

[2018] Update of Japanese Patent Act

1. Grace period is extended from 6 months to 12 months

The Patent Act has been revised, extending the grace period from 6 months to 12 months. The revised Patent Act applies to patent applications filed on or after June 9, 2018, and disclosures made on or after December 9, 2017. The same revision was also made to the Utility Model Act and the Design Act.

The revision only extends the term of the grace period, leaving other requirements unchanged. Accordingly, a petition is required at the time of filing a patent application, and a document to prove the disclosure should be submitted within 30 days from the filing date.

2. Discount of issue fees can be applied to all small entities

Currently, discount of official fees is applied to specified small entities, and a request for discount is required for every procedure (request for examination, issue fees or annuity fees). Under the newly added Article 109bis, discount of issue fees and annual fees (1st to 10th years) can be equally applied to all small entities without any certifications. A request for discount can be omitted after the small entity has been qualified to enjoy a discount. The effective date of Article 109bis will be determined later, but before May 31, 2019.

3. In-camera procedures are revised

Currently, Article 105 provides that the court may order a party to submit documents necessary to prove infringement or to calculate the damages caused by infringement, provided that the person in possession of the documents does not have a "legitimate reason" for refusing to submit them. If the court finds it is necessary to determine whether a party has a "legitimate reason" for refusing to submit them, the court may order the person in possession of the documents to present them to the parties or to their litigation representatives.

Under the revised Article 105, the above determination procedure can be applied to determine whether or not a party has a "legitimate reason" for demanding submission

of the documents as well. That is, if the court finds it necessary to determine whether a party has a "legitimate reason" for demanding submission of the documents, the court may order the person in possession of the documents to present them to aid in its determination. Moreover, when the court finds it necessary to hear opinions as to whether a party has a "legitimate reason", the court may disclose the documents to technical experts at the court. The effective date of the revised Article 105 is July 1, 2019.