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Japan Patent & Trademark Update

Contents

1. System for Non-Disclosure of Selected Patent Applications

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Introduction

On May 11, 2022, the Economic Security Promotion Act (hereinafter referred to as the "ESPA") was enacted, in which the System for Non-Disclosure of Selected Patent Applications (hereinafter referred to as the "Non-Disclosure System") was introduced along with the Systems for Ensuring Stable Supply of Critical Products, Ensuring Stable Provision of Essential Infrastructure Services and Enhancing Development of Specified Critical Technologies. The Non-Disclosure System has been in operation since May 1, 2024.

Under the Non-Disclosure System, if the specification, claims or drawings (hereinafter referred to as the "specification, etc.") of a patent application includes "an invention that, if made known to the public, would be highly likely to create a situation that undermines the security of the nation and its citizens through actions taken from the outside," a procedure established as a "security designation" is carried out to suspend the procedures such as publication of the application, decision of patent grant and decision of refusal, as well as to take measures to prevent information leakage, such as a restriction on working or disclosing the patent.

Review conducted from the perspective of the technology fields, etc. (primary review)

Inventions that are subjected to security designation are selected through two phases, i.e., a primary review conducted by the Commissioner of the Patent Office receiving the patent application, and a secondary review (security review) conducted by the Prime Minister (in practice, the rele vant section of the Cabinet Office).
Within three months of receipt of the patent application, the Patent Office conducts a primary review on whether the specification, etc. includes an invention that belongs to a **specified technology field**, and if such invention is included, the patent application will be sent for a secondary review (Article 66(1) of the ESPA). Furthermore, a patent applicant can also ask for a security review at the time of filing a patent application (Article 66(2) of the ESPA).
For these **specified technology fields**, critical technologies that can greatly affect the state of national security in Japan, as well as technologies that can serve as a means to cause significant damage to people's lives and economic activity in Japan, are defined in the Cabinet Office Ordinance by using the symbols according to the International Patent Classifications (IPC). The Patent Office performs the selection based on the classification result according to the International Patent Classifications.

As for the following specified technology fields (10)-(19), since these are the fields that can include technologies developed in industries and markets of the civil sector, such fields are considered to have a significant impact on the development of industries. Thus, only inventions that satisfy the additional requirements will be subjected to a secondary review.

The following is an overview of the specified technology fields:

Fields that can include critical technologies that can greatly affect the state of national security in Japan	(1) Camouflage and disguise technologies for aircraft, etc. (2) Technologies of unmanned vehicles, autonomous control, etc. relating to weapons, etc. (3) Technologies relating to guided weapons, etc. (4) Technologies relating to the trajectory of projectiles or missiles (5) Technologies relating to weapons using electromagnetic launchers (6) New technologies of attack or defense such as laser weapons and electromagnetic pulse (EMP) bombs (7) Defense technologies against aircraft and guided missiles (8) Technologies relating to attack or defense devices mounted on submarines (9) Technologies of position measurement, etc. using sound waves and relating to weapons
Fields that can include critical technologies that can greatly affect the state of national security in Japan (additional requirements needed)	(10) Technologies relating to scram-jet engines, etc. (11) Technologies relating to solid fuel rocket engines (12) Technologies relating to submarines (13) Technologies relating to unmanned underwater vehicles (14) Technologies of position measurement, etc. using sound waves and relating to submarines, etc. (15) Technologies relating to thermal protection, re-entry, coupling or separating, and meteoroid detection of cosmonautic vehicles (16) Observing and tracking technologies for cosmonautic vehicles (17) Technologies relating to semiconductor light-receiving devices, etc. having quantum dots and superlattice structures (18) Technologies of protecting components, etc. of calculators by tamper-resistant housings (19) Technologies relating to jamming of communications, etc.
Fields that can include the technologies that can serve as a means to cause significant damage to people's lives and economic activity in Japan	(20) Isotope separation technologies for uranium and plutonium (21) Technologies relating to dismantling, reprocessing, etc. of spent nuclear fuel (22) Technologies relating to heavy water (23) Technologies relating to nuclear explosion devices (24) Technologies relating to compositions for gas attacks (25) Technologies relating to ammunition, etc. that disperses gas, powder, etc.

