

# Japan Patent & Trademark Update



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## 1. Quick & Cost-effective Patent Prosecution in Japan for Overseas Applicants



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### Introduction

For those intending to file patent applications in Japan, the biggest concern tends to be how to obtain patents quickly and in a more cost-effective manner. This article provides some tips in this regard.

### (1) Procedures for Acceleration

For the purpose of obtaining patents in an expeditious manner, the Japan Patent Office (JPO) provides four major tools. The details are provided in the indicated websites.

#### i) Accelerated Examination (A/E)

([https://www.jpo.go.jp/torikumi\\_e/t\\_torikumi\\_e/outline\\_accelerated.htm](https://www.jpo.go.jp/torikumi_e/t_torikumi_e/outline_accelerated.htm)) This system is used to expedite proceedings during the examination process. When a request for examination is filed without making special requests, a patent application is placed on a waiting list for examination. However if you file a request for examination with a request for accelerated examination, your application will be fast-tracked (see Table 1).

[Table 1] (JPO Annual Report 2015)

Category	2012	2013	2014
Average Time Period until First OA (Normal)	20.1 M	14.1 M	9.6 M
Average Time Period until First OA (A/E)	1.9 M	1.9 M	2.1 M

All applications filed in Japan while claiming priority from one or more foreign country applications (including PCT) are eligible for A/E. You have to file an A/E before or at the same time as the request for examination. No official fees will be charged. Your Japanese counsel can take care of formal matters.

## ii) Accelerated Appeal Examination (A/A/E)

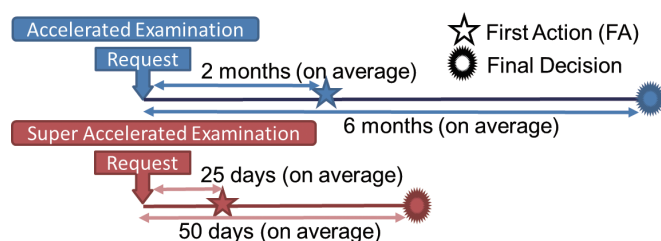
([https://www.jpo.go.jp/torikumi\\_e/t\\_torikumi\\_e/outline\\_accelerated.htm](https://www.jpo.go.jp/torikumi_e/t_torikumi_e/outline_accelerated.htm)) This system is for the accelerated examination applied to an *ex parte* trial, which is a review proceeding of the examiner's final decision. Inbound foreign applications are eligible for this procedure. No official fees are required for A/E/E. However, even when you have already requested an A/E, you still need to file an A/E/E again if you want to have the trial expedited. However, if you do make such application the term for the trial will be shortened remarkably (see Table 2).

[Table 2] (JPO Annual Report 2015)

Category	2012	2013	2014
Average Time Period until Appeal Decision (Normal)	15.8 M	12.6 M	12.4 M
Average Time Period until Appeal Decision (A/A/E)	3.3M	3.3 M	3.1 M

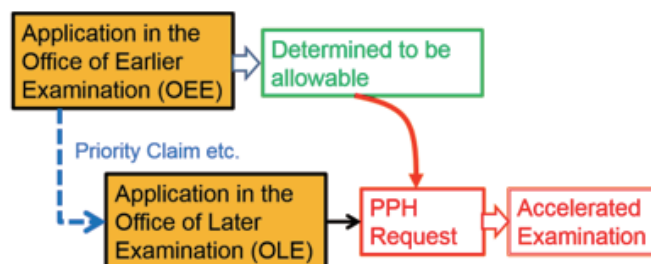
## iii) Super Accelerated Examination (Super A/E)

([https://www.jpo.go.jp/torikumi\\_e/t\\_torikumi\\_e/outline\\_super\\_accelerated.htm](https://www.jpo.go.jp/torikumi_e/t_torikumi_e/outline_super_accelerated.htm)) This system is used to further expedite the examination proceeding. You will receive a first Office Action (OA) within 2 months from the date of requesting the Super A/E and any subsequent OAs within one month from the date of submission of the response to each OA. Compared to the average total term required for an A/E of 6 months, Super A/E needs only 50 days on average. To be eligible for Super A/E, your invention needs to be being worked. Neither official fees nor proof of the working is required.



## iv) Patent Prosecution Highway (PPH)

([https://www.jpo.go.jp/torikumi\\_e/t\\_torikumi\\_e/patent\\_highway\\_e.htm](https://www.jpo.go.jp/torikumi_e/t_torikumi_e/patent_highway_e.htm)) This system is now a popular tool for expediting examination proceedings worldwide. In Japan, the PPH is treated as an A/E or Super A/E.



