

Patent Act (Article 71, paragraph (3), Article 105, Article 105-2-4, paragraph (5), Article 105-2-11, Article 105-4, Article 105-5, Article 105-7, Article 145, Article 146, Article 147, Article 151, Article 168, paragraph (6), Article 169, paragraph (2), Article 182, item (i), Article 190, Article 196, Article 196-2, Article 197, Article 198, Article 199, paragraph (1), Article 200, Article 200-2, Article 200-3 and Article 204 Not enforced (Tentative translation))

(Act No. 121 of April 13, 1959)

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Chapter I General Provisions

(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 is a product (including a computer program or anything equivalent; the same applies hereinafter), the producing, using, transferring, etc. it (meaning transferring it or leasing it out, and this includes providing it through a telecommunications line if it is a computer program or anything equivalent; 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 is 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.

(4) A "computer program or anything equivalent" 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 in 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 an examiner has designated a period during which procedures are to be undertaken pursuant to this Act, the official may extend the period, 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 a 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 other than through a legal representative; 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 guardianship supervisor, the legal representative must have that the supervisor's consent in order to undertake a procedure.
- (4) The preceding two paragraphs do not apply if a person under curatorship or a legal representative undertakes a procedure in connection with the filing of an opposition to a granted patent concerning the person's patent rights or in connection with a request for a trial, appeal, or retrial that an adverse party has filed.

(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 procedure or file an action objecting to a disposition reached by an administrative authority 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 acts as 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 Unless expressly empowered to do so, the privately appointed agent of a person that is 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 convert, abandon, or withdraw a patent application; withdraw an application to register extension of a patent right; withdraw a request, demand, application or motion; assert or withdraw a priority claim referred to in Article 41, paragraph (1); file a patent application based on the registration of a utility model under Article 46-2, paragraph (1); file a request for publication of an application; file 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, extinction by merger of the principal, termination of entrusted duties of a trustee that is the principal, the death of the legal representative or change or extinction of the legal representative'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 act as 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 jointly undertake a procedure, each of them acts as the agent of all of them with respect to procedures other than the conversion, abandonment 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 filing of 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 legal representative (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 act as the principal may be ratified by the principal with the legal capacity to undertake procedures or the principal's legal representative.

(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 legal representative 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 legal representative 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 as applied mutatis mutandis pursuant to Article 43-2, paragraph (2)) and including as 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 with 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 are to be paid pursuant to Article 195, paragraphs (1) through (3) have 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 service 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 as applied mutatis mutandis pursuant to Article 159, paragraph (2) (including as 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 receives 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 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 matters 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 beyond what is provided for in the preceding paragraph is made to a claim, in cases set forth in 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 beyond 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 the case where 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) the restriction of the claims (limited to the case where 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 explanation of an ambiguous statement (limited to 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 as 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 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)) 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 (1) 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 of the establishment of the patent rights 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 in Article 2, paragraph (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, paragraph (6) of the Act or by a specified correspondence delivery service provider as provided in Article 2, paragraph (9) of the Act (hereinafter referred to as "correspondence delivery") that is prescribed by Order of the Ministry of Economy, Trade and Industry to the Japan Patent Office under this Act, or any order rendered under this Act, that is subject to a time limit, is deemed to have arrived at the Japan 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, paragraph (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 12:00 p.m. 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 a successor in title to the patent right or other right under the patent.

(Continuance or Suspension of Procedures)

Article 22 (1) On 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 has 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 (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 "privately appointed agent 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) 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, extinction, restoration, or restrictions on its disposal;
 - (ii) the establishment of an exclusive license, its preservation, transfer, modification, extinction, 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, extinction or restrictions its disposal; and
 - (iv) the establishment of a provisional exclusive license, its preservation, transfer, modification, extinction, or 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 provided for 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

(Requirements 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 the items of the preceding paragraph, notwithstanding the preceding paragraph.

Article 29-2 Notwithstanding Article 29, paragraph (1), a person may not obtain 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 which the patent appears") is published pursuant to Article 66 paragraph(3), the application is published, or an issue of the utility model gazette 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

"gazette 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 Loss of Novelty of Invention)

Article 30 (1) 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 invention 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 comes 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 Be Granted a Patent)

Article 33 (1) The right to be granted a patent may be transferred.

(2) The right to be granted a patent may not be pledged.

(3) When the right to be granted 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 be granted 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 be granted a patent without the consent of all the other co-owners.

Article 34 (1) Succession to a right to be granted 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 be granted 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 be granted a patent or the right to be granted a utility model registration for the same invention or device based on succession from the same person.

(4) No succession to a right to be granted 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 be granted 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 to the right to be granted 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 be granted a patent may establish a provisional exclusive license with regard to the patent right to be obtained based on the right to be granted 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 concerning a patent application that is related to a provisional exclusive license, 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 be granted 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 be granted 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), a provisional exclusive license is deemed to have been established with regard to the patent right to be obtained based on the right to be granted 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 establishing the provisional exclusive license.
- (6) A provisional exclusive license is forfeited if the establishment of the patent right is registered in connection with the patent application, if the patent application is waived, withdrawn, or dismissed, or if an examiner's decision or trial decision 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 be granted a patent may grant another party a provisional non-exclusive license to the patent right is to be obtained based on the right to be granted 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 concerning a patent application that is related to a provisional non-exclusive license under the

preceding paragraph, 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 related to 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 be granted 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 be granted 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 be granted 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 be granted 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 be granted 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 be granted 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 be granted 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 be granted 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 be granted a patent pertaining to the provisional non-exclusive license, or a provisional exclusive license, or a provisional exclusive license on the right to be granted a patent pertaining to the provisional non-exclusive license.

(Employee Inventions)

- Article 35 (1) If an employee, officer of a corporation, or a national or local government (hereinafter referred to as an "employee, etc.") has obtained a patent for an invention which, by its nature, falls within the scope of the business of an employer, a corporation, or a national or local government (hereinafter referred to as an "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 be granted 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 be granted 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 be granted a patent for any employee invention is vested in the employer, etc., the right to be granted 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 be granted 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 establishes 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, 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 the 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 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 as 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 as 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 period 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 translations of foreign-language documents and the foreign-language abstract provided in paragraph (2) to the Commissioner of the Japan Patent Office only within the period provided by Order of the Ministry of Economy, Trade and Industry.
- (5) When the translations 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 has been 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 period 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 expiration 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.

(Co-Applications)

Article 38 If the right to the grant a patent is co-owned, a patent application may only be filed by all the co-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 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 description 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 description 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) When 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) In order to supplement the description or drawings pursuant to the preceding paragraph, a document supplementing the description or drawings (hereinafter referred to as a "written supplement of the description or drawings" in this Article and Article 67, paragraph (3), item (vi)) must be submitted in accordance with 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 or drawings; 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 as 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 or drawings 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 or drawings 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 or drawings submitted pursuant to paragraph (3) only within the period provided by Order of the Ministry of Economy, Trade and Industry.
- (8) If the written supplement of the description or drawings 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 abandoned, 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 referred to in 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 scope of claims for a patent, or scope of claims or drawings for a utility model registration (if the earlier application was an application written in a foreign language, 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 the case where 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 as 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 as applied *mutatis mutandis* pursuant to Article 43-3, paragraph (3)), or Article 43-3, paragraph (1) or (2) of the Patent Act (including as 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 as applied *mutatis mutandis* pursuant to Article 43-3, paragraph (3)), or Article 43-3, paragraph (1) or (2) of the Patent Act (including as 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 period 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 abandoned, 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 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 within the period provided by Order of the Ministry of the Economy, Trade and Industry, 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(including those provided by electronic or magnetic means (meaning by electronic means, magnetic means, or other means that is impossible to perceive through the human senses alone; the same applies in paragraph (5) and Article 44, paragraph (4)) or the copies thereof (hereinafter referred to as "priority certificate, etc." in this Article), within one year and four months from the earliest of the following dates:

- (i) the date of the first filing, the date of the filing that is deemed to be the first filing pursuant to Article 4.C.(4) of the Paris Convention, or the date of the filing that is found to be the first filing pursuant to A.(2) of that 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 as 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 priority certificate, etc.; provided, however, that if the filing number is not possible for the person to learn that filing number prior to the submission of the priority certificate, etc., 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 priority certificate, etc. within the period provided in paragraph (2) the priority claim is forfeited.
- (5) In applying of the preceding two paragraphs, the priority certificate, etc. 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 to be used for exchanging the details given in the documents provided for in paragraph (2) the priority certificate, etc. 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) priority certificate, etc. 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 priority certificate, etc. 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 priority certificate, etc. 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 the priority certificate, etc. or the documents to the Commissioner of the Japan Patent Office within the period provided by Order of the Ministry of Economy, Trade and Industry.
- (9) If the priority certificate, etc. 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 was unable to file a patent application containing a priority claim within the periods of priority pursuant to Article 4.C.(1) of the Paris Convention (hereinafter referred to in this paragraph as the "periods 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 filed the patent application pursuant to Order of the Ministry, Trade and Industry within the period 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 periods 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 periods of priority.

