attached to the application, designating an adequate time limit, in any of the following items:
- (i) where the device claimed in the application for a utility model registration does not pertain to the shape or structure of an article or combination of articles;
 - (ii) where the device claimed in the application for a utility model registration is not registrable under Article 4;
 - (iii) where the application for a utility model registration does not satisfy the requirement prescribed in Article 5(6)(iv) or in the preceding Article; or
 - (iv) where the description, scope of claims or drawing(s) attached to the application does not state all of the necessary matters or is extremely unclear.

(Prior application)

Article 7 (1) Where two or more applications for a utility model registration claiming identical devices have been filed on different dates, only the applicant who filed the application on the earliest date shall be entitled to obtain a utility model registration for the device claimed.

(2) Where two or more applications for a utility model registration claiming identical devices have been filed on the same date, none of the applicants shall be entitled to obtain a utility model registration for the device claimed.

(3) Where a device and an invention claimed in applications for a utility model registration and for a patent are identical and the applications for a utility model registration and for a patent are filed on different dates, the applicant for a utility model registration may obtain a utility model registration for the device claimed therein, only if the application for a utility model registration is filed prior to the application for a patent.

(4) Where an application for a utility model registration or a patent has been waived, withdrawn or dismissed, the application for a utility model registration or a patent shall, for the purpose of paragraphs (1) to (4), be deemed never to have been filed.

(5) Where the examiner's decision or trial decision to the effect that a patent application is to be refused has become final and binding, the patent application shall, for the purpose of paragraph (3), be deemed never to have been filed; provided, however, that this shall not apply to the case where the examiner's decision or trial decision to the effect that the patent application is to be refused has become final and binding on the basis that the latter sentence of Article 39(2) of the Patent Act is applicable to the said patent application.

(6) An application for a utility model registration or a patent filed by a person who is neither the creator nor inventor nor the successor in title to the right to obtain a utility model registration or a patent shall, for the purpose of application of paragraphs (1) to (3), be deemed to be neither an application for a utility model registration nor a patent application.

(7) Where no agreement is reached by consultations made under Article 39(4) of the Patent Act or such consultations are unable to be held, the applicant for a utility model registration shall not be entitled to obtain a utility model registration for the device claimed.

(Priority claim based on an application for a utility registration, etc.)

Article 8 (1) A person requesting the grant of a utility model registration may make a priority claim for a device claimed in the application for a utility model registration, based on a device disclosed in the description or scope of claims for a utility model registration or patent, or drawings (in the case where the earlier application was a written application in foreign language, the document in foreign language) originally attached to the application of an earlier application filed for a utility model registration or patent which the said person has the right to obtain (hereinafter an "Earlier Application"), except in the following cases:

(i) where the said application for a utility model registration is not filed within one year from the date of the filing of the Earlier Application;

(ii) where the Earlier Application is a new divisional application for a utility model registration extracted from an application for a utility model registration under Article 44(1) of the Patent Act as applied mutatis mutandis under Article 11(1), an application for a

- utility model registration converted from an application for a utility model registration under Article 10(1) or (2), or a new divisional patent application extracted from a patent application under Article 44(1) of the Patent Act, a patent application converted from a patent application under Article 46(1) or 46(2) of the Patent Act or a patent application based on a utility model registration under Article 46-2(1) of the Patent Act;
- (iii) where at the time of filing said application for a utility model registration, the Earlier Application had been waived, withdrawn or dismissed;
- (iv) where, at the time of filing said application for a utility model registration, the examiner's decision or the trial decision on the earlier application had become final and binding; and
- (v) where, at the time of filing said application for a utility model registration, the registration establishing a utility model right under Article 14(2) with respect to the Earlier Application had been effected.
- (2) Among devices claimed in an application for a utility model registration containing a priority claim under paragraph (1), for those that are disclosed in the description, scope of claims for a utility model registration or patent or drawings (in the case where the Earlier Application was a written application in foreign language prescribed in Article 36-2(2) of the Patent Act, the document in foreign language prescribed in paragraph (1) of the said Article) originally attached to the application of the Earlier Application on which the priority claim is based (in the case where the Earlier Application contains a priority claim under the preceding paragraph or Article 41(1) of the Patent Act, or Article 43(1) or 43-2(1) or (2) of the Patent Act (including their mutatis mutandis application under Article 11(1) of this Act), excluding any device disclosed in any documents (limited to those equivalent to the description, scope of claims for a utility model registration or patent or drawings) submitted at the time of the filing of the application on which the priority claim in the Earlier Application is based), the said application for a utility model registration shall be deemed to have been filed at the time when the Earlier Application was filed, in the case of the application of Article 3, the main clause of Article 3-2, Article 7(1) to (3), Article 30(1) to (3) of the Patent Act as applied mutatis mutandis under Article 11(1), Article 17, Articles 69(2)(ii), 72, 79, 81, 82(1) of the Patent Act as applied mutatis mutandis under Article 26, Articles 39(3) and (4) and 72 of the Patent Act, Articles 26, 31(2) and 32(2) of the Design Act (Act No. 125 of 1959), Article 29 of the Trademark Act (Act No. 127 of 1959) and Articles 33-2(3) and 33-3(3) (including their mutatis mutandis application under Article 68(3) of the Trademark Act) of the Trademark Act.
- (3) Among devices disclosed in the description, scope of claims or drawings originally attached to the application in an application for a utility model registration containing a priority claim under paragraph (1), for those that are disclosed in the description, scope of claims for a utility model registration or patent or drawings (in the case where the Earlier Application was a written application in foreign language prescribed in Article 36-2(2) of the Patent Act, the document in foreign language prescribed in paragraph (1) of the said Article) originally attached to the application of the Earlier Application on which the priority claim is based (in the case where the Earlier Application contains a priority claim under the preceding paragraph

or Article 41(1) of the Patent Act, or Article 43(1) or 43-2(1) or (2) of the Patent Act (including their mutatis mutandis application under Article 11(1) of this Act), excluding any device disclosed in any documents (limited to those equivalent to the description, scope of claims for a utility model registration or patent or drawings) submitted at the time of the filing of the application on which the priority claim in the Earlier Application is based), the Utility Model Bulletin pertaining to the Earlier Application or the laying open of the Earlier Application shall be deemed to have been issued or effected at the time when the Utility Model Bulletin pertaining to the said application for a utility model registration was issued, and the main clause of Article 3-2 of the Utility Model Act or Article 29-2 of the Patent Act shall apply.

- (4) A person requesting to make a priority claim under paragraph (1) shall submit to the Commissioner of the Patent Office a document stating thereof and the indication of the Earlier Application along with the application for a utility model registration.

(Withdrawal, etc. of Earlier Application)

Article 9 (1) An Earlier Application on which a priority claim is based under Article 8(1) shall be deemed to have been withdrawn when one year and three months has lapsed from the filing date of said Earlier Application; provided, however, that this shall not apply to the case where an Earlier Application has been waived, withdrawn or dismissed, where the examiner's decision or trial decision on an Earlier Application has become final and binding, where the registration establishing a Utility Model Right under Article 14(2) with respect to an Earlier Application has been effected or where all priority claims based on an Earlier Application have been withdrawn.

- (2) The applicant of an application for a utility model registration containing a priority claim under Article 8(1) may not withdraw the priority claim after a period of one year and three months has passed from the filing date of an Earlier Application.
- (3) Where the application for a utility model registration containing a priority claim under Article 8(1) is withdrawn within one year and three months from the filing date of an Earlier Application, the said priority claim shall be deemed withdrawn simultaneously.

(Conversion of application)

Article 10 (1) An applicant for a patent may convert his/her application (excluding patent applications filed based on a utility model registration under Article 46-2(1) of the Patent Act (including patent applications deemed to have been filed at the time of filing of the original patent application under Article 44(2) of the said Act (including its mutatis mutandis application under Article 46(5) of the said Act))) into an application for a utility model registration; provided, however, that this shall not apply after the expiration of 30 days from the date the certified copy of the examiner's initial decision to the effect that the patent application is to be refused has been served or after the expiration of nine years and six months from the date of filing of the patent application.

- (2) An applicant for a design registration may convert his/her application (excluding

- applications for a design registration deemed, under Article 10-2(2) of the Design Act as applied mutatis mutandis under Article 13(5) of the Design Act, to have been filed at the time of the original patent application which was filed based on an application for a utility model registration under Article 46-2(1) of the Patent Act (including applications for a design registration deemed to have been filed at the time of filing of the original application for a design registration under Article 10-2(2) of the Design Act)) into an application for a utility model registration; provided, however, that this shall not apply after the expiration of 30 days from the date the certified copy of the examiner's initial decision to the effect that the application for a design registration is to be refused has been served or after the expiration of nine years and six months from the date of filing of the application for a design registration.
- (3) Where an application is converted under the preceding two paragraphs, the application for a utility model registration shall be deemed to have been filed at the time of filing of the patent application or the application for a design registration; provided, however, that this shall not apply for the purposes of application of Article 3-2 of this Act or Article 29-2 of the Patent Act where the application for a utility model registration falls under another application for a utility model registration prescribed in Article 3-2 of this Act or an application for a utility model registration prescribed in Article 29-2 of the Patent Act, and Articles 30(4) and 43 (1) of the Patent Act (including mutatis mutandis application of Article 43(1) of the said Act under Article 43-2(3) of the said Act as applied mutatis mutandis under the Article 11(1)).
- (4) Where an application is converted under paragraph (1) or (2), for the purpose of application of Article 43(2) of the Patent Act as applied mutatis mutandis under Article 11(1) (including its mutatis mutandis application under Article 43-2(3) of the Patent Act as applied mutatis mutandis under Article 11(1)), "within one year and four months from the earliest of the following dates" in Article 43(2) shall read "within one year and four months from the earliest of the following dates or three months from the date of filing of the application of a utility model registration arising from the conversion of an application under Article 10(1) or (2) of the Utility Model Act, whichever is later."
- (5) Where an application is converted under paragraph (1) or (2), the patent application or the application for design registration shall be deemed to have been withdrawn.
- (6) Where the period as provided in Article 121(1) of the Patent Act is extended under Article 4 of the said Act, the 30-day period as provided in the proviso to paragraph (1) shall be deemed to have been extended only for that period as extended.
- (7) Where the period as provided in Article 46(1) of the Design Act is extended under Article 4 of the Patent Act as applied mutatis mutandis under Article 68(1) of the Design Act, the 30-day period as provided in the proviso to paragraph (2) shall be deemed to have been extended only for that period as extended.
- (8) Where a conversion of an application is made under paragraph (1), any statements or documents which have been submitted in relation to the original patent application and are required to be submitted in relation to the new application for a utility model registration under Article 8(4) of this Act or Article 30(4) or 43(1) and (2) of the Patent Act as applied mutatis mutandis under Article 11(1) (including mutatis mutandis application of Article 43(1)

and (2) of the Patent Act under Article 43-2(3) of the said Act as applied mutatis mutandis under the next Article (1)) shall be deemed to have been submitted to the Commissioner of the Patent Office along with the new application for a utility model application.

