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TMI Associates

Stay up to date with the latest developments in Japanese intellectual property through blog posts from TMI Associates' IP Practice Team. Here is a roundup of their recent articles – perfect for catching up quickly through their website, PDFs, and other resources.

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Effectiveness of Design Rights in Japanese Customs Enforcement

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Koji Akanegakubo

In recent years, Japan's border enforcement system has evolved into an increasingly powerful tool for combating counterfeit products through the strategic use of design rights. This article outlines the key features and practical advantages of this system.

Strong Authority of Customs to Determine Infringement

One of the most distinctive features of the Japanese system is that customs authorities have the authority to determine whether a design right has been infringed.

Under the Customs Act of Japan, customs may initiate a determination procedure and, upon finding infringement, seize or destroy the goods. This integrated system—under which customs authorities handle both the suspension of goods and the infringement determination—is relatively unique by international standards.

In contrast, jurisdictions such as the United States, the EU, and China often require judicial involvement or decisions by specialized tribunals to determine infringement.

Namely, in the United States and China, customs authorities primarily determine infringement for trademarks and copyrights, while patents and designs generally require decisions by courts or specialized bodies (e.g., the ITC). Japan is distinctive in that customs authorities handle the entire process, from application to final determination. (See the table below for an international comparison.)

Consequently, the Japanese system enables faster and more effective enforcement.

Comparison of Border Enforcement Systems (International Overview)

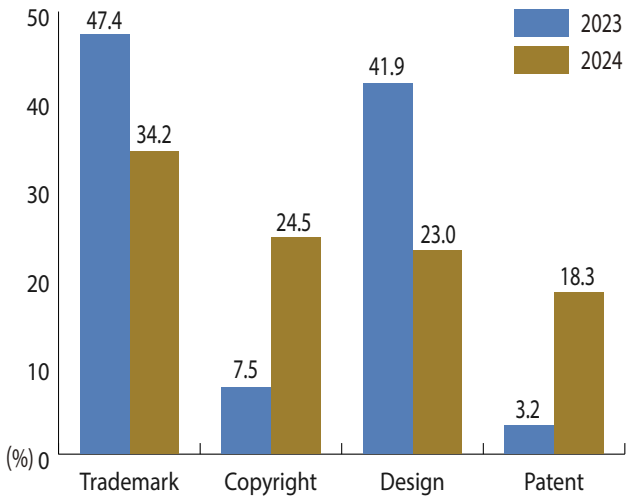
Action	TRIPS	EU	United States	China	Japan
Acceptance of Application	Administrative or judicial authority (Art. 51)	Customs	ITC / Customs	Customs	Customs
Suspension of Release of Goods	Customs authority (Art. 51)	Customs	Customs	Customs	Customs
Determination on the Merits (Infringement Decision)	Judicial or administrative authority (Art. 49)	Court	ITC / Court (Customs for trademarks/copyrights)	Court / Customs	Customs

Increasing Practical Use of Design Rights

Statistical trends indicate that design rights are becoming a key tool in customs enforcement. Recent data shows that design right-based seizures account for approximately 23% to over 40% of all seized items, depending on the year (e.g., about 41.9% in 2023 and 23.0% in 2024).

This significant share of design right-based seizures indicates that design rights have become an increasingly important enforcement pillar alongside trademarks.

Composition of Import Seizures by IP Type (Item Basis)



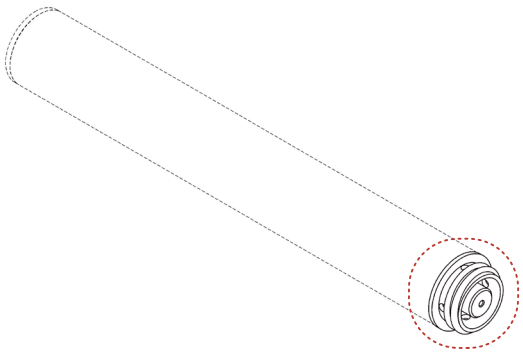
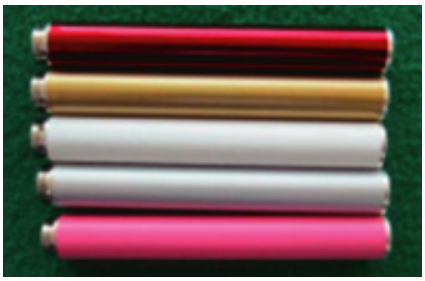
Broad Enforcement via Partial Designs

Another important feature of the Japanese system is that customs authorities recognize and enforce design rights covering only a **part of a product** ("partial designs").

In practice, Japanese customs may suspend the importation of an entire product even where the asserted design right protects only a specific portion of that product, provided that the protected portion is found to be infringed. This reflects a practical and enforcement-oriented approach at the border, allowing right holders to take effective action not only based on the overall product configuration, but also on key design elements.

As a result, partial designs can serve as a powerful tool in customs enforcement, particularly for protecting functionally important or interchangeable components, even when the overall appearance of the product differs.

To illustrate this point, the figure below shows an actual enforcement case in which a design right covering only a very small portion of a product (approximately 5% of the overall configuration) was successfully used to block the importation of the entire product.

Partial Design (Japanese Design Registration No.1554861, "E-cigarette battery")	Examples of Infringing Products Seized by Customs
 The portion highlighted by the red circle represents the claimed part, accounting for only about 5% of the overall product.	 

Conversion from Patent to Design Applications

Japan allows conversion from a patent application to a design application.

Although not widely known among foreign practitioners, Japan provides a system that permits applicants to convert a pending patent application into a design application.

One of the key advantages of this system is that it can be used to "rescue" subject matter that does not meet the requirements for patentability, such as inventive step, but still has commercially valuable design features.

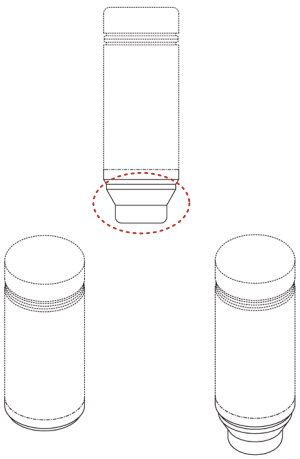
In addition, an important strategic aspect arises from differences in prosecution timelines. Design applications in Japan are typically registered relatively quickly (often within about six to eight months), meaning that competitors may review the published design and attempt to develop products that avoid infringement.

In contrast, patent applications can remain pending before the Japan Patent Office (JPO) for several years. By leveraging this feature, applicants can maintain a patent application on file and, if imitation products emerge at a later stage, convert the patent application into a new design application. This enables the applicant to obtain a design registration tailored to cover imitation products that were deliberately designed to avoid earlier registered designs.

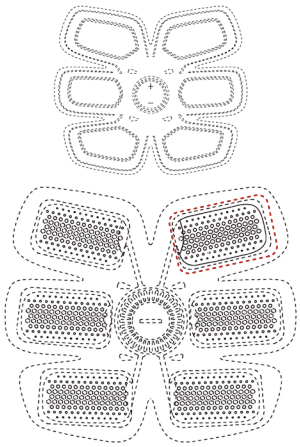
In this sense, the conversion system is a highly effective tool for addressing sophisticated design-arounds.

There are actual cases where design rights obtained through such conversion from patent applications were successfully used to eliminate imitation products. Two examples are shown below.

[Case 1]

Partial Design Converted from a Japanese Patent Application (Japanese Design Registration No. 1610493, "Pen Case")	Examples of Infringing Products Seized by Customs
 A pen case whose lower portion extends to increase its storage capacity. Only the portion highlighted by the red circle constitutes the claimed part of the design.	

[Case 2]

Partial Design Converted from a Japanese Patent Application (Japanese Design Registration No. 1579366, "Exercise apparatus")	Examples of Infringing Products Seized by Customs
 Only the portion highlighted by the red circle constitutes the claimed part of the design.	

Conclusion

Japan's customs enforcement system offers:

- Strong authority of customs to determine infringement
- Increasing practical use of design rights
- Broad protection through partial designs
- Flexible strategies via application conversion

These features make design rights a highly effective tool for border enforcement in Japan.
For companies entering the Japanese market, leveraging design rights for customs enforcement should be considered an important part of their anti-counterfeiting strategy.

Author

Koji Akanegakubo
Patent Attorney

The Japanese Supreme Court's Judgment in the TRIPP TRAPP Case

/ Published in May. 2026

Seiro Hatano, Takahiro Inoue, Satoshi Arakawa and Suzuno Yamashita

The Supreme Court of Japan issued the long-awaited judgment on the copyrightability of applied art in the Stokke v Noz case on April 24, 2026. Although the Court denied copyrightability for the product at issue, the decision sets out, for the first time, a general requirement for the copyrightability of applied art. (Note 1)

Overview of the Case

Stokke AS ("Stokke"), a Norwegian company that manufactures and distributes the well-known chair "TRIPP TRAPP", designed by Mr. Peter Opsvik, was the plaintiff and the defendant was Noz Co., Ltd., a Japanese furniture manufacturer. Stokke brought claims for copyright infringement and unfair competition in relation to the defendant's products, but both the Tokyo District Court, as the court of first instance, and the Intellectual Property High Court, as the appellate court, dismissed Stokke's claims. Accordingly, Stokke filed a petition for acceptance of final appeal with the Supreme Court.

The legal issue before the Supreme Court focused on the copyrightability of the TRIPP TRAPP (Note 2). In practice, it is extremely rare for the Supreme Court to accept cases for review in Japan, with the acceptance rate being less than 1%. Nevertheless, the Supreme Court decided to accept the appeal. Given that the lower-court precedents regarding the requirement for the copyrightability of applied art had been unclear and inconsistent, it was expected that the Supreme Court would clarify the requirement (Note 3). The decision has now been finally rendered.

"TRIPP TRAPP"

Summary of the Judgment

In conclusion, the Supreme Court denied copyrightability for the TRIPP TRAPP and dismissed the appeal. In its reasoning for the dismissal, the Supreme Court set out and clarified a general requirement for the copyrightability of applied art. It should first be noted that the Supreme Court did not use the term "applied art", but instead defined mass-produced products to be used for daily life as "Mass-produced Utilitarian Products".

The Supreme Court first clarified that, even where Mass-produced Utilitarian Products constitute "creatively produced expressions of thoughts or sentiments", which is the definition of copyrighted work under the Copyright Act, Mass-produced Utilitarian Products should not always be considered copyrighted works. The Supreme Court reasoned that the designs of such products may be protected as registered designs under the Design Act, and that granting additional protection under the Copyright Act would undermine the purpose of the Design Act.

On the other hand, the decision did not entirely exclude the possibility of copyright protection for such Mass-produced Utilitarian Products. The Court held that Mass-produced Utilitarian Products may be protected as copyrighted works where "**the configuration of the whole or a part of the Mass-produced Utilitarian Products can be conceptually perceived, independently from the elements derived from function, as a creatively produced expression of thoughts or sentiments**". Applying this requirement, the Court held that the TRIPP TRAPP was not copyrightable on the basis that its configuration could not be perceived as a creatively produced expression independently from its function as a children's chair.

