

## **Outline of the Act of Partial Revision of the Patent Act and other Acts (promulgated on May 21, 2021)**

The spread of the COVID-19 pandemic has led to major changes in economic activities toward such as digitalization, remote work and contact-less services. To address these changes, the Patent Act and other Acts were revised and the Act of Partial Revision of the Patent Act and other Acts was promulgated on May 21 of this year, with the following purposes: (1) developing new procedures (e.g., digitalization of procedures) to address the spread of the COVID-19 pandemic, (2) reviewing the protection of rights to address changes in corporate activities that accompany the advancement of digitalization and other technologies and (3) enhancing the foundation of the intellectual property systems, including reviews of procedures for litigation and fee structures.

The Act shall come into effect as from October 1, 2021 for the said (1) (“using credit card and other means of payment at specific service counters” described below at 1. (2) shall come into effect as from April 1, 2022), and as from April 1, 2022 for the said (2) and (3).

We summarized the Act as follows, which we hope you will find helpful.

### **1. Developing new procedures (e.g., digitalization of procedures) to address the spread of the COVID-19 pandemic**

#### **(1) Oral proceedings for trials by video conferencing [Patent•Utility•Design•Trademark]**

In trials for invalidation of patents, etc., oral proceedings have been conducted by appearing in person in the Trial Court. This will become possible via a video conference system at the decision of the chief administrative judge.



**(2) Abolition of the depositing of patent revenue stamps and the introduction of alternative means of fee payment [Property]**

Users will be allowed to pay patent and other fees in advance using bank transfers and other transfer methods (abolishment of advance payment by revenue stamps) or using credit card and other means of payment at specific service counters.

**(3) Digitization of procedures for international design and trademark applications [Design•Trademark]**

Procedures will be simplified to inform applicants of the decisions on registration of their designs or trademarks filed as international applications (e.g., allowing the JPO to electronically send such notifications via the International Bureau instead of sending them by postal mail which may stop in response to the spread of the COVID-19 pandemic).

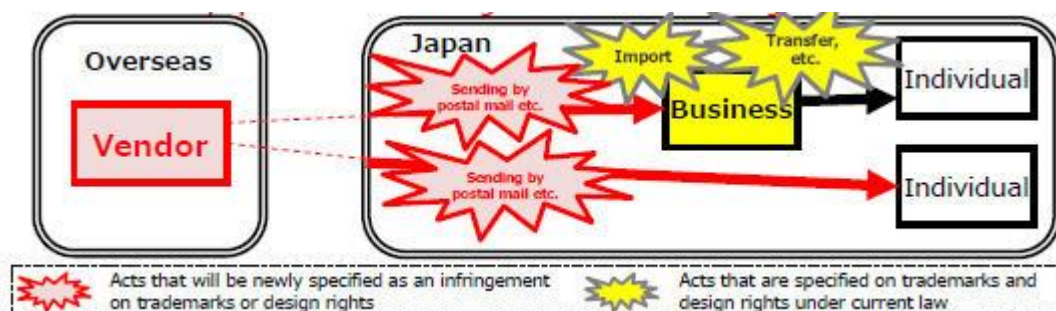
**(4) Exemption from the payment of surcharges due to processing periods expiring as a result of a disaster, etc. [Patent•Utility•Design•Trademark]**

If the payment for patent fees, etc. is overdue due to the spread of infectious diseases or a disaster, etc., the payment of additional surcharges will be exempted for the relevant period of time.

**2. Reviewing the protection of rights to address changes in corporate activities in line with the advancement of digitalization and other technologies**

**(1) Tightening regulations on the influx of counterfeit goods from overseas [Design•Trademark]**

In response to increases in the importing of counterfeit goods for private use, overseas vendors bringing counterfeit goods into Japan commercially via postal mail, etc. will be newly specified as an infringement of trademark rights.



**(2)Review of requirements for consent of non-exclusive licensees in trials for correction, etc.**

**[Patent•Utility•Design]**

In response to the increasing complexity of licensing forms of patent rights, etc. along with advancement of digital technologies, etc., obtaining consent from non-exclusive licensees (licensed persons) is no longer required for licensors in correcting patent rights, etc.

