



Key points of amendment of Japanese IP laws in 2021 with emphasis on Trademark Act

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The "Act for Partial Revision of the Patent Act, etc." was passed and enacted on May 14, 2021, and promulgated as Act No. 42 on May 21, 2021. The following is key points of the "Act for Partial Revision of the Patent Act, etc." in relation to trademarks and designs.

Establishment of procedures for digitization, etc.

(1) Review of the procedures for oral hearings, etc. of trial/appeal, etc. (making oral hearings of trials online)

With respect to oral hearings, etc. of trial/appeal, at the discretion of the presiding examiner, it will be possible for the parties, etc. to conduct the procedures using a web conference system without physically appearing in the trial / appeal court.

✓ Procedures on the date of oral proceedings, examination of evidence or preservation of evidence may be conducted by a method that enables trial examiners, trial clerks, parties and intervenors to communicate while mutually recognizing the status of the other party by sending and receiving images and sounds.

Already implemented on October 1, 2021

(2) Abolition of the two-step payment of fees for applications for international trademark registration.

The individual fees for applications for international trademark registration shall be paid collectively to the International Bureau prior to international registration.

(Related to Article 68-19(1), 68-30(1) and 68-35 of the Trademark Law)

The effective date will be a date to be determined by a Cabinet Order within a period not exceeding one year and six months from May 21, 2021 (currently undetermined).

(3) Review of service of a certified copy of the assessment of registration for an application for international registration of a design or trademark

With respect to the method of assessment of an application for international trademark registration, the Commissioner of the Patent Office may substitute the service of a certified copy of the assessment by notifying the International Bureau of the matters stated in the assessment as provided for in the Protocol to the Madrid Agreement on the International Registration of Marks. (Re: Trademark Act, Article 68-18-2)

The effective date will be a date to be determined by a Cabinet Order within a period not exceeding one year and six months from May 21, 2021 (currently undetermined).

With respect to the method of assessment of an application for international design registration, the Commissioner of the Patent Office may substitute the service of a certified copy of the assessment by notifying the International Bureau of the matters stated in the assessment of registration. (Re: Article 60-12-2 of the Design Act)

Already implemented on October 1, 2021

(4) Expansion of the method for submitting a certificate of exception to lack of novelty in an application for international design registration

An applicant of application for international design registration may file a certificate for the application of exception to loss of novelty with the International Bureau as provided for in the Geneva Amendment to the Hague Agreement on



the International Registration of Designs. (Related to Article 60-

7(2) of the Design Act)

Already implemented on October 1, 2021

Review of rights protection in response to changes in corporate behavior due to progress in digitalization, etc.

(1) Strengthening of restrictions on the influx of counterfeit goods from abroad

In response to the increasing number of counterfeit goods imported for personal use, the conduct of **foreign businesses** bringing counterfeit goods into Japan by mail or other means will be positioned as an infringement of trademark rights and/or design rights.

Under Japanese laws an individual importer of counterfeits for personal use cannot be regarded as infringer of trademark and/or design rights. Under the amended laws the foreign business will be an infringer of trademark and/or design rights when an individual in Japan imports counterfeits for personal use.

Importation as defined in the definition of working of designs includes the act of a person in a foreign country causing another person to bring into Japan from a foreign country. (Related to Article 2, Paragraph 2, Item 1 of the Design Act)

The importation provided for in the definition of use of a trademark includes the act of a person in a foreign state causing another person to bring the trademark into Japan from a foreign state. (Related to Article 2(7) of the Trademark Act)

The effective date will be a date to be determined by a Cabinet Order within a period not exceeding one year and six months from May 21, 2021 (currently undetermined).

(2) Relaxation of requirements for restoration of trademark rights, etc. (Trademark Law)

(i) Restoration of trademark right

Where the failure to renew the duration of a trademark right within the period from six months prior to the expiration of the duration of the trademark right to the date of expiration is found to be unintentional, such an application may be filed only within a certain period of time. (Article 21(1) of the Commercial Code).