One of the Supreme Court Justices added a supplementary opinion to the judgment, clarifying the background to, and scope of, the decision (the "Supplementary Opinion"). In the Supplementary Opinion, the Justice clarified that Mass-produced Utilitarian Products may be protected under the Copyright Act, but that the scope of such protection should be considered by taking into account the subject matter, purpose, requirements and procedures, as well as the scope and duration of the rights under the Copyright Act and the Design Act. Furthermore, the Justice stated, although international harmonization may be taken into account in the field of intellectual property law, there are significant differences between Japanese law, on the one hand, and US and EU laws, on the other. Accordingly, the scope of protection for applied art in Japan need not be aligned with the protection available under US or EU laws.

More importantly, the Supplementary Opinion makes clear that the decision deliberately did not use the term "aesthetic appreciation", which had been used in the judgment of the Intellectual Property High Court in this case, because that term may give rise to a misunderstanding that a high degree of creativity or artistic quality is required. It further clarifies that

the Supreme Court also considered it inappropriate for a court to determine whether a work is an object of aesthetic appreciation. The Supplementary Opinion concludes by expressing the expectation that, although the requirement provided by the Supreme Court in this case may not yet be sufficiently clear, the scope of copyrightability of the Mass-produced Utilitarian Products under the requirement will be clarified through the accumulation of future cases.

Comments

Although the decision did not use the term "applied art", but instead used the term "Mass-produced Utilitarian Products", the decision substantially sets out the requirement for the copyrightability of applied art. This decision is highly significant, given that the requirement for the copyrightability of applied art had been unclear and inconsistent in lower-court precedents, and that this is, in substance, the first Supreme Court decision in Japan to address that requirement.

The Supreme Court recognized the possibility of copyright protection for applied art where "the configuration of the whole or a part of the Mass-produced Utilitarian Products can be conceptually perceived, independently from the elements derived from function, as a creatively produced expression of thoughts or sentiments". It should be noted that this requirement indicates that (i) even the configuration of a part of a product could be protected by copyright; (ii) configuration derived from function is not protected; and (iii) copyright protection will be granted only to design elements that are conceptually independent from design derived from function. Furthermore, it is quite significant that the Supplementary Opinion clarifies that a high degree of creativity or artistic quality is not required for the copyrightability of applied art.

In light of the requirement and given that the decision denied copyrightability for the TRIPP TRAPP, minimalist designs that are closely associated with the function of the relevant products may be difficult to protect by copyright. On the other hand, where a product incorporates decorative elements whose designs do not serve any functional purpose, or where the configuration of the product is wholly unrelated to its function, those designs may be protected as copyrighted works even without a high degree of creativity or artistic quality.

The scope of copyright protection for applied art has long been unclear and inconsistent in Japan, and this decision finally provides a definitive requirement for the copyrightability of applied art, although the scope of protection remains to be fully clarified. In particular, the meaning of "can be conceptually perceived as a creatively produced expression of thoughts or sentiments" and "independently from the elements derived from function" is not entirely clear, and the scope of the protection under the requirement is expected to be clarified in future cases.

Finally, it should be borne in mind that even where copyright protection is not available, this does not mean that product designs are unprotected. They may be protected under the Design Act once registered. In addition, if the configuration of a product becomes famous and thereby acquires distinctiveness, it may be registered as a three-dimensional trademark under the Trademark Act (Note 4), and may also be protected under the Unfair Competition Prevention Act.

(Note 1)
https://www.courts.go.jp/assets/hanrei/hanrei-pdf-95904.pdf

(Note 2)
As background, in 2010, the Tokyo District Court denied copyright protection for the TRIPP TRAPP. However, in 2015, in a different case, the Intellectual Property High Court held that the TRIPP TRAPP is copyrightable. Then, in September 2024, in the present case, the Intellectual Property High Court reached the opposite conclusion and held that the TRIPP TRAPP is not copyrightable.

(Note 3)
See our previous article "Copyright Protection for Applied Arts in Japan":

(Note 4)
For example, the configuration of the TRIPP TRAPP has already been registered as a three-dimensional trademark.

Author

Seiro Hatano
Attorney-at-law

Author

Takahiro Inoue
Attorney-at-law

Author

Satoshi Arakawa
Attorney-at-law

Author

Suzuno Yamashita
Attorney-at-law

Tokyo District Court IP Division's 2026 SEP Guidelines

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Akihiro Tomomura

In January 2026, the Intellectual Property Divisions of the Tokyo District Court published the "Guidelines for Proceedings in Patent Infringement Actions Based on Standard Essential Patents." (the "Guidelines")

The Guidelines indicate that the Court aims not only to address Japanese patents included in standard essential patents ("SEPs"), but also to facilitate the formation of agreements on royalties under FRAND terms for the SEP holder's entire global SEP portfolio (the "Global FRAND Royalty"), thereby seeking to resolve SEP-related disputes on a global basis.

From this perspective, the Guidelines provide that, as a general rule, the Court will recommend settlement at the first hearing and promote settlement by scheduling settlement discussions in a planned and concentrated manner. In the course of settlement proceedings, the Court will respect the course and substance of the parties' negotiations while adjusting their settlement proposals.
It is also contemplated that, after sufficiently hearing both parties, the Court may present a concrete settlement proposal regarding the Global FRAND Royalty.

The Guidelines further require that the plaintiff propose a Global FRAND Royalty in the complaint, setting out the basis for its calculation in a concrete and detailed manner.

On the other hand, the defendant is required, in its answer, to provide specific admissions, denials, and rebuttals to the plaintiff's proposal, and to submit its own counterproposal for the Global FRAND Royalty with a clear explanation of its calculation basis. In particular, the defendant is expected to submit evidence regarding the number of units sold and sales amounts of the accused products. The Guidelines expressly state that failure to do so may result in adverse inferences. Specifically, a defendant failing to engage constructively may be deemed an "unwilling licensee," potentially exposing them to the risk of an injunction.

Finally, the Guidelines provide that, if settlement cannot be reached, the parties must promptly submit briefs and evidence consolidating their arguments and proof concerning the defense of abuse of rights (i.e., whether the implementer is willing to obtain a license on FRAND terms). Where issues of infringement or invalidity remain, the Court will conduct proceedings involving two rounds of briefing (plaintiff's submissions, defendant's responses, plaintiff's reply, and defendant's rejoinder).

In this regard, how these Guidelines will be implemented in practice remains to be seen, and it will be important to closely monitor their application through the accumulation of future cases. The English translation of the Guidelines is as follows.

[Translation]
Guidelines for Proceedings in Patent Infringement Actions Based on Standard Essential Patents

January 2026
Intellectual Property Divisions, Tokyo District Court (Civil Divisions No. 29, No. 40, No. 46, and No. 47)

Please take note of the following points when conducting proceedings in patent infringement actions based on standard essential patents (hereinafter, "SEPs"; and such actions, "SEP Actions").

1. Policy for Proceedings

In light of the global adoption of standardized technologies, which necessarily entails cross-border exploitation of SEPs, one of the important roles for the Court in resolving SEP Actions is to facilitate the formation of a royalty agreement under FRAND terms for a license covering the SEP holder's entire global SEP portfolio, including the SEPs at issue (hereinafter, the "Global FRAND Royalty"), to thereby provide a mechanism for resolving worldwide disputes concerning SEPs.

From this perspective, the Court in an SEP Action will, in principle at the first hearing date, recommend settlement and, for the purpose of expediting the formation of an agreement on the Global FRAND Royalty as promptly as possible, will designate hearing dates for settlement discussions in a planned and concentrated manner in order to support the parties in reaching an agreement.

2. Case Management Plan

In SEP Actions, it is common that the number of issues regarding infringement (claim construction/essentiality) and invalidity is relatively limited, and the principal issue becomes the viability of the defense of abus e of rights (i.e., whether or not the implementer has the willingness to obtain a license on FRAND terms).

With respect to the defense of abuse of rights, if settlement negotiations are conducted after the Court's settlement recommendation but the settlement procedure is terminated on the ground that there is no prospect of reaching a settlement, then both parties must promptly submit briefs and

evidence that organize and consolidate their assertions and proof concerning the defense of abuse of rights, taking into account the course and content of negotiations from before the filing of the action through the termination of the settlement procedure. In such case, the Court will decide on the viability of the defense of abuse of rights on the basis of these submissions.

Where there are issues remaining concerning infringement (essentiality/satisfaction) and invalidity, the Court will set deadlines at the first hearing date for two rounds of submitting briefs on these issues (plaintiff's assertions and evidence; defendant's rebuttals and counter-evidence; plaintiff's surrebuttal (further rebuttal) and counter-evidence; and defendant's further surrebuttal and counter-evidence), and will basically proceed primarily on the papers. In such case, the Court may, while taking into account the oral discussions at the first hearing, set a date for a Technical Explanation Session at that time, if necessary.

3. Settlement Procedure

Under the Court's settlement recommendation, both parties are to engage in focused settlement negotiations after the first hearing date, in parallel with the above-described paper-based proceedings. In the settlement procedure, the Court excludes extreme bargaining positions such as hold-up and hold-out positions, and seeks to establish a fair and neutral order for negotiations grounded in moderation. Respecting the course and content of the parties' negotiations, and from the standpoint of supporting the formation of an agreement, the Court will adjust the settlement proposals submitted by both parties. Ultimately, the Court may present a settlement proposal regarding the Global FRAND Royalty; even in such a case, however, the Court will not unilaterally determine the Global FRAND Royalty but will instead present a proposal that respects the parties' intentions after fully listening to the same.

Further, promptly after the first hearing date, the parties shall, from the standpoint of facilitating the formation of an agreement, confer and prepare an agreement on all terms other than the Global FRAND Royalty. If a settlement is reached, that agreement will then be supplemented by inserting the Global FRAND Royalty and attached as an appendix to the judicial settlement record.

4. Preparations by the Plaintiff

In the Complaint, the Plaintiff is to propose a Global FRAND Royalty with a concrete statement of the grounds and basis for the calculation thereof. As to the calculation methodology, any of the following may be used so long as the basis is specified: (i) the top-down approach; (ii) the comparable licenses approach; or (iii) a combination thereof.

5. Preparations by the Defendant

In the Answer, the Defendant is to state specific admissions or denials and rebuttals to the Plaintiff's stated calculation basis, and, after clarifying the Defendant's own calculation basis, is to submit a counterproposal concerning the Global FRAND Royalty. In doing so, the Defendant must also submit evidence regarding the number of units sold, the sales amounts, and the like, for the accused products, etc.