(9) The preceding paragraph shall apply mutatis mutandis to a conversion of an application under paragraph (2).

(Application mutatis mutandis of provisions of the Patent Act)

Article 11 (1) Articles 30 (exception to lack of novelty of invention), 38 (joint applications), 43 to 44 (procedures for a priority claim under the Paris Convention and division of patent applications) of the Patent Act shall apply mutatis mutandis to applications for a utility model registration.

(2) Article 33 and 34(1), (2) and (4) to (7) (right to obtain patent) of the Patent Act shall apply mutatis mutandis to the right to obtain a utility model registration.

(3) Article 35 (Inventions by Employees) of the Patent Act shall apply mutatis mutandis to devices created by employees, officers of the juridical person, or national or local government employees.

Chapter III Utility Model Technical Opinion

(Request for Utility Model Technical Opinion)

Article 12 (1) With regard to an application for a utility model registration or a utility model registration, any person may file with the Commissioner of the Patent Office a petition requesting a technical opinion as to the registrability of the device claimed in the application or of the registered utility model in the light of the provisions of Article 3(1)(iii) and (2) (limited to its application based on a device falling under Article 3(1)(iii)), Article 3-2, and Article 7(1) to (3) and (7)(such opinion is hereinafter referred to as "Utility Model Technical Opinion"). Similarly, in respect of applications or registered utility models that contain two or more claims, such a petition may be filed for each claim.

(2) A petition under the preceding paragraph may be filed even after the lapse of the utility model right; provided, however, that this shall not apply after the utility model right has been invalidated in a trial for invalidation of utility model registration.

(3) Notwithstanding the preceding two paragraphs, a petition under paragraph (1) shall not be allowed after a patent application based on the utility model registration is filed under Article 46-2(1) of the Patent Act.

(4) Where a petition under paragraph (1) is filed, the Commissioner of the Patent Office shall direct an examiner to prepare a written report containing a Utility Model Technical Opinion (hereinafter referred to as "Report of Utility Model Technical Opinion").

(5) Article 47(2) of the Patent Act shall apply mutatis mutandis to preparation of Reports of Utility Model Technical Opinion.

(6) A petition under paragraph (1) may not be withdrawn.

(7) Where a petition under paragraph (1) was filed by a person who is neither the applicant of

the application for a utility model registration nor the holder of utility model right, and then, a patent application under Article 46-2(1) of the Patent Act is filed based on the utility model registration with regard to which the petition under paragraph (1) was filed (including the utility model registration which has been granted based on the application for a utility model registration with regard to which the petition under paragraph (1) was filed), the petition shall be deemed not to have been filed. In this case, the Commissioner of the Patent Office shall notify thereof to the person who filed the petition.

Article 13 (1) Where a petition requesting a Utility Model Technical Opinion is filed, in the case where such a petition is filed prior to issuance of the Utility Model Bulletin, the Commissioner of the Patent Office shall publish the fact thereof in a utility model bulletin either at the time of issuance of the said Utility Model Bulletin or thereafter without delay, and in the case where such a petition is filed after issuance of the Utility Model Bulletin, without delay after issuance of the Utility Model Bulletin.

(2) Where a petition requesting a Utility Model Technical Opinion is filed by a person who is neither the applicant of the application for a utility model registration nor the holder of utility model right, the Commissioner of the Patent Office shall notify the applicant of the application for a utility model registration or the holder of utility model right thereof.

(3) Where a Report of Utility Model Technical Opinion is prepared, the Commissioner of the Patent Office shall serve its certified copy, in the case where the person who filed the petition is either the applicant of the application for a utility model registration or the holder of utility model right, to the person, and in the case where the person who filed the petition is neither the applicant of the application for a utility model registration nor the holder of utility model right, to the person and the applicant or the holder.

Chapter IV Utility Model Rights

Section 1 Utility Model Rights

(Registration of establishment of a utility model right)

Article 14 (1) A utility model right shall become effective upon registration of its establishment.

(2) When an application for a utility model registration has been filed, the establishment of a utility model right shall be registered, unless the application has been waived, withdrawn or dismissed.

(3) Where the registration under the preceding paragraph has been effected, the following matters shall be published in a utility model bulletin.

(i) the name, and the domicile or residence of the holder(s) of utility model right;

(ii) the number and the filing date of the application for utility model registration;

(iii) the name, and the domicile or residence of the creator(s) of the device;

(iv) the matters stated in the description and scope of claims attached to the application and the contents of the drawings attached to said application;

(v) the matters stated in the abstract attached to the application;

- (vi) the registration number and the date of registration of establishment; and
 - (vii) other necessary matters.
- (4) Article 64(3) of the Patent Act shall apply mutatis mutandis where the matters stated in the abstract as provided in item (v) of the preceding paragraph are published in the utility model gazette under the preceding paragraph.

(Correction of description, claim or drawing attached to the application)

Article 14-2 (1) Except for the following cases, a holder of utility model right may correct the description, scope of claims, or drawings attached to the application only once.

- (i) where two months have lapsed from the date when the first Report of Utility Model Technical Opinion was served; and
 - (ii) where the time limit initially designated under Article 39(1) for a trial for invalidation of utility model registration has expired.
- (2) The correction under the preceding paragraph shall be limited to those for the following purposes:
- (i) restriction of the scope of claims;
 - (ii) correction of errors; and
 - (iii) clarification of an ambiguous statement.
- (3) Any correction under paragraph (1) shall be made within the scope of the matters described in the description, scope of claims or drawings attached to the application (in the case of correction for the purpose of item (ii) of the preceding paragraph, the description, scope of claims or drawings originally attached to the application).
- (4) The correction under paragraph (1) shall not substantially enlarge or alter the scope of claims.
- (5) Article 4 of the Patent Act shall apply mutatis mutandis to the period prescribed in paragraph (1)(i).
- (6) Notwithstanding item (i) of paragraph (1), where, due to reasons beyond the control of the person who requests a correction under paragraph (1), the person is unable to request the correction within the time limit as provided in the said item, the person may request the correction within 14 days (where overseas resident, within two months) from the date on which the reasons ceased to exist, but not later than six months following the expiration of the said time limit.
- (7) In addition to the corrections allowed under paragraph (1), a holder of utility model right may correct the description, scope of claims, or drawings attached to the application as far as such correction is for the purpose of deletion of a claim or claims; provided, however, that where a trial for invalidation of the utility model registration is pending at the Patent Office, the description, scope of claims, or drawings attached to the application may not be corrected after notice is given under Article 156(1) of the Patent Act applied mutatis mutandis pursuant to Article 41 (in the case where the proceedings have been reopened under Article 156(2) of the Patent Act, after further notice is given under Article 156(1) of the Patent Act).
- (8) A correction under paragraph (1) or the preceding paragraph may be made even after the

lapse of the utility model right; provided, however, that this shall not apply after the utility model registration has been invalidated in a trial for invalidation of the utility model registration.

- (9) For any correction under paragraph (1) or paragraph (7), a statement of correction shall be submitted in writing.
- (10) For any correction under paragraph (1), the corrected description, scope of claims or drawings shall be attached to the statement of correction.
- (11) Where a correction has been made under paragraph (1) or paragraph (7), the filing of the application for the utility model registration and the registration of the establishment of the utility model right shall be deemed to have been made based on the corrected description, scope of claims or drawings.
- (12) Where a correction has been made under paragraph (1) or paragraph (7), the matters stated in the corrected description and scope of claims and the contents of the corrected drawings shall be published in the utility model bulletin in the case of correction under paragraph (1), and the fact thereof shall be published in the utility model bulletin in the case of correction under paragraph (7).
- (13) Articles 127 and 132(3) of the Patent Act shall apply mutatis mutandis to the case of paragraph (1) and (7).

(Order to amend relating to correction)

Article 14-3 Where matters stated in the corrected description, scope of claims or drawings attached to a statement of correction (limited to correction under paragraph (1) of the preceding Article) fall under any of the following, the Commissioner of the Patent Office may order the amendment of the corrected description, scope of claims or drawings attached to the statement of correction, designating an adequate time limit:

- (i) where the device identified by the matters stated in the corrected scope of claims attached to the statement of correction is not pertaining to the shape or structure of an article or combination of articles;
- (ii) where the device identified by the matters stated in the corrected scope of claims attached to the statement of correction is not registrable under Article 4;
- (iii) where the matters stated in the corrected description, scope of claims or drawings attached to the statement of correction do not satisfy the requirement prescribed in Article 5(6)(iv) or Article 6; or
- (iv) where the corrected description, scope of claims or drawings attached to the statement of correction does not state all the necessary matters or is extremely unclear.

(Duration of utility model rights)

Article 15 The duration of a utility model right shall expire after a period of ten years from the filing date of the application for utility model registration.

(Effect of utility model right)

Article 16 A holder of utility model right shall have the exclusive right to work the registered utility model as a business; provided, however, that where an exclusive license regarding the utility model right is granted to a licensee, this shall not apply to the extent that the exclusive licensee is licensed to exclusively work the registered utility model.

(Relationship with registered utility model, etc. held by others)

Article 17 Where a registered utility model uses another person's registered utility model, patented invention, or registered design or design similar thereto for which an application was filed prior to the date of filing of the application for the utility model registration, or where the utility model right is in conflict with another person's design right or trademark right obtained based on an application filed prior to the date of filing of the application for the utility model registration, the holder of utility model right, exclusive licensee or non-exclusive licensees may not work the registered utility model as a business.

(Exclusive license)

Article 18 (1) A holder of utility model right may grant an exclusive license to the utility model right.

(2) An exclusive licensee shall have an exclusive right to work the registered utility model as a business to the extent permitted by the contract granting the license.

(3) Articles 77(3) to (5) (transfer, etc.), 97(2) (waiver), 98(1)(ii) and (2) (effect of registration) of the Patent Act shall apply mutatis mutandis to exclusive licenses.

(Non-exclusive license)

Article 19 (1) A holder of utility model right may grant a non-exclusive license on the utility model to any third party.

(2) A non-exclusive licensee shall have a right to work the registered utility model as a business to the extent prescribed by this Act or permitted by the contract granting the license.

(3) Articles 73(1) (joint ownership), 97(3) (waiver), 99 (effect of registration) of the Patent Act shall apply mutatis mutandis to non-exclusive licenses.

(Non-exclusive license due to the working of the registered utility model prior to the registration of the request for a trial for patent invalidation)

Article 20 (1) A person falling under any of the following items, who is doing a business working an invention in Japan or preparing such business, before the registration of a request for a trial for patent invalidation under Article 123(1) of the Patent Act (simply referred to in this paragraph as the "Trial for Patent Invalidity"), without knowledge that the patent falls under any of the items of Article 123(1) of the Patent Act, shall, after the invalidation of the patent, have a non-exclusive license to the utility model right or the exclusive license existing at the time of the invalidation of the patent, but only to the extent of the invention and the purpose of such business worked or prepared:

(i) the original patentee in the case where a device to which a utility model registration has

been granted and his/her patented invention are identical and his/her patent has been invalidated;

(ii) the original patentee in the case where, after his/her patent has been invalidated, a utility model registration is granted to the person who is entitled to obtain a utility model registration for a device which is identical to his/her invention; and

(iii) in the case referred to in items (i) and (ii), a person that, at the time of the registration of the request for a Trial for Patent Invalidation, had an exclusive license to the patent right to be invalidated, or a non-exclusive license effective under Article 99(1) of the Patent Act to the patent right or an exclusive license on the patent right.