- (2) The preceding Article 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 applies 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 the Annex 1C to the Marrakesh Agreement; the same applies in the next paragraph)	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 as 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) 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 (in the case of a submission under Article 43-2 (including as applied mutatis mutandis pursuant to Article 43-2, paragraph (2) (including as applied mutatis mutandis pursuant to paragraph (3) of the preceding Article, the same shall apply hereinafter in this paragraph) and paragraph (3) of the preceding Article), including statements or documents provided by electronic or magnetic means) 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) 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. In this case, 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 for the examiner's technical opinion as provided in Article 12, paragraph (1) of the Utility Model Act with respect to the application 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)) applies *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 regarding the patent 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 of the application 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 expiration of the period prescribed in paragraph (1).
- (7) The preceding three paragraphs apply 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 of this.

(Prioritized Examination)

Article 48-6 If the Commissioner of the Japan Patent Office finds that a person other than the applicant is working the invention claimed in a patent application in the 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 be granted 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 the case where 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 as 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 the case where 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) No appeal may be entered against the ruling dismissing an amendment under paragraph (1); provided, however, that this does not apply in any trial that occurs if an appeal against an examiner's decision of refusal 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 on an opposition to a granted patent or a decision on a trial or appeal 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 order and public morals are 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), a priority certificate, etc. 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 establishment of the patent right with a claim amount that corresponds to the amount of money that 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 establishment of the patent right 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 abandoned, 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 "when the victim or legal representative thereof comes to know the damage and the identity of the perpetrator" in Article 724 (i) of the Civil Code is deemed to be replaced with " the day the establishment of the patent right 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 through registration of its establishment.

- (2) Establishment of a patent right is registered once all of the annual patent fees 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 has been made, 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 registration of its establishment; 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 patent term provided for in the preceding paragraph may be extended through 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 "permissible length for the extension") may not exceed the period calculated by deducting a period equivalent to the total of the periods listed in the following items (excluding overlapping periods among these periods, if there are any) from a period equivalent to the period from the base date until the date of registration of establishment of the patent right:
- (i) if a notice or order under the provisions of this Act (excluding Article 39, paragraph (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 a notice or order under the provisions of orders under these Acts (limited to that issued by the Commissioner of the Japan 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) if the period for undertaking the procedure under the provisions of this Act or orders under this Act (hereinafter referred to as the "Patent Act or related orders" in the following item, item (v) and item (x)) has been extended for the patent application: the period running from the date after the final day in the period for undertaking the procedure to the date on which the procedure was undertaken;
 - (iii) if the procedure under the provisions of the Patent Act or related orders concerning the patent application for which the period for undertaking the procedure is specified may be undertaken even after the expiration of the period by which the applicant should undertake the procedure pursuant to the provisions of the Patent Act or related orders, and the procedure is undertaken: the period from the date on which the period for undertaking the procedure has expired until the day on which the procedure is

- undertaken;
- (iv) if 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 put on hold due to the applicant's request or any other act: the period running from the date on which the request or any other act is made until the date on which the grounds for putting the disposition or notice on hold cease to exist;
 - (v) if a decision to reduce, exempt, or grant a deferment of payment for the relevant patent fee or other fee was reached regarding the payment of a patent fee or other fee under the provisions of the Patent Act or related orders in connection with the patent application: the period running from the date on which the application for the reduction, exemption, or deferment of payment was filed to the date on which the decision was reached;
 - (vi) if a written supplement of the description or drawings under Article 38-4 (7) was withdrawn with regard to the patent application: the period from the date on which the written supplement of the description or drawings was submitted pursuant to paragraph (3) of the Article until the day on which the written supplement of the description or drawings was withdrawn pursuant to paragraph (7) of the Article;
 - (vii) if an appeal against an examiner's decision of refusal was filed related to the patent application: the period specified in (a) through (c) below corresponding to the categories set forth therein:
 - (a) if an appeal decision to the effect that a patent is to be granted under Article 51 as applied mutatis mutandis pursuant to Article 159, paragraph (3) (including as applied mutatis mutandis pursuant to Article 174, paragraph (2)) is made: the period running from the date on which a certified copy of the examiner's decision of refusal was served until the date on which a certified copy of the appeal decision is served;
 - (b) if an appeal decision to order further examination under Article 160, paragraph (1) (including as applied mutatis mutandis pursuant to Article 174, paragraph (2)) is made: the period running from the date on which the certified copy of the examiner's decision of refusal was served until the date on which the certified copy of the appeal decision was served; and
 - (c) if an examiner's decision to the effect that a patent is to be granted under Article 51 as applied mutatis mutandis pursuant to Article 163, paragraph (3) is made: the period from the date on which the certified copy of the examiner's decision of refusal was served until the date on which the certified copy of the examiner's decision to the effect that a patent is to be granted was served;
 - (viii) if a determination for a request for review filed under the provisions of

- the Administrative Complaint Review Act (Act No. 68 of 2014) became final and binding with regard to a disposition under the Patent Act and related laws and regulations concerning the patent application: the period running from the date of filing of the request for review until the date on which the certified copy of the determination was served;
- (ix) if a judgment on an action filed under the provisions of the Administrative Case Litigation Act (Act No. 139 of 1962) became final and binding with regard to a disposition under the Patent Act and related laws and regulations concerning the patent application: the period running from the date of filing of the action until the date on which the judgment on the action became final and binding; and
- (x) if the procedure under the provisions of the Patent Act or related orders concerning the patent application was suspended or terminated: the period during which the procedure was suspended or terminated.
- (4) If there was a period during which the patented invention could not 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., was 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 applies in the proviso to Article 67-5, paragraph (3), Article 68-2, and Article 107, paragraph (1)) may be extended, upon the filing an application to register an extension of the duration, for a maximum of 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 the request for examination of the application was filed.
- (2) The written application under the preceding paragraph must be accompanied by documents stating the basis for the calculation of the period set forth in item (iii) of the paragraph as provided by Order of the Ministry of Economy, Trade and Industry.
- (3) The application to register an extension under paragraph (2) of the preceding Article must 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 person's 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 Article.

- (4) If a patent right is co-owned, none of the co-owners may file an application to register an extension under paragraph (2) of the preceding Article unless jointly with all the other co-owners.
- (5) If an application to register an extension under paragraph (2) of the preceding Article has been filed, the patent term provided for in paragraph (1) of the Article is deemed to have been extended; provided, however, that this does not apply once the examiner's decision to the effect that the application is to be refused has become final and binding or once the registration of extension under paragraph (3) of the following Article has been made.
- (6) If an application to register an extension under paragraph (2) of the preceding Article is filed, matters listed in the items of paragraph (1) must be published in the patent gazette.

Article 67-3 (1) If an application to register an extension under Article 67, paragraph (2) falls under any of the following items, the examiner must render an examiner's decision to the effect that the application is to be refused:

- (i) if the establishment of the patent right was not registered on or after the base date;
 - (ii) if the requested term of extension exceeds the permissible length for the extension of the term of those patent rights;
 - (iii) if the person filing the application is not the patentee; and
 - (iv) if the application does not meet the requirements under paragraph (4) of the preceding Article.
- (2) If no reasons for refusal are found for the application to register an extension under Article 67, paragraph (2), the examiner must render an examiner's decision to the effect that the extension is to be registered.
 - (3) If the examiner's decision under the preceding paragraph is rendered, the extension is to 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 paragraph (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, paragraph (1), Article 50, Article 52, and Article 139 (excluding item (vii)) apply mutatis mutandis to the examination of an application to register an extension under Article 67, paragraph (2). In this case, the term "which is being appealed" in Article 139, paragraph (6) is deemed to be replaced with "on the patent application regarding the patent right for which an application to register an extension under Article 67, paragraph (2) is filed".

- Article 67-5 (1) A person seeking to file an application to register an extension under Article 67, paragraph (4) must submit an 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 (not exceeding 5 years); and
 - (iv) the details of the disposition designated by Cabinet Order as referred to in Article 67, paragraph (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, paragraph (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, paragraph (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, paragraphs (4) through (6) apply mutatis mutandis to an application to register an extension under Article 67, paragraph (4). In this case, the term "paragraph (3) of the following Article" in the proviso to Article 67-2, paragraph (5) is deemed to be replaced with "Article 67-7, paragraph (3)", and the term "items of paragraph (1)" in Article 67-2, paragraph (6) is deemed to be replaced with "items of Article 67-5, paragraph (1)".

Article 67-6 (1) If it is anticipated that it will not be possible to obtain the disposition provided for by Cabinet Order that is referred to in Article 67, paragraph (4) by 6 months and one day before the expiration of the patent term under Article 67, paragraph (1), a person seeking to file an application to register an extension as referred to in Article 67, paragraph (4) must submit a document stating the following to the Commissioner of the Japan Patent Office

by that day:

- (i) the name, and domicile or residence of the person filing the application;
 - (ii) the patent number; and
 - (iii) the disposition provided for by Cabinet Order as referred to in Article 67, paragraph (4).
- (2) Unless the document that must be submitted pursuant to the preceding paragraph is submitted, an application to register an extension under Article 67, paragraph (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, paragraph (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, paragraph (4), the examiner must reach a decision to the effect that the extension is to be registered.
- (3) When an examiner's decision under the preceding paragraph is rendered, the extension is registered.
- (4) When 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, paragraph (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, paragraph (4).