Security review (secondary review)

In a secondary review, the Prime Minister (in practice, the relevant section of the Cabinet Office) conducts a security review for the patent application sent from the Commissioner of the Patent Office, in order to decide whether or not such application will be subjected to security designation (Article 70 of the ESPA).
The appropriateness of the security designation is reviewed by giving comprehensive consideration to the following factors: whether the specification, etc. of the patent application includes "an invention that … would be highly likely to create a situation that undermines the security of the nation and its citizens," how likely such situation is, and other circumstances such as "the level of the impact on industrial development if the security designation is implemented."
Although there is no legal upper limit on the period of the security review, given the fact that the prohibition of foreign applications is cancelled upon the elapse of ten months from the application for a patent, the security review must be completed in practice during that period.
If the security designation is deemed unnecessary, a notice is issued to notify the patent applicant of such decision, and the publication of the application is allowed, while the suspension of the decision (Article 66(7) of the ESPA) and the prohibition of foreign applications are cancelled (Article 78(1) of the ESPA). The procedure then returns to the normal patent application procedure.

Security designation

When a security designation is implemented, the Prime Minister (in practice, the relevant section of the Cabinet Office) notifies the patent applicant of the content of the security target invention, indicating which descriptions in the specification, etc. include such security target invention (Article 70(1) of the ESPA).
In terms of the effect of a security designation, the patent applicant who receives a notice of security designation will have to obey the following restrictions, until the security designation terminates: prohibition of withdrawal, etc. of the patent application (Article 72 of the ESPA); a permission system required for working the invention (Article 73 of the ESPA); a general prohibition on disclosure of the invention (Article 74 of the ESPA); an obligation to properly manage the invention information (Article 75 of the ESPA); a permission system for sharing an invention with other enterprises (Article 76 of the ESPA); and a prohibition of foreign applications (Article 78 of the ESPA).
Since the security designation comes with the restrictions listed above, a patent applicant who receives a notice of security designation can receive compensation for losses

from the government (Article 80 of the ESPA).
The period of the security designation is set as being one year or longer from the day of the security designation, and by the expiration of the period, the Prime Minister (in practice, the relevant section of the Cabinet Office) judges whether or not the security designation should continue, and extends the period if necessary (Article 70(2) and (3) of the ESPA).

Restrictions on filing of applications in foreign countries (first-filing requirement)

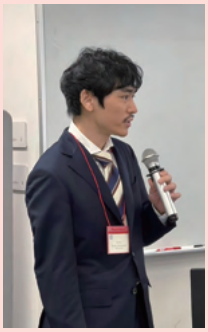
If the publication of a patent application is restricted in Japan but is still possible overseas, that would defeat the purpose of this system. Therefore, regarding inventions that are made in Japan and still unknown to the public, if there is an invention that belongs to a specified technology field and satisfies any additional requirements, the application for such invention must first be filed in Japan for a security review. Foreign applications are prohibited until a decision is made, after the application is filed for such patent in Japan, that a security designation will not be implemented, or until the elapse of ten months from the filing of the national application without the implementation of a security designation (Article 78(1) of the ESPA).
An "invention made in Japan" means that the place where the invention has been completed is in Japan, regardless of the address, etc. of the patent applicant. Thus, if research and development is conducted across several countries, the judgment is based on where the invention has been completed.
If the application for a patent is filed overseas in violation of the above prohibition, not only will this constitute a statutory crime (Article 94 and Article 92(1)(viii) of the ESPA), but the corresponding application in Japan might also be rejected (Article 78 (5) and Article 78(7) of the ESPA).
If the applicant wishes to file a foreign application that includes an invention which belongs to a specified technology field and satisfies any additional requirements, such applicant can ask the Commissioner of the Patent Office as to whether such foreign application is prohibited (Article 79(1) of the ESPA). After this advance confirmation, if the answer is that the invention in question is obviously not an invention that, if made known to the public, would affect the security of the nation and its citizens through actions taken from the outside, it is then possible to file a foreign application (main clause of Article 78(1) of the ESPA).

Conclusion

If an invention has been completed in Japan and belongs to a specified technology field, the patent application must first be filed in Japan for a security review. Therefore, it is necessary to take caution when conducting research and development in Japan or in collaboration with Japanese companies.