(2) The holder of a utility model right or an exclusive licensee shall have the right to receive reasonable consideration from the non-exclusive licensee under the preceding paragraph.

(Award granting non-exclusive license where a registered utility model is not worked)

Article 21 (1) Where a registered utility model is not sufficiently and continuously worked for three years or longer in Japan, a person intending to work the registered utility model may request the holder of utility model right or the exclusive licensee to hold consultations to discuss granting a non-exclusive license thereon; provided, however, that this shall not apply unless four years have lapsed from the filing date of the application based on which the utility model registration has been granted.

(2) Where no agreement is reached by consultations or no consultations are able to be held as provided in the preceding paragraph, the person intending to work the registered utility model may request the Commissioner of the Patent Office for an award.

(3) Articles 84 to 91-2 (procedures, etc. for award) of the Patent Act shall apply mutatis mutandis to an award under the preceding paragraph.

(Award granting non-exclusive license to work own registered utility model)

Article 22 (1) Where a registered utility model falls under any of the cases as provided in Article 17, the holder of utility model right or exclusive licensee may request the other person under the said Article to hold consultations to discuss granting a non-exclusive license to work the registered utility model or a non-exclusive license on the patent right or the design right.

(2) The other person under Article 17 who is requested to hold consultations under the preceding paragraph may request the holder of utility model right or exclusive licensee requesting such consultations to hold consultations to discuss granting a non-exclusive license to the extent of the registered utility model that the said holder or exclusive licensee intends to work with a non-exclusive license on the utility model right, on the patent right or on the design right granted through consultations.

(3) Where no agreement is reached by consultations or no consultations are able to be held as provided in paragraph (1), the holder of utility model right or the exclusive licensee may request the Commissioner of the Patent Office for an award.

(4) Where no agreement is reached by consultations or no consultations are able to be held as provided in paragraph (2) and where a request for an award is filed under the preceding

paragraph, the other person under Article 17 may request the Commissioner of the Patent Office for an award only within the time limit for the submission of a written answer by said other person designated by the Commissioner of the Patent Office under Article 84 of the Patent Act as applied *mutatis mutandis* pursuant to paragraph (7).

- (5) In the case of paragraph (3) or (4), the Commissioner of the Patent Office shall not render an award to the effect that a non-exclusive license is to be granted where the granting of the non-exclusive license will be unreasonably prejudicial to the interests of the other person under Article 17, the holder of utility model right or the exclusive licensee.
- (6) In the case of paragraph (4), in addition to the case provided for in the preceding paragraph, the Commissioner of the Patent Office shall not render an award ordering a non-exclusive license to be granted if an award ordering a non-exclusive license to be granted is not rendered with respect to the request for an award under paragraph (3).
- (7) Articles 84, 85(1) and 86 through 91-2 (procedures, etc. for award) of the Patent Act shall apply *mutatis mutandis* to the award under paragraph (3) or (4).

(Award granting non-exclusive license for public interest)

Article 23 (1) Where the working of a registered utility model is particularly necessary for the public interest, a person(s) intending to work the registered utility model may request the holder of utility model right or the exclusive licensee to hold consultations to discuss granting a non-exclusive license.

- (2) Where no agreement is reached by consultations or no consultations are able to be held as provided in the preceding paragraph, the person intending to work the registered utility model may request the Minister of Economy, Trade and Industry for an award.
- (3) Articles 84, 85(1) and 86 through 91-2 (procedures, etc. for award) of the Patent Act shall apply *mutatis mutandis* to the award under the preceding paragraph.

(Transfer, etc. of non-exclusive license)

Article 24 (1) Except for a non-exclusive license granted by an award under Article 21(2), 22(3) or (4), or 23(2), Article 92(3) of the Patent Act or Article 33(3) of the Design Act, a non-exclusive license may be transferred only where the business involving the working of the relevant registered utility model is also transferred, where the consent of the holder of utility model right (or, in the case of non-exclusive license on the exclusive license, the holder of utility model right and the exclusive licensee) is obtained or where the transfer occurs as a result of general succession including inheritance.

- (2) Except for a non-exclusive license granted by an award under Article 21(2), 22(3) or (4), or 23(2), Article 92(3) of the Patent Act or Article 33(3) of the Design Act, a non-exclusive licensee may establish a right of pledge on the non-exclusive right only where the consent of the holder of utility model right (or, in the case of non-exclusive license on the exclusive license, the holder of utility model right and the exclusive licensee) is obtained.
- (3) A non-exclusive license granted by an award under Article 21(2) or 23(2) may be transferred only where the business involved in the working of the relevant registered utility model is also

transferred.

- (4) Where a non-exclusive license is granted by an award under Article 22(3) of this Act, Article 92(3) of the Patent Act, or Article 33(3) of the Design Act, said non-exclusive license shall be transferred together with the utility model right, patent right or design right of the non-exclusive licensee on which the non-exclusive license is granted where business involved in the working the relevant registered utility model is also transferred, but shall be extinguished in the case where such right of the said non-exclusive licensee is extinguished or transferred independently of the said business.
- (5) A non-exclusive license granted by an award under Article 22(4) shall be transferred together with the utility model right, patent right or design right of the non-exclusive licensee on which the non-exclusive license is granted, but shall be extinguished in cases where said utility model right, patent right or design right is extinguished.

(Right of pledge)

- Article 25 (1) Unless otherwise agreed upon by contract, where a right of pledge is established on a utility model right, exclusive license or non-exclusive license, the pledgee may not work the registered utility model.
- (2) Article 96 (extension of a right of pledge to the proceeds of the patent right, etc.) of the Patent Act shall apply mutatis mutandis to a right of pledge established on a utility model right, exclusive license or non-exclusive license.
- (3) Article 98(1)(iii) and (2) (effect of registration) of the Patent Act shall apply mutatis mutandis to a right of pledge established on a utility model right or exclusive license.
- (4) Article 99(3) (effect of registration) of the Patent Act shall apply mutatis mutandis to a right of pledge established on a non-exclusive license.

(Mutatis mutandis application of Patent Act)

Article 26 Articles 69(1) and (2) and 70 to 71-2 (limitations of patent right and technical scope of patented invention), 73 (joint ownership), 76 (lapse of patent rights in absence of heir), 79 (non-exclusive license based on prior use), 81 and 82 (non-exclusive license after expiration of duration of design right), 97(1) (waiver), and 98(1)(i) and (ii) (effect of registration) shall apply mutatis mutandis to utility model rights.

Section 2 Infringement of rights

(Right to seek injunction)

- Article 27 (1) A holder of a utility model right or an exclusive licensee may demand a person who infringes or is likely to infringe said utility model right or exclusive license (hereinafter referred to as "Infringer, etc.") to stop or prevent such infringement.
- (2) In making a demand under the preceding paragraph, the holder of a utility model right or an exclusive licensee may demand measures necessary for the prevention of such infringement including the disposal of products constituting such act of infringement (including a Computer

Program, etc. (refers to a Computer Program, etc. as provided by Article 2(4) of the Patent Act, the same shall apply in the following Article), the same shall apply hereinafter) and the removal of facilities used for the act of infringement.

(Acts Deemed to constitute infringement)

Article 28 The following acts shall be deemed to constitute an infringement of a utility model right or an exclusive license:

- (i) acts of, as a business, producing, assigning, etc. (assigning and leasing and, in the case where the product is a Computer Program, etc., including providing through an electric telecommunication line, the same shall apply hereinafter), importing or offering for assignment, etc. (including displaying for the purpose of assignment, etc., the same shall apply hereinafter) any product to be used exclusively for making an article in which the registered utility model has been embodied;
- (ii) acts of producing, assigning, etc., importing or offering for assignment, etc. any product (excluding those widely distributed within Japan) to be used for making an article in which the registered utility model has been embodied and indispensable for the resolution of the problem by the device, as a business knowing that the said device is a registered utility model and the said product is used for the working of the device and;
- (iii) acts of possessing an article in which a registered utility model has been embodied for the purpose of assigning, leasing or exporting it.

(Presumption of Amount of Damage, etc.)

Article 29 (1) Where a holder of a utility model right or an exclusive licensee claims against an infringer compensation for damage sustained as a result of the intentional or negligent infringement of said utility model right or exclusive license, and the infringer assigned articles that constituted the act of infringement, the amount of damage sustained by the holder or the exclusive licensee may be presumed to be the amount of profit per unit of articles which would have been sold by the holder or the exclusive licensee if there had been no such act of infringement, multiplied by the quantity (hereinafter referred to in this paragraph as the "Assigned Quantity") of articles assigned by the infringer, the maximum of which shall be the amount attainable by the holder or the exclusive licensee in light of the capability of the holder or the exclusive licensee to work such articles; provided, however, that if any circumstances exist under which the holder or the exclusive licensee would have been unable to sell the Assigned Quantity in whole or in part, the amount calculated as the number of articles not able to be sold due to such circumstances shall be deducted.

(2) Where a holder of a utility model right or an exclusive licensee claims against an infringer compensation for damage sustained as a result of the intentional or negligent infringement of said utility model right or exclusive license, and the infringer earned profits from the act of infringement, the amount of profits earned by the infringer shall be presumed to be the amount of damage sustained by the holder of utility model right or exclusive licensee.

(3) A holder of a utility model right or an exclusive licensee may claim against an infringer

compensation for damage sustained as a result of the intentional or negligent infringement of the utility model right or exclusive license, by regarding the amount the holder of said utility model right or exclusive licensee would have been entitled to receive for the working of the registered utility model right as the amount of damage sustained.

- (4) The preceding paragraph shall not prevent any relevant party from claiming compensation for damage in an amount exceeding the amount provided for therein. In such a case, where the infringer committed the infringement of the utility model right or exclusive license without intent or gross negligence, the court may take these circumstances into consideration in determining the amount of damages.

(Presentation of Report of Utility Model Technical Opinion)

Article 29-2 A holder of a utility model right or an exclusive licensee may not exercise his/her utility model right or exclusive license against an Infringer, etc. unless he/she has given warning in the Report of Utility Model Technical Opinion regarding the registered utility model.

(Liability of holder of utility model right, etc.)

Article 29-3 (1) Where a trial decision to the effect that the utility model registration is to be invalidated (excluding those rendered on the ground of Article 37(1)(vi)) has become final and binding after the holder of utility model right or exclusive licensee exercised his/her right against, or gave warning thereof to, an Infringer, etc., the holder or exclusive licensee shall be held liable to compensate damage sustained by the Infringer, etc. as a result of the exercise of his/her right or the warning; provided, however, that this shall not apply where the holder or exclusive licensee exercised his/her right or gave warning thereof based on the Utility Model Technical Opinion stated in the Report of Utility Model Technical Opinion (excluding those to the effect that the device claimed in the application for a utility model registration or the registered utility model cannot be registered pursuant to the provision of Article 3(1)(iii) and (2) (limited to its application based on a device falling under Article 3(1)(iii)), Article 3-2, and Article 7(1) to (3) and (7)) or with other reasonable care.