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

(Effect of Patent Rights)

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 within the scope of the exclusive licensee's exclusive right to work the patented invention.

(Effect of Patent Rights When the Patent Term Is Extended Pursuant to Article 67, paragraph (4))

Article 68-2 If the duration prescribed in Article 67 (1) is extended pursuant to Article 67, paragraph (4) (including the case where the duration is deemed to have been extended pursuant to the main clause of Article 67-2, paragraph (5) as applied *mutatis mutandis* pursuant to Article 67-5, paragraph (4)), the effectiveness of the patent right does not extend to 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, paragraph (4) which constituted the reason for the registration of extension (when 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 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 no effect against the act of preparation of a medicine as per a physician's or dentist's prescription or against medicine prepared as per a physician's 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 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 (8), Article 146, Article 147, paragraphs (1), (2), and (3) (limited to the part of the mutatis mutandis application of Article 160-2, paragraph (1) of the Code of Civil Procedure), 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 "A trial or appeal, other than one 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 is likely to disrupt the public order or morality" in the proviso to Article 145, paragraph (6) is deemed to be replaced with "a chief administrative judge finds it necessary", the term "Article 147" in Article 151 is deemed to be replaced with "Article 147, paragraphs (1), (2), and (3) (limited to the part of the mutatis

mutandis application of Article 160-2, paragraph (1) of the Code of Civil Procedure)," and the phrase "up until such time as the 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 advisory opinion is served."

- (4) No appeal may be filed against the ruling under Article 135 to be applied mutatis mutandis following the deemed replacement 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 136, 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.

(Co-Owned Patent Rights)

- Article 73 (1) If a patent right is jointly owned, no co-owner may transfer or establish a right of pledge on the co-owner's own share without the consent of the other co-owners.
- (2) If a patent right is co-owned, unless otherwise agreed upon in a contract, each of the co-owners of the patent right may work the patented invention without the consent of any other co-owner.
- (3) If a patent right is co-owned, no co-owner may establish an exclusive license or grant a non-exclusive license on the patent right to any third party without the consent of the other co-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 be granted 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 co-owned patent right is transferred based on the request under paragraph (1).

Article 75 Deleted

(Lapse of a Patent Right 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 952, paragraph (2) 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 the course of trade to the extent specified by the act establishing 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 by the act establishing 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 (1) 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 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 the right to receive reasonable compensation from a person that holds a non-exclusive license 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 engage 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 a person holding a non-exclusive license 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 person holding a non-exclusive license 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 properly and continuously worked for three years or longer in Japan, a person intending to work the patented invention may request the patentee or 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 When a request for an award is filed as referred to in Article 83, paragraph (2), the Commissioner of the Japan Patent Office must serve a duplicate 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 properly 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 consideration, 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 licensees that have stated 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 Consideration)

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

- (i) the person required to pay the consideration has paid it but the person entitled to consideration refuses to receive it;
- (ii) the person entitled to the consideration is unable to receive it;
- (iii) an action with respect to the consideration is instituted under Article 183, paragraph (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 consideration (or if the consideration 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 awarding it have ceased to exist or for any other reason, or the person that was granted the non-exclusive license does not properly work the patented invention, the Commissioner may rescind that award at 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 properly 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 Dissatisfaction with the consideration determined in an award

under Article 83, paragraph (2) may not be used as grounds for protest in a request for administrative review under the provisions of the Administrative Complaint Review Act concerning that award.

(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 that is 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 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 right, or design right is transferred or forfeited independently of the business linked to 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 consideration 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 attach the consideration, money, or goods prior to their payment or delivery.

(Waiver of Patent Rights)

- 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 as under Article 77, paragraph (4), the exclusive licensee may waive the exclusive license, only if the consent of the pledgee or non-exclusive licensee has been obtained.
- (3) If there is a pledgee, a non-exclusive licensee may waive the non-exclusive license, only if the consent of the pledgee has been obtained.

(Effect of Registration)

Article 98 (1) The following matters do not become effective if they are not registered:

- (i) the transfer of a patent (other than due to inheritance or other general succession), its modification under a trust, lapse due to waiver, or restriction on its disposal;
- (ii) the grant, of an exclusive license, its transfer (other than due to inheritance or other general succession), modification, forfeiture (other than due to merger or to lapse 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 the 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 has been granted for an invention that is a product, the act of producing, transferring, etc., importing or offering to transfer, etc., in the course of trade, any article whose only use is to produce that product;
- (ii) if a patent has been granted for an invention that is a product, the act of producing, transferring, etc., importing or offering to transfer, etc., in the course of trade, any article (excluding one that is widely distributed within Japan) that is used in the production of the product and is essential to the invention's solution to the problem, 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 has been granted on an invention that is a product, the act of possessing the product for the purpose of transferring, etc. or exporting it in the course of trade;
- (iv) if a patent has been granted for an invention that is a product, the act of

- producing, transferring etc., importing or offering to transfer, etc., in the course of trade, any article whose only use is in that process;
- (v) if a patent has been granted for an invention that is a product, the act of producing, transferring, etc., importing or offering to transfer, etc., in the course of trade, any article (excluding one that is widely distributed within Japan) that is used in that process and that is essential to the invention's solution of the problem, with knowledge that the invention is a patented invention and that the article is used in the working of the invention; and
- (vi) if a patent has been granted for an invention that is a process for producing a product, the act 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) If a patentee or an exclusive licensee files a claims against an infringer for compensation for damage sustained as a result of the intentional or negligent infringement of the patent right or exclusive license, and the infringer has transferred articles that constitute the act of infringement, the amount of damage 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 arrived at when the amount of profit per unit for the articles that the patentee or exclusive licensee would have been able to sell if the infringement had not taken place is multiplied by that part of the quantity of articles that the person infringing the patent right or exclusive license has transferred (referred to as the "quantity transferred" in the following item) which does not exceed the quantity covered by the patentee's or exclusive licensee's ability to work the patented invention (referred to as the "workable quantity" in the same item) (if there are circumstances that render the patentee or the exclusive licensee unable to sell a quantity of products equivalent to all or part of the workable quantity, the workable quantity less the quantity not sellable due to those circumstances (referred to as the "specified quantity" in the same item));
- (ii) an amount equivalent to the amount of money that is to be received in exchange for the working of the patented invention under the patent right or exclusive license, for any quantity exceeding the workable quantity which is part of the quantity transferred, or for any specified quantity which is part of the quantity transferred (unless it is not found that the patentee would have been able to establish an exclusive license or grant a non-exclusive license under the patentee's patent rights, or that exclusive licensee would have been able to grant a non-exclusive license under the exclusive licensee's exclusive license).

- (2) If a patentee or exclusive licensee files a claim for compensation for damage that the patentee or licensee personally incurs due to infringement against a person that intentionally or due to negligence, infringes the patent right or violates the exclusive license, and the infringer has profited from the infringement, the amount of that profit is presumed to be the value of damage incurred by the patentee or exclusive licensee.
- (3) The patentee or exclusive licensee may fix the value of the damages that the patentee or exclusive 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 right 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 account the consideration that the patentee or the exclusive licensee would hypothetically obtain if they reached an agreement with the infringer concerning the consideration for the working of the patented invention that is covered by their patent right or exclusive license, based on the premise that the patent right or exclusive license had been infringed.
- (5) The provisions of paragraph (3) 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 of intent or gross negligence by the person that has infringed the patent right or violated the exclusive license in fixing the amount of damages.

(Presumption of Negligence)

Article 103 A person that infringes another person's patent right 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 right or violation of an exclusive license, if the adverse party denies the specific circumstances of the product or process that the patentee or exclusive licensee

asserts to constitute the act of infringement, 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 circumstances.

(Restriction on Exercise of Rights by the Patentee)

- Article 104-3 (1) In litigation involving the infringement of a patent right or the violation of an exclusive license, if it is found 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) The provisions of 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 an allegation or evidence under paragraph (1).

(Limitation on Assertions)

- Article 104-4 If one of the following rulings or decisions upon 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 or an exclusive license or in litigation involving 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 ruling or decision on trial or appeal has become final and binding in an action for a retrial against 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 at issue):
- (i) a ruling to the effect that the patent is to be revoked or a trial decision to the effect that the patent is to be invalidated;
 - (ii) a trial decision 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 patent.

(Submission of Documents)

Article 105 (1) In litigation involving the infringement of a patent right or an exclusive license, the court, at the motion of a party, may order a party to submit documents or electronic or magnetic records (meaning records used in computerized information processing which are created in electronic form, magnetic form, or any other form that cannot be perceived by the human senses; the same applies hereinafter) that are needed to prove the infringement or to calculate the damage caused by the infringement; provided, however, that this does not apply if the person in possession of the document or the person with the authority to access the electronic or magnetic record has legitimate grounds for refusing to submit them.