(ii) Restoration of trademark right through additional payment of late division registration fee, etc.

Where the failure to pay the late division registration fee and the registration surcharge within six months after the expiration of five years prior to the expiration of the trademark right is deemed to be unintentional, the late division registration fee and the registration surcharge may be paid in addition within a certain period of time (Article 41-3(i) of the Commercial Code).

(iii) Application for registration of renewal of the duration of a right based on defensive mark registration

An application for registration of renewal of the duration of a right based on defensive mark registration may be filed within a certain period of time, if the failure to file an application for registration of renewal during the period from six months prior to the expiration of the duration of the right based on defensive mark registration to the date of expiration is found to be unintentional (Article 65-3(iii) of the Commercial Code).

(iv) Application for registration of renewal

Where the failure to file an application for registration of renewal within the time limit for filing an application for registration of renewal is deemed to be unintentional, an application for registration of renewal may be filed only within a certain time limit (Article 3(iii) of the Supplementary Provisions of the Commercial Code).

The effective date will be a date to be determined by a Cabinet Order within a



period not exceeding one year and six months from May 21, 2021 (currently undetermined).

Strengthen the foundation of the intellectual property rights system

Effective April 1, 2022, the trademark registration fee will increase by 17% (from 28,200 yen per class to 32,900 yen per class) and the renewal registration application fee will increase by 12% (from 38,800 yen per class to 43,600 yen per class).

Ministerial Ordinance for Partial Revision of the Ordinance for Enforcement of the Patent Act and the Ordinance for Enforcement of the Design Act, etc.

- (1) Establishment of new provisions on the filing and electronic exchange of priority documents in international design registration applications

The applicant of an international design registration application can submit the priority document to the International Bureau at the same time as the international application, and the JPO can do the electronic exchange of the submitted priority document with the International Bureau.

Already implemented on October 1, 2021

If you have any questions, please do not hesitate to contact Ken Nakayama at ken@sugimura.partners.

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Frequently Asked Questions

National Application

Q. Would you recommend conducting a trademark availability search before filing a trademark application?

A. We conduct a complimentary identical trademark search or knock-out search before filing a trademark application. If you would like to know any possibility of existence of earlier similar marks that are likely to become a bar against use/registration of the mark, we would suggest conducting a full trademark availability search that covers similar marks as well as identical marks.

Q. What's the time frame for a trademark application to mature into registration after the filing?

A. It normally takes about 10 to 16 months after the filing, depending on the complexity of the case.

Q. What's the necessary document for filing a new trademark application?

A. No particular documents such as Power of Attorney are required in order to file a new trademark application in Japan.

Q. What information is needed for the purpose of filing a new trademark application?

A. We need the following information in order to proceed with the filing:

- i) Mark
- ii) Applicant's name and address

- iii) Class(es)
- iv) Goods and/or services

Q. Is the applied-for mark put under substantive examination before granted?

A. Yes. The examiner conducts examination in terms of both absolute ground (e.g. whether the mark is inherently distinctive) and relative ground (e.g. whether there are any earlier similar marks).

Q. Is it possible to obtain an extension of time to respond to an Office Action?

A. Yes. It is possible to obtain a one-month extension by submitting a written petition for the extension to the JPO.

Q. Is it possible to file a multiple-class trademark application?

A. Yes.

Q. It seems that an earlier registered mark cited against the applied-for mark in an Office Action covers a different class from that of the subject mark. Why did the examiner cite this earlier mark as conflicting with the filed mark?

A. The JPO adopts peculiar similarity group code to each good and service, and similarity between goods/services is automatically determined based on the allocated similarity group code. If two goods/services under different classes are allocated the same similarity group code, those goods/services are automatically deemed as being similar to each other at the examination stage.

Q. When is the due for claiming priority to a basic application?

A. Six months from the filing date of the basic application. It is necessary to submit a Certified Copy of Priority Document to the JPO within 3 months from the filing.