- (2) The preceding paragraph shall apply mutatis mutandis to the case where the holder of utility model right or exclusive licensee exercised his/her right, or gave warning thereof, based on the device which has come to fall outside the scope of claims at the time of the registration of the establishment of the utility model right as a result of correction made to the description, scope of claims or drawing attached to the application in the application for a utility model registration under Article 14-2(1) or (7).

(Mutatis mutandis application of Patent Act)

Article 30 Articles 104-2 to 106 (obligation to clarify the specific conditions (of infringement), restriction on exercise of rights of patentee, etc., production of documents, etc., expert opinion for calculation of damages, determination of reasonable damages, protective order, rescission of protective order, notice, etc. of a request inspection of record, etc., ban on open

examination of parties, etc. and measures to restore credibility) of the Patent Act shall apply mutatis mutandis to infringement of a utility model right or exclusive license.

Section 3 Registration Fees

(Registration fees)

Article 31 (1) A person obtaining the registration establishing a utility model right or a holder of utility model right shall pay as registration fees the amount specified in the right-hand column of the following table, corresponding to the relevant period in the left-hand column, for each registered utility model and for each year from the date of the registration establishing the utility model right to the expiration of the duration as provided in Article 15:

| Period within term | Amount |
|-----------------------|--|
| First to third year | Annually 2,100 yen plus 100 yen per claim |
| Fourth to sixth year | Annually 6,100 yen plus 300 yen per claim |
| Seventh to tenth year | Annually 18,100 yen plus 900 yen per claim |

- (2) The preceding paragraph shall not apply to utility model rights belonging to the State.
- (3) Notwithstanding the provisions of paragraph (1), where a utility model right is jointly owned by persons including the State and/or a person entitled to receive a reduction of the registration fees or exemption therefrom under Article 109 or the provisions of any other laws or ordinances (hereinafter referred to as a "reduction/exemption" in this paragraph), and the portion of their respective shares of said utility model right has been agreed, the registration fees payable under paragraph (1) shall be determined as the sum of the amounts calculated for each person other than the State jointly owning the utility model right by multiplying the applicable registration fees as provided in paragraph (1) (in the case of a person receiving a reduction/exemption, the amount after said reduction/exemption) by the ratio of the share of each person other than the State jointly owning the utility model right, and, the persons other than the State shall pay such sum.
- (4) For the amount of registration fees calculated under the preceding paragraph, fractional figures of less than ten yen shall be discarded.
- (5) The payment of registration fees under paragraph (1) shall be made by patent revenue stamps as provided by an Ordinance of the Ministry of Economy, Trade and Industry; provided, however, that where so provided by an Ordinance of the Ministry of Economy, Trade and Industry, a cash payment thereof shall be accepted.

(Time limit for payment of registration fees)

Article 32 (1) The registration fees for each year from the first to the third year under Article 31(1) shall be paid in a lump sum at the time of filing of the application for a utility model registration (or, in the case where conversion of application under Article 10(1) or (2) or division of application under Article 44(1) of the Patent Act as applied mutatis mutandis

pursuant to Article 11(1) has been made, at the time of conversion or division of the application).

- (2) The registration fees for each year from the fourth year and subsequent years under Article 31(1) shall be paid by the end of the previous year.
- (3) The Commissioner of the Patent Office may, upon a request by a person by whom the registration fees are to be paid, extend the time limit under paragraph (1) by a period not exceeding 30 days.

(Reduction, exemption or deferment of registration fees)

Article 32-2 Where the person to pay the registration fees for each year from the first to the third year under Article 31(1) is the creator of the device claimed in the application for a utility model registration or his/her heir, if the Commissioner of the Patent Office recognizes that the person has difficulties paying the registration fees due to insufficient funds, the Commissioner of the Patent Office may, pursuant to the provisions of the Cabinet Order, grant the person a reduction of, exemption from or deferment of the payment of the registration fees.

(Late payment of registration fees)

- Article 33 (1) Where a holder of utility model right is unable to pay the registration fees within the time limit under Article 32(2) or the time limit for deferred payment under Article 32-2, he/she may make a late payment of the registration fees after the expiration of the said time limit, but not later than six months following the expiration of the said time limit.
- (2) The holder of utility model right who makes a late payment of the registration fees under the preceding paragraph shall pay, in addition to the registration fees to be paid under Article 31(1), a registration surcharge in the same amount as the registration fees.
 - (3) The payment of the registration surcharge under the preceding paragraph shall be made by patent revenue stamps as provided by an Ordinance of the Ministry of Economy, Trade and Industry; provided, however, that where so provided by an Ordinance of the Ministry of Economy, Trade and Industry, a cash payment thereof shall be accepted.
 - (4) Where a holder of utility model right fails to pay, within the time limit for late payment of the registration fees under paragraph (1), the registration fees for each year from the fourth and subsequent years under Article 31(1) and the registration surcharge under paragraph (2), the utility model right shall be deemed to have been extinguished retroactively upon expiration of the time limit as provided in Article 32(2).
 - (5) Where a holder of utility model right fails to pay, within the time limit for late payment of the registration fees under paragraph (1), the registration fees for which the deferment was granted under Article 32-2 and the registration surcharge under paragraph (2), the utility model right shall be deemed never to have existed.

(Restoration of utility model right by late payment of registration fees)

Article 33-2 (1) Where the original holder of a utility model right which was deemed to have been extinguished under Article 33(4), or which was deemed never to have existed under

Article 33(5), was unable to pay the registration fees and the registration surcharge under Article 33(4) or (5) within the time limit for late payment of the registration fees under Article 33(1), due to reasons not attributable to him/her, he/she may make a late payment of the registration fees and the surcharge within 14 days (in the case of an overseas resident, within two months) from the date on which the reasons ceased to exist, but not later than six months following the expiration of the said time limit.

- (2) Where the registration fees and the surcharge are paid under the preceding paragraph, the utility model right shall be deemed to have been maintained retroactively from the time of expiration of the time limit as provided in Article 32(2) or to have existed from the beginning.

(Restriction on effect of restored utility model right)

Article 33-3 (1) Where a utility model right has been restored under paragraph (2) of the preceding Article, the utility model right shall not be effective against the article which was imported into, made or acquired within Japan after the lapse of the time limit during which the late payment of the registration fees is allowed under Article 33(1) but before the registration of the restoration of the utility model right.

- (2) A restored utility model right under paragraph (2) of the preceding Article shall not be effective against the following acts conducted after the lapse of the time limit during which the late payment of the registration fees is allowed under Article 33(1) but before the registration of the restoration of the utility model right:

- (i) acts of working of said device;
- (ii) acts of producing, assigning, etc., importing or offering for assignment, etc. any product to be used for making the article in which the registered utility model has been embodied; and
- (iii) acts of possessing an article in which the registered utility model has been embodied for the purpose of assigning, leasing or exporting it.

(Refund of registration fees)

Article 34 (1) The following registration fees shall be refunded upon the request of the person that paid them:

- (i) registration fees paid in error or in excess;
- (ii) registration fees in the case where the disposition to the effect that the application for a utility model registration is to be dismissed has become final and binding;
- (iii) registration fees for each year following the year in which a trial decision to the effect that the utility model registration is to be invalidated has become final and binding; and
- (iv) registration fees for each year following the year in which the duration of the utility model right would have expired.

- (2) A request for refund of registration fees under the preceding paragraph may not be filed after one year from the date of payment in the case of registration fees under item (i) above, after six months from the date on which the disposition or the trial decision became final and binding in the case of registration fees under items (ii) and (iii) above, or after one year from the date on which the establishment of the utility model right is registered in the case of

registration fees under items (iv) above.

Article 35 Deleted

(Mutatis mutandis application of Patent Act)

Article 36 Article 110 (payment of patent fees by interested persons) shall apply mutatis mutandis to registration fees.

Chapter V Trial

(Trial for invalidation of utility model registration)

Article 37 (1) Where a utility model registration falls under any of the following items, a request for a trial for invalidation of utility model registration may be filed. In the event of two or more claims, a request for a trial for invalidation of utility model registration may be filed for each claim.

- (i) where the utility model registration has been granted on an application for a utility model registration with an amendment that does not comply with the requirements as provided in Article 2-2(2);
 - (ii) where the utility model registration has been granted in violation of Article 25 of the Patent Act as applied mutatis mutandis pursuant to Article 2-5(3) of this Act, Article 3, Article 3-2, Article 4, Article 7(1) to (3) or Article 7(7) of this Act, or Article 38 of the Patent Act as applied mutatis mutandis pursuant to Article 11(1) of this Act;
 - (iii) where the utility model registration has been granted in violation of a treaty;
 - (iv) where the utility model registration has been granted on an application for a utility model registration not complying with the requirements as provided in Article 5(4) or (6)(excluding item (iv));
 - (v) where the utility model registration has been granted on an application for a utility model registration filed by a person who is not the creator of the device and has not succeeded to the right to obtain a utility model registration for the said device;
 - (vi) where, after the grant of a utility model registration, the holder of utility model right has become unable to hold a utility model right under Article 25 of the Patent Act as applied mutatis mutandis pursuant to Article 2-5(3), or the utility model registration has become in violation of a treaty; and
 - (vii) where the correction of the description, scope of claims or drawings attached to the application for the utility model registration has been obtained in violation of Article 14-2(2) to (4).
- (2) Any person may file a request for a trial for invalidation of utility model registration; provided, however, that where a request for a trial for invalidation of utility model registration is filed on the grounds that the utility model registration falls under item (ii) of the preceding paragraph (limited to cases where the utility model registration is obtained in violation of Article 38 of the Patent Act as applied mutatis mutandis pursuant to Article 11(1)) or item (v)

of the preceding paragraph, only an interested person may file a request for a trial for invalidation of utility model registration.

- (3) A request for a trial for invalidation of utility model registration may be filed even after the lapse of the utility model right.
- (4) Where a request for a trial for invalidation of utility model registration has been filed, the chief trial examiner shall notify the exclusive licensee of the utility model right and other persons who have any registered rights relating to the utility model.

(Formal requirements of request for trial)

Article 38 (1) A person filing a request for a trial shall submit a written request stating the following to the Commissioner of the Patent Office:

- (i) the name, and the domicile or residence of the party and the representative thereof;
- (ii) the identification of the trial case; and
- (iii) the gist and grounds of the request.

- (2) In the grounds for the request provided in item (iii) of the preceding paragraph, the facts on which the invalidation of the utility model registration is based shall be specified in concrete terms, and the relationship of each fact that is required to be proven with the relevant evidence shall be stated.