(2) If the court finds it necessary to do so in order to determine whether a document or electronic or magnetic record that is subject to a motion under the main clause of the preceding paragraph constitutes a document or electronic or magnetic record as referred to in the main clause of paragraph or in order to determine whether a person has legitimate grounds as provided in the proviso to paragraph, the court may have the person in possession of the document or the person with the authority to access the electronic or magnetic record present document. In this case, no person is entitled to seek the disclosure of the document or electronic or magnetic record that has been presented.

(3) In a case as referred to in the preceding paragraph, if the court finds that it is necessary to disclose a document or electronic or magnetic record referred to in the second sentence of the preceding paragraph and hear opinions as to whether a document or electronic or magnetic record that is subject to a motion under the main clause of paragraph (1) constitutes a document or electronic or magnetic record as referred to in the main clause of paragraph or as to whether a person has legitimate reason as provided in the proviso to the paragraph, the court may disclose the documents or electronic or magnetic record to a party, etc. (meaning a party (or, if a party is a corporation, its representative) or a party's agent (other than a litigation representative or assistant in court) or employee or other such worker; the same applies hereinafter), to a litigation representative, or to an assistant in court.

(4) In a case as referred to in paragraph (2), if the court finds that it is necessary to disclose a document or electronic or magnetic record as referred to in the second sentence of paragraph (2) and hear an explanation based on expert knowledge, the court may disclose the document or electronic or magnetic record to a technical advisor (meaning a technical advisor as provided in Part I, Chapter V, Section 2, Subsection 1 of the Code of Civil Procedure; the same applies in Article 105-2-6, paragraph (4)) with the consent of the party.

(5) The preceding paragraphs apply mutatis mutandis to the presentation of the object of an inspection that is necessary for proving the relevant infringement

in litigation involving the infringement of a patent right or exclusive license.

(Issuing an Investigation Order to an Investigator)

Article 105-2 (1) At the motion of a party, in litigation involving the infringement of a patent right or exclusive license, in order for the court to determine whether the facts that must be proven have or have not occurred, if it is found that it is necessary to collect evidence by verifying, activating, measuring, running experiments, or taking other such measures with a document, device, or other such item (hereinafter referred to as a "document, device, or analogous item") that the other party owns or manages; and if there are found to be adequate grounds to suspect that the other party has infringed the patent or exclusive license and it is expected that the movant will not be able to collect that evidence themselves or through other means, the court, after hearing the opinion of the other party, may order an investigator to conduct an investigation; provided, however, that this does not apply if it is found to be inappropriate to do so because the time required to collect the evidence or the burden on the party to be investigated would be unreasonable or due to other such circumstances.

- (2) A motion for an investigation must be made using a document stating the following:
- (i) the reason why there is sufficient grounds to suspect the other party has infringed the patent right or the exclusive license;
 - (ii) information sufficient to identify the documents, devices, or analogous items that would be subjected to the investigation, and the locations of those documents, devices, or analogous items;
 - (iii) the facts that must be proven and the relationship between them and the evidence that will be obtained through the investigation;
 - (iv) the reason why the movant is unable to collect the evidence provided for in the preceding item by themselves or through other means;
 - (v) if the movant is seeking the permission of the court that is referred to in Article 105-2-4, paragraph (2), the measures for which permission is sought and the necessity of those measures .
- (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 a motion for an investigation order.

(Designating an investigator; related matters)

Article 105-2-2 (1) An investigation is conducted by an investigator.

(2) The investigator is designated by the court.

- (3) The court may order an enforcement officer to provide the necessary assistance for the investigator at the motion of a party when it is deemed necessary for a more efficient investigation.

(Challenge)

Article 105-2-3 (1) If there are circumstances in which an investigator is involved that could prevent them from investigating in good faith, a party may challenge the investigator before that investigator conducts the investigation. The same applies even after the investigator has conducted the investigation, if either grounds for a challenge arise or a party comes to know of the existence of grounds for a challenge after the investigation.

- (2) . The provisions of Articles 214, paragraphs (2) through (4) of the Code of Civil Procedure apply mutatis mutandis to a motion for a challenge under the preceding paragraph and the decision on such a motion. In this case the phrase "the court in charge of the case, an authorized judge, or a commissioned judge" in paragraph (2) of that Article is deemed to be replaced with "the court".

(Investigation)

Article 105-2-4 (1) . When an order under the provisions of Article 105-2, paragraph (1) has been issued, an investigator must conduct an investigation, prepare a written report on the results (hereinafter referred to as an "investigation report"), and submit this to the court.

- (2) When conducting an investigation, an investigator may enter a factory, office of business, or other such place (referred to as "factory or other such place" in the following paragraph and the following Article) of the party being investigated where a document, device, or analogous item that the investigation is to cover is located, or may question the party being investigated or ask the party to present a document, device, or analogous item; and may additionally activate devices, take measurements, run experiments, and take any other measures permitted by the court as measures that are necessary to the investigation.
- (3) When providing the needed assistance referred to in Article 105-2-2, paragraph (3), an enforcement officer may enter the factory or other such place of the party being investigated where a document, device, or analogous item that the investigation is to cover is located, or, in order to help the investigator, may question the party being investigated or ask the party to present a document, device, or analogous item.
- (4) In a case as referred to in the preceding two paragraphs, the party being investigated must provide the investigator and enforcement officer with the cooperation necessary to the investigation.
- (5) Article 132-13 of the Code of Civil Procedure does not apply to the

investigation report submitted to the court under the provisions of paragraph (1).

(Consequences If a Party Being Investigated Refuses Entry into the Factory or Other Such Place and in Other Such Cases)

Article 105-2-5 If, without legitimate grounds, a party being investigated fails to comply with the following actions under the provisions of paragraph (2) of the preceding Article: an investigator's demand to enter a factory or other such place; an investigator's questioning or demand to present the document, device, or analogous item; or an investigator's demand to activate a device, take a measurement, run an experiment, or take other measures permitted by the court as measures that are necessary to the investigation, the court may find that the movant's claims regarding the facts that must be proven are true.

(Service of a Copy of the Investigation Report; Related Matters)

Article 105-2-6 (1) When an investigation report has been submitted, the court must serve a copy on the party that was investigated.

- (2) The party that was investigated may request to not have all or part of the investigation report disclosed to the movant, within two weeks from the date on which the party has received a copy of the investigation report.
- (3) If a motion under the preceding paragraph has been filed and the court finds there to be just cause, the court may issue a ruling establishing that it will not disclose all or part of the investigation report to the movant.
- (4) If the court finds it to be necessary to disclose all or part of an investigation report and hear the opinion of a party or other such person, litigation representative, assistant in court, or technical adviser as to whether the just cause provided for in the preceding paragraph is present, it may disclose all or part of the investigation report to that person; provided, however, that before the court discloses all or part of the investigation report to a party or other such person, assistant in court, or technical advisor, it must first obtain the consent of the party that was investigated.
- (5) An immediate appeal may be filed against a ruling dismissing a motion under the provisions of paragraph (2) and against a ruling establishing that the court will not disclose all or part of the investigation report as referred to in paragraph (3).

(Inspection of the Investigation Report; Related Matters)

Article 105-2-7 (1) Unless it has been established pursuant to the provisions of paragraph (3) of the preceding Article that the court will not disclose all of the investigation report, if the party that was investigated has not filed the motion provided for in paragraph (2) of that Article within the period provided for in

that paragraph, or if the judicial decision on a motion under the provisions of that paragraph has become final and binding, the movant or the party that was investigated may file a request with the court clerk to inspect or copy the investigation report, or to be issued the original, a certified copy or extract of the investigation report (excluding, if applicable, any part that it has been established pursuant to the provisions of paragraph (3) of the preceding Article that the court will not disclose).

(2) Beyond as provided in the preceding paragraph, no one may request to inspect or copy, to be issued the original or certified copy or extract of, or to duplicate an investigation report that has been submitted.

(3) The provisions of Article 91, paragraphs (4) and (5) of the Code of Civil Procedure apply *mutatis mutandis* to an investigation report as provided in paragraph (1). In this case, the phrase "the preceding paragraph" in paragraph (4) of that Article is deemed to be replaced with "Article 105-2-7, paragraph (1) of the Patent Act", and the phrase "a party to the case or a third party that makes a *prima facie* showing of interest in these objects" is deemed to be replaced with the phrase "the movant or the party that was investigated".

(Investigator's Right to Refuse Testimony)

Article 105-2-8 (1) If a current or former investigator is examined as a witness regarding a confidential matter learned in connection with an investigation, they may refuse to testify about that matter.

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

(Travel and Other Expenses of the Investigator)

Article 105-2-9 The travel expenses, daily allowances, and lodging fees associated with an investigator, as well as investigation fees and costs required for investigations, are handled based on the provisions related to these things that appear in the Act on the Costs of Civil Proceedings (Act No. 40 of 1971), to the extent that this is not contrary to their nature.