If your application to the Office of earlier examination (OEE) has determined that the application is allowable, it can be examined in an expedited way in the Office of later examination (OLE) by requesting entry into the PPH. PCT national entry applications are eligible for the PPH if the WO/ISA, the WO/IPEA, or the IPER shows patentability results without citing X or Y category documents (PCT-PPH). The Office of later filing but earlier examination can also be an OEE (PCT-MOTTAINAI). To request entry into the PPH, at least one claim in the OEE's application should be allowable or allowed and all the claims in the OLE's application should sufficiently correspond to the allowable or allowed claim(s) (A/C) in the OEE's application. The PPH system requires a request to be made before making the request for examination. All the Office Actions and claims are required to be translated. However, if the OEE has a dossier access system that provides the English version of OAs and claim(s), the translations are unnecessary.

## (2) Examiner Interview

An effective manner in which to obtain rapid and cost-effective prosecution is to avoid unnecessary Office Actions and *ex parte* Trials. Avoiding one OA may shorten the prosecution period by 3-6 months (in my experience), while avoiding an *ex parte* trial may shorten the period by 12.4 months (JPO Annual Report 2015). To achieve this goal, you should purposely utilize the personal interview system. As the JPO guidelines for personal interview examinations state, the Office is welcome to conduct personal interviews. They expressly accept at least one personal interview per application. In the personal interview, you can make statements to try to have the application patented without needing to be concerned about prosecution estoppel. You can also sound out possible claim amendments. Thus, effective use of personal interviews may avoid further Office Actions and/or *ex parte* trials.

### (3) Reducing Number of Claims

If you want to obtain patents more cost-effectively, you should also consider reducing the number of claims. Official fees for requests for examination, requests for appeal trials, and annuities are all accumulated based on the number of claims. Attorneys' fees may change depending on the number of claims as well. Table 3 shows how the official fees differ in accordance with the number of claims, such as 5, 10, 15, and 20 claims.

[Table 3] (Official fees as of 01/15/2016)

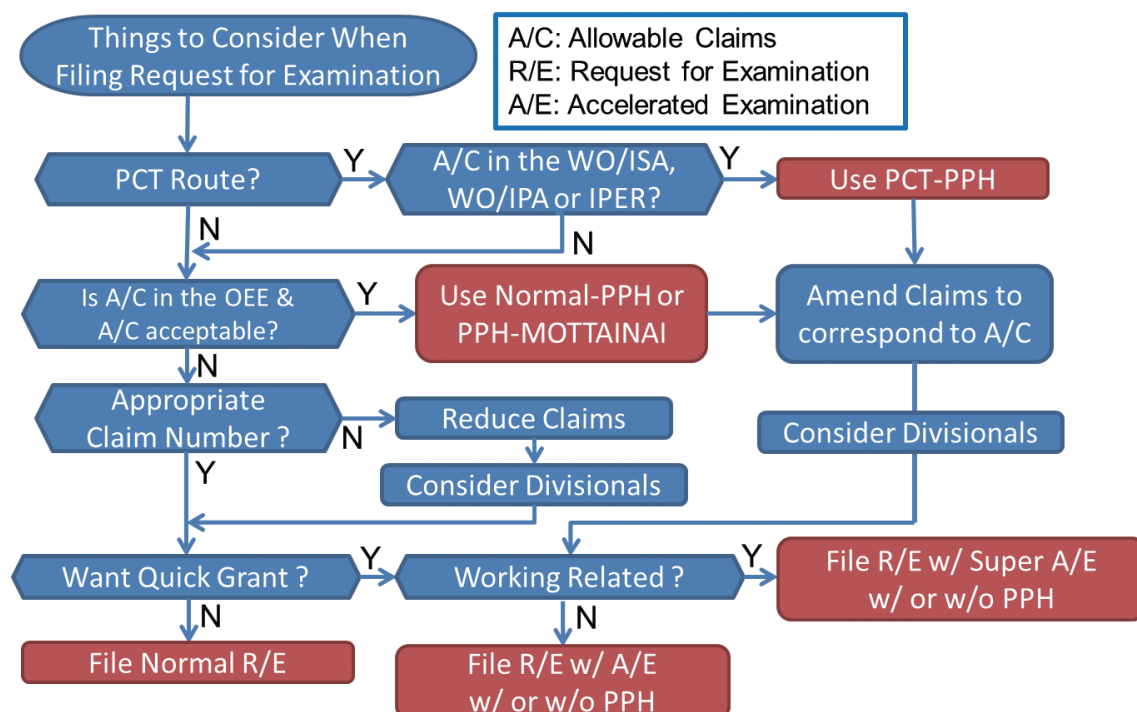
Name of Action	Number of Claims			
	5	10	15	20
Request for Examination	138,000	158,000	178,000	198,000
Request for Appeal	77,000	104,500	132,000	159,500
Total Annuities for Years 1-5	29,900	37,100	45,100	53,100
Total Annuities for Years 6-10	184,900	236,900	288,900	340,900
Total Annuities for Years 11-15	428,000	548,000	668,000	788,000

Therefore, reducing the number of claims at the early stage of prosecution is crucial. You do not have to reduce the number of claims at the time of filing or entering into the national phase, because the filing fee is a set price. A good time to consider this is at the time of making a request for examination.