Please note that if the Defendant does not voluntarily submit evidence necessary for calculating the Global FRAND Royalty, the Court may determine that the Defendant lacks the willingness to obtain a license on FRAND terms.
(End)

[Translation]
Guidelines for Proceedings in SEP Judicial Mediation (SEPJM)

January 2026
Intellectual Property Divisions, Tokyo District Court (Civil Divisions No. 29, No. 40, No. 46, and No. 47)

Tokyo District Court Civil Divisions No. 29, No. 40, No. 46, and No. 47 have decided to commence SEP Judicial Mediation (SEPJM) as special operational framework within the intellectual property mediation procedure for cases involving standard essential patents (hereinafter, "SEPs"). The purpose, features, and method of the proceedings for SEP Judicial Mediation matters are as follows. For all other matters, the operation of the intellectual property mediation procedure shall be applied mutatis mutandis; therefore, please refer to the notice titled "Operation of Intellectual Property Mediation Procedure" posted on the website of the Intellectual Property Divisions of the Tokyo District Court.

1. Purpose of SEP Judicial Mediation

In view of the fact that the implementation of SEPs necessarily crosses national borders due to the international dissemination of standardized technologies, SEP Judicial Mediation aims to facilitate the formation of an agreement on a royalty under FRAND terms for a license covering the SEP holder's entire global SEP portfolio, including the SEPs at issue (hereinafter, the "Global FRAND Royalty").
To achieve this purpose, the Mediation Committee, while referring to global standards, will smoothly and flexibly support the formation of an agreement on the Global FRAND Royalty and, in principle, aim to achieve successful mediation by the third mediation date.

2. Features of SEP Judicial Mediation

The features of SEP Judicial Mediation are as follows.

(1) International Character

SEP Judicial Mediation seeks to facilitate the formation of an agreement on the Global FRAND Royalty. In such case, the method of calculation concerning the Global FRAND Royalty shall, taking into account the global nature of SEPs, refer to global standards; for example, so long as the basis for calcula-

tion is specified, it is permissible to use any of the following: (i) the top down approach; (ii) the comparable licenses approach; or (iii) a combination thereof.

(2) Expediency
Between the parties to cases concerning SEPs, it is generally considered that: (i) negotiations are conducted prior to the filing of a mediation petition; (ii) the issues concerning the basis for calculating the Global FRAND Royalty are identified; and (iii) each party possesses the relevant materials and the like. SEP Judicial Mediation proceeds on this premise, and the Mediation Committee seeks the submission of assertions and evidence from both parties by the first mediation date, and, in principle, aims for the expeditious resolution of the dispute within three mediation dates.

(3) Expertise
The Mediation Committee in SEP Judicial Mediation is composed of a total of three members: one judge from the Intellectual Property Divisions and two experts such as attorneys or patent attorneys who have extensive experience in intellectual property cases. Therefore, in terms of expertise, it is on par with litigation and similar procedures. Furthermore, it is possible for court research officials possessing specialized knowledge concerning SEPs to be involved in the proceedings.

3. Method of Proceedings in SEP Judicial Mediation

(1) First Mediation Date
In its petition, the Petitioner shall submit a proposal for the Global FRAND Royalty with a concrete statement of the grounds and basis for the calculation thereof. In response, the Respondent shall, in its answer, state specific admissions or denials and rebuttals to the Petitioner's proposa l and, after clarifying the basis for calculation, submit a counterproposal concerning the Global FRAND Royalty. In doing so, the Respondent must also submit evidence regarding the number of units sold, the sales amounts, and the like, for the respondent's products, etc.

At the first mediation date, the Mediation Committee will individually hear from each party as to the purport of each proposal and will then instruct both parties to further submit their respective counterproposals by the second mediation date. Furthermore, after the first mediation date, from the standpoint of facilitating the formation of an agreement, both parties shall confer regarding all terms other than the Global FRAND Royalty and prepare an agreement. If mediation is successfully concluded, this agreement will then be supplemented by inserting the details of the Global FRAND Royalty and attached as an appendix to the mediation record.
Should there be issues concerning infringement (essentiality/-satisfaction) and invalidity, then, from the standpoint of achieving a simple and swift resolution, depending on the case, the parties may be asked to exchange one round of briefs on infringement (satisfaction) and invalidity ((i) the Respondent's assertions and proof of non infringement (non satisfaction) and invalidity in response to the petition; and (ii) the Petitioner's rebuttal and counter evidence thereto), and, if necessary, at the second mediation date, a date may be set for a simplified Technical Explanation Session. In such cases, from the standpoint of ensuring smooth coordination between the mediation and litigation proceedings, both parties will promptly submit each of the above briefs in litigation procedures pertaining to an action filed after mediation is unsuccessful or withdrawn.

(2) Second Mediation Date (If a simplified Technical Explanation Session is held on the second mediation date, this refers to the third mediation date.)
The Mediation Committee, taking into account the respective bases submitted by both parties for calculating the Global FRAND Royalty, will present a mediation proposal or instruct both parties to submit their final proposals. If both parties are instructed to submit their final proposals, they will submit such proposals by the third mediation date (if a simplified Technical Explanation Session is held on the second mediation date, this refers to the fourth mediation date; the same applies hereinafter).
In addition, if a simplified Technical Explanation Session is held on the second mediation date, the Mediation Committee may (as at the first mediation date) also provide instructions at the second mediation date to the effect that further respective counterproposals be submitted by the third mediation date.

(3) Third Mediation Date
If the Mediation Committee has presented a mediation proposal, it will confirm the parties' intention to accept the same and, based on such confirmation, deem the mediation to be successful or unsuccessful.
On the other hand, if the Mediation Committee has instructed both parties to present their own final proposals, then the Mediation Committee will take such proposals into account and present a mediation proposal. Then, after confirming the parties' intention to accept such proposal, the Committee will deem the mediation to be successful or unsuccessful.

(4) Handling Where Mediation Is Unsuccessful
If mediation is unsuccessful, the mediation record shall state, in the case where the Petitioner or the Respondent lacks the intention to participate in the mediation, that mediation was unsuccessful for that reason. In cases where a mediation proposal was presented, the mediation proposal and the opinion of the Mediation Committee shall be attached. Thereafter, in subsequent litigation or preliminary injunction proceedings, both parties may submit the said mediation record with respect to the defense of abuse of rights issue.
(End.)

Author
Akihiro Tomomura
Attorney-at-law


Updates to "When does a generic entry become possible? – patent protections and pharmaceutical regulations in Japan –"

/ Published in Jun. 2026

Sayaka Ueno

What this article covers

In March 2021, I authored "***When does a generic entry become possible? – patent protections and pharmaceutical regulations in Japan-***" (the "**Previous Article**"). This article provides an update on recent developments since publication of the Previous Article.

In the Previous Article, I explained that generic entry in Japan is primarily constrained by two key mechanisms: (i) the patent system and (ii) the re-examination period system. I also outlined Japan's patent linkage system, which operates in practice to connect patent rights with regulatory approval and drug pricing/listing procedures.

While the overall framework remains unchanged, some important developments have taken place. Two particularly noteworthy developments are:

- Changes to the re-examination period system, including the possibility of extending exclusivity to up to 12 years through pediatric development; and
- Recent revisions to Japan's patent linkage system, including the introduction of a trial expert panel system in patent linkage reviews.

Quick Recap

By way of background:

(A) In Japan, market exclusivity for originator drugs is generally ensured by the combination of **patent protection** and **the re-examination period**. In principle, generic entry becomes possible only after both have expired.

(B) A key feature of Japan's **patent term extension (PTE) system** is that an extended patent right does not uniformly cover the entire claim scope; rather, its effect is limited to the scope corresponding to the approved product. In addition, it is possible for a single patent to have multiple PTE registrations, and for a single marketing approval to support PTE registrations for multiple patents, making the analysis complex in practice.

(C) **Japan's patent linkage system** is not established by statute but is implemented through administrative practice based on MHLW [*] notifications (see Section 4 below). It consists of two stages:

a. Consideration of patents at the approval stage

If a patent covering the active ingredient of an originator drug is in force, approval for a generic drug will not be granted. Where patents cover only certain indications, dosages, or administration methods, approval may be granted limited to portions outside the patent scope.

b. Adjustments at the drug price listing stage

When applying for reimbursement listing, generic companies must conduct prior consultation with patent holders where patent disputes may arise, confirming both the absence of patent concerns and the ability to ensure stable post-launch supply.

"**MHLW**" = the Ministry of Health, Lab our and Welfare

Updates on Re-Examination Period

(A) Potential Extension of Re-examination Periods up to 12 Years Through Pediatric Development (effective May 1, 2026)

The re-examination period system is implemented under the MHLW notice **"Handling of Re-examination Periods."** A revision dated February 27, 2026 clarified that, in cases involving pediatric dosage development, the period may be extended beyond previous practice to a maximum of 12 years.

Previously, extensions could be granted in practice based on considerations for pediatric clinical trial plans, but the requirements were not clearly articulated in the notice. The revised notice now explicitly provides that:

"For pharmaceuticals for which it is clearly recognized that development for pediatric dosage and administration is necessary, if a development plan for such pediatric use is submitted by the completion of the review for adult approval, and development is conducted without delay in accordance with such plan, the investigation period may be extended by two years, up to a maximum of 12 years."

This clarification confirms that re-examination periods may reach up to 12 years (e.g., 8 years + 2 years of extension for New API Drugs, or 10 years + 2 years of extension for new Orphan Drugs), and (ii) the requirements for such extension are explicitly stated.

It is necessary that a concrete pediatric development plan be submitted by the completion of the adult approval review, and that clinical development be initiated and carried out without delay in accordance with that plan.

The 2025 amendment to the PMD Act [*] introduced an obligation to make efforts to formulate pediatric development plans at the time of adult drug development (effective May 1, 2026). Together with that, this revision to the MHLW notice

reflects an increasing policy emphasis on promoting pediatric drug development, where drug lag/loss has been a serious issue.

From an originator company perspective, this revision would create a clearer pathway to extending regulatory exclusivity through pediatric development planning in Japan.

* "PMD Act" = The Act on Securing Quality, Efficacy and Safety of Products Including Pharmaceuticals and Medical Devices

(B) Re-examination periods under the latest MHLW Notification

The February 27, 2026 revision did not fundamentally change the overall structure of Japan's re-examination period system. The most notable update is the clarification that, where specified requirements relating to pediatric development are satisfied, the re-examination period may be extended by an additional two years, resulting in a maximum period of 12 years.

For reference, a summary of the re-examination periods currently provided under the MHLW Notice **"Handling of Re-examination Periods"** (as revised on February 27, 2026) is included at the end of this article.

Revision of MHLW Notification Forming the Basis of Patent Linkage (October 8, 2025)

Unlike the U.S. Hatch-Waxman framework, Japan's patent linkage system is not established by statute and does not involve an Orange Book-type mechanism. The Japanese patent linkage system is operated in accordance with an MHLW notification [*], which was amended on October 8, 2025, including the following updates.