Topic1

Licensing Executives Society International (LESI) Young Member Committee (YMC) Asia Pacific Conference in Tokyo, Japan



Ryoki Nakamura (Patent Attorney; member of YMC Japan) organized the LESI YMC Asia Pacific Conference held in Tokyo on April 12, 2024, along with other organizing members. Ryoki emceed the conference and hosted the accompanying banquet. It was impressive that more than 50 young members attended in person and one-third of the participants joined the conference from outside Japan. The conference focused on the latest IP-related topics, including the impact of generative AI on our industry and IP protection in cross-border IP infringement cases. The participants were also able to enjoy receptions held at traditional Japanese restaurants the day before and immediately following the conference. The conference provided a great opportunity to have a lively exchange of ideas about IP practices in Japan, the U.S., Europe, and Asia, as well as offering a tremendous chance for international networking.

2. Recent IP High Court Decision regarding the Patent Linkage System in Japan

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Introduction

This article introduces a recent decision from the IP Hight Court (2022 (NE) No. 10093) (the "**High Court's Decision**") that was issued on May 10, 2023 in a generic versus originator dispute. The generic company (the "**GE Maker**"), as the plaintiff in the first instance and the appellant in the Hight Court Decision, sought a declaratory judgment for the court to confirm, mainly, the non-existence of the patentee's rights to demand an injunction and damages against possible infringement by their generic drug (the "**GE Drug**"), which was still under the marketing authorization ("**MA**") application process. The originator company and the relevant patent right holder were co-defendants and co-appellees (collectively, the "**Originator**"). In short, the court denied the GE Maker's claims.

This case is noteworthy because it is the first substantial court decision on the patent linkage system in a dispute between generic and originator companies. To understand the context of this dispute and the reasoning of this decision, it is essential to understand the patent linkage system in Japan. Therefore, before delving into the details of the Hight Court Decision, I will provide an overview of the patent linkage system.

Patent Linkage System in Japan

In Japan, the patent system and the drug approval system are not linked through legislation. The Act on Securing Quality, Efficacy and Safety of Products Including Pharmaceuticals and Medical Devices stipulates the cases where an MA should not be approved, such as lacking the necessary business licenses, efficacy or safety of the drug, or incompliance with GMP. However, it does not address the approval of generic drugs when relevant patents exist for the originator drug. Instead, the patent system and MA for generic drugs are linked by practices under the relevant ministry notice (the "**Notice**") issued by the Ministry of Health, Labor, and Welfare (the "**MHLW**"). Specifically, the Notice provides the following regarding MA process of generic drugs:

(i) if a patent exists at the expected approval date for the active pharmaceutical ingredient (the "**API**") of the originator drug it will therefore not be possible to manufacture the API, and the generic drug will not be approved; and

(ii) if a patent exists for some of the indications, dosage and administration of the originator drug, such patented indications, etc. will not be approved for the generic, while the generic may be approved for the other effects and/or dosage regimens if manufacture of such drug is possible.

In the application process for MA, a generic maker is required to submit if there is any patent regarding API, and if there is, a document proving that the generic drug can be promptly marketed after obtaining MA (such as a consent from the patentee, etc.).

In addition to and after obtaining MA, drugs further need to be filed for and listed on the National Health Insurance Drug Price List (the "**Price List**") so that they are practically marketable in Japan, where a nationwide universal health insurance system is adopted. Regarding the process to be listed on the Price List, the Notice provides that:

(iii) when there is concern about the patent issue, the parties involved (i.e., the generic and originator companies) shall hold a "Prior Consultation" to coordinate the issue and, for the generic maker, apply for listing only when it believes that the item can be stably supplied.

Even if the parties failed to reach an agreement in the Prior Consultation, it is still possible that an MA could be approved for a generic, e.g., if the generic maker submitted a document guaranteeing a stable supply at its responsibility.

Here, unlike the Orange Book in the U.S., there is no specific system in Japan for publishing patents covering new drugs. Patent information relevant to an originator drug can be submitted to the MHLW, typically with the timing of an application for MA, though not mandatory. The MHLW then makes the above-mentioned decision on whether to approve a generic drug, based on only the information as submitted, without making a substantial decision on patent infringement. These practices by the MHLW under the Notice do not aim at protecting patents or balancing between originators and generics, but rather intend to achieve its administrative purpose of protecting a stable supply of pharmaceuticals.