Q. What's the consequence of failing to submit the Certified Copy of Priority Document?

A. The Applicant cannot enjoy the benefit of the earlier filing date of the basic application. Instead, the applied-for mark is deemed as filed on an actual filing date.

Q. Does the mark need to be actually used so that the mark is granted?

A. No.

Trademark Registration/Right

Q. How long is a trademark registration valid?

A. A registered mark is valid for 10 years from the registration date.

Q. What's the risk of not using a registered trademark?

A. A trademark registration becomes vulnerable to cancellation 3 years after registration. If the mark has not been used for the past three consecutive years in Japan with regard to some or all of the goods/services, any party can cancel the mark with regard to those particular goods/services for which the mark has not been used, by initiating a non-use cancellation action before the JPO.

Q. What's the necessary document for initiating a non-use cancellation action?

A. An original Power of Attorney signed by the Appellant. The original POWER OF



ATTORNEY can be late-filed after the filing of the cancellation action.

Caveat: Under Covid 19 pandemic the JPO is currently accepting the Power of Attorney bearing the name of an officer of the applicant company without signature.

Q. When can an Opposition be filed?

A. The window for filing an Opposition is 2 months from the publication of Official Gazette of a trademark registration. Substantial arguments and supporting evidence can be late-filed within 90 days after filing a notice for Opposition before the JPO.

Q. What's the necessary document for filing Opposition?

A. An original POWER OF ATTORNEY signed by the Appellant. The original POWER OF ATTORNEY can be late-filed after the filing of the notice for Opposition.

Caveat: Under Covid 19 pandemic the JPO is currently accepting the Power of Attorney bearing the name of an officer of the applicant company without signature.

Renewal

Q. What's the necessary documents for renewal of a registered trademark?

A. No particular documents such as POWER OF ATTORNEY are required.

Q. Is it possible to renew a trademark after the due date for renewal has elapsed?

A. It is possible to renew the mark within 6 six months after the expiry by paying a surcharge in addition to the original official fee.

Q. Is it possible to reduce the number of classes at the time of renewal?



A. Yes. An original signed POWER OF ATTORNEY is required.

Q. When can the renewal procedure be taken before the JPO?

A. The renewal request can be filed 6 months prior to the due for renewal.

International Registration extension to Japan

Q. We received an Office Action from the JPO in relation to a Japanese designation of international trademark registration filed through the Madrid Protocol route. What's the necessary documents to have you respond to the OA with the JPO?

A. We need to submit an original POWER OF ATTORNEY signed by the Applicant, so that we can represent the case before the JPO. The original POWER OF ATTORNEY can be late-filed after submitting the response to the OA.

Q. When is the due for responding to an Office Action issued against a Japanese designation of IR through Madrid Protocol route?

A. Three months from the pronouncement date of the OA.

Misc.

Q. How many trademarks are filed with the JPO?

A. About 120,000 filings per year.

Non-traditional Trademarks

Q. Are any non-traditional marks accepted at the JPO?



- A. Yes. The following marks would be granted registration, provided all requirements including distinctiveness are met: sound marks; moving marks; hologram marks; color per se marks; position marks; three-dimensional marks.
- Q. Are there any additional requirements for filing the non-traditional trademark application?
- A. For moving marks, hologram marks, color per se marks, and position marks, it is necessary to provide a detailed explanation of the mark in the application request. Such detailed explanation of the mark is not mandatory for the sound mark. Instead, it is necessary to submit a CD-R or DVD-R recorded with the sound in MP3 format.
- Q. In the case of sound mark, what information needs to be included for the trademark drawing section of the application request?
- A. Either musical score or word description.
- Q. How the color of color per se mark is specified in the detailed description of the application request?
- A. The mark needs to be identified by, for example, the ratio of three primary colors (RGB), or Pantone number.
- Q. Are there any differences in official fee for filing a non-traditional trademark application?
- A. No.

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