

Japanese IP law and practice

Report of CIPA seminar, 2 September 2013, The CIPA Hall, London

Tatsuya Tanaka (Kyowey International), **Shigei Yamakawa** (Yamakawa International Patent Office), **Norihito Yamao** (Aoyama & Partners), **Yoshinori Shimizu** (Soei Patent & Law Firm), **Shigeyuki Nagaoka** (Fujimura Patent Bureau, P.C.), **Masato Sasaki** (Fukami Patent Office, P.C.) and **Ken-ichi Katayama** (Ohno & Partners) formed a delegation from the JPAA that visited CIPA on 2 September 2013 to give a seminar on different aspects of Japanese IP law and practice.

Mr Norihito Yamao began the session by giving a presentation on recent and expected developments in Japanese IP law and practice. Mr Yamao talked about nine main developments, all of which were brought into effect on 1 April 2011. The development that may be of most interest to UK practitioners, and which prompted the most questions from the audience, is the relaxation of limitations on the Japanese grace period. Previously the grace period was available only for specific types of disclosure, but that limitation has now been abolished. An applicant wanting to take advantage of the grace period should file a Japanese patent application (or a PCT application) within six months of the disclosure. Mr Yamao also explained that it is no longer necessary to register a non-exclusive licence with the Japanese Patent Office. A rightful patent owner can now request that a misappropriated patent be transferred to him. The requirements for obtaining a remedy in respect of a missed fee or late-filed translation have also been relaxed somewhat. Finally, Mr Yamao talked about the possibility that the Japanese Patent Office may introduce a post-grant review after changes to the invalidation trial system have not seen the increase in the number of invalidity cases that had been expected.

Mr Yoshinori Shimizu spoke about four recent court decisions in Japan. The first decision concerned inventive step. Applying reasoning that will feel familiar to any European practitioner, the court in the *Circuit Connecting Material* case said that it is imperative that the problems solved by the features of the invention are accurately grasped in order to be able to objectively determine whether the invention could have been easily arrived at. Interestingly, the guidelines followed by examiners at the Japanese Patent Office have not yet been updated to reflect this. Mr Shimizu provided the audience with useful advice when he explained that the Appeal Boards at the Japanese Patent Office take heed of the courts' judgments in a way that the examiners do not. Therefore, Mr Shimizu suggested, it can often be well worth appealing a final rejection on inventive-step grounds.

The second decision concerned filing experimental data. Mr Shimizu referred to the recent *Sunscreen* decision in which the court was willing to accept late-filed experimental data in support of inventive step. This contrasts with the earlier *Polarizing Film* case on enablement, in which the court ruled that late-filed experimental data did not solve a problem of lack of enablement.

The third decision was the *Solder Resist* case, which overturned the conventional view of the Examination Guidelines that "disclaimer" amendments are not permitted.

Mr Shimizu's fourth and final decision concerned product-by-process claims and the different scopes of protection that are accorded to "authentic" and "inauthentic" versions of these claims. In a lively question-and-answer session, Mr Shimizu explained that the principles laid down in these cases should eventually filter through into the Examination Guidelines.

Mr Katayama gave a presentation about making claim amendments at the Japanese Patent Office. He explained that amendments are considered to have retroactive effect in Japan, and consequently the opportunities for making amendments are only available at certain times and with restrictions depending on the stage of examination. The first opportunity for making amendments occurs after filing the application and before the issuance of the first notification of reasons for refusal. At this time amendment is essentially allowed provided that no new matter is added. The second opportunity occurs after the first notification of reasons for refusal is issued. At this stage amendments are only allowed if they fulfil the requirements for unity of invention. This means that the claim amendments must include the same or corresponding special technical features to the claim in which the examiner first identified a special technical feature. Mr Katayama recommended during the question-and-answer session following his presentation that important features be presented in the lower-numbered claims to maximise the chance of the examiner picking a special technical feature that is most beneficial to the applicant. The third opportunity for making amendments comes after the issuance of the final notification of reasons for refusal. At this stage the opportunities for making amendments are limited to deleting a claim, restricting a claim and correcting or clarifying the description. Mr Katayama finally gave a helpful explanation of the written description support requirements in Japan and how these differ from Europe.

In the final presentation of the day, Masato Sasaki talked about Japanese Design Law. Mr Sasaki gave the audience a helpful overview of Japanese design practice and the particular requirements of Japanese design law. He also perfectly illustrated the complexities of determining the "similarity" or otherwise of designs with reference to two cases from the Japanese courts that prompted much debate in the audience!

The lively discussion ensuing from Mr Sasaki's presentation rounded off what had been a very interesting and informative afternoon discussing Japanese IP law and practice.

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