In typical cases, the originator company would bring an action against a generic after learning that the MA was approved for the generic and around the time when it

is listed for pricing.

Factual Backgrounds and Claims Sought by the GE Maker in the Suit

When preparing the MA application, the GE Maker sent a letter to the Originator, asking to confirm that the marketing of the GE Drug does not infringe with the Originator's patents and that the Originator will not exercise the patent rights thereon. The Originator responded, indicating that there is a possibility that it might exercise such rights. Consequently, the GE Maker failed to prepare "the document proving that the generic drug can be promptly marketed after obtaining MA" as is necessary for obtaining the MA.

The GE Maker then filed this suit, seeking a declaratory judgement confirming:

A) the non-existence of the Originator's rights to seek an injunction and damages against the GE Drug based on patent infringement claims (the main claim in the suit);

B) the non-existence of the same rights when the GE drug is listed on the Price List (auxiliary claim 1); and/or

C) that the GE Drug does not fall under the technical scope of the patents at issue (auxiliary claim 2).

The High Court's Decision

The issues argued were whether there is an interest in seeking confirmation through a lawsuit for each of the claims. Established court precedent admits an interest in seeking confirmation only when a danger or uncertainty is currently present in the plaintiff's legal position and when it is necessary and appropriate to obtain a declaratory judgment to confirm the existence/non-existence of relevant legal rights or relationships between the plaintiff and the defendant to eliminate such danger or uncertainty. In the High Court's Decision, the court, like the court of the first instance, denied the interest in seeking confirmation for all claims, based on the reasonings as summarized or quoted below:

Regarding the Main Claim:

A) The probability of obtaining an MA and listing on the Price List for the GE Drug is low, and it is not likely that the GE Maker manufactures and sells the GE Drug on the market in the near future. The GE Maker currently manufactures and uses the GE Drug only for the purpose of obtaining MA and GMP compliance inspection therefor. The Originator is not asserting any infringement claims against the current manufacture/use of the GE Drug, nor is it demonstrating the intention of asserting claims against such manufacture/use in the future. In these circumstances the court sees no existing danger or uncertainty in the GE Maker's legal rights/position.

B) "… note that, even failing to obtain MA … under the practice of the Notice is problematic for the GE Maker, that is a matter of public law disputes between the GE Maker and the Minister of Health, Labor, and Welfare (the "***Minister***") (the government) about whether to approve an MA … by the Minister, therefore it cannot be considered a private legal dispute between the GE Maker and the Originator. Such public law dispute matters shall be remedied through legal measures such as filing of an action to confirm the illegality of inaction against an application for MA, an appeal against the Minister's action, and the like. Therefore, it cannot be concluded that it is necessary and appropriate to obtain a declaratory judgment in this suit between GE Maker and the Originator to eliminate any risk or uncertainty regarding the GE Maker's legal rights or status."

Regarding the Auxiliary Claim 1:

A) The legal relationship asserted here is that of a future (i.e., that arises when and if the GE drug is listed on the Price List in the future). As is established in court precedent, the court did not admit a danger or uncertainty existing in the GE Maker's legal rights/position to be eliminated.

B) The probability of obtaining MA and listing on the Price List is low for the GE Drug, thus it is uncertain whether a legal dispute will arise in the near future between the parties over the non-existence of the right to seek injunction/damages based on the patent rights at issue. Thus, no risk or uncertainty is recognized in the GE Maker's legal rights or status.

C) "… note that GE Maker argues that the current situation of practice where the MHLW is mechanically operating the process regarding whether a product belongs to the patented technical scope, which should be determined by the court, goes against the 'rule of law' and violates the constitutional rights of generic drug companies, such as the right to a judicial decision and freedom of business. However, in the present suit, what the GE Maker is seeking confirmation of is the legal relationship between the GE Maker and the Originator. Therefore, even if there are problems with the approval review practices as pointed out by GE Maker above, it does not give a reason for the interest in seeking confirmation to be recognized."

