



**Sonderhoff & Einsel News Update:
IP Newsletter (June 2021)**

On May 14, 2021, the Diet passed a bill to partially amend the Patent Law and other related laws

INTRODUCTION

A bill to partially amend the Patent Law and other related laws was submitted to the 204th ordinary session of the Diet and was passed on May 14, 2021. In principle, the amended law will go into effect within one year from the date of promulgation. The exact date of enactment is unknown but expected to be around the spring of 2022.

This article will list the amendments to be made to the Patent Law and other IP related laws and describe those which we believe will be of particular interest to our international clients.

OUTLINE OF THE BILL

I. Development of digitalization and other procedures to address the spread of the new coronavirus

1. Participation in oral proceedings in invalidation trials will be possible via a web conference system. The details of this system have not yet been published, but both the appellant and the appellee (i.e. the patent proprietor) should be able to join the oral proceedings virtually.
2. Stamp prepayment will be abolished and fee payment methods will be expanded to allow, for example, account transfer and credit card payment.
3. Dispatch of copies of registration decisions for foreign applicants using applications under the Hague Agreement (designs) or the Madrid Protocol (trademarks) will be digitalized. The current system of notifying from the JPO through international mail and WIPO will be unified, thereby leading to notification through WIPO only. Concerning international applications for trademark registration under the Madrid Protocol, the current two-step payment of the fee (first payment at the time of application and second payment at the time of registration) will be changed to a lump sum payment system which is currently in mainstream use across the world. In addition, proof for

loss of novelty to gain a Grace Period may be submitted to WIPO directly (digitally or in a hard copy) together with the international application for registration of design under the Hague Agreement. Submission of proof to the JPO will no longer be necessary.

4. Concerning the registration fee and annual fees, surcharges for missed deadlines due to natural disaster or other reasons not attributed to the patentee will be waived.

II. Review of rights protection in response to changes in corporate activities

1. The scope of acts constituting infringement of design rights and trademark rights in relation to the importation of counterfeit goods from abroad will be expanded. According to the revised law, bringing counterfeit products purchased from overseas vendors into Japan by post or the like will be regarded to be an infringement even if the purpose is for private use.

2. The consent of the non-exclusive licensee, which is currently required for correction trials or correction requests in oppositions or invalidation trials will no longer be necessary.

3. The requirement of a "justifiable reason" to obtain relief for various missed deadlines will be relaxed. According to the revised law, there will be a remedy for procedures such as the following as long as the failure was not intentional and the necessary fee has been paid:

- Filing of an examination request for a patent application
- Payment of registration and annual fee
- Submission of Japanese translation
- Patent application claiming a priority of an earlier application

Specific terms and fees have not yet been published, but we will let you know as soon as they are announced.

III. Strengthening the foundation of the intellectual property system

1. A third party opinion solicitation system (Japanese version of "Amicus Curiae") will be introduced

for patent and utility model infringement litigation. When the parties concerned plead for the use of this system and the court (in this case, Tokyo or Osaka District Court and the Intellectual Property High Court) finds it necessary, there will be an invitation for opinions and suggestions by third parties, which may be used as evidence. Patent Attorneys are allowed to support third parties in the preparation of such opinions.

2. The fee structure for patent registration and other fees will change. The details are not decided yet, but increase of some fee is expected.

3. The patent attorney system will be reviewed to allow a more flexible work style.

About us

Since 1910, Sonderhoff & Einsel has been among the first choices for International corporate clients seeking support in Japan regarding legal and intellectual property matters as well as tax and audit services. For more information, please visit <http://se1910.com/>.

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