

Major Amendments to the Japanese Patent Law (since 1985)

Date of enactment	Gist of Amendments	Transitional measures
1/11/1985	<p>1. Adoption of Internal Priority Internal priority may be claimed when filing a patent application in Japan if the application filed within 1 year from the previous Japanese application.</p> <p>2. Abolition of Certificate of Adding (追加特許)</p> <p>3. Other major amendments (1) An original application is deemed to be withdrawn after a conversion of the application (2) Residents abroad must proceed before the JPO through his patent administrator</p>	<p>Re: 1 Internal Priority may be claimed for all the patent applications pending as of 1/11/1985 onwards.</p> <p>Re: 2 Former patent law is applicable to 追加特許出願,追加特許権 pending as of the enactment date</p>
1/6/1988 except for the enactment date of ※1 and ※2. ※1: 1/6/1987 ※2: effective date of the declaration of withdrawal of PCT64(2)	<p>1. Abolition of an exclusion term to appeal an invalidation trial relating to a patent publicly known through foreign publications (Article 124)※1</p> <p>2. Adoption of multiple claim system, etc., This provision is adopted for the purpose of enhancing the protection of patents.</p> <p>(1) The same invention is allowed to be written in multiple claims. (2) An invalidation trial is possible to appeal or withdraw claim by claim,</p>	<p>Re: 1 Article 124(old provision) is still applicable to an appeal for invalidations relating to patents registered before 1/6/1987</p> <p>Re: 2 Applicable to patent applications filed on 1/6/1987 onwards</p>

	<p>and opposition is possible to appeal claim by claim</p> <p>(3) Requirements for a unity of invention is amended</p> <p>3. Other major amendments</p> <p>(1) A trial is allowed to withdraw until the trial is become final and exclusive※1</p> <p>(2) Deadline for submitting a priority certificate is amended※1</p> <p>(3) Term for filing an opposition is extended to three months from Second Pre-grant Publication</p> <p>(4) Introduction of Registration of Extension of Term(of Patent)</p> <p>(5) Introduction of Trial for Invalidation of Registration of Extension of Term</p> <p>(6) Deadline for entering Japanese National phase for PCT applications made in foreign language is provided same as that for PCT applications made in Japanese※2</p>	<p>Re: 3(3) Applicable to patent applications to be published(Kokoku) after the date of enactment</p> <p>Re: 3(4) Applicable to the patent applications unless its deadline for filing an application for the registration of extension of the term(Article 67bis Section 3) is before the date of enactment</p>
<p>1/12/1990 工業 所有権に関する 手続等の特例に 関する法律</p>	<p>Adoption of Electric Filing System Patent applications may be filed through terminals connectable to the JPO's mainframe computers.</p>	<p>Applicable to all the patent applications filed on 1/12/1990 onwards.</p>
<p>1/1/1994</p>	<p>1. Restriction of Amendments Amendments and corrections are restricted to those which do not include new matter.</p>	<p>Re: 1 ・ Old provisions remain to be applicable to all the patent applications or patents pending as of</p>

	<p>Therefore, amendments or correction adding new matter cause reasons for a decision of rejection or invalidation of patents.</p> <p>In response to this, Article 40 (if amendments are judged to have changed the gist after registration, the patent application relating to the amendments are deemed to have filed at the time of amendment) was deleted.</p> <p>2. Patentee is allowed to demand a correction of the patent in an invalidation trial.</p> <p>This provision is adopted for the purpose of acceleration of the process of a invalidation trial.</p> <p>Instead, an appeal of a trial for correction of patents is prohibited during an invalidation trial.</p> <p>3. Abolishment of Appeal against the Ruling to Dismiss an Amendment</p>	<p>the date of enactment until decisions or trial decisions for these applications or patents become final and exclusive.</p> <ul style="list-style-type: none">• An invalidation trial for the reason of the addition of new matter may be appealed to amendments of the patent applications which were submitted at JPO after the date of enactment.• A trial for invalidation of correction for a reason of the addition of new matter may be appealed to corrections of patents which were submitted at JPO after the date of enactment.• Applicable to invalidation trials which is appealed on 1/1/1994 onwards.• Former Article 40 is still applicable to patents which was amended before 1/1/1994 <p>Re:2 Applicable to invalidation trials which was appealed after the date of enactment.</p>
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	<p>for the purpose of the acceleration of an examination process.</p> <p>An applicant is allowed to state dissatisfaction against the ruling by demanding an appeal trial against a decision of final rejection within 30 days form the decision.</p> <p>4. Other major amendments</p> <p>(1) Abolishment of Trial for Invalidation of Correction</p> <p>(2) An amendment of claims is restricted to ones with purposes provided in Article 17bis Section 3. The violation of the article causes reasons of rejection.</p> <p>(3) Some non- exclusive licenses are amended along with the introduction of non-substantive examination system.</p>	<p>Re: 4(1)</p> <p>Old law remains to be applicable to corrections done in trials for correction which was been appealed before the date of enactment</p>
<p>1/7/1995</p>	<p>1. Relaxation of terms for amendments</p> <p>Amendments have become possible during the terms as follows:</p> <ul style="list-style-type: none"> • before receiving the First Office Action • within the term specified in the Second Office Action • within 30 days starting from the date the Appeal against Rejection is filed • any time after the patent is 	<p>Re: 1</p> <p>Applicable to all the applications filed on 1/7/1995 onwards</p>