* Current title: "Handling of Pharmaceutical Patents in Relation to Approval Reviews and Drug Price Listing under the Pharmaceutical and Medical Devices Act Concerning Generic Drugs and Biosimilars for Medical Use"

(A) Clarification of Biosimilars

Biosimilars, which had previously been treated similarly to generics in practice without explicit mention, are now clearly included within the scope of the notification.

(B) Clarification on Patent Information Reporting System

The revision clarifies that patents relating to originator active ingredients (i.e. substance or use patents) that are not reported via the patent information reporting form will, in principle, not be considered during generic approval review.

If such patents are granted after expiry of the re-examination period, the originator company or patent holder must submit the relevant report within 30 days of publication if it wishes the patent to be considered in the review process.

Trial Introduction of the Expert Panel System (From November 2025)

Pursuant to the MHLW notification dated November 14, 2025, titled "Trial Introduction of an Expert Panel System for Confirming the Existence of Patent Infringement in the Approval Review of Generic Drugs and Biosimilars," the MHLW has initiated, on a trial basis, a system under which it may, as necessary, seek opinions from patent experts.

While determinations of patent infringement fall within the jurisdiction of the courts, and the determination of patent validity lies with the Japan Patent Office (JPO), meaning that MHLW itself does not possess authority to make substantive legal judgments in this regard, in practice, under the patent linkage system, MHLW's decisions on whether to grant approval can affect the practical exclusivity of patents covering originator drugs vis-à-vis generics. In light of this situation, the system has been introduced with the aim of improving the quality of MHLW's assessments at the approval review stage, as well as enhancing the transparency and predictability of the overall process.

Here is a summary of how this new system works:

- **Designation of cases by MHLW:**

MHLW retains discretion to determine in which specific cases expert opinions should be sought during the review process. Where such designation is made, both the originator manufacturer and the generic manufacturer will be notified.

- **Submission of materials:**

Upon receiving notification, the originator and generic (or biosimilar) manufacturers may each submit, within 30 business days, any of the following materials to which they consent to be shared with the expert panel:

- o Approval application materials (e.g., CTD 1.4)
- o Drug patent information report forms
- o Documents summarizing the originator manufacturer's (or patent holder's) views on the existence of patent infringement
- o Expert opinions, case law, academic literature, and other reference materials concerning patent infringement
- o Results of JPO's **Hantei** (advisory opinion system)

- **Selection of experts and consultation process:**

Following conflict clearance and a selection process for panel members, MHLW will formally request the expert panel's opinion on the existence of potential patent infringement.

- **Preparation of expert opinion:**

The expert panel (in principle consisting of three members) will deliberate and prepare a written opinion, generally within approximately 30 business days after receiving (i) publicly available information concerning the relevant generic and originator drugs (such as patent publications and package inserts), and (ii) the shared materials described above.

The panel may also request additional information during this process. Once the consultation procedure is completed, MHLW will notify both the originator and generic manufacturers of its completion.

Disclosure of expert opinion:

After the final decision regarding the approval of the generic product has been made public, a copy of the expert opinion will, upon request, be promptly disclosed to the interested generic and originator companies, with certain information redacted, such as the names and affiliations of the experts, personal information, and portions constituting confidential business information.

As the framework remains at a trial stage, important questions remain regarding its practical operation, including the scope of issues that may be considered by the expert panel and the extent to which the system will affect the overall operation of Japan's patent linkage framework.

Closing remark

The intersection of pharmaceutical regulation and patent law in Japan remains an evolving and highly significant field. We will continue to follow developments and updates in this area. These developments may affect both exclusivity planning for originator companies and launch strategies for generic and biosimilar manufacturers. Companies with products approaching approval, patent expiry, or lifecycle management milestones should continue to monitor these changes closely.

Author

Sayaka Ueno

Attorney-at-law

Appendix:
Summary of Current Re-examination Periods (MHLW Notice "Handling of Re-examination Periods," as revised on February 27, 2026)

	Category of New Drugs	Re-examination Period
(1)	Orphan drugs (i) Initial approval for a new indication, or addition of a clearly different dosage defined by a specified patient population (e.g., pediatric use) (ii) Initial approval for the addition, for the same indication, of a clearly different route of administration or a clearly different dosage (e.g., pediatric dosage) (iii) Cases other than (i) and (ii)	(i) 10 years (ii) More than 6 years but not exceeding 8 years (iii) More than 6 years but not exceeding 8 years
(2)	New drugs for which it is clearly recognized as necessary to conduct post-marketing studies using pharmacoepidemiological methods to evaluate comprehensive therapeutic effects on patients, such as survival prolongation, improvement in quality of life (QOL), and prevention of complications, particularly with long-term use.	10 years
(3)	New drugs with active ingredients that are clearly different from those of already approved drugs (excluding (1) and (2))	8 years
(4)	New drugs that differ from already approved drugs only in indication (i) Pioneering Drugs (ii) Cases where such existing drugs have only indications designated as orphan drug indications (excluding (i)) (iii) Cases other than (i) and (ii)	(i) A period of more than 6 years and up to 8 years, as designated by the Minister of Health, Labour and Welfare (ii) 5 years and 10 months (iii) 4 years
(5)	New drugs that differ from already approved drugs only in dosage and administration (excluding route of administration) or dosage amount, where the active ingredient and route of administration are the same, or where the differences from previously approved drugs are otherwise considered minor (excluding (1) ~ (4))	4 years
(6)	New drugs not falling under categories (1) through (5)	6 years

Extension	For already approved drugs, where, after approval, it comes to be recognized that it is necessary to conduct evaluations using pharmacoepidemiological methods, based on endpoints such as survival prolongation, improvement in quality of life (QOL), and prevention of complications associated with long-term use, reflecting overall therapeutic benefit to patients	Up to a maximum of 10 years
	Where development has been conducted in accordance with a development plan for pediatric dosage and administration. **(see 3(A) of this blog article)**	Extension of +2 years (up to a maximum of 12 years)

[Series] Japan IP Dispute Resolution 101 – Part 1 & Part 2

Moeha Hosonuma

Welcome to our new series, "Japan IP Dispute Resolution 101," where we will introduce both the legal framework and the practical realities of handling IP disputes in Japan. Whether you are looking to protect your rights through IP enforcement or defend against infringement claims, this series will provide the essential insights you need to navigate the system.

Part 1: An Overview of IP Litigation in Japan / Published in Jun. 2026

Court Jurisdiction for IP Cases in Japan

Basic court structure. The Japanese judicial system operates on a three-tier structure: typical civil proceedings begin at a District Court (first instance), proceed to a High Court (appellate instance), and conclude at the Supreme Court (final appeal).

Specialized IP divisions in Tokyo and Osaka. At the District Court level, the Tokyo District Court and the Osaka District Court each have specialized Intellectual Property Divisions. These divisions handle and concentrate on IP-related matters, including claims concerning patents, utility models, designs, trademarks, copyrights, and layout-design exploitation rights, as well as cases related to the Unfair Competition Prevention Act and publicity rights.

Technology-related cases and exclusive jurisdiction.
Furthermore, within IP disputes, "technology-related cases" are subject to the exclusive jurisdiction of the Tokyo and Osaka District Courts among all district courts nationwide (Code of Civil Procedure, Article 6(1)). "Technology-related cases" are those involving patents, utility models, layout-design exploitation rights, or computer program copyrights.

The Intellectual Property High Court:
For appellate proceedings, any IP case appealed from the Tokyo District Court falls under the jurisdiction of the Intellectual Property High Court (IP High Court). Likewise, appeals for "technology-related cases" originating from the Osaka District Court are exclusively directed to the IP High Court (Code of Civil Procedure, Article 6(3); Act for Establishment of the Intellectual Property High Court, Article 2(1)).

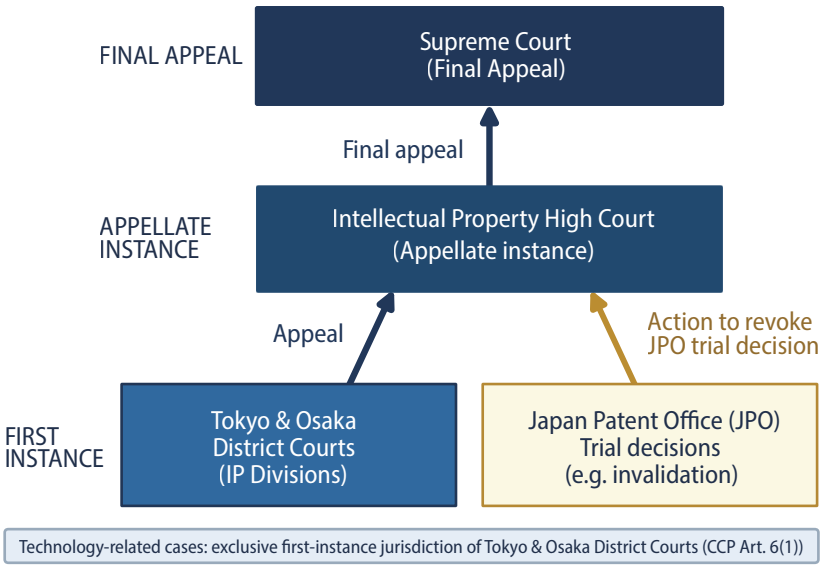
Concentrating these cases within the highly specialized IP High Court, which comprises judges and judicial research officials with deep expertise in IP rights, ensures comprehensive, expedited proceedings and promotes the early unification of judicial precedents. Consequently, rulings by the IP High Court attract significant attention and hold substantial weight in Japanese IP litigation practice. This is especially true for rulings rendered by the Grand Panel, a special panel composed of five judges (as opposed to the standard three-judge panel) that hears cases involving significant legal issues requiring a unified interpretation of the law.

The IP High Court also holds exclusive jurisdiction over actions for the revocation of trial decisions made by the Japan Patent Office (JPO), such as those regarding the invalidation of patents, trademarks, or designs (Patent Act, Article 178(1); Act for Establishment of the Intellectual Property High Court, Article 2(2)).

Important Notes on Court Structure:

- The IP divisions of the IP High Court and other courts do not handle criminal cases (such as criminal offenses for IP infringement).
- In Japan, there is **no jury system** for civil matters, including IP disputes.

