

Revised Patent Law

The following is our review of the revised Japanese Patent Law to be effective in 2004:

Revisions Effective as of January 1, 2004

(1) The current patent opposition system will be discontinued and merged into the new patent appeal system. Under the new patent appeal system, any one can seek trial for invalidation of patent any time. Under certain conditions, one can amend cause of action for such trial. One may state dissatisfaction against any decision. On and after the effective date above, no patent opposition whatsoever will be accepted even for the patents which still fall within the period for filing an opposition under the old patent law.

(2) Correction trial after the filing of civil action to obtain patent may be sought only within 90 days after such filing. In addition, when correction trial is sought, the court at its sole discretion can refer the relevant civil action to obtain patent back to the Patent Office for consideration in another trial for invalidation of patent.

(3) Requirement for unity of invention will be harmonized with that for PCT. Decision will be made based on whether there is a relation common to all of the claims (technical characteristics sufficient to surpass prior art). Decision will be made based on whether there exists a single general invention concept shared by all of the claims.

(4) When one submits a PCT application with the Japanese Patent Office as receiving office, all of the countries which are the party to the convention will be deemed to be designated to obtain patent protection. The actual selection of the countries to be designated cannot be made until the application enters into the national phase in Japan. Demand for international preliminary examination may be filed within two months of the priority date.

Revisions Effective as of April 1, 2004

(1) The filing fee of the patent applications filed on or after the effective date above will be reduced from 21000 yen to 16000 yen.

(2) The examination fee of the patent applications filed on or after the effective date above will be approx. twice the current fee. That is, it will be increased from 99,500 yen (current average fee) to 199,900 yen. The examination fee of the patent applications having the application date of March 31, 2004 or before will be unchanged and it is not necessary to seek substantive examination before the above effective date.

(3) As to the patent maintenance fee, annual maintenance fee until the 9th year will be greatly reduced. Annual maintenance fee for the first 1 through 3 years will be approx. one fifth of the current fee, that for the 4th through 6th year, approx. 1/2.5, and that for the 7th through 9th year, approx. 1/1.6. This reduced rate will be applied to the patent applications for which substantive examination is sought on and after the effective date. Those for which substantive examination is sought before the effective date will require the current maintenance fee.

(4) If one submits a patent application before the above effective date and seeks substantive examination before the above effective date, the filing fee, examination fee (no. of claims: 7.6; average for the year of 2001) and maintenance fee (up to the 9th year) would amount to approx. 476,700 yen. If one submits a patent application before the effective date and seeks substantive examination on or after the effective date, the filing fee, examination fee (no. of claims: 7.6; average for the year of 2001) and maintenance fee (up to the 9th year) would amount to approx. 287,100 yen. If one submits a patent application on or after the effective date and seeks substantive examination on or after the effective date, the filing fee, examination fee (no. of claims: 7.6; average for the year of 2001) and maintenance fee (up to the 9th year) would amount to approx. 381,600 yen. Therefore, in terms of expenses, it would be advisable to submit a patent application before March 31, 2004 and seek substantive examination on or after April 1, 2004. Based on the above, you are advised to postpone for the time being to seek substantive examination of the patent applications for which such examination is not urgently needed.

(5) For patent applications withdrawn or abandoned during the pending period for substantive examination after such examination is sought, one can demand refund of the examination fee.

(6) Reduction and exemption (examination fee reduced to 1/2 and maintenance fee for the first 1 through 3 years exempted): We do not go into the detail here.