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This English translation of the Patent Act has been prepared (up to the revisions of Act No. 51 of 2023 (Effective July 3, 2023)).

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## **Patent Act (Act No. 121 of 1959)** **Latest revision: Act No.51 of June 14,2023**

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**Chapter I General Provisions (Article 1 to Article 28)**

(Purpose)

Article 1 The purpose of this Act is to encourage inventions through promoting the protection and utilization of inventions, and thereby contribute to the development of industry.

(Definitions)

- Article 2 (1) The term "invention" as used in this Act means a highly advanced creation of technical ideas utilizing the laws of nature.
- (2) The term "patented invention" as used in this Act means an invention for which a patent has been granted.
- (3) The term "work" as used in this Act in respect of an invention means the following actions:
- (i) If the invention of a product (including a computer program, etc.; the same applies hereinafter), the producing, using, transferring, etc.it (meaning transferring it or lending it out, and this includes providing it through a telecommunications line if it is a computer program, etc.; the same applies hereinafter), exporting or importing it, or offering to transfer, etc. it (this includes displaying it for the purpose of transferring, etc.it; the same applies hereinafter) ;
  - (ii) if the invention is a process, using it; and
  - (iii) if the invention of a process for producing a product, beyond the action provided in the preceding item, acts of using, transferring, etc., exporting or importing, or offering to transfer, etc. it, beyond what is provided for in the proceeding item.
- (4) A "computer program, etc." in this Act means a computer program (meaning a set of instructions given to a computer which work to produce a specific result; hereinafter the same applies in this paragraph) and any other information that is to be processed by a computer equivalent to a computer program.

(Calculation of Time Periods)

- Article 3 (1) The calculation of time period under this Act or under an order that is based on this Act is as under the following provisions:
- (i) the first day of the period is not included in the calculation; provided, however, that this does not apply if the period of time commences at twelve midnight;
  - (ii) if the period is indicated by months or years, the months or years refer to

calendar months or calendar years, and if the period is not calculated from the beginning of a month or a year, the period expires on the day preceding the day corresponding to the first day of the calculation in the final month or year; provided, however, that if there is no corresponding day in the final month, the period expires on the last day of the final month.

- (2) If the last day of the prescribed period for filing a patent application and a request or demand, or for other procedures relating to a patent (hereinafter referred to as "procedures") is any of the days provided for in Article 1, paragraph (1) of the Act on Holidays of Administrative Organs (Act No. 91 of 1988), the day following that day is the last day of the period.

(Extension of Time Limits)

Article 4 The Commissioner of the Japan Patent Office may extend the period provided for in Article 46-2, paragraph (1), item (iii), Article 108, paragraph (1), Article 121, paragraph (1), and Article 173, paragraph (1) for a person in a remote area or an area with transportation difficulty, upon request or by the commissioner's own authority.

Article 5 (1) If the Commissioner of the Japan Patent Office, a chief administrative judge, or a trial or appeal examiner has designated a period by which procedures are to be undertaken pursuant to this Act, the official may extend the time limit, upon request or by the official's own authority.

- (2) If a chief administrative judge has designated a specific date pursuant to this Act, the judge may change the date, upon request or by the judge's own authority.
- (3) The extension of the period of time under paragraph (1) (limited to the period of time provided by Order of the Ministry of Economy, Trade and Industry) may be requested even after the passage of that period, but not later than the period provided by Order of the Ministry of Economy, Trade and Industry.

(Capacity of Associations Which Are Not Corporations to Undertake Procedures)

Article 6 (1) An association or foundation which is not a corporation but for which a representative or an administrator has been designated may, in its name:

- (i) request the examination of an application;
  - (ii) file an opposition to a granted patent;
  - (iii) request a trial for patent invalidation or a trial for invalidation of registration of a patent term extension; and
  - (iv) request a retrial pursuant to Article 171, paragraph (1), following a final and binding decision in a trial for patent invalidation or a trial for invalidation of registration of a patent term extension
- (2) An association or foundation which is not a corporation but for which a representative or an administrator has been designated may be named as a

petitioner in a request for a retrial against a final and binding decision in a trial for patent invalidation or a trial for invalidation of registration of patent term extension.

(Capacity of a Minor or Adult Ward to Undertake a Procedure)

Article 7 (1) A Minor or adult ward may not undertake a procedure if this is done through a statutory agent; provided, however, that this does not apply in the case of a minor who is capable of independently performing a juridical act.

- (2) A person under curatorship must have the consent of the curator in order to undertake a procedure.
- (3) If there is a supervisor of guardian, the statutory agent must have that the supervisor's consent in order to undertake a procedure.
- (4) If a person under curatorship or a statutory agent files an opposition to a granted patent concerning the person's patent right or an adverse party files a request for a trial, appeal, or retrial involving the person under curatorship or the statutory agent, the preceding two paragraphs do not apply.

(Patent Administrators for Overseas Residents)

Article 8 (1) Unless otherwise provided for by Cabinet Order, a person not domiciled or resident in Japan (or, without a business office in Japan, if it is a corporation) (hereinafter referred to as an "overseas resident") may only undertake a procedures or file an action objecting to a disposition reached by an administrative agency pursuant to the provisions of this Act or an order that is based on this Act, through a representative domiciled or resident in Japan that acts as the person's agent in respect of the patent (hereinafter referred to as a "patent administrator").

- (2) The patent administrator represents the principal in all procedures and litigation objecting to dispositions reached by an administrative agency pursuant to the provisions of this Act or an order that is based on this Act; provided, however, that this does not apply if the overseas resident limits the scope of authority of agency of the patent administrator.

(Scope of Authority of Agency)

Article 9 An agent of a person domiciled or resident in Japan (in the case of a corporation, with a business office in Japan) and that is undertaking a procedure may not, unless expressly so authorized, convert, waive or withdraw a patent application, withdraw an application for registration of extension of the duration of a patent right, withdraw a request, application or motion, make or withdraw a priority claim under Article 41, paragraph (1), file a patent application based on a registration of a utility model in accordance with Article 46-2, paragraph (1), file a request for publication of an application, file a request for an appeal against a

rejection, waive a patent right or appoint a subagent.

#### Article 10 Deleted

##### (Non-Extinguishment of Authority of Agency)

Article 11 The authority of an agent appointed by mandate of a person undertaking procedures does not extinguish upon the death of the principal, or in the case of a corporation, merger of the principal, termination of entrusted duties of a trustee that is the principal, the death of the statutory agent or change or extinction of the statutory agent's authority.

##### (Individual Representation by Agents)

Article 12 If there are two or more agents acting for a person that undertakes procedures, each of the agents may represent the principal before the Japan Patent Office.

##### (Replacement of Agents)

Article 13 (1) If the Commissioner of the Japan Patent Office or the chief administrative judge finds that a person undertaking procedures is not competent to undertake the procedures, the commissioner or judge may order the person to undertake the procedures through an agent.

(2) If the Commissioner of the Japan Patent Office or a chief administrative patent judge finds that an agent acting for a person undertaking procedures is not competent to undertake the procedures, the commissioner or judge may order that the agent be replaced.

(3) In the case of the preceding two paragraphs, the Commissioner of the Japan Patent Office or the chief administrative judge may order that a patent attorney be made the agent.

(4) After the Commissioner of the Japan Patent Office or the chief administrative judge issues an order under paragraph (1) or (2), the commissioner or judge may dismiss the procedures before the Japan Patent Office undertaken by the person undertaking procedures referred to in paragraph (1) or the agent referred to in paragraph (2).

##### (Mutual Representation of Multiple Parties)

Article 14 If two or more persons are jointly undertake a procedure, each of them acts as the agent of all of them with respect to procedures other than the conversion, waiver and withdrawal of a patent application, the withdrawal of an application to register a patent term extension, the withdrawal of a request, demand, application, or motion, the assertion or withdrawal of a priority claim as referred to in Article 41, paragraph (1), a request for publication of an

application, and the request for an appeal against a rejection; provided, however, that this does not apply if the persons have appointed a representative for all of them and have notified the Japan Patent Office accordingly.

(Jurisdiction Over Overseas Residents)

Article 15 Regarding a patent right or other right under a patent of an overseas resident, the domicile or residence of the overseas resident's patent administrator, or if there is no patent administrator, the address of the Japan Patent Office, is deemed to be the location of the property under Article 5, item (iv) of the Code of Civil Procedure (Act No. 109 of 1996).

(Ratification of Acts of a Person Lacking Legal Capacity to Undertake Procedures)

- Article 16 (1) A procedure undertaken by a minor (excluding one with the legal capacity to conduct juridical acts independently) or an adult ward may be ratified by the person's statutory agent (or by the adult ward, if the person later acquires the legal capacity to undertake procedures).
- (2) A procedure undertaken by a person with no authority to present the principal may be ratified by the principal with the legal capacity to undertake procedures or the principal's statutory agent.
- (3) A person under curatorship may have a procedure that has been undertaken by a person under curatorship without the consent of the curator ratified by gaining the approval of the curator.
- (4) If there is a guardianship supervisor, a statutory agent that gains the approval of the guardianship supervisor or a principal who acquires the legal capacity to undertake procedures may ratify a procedure that has been undertaken by the statutory agent without the consent of the guardianship supervisor.

(Amendment of Proceedings)

- Article 17 (1) A person undertaking a procedure may make an amendment only while the case is pending before the Japan Patent Office; provided, however, that the person may not amend the description, claims, drawings, or abstract attached to the written application, a document prescribed in Article 41, paragraph (4) or Article 43, paragraph (1) (including if applied mutatis mutandis pursuant to Article 43-2, paragraph (2) ) and including if applied mutatis mutandis pursuant to Article 43-3, paragraph (3)) and Article 43-3, paragraph (3)), or the corrected description, claims or drawings attached to the written request for correction or for a trial for correction as referred to in Article 120-5, paragraph (2) or Article 134-2, paragraph (1), unless an amendment may be made pursuant to the provisions of the following Article through Article 17-5.
- (2) Notwithstanding the main clause of the preceding paragraph, an applicant filing

an application written in a foreign language as referred to in Article 36-2, paragraph (2) may not amend the documents or abstract in a foreign language as referred to in Article 36-2, paragraph (1).

- (3) The Commissioner of the Japan Patent Office may order an amendment to be made with respect to a procedure an adequate, specified period of time, in the following cases:
- (i) the procedures do not comply with Article 7, paragraphs (1) through (3) or Article 9;
  - (ii) the procedure does not comply with the formal requirements specified by this Act or to an order that is based on this Act; and
  - (iii) the fees relating to the procedure that is to be paid pursuant to Article 195, paragraphs (1) through (3) has not been paid.
- (4) To amend procedures (except in the case of the payment of fees), a written amendment must be submitted, except for cases provided for in Article 17-2, paragraph (2).

(Amendment of the Description, Claims or Drawings Attached to the Written Application)

Article 17-2 (1) An applicant for a patent may amend the description, claims, or drawings attached to the written application, before the delivery of the certified copy of the examiner's decision notifying that a patent is to be granted; provided, however, that following the receipt of a notice provided under Article 50, an amendment may only be made in the following cases:

- (i) the applicant receives the notice (hereinafter referred to in this Article as the "notice of grounds for rejection") under Article 50 (including if applied *mutatis mutandis* pursuant to Article 159, paragraph (2) (including if applied *mutatis mutandis* pursuant to Article 174, paragraph (2)) and Article 163, paragraph (2); hereinafter the same applies in this paragraph) for first time, and makes the amendment within the designated period of time pursuant to Article 50;
  - (ii) after receiving notice of grounds for rejection, the applicant receives a notice under Article 48-7 and makes the amendment within the period of time specified pursuant to the Article;
  - (iii) after receiving notice of grounds for rejection, the applicant has received another notice of grounds for rejection and makes the amendment within the period of time specified pursuant to Article 50 for the most recently received notice of grounds for rejection; and
  - (iv) the applicant files an appeal against a rejection and makes the amendment at the same time as the appeal.
- (2) If an applicant of an application written in a foreign language provided in Article 36-2, paragraph (2) amends a description, claims or drawings pursuant to the preceding paragraph for the purpose of correcting a mistranslation, the

applicant must submit a mistranslation of correction form that gives the reasons for the correction.

- (3) Excluding the description, claims or drawings are being amended pursuant to paragraph (1) through the submission of a mistranslation correction form, the amendment of must remain within the scope of the matters indicated in the description, claims or drawings originally attached to the written application (in the case of an application written in a foreign language under Article 36-2, paragraph (2), the translation of foreign-language documents provided in Article 36-2, paragraph (2) that is deemed to constitute the description, claims and drawings pursuant to Article 36-2, paragraph (8) (if the description, claims or drawings has been amended through the submission of a mistranslation correction form matters indicated in the translation or in the amended description, claims and drawings); the same applies in Article 34-2, paragraph (1) and Article 34-3, paragraph (1)).
- (4) If an amendment other than what is provided for in the preceding paragraph is made to a claim, in a cases set forth in one of the items of paragraph (1), it must be made in such a way that the invention for which the pre-amendment notice of grounds for rejection indicates a judgment as to patentability and the invention defined by what is described in the claims after that amendment constitute a single group of inventions that satisfies the Article 37 requirement of unity of invention.
- (5) If an amendment other than what is provided for in the preceding two paragraphs is made to a claim in the cases of paragraph (1), items (i), (iii) and (iv) (for a case as set forth in item (i) of the paragraph, this is limited to if the applicant has received a notice under Article 50-2 along with the notice of grounds for rejection), the amendment of the claims is limited to that which is done for one of the following purposes:
  - (i) the deletion of a claim provided for in Article 36, paragraph (5);
  - (ii) restriction of the claims (limited to if the restriction is to restrict matters required to identify the invention stated in a claim pursuant to Article 36, paragraph (5), and the industrial applicability and the problem to be solved by the invention stated in a claim prior to the amendment are identical to those after the amendment);
  - (iii) the correction of errors; and
  - (iv) the clarification of an ambiguous statement (limited to a matters stated as grounds for rejection in the notice of grounds for rejection).
- (6) Article 126, paragraph (7) applies mutatis mutandis to the cases referred to in item (ii) of the preceding paragraph.

(Amendment of the Abstract)

Article 17-3 An applicant for a patent may amend the abstract attached to the



written application within a period provided by Order of the Ministry of Economy, Trade and Industry.

(Amendment of Document of Priority Claim)

Article 17-4 A person that claims priority pursuant to the provisions under Article 41, paragraph (1) or Article 43, paragraph (1), Article 43-2, paragraph (1) (including when applied mutatis mutandis pursuant to Article 43-3, paragraph (3)), or Article 43-3, paragraph (1) or (2) may amend the document prescribed in Article 41, paragraph (4) or Article 43, paragraph (1) (including when applied mutatis mutandis pursuant to Article 43-2, paragraph (2) (including when applied mutatis mutandis pursuant to Article 43-3, paragraph (3)) and Article 43-3, paragraph (3)) only within a period provided by Order of the Ministry of Economy, Trade and Industry.

(Amendment of Corrected Descriptions, Claims or Drawings)

Article 17-5 A patentee may amend a corrected description, claims or drawings attached to the written request for correction pursuant to Article 120-5, paragraph (2) only within the period of time designated pursuant to Article 120-5, paragraph (1) or (6).

(2) The respondent in a trial for patent invalidation may amend the corrected description, claims or drawings attached to the written request for correction as referred to in Article 134-2, paragraph (1) only within the period of time designated pursuant to Article 134, paragraph (1) or paragraph (2), Article 134-2, paragraph (5), Article 134-3, Article 153, paragraph (2), or Article 164-2, paragraph (2).

(3) The petitioner in a trial for correction may amend the corrected description, claims or drawings attached to the written request for a trial for correction, only prior to the notice under Article 156, paragraph (1) (or, if the proceedings are reopened as under Article 156, paragraph (3), prior to the notice under Article 156, paragraph (1) following this).

(Dismissal of Procedures)

Article 18 (1) The Commissioner of the Japan Patent Office may dismiss the procedures if a person ordered to make an amendment to the procedures pursuant to Article 17, paragraph (3) fails to make the amendment within the period of time the commissioner has specified pursuant to those provisions, or if the person obtaining the registration establishing a patent right fails to pay patent fees within the period of time provided for in Article 108, paragraph (1).

(2) The Commissioner of the Japan Patent Office may dismiss a patent application if the patent applicant to which the commissioner has issued an order pursuant to Article 17, paragraph (3) to pay a patent fees under Article 195, paragraph (3)

fails to pay the patent fees within the period of time the commissioner has specified pursuant to Article 17, paragraph (3).

(Dismissal of Non-Compliant Procedure)

Article 18-2 (1) The Commissioner of the Japan Patent Office is to dismiss a procedure that is not compliant and not amendable; provided, however, that this does not apply if the procedure falls under any of the items of Article 38-2, paragraph (1).

(2) If the Commissioner of the Japan Patent Office intends to dismiss a procedure under the preceding paragraph, the commissioner must notify the person undertaking the procedure of the grounds therefor and give the person an opportunity to submit a document stating an explanation (hereinafter referred to as a "written explanation") within an adequate specified period of time.

(Effective Time of Submission of Written Application)

Article 19 An application, a document or any other item submitted by mail or by service of correspondence delivery as provided Article 2(2) of the Act on Correspondence Delivery by Private Business Operators (Act No. 99 of 2002; hereinafter referred to as the Correspondence Delivery Act in this Article) provided by a general correspondence delivery service provider as provided in Article 2(6) of the said Act or by a specified correspondence delivery service provider as provided in Article 2(9) of the said Act (hereinafter referred to as correspondence delivery) that is prescribed by Ordinance of the Ministry of Economy, Trade and Industry to the Patent Office under this Act, or any order rendered under this Act, that is subject to a time limit, shall be deemed to have arrived at the Patent Office at the date and time when such application or item is presented to a business office of Japan Post Co., Ltd. (limited to those that conduct postal services) if such date and time are proven by the receipt of the postal item, at the date and time of the date stamp on the postal item or the letter item as provided in Article 2(3) of the Correspondence Delivery Act (hereinafter referred to as the letter item in this Article) if such date and time are clearly legible, or at noon of the day of the date stamp on the postal item or letter item if only the day, but not the time, of the date stamp is clearly legible.

(Succession of Effects of Procedures)

Article 20 The effects of the procedures involving a patent right or any right relating to a patent extend to a successor in title.

(Continuation of Procedures)

Article 21 When a patent right or any right under a patent is transferred while the case involving is pending with the Japan Patent Office, the Commissioner of the

Japan Patent Office or a chief administrative judge may continue the proceedings in that case with successor in title to the patent right or other right under the patent.

(Continuance or Suspension of Procedures)

Article 22 (1) If a motion to substitute a party in proceedings that have become subject to a continuance following the service of a certified copy of a ruling, examiner's decision or decision on a trial or appeal the Commissioner of the Japan Patent Office or the administrative judges must rule on whether to permit the substitution.

(2) The ruling as referred to in the preceding paragraph must be issued in writing and the reasons for that ruling must be given.

Article 23 (1) If the person that should undertake to substitute as the party to examination, proceedings, ruling on an opposition to a granted patent, or a trial and appeal or retrial and re-appeal that have become subject to a continuance fails to do so, the Commissioner of the Japan Patent Office or the administrative judges must order the person to substitute as a party within an adequate specified period of time, upon a motion or by the commissioner's or judges' own authority.

(2) If the party is not substituted within the period of time that the Commissioner of the Japan Patent Office or the administrative judge specifies pursuant to the preceding paragraph, the commissioner or the judge may deem the party to be substituted on the date on which the period of time elapses.

(3) If a party is deemed to have been substituted pursuant to the preceding paragraph, the Commissioner of the Japan Patent Office or the chief administrative judge must notify the parties thereof.

Article 24 The provisions of Article 124 of the Code of Civil Procedure and Articles (excluding paragraph (1), item (vi)), Articles 126 through 127, Article 128, paragraph (1), Articles 130 and 131, and Article 132, paragraph (2) (effect of continuances and suspensions of litigation proceedings) of that Code apply mutatis mutandis to a procedure for an examination, for proceedings and a ruling on an opposition to a granted patent, or for a trial and appeal, or retrial and re-appeal. In this case, the term "litigation representative" in Article 124, paragraph (2) of the Code is deemed to be replaced with "representative entrusted with the examination, or proceedings and a ruling on an opposition to a granted patent, or a trial and appeal, or retrial and re-appeal", the term "court" in Article 127 of the Code is deemed to be replaced with "Commissioner of the Japan Patent Office or a chief administrative judge", the term "court" in Article 128, paragraph (1) and Article 131 of the Code is deemed to be replaced with "Commissioner of the Japan

Patent Office or the administrative judges", and the term "court" in Article 130 of the Code is deemed to be replaced with " Japan Patent Office".

(Enjoyment of Rights by Foreign Nationals)

Article 25 A foreign national not domiciled or resident in Japan (or it is a corporation, without a business office in Japan) may not enjoy a patent nor rights or other rights under a patent, except in the following items:

- (i) the country of the foreign national allows Japanese nationals the enjoyment of a patent right or other rights relating to a patent based on the same conditions as for its own nationals;
- (ii) If the country of the foreign national has decided to allow Japanese nationals the enjoyment of patent rights or other rights under patents based on the same conditions as for its own nationals so long as Japan allows nationals of that country the enjoyment of patent rights or other rights under patents; or
- (iii) when otherwise provided by a treaty.

(Effect of Treaties)

Article 26 If specific provisions on patents are established by treaty, those provisions prevail.

(Registration in the Patent Register)

Article 27 (1) The following matters are registered in the patent register maintained in the Japan Patent Office:

- (i) the establishment of a patent right, extension of its term, its transfer, modification under a trust, forfeiture, restoration and restrictions on its disposal;
  - (ii) the establishment of an exclusive license, its preservation, transfer, modification, forfeiture and restrictions on its disposal;
  - (iii) the establishment of a pledge on a patent right or exclusive license, the transfer of such a pledge, its modification, forfeiture and restrictions its disposal; and
  - (iv) the establishment of a provisional exclusive license, its preservation, transfer, modification, forfeiture and restriction on its disposal.
- (2) The patent register may be prepared, in whole or in part, on a magnetic tape (including any other storage media using a similar method that is able to record and reliably store certain matters; the same applies hereinafter).
- (3) Beyond what is prescribed in this Act, the necessary matters as regards registration are prescribed by Cabinet Order.

(Issuance of a Patent Certificate)

- Article 28 (1) The Commissioner of the Japan Patent Office issues a patent certificate to the patentee when the establishment of a patent right is registered, and issues the same if the transfer of a patent right is registered based on a request under Article 74, paragraph (1), or if a ruling or a decision on a trial or appeal to correct the description, claims or drawings attached to the written application becomes final and binding, is registered.
- (2) The re-issuance of the patent certificate is prescribed by Order of the Ministry of Economy, Trade and Industry.

## **Chapter II Patents and Patent Applications(Article 29 to Article 46-2)**

(Conditions for Patentability)

- Article 29 (1) A person that invents an invention with industrial applicability may obtain a patent for that invention, unless the invention is as follows:
- (i) an invention that is public knowledge within Japan or in a foreign country prior to the filing of the patent application;
  - (ii) an invention that is publicly known to be worked within Japan or in a foreign country prior to the filing of the patent application; or
  - (iii) an invention that is described in a distributed publication or made available for public use over telecommunications lines within Japan or in a foreign country prior to the filing of the patent application.
- (2) A person may not obtain a patent if prior to the filing of the patent application, a person of ordinary skill in the art of the invention would have easily been able to make that invention based on an invention prescribed in one of the items of the preceding paragraph, notwithstanding the preceding paragraph.

Article 29-2 Notwithstanding Article 29, paragraph (1), a person may not be obtained a patent if an invention in a patent application is identical to an invention or device described in the description, patent claims, utility model claims, or drawings(or, for application written in a foreign language as referred to in Article 36-2, paragraph (2) the foreign-language documents as referred to in Article 36-2, paragraph (1))which originally attached to the written application for another patent application or utility model registration, filed prior to the date the relevant patent application is filed, with regard to which an issue of the patent gazette giving the particulars set forth in the items of Article 66, paragraph (3) of the Patent Act (hereinafter referred to as the "gazette in which the patent appears"), is published pursuant to Article 66 paragraph(3), the application is published, or an issue of the utility model bulletin giving the particulars set forth in the items of Article 14, paragraph (3) of the Utility Model Act (Act No. 123 of 1959) (hereinafter referred to as "bulletin in which the utility model appears") is published pursuant to Article 14, paragraph (3) of that Act

subsequent to the filing of the relevant application (this excludes any invention or device whose inventor is the same as the inventor of the invention in the relevant patent application); provided, however, that this does not apply if, at the time a patent application is filed, the person filing that patent application and the person filing the other application for patent or for utility model registration are the same person.

(Exception to the Lack of Novelty of Invention)

Article 30 In applying Article 29, paragraph (1) and (2) to an invention in a patent application that a person with the right to obtain a patent files within one year from the date on which the invention, contrary to that person's intention comes to fall under one of the items of Article 29, paragraphs (1), the intention is deemed not to fall under any of those items.

(2) The preceding paragraph also applies with respect to the of application of Article 29, paragraphs (1) and (2) to invention in a patent application that person with the right to obtain a patent files within one year after the date on which the invention, through that person's actions, comes to fall under one of the items of Article 29, paragraph (1) (excluding an invention which has come to fall under any of the items of Article 29, paragraph (1) due to being contained in a gazette relating to an invention, utility model, design or trademark).

(3) Any person seeking to have the preceding paragraph applied must submit a document stating that fact to the Commissioner of the Japan Patent Office when filing the patent application, and, must submit to the commissioner a document evidencing that the invention that come to fall under one of the items of Article 29, paragraph (1) is an invention to which the preceding paragraph is applicable (referred to as a "proving document" in the following paragraph), within thirty days after the date of filing of the patent application.

(4) If a person that is to submit a proving document prescribed in the preceding paragraph is unable to submit the proving document within the period provided in the paragraph due to reasons beyond the person's control, the person may submit the proving document to the Commissioner of the Japan Patent Office within 14 days (if the person is an overseas resident, within two months) from the date on which the reasons ceased to be applicable, but not later than six months following the passage of the period, notwithstanding the preceding paragraph.

Article 31 Deleted

(Unpatentable Inventions)

Article 32 An invention that is likely to disrupt public order, corrupt public morals or harm public health may not be patented, notwithstanding Article 29.

(Right to the Grant of a Patent)

Article 33 (1) The right to the grant of a patent may be transferred.

- (2) The right to the grant of a patent may not be pledged.
- (3) When the right to the grant of a patent is co-owned, no co-owner may transfer the co-owner's respective share without the consent of all the other co-owners.
- (4) When the right to the grant of a patent is co-owned, no co-owner may establish a provisional exclusive license or grant a provisional non-exclusive license on the patent right to be obtained based on the right to the grant of a patent without the consent of all the other co-owners.

Article 34 (1) Succession to a right to the grant of a patent prior to the filing of a patent application may not be asserted against any third party unless the successor in title files the patent application.

- (2) If two or more patent applications are filed on the same date based on the right to the grant of a patent based on succession from the same person, succession by a person other than one selected by consultations between the applicants may not be asserted against a third party.
- (3) The preceding paragraph applies if applications for a patent or for the registration of a utility model are filed on the same date based on the right to the grant of a patent or the right to the grant of a utility model registration for the same invention or device based on succession from the same person.
- (4) No succession to a right to the grant of a patent after the filing of the patent application is effective unless the Commissioner of the Japan Patent Office is notified, except in the case of general successions including inheritance.
- (5) If an inheritance or other general succession to the right to the grant of a patent occurs, the successor in title must notify the Commissioner of the Japan Patent Office thereof without delay.
- (6) If two or more notifications are filed on the same date regarding successions the right to the grant of a patent based on succession from the same person, no notification by a person other than the person selected by consultations between the persons submitting the notifications has effect.
- (7) Article 39, paragraphs (6) and (7) apply mutatis mutandis to the cases prescribed in paragraphs (2), (3) and (6).

(Provisional Exclusive Licenses)

Article 34-2 (1) A person that has the right to the grant of a patent may establish a provisional exclusive license with regard to the patent right to be obtained based on the right to the grant of a patent within the scope of the matters indicated in the description, claims or drawings originally attached to the written application.

- (2) If a patent right is registered in connection with a patent application to which a provisional exclusive license is linked, an exclusive license to the patent is

deemed to be established for the patent right within the scope specified by the act of establishing the provisional exclusive license.

- (3) A provisional exclusive license may be transferred only if the business involving the working of the invention under the patent application is also transferred, the consent of a person with the right to the grant of a patent or as a result of general succession including inheritance.
- (4) A provisional exclusive licensee may only grant a provisional non-exclusive license under the exclusive license to be obtained based on the provisional exclusive license to a third party only if the consent of a person that has the right to the grant of a patent is obtained.
- (5) If a patent application to which a provisional exclusive license is linked is divided pursuant to Article 44, paragraph (1), the provisional exclusive license is deemed to have been established with regard to the patent right to be obtained based on the right to the grant of a patent to which a new patent application resulting from the division of the patent application to the extent permitted by the act establishing the provisional exclusive license; provided, however, that this does not apply when otherwise provided by the act of establishment.
- (6) A provisional exclusive license is forfeited if the patent right is registered in connection with the patent application, if the patent application is waived, withdrawn or dismissed, or when the examiner's decision or decision on a trial or appeal rejecting the patent application becomes final and binding.
- (7) If there is a provisional non-exclusive licensee under paragraph (4) or in the main clause of paragraph (7) of the following Article, the provisional exclusive licensee may waive the provisional exclusive license only if the consent of the provisional non-exclusive licensee is obtained.
- (8) Article 33, paragraphs (2) through (4) apply mutatis mutandis to a provisional exclusive license.

#### (Provisional Non-exclusive Licenses)

Article 34-3 (1) A person that has the right to the grant of a patent may grant another party a provisional non-exclusive license to the patent right is to be obtained based on the right to the grant of a patent within the scope of the matters indicated in the description, claims or drawings originally attached to the written patent application.

- (2) If the establishment of a patent right has been registered with regard to a patent application to which a provisional non-exclusive license under the preceding paragraph is linked, a non-exclusive license to the patent is deemed to be granted for the patent right to a person that has the provisional non-exclusive license to the extent permitted by the act establishing the provisional non-exclusive license.
- (3) If an exclusive license is deemed to have been established with regard to a



provisional exclusive license in respect of a provisional non-exclusive license under Article 34-2, paragraph (4) pursuant to Article 34-2, paragraph (2), with regard to the exclusive license, the non-exclusive license is deemed to have been granted to a person that has the provisional non-exclusive license to the extent permitted by the act establishing the provisional non-exclusive license.

- (4) A provisional non-exclusive license may be transferred only if the business involving the working of invention under the patent application is also transferred, the consent of a person that has the right to the grant of a patent (in the case of a provisional non-exclusive license on the exclusive license to be obtained based on the provisional exclusive license, a person that has the right to the grant of a patent and a provisional exclusive licensee) is obtained, or the transfer occurs as a result of general succession including inheritance.
- (5) If a priority claim under Article 41, paragraph (1) is made based on the invention described in the description, claims or drawings (if the earlier application is an application written in a foreign language under Article 36-2, paragraph (2), foreign-language documents provided in Article 36-2, paragraph (1)) originally attached to the written application for the earlier application as referred to in Article 41, paragraph (1) to which a provisional non-exclusive license under paragraph (1) or Article 34-2, paragraph (4), or Article 4-2, paragraph (1) of the Utility Model Act is linked, the provisional non-exclusive license is deemed to have been granted to a person that has the provisional non-exclusive license on the patent right to be obtained based on the right to the grant of a patent pertaining to the patent application containing the priority claim to the extent permitted by the act establishing the provisional non-exclusive license; provided, however, that this does not apply when otherwise provided by the act of establishment.
- (6) If a patent application to which a provisional non-exclusive license is linked is divided pursuant to Article 44, paragraph (1), a provisional non-exclusive license is deemed to have been granted to a person that has the provisional non-exclusive license for the patent right to be obtained based on the right to the grant of a patent under a new patent application resulting from the division of the patent application to the extent permitted by the act establishing the provisional non-exclusive license; provided, however, that this does not apply when otherwise provided by the act of establishment.
- (7) If the provisional exclusive license to a patent right that is to be obtained based on the right to the grant of a patent to which a new patent application as provided in Article 34-2, paragraph (5) pertains (hereinafter in this paragraph referred to as the "provisional exclusive license linked to the new patent application") is deemed to have been established pursuant to the main clause of Article 34-2, paragraph (5), a person with a provisional non-exclusive license under the exclusive license that was to be obtained based on the provisional

exclusive license to the patent that was to be obtained based on the right to the grant of the patent to which the original patent application with which that new patent application is connected pertains is deemed to have been granted, a provisional non-exclusive license under the provisional exclusive license linked to the new patent application, within the extent permitted by the act establishing the provisional non-exclusive license; provided, however, that this does not apply if otherwise specified by the act of establishment.

- (8) If an application is converted pursuant to Article 46, paragraph (1) with regard to an application for utility model registration to which a provisional non-exclusive license under Article 4-2, paragraph (1) of the Utility Model Act is linked, the provisional non-exclusive license is deemed to have been granted to a person that has the provisional non-exclusive license on a patent right to be obtained based on the right to the grant of a patent to which the patent application resulting from the conversion of the application to the extent permitted by the act establishing the provisional non-exclusive license; provided, however, that this does not apply when otherwise provided by the act of establishment.
- (9) If an application is converted pursuant to Article 46, paragraph (2) with regard to an application for design registration to which a provisional non-exclusive license under Article 5-2, paragraph (1) of the Design Act (Act No.125 of 1959) is linked, the provisional non-exclusive license is deemed to have been granted to a person that has the provisional non-exclusive license with regard to a patent right to be obtained based on the right to the grant of a patent to which the patent application resulting from the conversion of the application to the extent permitted by the act establishing the provisional non-exclusive license; provided, however, that this does not apply when otherwise provided by the act of establishment.
- (10) A provisional non-exclusive license is forfeited when the establishment of a patent right has been registered, the patent application has been waived, withdrawn or declined, or an examiner's decision or decision on a trial or appeal rejecting the patent application becomes final and binding.
- (11) Beyond the case provided for in the preceding paragraph, the provisional non-exclusive license under Article 34-2, paragraph (4) or the main clause of paragraph (7) is forfeited when the provisional exclusive license is forfeited.
- (12) Article 33, paragraphs (2) and (3) apply mutatis mutandis to a provisional non-exclusive license.