**(3)Relaxation of requirements for reinstatement of patent rights, etc.**

**[Patent•Utility•Design•Trademark]**

The requirements will be relaxed for reinstatement of rights which are lost due to the failure to comply with prescribed time limits. Specifically, it is as follows (for patents):

- ① Where, in a patent application in foreign language, it is deemed unintentional that the translation of description, etc. fails to be submitted within the prescribed period of time, the said translation may be submitted within a certain period.
- ② Where, in a patent application with a claim for priority, it is deemed unintentional that the patent application fails to be filed within the period of time during which the priority can be claimed, the said priority may be claimed within a certain period.
- ③ Where, in a request for examination of patent application, it is deemed unintentional that the request fails to be filed within the period of time during which the request can be filed, the said request may be filed within a certain period.
- ④ Where, in a late payment of patent fees, it is deemed unintentional that the late payment fails to be made within the prescribed period of time, the said late payment may be made within a certain period.
- ⑤ Where, in a notification of appointment of patent administrator in an international patent application, it is deemed unintentional that the notification fails to be made to the Commissioner of the Patent Office within the prescribed period of time, the said notification may be made within a certain period.
- ⑥ The maximum amounts of fees to be paid by persons undertaking the procedures stipulated in ① to ⑤ shall be established.

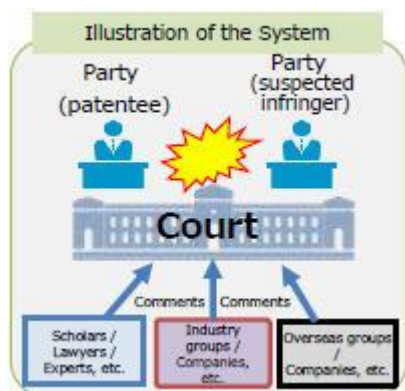
**3. Enhancing the foundation of intellectual property systems**

**(1)Introduction of a system for calling for third-party comments in patent infringement litigation [Patent•Utility•Attorney]**

- ① Introduction of a system that allows courts to call for comments from a wide range of third parties in patent infringement litigation.
- ② Supplement of the collection of evidence by parties concerned so that courts can make

judgments based on a wide range of comments in cases which significantly impact the society.

- ③ Allowing patent attorneys to respond to consultations under the system for calling for third-party comments.



## **(2) Review of the fee structure for patent fees, etc.**

### **[Patent•Utility•Design•Trademark•International]**

To secure the balance of income and expenditure in response to the increased examination burden and digitalization of procedures, the fee structure for patent fees, etc. was reviewed to conclude that the maximum amounts of patent fees, etc. shall be statutorily established, and the said amounts shall be specified by a Cabinet Order.

## **(3) Review of the patent attorney system [Attorney]**

- ① Services of agriculture, forestry and fishery-related intellectual property were added as those that can be conducted by patent attorneys.
- ② Introduction of “single-person business corporation system” that allows a single patent attorney to establish a patent business corporation.
- ③ Change of the Japanese name of “Patent Business Corporation” to “Attorney Corporation (Benrishi Hojin)”.

Note) Patent Act (Patent), Utility Model Act (Utility), Design Act (Design), Trademark Act (Trademark), Act on Special Provisions of Procedures, etc. concerning Industrial Property Rights (Property), Act on International Applications under the Patent Cooperation Treaty (International), Patent Attorney Act (Attorney)

Reference 1) Outline of the Act on Partial Revision of the Patent Act and Other Acts, and the same (reference materials) (JPO’s website)

2) Gist of the Act on Partial Revision of the Patent Act and Other Acts (JPO’s website)

[Attachment]

**1. patent**

Item	Amount before revision	revised amount
application fee	14,000 yen	14,000 yen
Fee for request for examination of application	138,000 yen + (number of claims) x 4,000 yen)	138,000 yen + (number of claims) x 4,000 yen)
Patent fees (first to third year)	2,100 yen + (number of claims x 200 yen) every year	<b>4,300 yen + (number of claims) x 300 yen)</b>
(Fourth to Sixth Years)	6,400 yen + (number of claims x 500 yen) every year	<b>10,300 yen + (number of claims x 800 yen) every year</b>
(Years 7 to 9)	19,300 yen + (number of claims x 1,500 yen) every year	<b>24,800 yen + (number of claims x 1,900 yen) every year</b>
(10 to 25)	55,400 yen + (number of claims x 4,300 yen) every year	<b>59,400 yen + (number of claims x 4,600 yen) every year</b>