Regarding the Auxiliary Claim 2:

A) Whether the GE Drug falls within the technical scope of the patents is merely a matter of fact-determination, not purposed for the confirmation of legal rights or

relationship between the parties.
B) Even if an MA is not approved under the Notice, because it is a matter of public law the disputes should be remedied through the types of legal procedures as stated above, thus the interest in seeking confirmation cannot be recognized for this suit between the GE Maker and the Originator.

Conclusion

Under this High Court's Decision an option is denied for generic companies to bring a suit to seek a declaratory judgment at the MA application stage. As the first substantial ruling on the patent linkage system, this case has garnered considerable attention and debate. It is worth closely monitoring how this decision might influence administrative, legislative, and industry movements.

Topic2

AI as an Inventor: Tokyo District Court Decision on the DABUS Application

We have released a new episode on our Podcast channel "TMI Podcast - Intellectual Property in Japan" which is available on Apple Podcasts, and Spotify. In the last few years, courts in several countries have been handing down decisions on whether AI can be listed as an inventor in cases concerning a PCT patent application with AI called "DABUS" listed as an inventor. For the Japanese national phase application thereof, the Japan Patent Office dismissed the application because listing AI as an inventor is not permissible. In May 2024, the Tokyo District Court issued the first decision on the DABUS application in Japan, where the legality of the JPO's dismissal was challenged. In this episode, we explain the key points of this decision by the Tokyo District Court.

3.Changes in Media, Changes in Evidence – Recent IP High Court Decision Recognized the Well-known Status of a "Viral" Unregistered Trademark–

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Introduction

Proving the well-known status of a mark is quite a challenge in Japan and usually requires a trademark owner to produce a substantial amount of evidence proving extensive use of the mark, typically consisting of advertisements, brochures and magazine articles bearing the trademark. However, in a recent IP High Court ("IPHC") decision, the IPHC acknowledged the well-known status of an unregistered "nickname" of a certain candy product that was not even used on the product's packaging based only on a limited amount of evidence and overturned the Trial and Appeal Department of the Japan Patent Office ("JPO") decision maintaining the registration for a mark identical to such nickname registered by a third party.

"Chikyu Gumi" IP High Court decision

On December 26, 2023, the IPHC issued a decision in an invalidation action against the trademark "Chikyu Gumi" ("earth gummy" in Japanese) registered in connection with "gummy candy" in Class 30 on the basis that such mark was identical to an unregistered well-known trademark for gummy candy in Japan. In the decision, the IPHC recognized that "Chikyu Gumi" was a well-known trademark for gummy candy despite the fact that such mark does not even appear on the product packaging. (2023 (Gyo-ke) 10079)

The plaintiff's product "Planet Gummi."
Yutaka Trading Company Limited.
http://www.yutaka-trd.co.jp/processedfood/trolli

These products went viral among younger-generation consumers who are frequent users of social media because of the earth shape of the products, through such consumers calling them "Chikyu Gumi," a term which a retailer named when it advertised such products. As such, the evidence submitted by the plaintiff did not include any marketing materials such as advertisements, brochures, etc. prepared and distributed by the plaintiff as would usually be submitted when trying to prove the well-known status of a mark, except for only a few Instagram posts with the hashtag "#Chikyu Gumi," etc. Rather, it was mostly posts on social media platforms (Twitter/X and Instagram, etc.), posted by third parties, as well as a few newspaper/magazine articles, online news articles, and television coverage introducing the craze for the candy. There were only around 40 pieces of evidence submitted, which is very limited compared to other cases, and the plaintiff did not even present details on sales figures or market share, which are viewed as some of the most important evidence in showing the penetration of products (and marks) in the market when proving the well-known status thereof. The IPHC nevertheless ruled that the "Chikyu Gumi" mark was well-known in Japan, finding as follows:

"The plaintiff's products are confectionery manufactured by a foreign company and are called "Trolli Planet Gumi" or "Planet Gumi", and neither the plaintiff's products, their packaging nor their individual packaging contain the Japanese characters "Chikyu Gumi". However, the plaintiff's products became very popular in Korea around 2018, mainly among video posters and their viewers, and this trend spread to Japan, and they achieved high popularity in Japan around 2020, mainly among video posters and their viewers, and by October of the same year, when the plaintiff began importing and selling the products, a retailer with stores nationwide began to advertise the products as "Chikyu Gumi." They were sold out immediately after being released for sale at retailers' stores, making them extremely difficult to purchase. Since the time the plaintiff began importing and selling the products, retailers with stores nationwide have repeatedly advertised the products as "Chikyu Gumi," and the products have also become extremely popular on video sharing sites, where they were again called "Chikyu Gumi." In June 2021, the plaintiff's products were reported in national newspapers and on television by a major station in Osaka as very popular products called "Chikyu Gumi," and in the television coverage, the products were highly ranked among the rankings of foods and beverages that were popular with Generation Z in the first half of the same year. The plaintiff's products were also reported on television by a major station in Tokyo in July 2021 as popular products and were introduced as something that all young people in their early twenties knew about (Note that the plaintiff started calling them "Chikyu Gumi" on television programs at the latest in June 2021 and began advertising them as "Chikyu Gumi" at the latest in September 2021). Furthermore, in November 2021, the plaintiff's products were introduced alongside novels and songs as examples of works or products that became popular after being posted on video sharing sites, and also won second place in the "Café/Gourmet" category of the "SHIBUYA109lab. Trend Target 2021" awards, which were the results of a survey (targeting 545 females aged 15 to 24) conducted by the management company of a well-known department store in Shibuya. Based on the trends of the product up to 2021, the "Basic Knowledge of Modern Terms 2022," published in January 2022 featured the term "Chikyu Gumi," which is the nickname for the products, as a product that attracted attention in 2021.

Given the above circumstances, it is reasonable to find that the words "Chikyu Gumi" formed a trademark that was widely recognized among consumers (who are deemed to be consumers of gummy candy, particularly young people, in light of the content and nature of the products for which the plaintiff's mark is used and the facts stated in the above) as indicating the products related to the business of the plaintiff or the manufacturer of the plaintiff's products by the date on which the Decision of Registration of the owner's trademark was issued, February 22, 2022, at the latest."

Conclusion

It is generally a high hurdle to establish well-known status of a trademark in Japan as the owner of the mark must prove its continuous use of the mark (usually for at least around 10 years) by submitting a substantial amount of marketing materials, including advertisements; namely, the amount of evidence presented is regarded as the most important decisive factor in determining the well-known status of a mark in Japan. In this case, however, "Chikyu Gumi" was recognized as a well-known trademark with very limited evidence, most of which was not even evidence of use by the owner itself but by third parties on social media within just a few years. This IPHC decision

demonstrates the significant influence of a new type of evidence, social media, as well as the impact of "going viral" on social media. What makes this case worthy of reference is the fact that: (i) the mark was not the name of the products but just a nickname given by a third party and was therefore not used on the product; (ii) the evidence mostly showed use of the mark by third parties, not by the owner itself; and (iii) the mark was mainly used verbally on TV or as a hashtag. Just like in broader society, traditional media is being replaced by new media in the field of law, and with the all-encompassing spread of social media, the speed at which things become common knowledge has dramatically increased. With the advent of social media, the evidence of use by third parties could become sufficiently adequate and the hurdle for trademark owners to prove the well-known status of a mark in Japan may be lowered.

Topic3

AI Patent Panel in Munich, Germany

Yukio Oishi (Partner, Patent Attorney) participated as a panelist at an AI Patent Panel held at the Hoffmann Eitle Munich Office on March 7, 2024. The panel discussed various AI-related patent issues, including patent eligibility, inventiveness, written descriptions, and inventorship, comparing the practices seen in five major jurisdictions: EP, US, CN, KR, and JP.

4.Remedial Conditions Eased from "Legitimate Reasons" to "Unintentional" under the Design Act

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Introduction

As of April 1, 2023, the requirements for the restoration of the design rights were relaxed by the revised Design Act (the "Revised Act").
More specifically, under the Revised Act, the requirements for the remedial provisions for (1) restoration of Paris Convention Priority and (2) delays in the payment of design annuities were eased.
In addition, in this article, we will also introduce the remedial provisions introduced under the Revised Act as well as another important relaxation of the requirement with respect to the requests for extension of time after expiry of the response period which was introduced as of April 1, 2021.