#### (Effect of Registration)

Article 34-4 (1) The establishment, transfer (excluding a transfer arising from general succession including inheritance), amendment, forfeiture (other than due to merger or under Article 34-2, paragraph (6)) or a restriction of disposition of a

provisional exclusive license has no effect unless it is registered.

- (2) Matters of general succession including inheritance as referred to in the preceding paragraph take place, must be notified to the Commissioner of the Japan Patent Office without delay.

(Assertion of Provisional Non-exclusive License)

Article 34-5 A provisional non-exclusive license has effect on any person that, after the grant thereof, has obtained the right to the grant of a patent pertaining to the provisional non-exclusive license, or a provisional exclusive license, or a provisional exclusive license on the right to the grant of a patent pertaining to the provisional non-exclusive license.

(Employee Inventions)

Article 35 (1) If an employee or officer (hereinafter referred to as an "employee, etc.") of an employer, corporation, or a national or local government (hereinafter referred to as an "employer, etc.") has obtained a patent for an invention which, by its nature, falls within the scope of the business of the employer, etc. and was achieved by an act categorized as a present or past duty of the employee, etc. performed for the employer, etc. (hereinafter referred to as "employee invention"), or if a successor to the right to the grant of a patent for the employee invention has obtained a patent therefor, the employer, etc. has a non-exclusive license on the patent right.

- (2) In the case of an invention by an employee, etc. other than an employee invention, any provisions in any agreement, employment regulation or any other stipulation providing in advance that the right to the grant of a patent is acquired by the employer, etc., that the patent rights for any invention made by an employee, etc. are vested in the employer, etc., or that a provisional exclusive license or exclusive license for the invention is established for the employer, etc., is null and void.
- (3) In the case of an employee invention by an employee, etc., when it is prescribed in any agreement, employment regulation or any other stipulation providing in advance that the right to the grant of a patent for any employee invention is vested in the employer, etc., the right to the grant of a patent belongs to the employer, etc. from its occurrence.
- (4) If an employee, etc. in accordance with any, employment regulation or any other stipulation, vests the right to the grant of a patent and the patent right for an employee invention in the employer, etc., or establishes an exclusive license therefor for the employer, etc., or if an exclusive license is deemed to have been established pursuant to Article 34-2, paragraph (2), and if the employee, etc., in accordance with any agreement, employment regulation or any other stipulation, establishes a provisional exclusive license therefor for the employer, etc., for an

employee invention, the employee, etc. has the right to receive a reasonable amount of money or other economic benefits (referred to as "reasonable benefits" in the next paragraph and paragraph (7)).

- (5) If the provisions of a contract, employment regulation or any other stipulation establish for reasonable benefits, providing reasonable benefits in accordance with those provisions must not be considered unreasonable in light of circumstances in which a negotiation between the employer, etc. and the employee, etc. has taken place in order to set standards for the determination of the reasonable benefits, the set standards have been disclosed, and the opinions of the employee, etc. on the determination of the content of the reasonable benefits have been received, and any other relevant circumstances.
- (6) In order to encourage inventions, the Minister of Economy, Trade and Industry is to establish guidelines on matters concerning circumstances, etc. to be considered under the preceding paragraph and publish them after hearing the opinion of the Industrial Structure Council.
- (7) If there are no provisions setting forth the reasonable benefits exists, or if it is found pursuant to paragraph (5) that the reasonable benefits to be granted in accordance with the relevant provisions are unreasonable, the content of the reasonable benefits to receive referred to in paragraph (4) must be set in compensation of the amount of profit to be gained by the employer, etc. from the invention, the burden and contribution of the employer, etc., and how the employer, etc. treats the employee, etc. and any other circumstances connected with the invention.

#### (Patent Applications)

Article 36 (1) A person seeking a patent must submit a written application to the Commissioner of the Japan Patent Office stating the following:

- (i) the name and domicile or residence of the applicant for the patent; and
  - (ii) the name and domicile or residence of the inventor.
- (2) A description, claims, required drawings, and abstract must be attached to the written application.
  - (3) The description referred to in the preceding paragraph must state the following:
    - (i) the title of the invention;
    - (ii) a brief explanation of the drawings; and
    - (iii) a detailed explanation of the invention.
  - (4) The statement of the detailed explanation of the invention referred to in item (iii) of the preceding paragraph must comply with each of the following items:
    - (i) as provided by Order of the Ministry of Economy, Trade and Industry, it is clear and sufficient to enable a person ordinarily skilled in the art of the invention to work the invention; and
    - (ii) if the person seeking the grant of a patent has knowledge of any invention

(meaning an invention as provided in Article 29, paragraph (1), item (iii), hereinafter the same applies in this item) that is connected to person's invention and that, as of the time the person files the patent application, has become a published, publicly-known invention appears and gives the whereabouts of other information on it.

- (5) In claims referred to in paragraph (2), the patent applicant must state all matters that the applicant finds to be necessary for defining the invention for which the patent is sought, separately for each claim. In this case, an invention specified by a statement in one claim may be the same invention specified by a statement in another claim.
- (6) The statement of the claims referred to in paragraph (2) must comply with each of the following items:
  - (i) the invention for which the patent is sought is stated in the detailed explanation of the invention;
  - (ii) the invention for which a patent is sought is clear;
  - (iii) the statement for each claim is concise; and
  - (iv) the statement is composed in accordance with an Order of the Ministry of Economy, Trade and Industry.
- (7) The abstract referred to in paragraph (2) must summarize the invention described in the description, claims or drawings, and state any other matters specified by Order of the Ministry of Economy, Trade and Industry.

Article 36-2 (1) A person seeking the grant of a patent may, in lieu of the description, claims, required drawings and abstract referred to in paragraph (2) of the preceding Article, attach to the written application a document in a foreign language provided by Order of the Ministry of Economy, Trade and Industry, stating matters required to be stated in the description or the claims under paragraphs (3) through (6) of the Article, and required drawings containing any descriptive text in the foreign language (hereinafter referred to as a "foreign-language document"), and a document in the foreign language stating matters required to be stated in the abstract pursuant to paragraph (7) of the Article (hereinafter referred to as "foreign-language abstract").

- (2) The applicant for a written patent application to which foreign-language documents and a foreign-language abstract are attached pursuant to the preceding paragraph (hereinafter referred to as an "application written in a foreign language") must submit to the Commissioner of the Japan Patent Office Japanese translations of the foreign-language documents and the foreign-language abstract within one year and four months from the date of filing of the patent application (in the case of a patent application containing a priority claim under Article 41, paragraph (1), the filing date of the earlier application provided for in the paragraph; in the case of a patent application containing a priority

claim under Article 43, paragraph (1), Article 43-2, paragraph (1) (including when applied mutatis mutandis pursuant to Article 43-3, paragraph (3)), or Article 43-3, paragraph (1) or (2), the filing date of the earliest application, the filing date of the patent application that is deemed to be the earliest application under Article 4.C(4) of the Paris Convention (meaning the Paris Convention for the Protection of Industrial Property of March 20, 1883, as revised in Brussels on December 14, 1900, Washington on June 2, 1911, The Hague on November 6, 1925, London on June 2, 1934, Lisbon on October 31, 1958, and Stockholm on July 14, 1967; the same applies hereinafter), or the filing date of the patent application that is recognized as the earliest application under Article 4.A(2) of the Paris Convention; and in the case of a patent application containing two or more priority claims under Article 41, paragraph (1), Article 43, paragraph (1), Article 43-2, paragraph (1) (including when applied mutatis mutandis pursuant to Article 43-3, paragraph (3)), or Article 43-3 paragraph (1) or (2), the earliest of the filing dates on which the priority claims are based; the same applies to Article 64, paragraph (1)); provided, however, that if the application written in a foreign language is a new patent application arising from the division of a patent application under Article 44, paragraph (1), or a patent application arising from the conversion of an application under Article 46, paragraph (1) or (2), or a patent application based on a utility model registration under Article 46-2, paragraph (1), the applicant may submit Japanese translations of the foreign-language documents and the foreign-language abstract even after the lapse of the time limit prescribed in the main clause, but only within two months following the division of the patent application, conversion of application, or filing of patent application based on a utility model registration.

- (3) When the translation of foreign-language documents and the foreign-language abstract provided in the preceding paragraph has not been submitted within the period prescribed in the main clause of the paragraph (the time limit prescribed in the proviso to the paragraph if the translation of foreign-language documents and the foreign-language abstract may be submitted pursuant to the proviso to the paragraph; hereinafter the same applies in this Article), the Commissioner of the Japan Patent Office must notify the applicant of the application written in a foreign language thereof.
- (4) A person that has received the notice provided in the preceding paragraph may submit the translation of foreign-language documents and the foreign-language abstract provided in paragraph (2) to the Commissioner of the Japan Patent Office only within the time limit provided by Order of the Ministry of Economy, Trade and Industry.
- (5) When a translation of foreign-language documents (excluding drawings) provided for in paragraph (2) are not submitted within the period prescribed in paragraph (4), the patent application is deemed to have been withdrawn upon

passage of the period prescribed in the main clause of the paragraph.

- (6) The applicant of a patent application that is deemed to have been withdrawn pursuant to the provisions of the preceding paragraph may submit translations of the foreign-language documents and the foreign-language abstract under paragraph (2) to the Commissioner of the Japan Patent Office pursuant to Order of the Ministry of Economy, Trade and Industry, only within the period provided by Order of the Ministry of Economy, Trade and Industry; provided, however, that this does not apply if the applicant is found to have intentionally failed to submit translations prescribed in the preceding paragraph within the time limit prescribed in paragraph (4).
- (7) The translation submitted under paragraph (4) or the preceding paragraph is deemed to have been submitted to the Commissioner of the Japan Patent Office at the time of passage of the period prescribed in the main clause of paragraph (2).
- (8) The translations of foreign-language documents provided in paragraph (2) are deemed to be the description, claims and drawings submitted with the written application pursuant to paragraph (2) of the preceding Article, and the translation of the foreign-language abstract provided for in paragraph (2) is deemed to be the abstract submitted with the written application pursuant to paragraph (2) of the preceding Article.

Article 37 Two or more inventions may be the subject of a single patent application in the same written application provided that these inventions are of a group of inventions recognized as fulfilling the requirements of unity of invention based on their technical relationship specified by Order of the Ministry of Economy, Trade and Industry.

(Joint Applications)

Article 38 If the right to the grant a patent is jointly owned, a patent application may only be filed by all the joint owners.

(Certification of Filing Date)

Article 38-2 (1) The Commissioner of the Japan Patent Office must certify the date on which a written application with regard to a patent application is submitted as the date of the filing of the patent application, except when the patent application falls under any of the following items:

- (i) it is found that the indication of requesting the grant of a patent is not clear;
- (ii) there is no statement of the name of the applicant or it is found that the statement of the name is not sufficiently clear to specify the applicant; or
- (iii) the description (in an application written in a foreign language, the matters to be stated in the description are stated in a foreign language provided by

Order of the Ministry of Economy, Trade and Industry referred to in Article 36-2, paragraph (1); hereinafter, the same applies in this Article) is not attached to the application (except when the patent application is filed by a method prescribed in paragraph (1) of the following Article).

- (2) If the patent application falls under any of the items of the preceding paragraph, the Commissioner of the Japan Patent Office must notify the person requesting the grant of a patent to the effect that the patent application may be supplemented.
- (3) A person that has received a notice provided under the preceding paragraph may supplement the patent application only within the period provided by Order of the Ministry of Economy, Trade and Industry.
- (4) If supplementing a patent application pursuant to the preceding paragraph, a document with respect to the supplement (hereinafter referred to as a "written supplement") must be submitted in accordance with an Order of the Ministry of Economy, Trade and Industry; provided, however, that if supplementing with regard to the description pursuant to the preceding paragraph, the description must be submitted at the same time as the submission of the written supplement.
- (5) If supplementing a patent application pursuant to paragraph (3), required drawings of Article 36, paragraph (2) may be submitted at the same time as the submission of the written supplement (in the case of a written application in a foreign language, required drawings which contain any descriptive text in a foreign language provided by Order of the Ministry of Economy, Trade and Industry under Article 36-2, paragraph (1); hereinafter the same applies in this Article).
- (6) If a patent application has been supplemented within the period under paragraph (3) by a person that has received a notice provided under paragraph (2), the patent application is deemed to have been filed at the time of submission of the written supplement. In this case, the Commissioner of the Japan Patent Office is to certify the date of filing of the patent application as the date on which the written supplement was submitted.
- (7) The description submitted pursuant to the proviso to paragraph (4) and the drawings submitted under paragraph (5) are deemed to have been submitted with the written application.
- (8) If a person that has received a notice provided in paragraph (2) does not supplement the patent application within the period under paragraph (3), the Commissioner of the Japan Patent Office may decline the patent application.
- (9) If a person seeking the grant of a patent undertakes the procedures to be undertaken by a person upon reception of the notice under paragraph (2) prior to receiving the notice, the procedures are deemed to be undertaken by the person by receiving the notice, unless otherwise provided for by Order of the Ministry of Economy, Trade and Industry.



(Patent Application by a Method for Claiming to Refer to an Earlier Patent Application)

- Article 38-3 (1) Except when filing a written application in a foreign language, a person requesting the grant of a patent may file a patent application by a method for claiming to refer to a patent application made by the person (including one made in a foreign country, hereinafter referred to as an "earlier patent application" in this Article) without attaching a specification or required drawings to the written application, notwithstanding Article 36, paragraph (2); provided, however, that this does not apply if the patent application falls under item (i) or (ii) of Article 38-2, paragraph (1).
- (2) A person filing a patent application by a method prescribed in the preceding paragraph must submit to the Commissioner of the Japan Patent Office a document stating that fact and matters provided by Order of the Ministry of Economy, Trade and Industry with regard to the earlier patent application, at the time of filing the patent application.
- (3) A person that has filed a patent application by the method prescribed in paragraph (1) must submit the description and required drawings to be submitted with the written application for the patent application, and a document provided by Order of the Ministry of Economy, Trade and Industry with regard to the earlier patent application referred to using the method prescribed in the paragraph within the period specified by Order of the Ministry of Economy, Trade and Industry.
- (4) If the matters stated in the description and drawings submitted pursuant to the preceding paragraph are not within the scope of the matters stated in the description, claims or drawings attached to the written application of the earlier patent application referred to using the method prescribed in paragraph (1) (if the earlier patent application was an application written in a foreign language, foreign-language documents; if the earlier patent application was filed in a foreign country, documents which were submitted at the time of filing the application and correspond to the description, claims or drawings), the patent application is deemed to have been filed at the time of submission of the description and drawings under the preceding paragraph, notwithstanding Article 38-2, paragraph (1).
- (5) The specification and drawings submitted pursuant to paragraph (3) are deemed to be submitted with the written application.
- (6) The preceding paragraphs of this Article do not apply to a new patent application arising from the division of a patent application under Article 44, paragraph (1), a patent application arising from the conversion of an application under Article 46, paragraph (1) or (2), or a patent application based on a utility model registration under Article 46-2, paragraph (1).

(Notice When a Part of the Description or Drawings Lacks a Statement)

- Article 38-4 (1) If determining the date of filing of a patent application, if the Commissioner of the Japan Patent Office finds that a part of the description or drawings (in the case of an application written in a foreign language, a document in a foreign language provided by Order of the Ministry of Economy, Trade and Industry stating matters required to be stated in the description specified by Article 36-2, paragraph (1), and required drawings which contain descriptive text in the foreign language; hereinafter the same applies in this article) attached to the written application lacks a statement, the commissioner must notify the applicant thereof.
- (2) A person that has received a notice provided under the preceding paragraph may supplement the description or drawings only within the period provided by Order of the Ministry of Economy, Trade and Industry.
- (3) If supplementing the specification or drawings pursuant to the preceding paragraph, a document with regard to the supplement (hereinafter referred to as a "written supplement of the description, etc." in this Article and Article 67(3)(vi).) must be submitted in accordance with an Order of the Ministry of Economy, Trade and Industry.
- (4) If a person that has received a notice provided under paragraph (1) supplements a patent application within the period provided in paragraph (2), notwithstanding Article 38-2, paragraph (1) or (6), the patent application is deemed to have been filed at the time of submitting the written supplement of the description, etc.; provided, however, that this does not apply if the supplement was made with regard to a patent application containing a priority claim under Article 41, paragraph (1), Article 43, paragraph (1), Article 43-2, paragraph (1) (including when applied mutatis mutandis pursuant to Article 43-3, paragraph (3)), or Article 43-3, paragraph (1) or (2) and the contents stated in the written supplement of the description, etc. submitted pursuant to the preceding paragraph are within the scope provided by Order of the Ministry of Economy, Trade and Industry.
- (5) If a patent application supplemented referred to in paragraph (2) falls under Article 38-2, paragraph (1), item (i) or (ii), and the relevant written supplement has been submitted after the submission of the written supplement of the description, etc. pursuant to paragraph (3), the patent application is deemed to have been filed at the time of submitting that relevant written supplement, notwithstanding the preceding paragraph.
- (6) The description or drawings supplemented pursuant to paragraph (2) are deemed to have been submitted with the written application.
- (7) A person that has supplemented a specification referred to in paragraph (2) may withdraw the written supplement of the description, etc. submitted pursuant to

paragraph (3) only within the period provided by Order of the Ministry of Economy, Trade and Industry.

- (8) If a written supplement of a description, etc. has been withdrawn under the preceding paragraph, the supplement is deemed to have not been made.
- (9) Article 38-2, paragraph (9) applies mutatis mutandis to the procedures made before receiving the notice under paragraph (1).
- (10) The preceding paragraphs of this article do not apply to a new patent application arising from the division of a patent application under Article 44, paragraph (1), a patent application arising from the conversion of an application under Article 46, paragraph (1) or (2), or a patent application based on a utility model registration under Article 46-2, paragraph (1).

(Waiver or Withdrawal of Patent Application)

Article 38-5 If there is a person that has a provisional exclusive license on a patent application and the applicant of the patent may only waive or withdraw the patent application with the consent of that person.

(Prior Application)

- Article 39 (1) If two or more patent applications claiming identical inventions are filed on different dates, only the applicant that filed the patent application on the earliest date may be granted a patent for the invention claimed.
- (2) If two or more patent applications claiming identical inventions are filed on the same date, only one applicant, selected by consultations between the applicants that filed the applications, may be granted a patent for the invention claimed. If no agreement is reached by consultations or consultations are unable to be held, none of the applicants may be granted a patent for the invention claimed.
  - (3) If the invention and the device claimed in applications for a patent and a utility model registration, respectively, are identical and the applications for a patent and a utility model registration are filed on different dates, the applicant for a patent may obtain a patent for the invention claimed, only if the application for a patent is filed prior to the application for a utility model registration.
  - (4) If the invention and the device claimed in applications for a patent and a utility model registration, respectively, are identical (excluding when an invention claimed in a patent application based on a utility model registration pursuant to Article 46-2, paragraph (1) (including a patent application that is deemed to have been filed at the time of filing of the relevant patent application Article 44, paragraph (2) (including as applied mutatis mutandis pursuant to Article 46, paragraph (6))) and a device in the utility model registration are identical) and the applications for the patent and a utility model registration are filed on the same date, only the applicants, selected by consultations between the applicants, may be granted a patent or a utility model registration. If no agreement is

reached by consultations or no consultations are able to be held, the applicant for a patent may not be granted a patent for the invention claimed.

- (5) If an application for a patent or a utility model registration has been waived, withdrawn or dismissed, or the examiner's decision or decision on a trial or appeal to the effect that a patent application is to be rejected has become final and binding, the application for a patent or a utility model registration is deemed never to have been filed, for the purpose of application of paragraphs (1) through (4); provided, however, that this does not apply if the examiner's decision or decision on the trial or appeal to the effect that the patent application is to be rejected has become final and binding on the basis that the second sentence of paragraph (2) or (4) is applicable to the patent application.
- (6) In the case of paragraph (2) or (4), the Commissioner of the Japan Patent Office must order the applicants to hold consultations specified referred to in paragraph (2) or (4) and to report the results thereof within a reasonable specified period of time.
- (7) If a notification under the preceding paragraph is not filed within the period specified pursuant to the paragraph, the Commissioner of the Japan Patent Office may deem that no agreement referred to in paragraph (2) or (4) not to have been reached.

#### Article 40 Deleted

##### (Priority Claim Based on a Patent Application)

Article 41 (1) A person seeking the grant of a patent may make a priority claim for an invention claimed in the patent application, based on an invention disclosed in the description or claims for a patent, or claims or drawings for a utility model registration (if the earlier application was an application written in a foreign language, in the foreign-language documents) originally attached to the written application for an earlier application filed for a patent or utility model registration which the person has the right to obtain (hereinafter referred to as "earlier application"), except in the following cases; provided, however, that if there is a person that has a provisional exclusive license on the earlier application, a priority claim may be made only if the consent of the person is obtained at the time of filing the patent:

- (i) the patent application is not filed within one year from the date of the filing of the earlier application (excluding if the person is not found to have intentionally failed to file the patent application within one year from the filing date of the earlier application and the patent application is filed pursuant to Order of the Ministry of Economy, Trade and Industry within the period provided by Order of the Ministry of Economy, Trade and Industry);
- (ii) the earlier application is a new patent application arising from the division of

a patent application under Article 44, paragraph (1), a patent application arising from the conversion of a patent application under Article 46, paragraph (1) or (2), a patent application based on a utility model registration under Article 46-2, paragraph (1), or a new utility model registration application arising from the division of a utility model registration application under Article 44, paragraph (1) of the Patent Act as applied mutatis mutandis pursuant to Article 11, paragraph (1) of the Utility Model Act or a utility model registration application arising from the conversion of a utility model registration application under Article 10, paragraph (1) or (2) of the Utility Model Act;

- (iii) at the time of the filing of the patent application, the earlier application has been waived, withdrawn or dismissed;
- (iv) at the time of the filing of the patent application, the examiner's decision or the decision on the trial or appeal for the earlier application has become final and binding; and
- (v) at the time of the filing of the patent application, the registration establishing a utility model right under Article 14, paragraph (2) of the Utility Model Act with respect to the earlier application has been effected.

(2) In applying Article 29, the main clause of Article 29-2, Article 30, paragraphs (1) and (2), Article 39, paragraphs (1) through (4), Article 69, paragraph (2), item (ii), Articles 72, 79, and 81, Article 82, paragraph (1), Article 104 (including as applied mutatis mutandis pursuant to Article 65, paragraph (6) (including as applied mutatis mutandis pursuant to Article 184-10, paragraph (2))) and Article 126, paragraph (7) (including as applied mutatis mutandis pursuant to Article 17-2, paragraph (6), Article 120-5, paragraph (9) and Article 134-2, paragraph (9)) of the Patent Act, Article 7, paragraph (3) and Article 17 of the Utility Model Act, Article 26, Article 31, paragraph (2) and Article 32, paragraph (2) of the Design Act, and Article 29, Article 33-2, paragraph (1) and Article 33-3, paragraph (1) of the Trademark Act (Act No. 127 of 1959) (including when those provisions are applied mutatis mutandis pursuant to Article 68, paragraph (3) of the Trademark Act (Act No. 127 of 1959)) to inventions claimed in a patent application containing a priority claim under the preceding paragraph, with regard to those that are indicated in the description or claims for a patent, or claims or drawings for a utility model registration (if the earlier application was an application written in a foreign language, foreign-language documents) originally attached to the written application for the earlier application on which the priority claim is based (if the earlier application contains a priority claim under paragraph (1) or Article 8, paragraph (1) of the Utility Model Act, or Article 43, paragraph (1), Article 43-2, paragraph (1) (including when applied mutatis mutandis pursuant to Article 43-3, paragraph (3)), or Article 43-3, paragraph (1) or (2) of the Patent Act (including when those provisions are applied mutatis mutandis pursuant to

Article 11, paragraph (1) of the Utility Model Act), this excludes any inventions indicated in any documents (limited to those equivalent to the description, claims for a patent or utility model registration, or drawings) submitted at the time of filing of the application on which the priority claim in the earlier application is based), the patent application containing a priority claim is deemed to have been filed at the time of filing of the earlier application.,

- (3) The earlier application is deemed to be published or to be published in the bulletin in which the utility model appears as the time that the relevant patent application is published in the gazette in which the patent appears or the relevant application is published, as regards the invention indicated in the description, claims or drawings (or, if this is an application written in a foreign language, in the foreign-language documents) originally attached to the written application for a patent application containing a priority claim under paragraph (1), if the invention is also indicated in the description or claims for a patent, or claims or drawings for a utility model registration (or, if the earlier application was an application written in a foreign language, in the foreign-language documents) originally attached to the written application for the earlier application on which the priority claim is based (or, if the earlier application contains a priority claim under paragraph (1) or Article 8, paragraph (1) of the Utility Model Act, or Article 43, paragraph (1), Article 43-2, paragraph (1) (including if applied mutatis mutandis pursuant to Article 43-3, paragraph (3)), or Article 43-3, paragraph (1) or (2) of the Patent Act (including if those provisions are applied mutatis mutandis pursuant to Article 11, paragraph (1) of the Utility Model Act), this excludes the inventions indicated in any documents (limited to those equivalent to the description or claims for a patent, or claims or drawings for a utility model registration) submitted at the time of the filing of the application on which the priority claim in the earlier application is based), and the main clause of Article 29-2 of the Patent Act and the main clause of Article 3-2 of the Utility Model Act apply.
- (4) A person requesting to make a priority claim under paragraph (1) must submit to the Commissioner of the Japan Patent Office a document stating that fact and an indication of the earlier application within the time limit provided by Order of the Ministry of Economy, Trade and Industry.

#### (Withdrawal of Earlier Application)

Article 42 (1) An earlier application on which a priority claim is based under Article 41, paragraph (1) is deemed to be withdrawn when the period provided by Order of the Ministry of Economy, Trade and Industry from the filing date of the earlier application has lapsed; provided, however, that this does not apply if the earlier application has been waived, withdrawn or dismissed, the examiner's decision or decision on the trial or appeal for the earlier application has become final and

binding, the registration establishing a utility model right under Article 14, paragraph (2) of the Utility Model Act with respect to the earlier application has been effected, or all priority claims based on the earlier application are withdrawn.

- (2) The applicant of a patent application containing a priority claim as under Article 41, paragraph (1) may not withdraw the priority claim after the period provided by Order of the Ministry of Economy, Trade and Industry from the passage of the filing date of the earlier application.
- (3) If a patent application containing a priority claim under Article 41, paragraph (1) is withdrawn within the period provided by Order of the Ministry of Economy, Trade and Industry from the filing date of the earlier application, the priority claim is deemed to be withdrawn at the same time.

(Priority Claim Procedures under the Paris Convention)

- Article 43 (1) A person desiring to take advantage of the priority of a patent application pursuant to Article 4.D(1) of the Paris Convention must submit a document to the Commissioner of the Japan Patent Office at same time as a patent application indicating this, and giving the name of country of the Paris Convention Union in which the application was first filed, deemed to have first been filed pursuant to C(4) of that Article, or found to have first been filed pursuant to A(2) of the Article, and stating the filing date of the application.
- (2) A person that has made a priority claim as under the preceding paragraph must submit a document to the Commissioner of the Japan Patent Office showing the filing date of the application and bearing the certification of the country of the Paris Convention Union in which the application was first made, or found to have been first made pursuant to Article 4.C(4) of the Paris Convention, or found to have first been made pursuant to A(2) of the Article, as well as certified copies of documents equivalent to the description, patent claims or utility model registration claims, and drawings submitted at the time of the filing of the application, or any bulletin or certificate giving the same type of details that published by the government of that country, within one year and four months from the earliest of the following dates:
    - (i) the first filing date; deemed to be the first filing date pursuant to Article 4.C(4) of the Paris Convention, or the date found to be first filing date pursuant to A(2) of the Article;
    - (ii) if the patent application contains a priority claim under Article 41, paragraph (1), the filing date of the application on which the priority claim is based; or
    - (iii) if the patent application contains other priority claims as under the preceding paragraph, paragraph (1) of the next Article (including when applied mutatis mutandis pursuant to Article 43-3, paragraph (3)), or Article 43-3, paragraph (1) or (2), the filing date of the application on which the priority claim is based.

- (3) A person that has made a priority claim as under paragraph (1) must submit to the Commissioner of the Japan Patent Office a document specifying the filing number of the application which was first filed, is deemed to have been first filed pursuant to Article 4.C(4) of the Paris Convention, or is recognized to have been first filed pursuant to A(2) of the Article, beyond the documents provided in the preceding paragraph; provided, however, that if the filing number is not possible for the person to learn that filing number prior to the submission of the documents provided for in the paragraph, a document specifying the reason therefor must be submitted in lieu of the document specifying the filing number, and the document specifying the filing number must be submitted without delay once the person comes to know that number.
- (4) If a person that has made a priority claim under paragraph (1) fails to submit the documents specified in paragraph (2) within the period provided therein, the priority claim is forfeited.
- (5) In applying of the preceding two paragraphs, the documents provided in paragraph (2) are deemed to be submitted in a case specified by Order of the Ministry of Economy, Trade and Industry, as one in which it is permissible for electronic or magnetic means (meaning an electronic means , a magnetic means ,or any other means that it is impossible to perceive through the human senses alone) to be used for exchanging the details given in the documents provided for in paragraph (2) through with a country of the Paris Convention Union or an international organization involved in industrial property rights, if the person claiming priority as under paragraph (1) submits to the Commissioner of the Japan Patent Office a document stating the filing number of the application and other matters specified by Order of the Ministry of Economy, Trade and Industry as necessary for exchanging the matters, within the provided for in paragraph (2),
- (6) If a document prescribed in paragraph (2) or a document prescribed in the preceding paragraph has not been submitted within the period prescribed in paragraph (2), the Commissioner of the Japan Patent Office must notify the person that has made the priority claim under paragraph (1) to that effect.
- (7) A person that has received a notice prescribed in the preceding paragraph may submit a document prescribed in paragraph (2) or a document prescribed in paragraph (5) to the Commissioner of the Japan Patent Office only within the period provided by Order of the Ministry of Economy, Trade and Industry.
- (8) If a person that has received a notice provided under paragraph (6) is unable to submit the documents provided in paragraph (2) or the document provided in paragraph (5) within the period provided under the preceding paragraph due to reasons beyond the person's control, notwithstanding the preceding paragraph, the person may submit to the Commissioner of the Japan Patent Office the documents within the period provided by Order of the Ministry of Economy,



Trade and Industry.

(9) If the documents prescribed in paragraph (2) or the document prescribed in paragraph (5) are submitted pursuant to paragraph (7) or the preceding paragraph, paragraph (4) does not apply.

(Priority Claims as under the Paris Convention)

Article 43-2 (1) With regard to a person that has been unable to file a patent application containing a priority claim within the period of priority pursuant to Article 4.C(1) of the Paris Convention (hereinafter referred to as the "period of priority"), despite requesting to make a priority claim pursuant to Article 4.D(1) of the Paris Convention regarding a patent application, if the person files the patent application pursuant to Order of the Ministry, Trade and Industry within the time limit provided by Order of the Ministry, Trade and Industry, the person may make a priority claim regarding the patent application under the Article, even after the lapse of the period of priority; provided, however, that this does not apply if the person is found to have intentionally failed to file the patent application within the period of priority.

(2) Article 43 applies mutatis mutandis when a priority claim is made pursuant to the preceding paragraph.

Article 43-3 (1) When a priority claim is based on a patent application filed by a person specified in the left-hand column of the following table in a country specified in the corresponding right-hand column, the priority claim regarding the patent application may be made in accordance with Article 4 of the Paris Convention.

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

- (2) The national of a country that is neither a country of the Paris Convention Union nor a member state of the World Trade Organization (limited to a country that allows Japanese nationals to make a priority claim under the same conditions as in Japan; hereinafter referred to as a "specified country" in this paragraph) may make a priority claim based on an application filed in that specified country, and a Japanese national, the national of a country of the Paris Convention Union, or the national of a member of the World Trade Organization may claim a priority for a patent application based on the application filed in a specified country, pursuant to Article 4 of the Paris Convention.
- (3) The preceding two Articles apply mutatis mutandis if a priority claim is made pursuant to the preceding two paragraphs.

(Division of Patent Applications)

Article 44 (1) An applicant for a patent may divide a patent application containing two or more inventions into one or more new patent application, but only in the following cases:

- (i) at the allowable time or within the allowable period for amendments of the description, claims or drawings attached to the written application;
- (ii) within 30 days from the date on which a certified copy of an examiner's decision to the effect that a patent is to be granted (excluding an examiner's decision to the effect that a patent is to be granted as under Article 51 as applied mutatis mutandis pursuant to Article 163, paragraph (3) and an examiner's decision to the effect that a patent is to be granted with regard to a patent application that has been subject to examination as provided in Article 160, paragraph (1)) is served; and
- (iii) within three months from the date on which a certified copy of an examiner's initial decision to the effect that the application is to be rejected has been served.
- (2) In the case referred to in the preceding paragraph, a new patent application is deemed to have been filed at the time of filing of the original patent application; provided, however, that this does not apply for the purpose of application of Article 29-2 of the Patent Act if the new patent application falls under another patent application provided for in the Article, application provided for in Article 3-2 of the Utility Model Act if the new patent application falls under a patent application provided in the Article, and application of Article 30, paragraph (3) of the Patent Act.
- (3) For the purpose of application of Article 43, paragraph (2) (including when applied mutatis mutandis pursuant to Article 43-2, paragraph (2) (including when applied mutatis mutandis pursuant to paragraph (3) of the preceding Article) and paragraph (3) of the preceding Article) when a new patent application is filed prescribed in paragraph (1), the phrase "within one year and

four months from the earliest of the following dates" in Article 43, paragraph (2) is replaced with "within one year and four months from the earliest of the following dates or three months from the filing date of the new patent application, whichever is later".