The below flowchart provides hints as to what you should consider reducing the number of claims at the time of making a request for examination.

### Conclusion

As explained above, when it comes to getting a patent quickly and more cost-effectively, please consider using the accelerated procedures, conducting examiner interviews, and reducing the number of claims.



## 2. Japanese Supreme Court Decision on Patent Term Extension (“PTE”)

- Is PTE allowed based on a new marketing approval (“MA”) where there is a prior MA existing and the patented invention was able to be worked by the prior MA<sup>1</sup> ?-



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### Introduction

The Japanese PTE system allows for the extension of the patent term for up to five years to recover the period during which the patented invention was unable to be worked because of the time required to obtain a marketing approval (“MA”) for drugs and agricultural chemicals. One of the most important characteristics of the Japanese PTE system is that, as long as given requirements are satisfied, more than one PTE application for one patent right may be granted based on more than one MA, and more than one PTE may be granted for more than one patent right based on one MA. Further, a PTE may also be granted even for a patent directed toward an invention other than the product *per se* (e.g., a method of preparing drugs, etc.). Nevertheless, under conventional patent practice in Japan, there was no precedent case wherein, a PTE application based on a new MA would be allowed if there were a prior MA existing and the patented invention was able to be worked by the prior MA.

On November 17, 2015, the Supreme Court handed down an important new case (Genentech Inc. vs. Japan Patent Office (JPO), 2014 (Gyo-Hi)356), on the requirements for registration of a PTE application where there is a prior MA existing. The issue was whether or not the patented invention which was able to be worked by the prior MA can be the subject of a PTE application based on a new MA for a new drug. This Supreme Court case was an appeal against a decision by the special division (Grand Panel system) of the Intellectual Property

High Court (IPHC) settled on May 30, 2014 (2013 (Gyo-Ke)10195 to 10198), which was rendered in favor of allowing a PTE based on the new MA.

### (1) Background

The following table shows a comparison between the prior MA and new MA. The active ingredient and the efficacy and effects are the same between the two MAs, and only the dosage and administration are different.

Prior MA (April 18, 2007)	New MA (September 18, 2009)
<b>Product Name:</b> Avastin for intravenous infusion, 100mg/4mL <b>Active Ingredient:</b> Bevacizumab (recombinant) <b>Efficacy and Effects:</b> Incurable/ Unresectable advanced/recurrent colorectal cancer	
<b>Dosage and administration:</b> In combination with other anticancer drugs, adults are ordinarily infused intravenously with bevacizumab at a dose of <u>5 mg/kg (weight) or 10 mg/kg (weight)</u> administered for an interval of at least <u>2 weeks</u> .	<b>Dosage and administration:</b> In combination with other anticancer drugs, adults are ordinarily infused intravenously with bevacizumab at a dose of <u>7.5 mg/kg (weight)</u> administered for an interval of at least <u>3 weeks</u> .

Claim 1 of Japanese Patent No. 3398382 (“the ‘382 patent”), the subject of the PTE application, is “A composition for treating cancer, comprising a therapeutically effective amount of hVEGF antagonist which is an anti-VEGF antibody,” and the “hVEGF antagonist which is an anti-VEGF antibody” recited in the claim is “Bevacizumab (recombinant),” the active ingredient. Therefore, the invention of the ‘382 patent was able to be worked by the prior MA and, in fact, a PTE based on the prior MA was already granted for the ‘382 patent.

Although the invention of the ‘382 patent was able to be worked by the prior MA, the manufacture and sale of “Bevacizumab (recombinant)” for a combination treatment of XELOX treatment (treatment with 3 weeks/cycle, and requiring only oral medicine and two hours infusion per cycle) and bevacizumab treatment was not allowed based on the prior MA, and such manufacture and sale of the same drug was allowed only after obtaining the new MA.

<sup>1</sup> In this article, unless otherwise stated, the active ingredient and efficacy/effect (indication) of the “new MA” are the same as those for the “prior MA”.



**(2) Decision by the Supreme Court**

The issue was whether the PTE application based on the new MA fell under Section 67<sup>ter</sup>(1)(i) of the Japanese Patent Law.