(Amendment of request for trial)

Article 38-2 (1) An amendment of the written request filed under paragraph (1) of the preceding Article shall not change the gist thereof; provided, however, that this shall not apply in the event that approval is granted by the chief trial examiner under the following paragraph.

- (2) Where an amendment of the grounds for the request provided in Article 38(1)(iii) changes the gist thereof, the chief trial examiner may make a ruling approving such amendment if he/she recognizes that there is no possibility of unreasonable delay of the proceedings by such amendment and any of the following facts exists:
 - (i) correction made under Article 14-2(1) has given rise to a need for amendment of the grounds for the request; and
 - (ii) other than the case as provided in the preceding item, there exist reasonable grounds for not stating the grounds for the request with regard to the amendment of the request at the time the request for a trial was filed, and the respondent has agreed to such amendment.
- (3) The approval of the amendment as provided in the preceding paragraph may not be granted if the written amendment of procedures with regard to the said amendment is submitted prior to the service of a copy of the written request under Article 39(1).
- (4) No appeal shall be available from a ruling under paragraph (2).

(Submission of a written answer, etc.)

Article 39 (1) Where a request for a trial has been filed, the chief trial examiner shall serve a copy of the written request to the respondent and give the respondent an opportunity to submit a written answer, designating an adequate time limit.

- (2) When the chief trial examiner approves an amendment of the written request under Article 38-2(2), the chief trial examiner shall serve a copy of the written amendment of procedures with regard to such amendment to the respondent, and shall give the respondent an opportunity to submit a written answer, designating an adequate time limit; provided, however, that this shall not apply where special circumstances exist under which it is recognized that giving an opportunity to the respondent to submit a written answer is not required.
- (3) Upon receipt of a written answer under paragraph (1) or the main clause of the preceding paragraph, or where a correction under Article 14-2(1) or (7) has been made while a trial for invalidation of utility model registration is pending at the Patent Office, the chief trial examiner shall serve to the demandant a copy of them.
- (4) The chief trial examiner may question the parties and the intervenors with regard to the trial.
- (5) Where after a request for a trial for invalidation of the utility model registration has been filed, a patent application under Article 46-2(1) of the Patent Act is filed based on the utility model registration, the chief trial examiner shall notify the parties and the intervenors thereof.

(Withdrawal of request for trial)

Article 39-2 (1) A request for a trial may be withdrawn before a trial decision becomes final and binding.

- (2) A request for a trial may not be withdrawn without the consent of the adverse party, after the written answer under Article 39(1) has been submitted.
- (3) Where the demandant for a trial has received the notice under Article 39(5), notwithstanding the preceding paragraph, he/she may withdraw the request for a trial within 30 days from the day on which he/she received the notice.
- (4) Article 4 of the Patent Act shall apply mutatis mutandis to the time limits provided in the preceding paragraph. In this case, the term "The Commissioner of the Patent Office" in the said Article shall be deemed to be replaced with "The chief trial examiner."
- (5) Where, due to reasons beyond his/her control, the demandant for a trial is unable to withdraw the request for a trial within the time limit provided in paragraph (3), he/she may, notwithstanding the said paragraph, file the request within 14 days (in the case of overseas resident, within two months) from the date on which the reasons ceased to exist, but not later than six months following the expiration of the said time limit.
- (6) When a request for a trial for invalidation of utility model registration has been filed with regard to two or more claims covered by a utility model registration that has two or more claims, the request may be withdrawn for any of the claims.

(Relationship with litigation)

Article 40 (1) Where deemed necessary during a trial, the trial proceedings may be suspended until the decision in another trial has become final and binding or court proceedings have been concluded.

- (2) Where an action is instituted or a motion for order of provisional seizure or order of provisional disposition is filed, the court may, if it considers it necessary, suspend the court

proceedings until the trial decision becomes final and binding.

- (3) Where an action with respect to infringement of a utility model right or an exclusive license is instituted, the court shall notify the Commissioner of the Patent Office thereof. The same shall apply when the said court proceedings have been concluded.
- (4) Where the Commissioner of the Patent Office receives the notice as provided in the preceding paragraph, the Commissioner of the Patent Office shall notify the court of whether a request for a trial with regard to the said utility model right has been filed. The same shall apply when, with regard to the said trial, a ruling dismissing the written request or a trial decision has been rendered or the request has been withdrawn.
- (5) Where the court receives the notice to the effect that a request for a trial with regard to a utility model right has been filed under the preceding paragraph, if a document stating a method of allegation or defense as provided in Article 104-3(1) of the Patent Act as applied mutatis mutandis pursuant to Article 30 has already been submitted in the court proceedings prior to the said notice, or if the said document is submitted for the first time after the said notice, the court shall notify the Commissioner of the Patent Office thereof.
- (6) Where the Commissioner of the Patent Office receives the notice as provided in the preceding paragraph, the Commissioner of the Patent Office may request the court to deliver copies of any record of the court proceedings which the trial examiner considers necessary for the trial.

(Mutatis mutandis application of Patent Act)

Article 41 Articles 125, 132 to 133-2, 135 to 154, 156, 157, 167, 169(1), (2), (5) and(6), and 170 of the Patent Act shall apply mutatis mutandis to trials.

Chapter VI Retrial and Litigation

(Request for retrial)

Article 42 (1) A party or an intervenor may file a request for a retrial against a final and binding trial decision.

(2) Articles 338 (1) and (2) and 339 (grounds for retrial) of the Code of Civil Procedure shall apply mutatis mutandis to a request for a retrial under the preceding paragraph.

Article 43 (1) Where a demandant for a trial, in conspiracy with the respondent, has caused the trial decision to be rendered for the purpose of harming the right or interest of a third party, the third party may file a request for a retrial against the final and binding trial decision.

(2) A request for a retrial under the preceding paragraph shall be filed against the demandant and the respondent in the trial as joint respondent.

(Restriction on effect of utility model right restored by retrial)

Article 44 (1) Where a utility model right pertaining to an invalidated utility model registration has been restored by a retrial, such utility model right shall not be effective against any

articles imported into, made or acquired in Japan in good faith, after the trial decision became final and binding but before the registration of the request for a retrial.

- (2) Where a utility model right pertaining to an invalidated utility model registration has been restored by a retrial, such utility model right shall not be effective against the following acts conducted after the trial decision became final and binding but before the registration of the request for a retrial:
- (i) the act of working the device in good faith;
 - (ii) the act of producing, assigning, etc., importing or offering for assignment, etc. , in good faith, any product used for making an article in which the registered utility model has been embodied without knowledge; and
 - (iii) the act of possessing an article, in good faith, in which a registered utility model has been embodied for the purpose of assigning, leasing or exporting it without knowledge.

(Mutatis mutandis application of Patent Act)

Article 45 (1) Articles 173 (time limit for request for retrial), 174(2) and (4) (application mutatis mutandis of provisions regarding trial, etc.), and 176 (non-exclusive license due to the working of the invention prior to the registration of the request for a retrial) of the Patent Act shall apply mutatis mutandis to retrials. In this case, the terms "131(1) , the main clause of 131-2(1)," "134(1), (3) and (4)" and "168" in the Article 174(2) of the Patent Act shall be deemed to be replaced with "38(1), the main clause of 38-2(1) of the Utility Model Act," "39(1), (3) and (4)" and "40 of the Utility Model Act," respectively.

- (2) Article 4 of the Patent Act shall apply mutatis mutandis to the time limit provided in Article 173(1) as applied mutatis mutandis pursuant to the preceding paragraph.

Article 46 Deleted

(Actions against trial decisions, etc.)

Article 47 (1) The Tokyo High Court shall have exclusive jurisdiction over any action against a trial decision or a ruling to dismiss a written request for a trial or a retrial.

- (2) Articles 178 (2) to (6) (statute of limitations for filing an action), 179 to 180-2 (appropriate party as defendant, notice of institution of action, and opinion of the Commissioner of the Patent Office in litigation rescinding the trial decision), 181(1) and (5) (rescission of the trial decision or ruling), 182 (delivery of original copy of judgment) and 182-2 (Composition of panel) of the Patent Act shall apply mutatis mutandis to actions under the preceding paragraph.

(Action against amount of compensation)

Article 48 (1) A person who has received an award under Article 21(2), 22(3) or (4), or 23(2) may, if not satisfied with the amount of the compensation determined in the award, institute an action demanding an increase or decrease of the said amount.

- (2) Articles 183(2) (statute of limitations for filing an action) and 184 (standing as defendant) of

the Patent Act shall apply mutatis mutandis to actions under the preceding paragraph.

(Relationship between (administrative) objection and litigation)

Article 48-2 Articles 184(2) (Relationship between (administrative) objection and litigation) shall apply mutatis mutandis to actions demanding the rescission of dispositions imposed by this Act or an order thereunder (excluding dispositions under Article 55(5)).

Chapter VII Special Provisions Concerning International Applications under the Patent Cooperation Treaty

(Application for a utility model registration based on international application)

Article 48-3 (1) An international application (limited only to an application for a utility model registration) to which the international application date is accorded under Article 11(1), 11(2)(b) or 14(2) of the Patent Cooperation Treaty signed in Washington on June 19, 1970 (hereinafter referred to as the "Treaty" in this Chapter) and which specifies Japan as a designated State under Article 4(1)(ii) of the Treaty shall be deemed to be an application for a utility model registration filed on the said international application date.

(2) Article 184-3(2) (patent application based on international application) of the Patent Act shall apply mutatis mutandis to an international application which has been deemed to be an application for a utility model registration under the preceding paragraph (hereinafter referred to as "International Utility Model Registration Application").

(Translations of International Utility Model Registration Application in foreign language)

Article 48-4 (1) An applicant of an International Utility Model Registration Application filed in a foreign language (hereinafter referred to as a "Utility Model Registration Application in a Foreign Language" shall submit to the Commissioner of the Patent Office Japanese translations of the description, scope of claims, drawings (the descriptive text in such drawings only), and the abstract, as provided in Article 3(2) of the Treaty, as of the international application date as provided in paragraph (1) of the preceding Article (hereinafter referred to as "International Application Date") within the period from the priority date under Article 2 (xi) of the Treaty (hereinafter referred to as "Priority Date") to two years and six months (hereinafter referred to as "Time Limit for the Submission of National Documents") therefrom; provided, however, that the applicant of a Utility Model Registration Application in a Foreign Language who has submitted the document under paragraph (1) of the following Article during the period from two months before the expiration of the Time Limit for the Submission of National Documents to the expiry date thereof (excluding the case where the said translations have been submitted prior to the submission of the said documents) may submit the said translations within two months from the date of submission of the said document (hereinafter referred to as "Special Time Limit for the Submission of Translations").

(2) In the case of the preceding paragraph, where the applicant of the Utility Model Registration

Application in a Foreign Language has made an amendment under Article 19(1) of the Treaty, the applicant may, in lieu of the translation of the scope of claim(s) as provided in the preceding paragraph, submit a translation of the amended scope of claim(s).