Court Structure for IP Cases in Japan



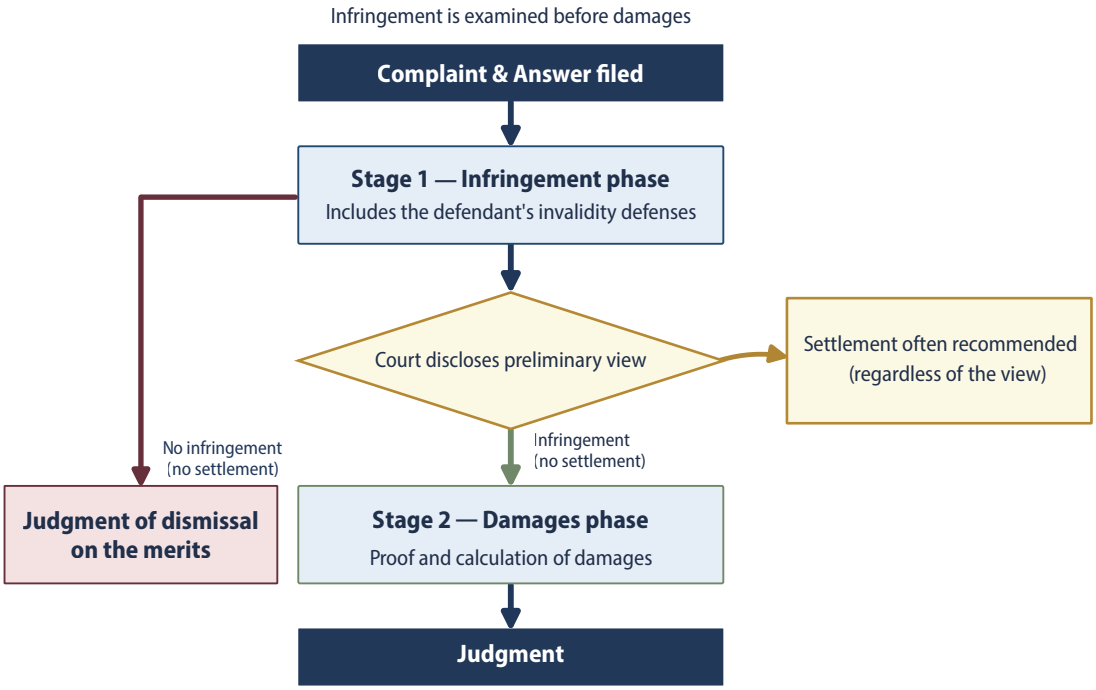
Two-Stage Proceedings at the District Court

One of the most important procedural features of Japanese IP litigation is its two-stage proceeding model within the district court proceedings:

- **Stage 1: Infringement Phase:** The court first examines whether infringement is established (which includes arguments on invalidity defenses). Once both parties finish presenting all their arguments, the court will disclose its preliminary view regarding the presence or absence of infringement.
- **Stage 2: Damages Phase:** Only if the court announces its preliminary view that infringement is established, the proceedings will advance to the second stage—the calculation of damages

For rights-holders initiating a lawsuit, this means it is necessary to prioritize the assertion and proof of infringement before moving on to the detailed proof and calculation of damages. Additionally, when the court discloses its preliminary view of infringement before transitioning to the damages phase, it will often recommend a settlement and designate a date for settlement negotiations.

Two-Stage Trial at the District Court

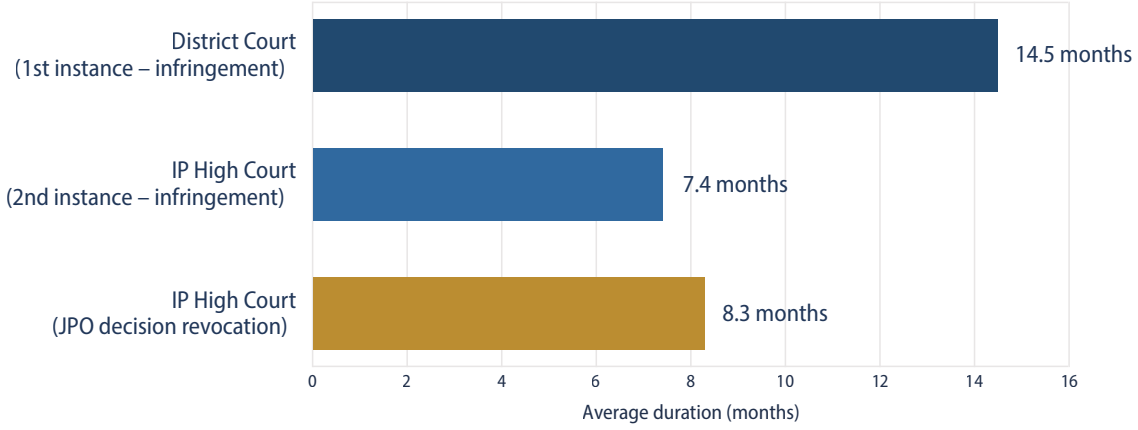


Timeline and Average Duration of IP Litigation in Japan

According to publicly available data from the courts, the average duration for IP-related civil cases in 2024 was:

- **District Courts (First Instance):** 14.5 months
- **IP High Court (Appeals):** 7.4 months
- **Actions for Revocatio n of JPO Decisions:** 8.3 months

Average Duration of IP Cases in Japan (2024)



E-Filing and Digitalization of Japanese Court Procedures

The Japanese judiciary has been gradually integrating IT into its civil proceedings since 2020, allowing parties to attend hearing dates via web conferencing and submit certain court documents online.

Taking this a step further, under the amended Code of Civil Procedure that recently came into effect on **May 21, 2026**, the entire civil litigation process—from the filing of a complaint to the issuance of a judgment—has been **fully digitalized**.

- **E-Filing**: Anyone can now file complaints, submit and receive court documents including service of process, and receive judgments online through the courts' "mints" system. For legal counsel, such as attorneys, utilizing these online procedures is now mandatory. (Note: Currently, the court system cannot be accessed from outside Japan).
- **Electronic Records:** For cases filed on or after May 21, 2026, all litigation records are managed electronically within the courts' "mints" system. Parties to a case can access and review the litigation records online at any time.
- **Third-Party Access:** Third parties with a legal interest to a case may view or copy the relevant records online from their own computers only with the permission of a court clerk. Third parties without a legal interest to a case must visit their nearest court in person to view the records on a court-provided terminal.
- **Hearings & Testimony:** While witness examinations can now be conducted remotely via web conferencing under certain strict conditions, spectator observation (which resembles public gallery seating) is not available online and remains restricted solely to the physical courtrooms.

Preliminary Injunctions (PI) vs. Main IP Litigation in Japan

When seeking to enjoin an infringement of IP rights, a party can file a motion for a Preliminary Injunction (PI) order seeking the suspension or prevention of infringement, in addition to a standard civil lawsuit.

A PI order may be issued when it is necessary to avoid substantial damage or imminent danger that would occur to the petitioner with regard to the relationship of the rights in dispute (Civil Preservation Act, Article 23(2)). The primary benefits of a PI include:

- **Speed:** PI proceedings are generally expected to be faster than main civil lawsuits.
- **Immediate Enforcement:** In a standard civil lawsuit, even if the plaintiff wins the first instance, the judgment cannot be executed if the defendant appeals. In contrast, a PI order becomes immediately enforceable upon notice (Civil Preservation Act, Article 43).

It is common practice for a plaintiff to file a main civil lawsuit and a PI petition simultaneously. In such cases, because the substantive arguments in both proceedings are nearly identical, the hearing dates often run concurrently (though this parallel processing can sometimes cause the PI to proceed slightly slower than if it were filed entirely alone).

The strategic advantage of simultaneous filing is clear: once the court confirms infringement, the petitioner can immediately obtain an enforceable PI order to halt the infringing activities. This secures immediate injunctive relief while the main lawsuit continues into the damages phase. It is important to note, however, that financial compensation cannot be claimed in PI proceedings; therefore, any claim for damages must be pursued concurrently within the main civil lawsuit.

Part 2: The Basic Framework of Patent Litigation in Japan

/ Published in Jun. 2026

Composition of the Bench in Patent Litigation

Patent litigation in Japan is typically heard by a three-judge panel. However, given the technical complexity inherent in patent disputes—including patent infringement actions and appeals from JPO trial decisions—the Japanese court system incorporates technical expertise through two categories of specialists: judicial research officials and technical advisors. This composition of a hybrid bench distinguishes patent litigation from other forms of IP litigation (such as copyright cases) and general civil litigation.

Judicial Research Officials:

Judicial research officials are internal court staff who collaborate with the judicial panel throughout the entire duration of a case. Under the direction of the presiding judges, they conduct technical investigations, prepare analyses of complex technical issues, and assist the judges in understanding the scientific or engineering principles at the heart of the dispute.

These officials typically have professional backgrounds as JPO patent examiners (including appeal examiners) or patent attorneys (***benrishi***). For each case, the court assigns an official whose technical expertise aligns with the relevant field.

Technical Advisors:

In contrast, technical advisors are external experts appointed by the court on a case-by-case basis. They participate in selected court sessions, typically Technical Presentations, where they provide explanations based on their specialized knowledge. While technical advisors may clarify technical concepts for the court, their explanations do not constitute formal evidence and cannot serve as the sole basis for factual findings.

Neither judicial research officials nor technical advisors possess adjudicative authority. While all legal determinations

and findings of fact are made exclusively by the three-judge panel, the participation of these judicial research officials and technical advisors enables judges to make informed decisions with a thorough understanding of the technical matters at issue, thereby enhancing the quality and reliability of patent adjudication in Japan.

Substantive Legal Issues in Patent Infringement Litigation

Taking patent infringement actions as an example, Japanese patent infringement actions follow a two-stage proceeding structure (introduced in Part 1). The proceedings are divided into two sequential phases: the Infringement Phase and the Damages Phase. This two-stage structure presupposes that the plaintiff seeks damages; where only injunctive relief is sought, the proceedings conclude with the Infringement Phase and no separate Damages Phase arises.

Phase 1: Infringement Phase

In the Infringement Phase, issues such as the following (1) through (3) are examined. The proceedings advance to the Damages Phase only if the court forms a preliminary view that infringement is established. It is customary for the court to disclose its preliminary view once the arguments in the Infringement Phase have been fully presented.

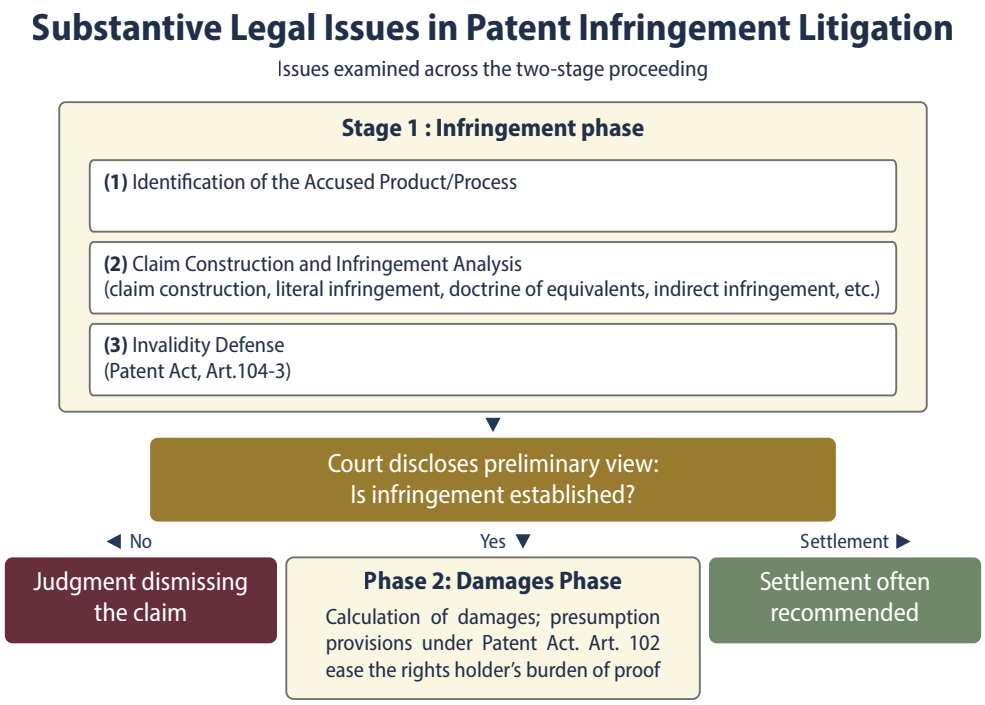
(1) Identification of the Accused Product/Process: At this stage, the court examines whether the defendant's product or process is sufficiently identified.