**2. utility model**

Item	Amount before revision	revised amount
application fee	14,000 yen	14,000 yen
technical evaluation fee	42,000 yen + (number of claims) x 1,000 yen)	42,000 yen + (number of claims) x 1,000 yen)
Registration Fee (Years 1 to 3)	2,100 yen + (number of claims) x 100 yen)	2,100 yen + (number of claims) x 100 yen)
(Fourth to Sixth Years)	6,100 yen + (number of claims) x 300 yen)	6,100 yen + (number of claims) x 300 yen)
(Years 7 to 10)	18,100 yen + (number of claims x 900 yen) every year	18,100 yen + (number of claims x 900 yen) every year

### 3. Design

Item	Amount before revision	revised amount
application fee	16,000 yen	16,000 yen
Registration Fee (Years 1 to 3)	8,500 yen annually	8,500 yen annually
(Years 4 to 25)	16,900 yen annually	16,900 yen annually

### 4. trademark

Item	Amount before revision	revised amount
application fee	3,400 yen + (number of classes x 8,600 yen)	3,400 yen + (number of classes x 8,600 yen)
On application for defensive mark registration or defensive mark registration Application for registration of renewal of duration of right	6,800 yen + (number of classes x 17,200 yen)	6,800 yen + (number of classes x 17,200 yen)
trademark registration fee	Number of classes x 28,200 yen	<b>Number of classes x 32,900 yen</b>
Amount paid in installments (for the first half and second half)	Number of classes x 16,400 yen	<b>Number of classes x 17,200 yen</b>
Application for registration of renewal	Number of classes x 38,800 yen	<b>Number of classes x 43,600 yen</b>
Amount paid in installments (for the first half and second half)	Number of classes x 22,600 yen	<b>Number of classes x 22,800 yen</b>
defensive mark registration fee	Number of classes x 28,200 yen	<b>Number of classes x 32,900 yen</b>
defensive mark renewal registration fee	Number of classes x 33,400 yen	<b>Number of classes x 37,500 yen</b>

### 5. Fee relating to international application (Patents and utility models)

Item	Amount before revision	revised amount
Shipping fee + Investigation fee	80,000 yen (Shipping fee: 10,000 yen)	<b>160,000 yen</b> (Shipping fee: 17,000 yen)

(Japanese)		
Shipping fee + Investigation fee (English)	166,000 yen (Shipping fee: 10,000 yen)	<b>186,000 yen</b> <b>(Shipping fee: 17,000 yen)</b>
Additional Fees for International Search (Japanese)	60,000 yen × (number of claimed inventions -1)	<b>105,000 yen × (number of claimed inventions -1)</b>
Additional Fees for International Search	126,000 yen × (number of claimed inventions -1)	<b>168,000 yen × (number of claimed inventions -1)</b>
Preliminary Examination Fee (Japanese)	26,000 yen	<b>34,000 yen</b>
Preliminary Examination Fee (English)	58,000 yen	<b>69,000 yen</b>
Additional fee for preliminary examination (Japanese)	15,000 yen × (number of claimed inventions -1)	<b>28,000 yen × (number of claimed inventions -1)</b>
Additional Fees for Preliminary Examination (English)	34,000 yen × (number of claimed inventions -1)	45,000 yen × (number of claimed inventions -1)

#### 6. Fee relating to application for international registration (design)

Item	Amount before revision	revised amount
Individual designation fee (equivalent to application fee and registration fee)	74,600 yen	74,600 yen
Individual designation fee (equivalent to renewal registration fee)	84,500 yen	84,500 yen

#### 7. Fee relating to application for international registration (trade mark)

Item	Amount before revision	revised amount
Individual designation fee (equivalent to application fee)	2,700 yen + (number of classes x 8,600 yen)	2,700 yen + (number of classes x 8,600 yen)
Individual designation fee (equivalent to registration fee)	Number of classes x 28,200 yen	<b>Number of classes x 32,900 yen</b>

Individual designation fee (equivalent to renewal registration fee)	Number of classes x 38,800 yen	<b>Number of classes x 43,600 yen</b>
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**Note)The bold part is the change this time.**