- (3) Where the translation of the description as provided in paragraph (1) and the translation of the scope of claim(s) as provided in the preceding two paragraphs have not been submitted within the Time Limit for the Submission of National Documents (in the case of a Utility Model Registration Application in a Foreign Language under the proviso to paragraph (1), the Special Time Limit for the Submission of Translations, hereinafter the same shall apply in the following paragraph), the International Utility Model Registration Application shall be deemed to have been withdrawn.
- (4) Where an amendment under Article 19(1) of the Treaty has been made, an applicant who has submitted the translation of the scope of claim(s) as provided in paragraph (1) may further submit a Japanese translation of the said amended scope of claim(s) no later than the date on which the Time Limit for the Submission of National Documents expires (where the applicant files the requests as provided in Article 23(2) or 40(2) of the Treaty within the Time Limit for the Submission of National Documents (hereinafter referred to as "Request for National Processing"), the time of filing the Request for National Processing (hereinafter referred to as "National Processing Standard Time")).
- (5) The main clause of Article 184-7(3) of the Patent Act shall apply mutatis mutandis to the case where the translation under paragraph 2 or the preceding paragraph has not been submitted.

(Submission of documents and order to amend procedures, etc.)

Article 48-5 (1) An applicant of an International Utility Model Registration Application shall submit a document to the Commissioner of the Patent Office within the Time Limit for the Submission of National Documents stating the following:

- (i) the name, and the domicile or residence of the applicant;
- (ii) the name, and the domicile or residence of the creator of the device; and
- (iii) matters as provided by an Ordinance of the Ministry of Economy, Trade and Industry, including the international application number.

(2) The Commissioner of the Patent Office may order the amendment of procedures for an applicant, designating an adequate time limit, in the following cases:

- (i) where the document to be submitted under the preceding paragraph is not submitted within the Time Limit for the Submission of National Documents;
- (ii) where the procedure as provided in the preceding paragraph does not comply with Articles 7(1) to (3) or Article 9 of the Patent Act as applied mutatis mutandis pursuant to Article 2-5(2);
- (iii) where the procedure as provided in the preceding paragraph does not comply with the formal requirements as provided by an Ordinance of the Ministry of Economy, Trade and Industry;
- (iv) where a translation of the abstract to be submitted under paragraph (1) of the preceding

Article is not submitted within the Time Limit for the Submission of National Documents (in the case of a Utility Model Registration Application in Foreign Language under the proviso to paragraph (1) of the preceding Article, the Special Time Limit for the Submission of Translations);

(v) where the fees payable under Article 32(1) are not paid within the Time Limit for the Submission of National Documents; and

(vi) where the fees payable under Article 54(2) are not paid within the Time Limit for the Submission of National Documents.

(3) Article 184-5(3) of the Patent Act shall apply mutatis mutandis to the amendment ordered under the preceding paragraph.

(4) An applicant of an International Utility Model Registration Application may file a Request for National Processing, only after he/she has paid the registration fees payable under Article 32(1) and fees payable under Article 54(2), and, in the case of an International Utility Model Registration Application filed in Japanese language (hereinafter referred to as "Utility Model Registration Application in Japanese Language," has completed the procedures under paragraph (1), or, in the case of a Utility Model Registration Application in Foreign Language, has completed the procedures under paragraph (1) and Article 48-4(1).

(Effect, etc. of application, description, etc. of international application)

Article 48-6 (1) The application of an International Utility Model Registration Application as of the International Application Date shall be deemed to be an application submitted under Article 5(1).

(2) The description of a Utility Model Registration Application in Japanese Language as of the International Application Date and translations of the description of a Utility Model Registration Application in Foreign Language as of the International Application Date shall be deemed to be the description submitted with the application under Article 5(2); scope of claim(s) of a Utility Model Registration Application in Japanese Language as of the International Application Date and a translation of the scope of claim(s) of a Utility Model Registration Application in Foreign Language as of the International Application Date shall be deemed to be the scope of claim(s) submitted with the application under Article 5(2); drawing(s) of a Utility Model Registration Application in Japanese Language as of the International Application Date, and drawing(s) (excluding the descriptive text in the drawing(s)) and a translation of the descriptive text in the drawing(s) of a Utility Model Registration Application in Foreign Language as of the International Application Date shall be deemed to be the drawing(s) submitted with the application under Article 5(2); and, the abstract of a Utility Model Registration Application in Japanese Language and a translation of the abstract of a Utility Model Registration Application in Foreign Language shall be deemed to be the abstract submitted with the application under Article 5(2).

(3) Where a translation of the amended scope of claim(s) under Article 19(1) of the Treaty is submitted as provided in Article 48-4(2) or (4), notwithstanding the preceding paragraph, a translation of the said amended scope of claim(s) shall be deemed to be the scope of claim(s)

submitted with the application under Article 5(2).

(Submission of drawing)

- Article 48-7 (1) Where an International Utility Model Registration Application does not include any drawing, the applicant thereof shall submit the drawing to the Commissioner of the Patent Office on or before the date into which the National Processing Standard Time falls.
- (2) Where the drawing under the preceding paragraph has not been submitted on or before the date into which the National Processing Standard Time falls, the Commissioner of the Patent Office may order the applicant of the International Utility Model Registration Application to submit the drawing, designating an adequate time limit.
- (3) Where the person ordered to submit the drawing under the preceding paragraph does not submit the drawing within the designated time limit under the said paragraph, the Commissioner of the Patent Office may dismiss the said International Utility Model Registration Application.
- (4) The submission of the drawing made under paragraph (1) or pursuant to the order under paragraph (2) (where a brief statement explaining the drawing is submitted with the drawing, the submission of the drawing and the statement) shall be deemed to be an amendment of procedures under Article 2-2(1). In this case, the proviso to Article 2-2(1) shall not apply to such submission.

(Special provisions concerning amendment)

- Article 48-8 (1) The proviso to Article 2-2(1) shall not apply to an amendment which is, under Articles 184-7(2) and 184-8(2) of the Patent Act as applied mutatis mutandis pursuant to Article 48-15(1), deemed to have been made under Article 2-2(1).
- (2) The proviso to Article 2-2(1) shall not apply to an amendment of an International Utility Model Registration Application under Article 28(1) or Article 41(1) of the Treaty.
- (3) With regard to the scope within which the description, scope of claims, drawings of a Utility Model Registration Application in Foreign Language may be amended, the term "the description, scope of claims or drawing(s) originally attached to the application" in Article 2-2(2) shall be deemed to be replaced with "the description, scope of claims or drawing of the international application as of the International Application Date referred to in Article 48-4(1)."
- (4) Article 184-12(1) of the Patent Act shall apply mutatis mutandis to an amendment of an International Utility Model Registration Application under the main clause of Article 2-2(1) or under Article 28(1) or Article 41(1) of the Treaty. In this case, the term "Article 195(2)" in Article 184-12(1) of the Patent Act shall be deemed to be replaced with "Article 54(2) of the Utility Model Act and registration fees payable under Article 32 (1) of the said Act," and "has been paid, and the National Processing Standard Time has lapsed" shall be deemed to be replaced with "has been paid."

(Special provision concerning conditions for utility model registration)

Article 48-9 For the purpose of the application of Article 3-2, in the case where another application for a utility model registration or patent application as provided in Article 3-2 is an International Utility Model Registration Application or an International Patent Application under Article 184-3(2) of the Patent Act, the term "another application for a utility model registration or for a patent" under Article 3-2 shall be deemed to be replaced with "another application for a utility model registration or for a patent (excluding a Utility Model Registration Application in Foreign Language under Article 48-4(1) of this Act or a Patent Application in Foreign Language under Article 184-4(1) of the Patent Act which has been deemed to have been withdrawn in accordance with Article 48-4(3) of this Act or Article 184-4(3) of the Patent Act," the term "the respective Article or for which" shall be deemed to be replaced with "the respective Article, for which," the term "the publication of the patent application has been effected" shall be deemed to be replaced with "the publication of the patent application has been effected, or international publication under Article 21 of the Patent Cooperation Treaty signed in Washington on June 19, 1970 has been effected," and the term "the description, scope of claims or drawings originally attached to the written application" shall be deemed to be replaced with "the description, scope of claims, or drawings of an international application as of the International Application Date under Article 48-4(1) of this Act or Article 184-4(1) of the Patent Act."

(Special provisions concerning a priority claim based on application for a utility model registration)

Article 48-10 (1) Articles 8(4) and 9(2) shall not apply to an International Utility Model Registration Application.

(2) For the purpose of application of Article 8(3) to a Utility Model Registration Application in Japanese Language, the term "the Utility Model Bulletin pertaining to the said application for a utility model registration was issued" in Article 8(3) shall be deemed to be replaced with "the Utility Model Bulletin pertaining to the said application for a utility model registration was issued or the international publication was effected under Article 21 of the Patent Cooperation Treaty signed in Washington on June 19, 1970."

(3) For the purpose of application of Article 8(3) to a Utility Model Registration Application in a Foreign Language, the term "in the description, scope of claims or drawings originally attached to the application in an application for a utility model registration containing a priority claim under paragraph (1)" in Article 8(3) shall be deemed to be replaced with "the description, scope of claims or drawings of an international application containing a priority claim under paragraph (1) as of the International Application Date under Article 48-4(1)," the term "the Utility Model Bulletin pertaining to the said application for a utility model registration was issued" shall be deemed to be replaced with "the Utility Model Bulletin pertaining to the said application for a utility model registration was issued or the international publication was effected under Article 21 of the Patent Cooperation Treaty signed in Washington on June 19, 1970."

(4) For the purpose of application of Articles 8(1) to (3) and 9(1), in the case where the earlier

application under Article 8(1) of this Act is an International Utility Model Registration Application or an International Patent Application under Article 184-3(2) of the Patent Act, the term "the description or scope of claims for a utility model registration or patent, or drawings originally attached to the application" in Articles 8(1) and (2) shall be deemed to be replaced with "the description, scope of claims or drawings of an international application as of the International Application Date under Article 48-4(1) of this Act or Article 184-4(1) of the Patent Act," the term "the description, scope of claims for a utility model registration or patent or drawings originally attached to the application of the Earlier Application" in Article 8(3) shall be deemed to be replaced with "the description, scope of claims or drawings of an international application of the Earlier Application as of the International Application Date under Article 48-4(1) of this Act or Article 184-4(1) of the Patent Act," the term "the laying open of" in Article 8(3) shall be deemed to be replaced with "the international publication under Article 21 of the Patent Cooperation Treaty signed in Washington on June 19, 1970," and the term "when one year and three months has lapsed from the filing date" in Article 9(1) shall be deemed to be replaced with "at the time of the National Processing Standard Time under Article 48-4(4) of this Act or Article 184-4(4) of the Patent Act or the time when one year and three months has lapsed from the International Application Date under Article 48-4(1) of this Act or Article 184-4(1) of the Patent Act, whichever the later."