(2) Claim Construction and Infringement Analysis: The court determines whether the defendant's product or process falls within the technical scope of the patented invention. Issues such as claim construction, literal infringement, the doctrine of equivalents, and indirect infringement arise at this stage.

(3) Invalidity Defense: The court examines whether the patent contains grounds for invalidation. Under Article 104-3 of the Patent Act, the defendant may assert that the patentee canno t exercise its rights when the patent should be invalidated through an invalidation trial.

Phase 2: Damages Phase

Only after the court forms a preliminary view of infringement following the examination of issues (1) through (3) do the proceedings move to the assessment of damages. The claim for damages arises in tort under Article 709 of the Civil Code; the Patent Act does not create an independent cause of action but supplements this framework with special rules. Regarding the calculation of damages, presumption provisions are established under Article 102 of the Patent Act, which serve to reduce the burden of proving the amount of damages.



Technical Presentations *(Gijutsu Setsumeikai)*

A Technical Presentation (***Gijutsu Setsumeikai***) is a proceeding in which judges, judicial research officials, and technical advisors receive explanations from the parties regarding the content of the invention and the underlying technology. In patent litigation, this procedure is frequently conducted during the Infringement Phase, particularly in technically complex cases.

In most instances, both parties, the judges, judicial research officials, and technical advisors participate. Each party first delivers a presentation, after which the judges, judicial research officials, and technical advisors pose questions to the parties.

This procedure enables the judges, who are responsible for adjudication, to develop a deeper understanding of the inventions and technologies at issue in the litigation. Technical Presentations play an important role in enhancing the quality of proceedings in technically complex cases, and both parties should fully utilize them as a valuable opportunity to convey technical matters clearly to the judges.

The "Double Track" System for Patent Invalidity Determinations

In Japan, a "**Double Track**" system is in place under which two parallel routes exist for challenging the validity of a patent:

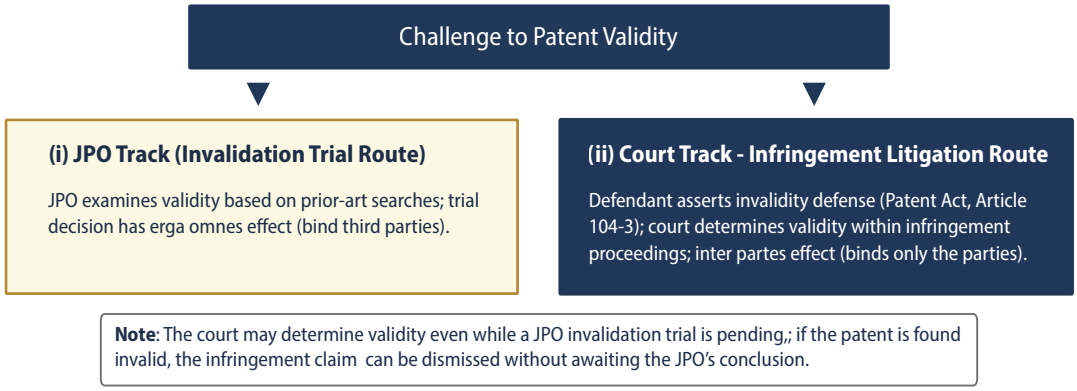
(i) JPO Track (Invalidation Trial Route): A party may file a request for an invalidation trial with the JPO. The JPO examines the validity of the patent based on prior art searches and other relevant materials. The resulting trial decision has ***erga*** omnes effect (i.e., binding on third parties beyond the parties to the invalidation trial).

(ii) Court Track (Infringement Litigation Route): In infringement litigation, the defendant may directly assert an "invalidity defense" (Patent Act, Article 104-3). The court has the authority to determine the validity of a patent within infringement proceedings, and it exercises this authority in practice. Such a determination has ***inter*** partes effect only (i.e., binding solely on the parties to the litigation).

Under this system, even while an invalidation trial is pending before the JPO, the court may determine patent validity within the infringement proceedings. If the court concludes that the patent is invalid, it can dismiss the infringement claim without waiting for the JPO's conclusion. On the other hand, a defendant may also file an invalidation trial with the JPO in parallel with the litigation.

The "Double Track" System for Patent Invalidity Determinations

Two parallel routes for challenging patent validity



Statistics on the Double Track:

According to JPO statistics for patent infringement actions with judgment dates in 2023, invalidation trials were pending for the corresponding patents in 60% of cases. Among those, an invalidity defense was asserted in 90% of the litigation cases.

Furthermore, according to JPO compilations for patent infringement actions with judgment dates between 2019 and 2023, the consistency rate between the conclusions reached in invalidation trials and the validity/invalidity determinations in district court judgments was 81%.

Key Statistics on Patent Infringement Litigation

When filing or defending a patent infringement action in Japan, understanding the likely outcomes and the level of damages awarded is important for formulating litigation strategy and settlement negotiations. The following presents key statistics on patent infringement litigation based on data published by the courts (FY2015–FY2024, IP Divisions of the Tokyo and Osaka District Courts).

(1) Case Outcomes: Ratio of Judgments to Settlements

Approximately 71% of patent infringement actions conclude with a final judgment, while approximately 29% conclude through a settlement.

Outcome	Percentage (%)
Judgment	71%
Settlement	29%

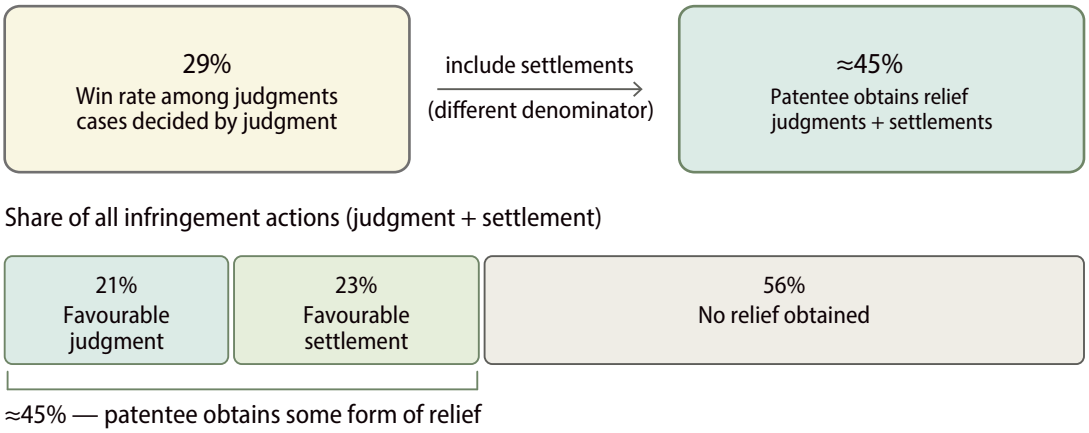
(2) Judgment Results (Plaintiff Success Rate)

Among cases that proceeded to judgment, patent plaintiffs prevail in approximately 29% of litigated cases, while defendants prevail in approximately 65%. This figure, however, reflects only cases decided by judgment and understates the practical prospects of enforcement. Settlem ents account for roughly 29% of all actions (see (1) above), and approximately 80% of those settlements include injunctive relief and/or a payment obligation in the patentee's favor. Taking plaintiff-favorable judgments and such settlements together, **the patentee obtains some form of relief in roughly 45% of all infringement actions**. For a rights holder considering enforcement in Japan, the realistic likelihood of securing relief is therefore materially higher than the headline judgment-based rate suggests.

Note: "Declaration of Non-Infringement Sustained" refers to actions initiated by the accused infringer seeking a declaratory judgment of non-infringement against the patent holder. In these cases, the "defendant" is the patent holder and the "plaintiff" is the accused infringer.

Result	Percentage (%)	Cases
Claims Sustained (Plaintiff Win)	29%	159
Claims Dismissed (Plaintiff Loss)	65%	349
Declaration of Non-Infringement Sustained	3%	16
Declaration of Non-Infringement Dismissed	0.6%	3
Dismissed on Procedural Grounds	2%	12

Patent enforcement in Japan: headline win rate vs. actual relief



(3) Distribution of Damages Awarded

Among judgments in favor of the plaintiff, the distribution of damages awarded is as follows.

Damages Awarded	Number of Cases
JPY 1 – less than JPY 1 million (< approx. USD 7,000)	19
JPY 1 million – less than JPY 10 million (approx. USD 7,000 – 70,000)	22
JPY 10 million – less than JPY 50 million (approx. USD 70,000 – 350,000)	35
JPY 50 million – less than JPY 100 million (approx. USD 350,000 – 700,000)	11
JPY 100 million or more (approx. USD 700,000+)	37

While there are 37 cases (approximately 30%) with awards of JPY 100 million (approx. USD 700,000) or more, a substantial number of cases involve awards of less than JPY 10 million (approx. USD 70,000), indicating a wide range in damage amounts.

Author

Moeha Hosonuma

Attorney-at-law

IP Rankings Highlight TMI's Top-Tier Performance in 2026

The leading international IP directories published in the first half of 2026 have placed TMI Associates at their highest tier in Japan — across patent, trademark, copyright, litigation and transactions. Gold, Band 1 and Tier 1 rankings were awarded in multiple categories by each of the following:

- **MIP IP STARS 2026** — Read details
- **WTR 1000 2026** — Read details
- **IAM Patent 1000 2026** — Read details
- **Chambers Global 2026** — Read details
- **ALB Asia IP Rankings 2026** — Read details

Japan Revises Trademark Registration Requirements for Trademarks Containing Another Person's Name: Overview of the Amendment and Recent Examination Practice

— Amendment to Article 4(1)(viii) of the Trademark Act —

/ Published in July. 2026

Koichiro Nakagawa

Introduction

The amended Trademark Act, which came into effect on April 1, 2024, revised the scope of Article 4(1)(viii) of the Trademark Act, which concerns trademarks containing another person's name or similar elements.