(Delegation to the Supreme Court Rules)

Article 105-2-10 Beyond what is provided for in this Act, the Supreme Court Rules prescribe the necessary matters connected with the implementation of the provisions in Article 105-2 through the preceding Article.

(Opinions of Third Parties)

Article 105-2-11 (1) At the motion of a party, if the court specified in each item of Article 6, paragraph (1) of the Code of Civil Procedure 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 hear the other party's opinion, and may specify a reasonable period and seek from the general public the submission of opinions either in writing or by electronic or magnetic means (meaning electronic or magnetic means as prescribed in Article 132-2, paragraph (1) of the Code of Civil Procedure; hereinafter the same applies in this Article) at the person's option regarding the application of this Act or regarding any other necessary matters relating to the case.

- (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 the items 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 High Court hear the other party's opinion, and may specify a reasonable period and seek from the general public the submission of opinions either in writing or by electronic or magnetic means at the person's option regarding the application of this Act or regarding any other necessary matters relating to the case.
- (3) A party may file a request with the court clerk to inspect or copy the documents submitted pursuant to the preceding two paragraphs, to be issued the original, certified copy, or extract thereof, to inspect or copy the electronic or magnetic records containing opinions submitted by electronic or magnetic means pursuant to those paragraphs, to be issued the documents certifying all or part of particulars thereof, or to provide the electronic or magnetic records certifying all or part of the contents thereof.
- (4) Article 91, paragraph (5) (including as applied *mutatis mutandis* pursuant to Article 91-2, paragraph (4)) of the Code of Civil Procedure apply *mutatis mutandis* to the inspection and copying of documents submitted pursuant to paragraphs (1) and (2) and the inspection and copying of electronic or magnetic records containing opinions submitted by electronic or magnetic means pursuant to those paragraphs.
- (5) Article 132-13 of the Code of Civil Procedure does not apply to the documents and recording media storing electronic or magnetic records submitted to the court 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, at the motion of a party, if the court 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 that 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 In litigation involving the infringement of a patent right or violation of an exclusive license, if damages are found to have been incurred, but it is extremely difficult to prove the facts that need to be proved in order to prove the value of damages, due to the nature of the facts, 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 right or violation of an exclusive license, if a prima-facie showing is made that proprietary trade secrets (meaning 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, at the motion of the party, the court may issue a ruling ordering the relevant party or other such person, litigation representative, and assistant 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 one that is subject to an order as under this paragraph in respect of the trade secrets; provided, however, that this does not apply if a party or other such person, litigation representative, or assistant 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) proprietary trade secrets of the party are detailed in a brief that has already been submitted or that is to be submitted, or the trade secrets are included in evidence that has already been examined or that is to be examined (including documents or electronic or magnetic records disclosed pursuant to Article 105, paragraph (3), all or part of the investigation report submitted under Article 105-2-4, paragraph (1), or documents or electronic or magnetic records disclosed under Article 105-7, paragraph (4)); and
 - (ii) the use of the trade secrets as referred to in the preceding item for a purpose other than conducting the litigation in question, or the disclosure of the trade secrets, would be likely to hinder the business activities of the party that are based on the 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 secrets 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 electronic written ruling (meaning electronic or magnetic records (limited to records recorded in a file stored on a computer (including its input and output devices) used by the court under the provisions of Article 253, paragraph (2) of the Code of Civil Procedure as applied mutatis mutandis pursuant to Article 122 of the Code) prepared under the provision of Article 252, paragraph (1) of the Code as applied mutatis mutandis pursuant to Article 122 of the Code; hereinafter the same applies in the following paragraph and paragraph (2) of the following Article) must be served on any person that has become subject to the confidentiality protective order.
- (4) A confidentiality protective order takes effect as of the time that the electronic written ruling is served on the person 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 a 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 on 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 electronic 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 come into 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 secrets 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 or review a part of the case record that holds the confidential information referred to in that Article, immediately after the request is filed, the court clerk 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 or review 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 in the paragraph (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 or review the parts of the case record that hold confidential information.

(Suspension of Open Examination of Parties)

- Article 105-7 (1) If a party or other such person in litigation involving the infringement of a patent right or violation of an exclusive license is to be questioned as a direct party to the case, legal representative or 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 proprietary trade secrets of a party, and if, with the unanimous accord of all judges, the court finds that the party or other such person will be unable to offer sufficient statements about the matters due to the significant harm that would clearly befall those of the party or other such person, the business activities that are based on the trade secrets as a result of the party or other such person 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 party or other such person 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 or other such person present a document giving the gist of the matters with regard to which the party or other such person would offer a statement or an electronic or magnetic record recording the matters to be given in the document. In this case, no person may request the disclosure of a document or electronic or magnetic record so presented.
- (4) If the court finds it to be necessary to disclose a document or electronic or magnetic record as referred to in the second sentence of the preceding paragraph, so as to hear the opinion of a party or other such person, litigation representative, or assistant in court, the court may disclose the document or electronic or magnetic record 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 obtains registration of establishing 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 registration establishing the patent right 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 co-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, or other laws and regulations (hereinafter referred to as a "reduction or exemption" in this paragraph), and the co-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 co-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 after the 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 must be paid by the persons other than the State.
- (4) If 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 a 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 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 obtaining registration of establishing 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, pursuant to the provisions of Cabinet Order, the commissioner may reduce, exempt, or grant a deferment for the payment of the patent fee that is to be paid pursuant to the provisions of Article 107, paragraph (1).

Article 109-2 (1) Pursuant to the provisions of Cabinet Order, the Commissioner of the Japan Patent Office may reduce, exempt, or grant a deferment for the payment of the patent fee that is to be paid pursuant to the provisions of Article 107, paragraph (1) for a person that obtains the registration establishing a patent right or a patentee, who is provided by Cabinet Order, comprehensively considering the financial resources, ability of research and development or technical development, and the degree of their contribution to industrial development and other factors of a small and medium-sized enterprise, research and development institute, etc., or other person or entity.

- (2) The term "small and medium-sized enterprise" 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 through 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 specified by Cabinet Order; and
 - (ix) a corporation engaging in specified non-profit activities (meaning a corporation engaging in specified non-profit activities provided in Article 2, paragraph (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 "research and development institute, etc." as used in paragraph (1) means a person that falls under any of the following items:
- (i) the president, vice president, dean, professor, associate professor, assistant professor, lecturer, assistant, or any other employee who exclusively engages in research 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); the president, vice president, dean, professor, associate professor, assistant professor, lecturer, or assistant, or any other employee who exclusively engages in research of a college of technology provided in that Article (referred to as a "college of technology" in the following item and item

- (iv)); or the head of an inter-university research institute provided in Article 2, paragraph (3) of the National University Corporation Act (Act No. 112 of 2003) (referred to as an "inter-university research institute" in the following item) or any other inter-university research institute employee who exclusively engages in research;
- (ii) a person that establishes a university or college of technology, or an inter-university research institute;
- (iii) an accredited organization as provided in Article 5, paragraph (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, paragraph (1) of the Act on General Rules for Incorporated Administrative Agencies (Act No. 103 of 1999)) that carries out research and development activities (referred to as a "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) In terms of the results of technology research arising at the research incorporated administrative agencies specified by Cabinet Order (hereinafter referred to as "specified research and development IAA" in this item), a person that is in the business of acquiring patent rights and rights to obtain patents owned by the specified research and development IAA, that relate to the results of technology research, and then transferring those research results to private businesses seeking to make use of them, by transferring those patent rights that the person acquires based on patent rights and rights to obtain patents, by establishing exclusive licenses, or by taking other such actions;
- (vi) a person that establishes a public research and development institute (meaning a laboratory, research institute, or other such organization that is established by a local government (excluding a public school provided in Article 2, paragraph (2) of the School Education Act) and that carries out research and development activities); and
- (vii) a local incorporated administrative agency for research and development (meaning a local incorporated administrative agency (meaning a local administrative incorporated agency provided for in Article 2, paragraph (1) of the Local Incorporated Administrative Agency Act (Act No. 118 of 2003)), which does not fall within the category of a public university corporation provided for in Article 68, paragraph (1) of that Act, and which carries out research and development activities).

(Payment of Patent Fees by a Person Other Than Those Required to Pay

Patent Fees)

Article 110 (1) An interested person or any other such person not constituting the person required to pay a patent fee may pay a patent fee even if this is against the will of the person required to pay the patent fee.

(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, paragraph (1); 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 pursuant to Order of the Ministry of Economy, Trade and Industry.
- (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 lapsed retroactively at 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 lapsed retroactive at 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 at the time that the time frame ended as provided in the main clause of Article 108, paragraph (2) or at the end of the year including the day of the expiration of the patent term, 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., or importing, or offering for transfer, etc. 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

(Filing of an 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 in this case, 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, 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 entered against the ruling in 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 a granted patent stating the following matters:

- (i) the name, and domicile or residence of the person filing an opposition to a granted patent and the patent opponent's representative;
 - (ii) an indication of the patent related to the opposition to a granted patent; and
 - (iii) an indication 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 or the date on which a notice under Article 120-5, paragraph (1) is received.