Restoration of Paris Convention Priority

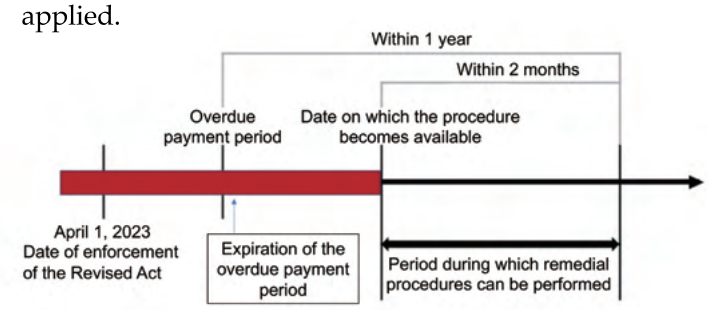
If the applicant "unintentionally" missed the Paris Convention priority deadline, the applicant may still file an application with the priority **within two months after expiration of the priority period.**

The following procedures are required to restore the Paris Convention priority:

1) Reasons for recovery and documentary evidence are submitted within two months after expiration of the priority period, and
2) A restoration fee of 24,500 JPY is paid when filing a

Reasons for recovery and documentary evidence for restoration.
In Reasons for recovery, it is sufficient to simply explain why it was not possible to file the application claiming Paris Convention priority within the prescribed period and to state that the failure was “unintentional”. This reason can be as simple as "carelessness."

In the meantime, the restoration fee may be waived in case the deadline was missed due to reasons beyond the control of the person responsible for the procedure and such facts can be confirmed by a document proving the uncontrollable reason. However, providing such proof tends to be generally quite difficult.
Further, if the applicant initially decided to proceed with the filing an application without claiming Paris Convention priority within the priority period and the priority period was missed, and later decided to undertake the remedial procedure due to a change in circumstances after the period has expired, the decision not to proceed initially may be deemed "intentional", and therefore, the remedial provision may not be applied.



Source: https://www.jpo.go.jp/system/laws/rule/guideline/kyusai_method2.html

Payment of Design Annuities

If the failure to pay the design annuities with surcharges within the overdue payment period is "unintentional," the applicant may make payments within two months from the date on which the procedure becomes available. Additionally, payments can be made within one year from the expiration of the overdue payment period, with a statement of reasons for restoration of payments to state why the procedure could not be followed. A restoration fee of 24,500 JPY must be paid when filing a statement of reasons for restoration. It is sufficient in the statement of reasons to simply explain why it was not possible to pay the design annuities within the prescribed period and to state that the failure was unintentional, as with the Restoration of Paris Convention Priority.

Retroactive Requests for Extension of Time after Expiry of the Response Period

Even after the deadline for filing a response to a notice of reasons for refusal has expired, it may be possible to extend the deadline retroactively by filing a request within two months from the original deadline for filing a response. The possible extension period is two months, and up to two requests will be allowed per response. The reason for the request will not be questioned. The official fee for requesting a retroactive extension of time to file a response is 7,200 yen. This procedure does not apply to cases after an appeal stage.

Procedure	Restoration of Paris Convention Priority	Payment of Design Annuities	Retroactive Requests for Extension of Time after Expiry of the Response Period
Deadline	Within 2 months after expiration of the priority period	Within 2 months from the date it became possible to pay and within 1 year from the expiration of the overdue payment period	Within 2 months from the original deadline for filing a response
Subjective Requirements	“Unintentional” failure to file within the priority period	“Unintentional” failure to pay within the overdue payment period	–
Official Fee	24,500 JPY * If the expired deadline was due to reasons beyond the control of the person responsible for the procedure, the fee may be waived.		7,200 JPY

Conclusion

In Japan, remedial provisions for missed deadlines have historically required the existence of a 'justifiable reasons,' limited strictly to force majeure events such as natural disasters or system errors. However, recent amendments have expanded the scope of relief to encompass situations where the deadline was missed unintentionally, removing the requirement for 'justifiable reasons' and broadening the eligibility for deadline extensions. Especially, given that the priority period is as short as six months, allowing priority claims to be recognized within two months even if the deadline is missed should be welcomed by users. Therefore, if you find yourself in such a situation, it is recommended to consider whether these remedial provisions can be applied to your case.