Under the previous Trademark Act, a trademark containing another person's name could not be registered unless the consent of that person had been obtained. While this provision played an important role in protecting personal interests in one's name, it had also been pointed out in practice that even a trademark containing the brand owner's own name could potentially be refused registration if there was a third party with the same name.

This issue was particularly significant for fashion brands and designer brands, which often use the names of their founders or designers as brand names. The inability to register such marks presented a serious issue from the perspective of brand protection.

Against this background, Article 4(1)(viii) was revised and new registration requirements were introduced, with a view to striking an appropriate balance between maintaining the protection of personal interests in one's name and ensuring brand protection.

This article provides an overview of the amendment, explains the newly introduced registration requirements, and introduces examples of trademarks containing another person's name that have been registered or refused under the amended Trademark Act.

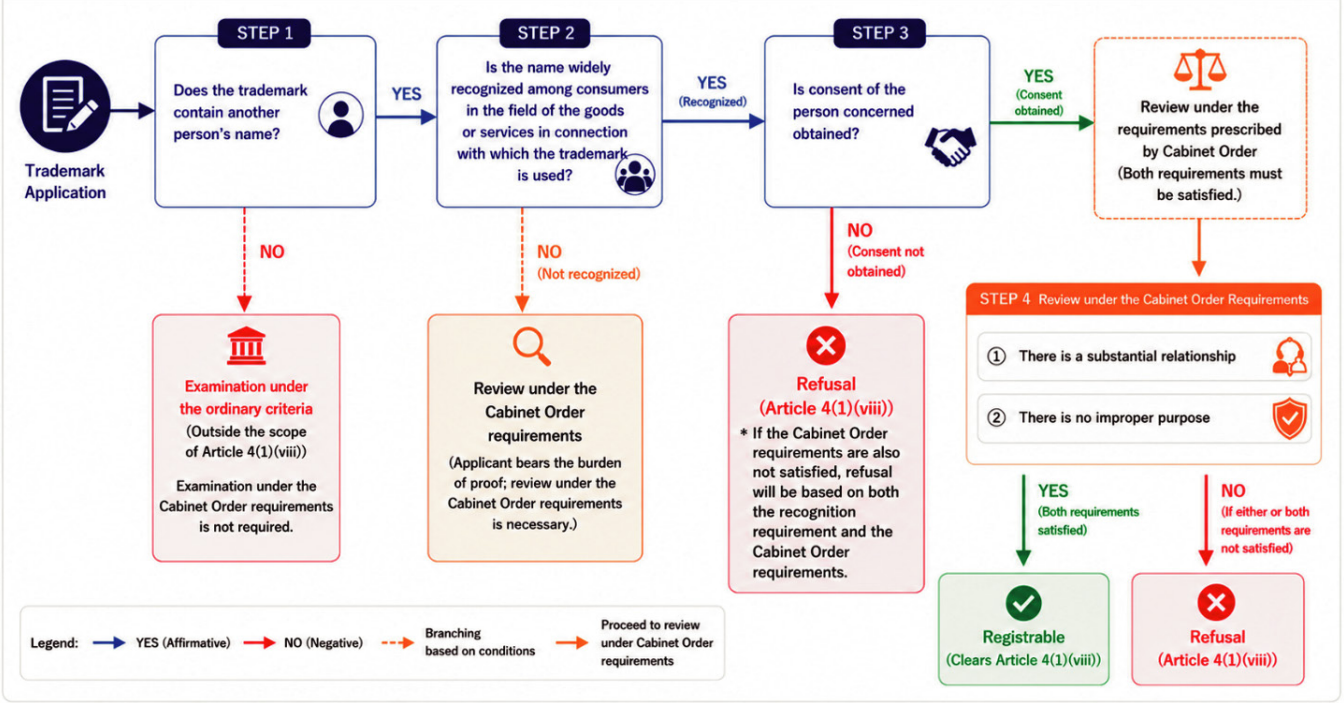
Overview of the Amendment

Under the amended Article 4(1)(viii) of the Trademark Act, trademarks containing another person's name may now be registered in certain circumstances.

More specifically, the amendment introduces two new criteria for determining whether such a trademark may be registered: (i) whether the name is widely recognized among consumers in the field of the goods or services in connection with which the trademark is used; and (ii) whether the requirements prescribed by Cabinet Order are satisfied.

The amendment preserves the original legislative purpose of protecting personal interests in one's name while promoting greater brand protection by facilitating the registration of trademarks containing names that satisfy these requirements.

Fig. 1 Examination Flowchart under the Amended Article 4(1)(viii) (Overall Image)



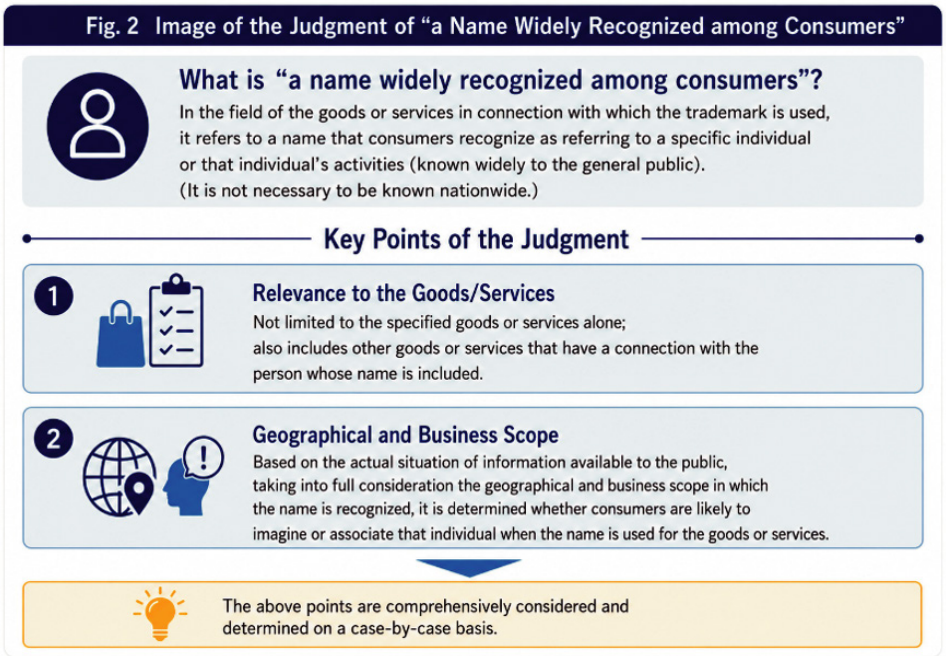
A Name Widely Recognized Among Consumers

First, the amended Article 4(1)(viii) of the Trademark Act introduces a new requirement as to whether another person's name is widely recognized among consumers in the field of the goods or services in connection with which the trademark is used.

Under the previous Trademark Act, the consent of another person was required in all cases where a trademark contained that person's name. Under the amended Act, however, the requirement has been relaxed so that consent is required only where the name is widely recognized among consumers in the field of the goods or services in connection with which the trademark is used. In other words, even if there is another person with the same name, the applicant is no longer required to obtain that person's consent unless the name is widely recognized within the relevant field.

According to the Trademark Examination Guidelines, in determining the "field of the goods or services in connection with which the trademark is used," consideration should be given, from the perspective of protecting personal interests in one's name, not only to the designated goods or services covered by the trademark application but also to goods or services that are related to the person whose name is included in the trademark.

Fig. 2 Image of the Judgment of "a Name Widely Recognized among Consumers"



In addition, when determining whether a name is "widely recognized among consumers," the Guidelines provide that, from the perspective of protecting personal interests in one's name, due consideration should be given to the geographical and business scope within which the person's name is recognized, with particular attention to whether consumers would associate or identify the relevant person when the name is used in connection with the relevant goods or services. However, nationwide recognition is not required.

Based on the above approach, the Trademark Examination Manual provide the following example of a name that is considered to be "widely recognized among consumers in the field of the goods or services in connection with which the trademark is used."

<Example>

Mr. Shōhyō Tarō is a fashion designer whose apparel brand, "Shōhyō Tarō," operates flagship stores in major cities throughout Japan and also sells clothing through stores located in several department stores. In addition, his latest collections have been presented at international fashion shows overseas. Assume that a third party who has no relationship with Mr. Shōhyō Tarō and has not obtained his consent files the following trademark application:

- Trademark: "Shōhyō Tarō"
- Designated goods: Footwear; bags and pouches

Trademark Examination Manual' Analysis

In this example, Mr. Shōhyō Tarō is considered to be widely recognized among consumers in relation to clothing. Furthermore, where clothing is closely related to the designated goods, namely footwear and bags and pouches, consumers in the relevant market are likely to associate the applicant's trademark with Mr. Shōhyō Tarō, even if he does not manufacture or sell those designated goods himself. Accordingly, the trademark falls within the scope of Article 4(1)(viii) of the Trademark Act.

It should also be noted that, under the examination practice of the Japan Patent Office (the "JPO"), written consent from the relevant person may be submitted proactively at the time of filing or before an Office Action is issued, rather than only after an Office Action has been issued.

In addition, where the name concerned is that of a foreign individual, omission of a middle name continues to be treated as an abbreviation of the person's name under Article 4(1)(viii), as under the previous practice. Accordingly, such abbreviated names constitute grounds for refusal only if they are well known.

Requirements Prescribed by the Cabinet Order

As discussed above, under amended Article 4(1)(viii) of the Trademark Act, the JPO examines not only whether the trademark contains the name of another person who is widely recognized among consumers in the field of the goods or services in connection with which the trademark is used, but also whether the requirements prescribed by the Cabinet Order are satisfied.

The Cabinet Order sets forth the following two requirements:

- There must be a substantial relationship between the person whose name is contained in the trademark and the applicant for trademark registration.
- The applicant must not seek to obtain trademark registration for an improper purpose.

These requirements were introduced because, while the amendment relaxes the registration requirements for trademarks containing another person's name by limiting the consent requirement to names that have attained a certain level of recognition, simply introducing a recognition threshold and allowing registration of all trademarks containing names that do not satisfy that threshold could encourage abusive trademark filings.

In particular, there was concern that applications might be filed by persons having no connection with the individual whose name is included in the trademark or by applicants acting for improper purposes. The Cabinet Order requirements were therefore introduced to prevent such abusive filings. Each of these requirements is explained below.

(1) Substantial Relationship

Whether a substantial relationship exists is determined by comprehensively taking into account the relationship between the trademark applicant and the person whose name is included in the trademark.

For example, the Trademark Examination Guidelines provide that a substantial relationship is recognized where the applicant is the person whose name is included in the trademark. A substantial relationship is also recognized where the name is that of the founder or representative of the applicant, or where it has been continuously used as the name of a store or business prior to the filing of the trademark application.

On the other hand, a substantial relationship is not recognized where it is evident that the inclusion of another person's name in the trademark is merely the result of the applicant's arbitrary choice, or where the name belongs to an acquaintance of the applicant and it is evident that the relationship is merely a private one.