- (3) A chief administrative judge must send a duplicate 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) Article 144-2, paragraphs (3) through (5) 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 co-owned patent right, the continuance or suspension has effect on all of the co-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, paragraphs (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 an 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 mistranslations;

(iii) explanation of an ambiguous statement; and

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

(3) If claims attached to a written application covering two or more claims are being corrected, a request for correction may be filed in the preceding paragraph for each claim; provided, however, that 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 a "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 send to the person filing an opposition to a patent document stating the grounds for revoking a patent of which notification was made pursuant to paragraph (1) and a duplicate of the written request for correction as well as a duplicate of the corrected description, claims, or drawings attached to the duplicate of the written request, and give the opponent 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 therefor 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".

(Formality Requirements of Ruling)

Article 120-6 (1) A ruling on a motion of an opposition to a granted 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 on the patentee, the patent opponent, intervenors, and a 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 a granted 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 that which 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, paragraphs (3) through (6), and Article 170 apply mutatis mutandis to proceedings and a ruling on an opposition to a granted patent.

- (2) Article 114, paragraph (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

(Appeal Against Examiner's Decision of Refusal)

Article 121 (1) A person that is subject to an examiner's decision to the effect that an application is to be refused, and that is dissatisfied with this decision may file an appeal against the examiner's decision of refusal 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 an examiner's decision of refusal has been unable to file it 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 in this case, 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 Articles 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 the 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 the 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 be granted 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 be granted the patent).

- (3) A request for a trial for patent invalidation may be filed even after the lapse 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 trial decision 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 trial decision to the effect that the patent is to be invalidated has become final and binding, the patent right is deemed not to have existed beginning from the time that item first became applicable to the patent.

(Trial for Invalidation Concerning the Registration of a Patent Term Extension)

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

- (i) the registration of the extension is made in response to an application filed before the base date;
 - (ii) the period by which the extending registration has extended the patent term exceeds the permissible length for the extension of the term of the patent rights;
 - (iii) the registration of extension is made in response to an application filed by a person that is not the patentee; and
 - (iv) the registration of the extension is made in response to an application which does not meet the requirements prescribed in Article 67-2, paragraph (4).
- (2) A request for a trial for invalidation concerning the registration of a patent term extension as referred to in the preceding paragraph may be filed only by an interested person.
 - (3) Article 123, paragraphs (3) and (4) apply *mutatis mutandis* to a request for a trial for invalidation concerning the registration of a patent term extension as referred to in paragraph (1).
 - (4) When a trial decision to the effect that the registration of extension as

referred to Article 67-3, paragraph (3) is to be invalidated has become final and binding, the extension of the term of the patent right resulting from the registration of the extension is deemed never to have occurred; provided, however, that if the registration of extension falls under paragraph (1), item (ii) and a trial decision to the effect that the registration of extension for the period that exceeds the permissible length for the extension of the patent right is to be invalidated has become final and binding, the extension is deemed not to have occurred .

- (5) Any application to register an extension as referred to in Article 67, paragraph (4) that was filed within the period by which the term of patent rights was extended based on a registration of extension that has been deemed never to have been made, pursuant to the main clause of the preceding paragraph, or that was filed within the period for which, pursuant to the proviso to that paragraph, the extension has been deemed not to have occurred, and that is pending before the Japan Patent Office, is deemed to have been withdrawn.
- (6) If an extending registration as referred to in Article 67-7, paragraph (3) has been made in connection with an application to register an extension as referred to in Article 67, paragraph (4) that was filed within the period by which the term of patent rights was extended based on a registration of extension that has been deemed never to have been made, pursuant to the main clause of paragraph (4), or that was filed within the period for which the extension has been deemed not to have occurred, pursuant to the proviso to the paragraph, the extension of the term of the patent rights resulting from the registration of extension is deemed never to have occurred .

Article 125-3 (1) A request for a trial for invalidation concerning the registration of a patent term extension may be filed if the registration of extension as referred to in Article 67-7, paragraph (3) falls under any of the following:

- (i) the registration of extension has been made in response to an application that has been filed in a case in which it is not found that the person needed to obtain the disposition provided by Cabinet Order as referred to in Article 67, paragraph (4) in order to work the patented invention;
- (ii) the registration of extension has been made in response to an application that has been filed in a case in which the patentee or an exclusive licensee or a non-exclusive licensee of the patent right has not obtained the disposition provided by Cabinet Order as referred to in Article 67, paragraph (4);
- (iii) the period by which the registration of extension has extended the patent term exceeds the period during which the patented invention could not be worked;
- (iv) the registration of extension has been made in response to an application

- filed by a person that is not the patentee; and
- (v) the registration of extension has been made in response to an application not complying with the requirements as provided in Article 67-2, paragraph (4) as applied *mutatis mutandis* pursuant to Article 67-5, paragraph (4).
- (2) Paragraphs (2) and (3) of the preceding Article apply *mutatis mutandis* to a request for invalidation trial of the registration of extension under the preceding paragraph.
- (3) Once a trial decision to the effect that the invalidating a registration of the extension as referred to in Article 67-7, paragraph (3) is to be invalidated has become final and binding, the extension of the term of the patent rights resulting from that registration of extension is deemed never to have occurred; provided, however, that if the registration of the extension falls under paragraph (1), item (iii) and a trial decision to the effect that invalidating the registration the extension for the period that exceeds the period during which the patented invention could not be worked has become final and binding, the extension is deemed not to have occurred for that excess period.

(Trials for Correction)

- Article 126 (1) The patentee may file a request for a trial for correction 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) explanation of an ambiguous statement; and
- (iv) rewriting a statement of claims that cites another statement of claims to a statement that does not cite the other statement of claims.
- (2) A request for a trial for correction may not be filed between the time that an opposition to a granted patent or a 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 claims attached to a written application covering two or more claims 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 group of claims in the relevant claim, a request must be filed for each group of claims.
- (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 for each group of claims pursuant to the

second clause of the preceding paragraph, with respect to the whole of any groups of claims 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 lapse 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 trial decision 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 establishment of a patent right is deemed to have been made based on the corrected description, claims, or drawings.

Articles 129 and 130 Deleted

(Formality 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 request.
- (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 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 request 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 changes the gist of the 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 the 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 changes the gist 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 made it necessary to amend the grounds for the request; or
 - (ii) there were 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 duplicate of the written request under Article 134, paragraph (1).
- (4) No appeal may be entered against the ruling as referred to in paragraph (2)

or inaction.

(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 a patent term extension in respect of the same patent right, these persons may jointly file the request for the trial.
- (2) If a request for trial or appeal is filed against a patentee that jointly owns the patent right, the request must be filed with all of the co-owners as respondents.
- (3) If a request for trial or appeal is filed by a co-owner of a patent right or a right to be granted a patent in respect of the right under co-ownership must be jointly filed by all of the co-owners.
- (4) If there are grounds for continuance or suspension of trial or appeal proceedings in respect of one of the persons that have 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 Formality 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 if the procedure falls under 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 formality 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, by a ruling, dismiss a procedure involved in a case under trial or appeal 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 the provisions 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 Unlawful Procedures)

- Article 133-2 (1) A chief administrative judge may, by a ruling, dismiss any procedures that are not lawful 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 paragraph (1) must be issued in writing and 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 duplicate of the written request on 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 duplicate of the written 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 duplicate thereof on 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 any one of the following purposes:
- (i) restriction of the claims;
 - (ii) correction of errors or mistranslations;
 - (iii) explanation of an ambiguous statement; and

- (iv) rewriting a statement of claims that cites another statement of claims to a statement of claims that does not cite the other statement of claims.
- (2) If claims attached to a written application covering two or more claims are being corrected, the request for correction referred to in the preceding paragraph may be filed on a claim-by-claim basis; provided, however, that if a request for a trial for patent invalidation has been filed on a claim-by-claim basis, the request for correction referred to in that paragraph must be filed on a claim-by-claim basis.
- (3) In the case referred to in the preceding paragraph, when there is a group of claims 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 the request, the judge must serve a duplicate 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 Article 126, paragraphs (5) through (7) 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 Unlawful Request for Trial or Appeal by Decision on Trial or Appeal)

Article 135 An unlawful 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 judges that make up the panel referred to paragraph (1) of the preceding Article 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 the case where a report under Article 164, paragraph (3) has been submitted).

- (2) If one of the administrative judges designated pursuant to 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 Japan Patent Office must designate one of the administrative judges designated under paragraph (1) of the preceding Article as the chief administrative judge.

- (2) The chief administrative judge presides over affairs relating to trial or appeal cases.

(Exclusion of Administrative Judges)

Article 139 An administrative judge is excluded 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 , an intervenor, or a patent opponent in the case;
- (ii) 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 cohabitating relative of a party to the case , an intervenor, or a patent opponent in the case;
- (iii) the administrative judge is a guardian, a guardian supervisor, a curator, a curator supervisor, an assistant, or an assistant supervisor of a party to the case, 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, an intervenor, or a patent opponent in the case;
- (vi) the administrative judge was involved, as the examiner, in the case connected to the appeal that has been filed against the examiner's decision;
or
- (vii) if the administrative judge handling a case involving an application to register an extension as referred to in Article 67, paragraph (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 exclusion as referred to in the preceding Article, a party or an intervenor may file a motion to disqualify.