(Special provision concerning conversion of application)

Article 48-11 An international application that has been deemed to be a patent application under Article 184-3(1) or 184-20(4) of the Patent Act may be converted to an application for a utility model registration, only after the fees payable under Article 195(2) of the said Act have been paid (or, in the case of an international application that is deemed to be a patent application under Article 184-20(4) of the said Act, after the ruling as provided in Article 184-20(4) has been rendered), and, in the case of a Patent Application in Japanese Language under Article 184-6(2) of the said Act, the procedures under Article 184-5(1) of the said Act have been completed, or, in the case of a Patent Application in Foreign Language under Article 184-4(1) of the said Act, the procedures under Articles 184-4(1) and 184-5(1) of the said Act have been completed.

(Special provision concerning time limit for payment of registration fees)

Article 48-12 For the purpose of payment of the registration fees of an International Utility Model Registration Application for each year from the first to the third year, the term "at the time of filing of the application for a utility model registration" in Article 32(1) shall be deemed to be replaced with "within the Time Limit for the Submission of National Documents as provided in Article 48-4(1) (in the case where a Request for National Processing is filed under Article 48-4(4), on or before the filing of the Request for National Processing)."

(Restriction on the time of filing a petition requesting Utility Model Technical Opinion)

Article 48-13 For the purpose of filing a petition requesting Utility Model Technical Opinion

with respect to an International Utility Model Registration Application, the term "any person" in Article 12(1) shall be deemed to be replaced with ", after National Processing Standard Time under Article 48-4(4) has come, any person."

(Special provisions concerning correction)

Article 48-13-2 For the purpose of the request for correction under Article 14-2(1) with respect to a Utility Model Registration Application in Foreign Language, the term "the description, scope of claims, or drawings attached to the application" in Article 14-2(1) shall be deemed to be replaced with "the description, scope of claims or drawing of the international application as of the International Application Date referred to in Article 48-4(1)."

(Special provisions concerning grounds for invalidation)

Article 48-14 For the purpose of a trial for invalidation of utility model registration with regard to a Utility Model Registration Application in Foreign Language, "where the utility model registration has been granted on an application for a utility model registration with an amendment that does not comply with the requirements as provided in Article 2-2(2)" in Article 37(1)(i) shall be deemed to be replaced with "where with regard to a utility model registration granted based on a Utility Model Registration Application in Foreign Language under Article 48-4(1), matters stated in the description, scope of claims or drawing attached to the application do not remain within the scope of matters stated in the description, scope of claims or drawing of the international application as of the International Application Date referred to in Article 48-4(1)."

(Mutatis mutandis application of Patent Act)

Article 48-15 (1) Articles 184-7 (amendment under Article 19 of the Treaty with regard to Patent Application in Japanese Language) and 184-8(1) to (3) (amendment under Article 34 of the Treaty) of the Patent Act shall apply mutatis mutandis to an amendment of an International Utility Model Registration Application made under the Treaty. In this case, the term "Article 17-2(1)" in Articles 184-7(2) and 184-8(2) shall be deemed to be replaced with "Article 2-2(1) of the Utility Model Act."

(2) Article 184-11 (Special provisions concerning patent administrators for overseas residents) of the Patent Act shall apply mutatis mutandis to procedures for International Utility Model Registration Application.

(3) Articles 184-9(6) and 184-14 of the Patent Act shall apply mutatis mutandis to International Utility Model Registration Applications.

(International application deemed to be application for utility model registration by decision)

Article 48-16 (1) Where a refusal under Article 25(1)(a) of the Treaty or a declaration under Article 25(1)(a) or (b) of the Treaty has been made by the receiving Office as defined in Article 2(xv) of the Treaty, or a finding under Article 25(1)(a) of the Treaty has been made by the International Bureau as defined in Article 2(xix) of the Treaty in relation to an

international application as defined in Article 2 (vii) of the Treaty (limited to an application for a utility model registration) which specifies Japan as a designated State under Article 4(1)(ii) of the Treaty, the applicant of the international application may make a request to the effect that the Commissioner of the Patent Office shall render a decision under Article 25(2)(a) of the Treaty in accordance with an Ordinance of the Ministry of Economy, Trade and Industry within the time limit provided in the Ordinance of the Ministry of Economy, Trade and Industry.

- (2) A person making a request under the preceding paragraph with regard to an international application in a foreign language shall submit at the time of the request to the Commissioner of the Patent Office Japanese translations of documents concerning the international application as required by an Ordinance of the Ministry of Economy, Trade and Industry, including the description, scope of claims, drawings (limited to the explanations in the drawings), and abstract.
- (3) Upon receiving the request under paragraph (1), the Commissioner of the Patent Office shall rule on whether the refusal, declaration or finding relating thereto may be justified under the provisions of the Treaty and the Regulations under the Patent Cooperation Treaty.
- (4) Where the Commissioner of the Patent Office has rendered a ruling under the preceding paragraph to the effect that the refusal, declaration or finding under the said paragraph was not justified under the provisions of the Treaty and the Regulations under the Patent Cooperation Treaty, the international application for which the decision is rendered shall be deemed to be an application for a utility model registration filed on the day which would have been accorded as the International Application Date if no such refusal, declaration or finding had been made for the international application.
- (5) For the purpose of amendment of an international application that is deemed to be an application for a utility model registration under the preceding paragraph, the term "the filing date of the application for a utility model registration" in the proviso to Article 2-2(1) shall be deemed to be replaced with "the date prescribed in Article 48-16(4)."
- (6) Articles 48-6(1) and (2), 48-7, 48-8(3), 48-9, 48-10(1), (3) and (4), and 48-12 to 48-14 of this Act and Articles 184-3(2), 184-9(6), 184-12(1) and 184-14 of the Patent Act shall apply *mutatis mutandis* to an international application that is deemed to be an application for a utility model registration under paragraph (4). In such a case, the replacement of terms necessary for the application of the said provisions shall be made as prescribed by Cabinet Order.

Chapter VIII Miscellaneous Provisions

(Registration in the utility model registry)

Article 49 (1) The following matters shall be registered in the utility model registry maintained in the Patent Office:

- (i) the establishment, transfer, lapse, restoration, or restriction on the disposition of a utility model right;

- (ii) the establishment, maintenance, transfer, modification, lapse, or restriction on the disposal of an exclusive or non-exclusive license; and
 - (iii) the establishment, transfer, modification, lapse, or restriction on the disposal of a right of pledge on a utility model right or on an exclusive or non-exclusive license.
- (2) The utility model registry may be prepared, in whole or in part, in the form of magnetic tapes (including other storage media using a similar method that may record and reliably store certain matters, the same shall apply hereinafter).
- (3) In addition to those prescribed in this Act, matters relating to registration shall be prescribed by Cabinet Order.

(Issuance of certificate of utility model registration)

Article 50 (1) The Commissioner of the Patent Office shall issue a certificate of utility model registration to the holder of a utility model right when the establishment of a utility model right has been registered or when a correction has been made under Article 14-2(1).

- (2) Re-issuance of a certificate of utility model registration shall be prescribed by Ordinance of the Ministry of Economy, Trade and Industry.

(Special provisions for utility model registration or utility model right covering two or more claims)

Article 50-2 Pertaining to a utility model registration or utility model right covering two or more claims, for the purposes of the application of Article 12(2), Article 14-2(8) of this Act, Articles 97(1) or Article 98(1)(i) of the Patent Act as applied mutatis mutandis pursuant to Article 26 of this Act, Article 34(1)(iii), Article 37(3), Article 125 of the Patent Act as applied mutatis mutandis pursuant to Article 41 of this Act, Article 132(1) of the Patent Act as applied mutatis mutandis pursuant to Article 41 of this Act or as applied mutatis mutandis pursuant to Article 174(2) of the Patent Act as applied mutatis mutandis pursuant to Article 45(1) of this Act, Article 44 of this Act, Article 176 of the Patent Act as applied mutatis mutandis pursuant to Article 45(1) of this Act, Article 49(1)(i) of this Act, or Article 193(2)(iv) of the Patent Act as applied mutatis mutandis pursuant to Article 53(2) of this Act, the utility model registration shall be deemed to have been granted, or the utility model right shall be deemed to exist, for each claim.

(Utility model registration Mark)

Article 51 A holder of utility model right, exclusive licensee or non-exclusive licensee shall make efforts to place a mark (hereinafter referred to as a "Utility Model Registration Mark") as provided by an Ordinance of the Ministry of Economy, Trade and Industry, on an article in which a registered utility model has been embodied, or package thereof, indicating that a registered utility model has been embodied in the article.

(Prohibition of false marking)

Article 52 It shall be prohibited for a person to do the following acts:

- (i) place putting a Utility Model Registration Mark or a mark confusing therewith on an article in which a registered utility model has not been embodied or on the packaging thereof;
- (ii) assign, lease or display for the purpose of assignment or lease an article in which a registered utility model has not been embodied, or place a Utility Model Registration Mark or a mark confusing therewith on the article or on the package thereof; or
- (iii) Regarding an article in which a registered utility model has not been embodied, display in an advertisement an indication to the effect that a registered utility model has been embodied in the article or an indication confusing therewith, for the purpose of having the article manufactured or used, or assigning or leasing the article.

(Utility model bulletin)

- Article 53 (1) The Patent Office shall publish the utility model bulletin (Jitsuyo Shinan Koho).
- (2) Article 193(2) (limited to the parts pertaining to items (iv) to (vi), (viii) and (ix)) shall apply mutatis mutandis to the utility model bulletin.

(Fees)

- Article 54 (1) Fees shall be paid by the following persons in an amount to be provided by Cabinet Order in view of the actual costs:
- (i) persons filing a request for an extension of the duration under Article 5(1) of the Patent Act as applied mutatis mutandis pursuant to Article 2-5(1) of this Act, Article 32(3) of this Act, or Article 4 of the Patent Act as applied mutatis mutandis pursuant to Article 14-2(5), 39-2(4), 45(2) or 54-2(5) of this Act, or for a change of the date under Article 5(2) of the Patent Act as applied mutatis mutandis pursuant to Article 2-5(1) of this Act;
 - (ii) persons notifying of succession under Article 34(4) of the Patent Act as applied mutatis mutandis pursuant to Article 11(2) of this Act;
 - (iii) persons filing a request for the re-issuance of a certificate of utility model registration;
 - (iv) persons filing a request for the issuance of a certificate under Article 186(1) of the Patent Act as applied mutatis mutandis pursuant to Article 55(1) of this Act;
 - (v) persons filing a request for the issuance of a certified copy of documents or an extract of documents under Article 186(1) of the Patent Act as applied mutatis mutandis pursuant to Article 55(1) of this Act;
 - (vi) persons filing a request to allow the inspection or copying of documents under Article 186(1) of the Patent Act as applied mutatis mutandis pursuant to Article 55(1); or
 - (vii) persons filing a request for the issuance of documents whose contents are stored on the magnetic tapes that constitute the part of the utility model registry under Article 186(1) of the Patent Act as applied mutatis mutandis pursuant to Article 55(1) of this Act.
- (2) The persons listed in the center column of the attached table shall pay fees in the amount as provided by Cabinet Order within the range of the amounts specified in the corresponding right-hand column of the table.
- (3) The two preceding paragraphs shall not apply where the person to pay the fee in accordance with these paragraphs is the State.