- (4) If a new patent application is filed as provided in paragraph (1), any statements or documents which have been submitted in relation to the original patent application and must be submitted in relation to the new patent application pursuant to Article 30, paragraph (3), Article 41, paragraph (4), or Article 43, paragraph (1) and (2) (including if the two paragraphs are applied mutatis mutandis pursuant to Article 43-2, paragraph (2) (including as applied mutatis mutandis pursuant to paragraph (3) of the preceding Article) and paragraph (3) of the preceding Article) are deemed to have been submitted to the Commissioner of the Japan Patent Office at the same time as the new patent application.
- (5) If the period prescribed in Article 108, paragraph (1) is extended pursuant to Article 4 or Article 108, paragraph (3), the 30-day period prescribed in paragraph (1), item (ii) is deemed to have been extended only by the length of that extension.
- (6) If the period prescribed in Article 121, paragraph (1) is extended pursuant to Article 4, the three-month period prescribed in paragraph (1), item (iii) is deemed to have been extended only by the length of that extension.
- (7) If the applicant for a new patent under paragraph (1) is unable to file the new patent application within the period prescribed in items (ii) and (iii) due to reasons beyond the applicant's control, notwithstanding the items, the applicant may file the new patent application within 14 days (if the applicant is an overseas resident, within two months) from the date on which the reasons ceased to be applicable, but not later than six months following the passage of the period.

#### Article 45 Deleted

(Conversion of Applications)

Article 46 (1) An applicant of a utility model registration may convert the application into a patent application; provided, however, that this does not apply after the passage of three years from the filing date of application for utility model registration.

- (2) An applicant of a design registration may convert the application into a patent application; provided, however, that this does not apply once three months have passed since the date on which the certified copy of the examiner's initial decision to the effect that the application for a design registration is to be rejected has been served or after the passage of three years from the filing date of application for design registration (excluding a period of a maximum of three months after the date on which the certified copy of the examiner's initial decision to the effect that the application for a design registration is to be rejected has been served).

- (3) If the period provided in Article 46, paragraph (1) of the Design Act is extended pursuant to Article 4 of the Patent Act as applied mutatis mutandis pursuant to Article 68, paragraph (1) of the Design Act, the three-month period prescribed in the proviso to the preceding paragraph is deemed to be extended only by the length of that extension.
- (4) If an application is converted as under paragraph (1) or (2), the original application is deemed to be withdrawn.
- (5) If a person that converts an application under paragraph (1) or paragraph (2) is unable to convert the application within the period prescribed in the proviso to paragraph (1) or within the period of three years prescribed in the proviso to paragraph (2) due to reasons beyond the person's control, notwithstanding the proviso to paragraph (1) or the proviso to paragraph (2), the person may convert the application within 14 days (if the person is an overseas resident, within two months) from the date on which the reasons ceased to be applicable, but not later than six months following the passage of the period of time prescribed in those provisions.
- (6) Article 44, paragraphs (2) through (4) apply mutatis mutandis to the case of conversion of an application under paragraph (1) or (2).

(Patent Applications Based on Utility Model Registration)

Article 46-2 (1) Except in the following cases, a person that holds a utility model right may file a patent application based on the person's own utility model registration pursuant to Order of the Ministry of Economy, Trade and Industry. To do so, the utility model right must be waived:

- (i) three years have lapsed from the filing date of the application for the utility model registration;
- (ii) a request the examiner's technical opinion as provided in Article 12, paragraph (1) of the Utility Model Act with respect to the application for a utility model registration to which the relevant utility model registration pertains or with respect to that utility model registration (in the following paragraph simply referred to as a "technical opinion about the utility model"), is filed by the applicant of the utility model registration or the utility model right holder;
- (iii) 30 days have passed since the date of receipt of an initial notice under Article 13, paragraph (2) of the Utility Model Act pertaining to a request for a utility model technical opinion on the application for the utility model registration, or on the utility model registration filed by a person that is neither the applicant of the utility model registration nor the utility model right holder; and
- (iv) the period of time initially designated pursuant to Article 39, paragraph (1) of the Utility Model Act for a utility model registration invalidation trial filed against the utility model registration as referred to in Article 37, paragraph (1)

of the Utility Model Act has expired.

- (2) A patent application under the preceding paragraph is deemed to have been filed at the time of filing of the application for the utility model registration, provided that matters stated in the description, claims or drawings attached to the written application for the patent application are within the scope of the matters stated in the description claims or drawings attached to the written application for the utility model registration application on which the patent application is based; provided, however, that this does not apply for the purpose of application of Article 29-2 of the Patent Act or Article 3-2 of the Utility Model Act if the patent application falls under another patent application under Article 29-2 of the Patent Act or a patent application under Article 3-2 of the Utility Model Act, respectively, or for the purpose of application of Article 30, paragraph (3), the proviso to 36-2, paragraph (2), and 48-3, paragraph (2).
- (3) If an applicant for a patent under paragraph (1) is unable to file an application for the patent within the period provided in item (i) or (iii) of paragraph (1) due to reasons beyond the applicant's control, notwithstanding those items, the applicant may file the patent application within 14 days (if the applicant is an overseas resident, within two months) from the date on which the reasons ceased to be applicable, but not later than six months following the passage of the time limits under those items.
- (4) If there is an exclusive licensee or a pledgee, or a non-exclusive licensee when Article 35, paragraph (1) of the Patent Act as applied pursuant to Article 11, paragraph (3) of the Utility Model Act, under Article 77, paragraph (4) of the Patent Act as applied pursuant to Article 18, paragraph (3) of the Utility Model Act, or under Article 19, paragraph (1) of the Utility Model Act is applicable, the holder of a utility model right may only file a patent application under paragraph (1), provided that the consent of the exclusive licensee, pledgee or non-exclusive licensee is obtained.
- (5) Article 44, paragraphs (3) and (4) apply mutatis mutandis when a patent application is filed under paragraph (1).

### **Chapter III Examinations**

(Examination by an Examiner)

Article 47 (1) The Commissioner of the Japan Patent Office must direct examiners to examine patent applications.

- (2) Qualifications for examiners are prescribed by Cabinet Order.

(Exclusion of Examiners)

Article 48 Article 139(excluding items (vi) and (vii)) shall apply mutatis mutandis to examiners.

(Examination of Patent Applications)

Article 48-2 The examination of a patent application is initiated after the filing of a request for examination.

(Request for Examination of Application)

Article 48-3 (1) Once a patent application is filed, any person may file with the Commissioner of the Japan Patent Office a request for the examination of the application within three years from the filing date thereof.

- (2) A request for examination may be filed even after the period referred to in the preceding paragraph has passed, if filed with respect to a new patent application arising from the division of a patent application under Article 44, paragraph (1), a patent application in question in the conversion of an application under Article 46, paragraphs (1) or (2), or a patent application based on a utility model registration under Article 46-2, paragraph (1), but only within 30 days after the relevant division or conversion of the patent application, or the filing of the patent application based on the utility model registration.
- (3) A request for the examination of application may not be withdrawn.
- (4) If a request for the examination of an application is not filed within the period in which it may be filed pursuant to paragraph (1), the patent application is deemed to be withdrawn.
- (5) The applicant of the patent application that is deemed to have been withdrawn pursuant to the preceding paragraph may file a request for examination pursuant to Order of the Ministry, Trade and Industry only within the period specified by Order of the Ministry, Trade and Industry; provided, however, that this does not apply if the applicant is found to have intentionally failed to file a request for the examination of the patent application within the period prescribed in paragraph (1).
- (6) The request for examination of application filed pursuant to the preceding paragraph is deemed to have been filed with the Commissioner of the Japan Patent Office at the time of passage of the period prescribed in paragraph (1).
- (7) Paragraph (3) applies mutatis mutandis if the request for examination of application has not been filed within the period prescribed in paragraph (2).
- (8) If a request for the examination of a patent application is filed pursuant to paragraph (5) (including as applied mutatis mutandis in the preceding paragraph; hereinafter the same applies in this paragraph) and the establishment of a patent right for the patent application is registered, if a person has been practicing the invention or preparing to working the invention in Japan in good faith after the fact that the patent application has been deemed to be withdrawn under paragraph (4) (including as applied mutatis mutandis in the preceding paragraph) is published in the patent gazette but before the fact that

the request for the examination of the patent application has been filed under paragraph (5) is published in the patent gazette, the person has a non-exclusive license on the patent right, only to the extent of the invention and the purpose of the business worked or prepared.

Article 48-4 To request an examination of an application, a person must submit a written request to the Commissioner of the Japan Patent Office stating the following:

- (i) the name and domicile or residence of the petitioner; and
- (ii) an identification of the patent application for which the examination is requested.

Article 48-5 (1) If a request for the examination of an application is filed prior to the publication of the application, the Commissioner of the Japan Patent Office must publish an indication of this in the patent gazette either at the time of publication of the application or thereafter without delay, and if a request for examination is filed after the publication of the application, the commissioner must publish this in the patent gazette thereafter without delay.

(2) If a request for the examination of an application is filed by a person other than the applicant for a patent, the Commissioner of the Japan Patent Office must notify the applicant thereof.

(Prioritized Examination)

Article 48-6 If the Commissioner of the Japan Patent Office that a person other than the applicant is working the invention claimed in a patent application in course of trade after the publication of the application, and it is necessary for the commissioner to do so, the commissioner may have an examiner prioritize the examination of that patent application over that of other patent applications.

(Notifying the Applicant with regard to Information about a published Publicly-known Invention)

Article 48-7 When an examiner finds that a patent application does not comply with the requirements prescribed in Article 36, paragraph (4), item (ii), the examiner may notify the applicant of the patent thereof and give the applicant an opportunity to submit a written opinion within a reasonable, specified period of time.

(Examiner's Decision of Rejection)

Article 49 The examiner must reach an examiner's decision to the effect that a patent application is to be rejected if the patent application falls under any of the following:

- (i) an amendment made to the description, claims or drawings attached to the written application of the patent application does not comply with the requirements prescribed in Article 17-2, paragraph (3) or (4);
- (ii) the invention claimed in the patent application is unpatentable, pursuant to Article 25, 29, 29-2, 32, or 38 or Article 39, paragraphs (1) through (4);
- (iii) the invention claimed in the patent application is unpatentable, pursuant to the provisions of any relevant treaty;
- (iv) the patent application does not comply with the requirements prescribed in Article 36, paragraph (4), item (i), Article 36, paragraph (6), or Article 37;
- (v) the applicant has been notified as under the preceding Article, but even after the amendment of the description or submission of the written opinion the patent application does not comply with the requirements prescribed in Article 36, paragraph (4), item (ii);
- (vi) the patent application is an application written in a foreign language, and matters stated in the description, claims or drawings attached to the written application are not within the scope of matters stated in foreign-language documents; or
- (vii) the applicant for the patent does not have the right to the grant of a patent for the invention claimed in the application.

(Notice of the Grounds for Rejection)

Article 50 Before reaching the decision to reject an application, an examiner must notify the applicant for the patent of the grounds therefor and give the applicant an opportunity to submit a written opinion within an adequate specified period of time; provided, however, that in cases as set forth in Article 17-2, paragraph (1), item (i) or (iii) (in the case set forth item (i), limited to when the examiner issues the notice under the following Article along with the notice of grounds for rejection), this does not apply if a ruling to dismiss as under Article 53, paragraph (1) is rendered.

(Notice to the Effect that Grounds for Rejection are the Same as in a Previous Notice)

Article 50-2 If an examiner intends to issue a notice of grounds for rejecting a patent application pursuant to the preceding Article, and these grounds for rejection are the same as the grounds for rejection in a notice under the preceding Article (including as applied mutatis mutandis pursuant to Article 159, paragraph (2) (including when applied mutatis mutandis pursuant to Article 174, paragraph (2)) and Article 163, paragraph (2)) that involves another patent application (but only if provisions of Article 44, paragraph (2) apply to either or both of the patent applications and they are deemed to have been filed simultaneously ) (other than notice of anything that the applicant filing that



patent application was not in position to know prior to the filing of a request for examination of the patent application), the examiner must also issue notice to that effect.

(Examiner's Decisions)

Article 51 If no grounds for rejection are found with regard to a patent application, the examiner must reach a decision to grant the patent.

(Formal Requirements for Examiner's Decisions)

Article 52 (1) An examiner's decision must be in writing and include the grounds therefor.

(2) Once an examiner's decision is rendered, the Commissioner of the Japan Patent Office must serve a certified copy of it on the patent applicant.

(Dismissal of Amendments)

Article 53 (1) In the case of Article 17-2, paragraph (1), item (i) or (iii) (in the case set forth in item (i), this is limited to if the examiner issues the notice under Article 50-2 along with the notice of grounds for rejection), if an amendment made to the description, claims or drawings attached to a written application is found not to comply with Article 17-2, paragraphs (3) through (6), prior to the service of the certified copy of the examiner's decision notifying to the effect that a patent is to be granted, the examiner must dismiss the amendment by a ruling.

(2) A ruling dismissing an amendment under the preceding paragraph must be made in writing and include the grounds therefor.

(3) A ruling dismissing an amendment under paragraph (1) may not be appealed; provided, however, that this does not apply in any trial occurs if an appeal against a rejection is filed.

(In Relation to Litigation)

Article 54 (1) If it is found to be necessary during an examination, the examination procedure may be suspended until a ruling or a trial decision on an opposition to a granted patent has become final and binding or until litigation proceedings are concluded.

(2) If an action is instituted or a motion for an order of provisional seizure or provisional disposition is filed, the court may, if it considers it necessary, suspend litigation proceedings until the examiner's decision becomes final and binding.

Articles 55 through 63 Deleted

### **Chapter III-2 Publication of Applications**

(Publication of Applications)

Article 64 (1) Once one year and six months have passed since the filing date of a patent application, the Commissioner of the Japan Patent Office must publish the patent application, unless the gazette in which the patent appears has already been published. The same applies when a request for the publication of a patent application as provided in paragraph (1) of the following Article is filed.

(2) The publication of a patent application is effected by stating the following matters in the patent gazette; provided, however, that this does not apply to the matters prescribed in items (iv) through (vi) if the Commissioner of the Japan Patent Office recognizes that public policy is likely to be injured by stating those matters in the patent gazette:

- (i) the name, and the domicile or residence of the applicant for the patent;
- (ii) the number and the filing date of the patent application;
- (iii) the name, and the domicile or residence of the inventor;
- (iv) the matters stated in the description, patent claims attached to the written application and the contents of the drawings attached to the application;
- (v) the matters stated in the abstract attached to the written application;
- (vi) in the case of an application written in a foreign language, the matters stated in the foreign-language documents and foreign-language abstract;
- (vii) the number and the date of publication of the patent application; and
- (viii) other necessary matters.

(3) If an indication in the abstract attached to the written application does not comply with Article 36, paragraph (7), or if the Commissioner of the Japan Patent Office finds it to be otherwise necessary, the commissioner may personally prepare matters and publish them in the patent gazette, in lieu of the matters indicated in the abstract as referred to in item (v) of the preceding paragraph.

(Request for the Publication of a Patent Application)

Article 64-2 (1) An applicant for a patent may file a request for the publication of the patent application with the Commissioner of the Japan Patent Office except in the following cases:

- (i) the patent application has already been published;
- (ii) the patent application contains a priority claim as under Article 43, paragraph (1), Article 43-2, paragraph (1) (including as applied mutatis mutandis pursuant to Article 43-3, paragraph (3)), or Article 43-3, paragraph (1) or (2), documents relating thereto prescribed in Article 43, paragraph (2) (including as applied mutatis mutandis pursuant to Article 43-2, paragraph (2) (including as applied mutatis mutandis pursuant to Article 43-3, paragraph (3))) and Article 43-3, paragraph (3)), and documents relating thereto prescribed in Article 43, paragraph (5) (including as applied mutatis mutandis pursuant to

Article 43-2, paragraph (2) (including as applied mutatis mutandis pursuant to Article 43-3, paragraph (3)) and 43-3, paragraph (3)) have not been submitted to the Commissioner of the Japan Patent Office; and

(iii) the patent application is an application written in a foreign language and translations of the foreign-language documents prescribed in Article 36-2, paragraph (2) have not been submitted to the Commissioner of the Japan Patent Office.

(2) A request for the publication of a patent application may not be withdrawn.

Article 64-3 To request the publication of a patent application, the patent applicant must submit a written request to the Commissioner of the Japan Patent Office stating the following:

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

(ii) an identification of the patent application subject to the request to publication.

(Effect of the Publication of Applications)

Article 65 (1) If the patent applicant issues a written warning giving the details of the invention in the patent application after that patent application is published, the applicant may file a claim for compensation against a person that works the invention in the course of trade after being so warned and prior to the registration of the patent right with a claim amount that corresponds to the amount of money, the applicant would be entitled to receive for the working of the invention if it were a patented invention. The same applies in respect of a claim against a person that knowingly and in the course of trade works an invention claimed in a published patent application, prior to the registration of the patent, even if no such warning is issued.

(2) The claim under the preceding paragraph may not be exercised until the patent is registered.

(3) If a provisional exclusive licensee or a provisional non-exclusive licensee works the invention in the patent application to the extent permitted by the act establishing a license, the applicant for the patent may not claim for compensation as prescribed in paragraph (1).

(4) The exercise of the right to claim compensation under paragraph (1) does not preclude the exercise of the patent right.

(5) If a patent application is waived, withdrawn or dismissed after the publication of the patent application; if the examiner's decision or a decision on the trial or appeal rejecting the patent application becomes final and binding; if the patent right is deemed never to have existed at all pursuant to Article 112, paragraph (6) (unless it is found that the patent right is deemed to have existed from the beginning pursuant to Article 112-2, paragraph (2)); if a revocation decision as

referred to in Article 114, paragraph (2) becomes final and binding; or, if with the exception of cases falling as referred to in the proviso to Article 125, a decision on an appeal to the effect that the patent is to be invalidated becomes final and binding, the right to claim referred to in paragraph (1) is deemed never to have arisen .

(6) Articles 101, 104 through 104-3, 105 through 105-2-12,, and 105-4 through 105-7, Article 168, paragraphs (3) through (6) of this Act, and Articles 719 and 724 (Torts) of the Civil Code (Act No. 89 of 1896) apply mutatis mutandis to the exercise of the right to claim compensation under paragraph (1). In this case, if a person having the right to make that claim learns of the fact that the invention claimed in the patent application is being worked and learns the identity of the person working the invention prior to the registration establishing a patent right, the phrase "by the victim or the victim's statutory agent within three years from the time when that person comes to know of the damages and the identity of the perpetrator" in Article 724(i) of the Civil Code is deemed to be replaced with "by the person entitled to make that claim within three years from the date the patent is registered".

#### **Chapter IV Patent Rights**

##### **Section 1 Patent Rights**

(Registration of Establishment of a Patent Right)

Article 66 (1) A patent right comes into effect be registered.

(2) A patent right is registered once all of the annual patent fees as under Article 107, paragraph (1) are paid for the first year to the third year or once an exemption or grace period is granted for the payment of the same.

(3) Once the registration referred to in the preceding paragraph is effected, the following matters must be published in the patent gazette; provided, however, that this does not apply to the matters set forth in paragraph (v) if the patent application has already been published:

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

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

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

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

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

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

(vii) other necessary matters.

(4) Article 64, paragraph (3) applies mutatis mutandis when the matters stated in the abstract which are referred to in Article 64, paragraph (3), item (v) are published in the patent gazette pursuant to the preceding paragraph.

(Patent Term)

Article 67 (1) The term of a patent right expires after a period of 20 years from the filing date of the patent application.

(2) The duration prescribed in the preceding paragraph may be extended upon the filing of an application to register an extension if the establishment of a patent right is registered on or after the date on which five years have passed since the date of filing of the patent application, or the date on which three years have passed since the date of filing of a request for examination of the application, whichever is later (hereinafter referred to as the base date).

(3) The period which may be extended pursuant to the preceding paragraph (hereinafter referred to as the extendible period) shall not exceed the period calculated by deducting a period equivalent to the total of the periods listed in the following items (excluding an overlapping period among these periods, if there is any) from a period equivalent to the period from the base date until the date of registration of establishment of the patent right:

(i) where a notice or order under the provisions of this Act (excluding Article 39(6) and Article 50), the Utility Model Act, or the Act on Special Provisions for Procedures related to Industrial Property Rights (Act No. 30 of 1990), or the provisions of orders under these laws (limited to a notice or order issued by the Commissioner of the Patent Office or the examiner) has been issued with regard to the patent application, and the procedure to be undertaken upon receiving the notice or order is undertaken: the period from the date on which the notice or order has been issued until the date on which the procedure is undertaken;

(ii) where the time limit for undertaking the procedure under the provisions of this Act or orders under this Act (hereinafter referred to as the Patent Act and orders in the following item, item (v) and item (x)) has been extended with regard to the patent application: the period from the date on which the time limit for undertaking the procedure has expired until the date on which the procedure is undertaken;

(iii) where the procedure under the provisions of the Patent Act and orders with regard to the patent application for which the time limit for undertaking the procedure is specified may be undertaken even after the expiration of the time limit by which the applicant should undertake the procedure pursuant to the provisions of the Patent Act and orders, and the procedure is undertaken: the period from the date on which the time limit for undertaking the procedure has expired until the day on which the procedure is undertaken;

- (iv) where a disposition or notice under the provisions of this Act or the Act on Special Provisions for Procedures related to Industrial Property Rights or the provisions of orders under these laws (referred to as the Patent Act and related laws and regulations in items (viii) and (ix)) is reserved with regard to the patent application due to the applicants request or any other act: the period from the date on which the request or any other act was made until the date on which the grounds for reserving the disposition or notice cease to exist;
- (v) where a decision to grant a reduction in or exemption from, or a deferment for payment of, the patent fees or other fees due to be paid under the provisions of the Patent Act and orders is made with regard to the patent application: the period from the date on which an application for the reduction or exemption, or deferment for payment was filed until the date on which the decision is made;
- (vi) where a written supplement of the description, etc. under Article 38-4(7) is withdrawn with regard to the patent application: the period from the date on which the written supplement of the description, etc. was submitted pursuant to paragraph (3) of the said Article until the day on which the written supplement of the description, etc. is withdrawn pursuant to paragraph (7) of the said Article;
- (vii) where an appeal against an examiners decision of refusal has been filed with regard to the patent application: the period specified in (a) to (c) below according to the categories set forth respectively therein:
  - (a) where an appeal decision to the effect that a patent is to be granted under Article 51 as applied mutatis mutandis pursuant to Article 159(3) (including the cases where applied mutatis mutandis pursuant to Article 174(2)) is made: the period from the date on which a certified copy of the examiners decision of refusal was served until the date on which a certified copy of the appeal decision is served;
  - (b) where an appeal decision to order further examination under Article 160(1) (including the cases where applied mutatis mutandis pursuant to Article 174(2)) is made: the period from the date on which a certified copy of the examiners decision of refusal was served until the date on which a certified copy of the appeal decision is served; and
  - (c) where an examiners decision to the effect that a patent is to be granted under Article 51 as applied mutatis mutandis pursuant to Article 163(3) is made: the period from the date on which a certified copy of the examiners decision of refusal was served until the date on which a certified copy of the examiners decision to the effect that a patent is to be granted is served;
- (viii) where a determination for a request for review filed under the provisions of the Administrative Complaint Review Act (Act No, 68 of 2014) has become final and binding with regard to a disposition under the Patent Act and related laws and regulations concerning the patent application: the period from the date of

filing of the request for review until the date on which a certified copy of the determination is served;

- (ix) where a judgment on an action filed under the provisions of the Administrative Case Litigation Act (Act No. 139 of 1962) has become final and binding with regard to a disposition under the Patent Act and related laws and regulations concerning the patent application: the period from the date of filing of the action until the date on which the judgment on the action becomes final and binding; and
  - (x) where the procedure under the provisions of the Patent Act and orders is suspended or terminated with regard to the patent application: the period during which the procedure has been suspended or terminated.
- (4) Where there is a period during which the patented invention is unable to be worked because approval prescribed by relevant Acts that are intended to ensure safety, etc. or any other disposition designated by Cabinet Order as requiring considerable time for its proper execution in light of its purpose, procedures, etc., is necessary to be obtained for the working of the patented invention, the duration prescribed in paragraph (1) (if it is extended pursuant to paragraph (2), including the period of extension; the same shall apply in the proviso to Article 67-5(3), Article 68-2, and Article 107(1)) may be extended, upon the filing an application to register an extension of the duration, by a period not exceeding 5 years.

#### (Registration of Patent Term Extension)

- Article 67-2 (1) A person filing an application to register an extension under paragraph (2) of the preceding Article must submit a written application to the Commissioner of the Japan Patent Office stating the following:
- (i) the name, and the domicile or residence of the applicant;
  - (ii) the patent number;
  - (iii) the period for which the extension is requested;
  - (iv) the number and the filing date of the patent application; and
  - (v) the date on which a request for examination of the application was filed.
- (2) The written application under the preceding paragraph shall be accompanied by documents stating the basis for the calculation of the period set forth in item (iii) of the said paragraph as provided by Ordinance of the Ministry of Economy, Trade and Industry.
- (3) The application to register an extension under paragraph (2) of the preceding Article shall be filed within the period of three months (if a person filing the application is unable to file the application within that period due to reasons beyond the persons control: within 14 days (in the case of an overseas resident, within two months) from the date on which the reasons ceased to be applicable (if the period exceeds nine months: within nine months)) from the date of

registration of establishment of the patent right; provided, however, that the application may not be filed after the passage of the period prescribed in paragraph (1) of the said Article.

- (4) Where a patent right is jointly owned, none of the joint owners may file an application to register an extension under paragraph (2) of the preceding Article unless jointly with all the other joint owners.
- (5) Where an application to register an extension under paragraph (2) of the preceding Article is filed, the duration prescribed in paragraph (1) of the said Article shall be deemed to have been extended; provided, however, that this shall not apply where the examiners decision to the effect that the application is to be refused has become final and binding or where the registration of extension under paragraph (3) of the following Article has been made.
- (6) Where an application to register an extension under paragraph (2) of the preceding Article is filed, matters listed in the items of paragraph (1) shall be published in the patent gazette.

Article 67-3(1) Where an application to register an extension under Article 67(2) falls under any of the following items, the examiner shall render an examiners decision to the effect that the application is to be refused:

- (i) where the establishment of the patent right has been registered before the base date;
  - (ii) the period for which the extension is requested exceeds the extendible period regarding the duration of the patent right;
  - (iii) where the person filing the application is not the patentee; and
  - (iv) where the application does not meet the requirements under paragraph (4) of the preceding Article.
- (2) Where no reasons for refusal are found for the application to register an extension under Article 67(2), the examiner shall render an examiners decision to the effect that the extension is to be registered.
  - (3) Where the examiners decision under the preceding paragraph is rendered, the extension shall be registered.
  - (4) Where the registration of extension under the preceding paragraph is made, the following matters shall be published in the patent gazette:
    - (i) the name and domicile or residence of the patentee;
    - (ii) the patent number;
    - (iii) the number and the filing date of the application to register an extension under Article 67(2);
    - (iv) the date of the registration of extension;
    - (v) the period of extension;



- (vi) the number and the filing date of the patent application; and
- (vii) the date on which a request for examination of the application was filed.

Article 67-4 Article 47(1), Article 50, Article 52 and Article 139(excluding item (vii)) shall apply mutatis mutandis to the examination of an application to register an extension under Article 67(2). In this case, the term which is being appealed in Article 139(vi) shall be deemed to be replaced with on the patent application regarding the patent right for which an application to register an extension under Article 67(2) is filed.

Article 67-5(1) A person(s) filing an application to register an extension under Article 67(4) shall submit an application to the Commissioner of the Patent Office stating the following:

- (i) the name, and the domicile or residence of the applicant;
  - (ii) the patent number;
  - (iii) the period for which the extension is requested (not exceeding 5 years); and
  - (iv) the details of the disposition designated by Cabinet Order as referred to in Article 67(4).
- (2) A written application as referred to in the preceding paragraph must be accompanied by materials specifying the grounds for the extension, pursuant to Order of the Ministry of Economy, Trade and Industry.
- (3) An application to register an extension under Article 67(4) must be filed within the period prescribed by Cabinet Order after the issuance of Cabinet Order-specified disposition as referred to in Article 67(4); provided, however, that the written application may not be filed after the passage of the term of patent prescribed in Article 67, paragraph (1).
- (4) Article 67-2(4) to (6) shall apply mutatis mutandis to an application to register an extension under Article 67(4). In this case, the term paragraph (3) of the following Article in the proviso to Article 67-2(5) shall be deemed to be replaced with Article 67-7(3), and the term items of paragraph (1) in Article 67-2(6) shall be deemed to be replaced with items of Article 67-5(1).

Article 67-6(1) Where the disposition designated by Cabinet Order under Article 67(4) is unlikely to be obtained prior to 6 months before the expiration of the duration under Article 67(1), a person filing an application to register an extension under Article 67(4) shall submit to the Commissioner of the Patent Office, on or before the time limit, a document stating the following:

- (i) the name, and domicile or residence of the person filing the application;
- (ii) the patent number; and
- (iii) the disposition designated by Cabinet Order as referred to in Article 67(4).

- (2) Unless the document required that must be submitted pursuant to the preceding paragraph is submitted, an application to register an extension under Article 67(4) may not be filed after six months or less before the expiration of the term of the patent right as prescribed in Article 67, paragraph (1).
- (3) Once the document as provided in paragraph (1) is submitted, the matters set forth in each item of the paragraph must be published in the patent gazette.
- (4) If a person that submits a document pursuant to paragraph (1) is unable to submit the document within the period provided in the paragraph due to reasons beyond the person's control, the person may submit the document within 14 days (if the person is an overseas resident, within one month) from the date on which the reasons ceased to be applicable, but not later than two months following the date prescribed in the paragraph, notwithstanding the provisions of the paragraph.

Article 67-7 (1) If an application to register an extension under Article 67(4) falls under any of the following items, the examiner must issue a decision to the effect that the application is to be rejected:

- (i) it is not found to be necessary to receive the disposition designated by Cabinet Order as referred to in Article 67, paragraph (4) for the working of the patented invention;
  - (ii) the patentee, or the person with the exclusive license or a non-exclusive license to the patent has not received the disposition designated by Cabinet Order as referred to in Article 67, paragraph (4);
  - (iii) the requested length of the extension exceeds the period during which it was not possible to work the patent invention;
  - (iv) the person filing the application is not the patentee; or
  - (v) the application does not meet the requirements stipulated in Article 67-2, paragraph (4), as applied mutatis mutandis pursuant to Article 67-5, paragraph (4).
- (2) If no grounds for rejection are found for the application to register an extension under Article 67(4), the examiner must reach a decision to the effect that the extension is to be registered.
  - (3) If an examiner's decision under the preceding paragraph is rendered, the extension shall be registered.
  - (4) Whenever a registration of extension as referred to in the preceding paragraph is made, the following matters must be published in the patent gazette:
    - (i) the name and the domicile or residence of the patentee;
    - (ii) the patent number;
    - (iii) the number and filing date of the application to register a patent term extension under Article 67(4);

- (iv) the date of the registration of the extension;
- (v) the length of the extension; and
- (vi) the contents of the disposition designated by Cabinet Order as referred to in Article 67(4).

Article 67-8 The first sentence of Article 67-4 shall apply mutatis mutandis to the examination of an application to register an extension under Article 67(4). In this case, the term item (vii) in the first sentence of Article 67-4 shall be deemed to be replaced with items (vi) and (vii).

(Effect of Patent Right)

Article 68 The patentee has an exclusive right to work the patented invention in the course of trade; provided, however, that if the patentee grants an exclusive license to the patent, this does not apply to the extent of the exclusive licensee's exclusive work the patented invention under the license.

(Effect of Patent Right in the Case of Term Extension under Article 67(4))

Article 68-2 Where the duration prescribed in Article 67(1) is extended under Article 67(4) (including the case where the duration is deemed to have been extended under the main clause of Article 67-2(5) as applied mutatis mutandis pursuant to Article 67-5(4)), such patent right shall not be effective against any act other than the working of the patented invention for the product which was the subject of the disposition designated by Cabinet Order under Article 67(4) which constituted the reason for the registration of extension (where the specific usage of the product is prescribed by the disposition, the product used for that usage).

(Limitations of Patent Right)

Article 69 (1) A patent right is not effective against the working of the patented invention for experimental or research purposes.

(2) A patent right is not effective against the following products:

- (i) vessels or aircraft merely passing through Japan, or machines, apparatus, equipment or other products used in them; and
- (ii) products present in Japan prior to the filing of the patent application.

(3) A patent right for a medical invention (medicine meaning a product used in the diagnosis, therapy, treatment or prevention of a human diseases; hereinafter the same applies in this paragraph) that is to be manufactured by two or more medicines being mixed together or for the invention of a process by which a medicine is manufactured by two or more medicines being mixed together has not effect against the act of preparation of a medicine as per a physician's or dentist's

prescription nor against medicine prepared as per a physicians or a dentist's prescription.

(Technical Scope of Patented Invention)

Article 70 (1) The technical scope of a patented invention must be determined based upon the statements in the claims attached to the written application.

(2) In the case referred to in the preceding paragraph, the meanings of terms used in the claims are to be interpreted in consideration of the statements in the description and drawings attached to the written application.

(3) In the case referred to in the preceding two paragraphs, statements in the abstract attached to the written application must not be taken into consideration.

Article 71 (1) A request may be made to the Japan Patent Office for an advisory opinion on the technical scope of a patented invention.

(2) If a request under the preceding paragraph is filed, the Commissioner of the Japan Patent Office must designate three administrative patent judges to provide an advisory opinion on the requested matter.

(3) Article 131, paragraph (1), the main clause of Article 131-2, paragraph (1), Article 132, paragraphs (1) and (2), Articles 133 and 133-2, Article 134, paragraphs (1), (3) and (4), Article 135, Article 136, paragraphs (1) and (2), Article 137, paragraph (2), Articles 138, 139 (excluding item (vi) and (vii)), 140 through 144, Article 144-2, paragraphs (1) and (3) through (5), Article 145, paragraphs (2) through (7), Article 146, Article 147, paragraphs (1) and (2), Article 150, paragraphs (1) through (5), Articles 151 through 154, Article 155, paragraph (1), Article 157, and Article 169, paragraphs (3), (4) and (6) apply mutatis mutandis to the advisory opinion referred to in paragraph (1). In this case, the term "decision on the trial or appeal" in Article 135 is deemed to be replaced with "ruling", the phrase "Trials and appeals, excluding those provided for in the preceding paragraph," in Article 145, paragraph (2) is deemed to be replaced with "Proceedings for advisory opinion", the term "open proceedings could disrupt the public policy" in the proviso to Article 145, paragraph (5) is deemed to be replaced with "if a chief administrative judge finds it necessary", the term "Article 147" in Article 151 is deemed to be replaced with "Article 147, paragraphs (1) and (2)", and the phrase "up until a decision on the trial or appeal becomes final and binding" in Article 155, paragraph (1) is deemed to be replaced with "up until the certified copy of the written advisory opinion is served".