67<sup>ter</sup>(1) The examiner shall make a decision that an application for registration of an extension of a patent right is to be refused where it falls under any of the following paragraphs:

(i) where it is not deemed that the obtaining of the disposition as provided for in the Cabinet Order referred to in Section 67(2) was necessary for the working of the patented invention;

The Supreme Court stated that, in cases where a prior MA and a new MA have been issued, if, upon a comparison thereof regarding examined matters which directly relate to “substantial identity as a medicine” in light of the category and subject of the patented invention concerning the application for PTE, the manufacture and sale of a medicine covered under the prior MA includes the manufacture and sale of a medicine covered under the new MA, the new MA shall not be necessary for implementation of the patented invention in relation to an application for PTE.

Turning to the present case, the Supreme Court stated that the items relating to the “substantial identity as medicine” in the case of the “invention of a product directed to ingredient(s) of a medicine” are “ingredient(s) of a medicine, quantity, administration, dosage, efficacy and effects.” Further, the Supreme Court referred to the differences regarding dosage and administration between the two MAs, and judged that, in the present case, the manufacture and sale of a medicine covered under the prior MA did not include the manufacture and sale of a medicine covered under the new MA. The Supreme Court maintained the conclusion of the IPHC, and reversed the Decision of Rejection initially made by the JPO. In the meantime, the Supreme Court did not refer to the “scope of the patent right” which was to be extended by the PTE.

**(3) Changes in the Examination Guidelines for PTE applications**

Following the present Supreme Court Case, the JPO announced on November 18, 2015 that they will revise the Examination Guidelines for PTE applications, and that

they will stop examinations for PTE applications, in a case where a prior MA exists, until the publication of their revised Examination Guidelines. The JPO is planning to publish the revised Examination Guidelines in the spring of 2016. As you may be aware, the Examination Guidelines for PTE applications were previously revised on December 28, 2011, following another Supreme Court Case (Takeda v.s. JPO, 2009 (Gyo-Hi)326), and the JPO will now revise the Examination Guidelines again. The following is a brief explanation of the chronological changes which have been or will be made in the Examination Guidelines for PTE applications.

Under the established practice in Japan, if an MA with a new combination of active ingredient and efficacy/effect (indication) were obtained, a PTE would be granted.

Then, after Supreme Court case 2009 (Gyo-Hi)326, in the case where the patented invention was not able to be worked under the prior MA, a PTE could be allowed for the patent based on a new MA, even if the active ingredient and efficacy/effect (indication) were the same between the two MAs. For example, if a prior MA for a normal tablet medicine existed and a new MA for a sustained-release medicine was obtained, a PTE for a patent directed to sustained release formulation could be allowed.

Now, based on the latest Supreme Court case 2014 (Gyo-Hi)356, it is presumed that a PTE can be granted if the “substantial identity as a medicine” differs between a prior MA and a new MA. Specifically, in the case of a patent relating to the “invention of a product directed to ingredient(s) of a medicine”, the “ingredient(s) of a medicine, quantity, administration, dosage, efficacy and effects” are compared between a prior MA and a new MA upon judging substantial identity, and if they are found to be substantially different, a PTE may be granted based on the new MA.

In any event, we will eagerly wait to review the publication of the JPO’s new Examination Guidelines. Lastly, for your information, in the case of filing a PTE application in Japan, please make sure that the PTE application is filed within 3 months after the applicant becomes aware that the MA has been obtained.

## 3. Update on Non-Traditional Marks in Japan



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### Introduction

Pursuant to the amendment of the Trademark Act, Non-Traditional Marks (NTMs) were introduced to Japan from April 1, 2015, and sounds, motions, positions, holograms and colors, became newly protectable. On October 27, the Japan Patent Office (“JPO”) published its first examination results for these NTMs.

#### (1) Number of Applications for NTMs

According to data published by the JPO, the total number of applications submitted up to October 23 are as follows.

	Sound	Motion	Hologram	Color	Position	Total
Until October 23 (provisional)	321	70	11	423	214	1,039
Decisions of Registration	21	16	1	0	5	43

The total number of applications amounted to more than a thousand in the first six months, and, in particular, color marks made up nearly half of the applications, with 423 applications in total, while hologram marks accounted for only 1% of the applications, and it can be seen that there is a big difference between each type of application. Among the above, Decisions of Registration have been granted for 21 sound marks, 16 motion marks, one hologram mark and five position marks – 43 cases in total – and thus almost half of the granted applications were sound marks, while none of the color marks were granted a Decision of Registration.


#### (2) Examples of granted NTMs

The examples of trademarks which were included in the first group of NTMs granted Decisions of Registration were as follows.

#### (a) Sound marks


There are three ways of specifying sound marks: (i) specifying them by characters, (ii) specifying them by musical scores, and (iii) specifying them by combining (i) and (ii). Among the 21 sound marks that have been granted Decisions of Registration at this time, (i) six trademarks were specified by characters, (ii) no trademarks were specified by musical scores, (iii) 15 trademarks were specified by way of combining letters and musical scores.