- (4) Where the State has joint ownership of a utility model right or a right to obtain a utility model registration with person(s) other than the State, and the portion of their respective shares of said rights has been agreed, notwithstanding the provisions of paragraph (1) or (2), the fees payable by the State and other persons for their utility model right or right to obtain a utility model registration under paragraph (1) or (2) (limited to those provided by Cabinet Order excluding the fees for the petition for Utility Model Technical Opinion) shall be determined as the sum of the provided fees multiplied by the ratios of the share of each person other than the State, and, the person(s) other than the State shall pay such sum.
- (5) Where the State or a person entitled to receive a reduction of the fees for the petition for Utility Model Technical Opinion or exemption therefrom under paragraph (8) or provisions of any other laws and ordinances (hereinafter in this paragraph a "Reduction/Exemption") has joint ownership of a utility model right or a right to obtain a utility model registration with other person(s), and the portion of their respective shares of said right has been agreed, notwithstanding the provisions of paragraph (2), the fees for the petition for Utility Model Technical Opinion payable by such persons for their utility model right or right to obtain a utility model registration under paragraph (2) shall be determined as the sum of the amounts calculated for each person other than the State jointly owning the right, by multiplying the applicable fees for the petition for Utility Model Technical Opinion provided under paragraph (2) (in the case of a person who receives the Reduction/Exemption, the amount after said Reduction/Exemption) by the ratios of the share of each person other than the State, and the person(s) other than the State shall pay such sum.
- (6) Where the amount of the fees calculated under the two preceding paragraphs has a fractional figure of less than ten yen, said portion shall be discarded.
- (7) The payment of the fees under paragraphs (1) and (2) shall be made by patent revenue stamps as provided by an Ordinance of the Ministry of Economy, Trade and Industry; provided, however, that where so provided by an Ordinance of the Ministry of Economy, Trade and Industry, a cash payment thereof shall be accepted.
- (8) Where the creator of a device claimed in an application for a utility model registration or of a registered utility model, or his/her heir, files a petition requesting Utility Model Technical Opinion on that device claimed in that application for a utility model registration or that registered utility model, if the Commissioner of the Patent Office recognizes that the person has difficulties paying the fees for the petition for Utility Model Technical Opinion to be paid under paragraph (2) due to insufficient financial means, the Commissioner of the Patent Office may, pursuant to the provisions of the Cabinet Order, grant the person a reduction of or exemption from the payment of the fees.

(Return of fees)

- Article 54-2 (1) After a petition requesting Utility Model Technical Opinion has been filed, where the petition becomes deemed not to have been filed under Article 12(7), fees for the petition paid by the person under Article 54(2) shall be refunded to the person.
- (2) Where a request for a trial for invalidation of utility model registration has been withdrawn

within the time limit provided in Article 39-2(3) or (5) (or, in the case where the time limit provided in Article 39-2(3) has been extended under Article 4 of the Patent Act as applied mutatis mutandis pursuant to Article 39-2(4), within the extended time limit), fees for the request for a trial paid under Article 54(2) by the person who requested the trial shall be refunded to the person upon his/her request.

- (3) No request for a refund of the fees under the preceding paragraph may be filed after six months has elapsed from the date on which the request for a trial for invalidation of utility model registration was withdrawn.
- (4) Where an intervenor of a trial for invalidation of utility model registration has withdrawn his/her application for intervention within 30 days from the receipt of the notice provided in Article 39(5), the fees for application of intervention paid by the intervenor under Article 54(2) shall be refunded to the intervenor upon his/her request.
- (5) Article 4 of the Patent Act shall apply mutatis mutandis to the time limit provided in the preceding paragraph. In this case, the term "The Commissioner of the Patent Office" in the said Article shall be deemed to be replaced with "The chief trial examiner."
- (6) Where, due to reasons beyond his/her control, an intervenor of a trial for invalidation of utility model registration is unable to withdraw the application for intervention within the time limit provided in paragraph (4), if the intervenor has withdrawn the application within 14 days (in the case of overseas resident, within two months) from the date on which the reasons ceased to exist and not later than six months following the expiration of the said time limit, notwithstanding the said paragraph, the fees for application of intervention paid by the intervenor under Article 54(2) shall be refunded to the intervenor upon his/her request.
- (7) No request for a refund of the fees under paragraph (4) and the preceding paragraph may be filed after six months has elapsed from the date on which the application for intervention was withdrawn.
- (8) Where an intervenor of a trial for invalidation of utility model registration has not withdrawn his/her application for intervention, if the request for the trial is withdrawn within the time limit provided in paragraph (4) or (6) (or, in the case where the time limit provided in paragraph (4) has been extended under Article 4 of the Patent Act as applied mutatis mutandis pursuant to paragraph (5), within the extended time limit), the fees for application of intervention paid by the intervenor under Article 54(2) shall be refunded to the intervenor upon his/her request; provided, however, that this shall not apply where the trial procedures have continued under 148(2) of the Patent Act as applied mutatis mutandis pursuant to Article 41.
- (9) No request for a refund of the fees under the preceding paragraph may be filed after one year from the date on which the request for a trial for invalidation of utility model registration was withdrawn.
- (10) Fees paid in excess or in error shall be refunded upon the request of the person who made payment thereof.
- (11) No request for a refund of the fees under the preceding paragraph may be filed after one year from the date on which the payment thereof has been made.

(Mutatis mutandis application of Patent Act)

Article 55 (1) Article 186 (request for certificate, etc.) of the Patent Act shall mutatis mutandis apply to utility model registrations.

(2) Articles 189 to 192 (service) of the Patent Act shall mutatis mutandis apply to services under this Act.

(3) Article 194 of the Patent Act shall mutatis mutandis apply to the procedures. In this case, the term "an examination" in paragraph (2) of the said Article shall be deemed to be replaced with "preparation of a Utility Model Technical Opinion under Article 12(1) of the Utility Model Act."

(4) Article 195-3 of the Patent Act shall mutatis mutandis apply to dispositions under this Act or an order issued under this Act.

(5) Article 195-4 (Restriction on appeals under Administrative Appeal Act) of the Patent Act shall mutatis mutandis apply to a trial decision, a ruling to dismiss a written request for a trial or retrial, and a disposition against which no appeal lies in accordance with this Act.

Chapter IX Penal Provisions

(Crime of infringement)

Article 56 An infringer of a utility model right or exclusive license shall be punished by imprisonment with work for a term not exceeding five years or a fine not exceeding 5,000,000 yen or combination thereof.

(Crime of fraud)

Article 57 Any person who has obtained a utility model registration or a trial decision by means of a fraudulent act shall be punished by imprisonment with work for a term not exceeding one year or a fine not exceeding 1,000,000 yen.

(Crime of false marking)

Article 58 Any person who fails to comply with Article 52 shall be punished by imprisonment with work for a term not exceeding one year or a fine not exceeding 1,000,000 yen.

(Crime of perjury, etc.)

Article 59 (1) A witness, an expert witness or an interpreter who has sworn under this Act and made a false statement or given a false expert opinion or interpretation to the Patent Office or the court commissioned thereby shall be punished by imprisonment with work for a term between three months and ten years.

(2) Where a person who has committed the crime in the preceding paragraph has made a voluntary confession before a certified copy of the judgment on the case has been served or a trial decision has become final and binding, the punishment may be reduced or exculpated.

(Crime of divulging secrets)

Article 60 A present or former official of the Patent Office who has divulged or misappropriated any secret relating to a device claimed in a pending application for a utility model registration that has become known to him/her in the course of performing his/her duties shall be punished by imprisonment with work for a term not exceeding one year or a fine not exceeding 500,000 yen.

(Crime of breach of protective order)

Article 60-2 (1) Any person who fails to comply with a protective order shall be punished by imprisonment with work for a term not exceeding five years or a fine not exceeding 5,000,000 yen or combination thereof.

(2) The prosecution of the crime under the preceding paragraph may not be initiated unless a complaint is filed.

(3) The crime under paragraph (1) shall apply to a person who commits the crime outside Japan.

(Dual liability)

Article 61 (1) Where a representative of a juridical person, or an agent, employee or other worker of a juridical person or an individual has committed in the course of performing his/her duties for the juridical person or individual, any act in violation prescribed in the following items, in addition to the offender, the juridical person shall be punished by a fine as provided in the following items and the individual shall be punished by a fine as provided in the Article prescribed in the respective items:

(i) Article 56 or 60-2(1), a fine not exceeding 300 million yen; and

(ii) Article 57 or 58, a fine not exceeding 30 million yen.

(2) In the case of the preceding paragraph, the complaint under Article 60-2(2) against the offender shall also have effect on the juridical person or individual and the complaint against the juridical person or individual shall also have effect on the offender.

(3) Where a fine is imposed on a juridical person or individual under paragraph (1) with regard to a violation of Article 56 or 60-2(1), the period of prescription provided for the crime in these Article shall apply.

(Civil fine)

Article 62 Where a person who has sworn under Article 207(1) of the Code of Civil Procedure as applied mutatis mutandis under Article 151 of the Patent Act which is applied mutatis mutandis under Articles 71(3) of the Patent Act as applied mutatis mutandis pursuant to Article 26 of this Act, is applied mutatis mutandis under Article 41 of this Act, or is applied mutatis mutandis under Article 174(2) of the Patent Act as applied mutatis mutandis pursuant to Article 45(1) of this Act has made a false statement before the Patent Office or a court commissioned thereby, said person shall be punished by a civil fine not exceeding 100,000 yen.

Article 63 A person who has been summoned by the Patent Office or a court commissioned

thereby in accordance with this Act, and fails to appear or refuses to swear, make a statement, testify, give an expert opinion or interpret, without a justifiable reason, shall be punished by a civil fine not exceeding 100,000 yen.

Article 64 A person who has been ordered by the Patent Office or a court commissioned thereby to submit or present documents or other materials for the purpose of examination or preservation of evidence in accordance with this Act and fails to comply with the order, without a justifiable reason, shall be punished by a civil fine not exceeding 100,000 yen.

Appended Table (In relation to Article 54)

| | The person(s) who shall pay fees | Amounts |
|--------|---|--|
| (i) | A person filing an application for utility model registration | 14,000 yen per case |
| (ii) | A person responsible for the procedures under Article 48-5(1) | 14,000 yen per case |
| (iii) | A person making a request under Article 48-16(1) | 14,000 yen per case |
| (iv) | A person filing a petition requesting Utility Model Technical Opinion | 42,000 yen per case plus 1,300 yen per claim |
| (v) | A person correcting a description, scope of claims or drawings | 1,400 yen per case |
| (vi) | A person requesting an advisory opinion under Article 71 (1) of the Patent Act as applied mutatis mutandis pursuant to Article 26 | 40,000 yen per case |
| (vii) | A person requesting an award | 55,000 yen per case |
| (viii) | A person requesting the cancel of an award | 27,500 yen per case |
| (iv) | A person filing a request for a trial or retrial | 49,500 yen per case plus 5,500 yen per claim |
| (x) | A person applying to intervene in a trial or retrial. | 55,000 yen per case |