(4) No appeal may be filed against a ruling under Article 135 to be applied mutatis mutandis following the deemed of terms pursuant to the preceding paragraph.

Article 71-2 (1) If the Commissioner of the Japan Patent Office is commissioned by the court for the provision of an expert opinion on the technical scope of a

patented invention, the commissioner must appoint three administrative judges and direct them to provide an expert opinion on the requested matter.

- (2) Article 36, paragraphs (1) and (2), Article 137, paragraph (2) and Article 138 apply mutatis mutandis to the commissioning of the provision of an expert opinion as referred to in the preceding paragraph.

#### (Relationship to Patented Inventions of Another Party)

Article 72 If a patented invention uses another person's patented invention, registered utility model, registered design or design similar thereto for which an application was filed prior to the date of filing of the patent application, or If the patent right is in conflict with another person's design right or trademark right for which an application was filed prior to the date of filing of the patent application, the patentee, exclusive licensee or non-exclusive licensee may not work the patented invention in the course of trade.

#### (Jointly-owned Patent Rights)

Article 73 (1) If a patent right is jointly owned, no joint owner may transfer or establish a right of pledge on the joint owner's own share without the consent of all the other joint owners.

- (2) If a patent right is jointly owned, unless otherwise agreed upon in a contract, each of the joint owners of the patent right may work the patented invention without the consent any other joint owner.
- (3) If a patent right is jointly owned, no joint owner may establish an exclusive license or grant a non-exclusive license on the patent right to any third party without the consent of all the other joint owners.

#### (Special Provisions on the Transfer of a Patent Right)

Article 74 (1) If a patent falls under the requirements prescribed in Article 123, paragraph (1), item (ii) (but only if the patent is obtained in violation of Article 38) or the requirements prescribed in item (vi) of that paragraph, the person that has the right to the grant of the patent for the invention pertaining to the patent may request that the patentee transfer the patent right as provided by Order of the Ministry of Economy, Trade and Industry.

- (2) If the transfer of a patent right is registered based on the request under the preceding paragraph, the patent right is deemed to have belonged to the person that has had this registered from the beginning. The same applies to the right to claim compensation under Article 65, paragraph (1) or Article 184-10, paragraph (1) for the invention so patented.
- (3) Paragraph (1) of the preceding Article does not apply when the share of a jointly owned patent right is transferred based on the request under paragraph (1).

## Article 75 Deleted

### (Forfeiture of a Patent Rights in Absence of an Heir)

Article 76 A patent right is forfeited when no person asserts the right to it as an heir within the period referred to in Article 958 of the Civil Code.

### (Exclusive Licenses)

Article 77 (1) The patentee may grant an exclusive license to the patent right.

- (2) The exclusive licensee has an exclusive right to work the patented invention in course of trade to the extent specified in the contract granting that license.
- (3) An exclusive license may be transferred only if the business linked to the working of the relevant invention is also transferred, with the consent of the patentee, or as a result of general succession including inheritance.
- (4) An exclusive licensee may establish a right of pledge or grant a non-exclusive license under that exclusive license to a third party only with the consent of the patentee.
- (5) Article 73 applies mutatis mutandis to exclusive license.

### (Non-exclusive licenses)

Article 78 (1) The patentee may grant another party a non-exclusive license to the patent right.

- (2) A non-exclusive licensee has a right to work the patented invention in the course of trade to the extent prescribed in this Act or specified in the contract granting the license.

### (Non-exclusive License Based on Prior Use)

Article 79 A person that, without knowing the details of the invention described in a patent application personally makes an identical invention or that learns of such an invention from a person that, without knowing the details of the invention described in a patent application, personally makes an identical invention; and that is engaging or preparing to engage in business that involves the working of the invention in Japan at the time of the patent application is filed, has a non-exclusive license under the patent right, but only within the extent of the invention that the person is working or preparing to work and within the purview of the business purpose.

### (Non-exclusive License based on the working of an Invention Prior to the Registration of Transfer of a Patent Right)

Article 79-2 If before the transfer of a patent right is registered, the person holding that patent at the time of its transfer is registered based on a request under Article 74, paragraph (1) or a person holding an exclusive license under the

patent right, or a non-exclusive license under the patent right, or under the exclusive license at the time of its transfer is registered based on a request pursuant to Article 74, paragraph (1) has been engaging or preparing to engage in business that involves the working of the invention in Japan, without that without knowing that the patent falls under the requirements prescribed in Article 123, paragraph (1), item (ii) (but only if the patent was obtained in violation of Article 38) or the requirements provided in item (vi) of the paragraph, the person has a non-exclusive license under the patent right only within the extent of the invention that the person has been working or preparing to work and within the purview of that business purpose.

- (2) The patentee has a right to receive reasonable compensation from a person that holds a non-exclusive licensee pursuant to the preceding paragraph.

(Non-exclusive License Based on the working of the Invention Prior to Registration of a Request for a Trial for Invalidation)

Article 80 (1) If, before a request for a trial for patent invalidation is registered, a person falling under any of the following items has been engaging or preparing to engaging in business that involves the working of an invention in Japan, without knowing that the patent falls under any of the items of Article 123, paragraph (1), that person has a non-exclusive license under the invalidated patent right or under the exclusive license existing that exists at the time of its invalidation, only within the extent of the invention that the person has been working or preparing to work and within the purview of that business purpose:

- (i) the original patentee, if one of the two or more patents granted for the same invention is invalidated;
- (ii) the original patentee, if, after a patent is invalidated, a patent is granted to the person that is entitled to obtain a patent for the same invention; or
- (iii) in the cases 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, has an exclusive license under the patent right to be invalidated, or a non-exclusive license under the patent right or exclusive license on the patent right.

- (2) The patentee or the exclusive licensee is entitled to receive reasonable compensation from the non-exclusive licensee pursuant to the preceding paragraph.

(Non-exclusive License after the Expiration of the Term of a Design Right)

Article 81 If a design right connected with an application for a design registration which is filed on or before the filing date of a patent application is in conflict with the patent right that the patent application is for, upon the passage of the term of the design right, the original holder of the design right has a non-exclusive license under the patent right or under the exclusive license that exists

at the time of the passage of the term of the design right, within the scope of the original design right.

Article 82 (1) If a design right connected with an application for a design registration which is filed on or before the filing date of a patent application is in conflict with the patent right that the patent application is for, once the term of the design right expires, any person that has an exclusive license on the design right, or a non-exclusive license on that design right or on an exclusive license on that design right at the time the term of the design right expires, has a non-exclusive license under the patent right or under any exclusive license that exists at the time the term of the design right expires, within the scope of the original right.

(2) The patentee or the exclusive licensee is entitled to receive reasonable compensation from a non-exclusive licensee pursuant to the preceding paragraph.

(Award Granting a Non-exclusive License if an Invention is not Worked)

Article 83 (1) If a patented invention has not been sufficiently and continuously worked for three years or longer in Japan, a person intending to work the patented invention may request the patentee or the exclusive licensee to hold discussions toward an agreement to grant the person a non-exclusive license; provided, however, that this does not apply unless four years have passed since the filing date of the patent application for the patented invention.

(2) If no agreement is reached by discussions or no discussions toward such an agreement are able to be held as referred to in the preceding paragraph, the person intending to work the patented invention may request the Commissioner of the Japan Patent Office to grant an award.

(Submission of a Written Answer)

Article 84 If a request for the award is filed as referred to in Article 83, paragraph (2), the Commissioner of the Japan Patent Office must serve a copy of the written request on the patentee or exclusive licensee that the request concerns, and any other person with a registered right under the patent, and give that person an opportunity to submit a written answer within a reasonable specified period of time.

(Statement of Opinions of Non-exclusive Licensees)

Article 84-2 If a request for the award is filed as referred to in Article 83, paragraph (2), a person with a non-exclusive license under the patent may state an opinion about the request for the award within the period providing for in the preceding Article.



(Hearing of Opinions of a Council)

Article 85 (1) Before rendering an award as referred to in Article 83, paragraph (2), the Commissioner of the Japan Patent Office must hear the opinions of the council or other body (meaning organs provided for in Article 8 of the National Government Organization Act (Act No. 120 of 1948)) that is provided for by Cabinet Order.

(2) If there is a justifiable reason that the patented invention has not been sufficiently worked, the Commissioner of the Japan Patent Office may not award a non-exclusive license.

(Formal Requirements for Awards)

Article 86 (1) The award referred to in Article 83, paragraph (2) must be rendered in writing and the reasons for that award must be given.

(2) The following matters must be determined in an award of a non-exclusive license:

- (i) the scope of the non-exclusive license being granted; and
- (ii) the amount of compensation, and the method and time for its payment thereof.

(Service of a Certified Copy of an Award)

Article 87 (1) Upon rendering an award as referred to in Article 83, paragraph (2), the Commissioner of the Japan Patent Office must serve a certified copy of the award on the parties, on non-parties with registered rights under the patent, and on non-exclusive licensee that have stated an opinions pursuant to Article 84-2.

(2) Once a certified copy of the award granting the non-exclusive license is served on the parties pursuant to the preceding paragraph, an agreement as prescribed in the award is deemed to have been reached between the parties.

(Deposit of Compensation)

Article 88 A person that is required to pay the compensation referred to in Article 86, paragraph (2), item (ii) must deposit that compensation in the following cases:

- (i) where the performance of consideration has been provided, and the person(s) entitled to the consideration refuses such consideration;
- (ii) where the person(s) entitled to the consideration is unable to receive such consideration;
- (iii) where an action with respect to the consideration is instituted under Article 183(1); or
- (iv) a right of pledge is established on the patent right or the exclusive license; provided, however, that this does not apply if the consent of the pledgee is obtained.

(Forfeiture of an Award)

Article 89 If a person seeking a non-exclusive license fails to pay or deposit compensation (or if the compensation is to be paid periodically or by installments, fails to pay the first installment) by the due date for payment fixed in the award referred to in Article 83, paragraph (2), the award to the effect that a non-exclusive license is to be granted loses its effect.

(Rescission of an Award)

Article 90 (1) If after the Commissioner of the Japan Patent Office awards a non-exclusive license pursuant to Article 83, paragraph (2), it becomes inappropriate to preserve the award because the grounds for the awarding it have ceased to exist or for any other reason, or the person that was granted the non-exclusive license does not sufficiently work the patented invention, the Commissioner may rescind that award upon the request of an interested person or by the commissioner's own authority.

(2) Articles 84 and 84-2, Article 85, paragraph (1), Article 86, paragraph (1), and Article 87, paragraph (1) apply mutatis mutandis to the rescission of an award as under the preceding paragraph and Article 85, paragraph (2) applies mutatis mutandis to the rescission of an award under the preceding paragraph when the person that was granted the non-exclusive license does not sufficiently work the patented invention.

Article 91 A non-exclusive license is forfeited if a ruling is rescinded as under Article 90, paragraph (1).

(Restriction on the Grounds for Objection to an Award)

Article 91-2 No request for review under the provisions of the Administrative Appeals Act in respect of an award under Article 83, paragraph (2) dissatisfaction with the compensation fixed in the award may not be used as grounds for protest.

(Award Granting a Person a Non-exclusive License to work That Person's Own Patented Invention)

Article 92 (1) If a patented invention falls under one of the cases provided for in Article 72, the patentee or exclusive licensee may request the other person that is referred to in that Article to hold discussions toward an agreement to grant the patentee or licensee a non-exclusive license to work that person's patented invention or to hold discussions toward an agreement to grant the patentee or licensee a non-exclusive license under the utility model right or the design right.

(2) The other person that is referred to in Article 72 if requested to hold discussions toward the agreement referred to in the preceding paragraph, may request the

- patentee or exclusive licensee that is requesting that person's agreement to hold discussions toward an agreement to grant the person a non-exclusive license within the scope of the patented invention that the patentee or exclusive licensee intend to work as a result of the person's agreement to grant a non-exclusive license under the relevant patent right, utility model right or design right.
- (3) If the agreement referred to in paragraph (1) is not reached or if discussions toward such an agreement cannot be held, the patentee or the exclusive licensee may file a request to be awarded a non-exclusive license by the Commissioner of the Japan Patent Office.
  - (4) If the agreement referred to in paragraph (2) is not reached or discussions toward such an agreement and a request for the award referred to in the preceding paragraph is filed, the other person that is referred to in Article 72 may file a request to be awarded a non-exclusive license by the Commissioner of the Japan Patent Office, but only within the period that the commissioner has designated for the person to submit a written answer, pursuant to Article 84 as applied *mutatis mutandis* pursuant to paragraph (7).
  - (5) In the case as referred to in paragraph (3) or (4), the Commissioner of the Japan Patent Office may not render an award granting a non-exclusive license if granting a non-exclusive license would be unreasonably prejudicial to interests of the other person that is referred to in Article 72, the patentee or the exclusive licensee.
  - (6) Other than in the case as prescribed in the preceding paragraph, if the Commissioner of the Japan Patent Office does not render an award granting a non-exclusive license pursuant to a request for the award referred to in paragraph (3), the commissioner may not render an award granting a non-exclusive license in a case as referred to in paragraph (4).
  - (7) Articles 84 and 84-2, Article 85, paragraph (1), and Articles 86 through the preceding Article apply *mutatis mutandis* to an award as referred to in paragraph (3) or (4).

(Award Granting a Non-exclusive License in the Public Interest)

- Article 93 (1) If the working of a patented invention is particularly necessary to the public interest, a person intending to work the patented invention may request the patentee or the exclusive licensee to hold discussions toward an agreement to grant the person a non-exclusive license.
- (2) If the agreement referred to in the preceding paragraph is not reached or if discussion toward such an agreement cannot be held, the person intending to work the patented invention may request the Minister of Economy, Trade and Industry to grant an award.
  - (3) Articles 84 and 84-2, Article 85, paragraph (1), and Articles 86 through 91-2 apply *mutatis mutandis* to the award referred to in the preceding paragraph.

(Transfer of a Non-exclusive License)

Article 94 (1) Except for a non-exclusive license granted by an award as referred to in Article 83, paragraph (2), Article 92, paragraph (3) or (4), or Article 93, paragraph (2) of the Patent Act, Article 22, paragraph (3) of the Utility Model Act, or Article 33, paragraph (3) of the Design Act, a non-exclusive license may be transferred only if business involving the working of the relevant invention is also transferred, the consent of the patentee (in the case of a non-exclusive license under exclusive license, the patentee and the exclusive licensee) is obtained, or as a result of general succession including inheritance.

(2) Except for a non-exclusive license granted by an award as referred to in Article 83, paragraph (2), Article 92, paragraph (3) or (4), or Article 93, paragraph (2) of the Patent Act, Article 22, paragraph (3) of the Utility Model Act, or Article 33, paragraph (3) of the Design Act, a non-exclusive licensee may establish a right of pledge on the non-exclusive right only when the consent of the patentee (or ,if it is a non-exclusive license under exclusive license, the patentee and the exclusive licensee) is obtained.

(3) A non-exclusive license under an award as referred to in Article 83, paragraph (2), or Article 93, paragraph (2) may be transferred only if the business linked to the working of the relevant invention is also transferred.

(4) A non-exclusive license under an award as referred to in Article 92, paragraph (3) of the Patent Act, Article 22, paragraph (3) of the Utility Model Act, or Article 33, paragraph (3) of the Design Act, is transferred if the patent right, utility model right or design right of the non-exclusive licensee under which the non-exclusive license is licensed is transferred together with the business linked to the working of the invention ; and is forfeited if the patent right utility model, or design right is transferred or forfeited independently of the business linked the working of the invention.

(5) A non-exclusive license under the award referred to in Article 92, paragraph (4) is transferred together with the patent right, utility model right or design right under which the non-exclusive licensee is licensed and is forfeited if the patent right, utility model right, or design right is forfeited.

(6) Article 73, paragraph (1) applies mutatis mutandis to a non-exclusive license.

(Right of Pledge)

Article 95 Unless otherwise stipulated by contract, if a right of pledge is established on a patent right, exclusive license or non-exclusive license, the pledgee may not work the patented invention.

Article 96 A right of pledge on a patent right, exclusive license or non-exclusive license may be exercised against any compensation to be paid for the patent

right, exclusive license or non-exclusive license or any money or goods to be received by the patentee or the exclusive licensee for the working of the patented invention; provided, however, that the pledgee must seize the compensation, money or goods prior to the payment of money or delivery of goods.

(Waiver of Patent Right)

Article 97 (1) If there is an exclusive licensee or a pledgee, the patentee may waive the patent right, only with the consent of those persons.

(2) If there is a pledgee, or a non-exclusive licensee provided in Article 77, paragraph (4), the exclusive licensee may waive the exclusive license, only if the consent of the pledgee or non-exclusive licensee is obtained.

(3) If there is a pledgee, a non-exclusive licensee may waive the non-exclusive license, only if the consent of the pledgee is obtained.

(Effect of Registration)

Article 98 (1) The following matters must be registered to take effect:

- (i) the transfer of a patent (other than due to inheritance or other general succession), its modification under a trust, forfeiture due to waiver, or restriction on its disposal;
  - (ii) the grant, of an exclusive license, its transfer (other than due inheritance or other general succession), modification, forfeiture (other than due to merger or to forfeiture of the patent right), or a restriction on its disposal; and
  - (iii) the grant of a pledge on a patent or exclusive license, the transfer of such a pledge (other than due to inheritance or other general succession), its modification, forfeiture (other than due to merger or the extinguishment of the claim secured thereby), or a restriction on its disposal.
- (2) If general succession including inheritance as referred to in one of the items of preceding paragraph takes place, notification of this must be filed with the Commissioner of the Japan Patent Office without delay.

(Perfection of a Non-exclusive License)

Article 99 A non-exclusive license is valid against a person that subsequently acquires the patent or the exclusive licensee, or acquires an exclusive license under the patent right.

## **Section 2 Infringement of rights**

(Right to demand an Injunction)

Article 100 (1) A patentee or exclusive licensee may file a claim against a person that infringes or is likely to infringe the patent right or exclusive license for the cessation or prevention of the infringement.

(2) In filing the claim under the preceding paragraph, the patentee or exclusive licensee may demand measures necessary for the prevention of infringement, including the disposal of products constituting the act of infringement (if the patented invention is a process by which a product is produced, this includes articles produced through infringement; the same applies in Article 102, paragraph (1)) and the removal of equipment used to infringe.

(Acts Deemed to Constitute Infringement)

Article 101 The following acts are deemed to constitute infringement of a patent right or violation of an exclusive license:

- (i) if a patent is granted on an invention that is a product, producing, transferring, etc., importing or offering to transfer, etc. in course of trade, any article whose only use is to produce that product;
- (ii) if a patent is granted on an invention of a product, producing, transferring, etc., importing or offering for transfer, etc. in the course of trade, any article (excluding those widely distributed within Japan) that is used in the production of the product and is indispensable for the resolution of the problem by the invention, with knowledge that the invention is a patented invention and that the article is used for the working of the invention;
- (iii) if a patent is granted on an invention that is a product, possessing the product for the purpose of transferring, etc. or exporting it in the course of trade;
- (iv) if a patent is granted on an invention that is a process, acts of producing, transferring, etc., importing or offering for transfer, etc., in the course of trade any article whose only use is in that process; and
- (v) if a patent is granted on an invention that is a process, producing, transferring, etc., importing or offering for transfer, etc. in course of trade, any article (excluding those widely distributed within Japan) that is used in that process and is indispensable for the resolution of the problem by the invention, with knowledge that the invention is a patented invention and that the article is used in the working of the invention;
- (vi) if a patent is granted on an invention that is a process for producing a product, acts of possessing the product produced by that process for the purpose of transferring, etc. or exporting it in the course of trade.

(Presumption of the Value of Damage)

Article 102(1) Where a patentee or an exclusive licensee claims against an infringer compensation for damage sustained as a result of the intentional or negligent infringement of the patent right or exclusive license, and the infringer assigned articles that constitute the act of infringement, the amount of damages sustained by the patentee or the exclusive licensee may be presumed to be the total of the

amounts written in each of the following items.

- (i) the amount of profit per unit of the product(s) which would have been sold by the patentee or the exclusive licensee if there had been no such act of infringement, multiplied by the portion not exceeding the quantity (if there are circumstances due to which the patentee or the exclusive licensee would have been unable to sell the quantity of products equivalent to all or part of the portion, the quantity due to such circumstances (referred to as specified quantity in the next item) shall be deducted) proportionate to the ability of the patentee or the exclusive licensee to work the products (referred to as working equivalent quantity in the same item) within the quantity of products assigned by the infringer who has committed the infringement of the patent right or exclusive license (referred to in the next item as assigned quantity) ;
  - (ii) the amount equivalent to the amount of money to be received for the working of the patented invention relating to the patent right or exclusive license according to the quantity in the case where there is a quantity that exceeds the working equivalent quantity within the assigned quantity, or a specified quantity (except in the case where it is not recognized that the patentee or the exclusive licensee would have been able to establish the exclusive license or grant a non-exclusive license on the patent right of the patentee, or grant a non-exclusive license on the exclusive license of the exclusive licensee).
- (2) If a patentee or exclusive licensee claims compensation for damages that the patentee or licensee personally incurs due to infringement, against a person that, intentionally or due to negligence, infringes the patent or violates the exclusive license, and the infringer has made a profit from the infringement, the amount of that profit is presumed to be the value of damages incurred by the patentee or exclusive licensee.
  - (3) The patentee or exclusive licensee may fix the value of the damages that the patentee or licensee has personally incurred as being equivalent to the amount of money the patentee or exclusive licensee would have been entitled to receive for the working of the patented invention, and may claim compensation for this against a person that, intentionally or due to negligence, infringes the patent or violates the exclusive license.
  - (4) When a court determines the amount equivalent to the amount of money to be received for the working of the patented invention provided in paragraph (1) item (ii) and the preceding paragraph, the court may take into consideration compensation which the patentee or the exclusive licensee would obtain if the patentee or the exclusive licensee agreed on the compensation of the working of the patented invention relating to the patent right or the exclusive license with the infringer on the premise that the patent right or exclusive license had been infringed.
  - (5) The paragraph (3) shall do not preclude any claim to compensation for damages

in excess of the amount provided for therein. In this case, the court may consider the absence intent or gross negligence, by the person that has infringed the patent or violated the exclusive license in fixing the amount of damages.

(Presumption of Negligence)

Article 103 A person that infringes another person's patent or violates another person's exclusive license is presumed to be negligent in having infringed or violated it.

(Presumption of Production Process)

Article 104 If a patent is granted on an invention that is a process for producing a product and the product was not publicly known in Japan prior to the filing of the patent application, any article identical to that product is presumed to have been produced using the patented process.

(Obligation to Clarify Specific Circumstances)

Article 104-2 In litigation involving the infringement of a patent or violation of an exclusive license, if the adverse party denies the specific circumstances of the thing that the patentee or exclusive licensee asserts to be the infringing article or process, the adverse party must clarify the specific circumstances of the adverse party's own action; provided, however, that this does not apply if there are reasonable grounds for the adverse party not being able to clarify these.

(Restriction on Exercise of Rights by the Patentee)

Article 104-3 (1) If it is found, in litigation involving the infringement of a patent right or the violation an exclusive license, that the patent should be invalidated through a trial for patent invalidation or that the registration of patent term extension should be invalidated through a trial for invalidation concerning the registration of a patent term extension, the rights of the patentee or exclusive licensee may not be exercised against the adverse party.

(2) If an allegation or evidence as under the preceding paragraph is found to have been submitted for the purpose of unreasonably delaying the proceedings, the court upon a motion or by its own authority, may rule to dismiss it.

(3) Article 123, paragraph (2) does not preclude a person other than a person that may file a request for a trial for patent invalidation on the patented invention from submitting a method of allegation or evidence under paragraph (1).

(Limitation on Assertions)

Article 104-4 (1) If one of the following ruling or decision on a trial or appeal has become final and binding after a final judgment becomes final and binding in litigation involving the infringement of a patent right ,the violation of an



exclusive license, or a claim for the payment of compensation as provided in Article 65, paragraph (1) or Article 184-10, paragraph (1), a person that was a party to the litigation may not assert that the trial or appeal in respect to the final judgment (including in any action claiming compensation for damages against the obligee in the case involving a provisional seizure order in which the litigation is the principal matter at issue, or in any action claiming compensation for damages and the restitution for unjust enrichment against an obligee in a case involving a provisional disposition order in which that litigation is the principal matter issue):

- (i) a ruling to the effect that the patent is to be revoked or a decision on the trial or appeal to the effect that the patent is to be invalidated;
- (ii) a decision on the trial or appeal invalidating the registration of the patent term extension;
- (iii) a ruling or a decision on the trial or appeal as provided by Cabinet Order correcting the description claims or drawings attached to the written application for the grant of a patent.

(Submission of Documents)

Article 105 (1) In litigation involving the infringement of a patent or the violation of an exclusive license, the court, at the motion of a party, may order a party to submit documents that are needed to prove the infringement or to calculate the damages caused by the infringement; provided, however, that this does not apply if the person in possession of the document has a legitimate reason for refusing to submit them.

(2) When the court finds it necessary for determining whether or not the documents concerning the motion under the main clause of the preceding paragraph fall within the scope of documents referred to in the main clause of the said paragraph or whether or not there are reasonable grounds as provided in the proviso to the preceding paragraph, the court may cause the person possessing the documents to present such documents. In such a case, no person may request the disclosure of the documents presented.

(3) In the case referred to in the preceding paragraph, when the court finds that it is necessary disclose a document referred to in the second sentence of the preceding paragraph and hear opinions as to whether or not the documents concerning the motion under the main clause of paragraph (1) fall within the scope of documents referred to in the main clause of the said paragraph or a party has a legitimate reason as provided in the proviso to the said paragraph,, the court may disclose the documents to the parties, etc. (meaning the parties (or,

if a party is a corporation, its agents)other parties' agents (other than litigation representatives and assistants in court), employees and other workers; the same applies hereinafter), their litigation representatives, or

- (4) In the case of paragraph (2), where the court deems it necessary to hear an explanation based on expert knowledge by disclosing the documents as provided in the latter sentence of paragraph (2), the court may disclose the documents to technical advisors (as provided in Part I, Chapter V, Section 2, Subsection 1 of the Code of Civil Procedure, and the same as 105-2-6(iv)) with the consent of the parties.
- (5) The preceding paragraphs apply mutatis mutandis to the presentation of the object of any inspection that is necessary for proving the relevant infringement in litigation involving the infringement of a patent or exclusive license.

(Order of investigation to the investigator)

Article 105-2(1) In a lawsuit relating to infringement of a patent right or exclusive license, the court may hear the other party's opinion and order investigators to investigate when it is deemed there is a sufficient reason to suspect the other party has infringed the patent right or exclusive license if it is deemed that it is necessary to collect evidence by making confirmations, taking actions, measurements, experiments, and other measures on documents, equipment, and other things (hereinafter referred to as documents, etc.) owned or managed by the other party and it is likely that the petitioners cannot collect such evidence or carry out any other measure by themselves to determine whether there are facts to be proven or not, upon the petition of the parties. However, this shall not apply when it is deemed inappropriate due to the time required to collect such evidence, the burden on the party to be investigated, or other reasons.

- (2) A petition for the investigation shall be conducted in writing specifying the following matters:
  - (i) the reason why there is sufficient reasoning to suspect the other party has infringed the patent right or the exclusive license;
  - (ii) matters that are necessary in order to specify documents, etc. that are subject to investigation, and the locations of said documents, etc.;
  - (iii) the relationship between the facts to be proven and the evidence obtained by these facts and the investigations;
  - (iv) reasons why petitioner cannot collect the evidence prescribed in the preceding item by the petitioner or by other means;
  - (v) measures pertaining to the permission and the necessity thereof when the permission of the court is intended to be granted as set forth in Article 105-2-4(2).
- (3) The court may cancel the order if it is deemed that it is not appropriate to

conduct an investigation for reasons set forth in the proviso of paragraph (1) after having made an order pursuant to the provisions in paragraph (1).

(4) An immediate appeal may be filed against a decision on the petition of an order of an investigation.

(Designation of investigator, etc.)

Article 105-2-2(1) Investigations shall be conducted by the investigator.

(2) The investigator shall be designated by the court.

(3) The court may order an enforcement officer to provide the necessary assistance for the investigator upon the petition of the parties when it is deemed necessary for a more efficient investigation.

(Challenge)

Article 105-2-3(1) Under the circumstances that prevent the investigator from investigating in good faith, the parties may challenge the investigation before the investigation is conducted by the investigator. Even if the investigation is carried out by the investigator, in the case where the cause of a challenge arises or the parties come to know the cause after the investigation, the same shall apply.

(2) The provisions of Articles 214(2) to (4) of the Code of Civil Procedure shall apply mutatis mutandis to the petition for any challenges under the preceding paragraph and the decision thereto. In this case the court of the suit, the authorized judge, or the commissioned judge in paragraph (2) of the same article shall be deemed to be replaced with as court.

(Investigation)

Article 105-2-4(1) When an order pursuant to the provision of Article 105-2(1) is issued, the investigator shall conduct an investigation, and create and submit to the court a report on the results (hereinafter referred to as the Investigation report).

(2) When the investigator conducts an investigation, the investigator may enter a factory, office or other place (referred to as factory, etc. in the next paragraph and the next article) belonging to the party being investigated to locate documents, etc. subject to the investigation, ask the party under investigation questions, or request the presentation of documents, etc., and additionally take measures, granted by the court as measures required for investigation, including the operation of equipment, measurement, experiments, and/or any other measures.

(3) The enforcement officer, upon providing the necessary assistance under Article 105-2-2(3), may enter the factory etc. belonging to the party under investigation to locate documents, etc. subject to the investigation, ask the party under

investigation questions, or request the presentation of documents, etc. in order to assist the investigator.

- (4) In the case that the preceding two paragraphs come into effect, the party under investigation shall fully cooperate with the investigator and the enforcement officer concerning matters related to the investigation as necessary.

(Consequences in cases where the party under investigation refuses entry into the factory etc.)

Article 105-2-5 When a party under investigation does not reply to questions, or approve the request from an investigator to enter a factory, etc., be presented with necessary documents, etc., or take measures granted by the court as measures required for the investigation including the operation of equipment, taking of measurements, and conduction of experiments, or any other applicable measures as per paragraph (2) of the preceding Article without a justifiable reason, the court may recognize the complainants claim related to the facts yet to be proven as true.

(Delivery of the copy of the Investigation report, etc.)

Article 105-2-6(1) Upon the submission of the Investigation report, the court shall deliver a copy to the party under investigation.

- (2) The party under investigation may petition to not have all or part of the Investigation report disclosed to the petitioner within two weeks from the date the party received a copy of the Investigation report.
- (3) In the case where the petition under the preceding paragraph has been filed, the court may decide not to disclose all or part of the Investigation report to the petitioner if it is deemed that there is a justifiable reason.
- (4) When it is deemed by the court that the disclosure of all or part of the Investigation report and a hearing to determine whether there is a justifiable reason as per the preceding paragraph is necessary, the court may disclose all or part of the Investigation report to the relevant parties, etc., attorneys, assistants or technical advisors. However, when disclosing all or part of the Investigation report to these parties, etc., assistants or technical advisors, the consent of the party under investigation must be obtained in advance.
- (5) An immediate appeal may be filed against the decision to dismiss the petition based on the provision in paragraph (2) and the decision not to disclose all or part of the Investigation report in paragraph (3).

(Inspection of the Investigation report, etc.)

Article 105-2-7(1) When no petitions are filed by the party under investigation within the period as per paragraph (2) of the preceding article, or when the court trial on the petition as per the same paragraph is finalized, the petitioner and the party under investigation can claim to the court clerk to inspect or copy the Investigation report, or deliver the original, copy or abstract thereof except in the case where it is decided not to disclose the entire report as per paragraph (3) of the same article (if it is decided that part of the report is not to be disclosed as per the same paragraph, the part concerned will be excluded).

(2) Except in the case outlined in the preceding paragraph, no one may request to inspect or copy the submitted Investigation report, or for the original, copy or abstract thereof to be issued or copied.

(3) The provisions of Article 91(4) and (5) of the Code of Civil Procedure shall apply mutatis mutandis to the Investigation report outlined in paragraph (1). In this case, the phrase the preceding paragraph in paragraph 4 of the same article shall be deemed to be replaced with the phrase Article 105-2-7(1) of the Patent Act, and parties or third parties who have provided prima facie evidence with regard to their interest shall be deemed to be replaced with the phrase the petitioner or the party under investigation.

(Investigators right to refuse testimony)

Article 105-2-8(1) When a person(s) who is/are or was/were the investigator(s) is/are interrogated as a witness(es) about matters concerning secrecy that has been acquired regarding the investigation, the person(s) may refuse testimony.

(2) The provision of Article 197(2) of the Civil Procedure Code shall apply mutatis mutandis to the case of the preceding paragraph.

(Travel expenses, etc. of the investigator)

Article 105-2-9 Travel expenses, daily allowances and lodging expenses related to the investigator, investigation fees and costs required for investigations are decided depending on the example of the provisions of the Act on Civil Procedure Costs (Act No. 40 of 1971) unless such provisions are contrary to the nature of said matters.

(Delegation to the Supreme Court Rules)

Article 105-2-10 In addition to what is provided in this Act, matters necessary for the implementation of the provisions in Article 105-2 to the preceding article shall be provided in the Supreme Court Rules.

(Opinions of Third Parties)

Article 105-2-11(1) If the court specified in each item of Article 6, paragraph (1) of

the Code of Civil Procedure, at the motion of a party, finds it to be necessary in the first instance of litigation involving the infringement of a patent right or violation of an exclusive license, the court may specify a reasonable period and seek from the general public the submission of documents stating their opinions regarding the application of this Act or regarding any other necessary matters relating to the case, after hearing the other party's opinion.

(2) If an appeal is filed with the Tokyo High Court against a final judgment on the litigation involving the infringement of a patent right or violation of an exclusive license which has been made by the court set forth in each item of Article 6, paragraph (1) of the Code of Civil Procedure as the court of prior instance, and the Tokyo High Court, at the motion of a party, finds it to be necessary in the litigation to which the appeal pertains, the Tokyo District Court may specify a reasonable period and seek from the general public the submission of documents stating their opinions regarding the application of this Act or regarding any other necessary matters relating to the case, after hearing the other party's opinion.