Topic4

Patents in the Generative AI Era in Paris, France

Dr. Toshiko Takenaka (Professor at University of Washington School of Law, Special Foreign Counsel at TMI Associates), Mr. Yoshiyuki Inaba (Senior Partner, Patent Attorney) and Mr. Atsushi Sato (Partner, Patent Attorney) spoke at the seminar organized by IÉSEG School of Management, Paris, France, about the differences in patent policies of AI related inventions among EP, JP and US.

Topic5

Ranked in IAM Patent 1000 2024

In the IAM Patent 1000 2024 rankings, TMI has been recognized with Gold rankings for the Japan: Domestic categories in patent litigation and patent prosecution. In addition, four of our lawyers and five of our patent attorneys received high individual ratings.

TMI Associates - Patent 1000 - IAM (iam-media.com)

Rated in IP STARS 2024

Also in "IP STARS 2024" published by Managing Intellectual Property (MIP), TMI has been rated as Tier 1 in patent disputes, patent prosecution and trademark, highly recommended in copyright, and recommended in IP transactions.

TMI Associates - Japan - Firm Profile | IP STARS

Topic6

Two Local Offices Opened in Indonesia and Malaysia

TMI opened a new office in Jakarta through a partnership with Frans & Setiawan Law Office, an Indonesian law firm, in December 2023 and also opened another office in Kuala Lumpur in affiliation with SY Teo & Co., a Malaysian law firm, in April 2024.

Jakarta office:
https://www.tmi.gr.jp/about/bases/indonesia-desk.html

Kuala Lumpur office:
https://www.tmi.gr.jp/about/bases/malaysia-desk.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 our firm from the beginning, and we boast an unrivaled level of experience and achievement in this area.

Organizational Structure

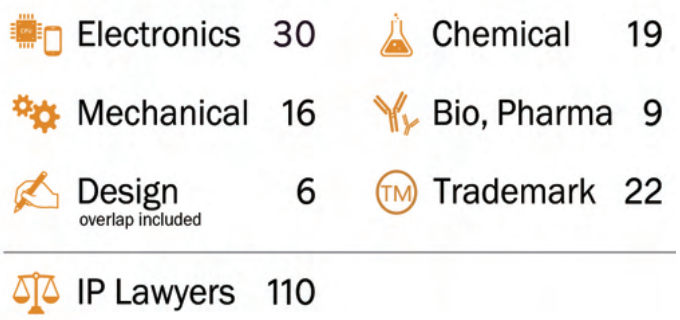
TMI has a total of more than 1,200 employees worldwide, including over 700 IP/Legal professionals, comprised of 569 attorneys (Bengoshi), 96 patent/trademark attorneys (Benrishi), and 55 foreign law professionals.

Attorneys (Bengoshi)	569
Patent / Trademark Attorneys (Benrishi)	96
Foreign Law Counsels	8
Foreign Attorneys	47
Advisors	14
Management Officers	2
Patent Engineers, Staff	485
Total	1,221

(As of July 1, 2024)

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 Customs. TMI handles over 9,000 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

TMI, its attorneys, and its patent and trademark attorneys have been the proud recipients of prestigious awards every year. This year, TMI received again various awards:
Chambers Global and **Chambers Asia-Pacific** - Top Ranked; **MIP IP STARS** – Tier 1 / Patent disputes, Patent prosecution and Trademark; **IAM Patent 1000** - Gold / Patent Litigation, Prosecution and Transactions; **WTR 1000** - Gold / enforcement and litigation, prosecution and strategy; **Asia IP** – IP EXPERTS; **The Legal 500 Asia Pacific** - Tier 1 / Intellectual Property

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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Offices - Tokyo, Nagoya, Kobe, Osaka, Kyoto, Fukuoka, Shanghai, Beijing, Yangon, Singapore, Ho Chi Minh City, Hanoi, Phnom Penh, Silicon Valley, London, Bangkok, Paris, Kuala Lumpur (affiliated with SY Teo & Co.), Jakarta (partnering with Frans & Setiawan Law Office)