#### ■ [Examples of Granted Sound Marks]

<p>Reg. No. 5813496 (Epson Sale)</p>  <p>カラリオ ("Colorio")</p>
<p>Class 2 - Inks, etc., for ink-jet printers Class 9 - Printers, etc.</p>
<p>Reg. No. 5805757 (Ito-En)</p> <p>This trademark consists of a person's voice saying "O-i Ocha ("Hello, tea")", and is four seconds long.</p>
<p>Class 30 - Tea, tea drinks</p>

#### ■ [Examples of Sound Marks Not granted at this time]

The Decisions of Registration for sound marks that do not include linguistic elements listed below were not granted at this time.

<p>App. No. 2015-29978 (Epson Sale)</p> 
<p>Class 2 - Inks, etc., for ink-jet printers Class 9 - Printers, etc.</p>

App. No. 2015-29981 (Intel Corporation)



Class 9 - Computer hardware, integrated circuits (IC), IC chips, semiconductor processors, etc.

As we can see from the above, while Epson Sales has applied for a sound mark that does not include the linguistic element “Colorio”, in parallel to the application for the sound mark including such linguistic element, a Decision of Registration has not been granted with regard to the former, and this indicates that even within the same sound marks category, sound marks that do not include linguistic elements undergo a careful examination at this moment.

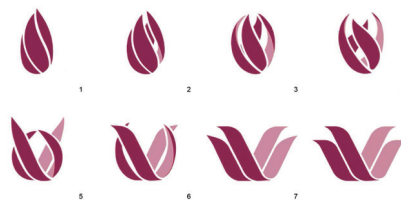
At any rate, many of the applications for sound marks whose registrations were granted at this time were cumulative applications (for sound trademarks) for already registered word marks, such as house marks for companies that are repeatedly announced in advertisements on TV, etc., or their main products.

### (b) Motion marks

With regard to motion marks, there were only about 70 applications, the second lowest number, following hologram marks, and 16 of these applications have been granted Decisions of Registration.

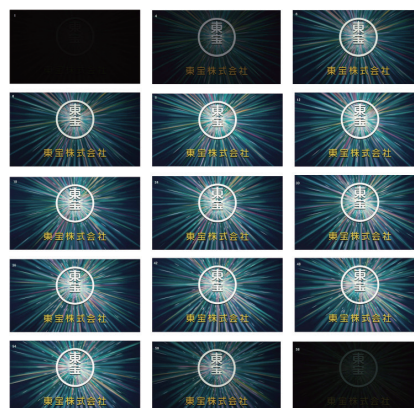
### ■ [Examples of Granted Motion Marks]

Reg. No. 5804316 (Wacoal)



Class 25 - Clothing, garters, socks stoppers, suspenders, bands, belts, footwear, costumes, special clothing for exercise, special shoes for exercise

Reg. No. 5805759 (Toho)



A total of 59 figures

Class 9 - Programs for video game machines for commercial use, , etc.  
Class 41 - Planning, operating of the performance of movies, entertainment, theaters or music, or providing movies using communication networks, etc.

For motion marks as well, many of the Decisions of Registration were carried out upon trademarks such as moving house marks combined with sounds, such as the ones seen in advertisements on TV, etc. However, it should be noted that, since this amendment of the Trademark Act has not allowed applications for trademarks consisting of combinations of sounds and motions, or movies, trademarks for sounds and trademarks for motion still have to be obtained separately.

## (c) Hologram marks

With regard to hologram marks, there were 11 applications, which was the lowest number for any of the NTMs. Among such applications, a Decision of Registration was granted to the one hologram trademark shown below.

### ■ 【Examples of Granted Hologram Marks】



Regarding the 11 applications, due to the nature of hologram marks, most of the applications were filed by finance-related entities, such as Sumitomo Mitsui Card, VJA, Mitsubishi UFJ Financial Group, and Hoken-no Madoguchi Group, which have each filed one application, and JCB, which has filed six applications.