(3) A party may file a request with the court clerk to inspect or copy the documents submitted pursuant to the preceding two paragraphs, or to be issued an authenticated copy, transcript, or extract thereof.

(4) Article 91, paragraph (5) of the Code of Civil Procedure shall apply mutatis mutandis to the inspection and copying of documents submitted pursuant to paragraphs (1) and (2).

(Expert Opinion for Calculation of Damages)

Article 105-2-12 In litigation involving the infringement of a patent right or violation of exclusive license, if the court, at the motion of a party, orders an expert opinion in order to calculate the damages from the act of infringement , the parties must explain to the expert witness the details need to be explained in order for the expert witness to give an expert opinion.

(Approval of Reasonable Amount as the Value of Damages)

Article 105-3 If, in litigation involving the infringement of a patent right or violation of an exclusive license, damages are found to have been incurred but, due to the nature of the facts, it is extremely difficult to prove the facts that need to be proved in order to prove the value of damages, the court may approve a reasonable amount as the value of damages, based on the overall import of oral arguments and the results of the examination of evidence.

(Confidentiality Protective Orders)

Article 105-4 (1) In litigation involving the infringement of a patent or violation of an exclusive license, if a prima-facie showing is made that a proprietary trade secrets (meaning a trade secrets provided in Article 2, paragraph (6) of the Unfair Competition Prevention Act (Act No. 47 of 1993); the same applies hereinafter) of the party in question falls under both of the following circumstances, the court at motion of the party, may issue a ruling ordering the relevant parties, etc., litigation representative, and assistants in court use the trade secrets for any purpose other than conducting the litigation in question, and not to disclose the trade secrets to any person other than those one that is subject to an order as under this paragraph in respect of that trade secret; provided, however, that this does not apply if a party, etc., litigation representative, or assistants in court acquires or gains , possession of the trade secrets before that motion is filed, by means other than perusal of the brief provided for in item (i) or the examination or disclosure of evidence as provided in that item:

- (i) a proprietary trade secrets of the party is detailed in a brief that has already been submitted or that is to be submitted, or such a trade secret is included in evidence that has already been examined that is to be examined (including documents disclosed pursuant to Article 105, paragraph (3) , all or part of the Investigation report submitted under Article 105-2-4, paragraph (1), or documents disclosed under Article 105-7, paragraph (4)); and
  - (ii) the use of a trade secret as referred to in the preceding item for a purpose other than conducting the litigation in question or the disclosure of such a trade secret, would be likely to hinder the business activities of the party that are based on that trade secrets, and it is necessary to restrict their use or disclosure in order to prevent such hindrance.
- (2) A motion for an order as referred to in the preceding paragraph (hereinafter referred to as a "confidentiality protective order") must be made in writing specifying the following matters:
- (i) the persons that would be subject to the confidentiality protective order;
  - (ii) facts sufficient to identify the trade secret that would be protected by the confidentiality protective order; and
  - (iii) facts falling under the category of circumstances set forth in the items in the preceding paragraph.
- (3) If a confidentiality protective order is issued, the written ruling must be served to any persons that has become subject to the confidentiality protective order.
- (4) The confidentiality protective order is issued, the written ruling must be served on any persons, that has become subject to the confidentiality protective order.
- (5) An immediate appeal against a ruling may be filed against a judicial decision to dismiss a motion for confidentiality protective order.

(Vacating Confidentiality Protective Order)

- Article 105-5 (1) A person that files a motion for confidentiality protective order or that becomes subject to a confidentiality protective order may file a motion to vacate that confidentiality protective order with the court that has the case record of file (or, if no court has the case record on file, with the court issuing the confidentiality protective order) on the grounds that the requirements provided in Article 105-4, paragraph (1) have not been met or have come to no longer be met.
- (2) Once a judicial decision is reached on a motion to vacate a confidentiality protective order, the written ruling must be served on the person that filed the motion and on the adverse party.
- (3) An immediate appeal against a ruling may be filed against a judicial decision on a motion to vacate a confidentiality protective order.
- (4) A judicial decision to vacate a confidentiality protective order does not effect unless it becomes final and binding.
- (5) If the court reaches a judicial decision to vacate a confidentiality protective order and any person other than the person filing the motion to vacate the confidentiality protective order and the adverse party was subject to the confidentiality protective order on the trade secret in the litigation in which that confidentiality protective order was issued, the court must immediately notify that person that it has reached a judicial decision to vacate the confidentiality protective order.

(Notice of a Request to Inspect a Case Record)

- Article 105-6 (1) If the ruling referred to in Article 92, paragraph (1) of the Code of Civil Procedure has been issued with respect to the case record in litigation in which a confidentiality protective order has been issued (excluding litigation in which all confidentiality protective orders have been vacated) and a party not subject to a confidentiality protective order in that litigation files a request to inspect a part of the case record that holds the confidential information referred to in that Article, the court clerk, immediately after the request is filed, must notify the party that filed the motion referred to in that paragraph (restricting access to the record) that such a request has been filed (unless the person that filed that motion is also the person filing the request, the same applies in paragraph (3)).
- (2) In the case as referred to in the preceding paragraph, the court clerk must not allow the person filing the request to inspect, etc. the part of the case record that holds confidential information as referred to in Article 92, paragraph (1) of the Code of Civil Procedure until after two weeks have elapsed since the date that the request referred to in the confidentiality protective order (or, if during those two weeks, a motion for a confidentiality protective order is filed against the person that filed the request, the court clerk must not allow the filer to inspect that part of the case record before the judicial decision on the motion becomes final and



binding).

- (3) The preceding two paragraphs do not apply if all the parties concerned that have filed the motion referred to in Article 92, paragraph (1) of the Code of Civil Procedure agree to allow, the person filing request referred to in paragraph (1) to inspect, etc. the parts of the case record that hold confidential information.

(Suspension of Open Examination of Parties)

Article 105-7 (1) If a party, etc., to litigation involving the infringement of a patent right or violation of an exclusive license will be questioned as a direct party to the case, statutory agent or as a witness, with regard to matters that will form the basis for the determining whether or not the infringement or violation has occurred but that falls under the category of a proprietary trade secrets of a party, and if, with the unanimous accord of all judges, the court finds that the party, etc. will be unable to offer a sufficient statements about the matters due to the significant harm that would clearly befall those of the party, etc. ,the business activities that are based on the trade secrets as a result of the party, etc. offering a statement, about the matter in open court and that in the absence of such a statement and based on other evidence alone the court cannot reach a proper judicial decision as to whether the patent has determination of whether the exclusive license has been violated, since the court's determination of whether this has occurred needs to be based on the matter the court may rule not to conduct the questioning with regard to the matter in open court, and conduct that questioning in camera.

- (2) The court must hear the opinions of the parties, etc. before issuing the ruling referred to in the preceding paragraph.
- (3) In a case as referred to in the preceding paragraph, if the court finds it to be necessary, it may have a party, etc. present a document giving the gist of the matters with regard to which the party, etc. would offer a statement. In this case, no person may request the disclosure of a document so presented.
- (4) If the court finds it to be necessary to disclose a document as referred to in the second sentence of the preceding paragraph, so as to hear the opinion a party, etc., litigation representative, or assistant in court, the court may disclose the document to the person.
- (5) If questioning with regard to certain matters is to be held in camera pursuant to paragraph (1), the court must so declare and indicate its reasons for doing so prior to having the public leave the courtroom. Upon completion of questioning with regard to those matters, the court must allow the public to re-enter the courtroom.

(Measures to Restore Credibility)

Article 106 At the request of the patentee or exclusive licensee, the court may order

a person that has harmed the business credibility of the patentee or exclusive licensee by intentionally or negligently infringing upon the patent right or violating the exclusive license to take measures necessary to restore the business credibility of the patentee or exclusive licensee in lieu of or beyond compensation for damages.

### **Section 3 Patent Fees**

(Patent Fees)

Article 107 (1) The person that registers a patent right or a patentee must pay the amount specified by Cabinet Order not exceeding 61,600 yen plus the amount specified by Cabinet Order not exceeding 4,800 yen per claim, for each patent registration and in each year from the date of the patent registration to expiration of the term prescribed in Article 67, paragraph (1) (and, if the term is extended pursuant to Article 67, paragraph (4), in each year of the additional period):

(2) The preceding paragraph does not apply to patent rights belonging to the State.

(3) Notwithstanding the provisions of paragraph (1), if a patent right held under joint ownership with the State or a person entitled to receive a reduction in or exemption from patent fees as under Article 109 or Article 109-2 other laws and regulations (hereinafter referred to as a "reduction or exemption" in this paragraph), and the joint owner's shares have been agreed upon, the amount of the patent fee provided for in paragraph (1) is the sum total calculated by first multiplying, for each joint owner other than the State, the applicable patent fees provided for in paragraph (1) (for a person receiving a reduction or exemption, this means the patent fee provided for in that paragraph less that reduction or exemption) by the percentage that represents that person's share, and then adding together the amounts so arrived at, and this sum total is amount that the person other than the State must pay .

(4) For the amount of patent fees as calculated pursuant to the preceding paragraph, is not a multiple of ten yen, the amount of that patent fee is rounded down to the nearest multiple of ten yen.

(5) Payment for a patent fee referred to in paragraph (1) must be made with patent revenue stamps pursuant to Order of the Ministry of Economy, Trade and Industry; provided, however, that if so stipulated by Order of the Ministry of Economy, Trade and Industry, a cash payment may be made.

(Due date for the Payment of Patent Fees)

Article 108 (1) The patent fees for all years from the first to the third year as under

Article 107, paragraph (1) must be paid in a lump sum within 30 days after the date on which a certified copy of the examiner's decision or the decision on a trial or appeal to the effect that the patent is to be granted has been served.

- (2) The annual patent fee for each of the fourth and subsequent years as under Article 107, paragraph (1) must be paid by the end of the previous year; provided, however, that if the date of service of a certified copy of an examiner's decision or decision on the trial or appeal to register the extension of the term of patent right (hereinafter referred to in this paragraph as the "certified copy service date") is on or after the day that marks thirty days before the end of the year in which the term of the patent right will expire if the extension is not registered, the annual patent fees for each of the years from the year that follows this to the year in which the certified copy service date falls (or, if the time from the certified copy service date to the last day of the year in which the certified copy service date falls is shorter than 30 days, the year following the year in which the certified copy service date falls) must be paid in a lump sum within 30 days after the certified copy service date.
- (3) The Commissioner of the Japan Patent Office may extend the period prescribed in paragraph (1) by up to 30 days, at the request of a person that is to pay a patent fees.
- (4) If a person that pays patent fees, is unable to pay the patent fees within the period of time (when the period has been extended under the preceding paragraph, the period after being extended) provided in paragraph (1), due to reasons beyond the person's control, the person may pay the patent fees within 14 days (if the person is an overseas resident, within two months) from the date on which the reasons ceased to be applicable, but not later than six months following the passage of the period, notwithstanding paragraph (1).

#### (Reduction, Exemption or Deferment of Patent Fees)

Article 109 If the Commissioner of the Japan Patent Office finds that a person registering a patent right, or a patentee meeting the requirements that Cabinet Order specifies in consideration of financial resources, is having difficulty paying a patent fee, the commissioner pursuant to the provisions of Cabinet Order ,may reduce the annual patent fee, ,exempt the person from paying annual patent fees, or give the person a deferment for the payment of the patent fee that is to be paid pursuant to Article 107.

Article 109-2(1) The Commissioner of the Patent Office may, pursuant to the provisions of Cabinet Order, grant a person obtaining the registration establishing a patent right or a patentee who is a person specified by Cabinet Order, while comprehensively considering matters including the person's financial resources, ability to carry out research and development and technology

development, and degree of contribution to the development of industry, such as a small and medium-sized enterprise operator and an experiment and research institute, etc., a reduction of, exemption from, or deferment of the payment of the patent fee that is to be paid pursuant to Article 107(1).

- (2) The term small and medium-sized enterprise operator as used in the preceding paragraph means a person that falls under any of the following items:
- (i) a company having an amount of stated capital or total amount of capital contributions of not more than 300 million yen or a company or individual hiring not more than 300 full-time employees, where the principal business thereof is manufacturing, construction, transportation or any other type of business (excluding the types of business listed in the following item to item (iv) and the type of business specified by Cabinet Order under item (v));
  - (ii) a company having an amount of stated capital or total amount of capital contributions of not more than 100 million yen or a company or individual hiring not more than 100 full-time employees, where the principal business thereof is wholesale business (excluding the type of business specified by Cabinet Order under item (v));
  - (iii) a company having an amount of stated capital or total amount of capital contributions of not more than 50 million yen or a company or individual hiring not more than 100 full-time employees, where the principal business thereof is service business (excluding the type of business specified by Cabinet Order under item (v));
  - (iv) a company having an amount of stated capital or total amount of capital contributions of not more than 50 million yen or a company or individual hiring not more than 50 full-time employees, where the principal business thereof is retail business (excluding the type of business specified by Cabinet Order under item (v));
  - (v) a company having an amount of stated capital or total amount of capital contributions which does not exceed the amount specified by Cabinet Order for each type of business or a company or individual hiring a number of full-time employees which does not exceed the number specified by Cabinet Order for each type of business, where the principal business thereof is a business that falls under the type of business specified by Cabinet Order;
  - (vi) an enterprise cooperative;
  - (vii) a cooperative partnership;
  - (viii) an association incorporated under special laws and a federation of such associations, such as a business cooperative, small business cooperative, commercial and industrial partnership, and federation of cooperatives; and
  - (ix) a corporation engaging in specified non-profit activities (meaning a corporation engaging in specified non-profit activities provided in Article 2(2) of the Act on Promotion of Specified Non-profit Activities (Act No. 7 of 1998), which hires not

more than 300 full-time employees (or not more than 50 full-time employees in the case of a corporation engaging in the retail business as the principal business; or not more than 100 full-time employees in the case of a corporation engaging in the wholesale business or service business as the principal business).

(3) The term experiment and research institute, etc. as used in paragraph (1) means a person that falls under any of the following items:

- (i) an employee of a university provided in Article 1 of the School Education Act (Act No. 26 of 1947) (hereinafter referred to as a university in the following item), such as the president, a vice president, a dean, a professor, an associate professor, an assistant professor, a lecturer or an assistant, who exclusively engages in research, an employee of a college of technology provided in the said Article (referred to as a college of technology in the following item and item (iv)), such as the principal, a professor, an associate professor, an assistant professor, a lecturer or an assistant, who exclusively engages in research, or the head or an employee of an inter-university research institute provided in Article 2(3) of the National University Corporation Act (Act No. 112 of 2003) (referred to as an inter-university research institute in the following item), who exclusively engages in research;
- (ii) a person that establishes a university or college of technology, or an inter-university research institute;
- (iii) an approved TLO provided in Article 5(2) of the Act to Facilitate Technology Transfer from Universities to the Private Sector (Act No. 52 of 1998);
- (iv) an incorporated administrative agency (meaning an incorporated administrative agency provided in Article 2(1) of the Act on General Rules for Incorporated Administrative Agencies (Act No. 103 of 1999)) that carries out experiment and research activities (referred to as an experiment and research incorporated administrative agency in the following item), which is specified by Cabinet Order as not being one that establishes a college of technology;
- (v) a person that engages in the business wherein, with regard to research results related to technology achieved at a an experiment and research incorporated administrative agency that is specified by Cabinet Order (hereinafter referred to as a specified experiment and research incorporated administrative agency in this item), the person acquires a patent right or right to obtain a patent through assignment from the specified experiment and research incorporated administrative agency relating to the research results, and then transfers the research results to a private business seeking to make use of them, by carrying out an act such as assigning, or granting an exclusive license of, the patent right or a patent right obtained based on the right to obtain a patent;
- (vi) a public experiment and research institute (meaning an organization such as a laboratory and research institute established by a local government (excluding a public school provided in Article 2(2) of the School Education Act), which carries

- out experiment and research activities; and
- (vii) an experiment and research local incorporated administrative agency (meaning a local incorporated administrative agency (meaning a local administrative incorporated agency provided in Article 2(1) of the Local Incorporated Administrative Agency Act (Act No. 118 of 2003)), which does not fall within the category of public university corporation provided in Article 68(1) of the said Act and which carries out experiment and research activities).

(Payment of Patent Fees by a Person Other Than a Person that Is to Pay the Patent Fees)

- Article 110 (1) An interested person and other person than a person by whom are to be paid may pay a patent fee even against the will of the person that is to pay the patent fees.
- (2) A person that has paid the patent fees pursuant to the preceding paragraph may claim reimbursement of the expenses arising therefrom to the extent of the actual benefit obtained by the person that is required to pay the patent fees.

(Refunding of Patent Fees)

- Article 111 (1) The following patent fees are refunded upon the request of the person that paid them:
- (i) patent fees paid in error or in excess;
- (ii) annual patent fees for each year following the year in which a revocation decision under Article 114, paragraph (2) or a decision on a trial or appeal to invalidate the patent becomes final and binding; and
- (iii) annual patent fees for the year following the year in which a decision on a trial or appeal to the effect that the registration of patent term extension is to be invalidated became final and binding, and subsequent years (limited to those for the year following the year in which the term of a patent right would have expired if the extension had not been registered, and subsequent years).
- (2) A request for a refund of patent fees as under the preceding paragraph may not be filed once one year has passed since the date the patent fees referred to in item (i) of that paragraph were paid or once six months from the date on which a revocation decision referred to in Article 114, paragraph (2) or a decision on a trial or appeal became final and binding in the case of patent fees referred to in items (ii) and (iii) of that paragraph.
- (3) If a person that files a request for a refund of patent fees under paragraph (1) is unable to file the request within the period provided for in the paragraph, due to reasons beyond the person's control, the person may file the request within 14 days (if the person is an overseas resident, within two months) from the date on which the reasons ceased to be applicable, but not later than six months following the passage of the period, notwithstanding paragraph (1).

(Late Payment of Patent Fees)

- Article 112 (1) If a patentee is unable to pay a patent fee within the time frame provided for in Article 108, paragraph (2) or within the time frame for deferred payment as under Article 109 or Article 109-2, the patentee may make a late payment of the patent fees even after that time frame, if this is done within six months after the end of the relevant time frame.
- (2) A patentee making a late payment for the patent fees pursuant to the preceding paragraph must pay a patent surcharge in the same amount as a patent fee, beyond the patent fees to be paid pursuant to Article 107; provided, however, that if the patentee is unable to pay the patent fee within the time frame provided for in Article 108, paragraph (2) or within the time frame for deferred payment as under Article 109 or Article 109-2 due to reasons beyond the patentee's control, the patentee is not required to pay the patent surcharge.
- (3) Payment for the patent surcharge as referred to in the preceding paragraph must be made with patent revenue stamps pursuant to Order of the Ministry of Economy, Trade and Industry; provided, however, that if stipulated by Order of the Ministry of Economy, Trade and Industry, a cash payment thereof may be made.
- (4) If a patentee fails to pay patent fees that were due and payable within the time frame provided for in the main clause of Article 108, paragraph (2) and the patent surcharge that is to be paid pursuant to paragraph (2) within the time frame during which the patentee is permitted to make a late payment for patent fees pursuant to paragraph (1), the patent right is deemed to have been forfeited retroactively to the end of the time frame provided for in the main clause of Article 108, paragraph (2).
- (5) If a patentee fails to pay the patent fees provided for in the proviso to Article 108, paragraph (2) and the patent surcharge that is to be paid pursuant to paragraph (2), within the time frame during which the patent is permitted to make a late payment for patent fee pursuant to paragraph (1), the patent right is deemed to have been forfeited retroactive to the end of the year in which the term of the patent right would have expired if the extension had not been registered.
- (6) If a patentee fails to pay patent fees whose payment has been deferred pursuant to Article 109 or Article 109-2 and the patent surcharge that is to be paid pursuant to paragraph (2), within the time frame during which the patentee is permitted to make a late payment for patent fees pursuant to paragraph (1), the patent right is deemed never to have existed.

(Restoration of Patent Right by Late Payment of Patent Fees)

- Article 112-2 (1) The original patentee of the patent right that is deemed to have been forfeited pursuant to Article 112, paragraph (4) or (5), or that is deemed

never to have existed pursuant to Article 112, paragraph (6) may make a late payment of the patent fees and the patent surcharge provided for in Article 112, paragraphs (4) through (6) pursuant to Order of the Ministry of Economy, Trade and Industry only within the time frame provided by Order of the Ministry of Economy, Trade and Industry; provided, however, that this does not apply if the original patentee is found to have intentionally failed to pay the patent fees and the patent surcharge within the time frame during which the patentee is permitted to make a late payment for the patent fees pursuant to Article 112, paragraph (1).

- (2) If the patent fees and a patent surcharge are paid as under the preceding paragraph, the patent right is deemed to have continued retroactive from the time that the time frame ended as provided in the main clause of Article 108, paragraph (2) or from the end of the year in which the day marking the expiration of the patent term falls or is deemed to have existed from the beginning.

(Restriction on Effect of Restored Patent Right)

Article 112-3 (1) If a patent right is restored pursuant to paragraph (2) of the preceding Article, and the patent was granted on an invention that is a product, the patent right has no effect against articles imported into or, produced or acquired within Japan after the end of the time frame during which the patentee is permitted to make a late payment for patent fees pursuant to Article 112, paragraph (1) and before the restoration of the patent right is registered.

- (2) A patent restored pursuant to paragraph (2) of the preceding Article has no effect against the following actions performed after the end of the time frame during which the patentee is permitted to make a late payment for patent fees pursuant to Article 112, paragraph (1) and before the restoration of the patent right is registered:

- (i) the working of the invention;
- (ii) if a patent was granted on an invention that is a product, producing, transferring, etc., importing or offering for transfer, etc. of any article used in the production of the product; and
- (iii) if the patent was granted on an invention that is a product, possessing the product for the purpose of transferring, etc. or exporting it;
- (iv) if the patent was granted on an invention that is a process, producing, transferring, etc., importing, or offering for transfer, etc. of an article used in that process; and
- (v) if a patent was granted on an invention that is a process for producing a product, possessing the product produced by that process for the purpose of transferring, etc. or exporting it.



## **Chapter V Opposition to a Granted Patent**

### **(Opposition to a Granted Patent)**

Article 113 Any person may file with the Commissioner of the Japan Patent Office an opposition to a granted patent on the grounds that a patent falls under any of the following items, no later than six months from the publication of a gazette containing the patent, and if a patent has two or more claims, an opposition to a granted patent may be filed for each claim:

- (i) the patent has been granted on a patent application (excluding an application written in a foreign language) with an amendment that does not comply with the requirements provided in Article 17-2, paragraph (3);
- (ii) the patent has been granted in violation of Articles 25, 29, 29-2, or 32, or Article 39, paragraphs (1) through (4);
- (iii) the patent has been granted in violation of a treaty;
- (iv) the patent has been granted on a patent application not complying with the requirements provided in Article 36, paragraph (4), item (i) or Article 36, paragraph (6) (excluding item (iv) of that paragraph); or
- (v) matters stated in the description, claims or drawings attached to the application written in a foreign language are not within the scope of matters stated in foreign-language documents.

### **(Ruling)**

- Article 114 (1) Proceedings and a ruling on an opposition to a granted patent are conducted by a panel consisting of three or five administrative judges.
- (2) The administrative judges must make a ruling that a patent related to an opposition to a granted patent is to be revoked (hereinafter referred to as a "revocation decision") if they recognize that the patent falls under any of the items of the preceding Article.
  - (3) If a revocation decision has become final and binding, the patent right is deemed never to have existed.
  - (4) The administrative judges must make a ruling that a patent related to an opposition to a granted patent is to be maintained if they do not recognize that the patent falls under any of the items of the preceding Article.
  - (5) No appeal may be made against the ruling under the preceding paragraph.

### **(Formal Requirements for Filing)**

Article 115 (1) A person that files an opposition to a granted patent must submit to the Commissioner of the Japan Patent Office a written opposition to grant of patent stating the following matters:

- (i) the name, and domicile or residence of the person filing an opposition and the patent opponent's representative;
- (ii) an indication of the patent related to the opposition to a granted patent; and

- (iii) an identification of the grounds and the necessary evidence for the opposition to a granted patent.
- (2) An amendment of the written opposition to a granted patent filed under the preceding paragraph must not change the gist of the statement; provided, however, that this does not apply if the amendment falls under any of the matters provided in item (iii) of the preceding paragraph and is made by the earlier of the date on which the period provided for in Article 113 expires and the date on which a notice under Article 120-5, paragraph (1) is received.
- (3) A chief administrative judge must deliver a copy of the written opposition to a granted patent to the patentee.
- (4) Article 123, paragraph (4) applies mutatis mutandis to the case if an opposition to a granted patent is filed.

(Designation of Administrative Judges)

Article 116 Article 136, paragraph (2) and Articles 137 through 144 apply mutatis mutandis to a panel provided in Article 114, paragraph (1) and the administrative judges that are the members of the panel.

(Trial and Appeal Clerks)

- Article 117 (1) The Commissioner of the Japan Patent Office must designate a trial or appeal clerk for each case of an opposition to a granted patent.
- (2) Paragraphs (3) through (5) in Article 144-2 apply mutatis mutandis to the trial or appeal clerk of the preceding paragraph.

(Procedure of Proceedings)

- Article 118 (1) The proceedings with regard to an opposition to a granted patent are conducted by documentary proceedings.
- (2) If there are grounds for continuance or suspension of procedures of proceedings and a ruling on an opposition to a granted patent, with regard to one of the patentees of a jointly owned patent right, the continuance or suspension has effect on all of the joint owners.

(Intervention)

- Article 119 (1) A person that has a right on a patent right and all other persons with an interest in the patent right may intervene in the proceedings on an opposition to a granted patent to assist the patentee until a ruling on the motion is rendered.
- (2) Article 148, paragraph (4) and (5), and Article 149 apply mutatis mutandis to the intervenors under the preceding paragraph.

(Examination and Preservation of Evidence)

Article 120 Articles 150 and 151 apply mutatis mutandis to the examination and preservation of evidence in the proceedings on an opposition to a granted patent.

(Proceedings by the Trial Examiner's Own Authority)

Article 120-2 (1) Any grounds not pleaded by a patentee, a person filing an opposition, or intervenor may be examined in proceedings on an opposition to a granted patent.

(2) No claim to which an opposition to a granted patent is not filed may be examined in the proceedings on an opposition to a granted patent.

(Joint or Separate Conduct of Motions)

Article 120-3 (1) If there are two or more motions of an opposition to a granted patent related to the same patent right, the proceedings are to be jointly conducted, except if special circumstances exist.

(2) Proceedings that have been jointly conducted pursuant to the preceding paragraph may later be separately conducted.

(Withdrawal of a Motion)

Article 120-4 (1) An opposition to a granted patent may not be withdrawn after the notice under paragraph (1) of the next Article has been given.

(2) Article 155, paragraph (3) applies mutatis mutandis to the withdrawal of an opposition to a granted patent.

(Submission of a Written Opinion)

Article 120-5 (1) If a chief administrative judge intends to render a revocation decision, the judge must notify the patentee and the intervenors of the grounds therefor and give them an opportunity to submit a written opinion within a reasonable, specified period of time.

(2) The patentee may file a request for a correction of the description, claims or drawings attached to the written application only within the period of time designated in accordance with the preceding paragraph; provided, however, that the correction is limited to the following purposes:

(i) restriction of the claims;

(ii) correction of errors or incorrect translations;

(iii) clarification of an ambiguous description; and

(iv) correction of a statement of claims which cites another statement of claims to a statement which does not cite that other statement of claims.

(3) If correcting claims attached to a written application covering two or more claims, a request for correction may be filed in the preceding paragraph for each claim; provided, however, if an opposition to a granted patent has been filed for

each claim, a request for correction must be filed for each claim.

- (4) In the case of the preceding paragraph, if the claims include one or more groups of claims which are related because a statement of one claim is cited by another claim or have any other relationship provided by Order of the Ministry of Economy, Trade and Industry (hereinafter referred to as "group of claims"), a request must be filed for each group of claims.
- (5) If a request for correction has been filed pursuant to paragraph (2) within a period of time designated under paragraph (1), a chief administrative judge must serve to the person filing an opposition to a patent a copy of a document stating the grounds for revoking a patent of which notification was made pursuant to paragraph (1) and the written request for correction as well as a copy of the corrected description, claims or drawings attached to the request, and give the applicant an opportunity to submit a written opinion within a reasonable, specified period of time; provided, however, this does not apply if the person filing an opposition does not wish to submit a written opinion, or special circumstances exist under which it is recognized that it is not necessary to give an opportunity to the opponent to submit a written opinion.
- (6) If a request for correction under paragraph (2) does not correspond to one of the purposes provided in the proviso to the paragraph or does not comply with paragraphs (5) through (7) of Article 126 to be applied mutatis mutandis in paragraph (9), a chief administrative judge must notify the patentee and intervenors of the reasons therefore and give them an opportunity to submit a written opinion within a reasonable, specified period of time.
- (7) If a request for correction as referred to in paragraph (2) is made, if another request for correction has been previously made in the case of an opposition to a granted patent, the previous request is deemed to have been withdrawn.
- (8) The request for correction as referred to in paragraph (2) may be withdrawn only within the period of time during which the amendment under Article 17-5, paragraph (1) may be made with regard to the corrected description, claims or drawings attached to the written request for correction in the paragraph. In this case, if a request for correction in paragraph (2) has been filed for each claim or each group of claims pursuant to paragraph (3) or (4), all those requests must be withdrawn.
- (9) Article 126, paragraphs (4) through (7), Articles 127 and 128, Article 131, paragraphs (1), (3) and (4), Article 131-2, paragraph (1), Article 132, paragraphs (3) and (4), and Article 133, paragraphs (1), (3) and (4) apply mutatis mutandis to the case of paragraph (2). In this case, the term "item (i) or (ii) of the proviso to paragraph (1)" in Article 126, paragraph (7) is deemed to be replaced with "item (i) or (ii) of the proviso to paragraph (1) pertaining to a claim for which an opposition to a granted patent is not filed".

(Formal Requirements of Ruling)

Article 120-6 (1) A ruling on a motion of an opposition to grant of patent must be rendered in writing stating the following matters:

- (i) the number of the case of the opposition to a granted patent;
- (ii) the name, and domicile or residence of the patentee, the patent opponent, intervenor and their representatives;
- (iii) an indication of the patent related to the ruling;
- (iv) the conclusion of and grounds for the ruling; and
- (v) the date of the ruling.

(2) If a ruling has been rendered, the Commissioner of the Japan Patent Office must serve a certified copy of the ruling to the patentee, the patent opponent, intervenors and person whose application for intervention has been rejected.

(Scope of Final and Binding Ruling)

Article 120-7 A ruling on an opposition to a granted patent becomes final and binding for each case of opposition to grant of patent; provided, however, that in the cases listed in the following items, the ruling becomes final and binding as provided in the corresponding item:

- (i) if an opposition to a granted patent has been filed for each claim and a request for correction has been filed as referred to in Article 120-5, paragraph (2) for each group of claims: for each group of claims; and
- (ii) if an opposition to a granted patent has been filed for each claim and a case other than those listed in the preceding item: for each claim

(Application Mutatis Mutandis of Provisions Regarding Trials and Appeals)

Article 120-8 (1) Articles 133 and 133-2, Article 134, paragraph (4), Articles 135, 152, and 168, Article 169, paragraph (3) through (6), and Article 170 apply mutatis mutandis to proceedings and a ruling on an opposition to a granted patent.

(2) Article 114-5 applies mutatis mutandis to a ruling under Article 135 as applied mutatis mutandis as referred to in the preceding paragraph.

## **Chapter VI Trials and Appeals**

(Appeals against a Rejection)

Article 121 (1) A person that is subject to an examiner's decision to the effect that an application is to be rejected and that is dissatisfied with this decision may file an appeal against a rejection within three months after the date that the certified copy of the examiner's decision is served.

(2) If a person filing an appeal against a rejection has been unable to file that within the period prescribed in the preceding paragraph due to reasons beyond

the person's control, the person may file an appeal within 14 days (or within two months, if the person is an overseas resident,) after the date on which those reasons cease to exist, but no later than six months after the end of the aforementioned period, notwithstanding the preceding paragraph.

#### Article 122 Deleted

##### (Trial for Patent Invalidation)

Article 123 (1) If a patent falls under any of the following items, a request for a trial for patent invalidation may be filed. If the request involves two or more claims, it may be filed on a claim-by-claim basis:

- (i) the patent has been granted on a patent application (excluding an application written in a foreign language) with an amendment that does not comply with the requirements stipulated in Article 17-2, paragraph (3);
  - (ii) the patent has been granted in violation of Article 25, 29, 29-2, 32, or 38, or Article 39, paragraphs (1) through (4) (if the patent has been obtained in violation of Article 38, excluding if the transfer of a patent right under that patent has been registered based on a request under Article 74, paragraph (1));
  - (iii) the patent has been granted in violation of a treaty;
  - (iv) the patent has been granted on a patent application not complying with the requirements stipulated in Article 36, paragraph (4), item (i) or paragraph (6) (excluding item (iv) of that paragraph);
  - (v) the matters stated in the description, claims or drawings attached to the application written in a foreign language are not within the scope of matters stated in foreign-language documents;
  - (vi) the patent has been granted on a patent application filed by a person that does not have the right to the grant of a patent for the invention (excluding when the transfer of a patent right under the patent has been registered based on a request under Article 74, paragraph (1));
  - (vii) after being granted a patent, the patentee comes to fall under a category of person that is not permitted the enjoyment of a patent right pursuant to Article 25, or the patent comes to violate a treaty after being granted; or
  - (viii) the correction of the description, claims or drawings attached to the written application for the patent have been obtained in violation of the proviso to Article 126, paragraph (1), and paragraphs (5) through (7) (including as applied mutatis mutandis pursuant to Article 120-5, paragraph (9) or Article 134-2, paragraph (9)), the proviso to Article 120-5, paragraph (2) or the proviso to Article 134-2, paragraph (1).
- (2) A request for a trial for patent invalidation may be filed only by an interested person (if a request for a trial for patent invalidation is filed on the grounds that the patent falls under item (ii) of the preceding paragraph (limited to a case in

which the patent is obtained in violation of Article 38) or item (vi) of the paragraph, a person that has the right to the grant of the patent).