Where the examiner determines that a substantial relationship has not been established, the examiner will issue an Office Action, and the applicant will have an opportunity to demonstrate that such a substantial relationship exists.

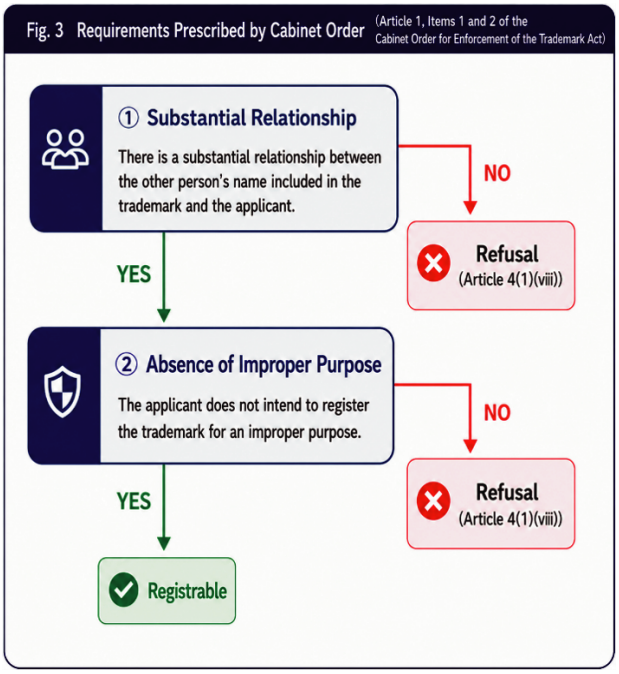
(2) Absence of an Improper Purpose

According to the Trademark Examination Guidelines, an improper purpose includes circumstances where the applicant seeks to harass another person or intends to obtain payment by filing the trademark application ahead of the legitimate user and subsequently demanding that the trademark be purchased.

Whether an improper purpose exists is determined by the examiner based on publicly available information as well as information submitted through the Information Submission System, under which any person may submit information asserting that a trademark application should not be registered.

Where the examiner determines that the applicant h as filed the application for an improper purpose, the examiner will issue an Office Action, and the applicant will have an opportunity to demonstrate that no such improper purpose exists.

Fig. 3 Requirements Prescribed by Cabinet Order (Article 1, Items 1 and 2 of the Cabinet Order for Enforcement of the Trademark Act)



(3) Relationship Between the Consent of the Person Concerned and the Cabinet Order Requirements

Where the consent of the person whose name is contained in the trademark has been obtained, does this automatically mean that the Cabinet Order requirements are satisfied? The JPO distinguishes between the two Cabinet Order requirements—namely, a substantial relationship and the absence of an improper purpose.

With respect to the requirement of a substantial relationship, the issue is whether a substantial relationship exists between the applicant and the person whose name is included in the trademark. Accordingly, even if the applicant has obtained the consent of that person, such consent alone does not automatically establish a substantial relationship. Rather, the existence of a substantial relationship is determined based on the consent together with any other supporting evidence submitted by the applicant.

By contrast, with respect to the requirement of the absence of an improper purpose, the JPO presumes that no improper purpose exists where the consent of the person concerned has been obtained.

Examination Practice Following the Amendment

Examples of Trademarks Registered Following the Amendment

Trademark	KEN KIKUCHI	「山岸一雄大勝軒」 ("Yamagishi Kazuo Taishoken" in Japanese)	「山岸一雄」 ("Yamagishi Kazuo" in Japanese)
Applicant	Ken Kikuchi	Taishoken Co., Ltd.	
Designated Goods or Services	Class 14: Ornaments of precious metal; Key rings; Clocks and watches; etc. Class 18: Bag; Pouches; Wallets; etc. Class 25: Clothing for men, women and children; Footwear [other than special footwear for sports]; etc.	Class 30: Sweets, confectionery and snacks other than meat-based, fish-based, fruit-based, vegetable-based, bean-based or nut-based; Bread and buns; etc. Class 43: Providing foods and beverages; Providing Chinese or other Oriental cuisine.	
Result (Before Amendment)	✕ Refused under Article 4(1)(viii) of the Trademark Act		
Judicial Decision	The Intellectual Property High Court's decision of August 7, 2019 From both the purpose of Article 4(1)(viii) of the Trademark Act and its wording, it is difficult to interpret the phrase "another person's name" in the same provision as being limited to names possessing fame or distinctiveness. Furthermore, where a trademark contains another person's name, there is no need to consider whether the trademark itself has acquired a certain degree of recognition as a brand.	The Intellectual Property High Court's decisions of August 10, 2016 Article 4(1)(viii) is intended to protect an individual's personal interest in his or her own name. Therefore, "another person's name" is not limited to famous or distinctive names, and registrability does not depend on whether the mark has acquired recognition or is likely to cause confusion.	
	↓ These trademarks were refiled after the amendment.		
Result (After Amendment)	✓ Registrable (clears Article 4(1)(viii))		
Registration No.	Registration No. 6889089	Registration No. 6895827 / Registration No. 6895828	

It is also instructive to examine how the JPO has applied the amended provision in practice.

As shown in the above table, the trademarks "KEN KIKUCHI," "山岸一雄大勝軒 ("Yamagishi Kazuo Taishoken" in Japanese)," and "山岸一雄 ("Yamagishi Kazuo" in Japanese)"(where "Yamagishi Kazuo" constitutes the other person's name) were all originally filed before the amendment and were refused. Following the amendment, however, new applications were filed for each of these marks, and all of them proceeded to registration without the issuance of an Office Action.

Before the amendment, each applicant challenged the refusal all the way to the Intellectual Property High Court. The Court held that, once a trademark contained another person's name, it fell within the scope of Article 4(1)(viii) regardless of whether that person's name was well known, and therefore could not be registered unless the consent of that person had been obtained.

As discussed above, however, the amendment changed this framework by requiring consent only where another person whose name is widely recognized in the relevant field of the goods or services exists. Accordingly, the issue identified by the Court under the previous law no longer arose after the amendment.

As also explained above, registration under the amended provision additionally requires that (i) there be a substantial relationship and (ii) the application not be made for an improper purpose. In the case of "KEN KIKUCHI," although the applicant did not submit any explanation specifically addressing these two requirements, the applicant himself was Mr. Ken Kikuchi. It therefore appears that the JPO naturally concluded that both requirements were satisfied.

By contrast, in the cases of "山岸一雄大勝軒 ("Yamagishi Kazuo Taishoken" in Japanese)," and "山岸一雄 ("Yamagishi Kazuo" in Japanese)", the applicant was Taishoken Co., Ltd., rather than Mr. Yamagishi Kazuo himself. However, because Mr. Yamagishi Kazuo was the founder of the ramen restaurant "Taishoken," and the applicant submitted a petition stating that it had obtained Mr. Yamagishi's consent to file trademarks containing his name, it can be understood that the JPO found that both the substantial relationship requirement and the absence of an improper purpose requirement had been satisfied.

By contrast, there have also been cases in which the JPO issued an Office Action under the amended provision.

The first example shown in the above table, "Yano Yuri," was considered to constitute another person's name. Because the applicant was the Chinese individual "Ouyang Lizhuang," the JPO found that no substantial relationship existed between the applicant, "Ouyang Lizhuang," and that name. Accordingly, the JPO issued an Office Action on the ground that the application fell within the scope of Article 4(1)(viii). However, because the applicant did not submit any response to the JPO, the application was ultimately refused.

The second trademark shown in the above table consists of a device mark together with the wording "TAYLOR HILTON." The wording was considered to constitute another person's name, and the JPO found that no substantial relationship existed between the applicant, "Hirotaka Ao," and that name. Accordingly, the JPO issued an Office

Examination Results Following the Amendment

No.	Application No.	Trademark	Designated Goods or Services	Applicant	JPO Decision
1	2025-40276	Yano Yuri	Class 25: Swimwear [bathing suits]; Overalls; Underwear [underclothing]; etc.	Ouyang Lizhuang	Registration refused by the JPO because no substantial relationship was found between the applicant, Ouyang Lizhuang, and the other person's name, "Yano Yuri."
2	2024-129917	TAYLOR HILTON	Class 18: Clothing for domestic pets.	Hirotaka Ao	Registration refused by the JPO because no substantial relationship was found between the applicant, Hirotaka Ao, and the other person's name, "TAYLOR HILTON."
3	2024-43949	WILLIAM WALTERS	Class 41: Provision of information, commentary and advice in the field of sports, entertainment, sporting events and sports competitions; etc.	Las Vegas Gamblers Limited Liability Company	The JPO issued an Office Action on the ground that no substantial relationship was found between the applicant, Las Vegas Gamblers Limited Liability Company, and the other person's name, "WILLIAM WALTERS." Subsequently, however, the applicant submitted a letter of consent from Mr. WILLIAM WALTERS and argued that he was one of the members of the applicant. As a result, the trademark was allowed to proceed to registration.

Action on the ground that the application fell within the scope of Article 4(1)(viii). However, because the applicant did not submit any response to the JPO, the application was ultimately refused.

The same issue also arose in the bottom example shown in the above table, "WILLIAM WALTERS." The JPO issued an Office Action on the ground that no substantial relationship existed between the applicant, "Las Vegas Gamblers Limited Liability Company," and "WILLIAM WALTERS." In response, however, the applicant submitted a letter of consent confirming that Mr. WILLIAM WALTERS had consented to the applicant's registration of the trademark in Japan. In its Written Opinion, the applicant also argued that Mr. WILLIAM WALTERS was one of the members of the applicant. As a result, the JPO accepted these arguments, and the trademark proceeded to registration.

As a result of the amendment, a new requirement has been introduced that another person's name must be widely recognized among consumers in the field of the goods or services in connection with which the trademark is used. Because relatively few individuals are likely to satisfy this level of recognition, this requirement will generally not present a significant obstacle to registration. By contrast, as illustrated in the above table, applicants should be aware that an application may still be refused unless they are able to adequately demonstrate the existence of a substantial relationship between themselves and the other person whose name is included in the trademark.

Requirements Prescribed by the Cabinet Order

The amendment represents a significant step forward from the perspective of brand protection by making it easier to obtain trademark registration in cases where a person's own name is used as a brand name. As discussed above, there are already examples of trademarks that had been refused registration before the amendment but were subsequently refiled and registered after the amendment.

Although the JPO has clarified its examination criteria and examination practice to a certain extent, disputes are likely to arise regarding the application of the new requirements in individual cases, including whether a name is "widely recognized among consumers in the field of the goods or services in connection with which the trademark is used," and whether the Cabinet Order requirements—namely, the existence of a substantial relationship and the absence of an improper purpose—have been satisfied.

It will therefore be necessary to await the accumulation of future appeal decisions and court decisions to see how these issues develop in practice.

Author

Koichiro Nakagawa

Trademark Attorney

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