(Challenging against the Administrative Judge)

Article 141 (1) If there are 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 giving a written or oral statement regarding the case to the administrative judge; 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.

(Formality Requirements for a Motion to Exclude or Challenge)

Article 142 (1) A person filing a motion to exclude 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 Exclude or Challenge)

Article 143 (1) If a motion to exclude 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 entered against the ruling as referred to in paragraph (1) or inaction thereof.

Article 144 If a motion to exclude 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 the case where 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 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 affairs for that case.
 - (5) Articles 139 (excluding items (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 exclude or challenge may not participate in the trial as regards to the exclusion or challenge.

(Formal Requirement for Trial and Appeal Proceedings)

- Article 145 (1) A trial for patent invalidation or a trial for invalidation concerning the registration of a 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 or appeal, other than one provided for in the preceding paragraph is conducted through written proceedings; provided, however, that a chief administrative judge may decide 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 intervenors to appear on that date.
 - (4) The summons to appear on an oral proceeding date as referred to in the preceding paragraph is effected through the service of a writ of summons, through the announcement of the oral proceeding date to a person who has appeared in connection with the relevant case, or by any other means that is considered to be appropriate.
 - (5) If the summons to appear on an oral proceedings date as referred to in paragraph (3) is effected other than through the service of a writ of summons or the announcement of the oral proceedings date to a person who has appeared in connection with the case, no legal sanction nor any other disadvantage may be attributed to a party, intervenor, witness, or expert who does not appear on the oral proceedings date for failure to keep the oral proceedings date; provided, however, that this does not apply if the relevant person has submitted a document indicating receipt of the summons to appear on the date.
 - (6) 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 order and public morals.
 - (7) At the motion of a party or intervenor or by the chief administrative judge's

own authority, the chief administrative judge may conduct proceedings on the date for the trial or appeal referred to in paragraph (3) in a way that enables the administrative judges and the trial or appeal clerk, and the parties and the interveners to communicate with one another, with an awareness of each other's condition, through audio and visual transmissions, pursuant to Order of the Ministry of Economy, Trade and Industry.

- (8) 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 of the Code of Civil Procedure (Presence of Interpreters) applies *mutatis mutandis* to a trial or appeal. In this case, the term "the Rules of the Supreme Court" in Article 154, paragraph (2) is deemed to be replaced with "the Ordinance of the Ministry of Economy, Trade and Industry," and the term "the court and both parties" is deemed to be replaced with "the administrative judges and the trial or appeal clerk, and the parties and the interveners."

(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 the gist 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 their opinion in the record.

- (3) Article 160, paragraphs (3) and (4) of the Code of Civil Procedure (Statement of Oral Arguments) and Article 160-2, paragraph (1) of the Code (Correction of a statement) apply *mutatis mutandis* to the trial or appeal record referred to in paragraph (1). In this case, the term "the Rules of the Supreme Court" in Article 160, paragraph (3) of the Code is deemed to be replaced with "the Ordinance of the Ministry of Economy, Trade and Industry."

(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 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 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 duplicate 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 issue a ruling on the application.
- (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 entered against the ruling as 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 request 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 affairs.

Article 151 Article 145, paragraphs (3) through (5), (7) and (8), Article 147 of this Act and Article 93, paragraph (1) (Designation of Court Dates), Articles 179 through 181, 183, and 184, Article 185, paragraphs (1) and (2), Article 186, paragraph (1), Articles 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), Article 215, paragraphs (1) and (3), Articles 215-2 through 217, Article 218, paragraphs (1) and (2), Articles 219 through 222, Article 223, paragraphs (1) through (6), Article 226, Article 227, paragraph (1), Article 228, Article 229, paragraphs (1) through (3), Articles 231 and 231-2, Article 231-3, paragraphs (1) (limited to the part of the mutatis mutandis application of Articles 220 through 222, Article 223, paragraphs (1) through (6), Article 226, Article 227, paragraph (1), and Article 228 (excluding paragraph (4)) of the Code of Civil Procedure) and (2), Article 232, paragraph (1), Articles 233, 234, 236 through 238, and 240 through 242 (Evidence), and Article 278, paragraph (1) (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 phrase "Designation and Change of Court Dates" in Article 93, paragraph (1) of the Code of Civil Procedure is deemed to be replaced with "Designation of Court Dates," the term "facts admitted by a party in court and obvious facts" in Article 179 of the Code 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 "the Ordinance of the Ministry of Economy, Trade and Industry," the phrase "a document or electronic or magnetic record detailing or recording the result of expert opinion" in Article 218, paragraph (2) of the Code is deemed to be replaced with "a written expert opinion," the term "the Rules of the Supreme Court" in Article 231-2, paragraph (2) and Article 231-3, paragraph (2) of the Code is deemed to be replaced with "the Ordinance of the Ministry of Economy, Trade and Industry," the phrase "by way of submitting a recording medium storing the electronic or magnetic record or using an electronic data processing system specified by the Rules of the Supreme Court" in Article 231-2, paragraph (2) is deemed to be replaced with "by way of submitting a recording medium storing the electronic or magnetic record," the phrase "by way of submitting or sending a recording medium storing the electronic or magnetic record or using an electronic data processing system specified by the Rules of the Supreme Court" in Article 231-3,

paragraph (2) is deemed to be replaced with "by way of submitting or sending a recording medium storing the electronic or magnetic record."

(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.

(Consolidation or Separation of Proceedings)

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

(2) Proceedings that are consolidated pursuant to the preceding paragraph may later be separated.

(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 group-by-group basis, any withdrawal of the request must constitute the withdrawal of 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 concluded.

- (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) the 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 on the parties, intervenors, and person whose application to intervene has been rejected.

(Special Provisions Regarding Appeals Against Examiner's Decision of Refusal)

Article 158 A procedure undertaken during an examiner's examination is also valid during an appeal against an examiner's decision of refusal.

Article 159 (1) Article 53 applies *mutatis mutandis* to an appeal against an examiner's decision of refusal. 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 an examiner's decision of refusal)".

- (2) Article 50 and Article 50-2 apply *mutatis mutandis* when any of the reasons for rejection found in an appeal against an examiner's decision of refusal 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 the case where the examiner issues the notice under the following Article together with the notice of grounds for refusal)" 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 the case where the examiner issues the notice under the following Article together with the notice of grounds for refusal, and excluding a case in which the applicant makes an amendment prior to filing of an appeal against an examiner's decision of refusal), item (iii) (excluding a case in which the applicant makes an amendment prior to filing of an appeal against an examiner's decision of refusal) or item (iv)".
- (3) Articles 51, Article 67-3, paragraphs (2) through (4) and Article 67-7, paragraphs (2) through (4) apply *mutatis mutandis* to an appeal if there are found to be reasonable grounds to file an appeal against an examiner's decision of refusal.

Article 160 (1) If the examiner's decision is rescinded in an appeal against an examiner's decision of refusal, 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 an examiner's decision of refusal.

Article 162 If an appeal is filed against an examiner's decision of refusal is requested 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 filing of the appeal against an examiner's decision of refusal)".

- (2) Articles 50 and 50-2 apply *mutatis mutandis* if any of the reasons for refusal are found that differ from the reason for the examiner's decision is discovered in the 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 the case where the examiner issues the notice under the following Article together with the notice of reasons for refusal)" 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 the case where the examiner issues the notice under the following Article together with the notice of the reasons for refusal, and excluding a case in which the applicant makes an amendment prior to the filing of an appeal against an examiner's decision of refusal), item (iii) (excluding a case in which the applicant makes an amendment prior to the filing of an appeal against an examiner's decision of refusal) 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 refuse 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 the 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 is 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 therefor 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 trial decision in a trial for invalidation concerning the registration of a 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 A decision on a trial or appeal becomes final and binding on a trial or 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 the 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 send copies of any record of the litigation which the administrative judges find to be necessary for the trial or appeal or printed documents of any matters recorded in electronic or magnetic case records of the litigation (meaning electronic or magnetic case records as prescribed in Article 91-2, paragraph (1) of the Code of Civil Procedure) which the administrative judges find to be necessary for the trial or appeal.

(Bearing of Costs of a Trial or Appeal)

- Article 169 (1) The burden of costs connected 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 (3) of the Code of Civil Procedure (Bearing of Court Costs) 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 (3) 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 an examiner's decision of refusal or a trial for correction are borne by the petitioner.
- (4) Article 65 of the Code of Civil Procedure (Burden of Costs in Joint Litigation) 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 legal representative 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 an examiner's decision of refusal.
 - (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) of the Code of Civil Procedure (Scope of Proceedings) applies *mutatis mutandis* to a retrial.