- (3) A request for a trial for patent invalidation may be filed even after the forfeiture of the patent right.
- (4) When a request for a trial for patent invalidation has been filed, a chief administrative judge must notify any exclusive licensee under the patent right and notify any other persons with registered rights under the patent of the same.

#### Article 124 Deleted

Article 125 Once a decision on a trial or appeal to the effect that a patent is to be invalidated has become final and binding, the patent right is deemed never to have existed; provided, however, that if a patent falls under Article 123, paragraph (1), item (vii) and a decision on a trial or appeal to the effect that the patent is to be invalidated has become final and binding, the patent is deemed not to have existed beginning from the time that item first became applicable to the patent.

#### (Trial for Invalidation of Registration of Patent Term Extension)

Article 125-2(1) A request for invalidation trial of the registration of extension may be filed if the registration of extension under Article 67-3(3) falls under any of the following:

- (i) where the registration of extension is made in response to an application filed before the base date;
  - (ii) the period extended by the registration of extension exceeds the extendible period regarding the duration of the patent right;
  - (iii) the registration of extension is made in response to an application filed by a person who is not the patentee; and
  - (iv) the registration of extension is made in response to an application which does not meet the requirements prescribed in Article 67-2(4).
- (2) A request for invalidation trial of a registration of extension under the preceding paragraph may be filed only by an interested person.
  - (3) Article 123(3) and (4) shall apply mutatis mutandis to a request for invalidation trial of a registration of extension under paragraph (1).
  - (4) Where a trial decision to the effect that the registration of extension under Article 67-3(3) is to be invalidated has become final and binding, the extension of the duration of the patent right by the said registration of extension shall be deemed never to have been made; provided, however, that where the registration of extension falls under paragraph (1)(ii) and a trial decision to the effect that the registration of extension for the period exceeding the extendible period regarding the duration of the patent right is to be invalidated has become final and binding,

the extension for the said excess period shall be deemed not to have been made.

- (5) Where an application to register an extension under Article 67(4) is filed within the period of the extension for the duration of a patent right based on the registration of extension that is deemed never to have been made pursuant to the main clause of the preceding paragraph, or within the period for which the extension is deemed not to have been made pursuant to the proviso to the said paragraph, the said application shall be deemed to have been withdrawn if it is pending before the Patent Office.
- (6) Where the registration of extension under Article 67-7(3) is made in response to an application to register an extension under Article 67(4) which has been filed within the period of the extension for the duration of a patent right based on the registration of extension that is deemed never to have been made pursuant to the main clause of paragraph (4), or within the period for which the extension is deemed not to have been made pursuant to the proviso to the said paragraph, the extension for the duration of the patent right by the said registration of extension shall be deemed never to have been made.

Article 125-3(1) A request for invalidation trial of the registration of extension of duration of a patent right may be filed if the registration of extension under Article 67-7(3) falls under any of the following:

- (i) where the registration of extension has been made for an application filed where the disposition as provided in Cabinet Order under Article 67(4) for the working of the patented invention is not deemed to have been required;
  - (ii) where the registration of extension has been made for an application filed where the patentee or an exclusive licensee or a non-exclusive licensee of the patent right did not receive the disposition as provided in Cabinet Order under Article 67(4);
  - (iii) where the duration extended by the registration of extension exceeds the period during which the patented invention could be worked;
  - (iv) where the registration of extension has been made upon an application filed by a person who is not the said patentee; and
  - (v) where the registration of extension has been made upon an application not complying with the requirements as provided in Article 67-2(iv) as applied *mutatis mutandis* pursuant to Article 67-5(4).
- (2) Paragraphs (2) and (3) of the preceding Article shall apply *mutatis mutandis* to a request for invalidation trial of the registration of extension under the preceding paragraph.
- (3) Where a trial decision to the effect that the registration of extension under Article 67-7(3) is to be invalidated has become final and binding, the extension of the duration of the patent right by the said registration of extension shall be



deemed never to have been made; provided, however, that where the registration of extension falls under paragraph (1)(iii) and a trial decision to the effect that the registration of extension for the duration exceeding the period during which the patented invention could be worked is to be invalidated has become final and binding, the extension for the said excess period shall be deemed not to have been made.

(Correction Trials)

Article 126 (1) The patentee may file a request for a correction trial for correcting the description, claims or drawings attached to the written application; provided, however, that a correction is limited to the following:

- (i) restriction of the claims;
  - (ii) correction of errors or mistranslations;
  - (iii) clarification of an ambiguous statement; and
  - (iv) rewriting a claim that cites another claim into a claim that does not cite that other claim.
- (2) A request for correction trial may not be filed between the time that an opposition to a granted patent or trial for patent invalidation becomes pending before the Japan Patent Office and the time that ruling on the opposition or the trial decision (meaning all the rulings on the opposition or trial decisions if a request is filed on a claim-by-claim basis) becomes final and binding.
- (3) If two or more of the patent claims attached to a written application are being corrected, a request for a correction trial under paragraph (1) may be filed on a claim-by-claim basis. In this case, if there is a set of claims in the relevant claim, a request must be filed for on a set by set basis.
- (4) If the description or drawings attached to a written application are being corrected and the person seeks to file the request for a correction trial under paragraph (1) on a claim-by-claim basis, the request must be filed with respect to all claims involved in the correction of the description or drawings (or, if a request under paragraph (1) is filed on a set-by-set basis pursuant to the second clause of the preceding paragraph, with respect to the whole of any claim set that includes a claim involving in the correction of the description or drawings).
- (5) The correction of a description, claims or drawings as referred to in paragraph (1) must remain within the scope of the matters disclosed in the description, claims, or drawings attached to a written application (in the case of a correction for the purpose provided in item (ii) of the proviso to paragraph (1), the description, claims and drawings originally attached to the written application (or in the case of a patent linked to an application written in a foreign language, foreign-language documents)).
- (6) The correction of the description, claims, or drawings as referred to in paragraph (1) must not substantially enlarge or alter the claims.

- (7) Corrections for any of the purposes set forth in item (i) or (ii) of the proviso to paragraph (1), must be such as would allow the invention defined by what is described in the corrected claims to be patented independently upon the filing of the patent application.
- (8) A request for a trial for correction may be filed even after the forfeiture of the patent right; provided, however, that this does not apply after the patent has been revoked by a revocation decision or invalidated by a trial for patent invalidation.

Article 127 If there is an exclusive licensee or a pledgee, the patentee may file a request for a trial for correction only with the consent of those persons.

Article 128 Once a decision on a trial or appeal to the effect that the description, claims or drawings attached to a written application are to be corrected has become final and binding, the filing of the patent application, the publication of the patent application, the examiner's decision or the decision on the trial or appeal to the effect that the patent is to be granted, or the registration of the patent right is deemed to have been made based on the corrected description, claims or drawings.

Articles 129 and 130 Deleted

(Formal Requirements for Request for Trial or Appeal)

Article 131 (1) A person filing a request for trial or appeal must submit a written request stating the following to the Commissioner of the Japan Patent Office:

- (i) the name, and the domicile or residence of the party and the agent thereof;
  - (ii) an indication of the trial or appeal case; and
  - (iii) the object and grounds of the claim.
- (2) When a request for a trial for patent invalidation is filed, the grounds for the request that are set forth in item (iii) of the preceding paragraph must concretely identify the facts that are the basis for invalidating the patent and must state the relationship of each fact that needs to be proved to the evidence.
- (3) When a request for a trial for correction is filed, the object and grounds of the claim that are set forth in paragraph (1), item (iii) must be stated as provided by Order of the Ministry of Economy, Trade and Industry.
- (4) When a request for a trial for correction is filed, the corrected description, claims or drawings must be attached to the written request.

(Amendment of Request for a Trial or Appeal)

Article 131-2 (1) The amendment of a written request submitted pursuant to paragraph (1) of the preceding Article must not be such as modifies the overall

substance of request; provided, however, that this does not apply if the amendment falls under any of the following items:

- (i) the amendment is made with respect to the grounds for the request set forth in paragraph (1), item (iii) of the preceding Article in the course of filing a request for a trial or appeal other than a trial for patent invalidation;
  - (ii) the amendment is allowed by a chief administrative judge under the following paragraph; or
  - (iii) an order has been issued to amend the written request pursuant to Article 133, paragraph (1) (including as applied mutatis mutandis pursuant to Article 120-5, paragraph (9) and Article 134-2, paragraph (9)) and the amendment is made with respect to a matter so ordered
- (2) If a request for a trial for patent invalidation is filed and an amendment of the grounds for the request set forth in paragraph (1), item (iii) of the preceding Article modifies the overall substance of those grounds, the chief administrative judge may rule to allow the amendment upon finding there to clearly be no risk that the amendment will unreasonably delay the trial proceedings and that the circumstances fall under one of the following items:
- (i) a request for correction as referred to in Article 134-2, paragraph (1) has been filed during the trial for patent invalidation and that request for correction has been made in necessary to amend the grounds for the request; or
  - (ii) there are reasonable grounds other than what is set forth in the preceding item for the grounds for the request as amended not having been included in the written request at the time the request for a trial was filed, and the respondent has agreed to the amendment.
- (3) The approval of the amendment as referred to in the preceding paragraph may not be made if the written amendment of proceedings for that amendment is submitted prior to the service of a copy of the written request under Article 134, paragraph (1).
- (4) An appeal may not be filed against a ruling referred to in paragraph (2) or inaction thereof.

#### (Joint Trial or Appeal)

Article 132 (1) If there are two or more persons filing a request for a trial for patent invalidation or a trial for invalidation concerning the registration of an extension in respect of the same patent right, these persons may jointly file the request for the trial.

- (2) A request for trial or appeal is filed against a patentee that jointly owns the patent right, must have all of the joint owners as the respondents.
- (3) A request for trial or appeal is filed by a joint owner of a patent right or a right to the grant of a patent in respect of the right under joint ownership must be jointly filed by all of the joint owners.

- (4) If there are grounds for continuance or suspension of trial or appeal proceedings in respect of one of the person that has filed a request for trial or appeal pursuant to paragraph (1) or (3) or in respect of one of the persons on the responding side of a request for trial or appeal filed pursuant to paragraph (2), the continuance or suspension is valid against all of them.

(Dismissal by Ruling in the Case of Non-compliance with Formal Requirements)

- Article 133 (1) If a written request does not comply with Article 131, a chief administrative judge must order the petitioner to amend the written request within a reasonable, specified period of time.
- (2) Other than in a case as provided in the preceding paragraph, the chief administrative judge may order an amendment to be made with respect to a procedure involved in the case under trial or appeal within a reasonable specified period of time, in any of the following cases:
- (i) the procedure does not comply with Article 7, paragraphs (1) through (3) or Article 9;
  - (ii) the procedure does not comply with a formal requirements specified by this Act or an order that is based on this Act; or
  - (iii) the fee for a procedure that is to be paid pursuant to Article 195, paragraph (1) or (2) has not been paid;
- (3) The chief administrative judge may rule to dismiss a procedure involved in a case under trial if the person that the judge orders, pursuant to the preceding two paragraphs, to make an amendment with respect to that procedure fails to make the amendment within the period of time the judge has specified pursuant to those paragraphs, or if the amendment violates of Article 131-2, paragraph (1).
- (4) The ruling as referred to in the preceding paragraph must be issued in writing and the reasons for that ruling must be given.

(Dismissal of Non-Compliant Procedures)

- Article 133-2 (1) A chief administrative judge may, by a ruling, dismiss any procedures that are not compliant and not amendable among the procedures pertaining to a trial or appeal case (excluding a request for trial or appeal).
- (2) Before a chief administrative judge intends to dismiss a procedure under the preceding paragraph, the judge must notify the person that undertook the procedures of the reasons for dismissing it and give the person an opportunity to submit a written explanation within an adequate specified period of time.
- (3) A ruling as referred to in this paragraph (1) must be issued in writing and e the reasons for that ruling must be given.

(Submission of a Written Answer)

- Article 134 (1) Once a request for trial or appeal has been filed, a chief

administrative judge must serve a copy of the written request to the respondent and give the respondent an opportunity to submit a written answer within an adequate specified period of time.

- (2) If a chief administrative judge allows the amendment of a written request pursuant to Article 131-2, paragraph (2), the judge must serve a copy of the procedure amendment form for that amendment on the respondent, and must give the respondent an opportunity to submit a written answer within an adequate specified period of time; provided, however, that this does not apply if there are special circumstances in occurrence in which it is recognized not to be necessary to give the respondent the opportunity to submit a written answer.
- (3) Once the chief administrative judge accepts a written answer as referred to in paragraph (1) or the main clause of the preceding paragraph, the judge must serve a copy thereof to the petitioner.
- (4) The chief administrative judge may interrogate the parties and any intervenors with regard to a trial or appeal.

(Request for Correction during Trial for Patent Invalidation)

Article 134-2 (1) The respondent in a trial for patent invalidation may file a request for a correction of the description, claims or drawings attached to the written application only within a period of time that is specified pursuant to paragraph (1) or (2) of the preceding Article, the following Article, Article 153, paragraph (2), or Article 164-2, paragraph (2); provided, however, that the correction is limited to one with the following purposes:

- (i) restriction of the claims;
  - (ii) correction of errors or mistranslations;
  - (iii) clarification of an ambiguous statement; and
  - (iv) rewriting a claim that cites another claim into a claim that does not cite that other claim.
- (2) If two or more of the patent claims accompanying a request would be corrected the request for correction referred to in the preceding paragraph may be filed on a claim-by-claim basis; provided, however, that the request for correction referred to in that paragraph must be filed on a claim-by-claim basis if a request for a trial for patent invalidation has been filed on a claim-by-claim basis.
  - (3) In the case referred to in the preceding paragraph, when there is a claim set among the two or more claims, the request must be filed on a set-by-set basis.
  - (4) Once a chief administrative judge accepts a written request for correction as referred to in paragraph (1) and the corrected description, claims or drawings attached to a request, the judge must serve a copy thereof on the petitioner.
  - (5) An administrative judge may examine grounds that have not been pleaded by a party to a case or an intervenor in looking at whether a request for correction as referred to in paragraph (1) fails to be for a purpose set forth in one of the items

- of the proviso to the paragraph, or in looking at whether it fails to conform to the provisions of paragraphs (5) through (7) of Article 126 as applied mutatis mutandis pursuant to paragraph (9) after the deemed replacement of terms. In this case, if the chief administrative judge does not allow the request for correction because of such grounds, the judge must notify the parties to the case and the intervenors of the results of the examination and give them an opportunity to state their opinions within an adequate specified period of time.
- (6) If a request for correction as referred to in paragraph (1) is filed and another request for correction has been filed previously in the relevant case under trial, the previous request is deemed to be withdrawn.
- (7) A request for correction as referred to in paragraph (1) may be withdrawn only within the period of time during which an amendment as referred to in Article 17-5, paragraph (2) may be made with regard to the corrected description, claims or drawings attached to the written request for correction referred to in that paragraph. In this case, if the request for correction as referred to in paragraph (1) has been filed on a claim-by-claim basis or a set-by-set basis pursuant to paragraph (2) or (3), all those requests must be withdrawn.
- (8) If a request for a trial for patent invalidation has been withdrawn for each claim pursuant to Article 155, paragraph (3), the request for correction as referred to in paragraph (1) is deemed to be withdrawn on a claim-by-claim basis, and if all requests in the case under a trial for patent invalidation are withdrawn, all the requests for correction as referred to in the paragraph in the case under trial are deemed to be withdrawn.
- (9) Article 126, paragraphs (4) through (8), Articles 127 and 128, Article 131, paragraphs (1), (3) and (4), Article 131-2, paragraph (1), Article 132, paragraphs (3) and (4), and Article 133, paragraphs (1), (3) and (4) apply mutatis mutandis to the case referred to in paragraph (1). In this case, the term "item (i) or (ii) of the proviso to paragraph (1)" in Article 126, paragraph (7) is deemed to be replaced with "item (i) or (ii) of the proviso to paragraph (1) in connection with a claim in respect of which a request for a trial for patent invalidation is not filed".

(Request for Correction when Rescission Judgment is Rendered)

Article 134-3 If a judgment rescinding a trial decision in a trial for patent invalidation (limited to a trial decision concluding that there are no grounds for requesting a trial) as under Article 181, paragraph (1) becomes final and binding, and the proceedings under paragraph (2) of the Article are initiated, the chief administrative judge may specify to the respondent an adequate period of time for filing a request for the correction of the description, claims or drawings attached to the written application, but only if the respondent files a petition to do so within one week from the date that the judgment becomes final and binding.

(Dismissal of Non-Compliant Request for Trial or Appeal by Decision on Trial or Appeal)

Article 135 A non-compliant request for trial or appeal that is not amendable may be dismissed by a decision on the trial or appeal without the respondent being given an opportunity to submit a written answer.

(Panel System for Trial and Appeal)

Article 136 (1) A trial or appeal is conducted by a panel consisting of either three or five administrative judges.

(2) A panel as referred to in the preceding paragraph reaches its decisions by a majority vote.

(3) Administrative judge qualifications are specified by Cabinet Order.

(Designation of Administrative Judges)

Article 137 (1) The Commissioner of the Japan Patent Office must designate the administrative judge that make up the panel referred to Article 136, paragraph (1) for each case under trial or appeal (for a case under trial or appeal in respect of filing that is examined by an examiner pursuant to Article 162, this is limited to if a report under Article 164, paragraph (3) has been submitted ).

(2) If one of the administrative judges designated pursuant to in the preceding paragraph is unable to participate in the trial or appeal, the Commissioner of the Japan Patent Office must dissolve that designation and appoint another administrative judge to fill the vacancy.

(Chief administrative judge)

Article 138(1) The Commissioner of the Patent Office shall designate one of the administrative judges designated under paragraph (1) of the preceding Article as the chief administrative judge.

(2) The chief administrative judge shall preside over matters relating to the trial.

(The Disqualification of Administrative Judges)

Article 139 An administrative judge is disqualified from acting as judge in the following cases:

- (i) the administrative judge or the judge's spouse or former spouse is or was formerly a party to the case or an intervenor or a patent opponent in the case;
- (ii) where the administrative judge is or was a relative by blood within the fourth degree of kinship, a relative by affinity within the third degree of kinship or a relative living together (as defined in the Civil Code of Japan) of a party in the case or an intervenor in the case;

- (iii) where the administrative judge is a guardian, a supervisor of a guardian, a curator, a supervisor of the curator, an assistant or a supervisor of the assistant of a party in the case or an intervenor or a patent opponent in the case;
- (iv) the administrative judge becomes a witness or an expert witness in the case;
- (v) the administrative judge is or was formerly the agent of a party to the case or an intervenor or a patent opponent in the case;
- (vi) the administrative judge was involved in the case connected to the appeal that has been filed against the examiner's decision as the examiner; or
- (vii) where the administrative judge handling a case of an application to register an extension under Article 67(2) was involved, as the examiner, in the examination of the patent application regarding the patent right connected to the case;
- (viii) the administrative judge has a direct interest in the case.

Article 140 If there are any grounds for disqualification as referred to in Article 139, a party or an intervenor may file a motion requesting the exclusion.

(Challenging against Administrative Judge)

Article 141 (1) If there exist any circumstances involving an administrative judge that could prejudice the fairness of proceedings of a trial or appeal, a party or an intervenor may challenge the administrative judge.

(2) A party or an intervenor may not challenge an administrative judge after offering a written or oral statement to the administrative judge with regard to the case; provided, however, that this does not apply if the party or the intervenor is not aware of the grounds for challenge at that time or if the grounds for challenge occur thereafter.

(Formal Requirements for a Motion to Disqualify or Challenge)

Article 142 (1) A person filing a motion to disqualify or challenge must submit a document to the Commissioner of the Japan Patent Office stating the grounds therefor; provided, however, that in oral proceedings this motion may be made orally.

(2) A prima facie showing of grounds for disqualification or for the challenge must be made within three days from the motion as referred to in the preceding paragraph is filed. The same applies with respect to the facts referred to in the proviso to Article 141, paragraph (2).

(Ruling on a Motion to Disqualify or Challenge)

Article 143 (1) If a motion to disqualify or challenge is filed, the administrative judges other than the administrative judge named in the motion try that motion



and issue a ruling; provided, however, that the judge named in the motion may present an opinion.

- (2) A ruling as referred to in the preceding paragraph must be issued in writing and the reasons for that ruling must be given.
- (3) No appeal may be filed against the ruling as referred to in paragraph (1) or inaction thereof).

Article 144 If a motion to disqualify or challenge is filed, trial and appeal proceedings must be suspended until the ruling on the motion is issued; provided, however, that this does not apply when urgent action is necessary.

(Trial and Appeal Clerks)

Article 144-2 (1) The Commissioner of the Japan Patent Office must designate a clerk for each trial or appeal case (for a case under trial in respect of a filing that is examined by an examiner pursuant to Article 162, this is limited to if a report under Article 164, paragraph (3) has been submitted).

- (2) Qualifications of trial and appeal clerks are provided by Cabinet Order
- (3) If a trial or appeal clerk designated pursuant to paragraph (1) is unable to participate in the trial or appeal, the Commissioner of the Japan Patent Office must dissolve that designation and designate another trial or appeal clerk.
- (4) The trial or appeal clerk undertakes clerical affairs in respect of record preparation and service of process for the trial or appeal record and, at the order of a chief administrative judge, undertakes any other clerical affairs for that case.
- (5) Articles 139 (excluding item (vi) and (vii)) and 140 through 144 apply mutatis mutandis to a trial and appeal clerk. In this case, the trial or appeal clerk named in the motion to disqualify or challenge may not participate in the trial as regards to the disqualification or challenge.

(Formal Requirement for Trial and Appeal Proceedings)

Article 145 (1) A trial for patent invalidation or a trial for invalidation concerning registration of patent term extension is conducted through oral proceedings; provided, however, that a chief administrative judge may decide to conduct the trial through written proceedings, at the motion of a party or intervenor or by the judge's own authority.

- (2) A Trial and appeal, other than one provided for in the preceding paragraph is conducted through written proceedings; provided, however, that a chief administrative judge may to conduct such a trial or appeal through oral proceedings, at the motion of a party or by the judge's own authority.
- (3) If a trial or appeal is conducted through oral proceedings pursuant to paragraph (1) or the proviso to the preceding paragraph, the chief administrative judge must set the date and the place for the trial or appeal and summon the parties and the

intervenor to appear on that date.

- (4) Article 94 (Summons to Appear on a Court Date) of the Code of Civil Procedure applies *mutatis mutandis* to a summons to appear on a trial date as referred to in the preceding paragraph.
- (5) The oral proceedings under paragraph (1) and the proviso to paragraph (2) are open to the public; provided, however, that this does not apply if open proceedings is likely to disrupt the public policy.
- (6) The chief administrative judge may, at the motion of a party or intervener or by the judge's own authority, conduct proceedings on the date for the trial referred to in paragraph (3) in a way that enables the administrative judges and the trial and appeal clerk, and, the parties and the interveners to communicate with one another, with an awareness of one another's state of being, through audio and visual transmissions, pursuant to Order of the Ministry of Economy, Trade and Industry.
- (7) The parties and interveners who have participated in the proceedings referred to in the preceding paragraph without appearing on the date referred to in paragraph (3) are deemed to have appeared on that date for the trial.

Article 146 Article 154 (Presence of Interpreters) of the Code of Civil Procedure applies *mutatis mutandis* to a trial or appeal.

(Records)

- Article 147 (1) For oral proceedings under paragraph (1) or the proviso to paragraph (2) of Article 145, the trial or appeal clerk must prepare a trial or appeal record giving an overview of the proceedings and all other necessary details on each trial or appeal date.
- (2) If a trial or appeal clerk is issued an order by the chief administrative judge with regard to the preparation or modification of a trial or appeal record referred to in the preceding paragraph but finds such preparation or modification to be inappropriate, the clerk may make a note of this opinion in the record.
  - (3) Paragraphs (2) and (3) of Article 160 (Record of Oral Arguments) apply *mutatis mutandis* to the trial or appeal record referred to in paragraph (1).

(Intervention)

- Article 148 (1) A person that may file a request for a trial pursuant to Article 132, paragraph (1) may intervene in the trial as a petitioner up until such time as the proceedings reach a conclusion.
- (2) An intervenor as under the preceding paragraph may continue to pursue the trial proceedings even after the original party withdraws the request for that trial.

- (3) A person with an interest in the results of a trial or appeal may intervene in the trial or appeal to assist one of the original parties up until such time as the proceedings reach a conclusion.
- (4) An intervenor as under the preceding paragraph may act in respect of all trial or appeal proceedings.
- (5) If there are grounds for continuance or suspension of trial or appeal proceedings in respect of an intervenor as under paragraph (1) or (3), the continuance or suspension is valid against the original parties.

Article 149 (1) A person applying to intervene must submit an application for intervention to a chief administrative judge.

- (2) If an application for intervention is filed, the chief administrative judge must serve a copy of the application for intervention on the original parties and any intervenors and give them an opportunity to present their opinions within an adequate, specified period of time.
- (3) If an application for intervention is filed, the administrative judges for the trial or appeal in which the applicant intends to intervene try that application issue a ruling.
- (4) The ruling as referred to in the preceding paragraph must be issued in writing and reasons for that ruling must be given.
- (5) No appeal may be filed against the ruling referred to in paragraph (3) or inaction thereof

(Examination and Preservation of Evidence)

- Article 150 (1) Evidence may be examined in a trial or appeal, at the motion of a party or an intervenor, or on the judge's own authority.
- (2) Evidence may be preserved for trial or appeal, either at the motion of an interested person prior to the filing of a request for a trial or appeal, or at the motion of a party or an intervenor, or on the judge's own authority once the trial or appeal is pending.
  - (3) A motion prior to the filing of a request for a trial or appeal as under the preceding paragraph must be filed with the Commissioner of the Japan Patent Office.
  - (4) If a motion is filed prior to the filing of a petition for a trial or appeal as under paragraph (2), the Commissioner of the Japan Patent Office must designate the administrative judge and trial or appeal clerk that are to be in charge of preserving the evidence.
  - (5) If evidence is examined or preserved pursuant to paragraph (1) or (2), by the judge's own authority, the chief administrative judge must notify the parties and intervenors of the results thereof and give them an opportunity to present their opinions within a reasonable, specified period of time.

- (6) The examination or preservation of evidence referred to in paragraph (1) or (2) may be entrusted to the district court or summary court with jurisdiction over the matter.

Article 151 Article 145, paragraphs (6) and (7), Article 147 of this Act and Article 93, paragraph (1) (Designation of Court Dates), Article 94 (Summons to Appear on a Court Date), Articles 179 through 181, 183 through 186, 188, 190, 191, and 195 through 198, Article 199, paragraph (1), Articles 201 through 204, 206, 207, and 210 through 213, Article 214, paragraphs (1) through (3), Articles 215 through 222, Article 223, paragraphs (1) through (6), Articles 226 through 228, Articles 229, paragraphs (1) through (3), Article 231, Article 232, paragraph (1), Articles 233, 234, 236 through 238, and 240 through 242 (Re-examination During Oral Arguments), and Article 278 (Submission of Documents in Lieu of Examination) of the Code of Civil Procedure apply mutatis mutandis to the examination and preservation of evidence under the preceding Article. In this case, the term "facts admitted by a party in court and obvious facts" in Article 179 of the Code of Civil Procedure is deemed to be replaced with "obvious facts", and the term "the rules of the Supreme Court" in Article 204 and 215-3 of the Code is deemed to be replaced with "Order of the Ministry of Economy, Trade and Industry".

(Proceedings by Chief Administrative Judge's Own Authority)

Article 152 The chief administrative judge may proceed with trial or appeal procedures, even if a party or intervenor fails to undertake a required procedure within the statutory or specified period of time and even if the person fails to appear pursuant to the provisions of Article 145, paragraph (3).

Article 153 (1) Grounds not pleaded by a party or intervenor may also be examined in a trial or appeal.

(2) If grounds not pleaded by a party or intervenor are examined pursuant to the preceding paragraph, the chief administrative judge must notify the parties and the intervenors of the result thereof and give them an opportunity to present opinions within a reasonable, specified period of time.

(3) No object of claim not claimed by the petitioner may be examined in a trial or appeal.

(Joint or Separate Conduct of Proceedings)

Article 154 (1) When one or both parties to two or more trials or appeals are identical, the proceedings may be jointly conducted.

(2) Proceedings that are jointly conducted pursuant to the preceding paragraph may later be separately conducted.

(Withdrawal of Request for Trial or Appeal)

Article 155 (1) A request for a trial or appeal may be withdrawn up until such time as the decision on the trial or appeal becomes final and binding.

- (2) A request for a trial or appeal may not be withdrawn without the consent of the adverse party, once the written answer referred to in Article 134, paragraph (1) has been submitted.
- (3) If a request for a trial for patent invalidation is filed in respect of two or more claims in a patent that has two or more claims, that request may be withdrawn on a claim-by-claim basis.
- (4) If a request for a trial for correction has been filed on claim-by-claim basis or set-by-set basis any withdrawal of the request must constitute the withdraw all requests.

(Notice of the Conclusion of Proceedings)

Article 156 (1) When a case reaches the point at which a decision on the trial or appeal can be rendered in a trial other than a trial for patent invalidation, the chief administrative judge must notify the parties and intervenors of the conclusion of the proceedings.

- (2) When a trial for patent invalidation case reaches the point at which a trial decision can be rendered, and an advance notice of a trial decision as referred to in Article 164-2, paragraph (1) is not given or when an advance notice of a trial decision as referred to in Article 164-2, paragraph (1) has been given but the respondent does not file a request for correction as referred to in Article 134-2, paragraph (1) or make an amendment as referred to in Article 17-5, paragraph (2) within the period of time that has been specified pursuant to Article 164-2, paragraph (2), the chief administrative judge must notify the parties and intervenors of the conclusion of the proceedings.
- (3) A chief administrative judge may resume proceedings, upon a motion of a party or intervenor, or by the judge's own authority, when necessary, even after the notice has been given under the preceding two paragraphs.
- (4) A trial decision must be rendered within 20 days from the date on which the notice under paragraph (1) or (2) is issued; provided, however, that this does not apply if the case is complex or there are unavoidable reasons for not doing so.

(Trial or Appeal Decisions)

Article 157 (1) When a decision on a trial or appeal is rendered, the trial or appeal is reached.

- (2) A decision on a trial or appeal must be rendered in writing stating the following matters:
  - (i) the trial or appeal number;

- (ii) the name, and domicile or residence of each of the parties, intervenors and agents;
  - (iii) an identification of the trial or appeal case;
  - (iv) the conclusion of and reasons for the decision on the trial or appeal; and
  - (v) the date of the decision on the trial or appeal.
- (3) When a decision on a trial or appeal is rendered, the Commissioner of the Japan Patent Office must serve a certified copy of the decision to the parties, intervenors and person whose application to intervene has been rejected.

(Special Provisions Regarding Appeals against a Rejection)

Article 158 A procedure undertaken during an examination is also valid during an appeal against a rejection.

Article 159 (1) Article 53 applies mutatis mutandis to an appeal against a rejection.

In this case, the term "Article 17-2, paragraph (1), item (i) or (iii)" in Article 53, paragraph (1) is deemed to be replaced with "Article 17-2, paragraph (1), item (i), (iii) or (iv)", and the term "an amendment" in Article 53, paragraph (1) is deemed to be replaced with "an amendment (in the case of Article 17-2, paragraph (1), item (i) or (iii), excluding any amendment made prior to the filing of an appeal against the rejection)".

- (2) Article 50 and Article 50-2 apply mutatis mutandis when any of the reasons for rejection found in an appeal against a rejection are different from the reasons for the examiner's decision. In this case, the term "in cases as set forth in Article 17-2, paragraph (1), item (i) or (iii) (in the case of item (i), limited to if the examiner issues the notice under the following Article together with the notice of grounds for rejection)" in the proviso to Article 50 is deemed to be replaced with "in cases set forth in Article 17-2, paragraph (1), item (i) (limited to if the examiner issues the notice under the following Article together with the notice of grounds for rejection, and excluding a case in which the applicant makes an amendment prior to filing a request for appeal against a rejection), item (iii) (excluding a case in which the applicant makes an amendment prior to filing a request for appeal against a rejection) or item (iv)".
- (3) Articles 51, Article 67-3(2) to (4) and Article 67-7(2) to (4) shall apply mutatis mutandis to an appeal where a request for appeal against an examiners decision of refusal is found to have reasonable grounds.

Article 160 (1) If the examiner's decision is rescinded in an appeal against a rejection, an appeal decision ordering a further examination may be issued.

- (2) The determination in an appeal decision as referred to in the preceding paragraph is binding upon the examiner with respect to the case.
- (3) Article 159, paragraph (3) does not apply if an appeal decision as referred to in

paragraph (1) is rendered.

Article 161 Article 134, paragraphs (1) through (3), and Articles 134-2, 134-3, 148 and 149 do not apply to an appeal against a rejection.

Article 162 If an appeal is filed against a rejection and, at the same time that the appeal is filed an amendment is made to the description, claims or drawings attached to the written application in the patent application to which the request pertains the Commissioner of the Japan Patent Office must have an examiner examine the filing.

Article 163 (1) Articles 48, 53 and 54 apply mutatis mutandis to an examination under the preceding Article. In this case, the term "Article 17-2, paragraph (1), item (i) or (iii)" in Article 53, paragraph (1) is deemed to be replaced with "Article 17-2, paragraph (1), item (i), (iii) or (iv)" and the term "an amendment" in Article 53, paragraph (1) is deemed to be replaced with "an amendment (in the case set forth in item (i) or (iii), excluding an amendment made prior to the request for appeal against a rejection)".

(2) Articles 50 and 50-2 apply mutatis mutandis if any of the reasons for rejection from the reason for the examiner's decision is discovered in the request for appeal during an examination under the preceding Article. In this case, the term "in cases as set forth in Article 17-2, paragraph (1), item (i) or (iii) (in the case set forth in item (i), limited to if the examiner issues the notice under the following Article together with the notice of grounds for rejection)" in the proviso to Article 50 is deemed to be replaced with "in cases set forth in Article 17-2, paragraph (1), item (i) (limited to if the examiner issues the notice under the following Article together with the notice of the grounds for rejection, and excluding a case in which the applicant makes an amendment prior to filing a request for appeal against a rejection), item (iii) (excluding a case in which the applicant makes an amendment prior to filing a request for appeal against a rejection) or item (iv)".

(3) Articles 51 and 52 apply mutatis mutandis if there are found to be grounds for appeal during examination under the preceding Article.

