

JAPAN

<http://www.jpo.go.jp/infoe/seidoe.htm>

Review of Patent Law and Trademark Law

1. Objectives of the Amendments

- In order to cope with rapid advances in the information technology field, it is necessary to introduce legislation to respond to new business which utilize networks and to review the scope of validity of the Patent Law.
- At the same time, from the viewpoint of international concordance of systems, reduction of applicant burden and improvement of efficiency of examination at the JPO, it is also necessary to review the method of application for patents and designs.

2. Outline of the Amendments

1. Reinforcement of Patent Protection for Information-based Property such as Software and Enhancement of Network Transactions

- Existing legislation was drawn up with the concept of inventions being utilized as tangible items. As a result the extent that computer programs themselves as intangible items are protected under the Patent Law is not necessarily obvious.
- In view of the fact that the sale/distribution via the Internet of programs not stored on such media as CD-ROM has been on the rise as a result of the popularization of broadband the amendment is intended to clearly show that transmission of patented programs over the network without approval falls under the category of infringement of the patent right.

(Subsection 3, Section 2, of the Patent Law)

In this law, "implementation" of an invention shall mean the activities listed hereunder.

- a. In the case of invention of a "thing", activities to produce, use, assign, lend, or import the thing, or to propose the assignment or lending of the thing (to include display for the purpose of assignment or lending; hereinafter the same shall apply)

2. Expansion of Provisions for Indirect Infringement of Patent Law

- Under existing legislation, activities to aid and abet the infringement of the patent right by providing parts or materials used therefor are included in the activities of infringement; however, there are many judicial precedents in which infringement has been admitted since the subject of the law's application is limited to exclusive parts (i.e., materials used only for production).
- From the viewpoint of reinforcing protection of the right, the amendment is intended to expand the scope of indirect infringement to include the activity of providing parts with malicious intent (knowing that it is a patented invention and that it is used for the purpose of infringement).

3. Reinforcing Protection of Trust for **Trademarks** used in Internet Business

- Existing legislation has been drawn up with trademarks attached to tangible items in mind. In recent years, due to the increase of network businesses, provision of commodities on the

Internet has been promoted. Consequently sufficient protection for trademarks displayed on the screens of PCs and mobile phones of users are needed.

- Under such circumstances, the amendment is intended to show clearly that such activity as to use trademarks by displaying them on screens in conjunction with business activities such as commodity distribution, provision of services, and advertising via networks falls under the category of trademark infringement.

4.Reduction of Applicant Burden and Promotion of Speedy and Efficient Examination

- Reduction of the burden of application preparation on the part of applicants by making application procedures compatible with the PCT international application as well as applications of advanced nations

(i.e. separation of the scope of the patent claim from the specification)

- Extend the deadline of the submission of domestic documents for international application to as long as 30 months uniformly in line with such a resolution of the Assembly of the International Patent Cooperation Treaty Union and provide a grace period of two months for the submission of translations to enhance the quality of translations, user convenience and examination efficiency

(extension of submission period for domestic documents)

- Realize quicker and more precise examination through systemization of disclosure to examiners upon application of prior art information in the possession of applicants

(introduction of a disclosure system of prior art information)

- Among the individual fees for international trademark registration, allow payment of the registration fee to be made only when the application is granted domestic registration, the same as for domestic applications

(installment payment of international trademark registration individual fees)

http://www.jpo.go.jp/saikine/asia_ip/asia_ip_tope.htm

International IP related Activities

1. Intellectual Property Cooperation in The Asia-Pacific Region

2. Trilateral Cooperation

The 20th Annual Trilateral Conference hosted by the EPO was held in Vienna, Austria this year in November.

Summary of the Conferences

Pre-Conference and Conference

In view of the surge in examination workload in the Trilateral Offices in recent years, the Trilateral Offices discussed and exchanged views on the current situations of their Offices and future strategy of the Trilateral Cooperation. They discussed and adopted the new Trilateral Project Layout which was prepared based on the layout drafted at the Trilateral Technical Meeting in May 2002. Opinion exchanges and discussions by experts were carried out on a project-to-project basis in such fields as mutual exploitation of search/examination results, analytical comparisons of examination practice in advanced technology areas, TRINet, and data exchanges.

International Symposium

Presentations were made by the Trilateral Founding Fathers, current heads of the Trilateral Offices, and representatives of users respectively under the themes of "Visions at the Time (a presentation made by the Trilateral Founding Fathers)," "Mastering the Workloads: the View of the Trilateral Offices (by heads of the Trilateral Offices)," and "the Demand for Patents: the View of the Trilateral Offices (by representatives of users)." A panel discussion was also held between representatives of the Trilateral Offices and users.

This report is provided by Ms. Haruka Onda of the 20th Board of the Appeal of the Japan Patent Office.