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

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

- (2) If patent rights under a revoked or invalidated patent or patent rights under an invalidated registration of patent term extension are restored on retrial, or if the establishment of patent rights or the patent term extension is registered on retrial in connection with a patent application or an application for registration of patent term extension that was rejected in a trial decision, the effect of the patent rights does not extend to the following actions as performed after the decision to revoke or the trial decision becomes final and binding but before the registration of the request for a retrial:
- (i) the working of 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. any 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 rights under a revoked or invalidated patent or patent rights under an invalidated registration of patent term extension are restored on retrial, or if the establishment of patent rights or the patent term extension is registered on retrial in connection with 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 those patent rights, but only within the scope of the invention that the person is working or preparing to work and within the purview 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 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 (1) 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 a trial for patent invalidation 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 that trial for patent invalidation, the court must send 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 permission, 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 Japan Patent Office may designate a 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 the claim set.

(Sending of the Original 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, without delay, the court must send the document as provided in the corresponding item to the Commissioner of the Japan Patent Office:

- (i) if the court procedures have been concluded by a judicial decision: the original of the judgment rendered by the court of each instance or a document stating the particulars of the judgment which is certified by a court clerk that the particulars stated in the document are identical to the particulars of the judgment; and
- (ii) if the court procedures have been concluded by a means other than a judicial decision: the documents necessary for identifying claims pertaining to that action.

(Composition of a Panel)

Article 182-2 With respect to an action as referred to in Article 178, paragraph (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 Consideration)

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 consideration 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 (1) or (2)(b), or Article 14 (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 (1)(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 as 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 (2) of the treaty, as they stand on the international filing date provided for in (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 "exception period for submitting national documents") from the priority date referred to in Article 2 (xi) of the 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 period 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 (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 or drawings") are not submitted within the exception period 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 or drawings and translations of the drawings and abstracts provided for 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 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 the translation of the description or drawings within the period 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 the time of expiration of the period for the submitting national documents.
- (6) If an amendment under Article 19 (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 period for the submitting national documents expires (if the applicant requests examination of the application within the period 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 period 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 period 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 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 period 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 exception period for submitting translations); and
- (v) a fee that is to be paid pursuant to Article 195, paragraph (2) is not paid within the period 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 or drawings 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 (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 (1) of the Treaty, the applicant must submit a copy of the written amendment submitted under Article 19 (1) to the Commissioner of the Japan Patent Office on or before the date on which the standard time for national processing 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 provided for in paragraph (1), the amendment under Article 19 (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 (2)(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 (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 served to the Japan Patent Office as under Article 36 (3)(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 a 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 period 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 exception period 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 period 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, 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 or drawings has been submitted pursuant to Article 184-4, paragraph (4) without delay, after the translation of the description or drawings 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, 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 a 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 for in Article 3 (2) of the Patent Cooperation Treaty Done at Washington on June 19, 1970 (excluding those in an international patent application for which the establishment of patent rights 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 that is the subject of the international patent application 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 warned and prior to the registration of establishment of the patent rights, 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 prior to the registration of establishment of the patent rights, works an invention connected with a Japanese-language patent application that has been claimed in an internationally published international patent application; or against a person that knowingly, in the course of trade, and prior to the registration of establishment of the patent rights, works an invention connected with a foreign-language patent application that has been claimed in a nationally published international patent application.

- (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 expiration 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 be 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 drawings have 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 (1) of the Patent Cooperation Treaty Done at 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 a 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 is 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 Done at 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 Loss 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 Done at 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 Done at 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 "paragraph (1) is deemed to be replaced with "the preceding paragraph" in Article 41, paragraph (2); 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 "paragraph (1)" is "paragraph (1)"; the phrase "application is deemed to be published " in

Article 41, paragraph (3) is deemed to be replaced with "the international publication as prescribed in Article 21 of the Patent Cooperation Treaty Done at Washington on June 19, 1970", 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 standard 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, paragraph (1) or (4), or Article 48-5, paragraph (1) of the Act has 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 period for 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 the exception period for submitting 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))."

(An International Application Deemed a Patent Application by Decision)

Article 184-20 (1) If a refusal as provided in Article 25 (1)(a) of the Treaty or a declaration as provided in Article 25 (1)(a) or (b) of the Treaty has been issued by the receiving Office as referred to in Article 2 (xv) of the Treaty, or if a finding as provided in Article 25 (1)(a) of the Treaty has been made by the International Bureau referred to in Article 2 (xix) of the Treaty in connection with an international application (limited to a patent application only) that lists Japan as a designated State as referred to in Article 4 (1)(ii) of the Treaty, an applicant filing an international application as referred to in Article 2 (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 (2)(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 *mutatis mutandis* 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 right 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 on 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 the trade secrets owned by the 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 an examiner's decision of refusal (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 the proprietary trade secrets 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 daily life; and
 - (vii) documents which are likely to injure public order and public morals.
- (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 the administrative entity holds (meaning the personal information the administrative entity holds that is provided for in Article 60, paragraph (1) of the same 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 for 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), Article 99, Article 100, paragraph (1), Articles 101 through 103, Articles 105 and 106, and Article 107, paragraphs (1) (excluding items (ii) and (iii)) and (3) of the Code of Civil Procedure (service) 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 102 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 101, 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 (excluding when the service is possible under the provision of Article 109-2), 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 indication being published 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 this on board of the Japan Patent Office or by displaying this on the screen of a computer located in the office of the Japan Patent Office so that it can be inspected.

- (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 who must be served on.

- (2) If 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 applies 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 what is provided for in this Act, the following must be published in the patent gazette:

- (i) examiners' decisions to reject patent applications after their publication; waivers, withdrawals, and dismissals of patent applications after their publication; and withdrawals of applications to register patent term extensions;
- (ii) succession to the right to be granted 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 as applied mutatis mutandis pursuant to paragraph (7) of the Article);
- (v) lapse of patent (excluding lapse at the expiration of the period 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 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 the case where 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 a patent or a right to be granted a patent is held under the co-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 are payable by the State and the person other than the State pursuant to those provisions in respect of their own patent or a right to be granted a patent (but only a fee specified by Cabinet Order which is other than for the request for examination) are the amount arrived at by multiplying the fee provided for in those provisions by the percentage that represents the share of the person other than the State, and this is the amount that the person other than the State must pay.
- (6) If the right to be granted a patent is held under co-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 co-owner's shares of the right to be granted 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 be granted a patent is the sum total calculated by first multiplying the applicable fee for filing the request for examination provided for in that paragraph for each co-owner other than the State (for a person receiving a reduction or exemption, this means the fee after 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 amount 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 follows or before the service of a certified copy of the examiner's decision as follows, 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 of 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. However, for a person other than a person specified by Cabinet Order as a person who has particular difficulty in paying the fee for requesting the examination of the application due to economic difficulties or other reasons, the number of cases shall be limited to the number specified by Cabinet Order.

Article 195-2-2 Pursuant to the provisions of Cabinet Order, the Commissioner of the Patent Office may reduce or waive the fees for a request for examination that are payable pursuant to Article 195, paragraph (2) for a person that is filing a request for examination of the person's own patent application and that constitutes a person specified by Cabinet Order as referred to in Article 109-2, paragraph (1). However, for a person other than a person specified by Cabinet Order as a person who has a particularly high ability to carry out research and development and technology development, or a particularly high degree of contribution to the development of industry of an experimental and research institute, etc., provided in Article 109-2, paragraph (3), or other person or entity, the number of cases shall be limited to the number specified by Cabinet Order.

(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 Administrative Review Under the Provisions of the Administrative Complaint Review Act)

Article 195-4 It is not permissible to request for administrative review under the provisions of the Administrative Complaint Review Act for an examiner's decision, revocation decision, or trial decision, for a ruling to dismiss a statement of opposition to a granted patent, for a written request for a trial or retrial or a written request for correction under Article 120-5, paragraph (2) or Article 134-2, paragraph (1), or for a disposition against which no appeal may be filed pursuant to this Act, or inactions thereof.

Chapter XI Penal Provisions

(The Crime of Infringement)

Article 196 A 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 If a current or former investigator discloses or misappropriates a secret learned in connection with their investigation, the current or former investigator is subject to imprisonment 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 a 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 paragraph (1) of the preceding Article: 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 paragraph (2) of the preceding Article 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 paragraph (1) of the preceding Article, 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 legitimate grounds 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, other materials, or electronic or magnetic records for examination or for the preservation of evidence, but that, without legitimate grounds for doing so, does not comply with that order is subject to punishment by a civil fine not exceeding 100,000 yen.

Appended Table (In relation to Article 195)

	Person who must 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 a foreign language	26,000 yen per case
3	A person responsible for the procedures under Article 38-3, paragraph (3)	16,000 yen per case
4	A person responsible for the procedures under Article 184-5, paragraph (1)	16,000 yen per case
5	A person filing a petitio under Article 184-20, article (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) Applying the registration of extension under Article 67, paragraph (2).	43,600 yen per case
	(2) Applying the registration of extension under Article 67, paragraph (4).	74,000 yen per case
7	A person filing a request for extension of time limits under Article 5, paragraph (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, paragraph (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, paragraph (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 term of a patent right, a trial for invalidation of the registration of extension of the term 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