Article 164 (1) In an examination under Article 162, if the examiner reaches the decision to the effect that a patent is to be granted, the examiner must rescind the examiner's decision to reject the application that was the basis of the appeal.

(2) Except in a case as provided in the preceding paragraph, an examiner must not render a ruling dismissing an amendment under Article 53, paragraph (1) as applied mutatis mutandis pursuant to Article 163, paragraph (1).

(3) Except in a case as provided in paragraph (1), an examiner must report the results of the examination to the Commissioner of the Japan Patent Office

without reaching a decision on the filing of the appeal.

(Special Provisions on Trial for Patent Invalidation)

Article 164-2 (1) When a case in a trial for patent invalidation reaches the point at which a trial decision can be rendered, if the chief administrative judge finds there to be reasonable grounds for the request for the trial and if otherwise provided by Order of the Ministry of Economy, Trade and Industry, the judge must give the parties and intervenors advance notice of the trial decision.

(2) When a chief administrative judge gives advance notice of a trial decision as referred to in the preceding paragraph, the judge must specify an adequate period of time for respondent to file a request for correction of the description, claims or drawings attached to the written application.

(3) Article 157, paragraph (2) applies mutatis mutandis to the advance notice of a trial decision that is referred to in paragraph (1).

(Special Provisions on Trials for Correction)

Article 165 If the purpose of a trial for correction not one of those set forth in the proviso to Article 126, paragraph (1) or the correction does not comply with Article 126, paragraphs (5) through (7), the chief administrative judge must notify the petitioner of the reasons therefore and give the petitioner an opportunity to submit a written opinion within an adequate, specified period of time .

Article 166 Article 134, paragraphs (1) through (3), and Articles 134-2, 134-3, 148 and 149 do not apply to a trial for correction.

(Effect of a Trial Decision)

Article 167 Once the trial decision in a trial for patent invalidation or a decision in a trial for invalidation of registration of patent term extension has become final and binding, neither the parties nor intervenors may file a request for either such kind of trial on the basis of the same facts or evidence.

(Scope of Final and Binding Decision Trial or Appeal)

Article 167-2 (1) A decision on a trial or appeal becomes final and binding on a trial/appeal case-by-trial/appeal case basis; provided, however, that, in a case as set forth in one of the following items, the decision on the trial or appeal becomes final and binding as provided in the corresponding items:

- (i) a request for a trial for patent invalidation has been filed on a claim-by-claim basis and a request for correction as referred to in Article 134-2, paragraph (1) is filed on a set-by-set basis; on a set-by-set basis;
- (ii) a request for a trial for correction is filed on a set-by-set basis; on a set-by-set



- basis; and,
- (iii) a request for a trial or appeal is filed on a claim-by-claim basis other than as set forth in item (i): on a claim-by-claim basis

(Connection with Litigation)

- Article 168 (1) If it is found to be necessary during a trial or appeal, the trial or appeal proceedings may be suspended until the ruling on an opposition to a granted patent or the decision from another trial or appeal becomes final and binding or until litigation proceedings conclude.
- (2) If an action has been instituted or a motion has been filed for an order of provisional seizure or an order of provisional disposition and the court finds it to be necessary, the court may suspend litigation proceedings until the decision on the trial or appeal becomes final and binding.
  - (3) If an action is instituted with respect to infringement of a patent right or violation of an exclusive license the court is to notify the Commissioner of the Japan Patent Office of this. The same applies once the litigation proceedings conclude.
  - (4) If the Commissioner of the Japan Patent Office is notified as provided in the preceding paragraph, the commissioner is to notify the court of whether a request for a trial or appeal has been filed with Japan Patent Office with regard to that patent right. The same applies if the Japan Patent Office issues a ruling dismissing the written request for the trial or appeal, if it renders a decision on the trial or appeal in such a trial or appeal, or if the request for such a trial or appeal is withdrawn.
  - (5) If the court is notified pursuant to the preceding paragraph that a request for a trial or appeal with regard to the relevant patent right, and if a document stating a method of allegation or evidence under Article 104-3, paragraph (1) has already been submitted in the litigation prior to the notice or the document is submitted for the first time after the notice, the court must notify the Commissioner of the Japan Patent Office of that fact.
  - (6) If the Commissioner of the Japan Patent Office is notified as provided in the preceding paragraph, the commissioner may request the court to deliver copies of any record of the litigation which the administrative judges consider necessary for the trial or appeal.

(Burden of Costs of a Trial or Appeal)

- Article 169 (1) The burden of costs in connection with a trial for patent invalidation or trial for invalidation concerning registration of a patent term extension must be decided by the court's own authority by a trial decision if the trial ends by a trial decision or by a ruling during the trial if the trial ends otherwise.
- (2) Articles 61 through 66, Article 69, paragraphs (1) and (2), Article 70, and Article

71, paragraph (2) (Bearing of litigation costs) of the Code of Civil Procedure apply mutatis mutandis to costs of a trial provided for in the preceding paragraph. In this case, the term "the Rules of the Supreme Court" in Article 71, paragraph (2) of the Code is deemed to be replaced with "Order of the Ministry of Economy, Trade and Industry".

- (3) The costs of an appeal against a rejection or a trial for correction are borne by the petitioner.
- (4) Article 65 (Burden of Costs in Joint Litigation) of the Code of Civil Procedure applies mutatis mutandis to the costs to be borne by the petitioner pursuant to the preceding paragraph.
- (5) The amount of costs in connection with a trial or appeal is determined by the Commissioner of the Japan Patent Office upon request, after the decision or ruling on the trial or appeal has become final and binding.
- (6) The scope, the amount and the payment of the costs in connection with a trial or appeal, and the payment required for undertaking a procedural act in a trial or appeal are governed by the relevant provisions of the Act on Costs of Civil Procedure (excluding provisions in Chapter II, Sections 1 and 3 of the Act) unless this is contrary to their nature .

(Enforceability of Rulings on the Amount of Costs)

Article 170 A final and binding ruling on the amount of costs for a trial or appeal has the same effect as that of an enforceable title of obligation.

## **Chapter VII Retrials**

(Request for a Retrial)

- Article 171 (1) A party or an intervenor may file a request for a retrial against a final and binding revocation decision and a final and binding trial decision.
- (2) Article 338, paragraphs (1) and (2), and Article 339 (Grounds for Retrial) of the Code of Civil Procedure apply mutatis mutandis to a request for a retrial as referred to in the preceding paragraph.

Article 172 (1) If the petitioner and a respondent in a trial or appeal have conspired to bring about a decision on the trial or appeal with the aim of harming the rights or interests of a third party, the third party may file a request for a retrial to overturn the final and binding decision.

- (2) A request for a retrial as referred to in the preceding paragraph must be filed against the petitioner and the respondent from the trial or appeal as joint respondents.

(Period for Request for Retrial)

Article 173 (1) A request for a retrial must be filed within 30 days from the date on which the petitioner becomes aware of the grounds for the retrial after the revocation decision or the decision on the trial or appeal becomes final and binding.

- (2) If a person filing a request for a retrial is unable to file the request within the period provided for in the preceding paragraph due to reasons beyond the person's control, notwithstanding the paragraph, the person may file the request within 14 days (if the person is an overseas resident, within two months) after the date on which those reasons cease to exist, but not later than six months after the end of the aforementioned period.
- (3) If a request for a retrial is filed on the grounds that the petitioner was not represented in accordance with the provisions of law, the period provided for in paragraph (1) is counted from the day following that on which the petitioner or the statutory agent is served and thereby learns that the revocation decision or the trial decision has been rendered.
- (4) A request for a retrial may not be filed once three years have passed since the date that the revocation decision or the trial decision became final and binding.
- (5) If grounds for a retrial arise after the revocation decision or the trial decision becomes final and binding, the period provided for in the preceding paragraph is counted from the day following that on which the grounds first arise.
- (6) Paragraphs (1) and (4) do not apply to a request for a retrial filed on the grounds that the trial decision is in conflict with a final and binding trial decision previously rendered.

(Application Mutatis Mutandis of Provisions on Trials and Appeals)

Article 174 (1) Articles 114, 116 through 120-2, and 120-5 through 120-8, Article 131, paragraph (1), the main clause of Article 131-2, paragraph (1), Article 132, paragraph (3), Article 154, Article 155, paragraphs (1) and (3), and Article 156, paragraphs (1), (3) and (4) apply mutatis mutandis to a retrial following a final and binding revocation decision.

- (2) Article 131, paragraph (1), the main clause of Article 131-2, paragraph (1), Article 132, paragraphs (3) and (4), Articles 133 and 133-2, Article 134, paragraph (4), Articles 135 through 147 and 150 through 152, Article 155, paragraph (1), Article 156, paragraphs (1), (3) and (4), Articles 157 through 160, the main clause of Article 167-2, Article 168, Article 169, paragraphs (3) through (6), and Article 170 apply mutatis mutandis to a retrial following a final and binding appeal decision from an appeal against a rejection.
- (3) Article 131, paragraph (1), the main clause of Article 131-2, paragraph (1), Article 132, paragraphs (1), (2) and (4), Articles 133 and 133-2, Article 134, paragraphs (1), (3) and (4), Articles 135 through 152, Article 154, Article 155, paragraphs (1) through (3), Article 156, paragraphs (1), (3) and (4), Articles 157,

167, and 168, Article 169, paragraphs (1), (2), (5) and (6), and Article 170 apply mutatis mutandis to a retrial following the final and binding trial decision from an trial for patent invalidation or from a trial for invalidation of registration of a patent term extension.

- (4) Articles 131, paragraphs (1) and (4), the main clause of Article 131-2, paragraph (1), Article 132, paragraphs (3) and (4), Articles 133 and 133-2, Article 134, paragraph (4), Articles 135 through 147 and 150 through 152, Article 155, paragraphs (1) and (4), Article 156, paragraphs (1), (3) and (4), Articles 157, 165, 167-2, and 168, Article 169, paragraph (3) through (6), and Article 170 apply mutatis mutandis to a retrial following the final and binding trial decision from a trial for correction.
- (5) Article 348, paragraph (1) (Scope of Proceedings) of the Code of Civil Procedure applies mutatis mutandis to a retrial.

(Restriction on the Effect of Patent Right Restored by Retrial)

Article 175 (1) If a patent rights under a revoked or invalidated patent or a patent rights under an invalidated registration of patent term extension are restored on retrial, or if the establishment of a patent right or the patent term extension with respect to a patent application or an application for registration of patent term extension which was rejected by a trial decision has been registered by a retrial, and the patent was granted on an invention that is a product, the patent right is not effective against any relevant product imported into or produced or acquired in Japan in good faith, after the revocation decision or the trial decision becomes final and binding but before the registration of the request for a retrial.

(2) If a patent rights under a revoked or invalidated patent or a patent rights under an invalidated registration of patent term extension are restored on retrial, or if the establishment of a patent right or the patent term extension is registered on retrial in respect of a patent application or an application for registration of patent term extension that was rejected in a trial decision the patent right is not effective against the following actions as performed after the revocation decision or the trial decision becomes final and binding and before the registration of the request for a retrial:

- (i) working the invention in good faith;
- (ii) if the patent was granted on an invention that is a product, producing, transferring, etc., importing or offering to transfer, etc. any article used in the production of the product in good faith;
- (iii) if a patent was granted on an invention that is a product, possessing the product for the purpose of transferring, etc. or exporting it in good faith;
- (iv) if the patent was granted on an invention that is a process, producing, transferring, etc., importing or offering to transfer, etc. article used in that process in good faith; and

- (v) if the patent was granted on an invention that is a process for producing a product, possessing the product produced by the process for the purpose of transferring, etc. or exporting it in good faith.

Article 176 If patent right under a revoked or invalidated patent or a patent right under an invalidated registration of patent term extension are restored on retrial, or if a patent right or the patent term extension is registered on retrial in respect of a patent application or an application to register a patent term extension that was rejected in a trial decision and a person has been engaging or preparing to engage in business that involves the working the invention in Japan in good faith, after the revocation decision or the trial decision becomes final and binding and before the registration of the request for a retrial, the person has a non-exclusive license under the patent right, but only within to the scope of the invention that the person is working or preparing to work and within the purview of that business of that business purpose.

Article 177 Deleted

### **Chapter VIII Litigation**

(Actions against Decisions on a Trial or Appeal)

- Article 178 (1) The Tokyo High Court has exclusive jurisdiction over any action against a revocation decision or a decision on a trial or appeal, a ruling to dismiss a written request for an opposition to a granted patent, a trial or appeal, or a retrial or a written request for correction as referred to in Article 120-5, paragraph (2) or Article 134-2, paragraph (1).
- (2) An action as referred to in the preceding paragraph may be instituted only by a party in the case, an intervenor, or a person whose application to intervene in the proceedings of the opposition to a granted patent, in the trial or appeal, or in the retrial is rejected.
  - (3) An action as referred to in paragraph (1) may not be instituted once thirty days have passed since the date that a certified copy of the decision on a trial or appeal, or the ruling was served.
  - (4) The time frame referred to in the preceding paragraph is inalterable.
  - (5) The chief administrative judge may establish an additional time frame to add to the inalterable time frame referred to in the preceding paragraph for a person in a distant location or an area with transportation difficulties by the judge's own authority.
  - (6) An action involving a matter for with regard to which a request for a trial or appeal can be filed may only be instituted as an action seeking to overturn a decision on a trial or appeal.

(The Proper Defendant)

Article 179 In an action as referred to in Article 178, paragraph (1), the Commissioner of the Japan Patent Office must be made the defendant; provided, however, that in an action in which a party seeks to overturn the trial decision from a trial for patent invalidation, or a trial for invalidation concerning registration of a patent term extension, or from a retrial as referred to in Article 171, paragraph (1) following the final and binding trial decision in a relevant trial, the petitioner or the respondent from the trial or retrial must be made the defendant.

(Notice of the filing of Action)

Article 180 If an action provided for in the proviso to the preceding Article is instituted, the court must notify the Commissioner of the Japan Patent Office thereof without delay.

- (2) In a case as referred to in the preceding paragraph, if the action seeks to overturn the trial decision from invalidity trial that was requested on a claim-by-claim basis or to overturn the trial decision in a retrial following the final and binding trial decision from such an trial for invalidation, the court must deliver the necessary documents for identifying claims involved in the action to the Commissioner of the Japan Patent Office.

(Opinion of the Commissioner of the Japan Patent Office in Litigation Rescinding a Decision on a Trial or Appeal)

Article 180-2 (1) If an action provided for in the proviso to Article 179 is instituted, the court may seek the opinion of the Commissioner of the Japan Patent Office regarding the application of this Act or regarding any other necessary matters relating to the case.

- (2) If an action provided for in the proviso to Article 179 is instituted, upon the court's consent, the Commissioner of the Japan Patent Office may express an opinion to the court regarding the application of this Act or regarding any other necessary matters relating to the case.
- (3) The Commissioner of the Patent Office may designate another Japan Patent Office official to express the commissioner's opinions as referred to in the preceding two paragraphs.

(Rescission of a Decision on a Trial or Appeal, or Ruling)

Article 181 (1) If the court finds grounds for the request in an action instituted as referred to in Article 178, paragraph (1), it must rescind the decision on a trial or appeal, or ruling.

- (2) Once the court's decision rescinding a decision on a trial or appeal, or ruling,

under the preceding paragraph has become final and binding, the administrative judges must carry out further proceedings and issue a decision on a trial or appeal, or ruling. In this case, if the court's decision rescinding the decision on a trial or appeal, or the ruling, becomes final and binding with regard to a part of the claims in a claim set for which a request for correction as referred to in Article 120-5, paragraph (2) or Article 134-2, paragraph (1) has been filed, in carrying out the proceedings, the administrative judges must rescind the decision on a trial or appeal, or the ruling, on the other claims in claim set.

(Delivery of the Original Copy of the Judicial Decision)

Article 182 In the cases listed in the following items with respect to an action under the proviso to Article 179, the court shall, without delay, deliver the document as provided in the corresponding item to the Commissioner of the Patent Office:

- (i) where the court procedures have been concluded by a judicial decision: the original copy of the judgment rendered by the court of each instance; and
- (ii) where the court procedures have been concluded by a means other than a judicial decision: the documents necessary for identifying claims pertaining to the said action.

(Composition of a Panel)

Article 182-2 With respect to an action as referred to in Article 178 (1), the ruling that proceedings and judicial decision are to be rendered by a panel consisting of five judges may be made if so determined by the panel.

(Action Protesting the Amount of Compensation)

Article 183 (1) If a person that has received an award as referred to in Article 83, paragraph (2), Article 92, paragraph (3) or (4), or Article 93, paragraph (2) is not satisfied with the amount of the compensation determined in the award, the person may institute an action demanding an increase or decrease in that amount.

- (2) An action as referred to in the preceding paragraph may not be instituted once six months have passed since the date that a certified copy of the award was served.

(The Proper Defendant)

Article 184 In an action as referred to in Article 183, paragraph (1), the following persons must be made the defendant:

- (i) in an action against an award as referred to in Article 83, paragraph (2), Article 92, paragraph (4), or Article 93, paragraph (2), the non-exclusive licensee, patentee or exclusive licensee; and
- (ii) in an action against an award as referred to in Article 92, paragraph (3), the

non-exclusive licensee or the other person referred to in Article 72.

Article 184-2 Deleted

### **Chapter IX Special Provisions for International Applications under the Patent Cooperation Treaty**

(The Filing of the Patent Application through an International Application)

Article 184-3 (1) An international application (limited to a patent application) to which an international filing date is accorded under Article 11, paragraph (1) or (2), item (b), or Article 14, paragraph (2) of the Patent Cooperation Treaty Done at Washington on June 19, 1970 (hereinafter referred to as "the treaty" in this Chapter), which specifies Japan as a designated state as referred to in Article 4, paragraph (1), item (ii) of the treaty is deemed to be a patent application that was filed on the international filing date.

(2) Article 43 (including as applied mutatis mutandis pursuant to Article 43-2, paragraph (2) (including when applied mutatis mutandis pursuant to Article 43-3, paragraph (3)) and Article 43-3, paragraph (3)) does not apply to an international application that is deemed to be a patent application pursuant to the preceding paragraph (hereinafter referred to as an "international patent application").

(Translations of International Patent Application Filed in a Foreign Language)

Article 184-4 (1) An applicant filing an international patent application in a foreign language (hereinafter referred to as a "foreign-language patent application") must submit Japanese translations of the description, claims, drawings (but only the descriptive text in the drawings; hereinafter the same applies in this Article), and abstract, provided for in Article 3, paragraph (2) of the treaty, as they stand on the international filing date provided for in paragraph (1) of the preceding Article (hereinafter referred to as the "international filing date") to the Commissioner of the Japan Patent Office, within two years and six months (hereinafter referred to as the "time limit for submitting national documents") from the priority date referred to in Article 2 (xi) of Treaty (hereinafter referred to as the "priority date"); provided, however, that an applicant filing a foreign-language patent application that has submitted documents provided for in paragraph (1) of the following Article between two months before the expiration of the time limit for submitting national documents and the end date of that time limit (excluding when the translations have been submitted prior to the submission of those documents) may submit the translations within two months from the date of submission of those documents (hereinafter referred to as the "special time limit



- for submitting translations").
- (2) In the case as referred to in the preceding paragraph, if the applicant filing the foreign-language patent application makes an amendment under Article 19, paragraph (1) of the Treaty, the applicant may, in lieu of submitting a translation of scope of the claims as provided in the preceding paragraph, submit a translation of the amended claims.
  - (3) If the translation of a description provided for in paragraph (1) and the translation of the claims provided in the preceding two paragraphs (hereinafter referred to as "translation of the description, etc.") are not submitted within the time limit for submitting national documents (in the case of a foreign-language patent application as referred to in the proviso to paragraph (1), within the special time limit for submitting translations; hereinafter the same applies in this Article), the international patent application is deemed to be withdrawn.
  - (4) The applicant filing an international patent application that is deemed to be withdrawn pursuant to the preceding paragraph may submit the translation of the description, etc. and translations of the drawings and abstracts provided to in paragraph (1) to the Commissioner of the Japan Patent Office pursuant to Order of the Ministry of Economy, Trade and Industry only within the time limit provided by Order of the Ministry of Economy, Trade and Industry; provided, however, that this does not apply if the applicant is found to have intentionally failed to submit the translation of the description, etc. within the time limit for submitting national documents.
  - (5) Translations submitted pursuant to the preceding paragraph are deemed to have been submitted to the Commissioner of the Japan Patent Office at a time just before the time limit for the submitting national documents.
  - (6) If an amendment under Article 19, paragraph (1) of the Treaty is made, an applicant submitting a translation of the claims provided for in paragraph (1) may further submit a Japanese translation of the amended claims no later than the date on which the time limit for the submitting national documents expires (if the applicant requests examination of the application within the time limit for submitting national documents, the time of the request; hereinafter referred to as the "standard time for national processing").
  - (7) The main clause of Article 184-7, paragraph (3) applies mutatis mutandis if a translation provided for in paragraph (2) or the preceding paragraph is not submitted.

(Submission of Documents and Order to Amend Procedures)

Article 184-5 (1) An applicant filing an international patent application must submit a document to the Commissioner of the Japan Patent Office within the time limit for submitting 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 inventor; and
  - (iii) matters provided by Order of the Ministry of Economy, Trade and Industry, including the international application number.
- (2) The Commissioner of the Japan Patent Office may order an amendment to be made with respect to a procedure within an adequate specified period of time in the following cases:
- (i) the document that must be submitted pursuant to the preceding paragraph is not submitted within the time limit for submitting national documents;
  - (ii) the procedure under the preceding paragraph does not comply with Article 7, paragraphs (1) through (3) or Article 9;
  - (iii) the procedure under the preceding paragraph does not comply with a formal requirements specified by Order of the Ministry of Economy, Trade and Industry;
  - (iv) the translation of the abstract that must be submitted pursuant to paragraph (1) of the preceding Article is not submitted within the time limit for submitting national documents (or, if the application is a foreign-language patent application as referred to in the proviso to paragraph (1) of the preceding Article, within the special time limit for submitting translations); and
  - (v) a fee that is to be paid pursuant to Article 195, paragraph (2) is not paid within the time limit for submitting national documents.
- (3) If a person that the Commissioner of the Japan Patent Office has ordered to make the amendment with respect to a procedure to the preceding paragraph does not make the amendment within the period of time the Commissioner specifies pursuant to that paragraph, the Commissioner may dismiss the international patent application.

(Effect of the Request or Description in an International Application)

Article 184-6 (1) The written application for an international patent application as of the international application date is deemed to be a written application submitted pursuant to Article 36, paragraph (1).

- (2) The description, as of the international filing date, of an international patent application filed in the Japanese (hereinafter referred to as a "Japanese-language patent application") or the translation of the description, as of the international filing date of a foreign-language patent application is deemed to be the description submitted with the written application pursuant to Article 36, paragraph (2); the claims, as of the international filing date, of a Japanese-language patent application or the translation of the claims, as of the international filing date, of a foreign-language patent application are deemed to be the claims submitted with the written application pursuant to Article 36, paragraph (2); the drawings, as of the international filing date, of a Japanese-

language patent application or the drawings, as of the international filing date , of a foreign-language patent application (other than the descriptive text in the drawings) and a translation of the descriptive text in those drawings as of that date are deemed to be drawings submitted with the written application pursuant to Article 36, paragraph (2); and the abstract of a Japanese-language patent application or a translation of the abstract of a foreign-language patent application is deemed to be the abstract submitted with the written application pursuant to that paragraph.

- (3) If a translation of claims amended under Article 19, paragraph (1) of the Treaty is submitted pursuant to Article 184-4, paragraph (2) or (6), notwithstanding the preceding paragraph, the translation of the amended claims is deemed to be the claims submitted with the written application pursuant to Article 36, paragraph (2).

(Amendments based on Article 19 of the Treaty to a Japanese-language Patent Application)

Article 184-7 (1) If an applicant of a Japanese-language patent application has made an amendment under Article 19, paragraph (1) of the Treaty, the applicant must submit a copy of the written amendment submitted under Article 19, paragraph (1) to the Commissioner of the Japan Patent Office on or before the date on which the standard domestic processing time falls.

- (2) If a copy of a written amendment is submitted pursuant to the preceding paragraph, the amendment under Article 17-2, paragraph (1) is deemed to have been made to the claims accompanying the request based on the copy of the written amendment; provided, however, that if the written amendment is communicated to the Japan Patent Office under Article 20 of the Treaty within the period provided for in the preceding paragraph, the amendment is deemed to have been made based on the written amendment.
- (3) If the procedure provided for in paragraph (1) is not undertaken by an applicant filing a Japanese-language patent application within the period for in paragraph (1), the amendment under Article 19, paragraph (1) of the Treaty is deemed not to have been made; provided, however, that this does not apply as provided in the proviso to the preceding paragraph.

(Amendment under Article 34 of the Treaty)

Article 184-8 (1) After making an amendment under Article 34, paragraph (2), item (b) of the Treaty, if that amendment concerns a Japanese-language patent application, the applicant filing the international patent application, must submit a copy of the written amendment submitted under Article 34, paragraph (2)(b) to the Commissioner of the Japan Patent Office , and if the amendment concerns a foreign-language patent application, the applicant must submit a Japanese

translation of the written amendment to the commissioner, by the date on which the standard time for national processing falls.

- (2) If a copy of a written amendment or a translation of a written amendment is submitted pursuant to the preceding paragraph, the amendment under Article 17-2, paragraph (1) is deemed to have been made to the description, claims or drawings attached to the written application based on the copy of the written amendment or the translation of the written amendment; provided, however, that if a written amendment to a Japanese-language patent application is communicated to the Japan Patent Office as under Article 36, paragraph (3), item (a) of the Treaty within the period provided for in the preceding paragraph, the amendment is deemed to have been made based on the written amendment.
- (3) If the procedure provided for in paragraph (1) is not undertaken by an applicant filing an international patent application within the period provided for in paragraph (1), the amendment under Article 34 (2), (b) of the Treaty is deemed not to have been made; provided, however, that this does not apply as provided in the proviso to the preceding paragraph.
- (4) If pursuant to paragraph (2), the amendment under Article 17-2, paragraph (1) is deemed to have been made to the description, claims or drawings attached to a written application in foreign-language patent application, that amendment is deemed to have been made through the submission of a mistranslation correction form as referred to in Article 17-2, paragraph (2).

(National Publication)

Article 184-9 (1) Unless the application in question is a foreign-language patent application in respect of which gazette in which the patent appears has already been published, the Commissioner of the Japan Patent Office must effect the national publication of the foreign-language patent application for which a translation has been submitted pursuant to Article 184-4, paragraph (1) or (4), without delay after the end of the time limit for submitting national documents (or, for a foreign-language patent application as referred to in the proviso to Article 184-4, paragraph (1), without delay after the end of the special time limit for submitting translations; hereinafter the same applies in this paragraph) (or, for an international patent application that the applicant has requested be examined within the time limit for submitting national documents and for which the international publication provided for in Article 21 of the Treaty (hereinafter referred to as "international publication") has been effected, after without delay after the request for the examination of the patent application; and a foreign-language patent application for which a translation of the description, etc. has been submitted pursuant to Article 184-4, paragraph (4) without delay, after the translation of the description, etc. is submitted).

- (2) National publication is effected through the publication of the following matters

in the patent gazette:

- (i) the name, and the domicile or residence of the applicant;
  - (ii) the filing number of the application;
  - (iii) the international filing date;
  - (iv) the name, and the domicile or residence of the inventor;
  - (v) the matters stated in the translations of the description and the descriptive text in the drawings provided in Article 184-4, paragraph (1); the matters stated in the translation of the claims as provided in the paragraph (or, if a translation has been submitted pursuant to paragraph (2) of the Article, the matter stated that translation); the matters stated in the translation provided for in paragraph (6) of the Article; the contents of the drawings (other than the descriptive text in the drawings); and the matters stated in the translation of the abstract (excluding matters whose publication in the patent gazette the Commissioner of the Japan Patent Office finds could disrupt public order or corrupt public morality);
  - (vi) the number and the date of the national publication; and
  - (vii) necessary matters beyond what is set forth in the preceding items.
- (3) Article 64, paragraph (3) applies mutatis mutandis if the matter stated in the translation of the abstract as referred to in item (v) of the preceding paragraph are published in the patent gazette pursuant to the preceding paragraph.
- (4) Article 64 does not apply to an international patent application.
- (5) The term "the publication of the application" in Article 48-5, paragraph (1), Article 48-6, the proviso to Article 66, paragraph (3), Article 128, Article 186, paragraph (1), items (i) and (iv)), and Article 193, paragraph (2), items (i), (ii), (vii) and (x) is deemed to be replaced with "international publication as referred to in Article 184-9, paragraph (1)" if an international patent application is a Japanese-language patent application, and is deemed to be replaced with "national publication as referred to in Article 184-9, paragraph (1)" if an international patent application is foreign-language patent application.
- (6) If a request for a certificate, etc., concerns a foreign-language patent application, the phrase "or the materials referred to in Article 67-2, paragraph (5)" in Article 186, paragraph (1), item (i) is deemed to be replaced with "or a written application, a description, claims, drawings, or abstract in an international application provided to in Article 3, paragraph (2) of the Patent Cooperation Treaty signed in Washington on June 19, 1970 (excluding those in an international patent application for which a patent right has been registered, or those in respect of which international publication has been effected)".
- (7) With respect to the matters that must be published in the patent gazette concerning an international patent application, the phrase "after the publication of the patent applications" in Article 193, paragraph (2), item (iii) is deemed to be replaced with "with regard to an international patent application, in respect of

which international publication has been effected".

(Effects of International Publication and National Publication)

Article 184-10 (1) If an applicant filing an international patent application issues written warning giving the details of the invention in the international patent application, or after the international publication of a Japanese-language patent application, or after the national publication of a foreign-language patent application, the applicant may file a claim compensation against a person that works the invention in the course of trade after being so warned and prior to the registration establishing a patent right, with a claim amount that corresponds to amount of money the applicant would be entitled to receive for the working of the invention if it were patented invention. The same applies to a claim against a person that knowingly, in the course of trade, and before the patent is registered works the invention linked to a Japanese-language patent application and claimed in an international patent application for which international patent application has been effected or against a person that knowingly, in the course of trade and before the patent is registered works the invention linked to a foreign-language patent application and claimed in an international publication has been effected.

(2) Paragraphs (2) through (6) of Article 65 apply mutatis mutandis to the exercise of a claim pursuant to the preceding paragraph.

(Special Provisions on Patent Administrators for Overseas Residents)

Article 184-11 (1) Notwithstanding Article 8, paragraph (1), prior to the standard time for national processing, a person filing an international patent application that is an overseas resident may undertake a procedures without recourse to a patent administrator,

(2) A person as prescribed in the preceding paragraph must appoint a patent administrator and notify the Commissioner of the Japan Patent Office of that fact at or after the standard time for national processing within the period specified by Order of the Ministry of Economy, Trade and Industry.

(3) If a person prescribed in paragraph (1) has not provided notification of appointment of a patent administrator within the period provided in the preceding paragraph, the Commissioner of the Japan Patent Office must notify the person of that fact.

(4) A person that has received a notice provided under the preceding paragraph may appoint a patent administrator and notify the Commissioner of the Japan Patent Office of that fact only within the period provided by Order of the Ministry of Economy, Trade and Industry.

(5) If no notification regarding the appointment of a patent administrator is filed within the period provided for in the preceding paragraph, the international

patent application is deemed to be withdrawn.

- (6) The applicant of an international patent application which has been deemed to have been withdrawn pursuant to the preceding paragraph may appoint a patent administrator and notify the Commissioner of the Japan Patent Office of that fact pursuant to Order of the Ministry of Economy, Trade and Industry only within the period prescribed by Order of the Ministry of Economy, Trade and Industry; provided, however, that this does not apply if the applicant is found to have intentionally failed to file a notification of appointment of a patent administrator within the period prescribed in paragraph (4).
- (7) The notification made pursuant to paragraph (4) or the preceding paragraph is deemed to be a notification made at the time of passage of the period provided in paragraph (2).
- (8) If a person as provided in paragraph (1) undertakes a procedure under Article 184-4, paragraph (4) through a patent administrator, the provisions of paragraphs (2) through (7) do not apply.

(Special Provisions on Amendments)

Article 184-12 (1) Notwithstanding the main clause of Article 17, paragraph (1), an amendment in respect of a procedure (other than an amendment as provided in Article 184-7, paragraph (2) and Article 184-8, paragraph (2)) may not be made in connection with a Japanese-language patent application unless it is after the procedure under Article 184-5, paragraph (1) has been undertaken and after the fee that is to be paid pursuant to Article 195, paragraph (2) has been paid; nor may such an amendment to made in connection with a foreign-language patent application, unless it is after the procedures under Article 184-4, paragraphs (1) or (4), under Article 184-5, paragraph (1) have been undertaken, after the fee to be paid pursuant to Article 195, paragraph (2) is paid, and after the standard time for national processing has lapsed.

- (2) With respect to the allowable scope of amendment to the description, claims or drawings of a foreign-language patent application, the phrase "an application written in a foreign language provided in Article 36-2, paragraph (2)" in Article 17-2, paragraph (2) is deemed to be replaced with "a foreign-language patent application as referred to in Article 184-4, paragraph (1)"; the phrase "the description, claims or drawings that originally attached to the written application (if the application is a foreign-language application as referred to in Article 36-2, paragraph (2), matter indicated in the translation of foreign-language documents as provided in Article 36-2, paragraph (2) that is deemed to constitute the description, claims and drawings under Article 36-2, paragraph (8) (or if the description, claims or drawing has been amended through the submission of a mistranslation correction form, matter indicated in the translation or the amended description, claims or drawings); the same applies in Article 34-2,

paragraph (1) and Article 34-3, paragraph (1))" in Article 17-2, paragraph (3) is deemed to be replaced with "a translation as referred to in Article 184-4, paragraph (1) of the description and drawings (limited to the descriptive text in the drawings) as of the international filing date as referred to in Article 184-4, paragraph (1) (hereinafter referred to as an "international filing date" in this paragraph), in an international patent application as referred to in Article 184-3, paragraph (2) (hereinafter referred to as the "international patent application" in this paragraph), a translation as referred to in Article 184-4, paragraph (1) of the claims of an international application date, in an international patent application (or if a translation of the claims amended under Article 19, paragraph (1) of the Patent Cooperation Treaty signed in Washington on June 19, 1970, has been submitted pursuant to Article 184-4, paragraph (2) or (6), that translation); or the drawings (excluding the descriptive text in the drawings) as of international application date, in an international patent application (hereinafter referred to as a "translations, etc." in this paragraph) (or if an amendment to the description, claims or drawings has been made through the submission of a mistranslation correction form, the translations, etc. and the amended description, claims or drawings)".