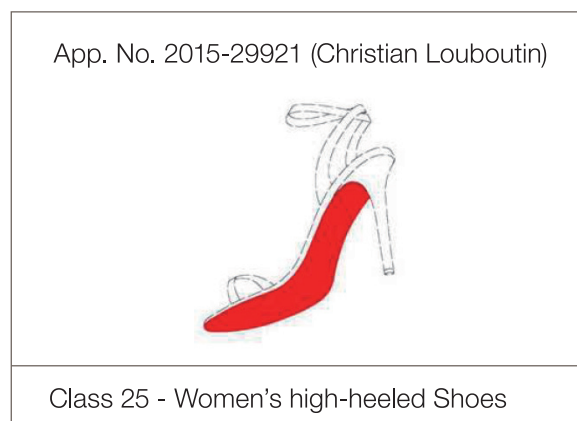
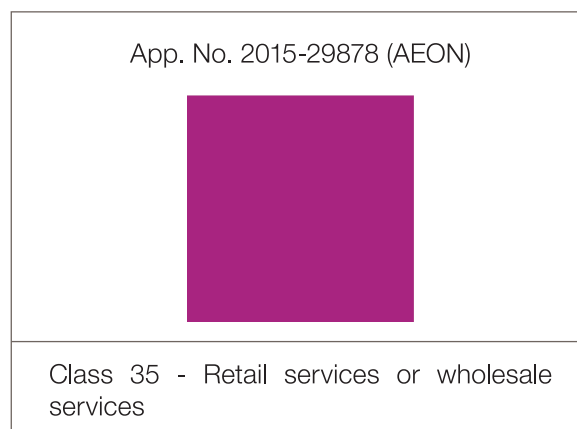
## (d) Color marks

With regard to color marks, despite the fact that these marks made up the biggest number (423) of applications, no Decisions of Registration have been granted. It can be considered that the JPO is examining these applications carefully, due to the considerable impact they may have if the registrations of color marks were to be admitted.

Color marks may be specified by way of the following three methods:

- (i) Specification by a single color;
  - (ii) Specification by a combination of colors; and
  - (iii) Specification by the position of the color on the goods.
- Among the 423 applications made as color marks, the number of applications that could be confirmed in the patent information platform, "J-PlatPat", as of November 11, 2015 was 416, and (i) more than 180 of the said applications, the largest group in terms of numbers, were specified by single colors, followed by (ii) more than 130 of such applications being specified by combinations of colors, and (iii) more than 90 of such applications being specified by the position of the colors on the goods.

### ■ 【Examples of Color Marks filed】

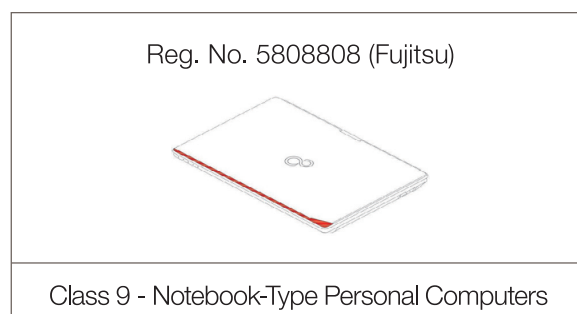


It is considered that trademarks that are specified by combinations of colors or trademarks specified by the positions of colors could be admitted to register, but as for single-color trademarks, registrations for some of them are considered to be admitted through the JPO Appeal Board or the IP High Court.

## (e) Position marks

There were 214 applications for position marks, and this was the third highest number, following the applications for color marks and sound marks. Among these, at this time, five position marks were granted.

### ■ 【Examples of Granted Position Marks】





Reg. No. 5805761 (Seiko Mart)

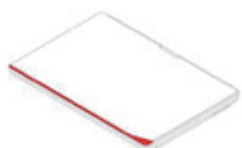


Class 35 - Retail services or wholesale services

Fujitsu has also filed an application for a position mark shown below, in the same manner, but registration has not been granted for this application.

#### ■ 【Examples of Position Marks Not granted at this time】

App. No. 2015-30238 (Fujitsu)



Class 9 - Notebook-Type Personal Computers

Looking at the difference between the granted applications and the non-granted applications made by Fujitsu for position marks, it can be seen that (i) the granted position mark, for instance, specified the subject position mark by way of two figures, including a figure placed in the center of the upper side of the lid, and stated that the mark “consists of a figure placed on the apertural side of the closed lid, inside of the edge line of the upper side, and a figure placed in the center of the upper side of the lid”, whereas (ii) the non-granted position mark, for instance, only specified the position mark as “a figure placed on the apertural side of the closed lid, inside of the edge line of the upper side.” Thus, it can be considered that the more factors, such as figures, which constitute the position mark that are

mentioned in the application, the more likely the trademark is to be registered.

### (3) Analysis

As stated above, Decisions for Registration have been carried out concerning the NTMs for the first time since the introduction of the NTMs; and among the applications for the NTMs, which amount to more than 1,000, it is considered that there will be further progress in the examinations for sound, color and position marks, which add up to 92% of the total number of applications, and the JPO will issue more notifications of reasons for rejection.

Regarding color marks, while Decisions for Registration for single color trademarks are much awaited, the hurdles which need to be overcome are quite high, and it is assumed that, as has been the case with 3D marks concerning the shapes of goods, some single color marks are predicted to be admitted through the JPO Appeal Board or the IP High Court in the future. Factors that facilitate color mark registrations, such as how to combine the colors or how to specify the position of the colors on goods, etc., are also expected to become clearer as the examinations progress in the days ahead. Further, for position marks as well, as it is considered that registration thereof is facilitated by combining the mark together with a word mark or adding features that constitute position marks, such as figures, etc., it is important for applicants to review their application strategies, etc., taking the above viewpoint into consideration.