(Special Provisions for Registration in the Patent Register)

Article 184-12-2 Notwithstanding Article 27, paragraph (1), item (iv), a provisional exclusive license may not be registered in connection with Japanese-language patent application until after the procedures under Article 184-5, paragraph (1) has been undertaken and the fee that is to be paid pursuant to Article 195, paragraph (2) has been paid ;, nor may a provisional exclusive license be registered in connection with a foreign-language patent application until after the procedures under Article 184-4, paragraphs (1) or (4), or Article 184-5, paragraph (1) have been undertaken, the fee that in to be paid pursuant to Article 195, paragraph (2) has been paid, and, standard time for national processing has passed.

(Special Provisions on Patentability)

Article 184-13 In applying Article 29-2 to a case in which the other patent application or the application to register a utility model provided for in Article 29-2 is an international patent application or an international application to register a utility model referred to in Article 48-3, paragraph (2) of the Utility Model Act, in Article 29-2 of this Act, the phrase "in another patent application or in an application to register a utility model " is deemed to be replaced with "in another patent application or in an application to utility model registration application (other than a foreign-language patent application as referred to in Article 184-4, paragraph (1) or utility model registration application in a foreign



language as referred to in Article 48-4, paragraph (1) of the Utility Model Act which is deemed to have been withdrawn pursuant to Article 184-4, paragraph (3) of this Act or Article 48-4, paragraph (3) of the Utility Model Act)", the phrase "the patent application is published, or" is deemed to be replaced with "the patent application is published" the phrase "is published pursuant to Article 14, paragraph (3) of that Act subsequent to the filing of the relevant application, " is deemed to be replaced with "is published pursuant to Article 14, paragraph (3) of that Act subsequent to the filing of the relevant application, or international publication is effected as provided in Article 21 of the Patent Cooperation Treaty signed in Washington on June 19, 1970", and the phrase "in the description, claims for a patent, or in the claims or drawings for a utility model registration (or, for a foreign language as referred to in Article 36-2, paragraph (2), in the foreign-language documents referred to in Article 36-2, paragraph (1)) which originally attached to the written application" is deemed to be replaced with "in the description, claims, or drawings in the international application (or, for an application written in a foreign language as referred to in Article 36-2, paragraph (2), in the foreign-language documents referred to in Article 36-2, paragraph (1))", , as of the international application date referred to in Article 184-4, paragraph (1) of this Act or Article 48-4, paragraph (1) of the Utility Model Act.

(Special Provisions on Exception to Lack of Novelty of Invention)

Article 184-14 Notwithstanding Article 30, paragraph (3), after the standard time for national processing but within the period specified by Order of the Ministry of Economy, Trade and Industry, a person filing an international patent application and seeking to apply Article 30, paragraph (2) may submit a document to the Commissioner of the Japan Patent Office, stating this, as well as a document evidencing that the invention is one that has come to fall under one of the items of Article 29, paragraph (1) and to which Article 30, paragraph (2) can be applied.

(Special Provisions on Priority Claim Based on a Patent Application)

Article 184-15 (1) The proviso to Article 41, paragraph (1), and Article 41, paragraph (4) and Article 42, paragraph (2) do not apply to an international patent application.

- (2) In applying Article 41, paragraph (3) to a Japanese-language patent application, the phrase "or the publication of the application" in the Article is deemed to be replaced with "or the international publication is effected as prescribed in Article 21 of the Patent Cooperation Treaty signed in Washington on June 19, 1970".
- (3) In applying Article 41, paragraph (3) for a foreign-language patent application, the phrase "in the description, claims or drawings (in the case of an application written in a foreign language, foreign-language documents) originally attached to a written application for a patent application" in the Article is deemed to be

replaced with "in the description, claims or drawings (in the case of an application written in a foreign language, foreign-language documents) in the international application, as of the international filing date referred to in Article 184-4 (1)," and the phrase "or the publication of the application" is deemed to be replaced with "or the international publication is effected as prescribed in Article 21 of the Patent Cooperation Treaty signed in Washington on June 19, 1970".

- (4) In applying Article 41, paragraphs (1) through (3), and Article 42, paragraph (1), to a case in which an earlier application as referred to in Article 41, paragraph (1) of this Act is an international patent application or an international application to register a utility model as referred to in Article 48-3, paragraph (2) of the Utility Model Act, the phrase "in the description or claims for a patent, utility model registration, or drawings originally attached to the written application" in Article 41, paragraphs (1) and (2) is deemed to be replaced with "in the description, claims or drawings in the international application, as of the international filing date referred to in Article 184-4, paragraph (1) of this Act or Article 48-4, paragraph (1) of the Utility Model Act, "; the phrase "in the description, patent claim, utility model registration claims, or drawings originally attached to the written application of the earlier application" in Article 41, paragraph (3) is deemed to be replaced with "in the description, claim, or drawings in the international application as of the international application date referred to in Article 184-4, paragraph (1) of this Act or Article 48-4, paragraph (1) of the Utility Model Act", in respect of the earlier application"; the phrase "the earlier application is deemed to be published or" in Article 41, paragraph (3) is deemed to be replaced with "the international publication as prescribed in Article 21 of the patent Cooperation Treaty signed in Washington on June 19, 1970, is deemed to be effected with respect to the earlier application or the earlier application is deemed";, and the phrase "once the period provided by Order of the Ministry of Economy, Trade and Industry have passed since the filing date" in Article 42, paragraph (1) is deemed to be replaced with "at the stand time for national processing referred to in Article 184-4, paragraph (6) of this Act or Article 48-4, paragraph (6) of the Utility Model Act or once the period provided by Order of the Ministry of Economy, Trade and Industry have passed since the international application date referred to in Article 184-4, paragraph (1) of this Act or Article 48-4, paragraph (1) of the Utility Model Act, whichever is later".

(Special Provisions on the Conversion of Application)

Article 184-16 If an international application that is deemed, pursuant to Article 48-3, paragraph (1) or 48-16, paragraph (4) of the Utility Model Act, to be an application to register a utility model is a Japanese-language application to register a utility model as referred to in Article 48-5, paragraph (4) of that Act, it may not be converted into a patent application until after the procedure under

Article 48-5, paragraph (1) of that Act has been undertaken; if such an international application is a foreign-language application to register a utility model as referred to in Article 48-4, paragraphs (1) of that Act, it may not be converted into a patent application until after the procedure under Article 48-4, paragraphs (1) or (4), or Article 48-5, paragraph (1) of the Act have been undertaken; and in any case, it may not be converted into a patent application until after any fee that is to be paid pursuant to Article 54, paragraph (2) of that Act has been paid (or, if the international application is deemed to be an application to register a utility model pursuant to Article 48-16, paragraph (4) of the Act, until after the ruling provided in the paragraph).

(Limitation on Period for Request for Examination of an Application)

Article 184-17 The applicant filing an international patent application may not request for an examination of an Japanese-language patent application until after undertaking the procedure under Article 184-5, paragraph (1); may not request for an examination for a foreign-language patent application until after undertaking the procedures under Article 184-4, paragraphs (1) or (4), or Article 184-5, paragraph (1); and may not request for the examination of any international patent application and until after paying any fee that is to be paid pursuant to Article 195, paragraph (2); and a person other than the applicant filing the international patent application may not request for the examination of that international patent application until after the end of the time limit for the submitting national documents (or, if a foreign-language patent application as referred to in the proviso to Article 184-4, paragraph (1), until after the end of special time limit for submission of translation).

(Special Provisions on the Grounds for Rejection)

Article 184-18 In respect of an examiner's rejection, an opposition to a granted patent, or a trial for patent invalidation, as concerns a foreign-language patent application, the term "application written in a foreign language" in Article 49, item (vi), Article 113, items (i) and (v), and Article 123, paragraph (1), items (i) and (v) is deemed to be replaced with "foreign-language patent application referred to in Article 184-4, paragraph (1)", and the term "in foreign-language documents" in Article 49, item (vi), Article 113, item (v), and Article 123, paragraph (1), item (v) is deemed to be replaced with "the description, claims or drawings in the international application as of the international filing date referred to in Article 184-4, paragraph (1)."

(Special Provisions on Corrections)

Article 184-19 In respect of a request for a trial for correction as referred to in Article 120-5, paragraph (2) and Article 134-2, paragraph (1) and a request for a

correction trial as concerns a foreign-language patent application,, the term "application written in a foreign language" in Article 126, paragraph (5) is deemed to be replaced with "application written in a foreign language referred to in Article 184-4, paragraph (1)" and the term "foreign-language documents)" is deemed to be replaced with "the description, claims or drawings in the international application as of the international filing date referred to in Article 184-4, paragraph (1))."

- Article 184-20 (1) If a rejection as provided in Article 25, paragraph (1), item (a) of the Treaty or a declaration as provided in Article 25, paragraph (1), item (a) or (b) of the Treaty has been issued by the receiving office as referred to in Article 2, item (xv) of the Treaty, or if a finding as provided in Article 25, paragraph (1), item (a) of the Treaty has been made by the International Bureau referred to in Article 2, item (xix) of the Treaty in connection with an international application (meaning a patent application only) that lists Japan as a designated state as referred to in Article 4, paragraph (1), item (ii) of the Treaty, an applicant filing an international application as referred to in Article 2, item (vii) of the Treaty may petition the Commissioner of the Japan Patent Office pursuant to Order of the Ministry of Economy, Trade and Industry and within the period specified by Order of the Ministry of Economy, Trade and Industry, to, make the decision provided for in Article 25, paragraph (2), item (a) of the Treaty.
- (2) A person filing a petition as referred to in the preceding paragraph in connection with an international application filed in a foreign language must submit Japanese translations of the description, claims, drawings (limited to the descriptive text in the drawings), abstract and other international application documents specified by Order of the Ministry of Economy, Trade and Industry to the Commissioner of the Japan Patent Office at the time of the petition.
  - (3) Upon receiving the petition as referred to in paragraph (1), the Commissioner of the Japan Patent Office must decide whether the rejection, declaration or finding to which the petition was justified in light of the provisions of the Treaty and the Regulations based on the Patent Cooperation Treaty.
  - (4) If the Commissioner of the Japan Patent Office, pursuant to the preceding paragraph, decide a rejection, declaration or finding referred to in that paragraph was not justified in light of the provisions of the Treaty and the Regulations based on the Patent Cooperation Treaty, the international application subject to that decision is deemed to be a patent application filed on the day that it is found would have been the international filing date if no such rejection, declaration or finding had been made with respect to the international application.
  - (5) In respect of the publication of an international application that is deemed to be a patent application pursuant to the preceding paragraph, the phrase "the filing date of a patent application" in Article 64, paragraph (1) is deemed to be replaced

with "the priority date under Article 184-4, paragraph (1)", the terms "application written in a foreign language" and "foreign-language documents and foreign-language abstract" in Article 64, paragraph (2), item (vi) are deemed to be replaced with "an international application filed in a foreign language" and "description, claims, drawings, and abstract in the international application, as of the day that it is found would have been the international filing date as provided in Article 184-20, paragraph (4)", respectively.

(6) Article 184-3, paragraph (2), Article 184-6, paragraphs (1) and (2), Article 184-9, paragraph (6), Articles 184-12 through 184-14, Article 184-15, paragraphs (1), (3) and (4), and Articles 184-17 through 184-19 apply mutatis mutandis to an international application that is deemed to be a patent application under paragraph (4). In this case, the technical replacement of terms necessary for the application of the provisions is provided by Cabinet Order.

## **Chapter X Miscellaneous Provisions**

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

Article 185 In applying of Article 27, paragraph (1), item (i), Article 65, paragraph (5) (including as applied mutatis mutandis pursuant to Article 184-10, paragraph (2)), Article 80, paragraph (1), Article 97, paragraph (1), Article 98, paragraph (1), item (i), Article 111, paragraph (1), item (ii), Article 114, paragraph (3) (including as applied mutatis mutandis pursuant to Article 174, paragraph (1)), Article 123, paragraph (3), Article 125, Article 126, paragraph (8) (including as applied mutatis mutandis pursuant to Article 134-2, paragraph (9)), Article 128 (including as applied mutatis mutandis pursuant to Article 120-5, paragraph (9) and Article 134-2, paragraph (9)), Article 132, paragraph (1) (including as applied mutatis mutandis pursuant to Article 174, paragraph (3)), Article 175 or 176, or Article 193, paragraph (2), item (v) of this Act, or of Article 20, paragraph (1) of the Utility Model Act to the granting of a patent or patent with two or more claims, the patent is deemed to have been granted, or the patent right is deemed to exist, on a claim-by-claim basis.

(Request for Certificate)

Article 186 (1) Any person may file a request with the Commissioner of the Japan Patent Office to be issued a certificate, a certified copy of documents in connection with the patent, may request to inspect or copy documents in connection with the patent, or to be issued a document that shows the information that has been recorded in a part of the Patent Register that is stored magnetic tapes; provided, however, that this does not apply with respect to the following documents, if the Commissioner of the Japan Patent Office finds it to be necessary to keep them confidential:

- (i) a written application, or the description, claims, drawings or abstract attached to a written application, foreign-language documents, a foreign-language abstract or a document from the examination of a patent application (unless an establishment of a patent right has been registered or the publication of a patent application has been effected), or the materials referred to in Article 67-5, paragraph (2);
  - (ii) documents concerning an advisory opinion on the technical scope of a patented invention, with respect to which a party in the case has given notice that a trade secret owned by the said party in the case has been described;
  - (iii) documents concerning an award to which parties or non-parties with registered rights under the patent, or a non-exclusive licensee that has stated an opinion pursuant to Article 84-2, have given notice that proprietary trade secrets of those persons have been described;
  - (iv) documents from an appeal against a rejection (unless a patent has been registered in connection with the patent application involved in the case or the publication of a patent application has been effected);
  - (v) documents from a trial for patent invalidation, from a trial for invalidation of registration of a patent term extension or from a retrial following a final and binding trial decision from either such trial for invalidation, if a party to the case or an intervenor has given notice that a proprietary trade secret of the party or intervenor is included in those documents;
  - (vi) documents that are likely to cause damage to an individual's reputation or peaceful existence; and
  - (vii) documents which are likely to injure public policy.
- (2) If the Commissioner of the Japan Patent Office approves a request as referred to in the main clause of the preceding paragraph in respect of a document set forth in one of items (i) through (vi) of that paragraph, the commissioner must notify the person that submitted that document of this and indicate the reasons for approving it.
- (3) The provisions of the Act on Access to Information Held by Administrative Organs (Act No. 42 of 1999) do not apply to documents concerning patents or the part of the Patent Register that is stored on magnetic tapes.
- (4) The provisions of Chapter V, Section 4 of the Act on the Protection of Personal Information (Act No. 57 of 2003) do not apply to personal information held (meaning the personal information held that is provided for in Article 60, paragraph (1) of the Act) recorded in the documents concerning patents and the part of the Patent Register that is stored on magnetic tapes.

#### (Patent Marking)

Article 187 A patentee, exclusive licensee, or non-exclusive licensee must endeavor to mark a product that constitutes a patented invention, a product produced by a

process that constitutes a patent invention (hereinafter referred to as a "patent product"), or the packaging of the patented product, with a mark (hereinafter referred to as a "patented mark") as provided by Order of the Ministry of Economy, Trade and Industry, indicating that the product or process constituting the invention is patented.

(Prohibition of False Marking)

Article 188 It is prohibited for any person to take the following actions:

- (i) putting a patent mark or a mark that could be confused with a patent mark on a non-patented product or the packaging of a non-patent product;
- (ii) transferring, etc. or displaying for the purpose of transferring, etc. a non-patented product, or the packaging of a non-patented product, that bears a patent mark or a mark that could be confused with a patent mark;
- (iii) representing a non-patented product to be in any way connected with a patent in an advertisement, or making a representation in an advertisement that could be confused with meaning this, in order to cause that product to be produced or used, or for the purpose of transferring, etc. that product; or
- (iv) representing a non-patented process to be in any way connected with patent in advertisement, or making a representation in an advertisement, or making a representation in an advertisement that could be confused with meaning this, in order to cause that the process to be used, or in order to transfer or rent out the process.

(Service)

Article 189 Beyond what is provided in this Act, documents to be served are specified by Order of the Ministry of Economy, Trade and Industry.

Article 190 Article 98, paragraph (2), Articles 99 through 103, Articles 105 and 106, Article 107, paragraphs (1) (excluding items (ii) and (iii)) and (3), and Article 109 (Service) of the Code of Civil Procedure apply mutatis mutandis to the service of documents specified in this Act or by Order of the Ministry of Economy, Trade and Industry as referred to in the preceding Article. In this case, the term "a court clerk" in Articles 98, paragraph (2) and Article 100 of the Code of Civil Procedure is deemed to be replaced with "an official designated by the Commissioner of the Japan Patent Office, or the trial or appeal clerk"; the phrase "by mail or by court execution officer" in Article 99, paragraph (1) of the Act is deemed to be replaced with "by mail"; and the phrase "if it is impossible for service to be effected pursuant to the provisions of the preceding Article, the court clerk" in Article 107, paragraph (1) of the Act is deemed to be replaced with "if it is impossible for service to be effected pursuant to the provisions of the preceding Article or if documents from an examination are to be served, the

official designated by the Commissioner of the Japan Patent Office, or a trial or appeal clerk"; and the phrase "the Rules of the Supreme Court" in article 107, paragraph (1) of the Act is deemed to be replaced with "Order of the Ministry of Economy, Trade and Industry".

Article 191 (1) An official designated by the Commissioner of the Japan Patent Office, or the trial or appeal clerk may use service by publication in the following cases:

- (i) if the domicile or residence of the person to be served or any other place where the person is to be served is unknown;
  - (ii) if the service cannot be effected pursuant to Article 107, paragraph (1) (excluding items (ii) and (iii)) of the Code of Civil Procedure as applied mutatis mutandis pursuant to Article 190 of this Act;
  - (iii) if the situation of difficulty in dispatching the documents pursuant to paragraph (2) of the following Article continues for a period of six months.
- (2) Service by publication is effected by publishing a notice in the official gazette and the patent gazette that documents to be served can be served on the person to be served at any time, and by posting the notice on the noticeboard of the Japan Patent Office or by displaying a copy of the notice on the screen of a computer in the office of the Japan Patent Office so that it can be viewed.
- (3) Service by publication takes effect once 20 days have passed since the day the relevant indication is published in the official gazette.

Article 192 (1) If an overseas resident has a patent administrator, the patent administrator is the one must be served.

- (2) Where an overseas resident has no patent administrator, documents may be dispatched by registered mail, etc. (refers to registered mail or service of correspondence delivery that is prescribed by Ordinance of the Ministry of Economy, Trade and Industry as being equivalent to registered mail; hereinafter the same shall apply in paragraph (3)).
- (3) If a document is sent by registered mail, etc., pursuant to the preceding paragraph, it is deemed to be served at the time it is sent.

(Patent Gazette)

Article 193 (1) The Japan Patent Office publishes the patent gazette (Tokkyo Koho).

- (2) Beyond the matters provided for in this Act, the patent gazette must publish:
  - (i) examiners' decisions to reject patent application, the waiver, withdrawal or dismissal of patent application after the publication of the patent applications, and withdrawal of an application to register a patent term extension;
  - (ii) successions to the right to the grant of a patent after the publication of a patent application;



- (iii) amendments of the descriptions, claims or drawings attached to written applications under Article 17-2, paragraph (1) after the publication of the patent application (in the case of an amendment under one of the items in the proviso to that paragraph, this is limited to an amendment made through the submission of a mistranslation correction form);
- (iv) requests for the examination of an application under Article 48-3, paragraph (5) (including when applied mutatis mutandis pursuant to paragraph (7) of the Article);
- (v) forfeiture of patent (excluding forfeiture at the expiration of the patent term and forfeiture under Article 112, paragraph (4) or (5)) or the restoration of the same (limited to a restoration under Article 112-2, paragraph (2));
- (vi) oppositions to a granted patent, or trials, appeals, or retrials, or withdrawals thereof;
- (vii) final and binding rulings on oppositions to a granted patent, final and binding decisions on trials and appeals, and or final and binding retrial decisions (but only to if a patent application for which the establishment of a patent right is registered or patent application is published);
- (viii) matters stated in the corrected descriptions and claims, and the contents of drawings (limited to those corrected following a final and binding decision on a trial or appeal to correct them);
- (ix) requests for awards, withdrawal of request for awards and the awarding of awards; and
- (x) final and binding judgments in an action under Article 178, paragraph (1) (limited to when the establishment of a patent right has been registered or the publication of the patent application has been effected).

(Submission of Documents)

Article 194 (1) The Commissioner of the Japan Patent Office or the examiner may request a party to a case to submit documents or other materials that are necessary for a procedure other than one relating to an opposition to a granted patent, a trial, appeal, or retrial.

(2) The Commissioner of the Japan Patent Office or the examiner may request the relevant administrative agency, educational institution or any other organizations to conduct an investigation that is necessary to the examination.

(Fees)

Article 195 (1) The following persons must pay the amount of fees that Cabinet Order specifies in view of the actual costs:

- (i) a person filing a request for the extension of a period as under Article 4, Article 5, paragraph (1), Article 108, paragraph (3), or a request for a change of date as under Article 5, paragraph (2);

- (ii) a person filing a request for re-issuance of a patent certificate;
  - (iii) a person filing notification of a succession pursuant to Article 34, paragraph (4);
  - (iv) a person filing a request for issuance of a certificate pursuant to Article 186, paragraph (1);
  - (v) a person filing a request for issuance of a certified copy of documents or an extract of documents pursuant to Article 186, paragraph (1);
  - (vi) a person filing a request to inspect or copy documents pursuant to Article 186, paragraph (1); and
  - (vii) a person filing a request to be issued a document that shows the information that has been recorded in a part of the Patent Register that is stored on magnetic tapes, pursuant to Article 186, paragraph (1).
- (2) A person set forth in the center column of the attached table must pay the amount of fees that Cabinet Order specifies within the scope of the amount of money set forth in the corresponding right-hand column of the table.
- (3) Notwithstanding the provisions of the preceding paragraph, if the number of claims increases due to an amendment of the claims attached to the written application for the patent application after a person other than the applicant of the patent files a request for examination of an application, the fees for the request for examination of the patent application which is payable pursuant to the preceding paragraph in respect of the increased claims must be paid by the applicant of the patent.
- (4) The three preceding paragraphs do not apply if the person that would be required to pay the fee pursuant to those paragraphs is the State.
- (5) If the a patent or a right to the grant of patent is held under the joint ownership of the State and a person other than the State, and their shares have been agreed upon, notwithstanding the provisions of paragraph (1) or (2), the fees that is payable by the State and the person other than the State pursuant to those provisions in respect of their own patent or right to the grant of a patent (but only a fee specified by Cabinet Order which is other than for the request for examination) is the amount arrived at by multiplied the fee provided for in those provisions by the percentage that represents the share of the person other than the State, and this is amount that the person other than the State must pay.
- (6) If the right to the grant of a patent is held under joint ownership with the State or a person receiving a reduction in or exemption from the fees for filing a request for examination as under the following Article or Article 195-2-2 or other laws or regulations (hereinafter in this paragraph referred to as a "reduction or exemption"), and the joint owner's shares of the right to the grant of a patent have been agreed upon, notwithstanding the provisions of paragraph (2), the amount of fee for filing a request for examination that is payable by the persons pursuant to paragraph (2) in respect of their own right to the grant a patent is

the sum total calculated by first multiplying, for each joint owner other than the State, the applicable fee for filing the request for examination provided for in that paragraph (for a person receiving a reduction or exemption, this means the fee provided for in that paragraph less that reduction or exemption) by the percentage that represents that person's share and then adding together the amounts so arrived at, and this sum total is the persons other than the State must pay.

- (7) If the amount of a fee as calculated pursuant to one of the two preceding paragraphs is not a multiple of ten yen, the amount of that fee is rounded down to the nearest multiple of ten yen.
- (8) Payment for the fees referred to in paragraphs (1) through (3) must be made with patent revenue stamps, pursuant to Order of the Ministry of Economy, Trade and Industry; provided, however, that if so stipulated by Order of the Ministry of Economy, Trade and Industry, a cash payment may be made.
- (9) If the patent application is waived or withdrawn after the examination of the application is requested and before the issuance of an order or notice as allows or before the service of certified copy of the examiner's decision as follow, at the request of the person that paid the fee for requesting for examination pursuant to paragraph (2), the amount specified by Cabinet Order is refunded:
  - (i) an order under Article 39, paragraph (6);
  - (ii) a notice under Article 48-7;
  - (iii) a notice under Article 50; or
  - (iv) service of a certified copy of the examiner's decision under Article 52, paragraph (2).
- (10) A request for a refund of fees under the preceding paragraph may not be filed once six months have passed since the date on which the patent application was waived or withdrawn.
- (11) Fees paid in excess or in error are refunded at the request of the person that paid them.
- (12) A refund of fees under the preceding paragraph may not be filed once one year has passed since the date those fees were paid.
- (13) If a person that makes a request for a refund of fees under paragraph (9) or paragraph (11) is unable to make the request within the period provided in paragraph (10) or the preceding paragraph due to reasons beyond the person's control, the person may, notwithstanding these provisions, make the request within 14 days (if the person is an overseas resident, within two months) from the date on which the reasons ceased to be applicable, but not later than six months following the passage of the period prescribed in these provisions.

(Reduction of or Exemption from Fees for Request for Examination of an Application)

Article 195-2 If the Commissioner of the Japan Patent Office finds that a person requesting the examination of the person's own patent application and meeting the requirements that Cabinet Order specifies in consideration financial resources, is having difficulty paying the fee for requesting for the examination of the application, the Commissioner of the Japan Patent Office may, pursuant to Cabinet Order, reduce the fees payable for the request for examination of the application pursuant to paragraph (2) of the preceding Article or exempt the person from paying that fee.

Article 195-2-2 The Commissioner of the Patent Office may, pursuant to the provisions of Cabinet Order, grant a person that files a request for examination of the persons own patent application and falls within the category of person specified by Cabinet Order under Article 109-2(1), a reduction of, or exemption from, the fees for the request for the examination for the application payable under Article 195(2).

(Exclusion from Application of the Administrative Procedures Act)

Article 195-3 Chapters II and III of the Administrative Procedures Act (Act No. 88 of 1993) do not apply to dispositions under this Act or an order issued pursuant to this Act.

(Restriction on Request for Review under Provisions of Administrative Complaint Review Act)

Article 195-4 No request for review shall be available under the provisions of the Administrative Complaint Review Act with regard to an examiners decision, revocation decision, or a trial decision, or a ruling to dismiss a statement of opposition to a granted patent, a written request for a trial or retrial or a written request for correction under Article 120-5(2) or Article 134-2(1), or against dispositions against which no appeal lies in accordance with this Act, or inaction thereof.

## **Chapter XI Penal Provisions**

(The Crime of Infringement)

Article 196 An person that infringes a patent right or violates an exclusive license (other than a person committing an act that is deemed to constitute the infringement of a patent right or violation of an exclusive license pursuant to Article 101) is subject to punishment by imprisonment for a term not exceeding ten years or a fine not exceeding 10,000,000 yen, or a combination thereof.

Article 196-2 A person that commits an act that is deemed to constitute the infringement of a patent right or violation of an exclusive license pursuant to Article 101 is subject to punishment by imprisonment for a term not exceeding five years or a fine not exceeding 5,000,000 yen or a combination thereof.

(The Crime of Fraud)

Article 197 A person that obtains a patent, registers a patent term extension, or is issued a ruling on an opposition to a granted patent or a decision on a trial or appeal by means of a fraudulent act is subject to punishment by imprisonment for a term not exceeding three years or a fine not exceeding 3,000,000 yen.

(Crime of False Marking)

Article 198 A person that violates Article 188 is subject to punishment by imprisonment for a term not exceeding three years or a fine not exceeding 3,000,000 yen.

(The Crime of Perjury)

Article 199 (1) A witness, expert or interpreter that has sworn under oath pursuant to this Act and then offered a false statement, expert opinion, or false interpretation to the Japan Patent Office or the court commissioned thereby is subject to punishment by imprisonment for a term between three months and ten years.

(2) If a person that has committed the crime referred to in the preceding paragraph makes a voluntary confession before a certified copy of the judgment in the case is served, or before a ruling on an opposition to a granted patent or a decision on a trial or appeal has become final and binding, the relevant punishment may be reduced or remitted.

(The Crime of Disclosing Confidential Information)

Article 200 A present or former official of the Japan Patent Office that discloses or misappropriates confidential information about an invention claimed in a pending patent application that the official has learned in connection with official duties is subject to punishment by imprisonment for a term not exceeding one year or a fine not exceeding 500,000 yen.

Article 200-2 The disclosing or theft of any acquired secret concerning the investigation by any person(s) who is/are or was/were the investigator(s), shall be punishable by imprisonment with work for a term not exceeding a year or a fine not exceeding 500,000 yen.

(The Crime of Violating a Confidentiality Protective Order)

Article 200-3 (1) A person that violates a confidentiality protective order is subject to punishment by imprisonment for a term not exceeding five years or a fine not exceeding 5,000,000 yen or a combination thereof.

(2) The crime referred to in the preceding paragraph may not be prosecuted unless a complaint is filed.

(3) The crime referred to in paragraph (1) also applies to person that commits that crime outside Japan.

(Dual Liability)

Article 201 (1) If the representative of a corporation, or the agent, employee or other worker of a corporation or an individual commits a violation of the provisions set forth in one of the following items in connection with business of that corporation or individual, beyond the offender being subject to punishment, the corporation is subject to punishment by a fine prescribed in the relevant item and the individual is subject to punishment by a fine prescribed in the relevant Article referred to in the that item:

(i) Article 196, Article 196-2, or Article 200-2, paragraph (1): a fine not exceeding 300 million yen; and

(ii) Article 197 or 198: a fine not exceeding 100 million yen.

(2) In a case as referred to in the preceding paragraph, a complaint as referred to in Article 200-2, paragraph (2) which is filed against the offender also has effect against the corporation or individual and a complaint that is filed against the corporation or individual also has effect against the offender.

(3) If a fine is imposed on a corporation or individual pursuant to paragraph (1) in connection with a violation referred to in Article 196 or 196-2, or Article 200-2, paragraph (1), the period of prescription is governed by the same rules as those for crimes in the provisions of those provisions.

(Civil Fine)

Article 202 If a person that has sworn under oath pursuant to Article 207, paragraph (1) of the Code of Civil Procedure as applied pursuant to Article 151 (including as applied mutatis mutandis pursuant to Article 71, paragraph (3), Article 120 (including as applied mutatis mutandis pursuant to Article 174, paragraph (1)) and Article 174, paragraphs (2) through (4) of this Act) offers a false statement to the Japan Patent Office or the court commissioned thereby, the person is subject to punishment by a civil fine not exceeding 100,000 yen.

Article 203 A person that, pursuant to this Act, has been summoned by the Japan Patent Office or the court commissioned thereby, but that, without a legitimate reason for doing so, fails to appear or refuses to swear under oath, offer a

statement, testify, give an expert opinion or provide interpretation is subject to punishment by a civil fine not exceeding 100,000 yen.

Article 204 A person that, pursuant to this Act, is ordered by the Japan Patent Office or the court commissioned thereby to submit or present documents or other materials for examination or for the preservation of evidence, but that, without a legitimate reason for doing so, does not comply with that order is subject to punishment by a civil fine not exceeding 100,000 yen.

### Supplementary provisions (Extract)

Appended Table (In relation to Article 195)

	A person(s) who shall pay fees	Amounts
1	A person filing a patent application (excluding one in the following item)	16,000 yen per case
2	A person filing a written application in foreign language	26,000 yen per case
3	A person responsible for the procedures under Article 38-3(3)	16,000 yen per case
4	A person responsible for the procedures under Article 184-5(1)	16,000 yen per case
5	A person responsible for the procedures under Article 184-20(1)	16,000 yen per case
6	A person filing an application for the registration of extension of the duration of a patent right; (1) The registration of extension under Article 67(2). (2) The registration of extension under Article 67(4).	43,600 yen per case 74,000 yen per case
7	A person filing a request for extension of time limits under Article 5(3) (excluding that with regard to the time limit designated under Article 50)	4,200 yen per case
8	A person filing a request for extension of time limits under Article 5(3) (that of the time limit designated under Article 50 only)	68,000 yen per case

9	A person requesting an examination of an application	168,600 yen per case plus 4,000 yen per claim
10	A person amending a description, scope of claims or drawings through the submission of a statement of correction of incorrect translation	19,000 yen per case
11	A person undertaking any of the procedures pursuant to Article 36-2, paragraph (6), the provisions in parentheses of Article 41, paragraph (1), item (i), Article 43-2, paragraph (1) (including as applied mutatis mutandis pursuant to Article 43-3, paragraph (3)), Article 48-3, paragraph (5) (including as applied mutatis mutandis pursuant to Article 48-3, paragraph (7)), Article 112-2, paragraph (1), Article 184-4, paragraph (4) or Article 184-11, paragraph (6) (excluding a person who needs to undertake any of the procedures prescribed in these provisions due to reasons beyond the person's control)	297,000 yen per case
12	A person requesting an advisory opinion under Article 71(1)	40,000 yen per case
13	A person requesting an award	55,000 yen per case
14	A person requesting canceling of an award	27,500 yen per case
15	a patent opponent	16,500 yen per case plus 2,400 yen per claim
16	a person applying intervention in proceedings on an opposition to a granted patent	11,000 yen per case
17	A person filing a request for a trial or retrial (excluding one in the following item)	49,500 yen per case plus 5,500 yen per claim



18	A person filing a request for a trial against an examiner's decision of refusal of the registration of extension of the duration of a patent right, a trial for invalidation of the registration of extension of the duration of a patent right, or a retrial against the final and binding administrative judge's decision in these trials.	55,000 yen per case
19	A person filing a request for a correction of the description, scope of claim(s) or drawing(s)	49,500 yen per case plus 5,500 yen per claim
20	A person applying intervention in a trial or retrial.	55,000 yen per case