At any rate, as for the NTMs, an important point to keep in mind is that the main purpose is not to file an application and obtain a registration, but rather to exploit the same and increase the value of the applicant's brand from various perspectives. By exploiting NTMs such as sounds, colors, positions, motions and holograms as trademarks, they may well become global communication tools for companies that go beyond mere characters and languages, and brand owners should once again positively consider how to exploit those trademarks, taking into consideration the further progressing global expansion of companies due to the TPP Agreement into consideration.

#### 4. Three (3) Revision to the employee invention system in Japan



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##### Introduction

On July 3, 2015, the Diet passed a bill into law which revised the employee invention system in Japan (new employee invention system). The new Patent Act will come into force on April 1, 2016. This new employee invention system will apply not only to patents but also utility models and designs.

With regard to the employee invention system, the previous Patent Act stipulates that the right to obtain a patent originally belongs to the employee (inventor). It also allows reserved succession of the right to obtain a patent for the employer. On the other hand, the previous law provides the employees who have actually created the invention with the right to demand payment of “appropriate remuneration” in return for allowing the employers to succeed to the right to obtain a patent.

Under the employee invention system prior to 2005, when an inventor (employee) complained about the amount of remuneration, the amount of remuneration calculated by the court was considered to be “appropriate remuneration” even if the remuneration relating to an employee invention had been regulated by the employment regulations or other stipulations of the employer. In contrast, under the employee invention system from 2005 onwards, where remuneration relating to an employee invention was determined in accordance with the employee’s employment contract, employment regulations or other stipulations, the determined remuneration was considered to be “appropriate remuneration” unless payment of the remuneration in accordance with the stipulations was recognized as being unreasonable. In judging unreasonableness, consideration is given to procedures such as where consultation takes place between the employers and the employees in order to set stipulations for the determination of the said remuneration, where the decided-upon

stipulations have been disclosed, and where the opinions of the employees on the calculation of the amount of the remuneration have been heard, etc.

However, the previous employee invention system under which the right to obtain a patent originally belongs to the employee (inventor) has been criticized because the employee may assign the right to obtain a patent to a third party. In addition, it is not clear how carefully the employers have to proceed with the above procedures in order for them to be judged reasonable. Thus, the employee invention system has now been revised.

##### New employee invention system

The new employee invention system features the three points set forth below:

(a) The revised act stipulates that the invention by an employee belongs to the employer when the right becomes effective, if any provision in any agreement, employment regulation or any other contract stipulates in advance that the right to obtain a patent for any invention made by the employee will be vested in the employer, and thereby aims to eliminate the instability in the ownership of a patent right.

(b) The revised act also stipulates a provision that an employee has the right to receive “reasonable remuneration or other economic profits”, if the employee causes his/her employer to acquire the right to obtain a patent.

(c) The revised act also stipulates a provision that the Minister of Economy Trade and Industry will define guidelines for procedures to determine the details of the reasonable remuneration or other economic profits, through the examination procedures at the Industrial Structure Council, and thereby aims to encourage inventions.

With regard to (a), if the employer does not stipulate in advance that the right to obtain a patent for any invention made by the employee will be vested in the employer, the employee will acquire the right to obtain a patent in the same manner as in the previous employee invention system. Therefore, in order to ensure that employee inventions will automatically belong to the employer, it is important to stipulate such provision.

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With regard to (b), the “reasonable remuneration or other economic profits” mentioned therein constitute an incentive for employee inventions and are not consideration for assignment of the right to obtain a patent. Therefore, it is not necessary for the “reasonable remuneration or other economic profits” to be paid in money and to be appropriate to the value of the employee invention. Examples of non-monetary “reasonable remuneration or other economic profits” are giving an opportunity to study abroad at the expense of the employer, giving stock options, and providing a promotion with a salary increase, etc. In contrast, merely giving a commendation or citation to the employee will not be deemed to constitute “reasonable remuneration or other economic profits” because it is not an economic profit.

With regard to (c), in judging the reasonableness of the “reasonable remuneration or other economic profits”, the procedures are still very important. In addition, the Minister of Economy Trade and Industry will define the guidelines for the procedures. The draft of such guidelines has been disclosed and the guidelines will come into force after April 1, 2016. Thus, when employers make or revise a stipulation about employee inventions, employers have to conform to the guidelines.

### Conclusion

As discussed above, the new employee invention system aims to eliminate the instability in the ownership of patent rights and to encourage inventive creativity. We hope that this new employee invention system, including the guidelines, will be helpful for the increased development of business. Thus, we will continue to keep a close eye on the new employee invention system.



### New Topics

#### Reduction of the official fees in April 2016

As from April 1, 2016, according to the revision of the Patent / Trademark Act, the Japan Patent Office will reduce its official fees. Filing fees for patents will be reduced from 15,000JPY to 14,000JPY, and registration fees for patent will be reduced by approximately 10%, registration fees for trademark will be reduced by approximately 25%, and registrations for renewal will be reduced by approximately 20%.

#### English translations of selected JPO Appeal/Trial Board decisions and Opposition decisions

Since January 2016, the Japan Patent Office has provided English translations of selected JPO Appeal/Trial Board decisions and Opposition decisions at the website set forth below.

The JPO issues approximately 13,000 Appeal/Trial decisions and Opposition decisions per year and will select approximately 100 decisions each year and provide English translations thereof.

[http://www.jpo.go.jp/torikumi\\_e/t\\_torikumi\\_e/trial\\_appeal\\_decisions.htm](http://www.jpo.go.jp/torikumi_e/t_torikumi_e/trial_appeal_decisions.htm)

#### Guidebook of the IP High Court and IP Decisions Database in English

The Intellectual Property High Court published its guidebook in October 2015, which includes sections on past Grand Panel Cases as well as Statistics.

[http://www.ip.courts.go.jp/eng/documents/thesis/141006\\_setuguusiryo/index.html](http://www.ip.courts.go.jp/eng/documents/thesis/141006_setuguusiryo/index.html)

The IP High Court also provides an English translations of selected IP decisions in Japan in its database. The IP decisions can be found by using a database search or by browsing a topic list.

<http://www.ip.courts.go.jp/eng/hanrei/index.html>

## 5. About TMI

Since our establishment on October 1, 1990, TMI Associates has grown rapidly to become a full-service law firm that offers valuable and comprehensive legal services of the highest quality at all times. Among TMI's practice areas, intellectual property (IP) – including patents, designs and trademarks – has been a vital part of the firm from the beginning, and our firm boasts an unrivalled level of experience and achievement in this area.

### Organizational Structure

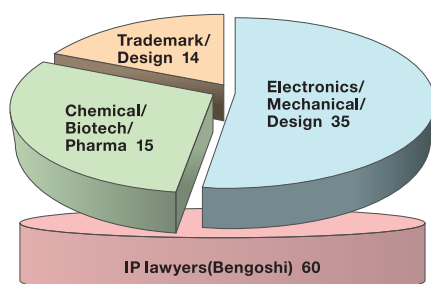
TMI, one of the "Big Five" law firms in Japan, has a total of more than 700 employees worldwide, including around 450 IP/Legal professionals, comprised of approximately 350 attorneys-at-law (Bengoshi), 70 patent/trademark attorneys (Benrishi), and 30 foreign law professionals.

Attorneys (Bengoshi)	350
Patent/Trademark Attorneys(Benrishi)	64
Foreign Law Counsels	5
Foreign Attorneys	22
Foreign Patent Attorney	1
Advisors	5
Management Officers	3
Patent Engineers, Staff	286
<b>Total</b>	<b>736</b>

(As of January 4,2016)

### Attorneys/Patent Attorneys' Areas of Expertise

TMI's practice covers all aspects of IP, including patent/trademark prosecution, transactions (e.g., patent sales, acquisitions and licensing), litigation, invalidation trials, oppositions, due diligence activities and import suspension at the customs. TMI handles over 3,000 patent/trademark/design applications and over 20 IP lawsuits per year and TMI's patent team covers all technical fields, including electronics, computer software, telecommunications, semiconductors, chemicals, biotechnology, pharmaceuticals, and mechanical fields.



### Awards

The firm and our attorneys/patent attorneys have been the proud recipients of awards every year in recent times.

Here is a selected list of just some of the awards TMI has recently received.

- ✓ International Legal Alliance Summit & Law Awards (2014): "Best Japanese IP Firm 2014"
- ✓ ALB Japan Law Awards (2010, 2011 and 2014): "IP Law Firm of the Year"
- ✓ Ranked TIER1 for IP local firms by The Legal 500 Asia Pacific in 2015
- ✓ Selected as a Recommended firm for patent prosecutions by IAM Patent 1000 (2015)
- ✓ Ranked Gold for Trademark Practice by World Trademark Review (WTR) 2013, 2014, 2015 and 2016

### Contact and Global offices

If you have any questions or requests regarding our services, please contact our attorneys and patent attorneys who you regularly communicate with or use our representative address.

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### Feedback

If you have any comments, questions or requests regarding our newsletter, please contact Toyotaka Abe ([tabe@tmi.gr.jp](mailto:tabe@tmi.gr.jp)), editor-in-chief.