	<p>granted</p> <p>Therefore, even one year and three months after a filing date, an amendment is possible to file unless a first Office Action is received.</p> <p>2. Adoption of English language filing to prevent filing a mistranslated specification</p> <p>Patent applications may be filed in English on the condition that a Japanese language translation is submitted within two months from filing date.</p> <p>3. Introduction of attack on the basis of mistranslation and possibility of rectification</p> <p>Relevant to introduction of English language filing, the law also provides applicants of foreign language filing and PCT applications for foreign language with a chance for rectification of mistranslations within the scope of the original specifications and drawings during the term in which amendments are allowed.</p> <p>However, for these patent applications, mistranslations can be a reason for Rejection, Opposition or Invalidation when the translation is deemed to be without the scope of the original specification filed at the filing date.</p> <p>4. Simplification of Patent Term</p> <p>The Term of validity of a patent is now 20 years from the filing date as long as maintenance fees are paid in a timely manner.</p>	<p>Re: 2</p> <p>Applicable to all the applications filed on 1/7/1995 onwards</p> <p>Re: 3</p> <p>Applicable to all the applications filed on 1/7/1995 onwards</p>
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	<p>Terms of some patents are prolonged by this new provision (for further details, see supplementary provision Article4 of the Law for amending the Patent Law).</p> <p>5. Relaxation of description requirements of specifications Applicants need to describe the purpose, effects, and constitutions of the inventions.</p> <p>6. Priority claim declared as governed by the Paris Convention</p> <p>7. 原子核変換の方法により製造されるべき物質 is deleted from unpatentable inventions</p> <p>8. Other major amendments</p> <p>(1) One of the meanings of "working" of an invention is amended to "offering" in order to enlarge the scope of patents.</p> <p>(2) Article 30 Section3 of the law ("Exceptions to lack of novelty of invention") is applicable to inventions which became publicly known in country parties of the</p>	<p>Re: 5 Applicable to all the applications filed on 1/7/1995 onwards</p> <p>Re: 6 Applicable to all the applications filed on 1/7/1995 onwards</p> <p>Re: 7 Patent applications which disclose inventions of 原子核変換の方法により製造されるべき物質 in the specifications or drawings is possible to amend within the six months from 1/7/1995. (See further Supplementary provision Art.3 of the Law for Amending the Patent Law.)</p>
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	<p>WTO.</p> <p>(3) Statements sitting forth the claims shall be clear and concise. Violation of the provision cause reasons for rejection or invalidation of patents.</p> <p>(4) Adoption of Article 70 relating to interpretation of the technical scope of patents.</p> <p>(5) Adoption of restoration of a patent right by payment of annual fee (Article 112bis) and restriction of patent right restored (Article 112ter)</p> <p>(6) Effects of amendments made in the international phase of PCT applications in foreign language, and examination provisions applicable to said applications:</p> <ul style="list-style-type: none"> • Effect of Amendment under Art 19 of the treaty : A translation of Amendment under the Article 19 of the PCT (including the amendment under Art.19 additionally submitted within the deadline for the submission of a national form paper or relevant time for the national processing) become effective as claims in the specification originally attached to the request form. • Effect of Amendment under Art 34 of the treaty: Translation of Amendment under Art 34 of the PCT become effective as a written correction of an incorrect translation under 	<p>Re:8(3) Applicable to all the applications filed on 1/7/1995 onwards</p> <p>Re:8(5) New provisions are not applicable to patents which is deemed to have vanished according to the former Article 112 Section 4 to 6.</p> <p>Re:8(6) Applicable to all the PCT applications in foreign language filed on 1/7/1995 onwards</p>
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	<p>Section 17bis(2)</p> <ul style="list-style-type: none"> • Adoption of Special provisions concerning reasons for refusal, correction, amendment: In principle, PCT applications in foreign language are treated in the same manner as English language filing concerning above matters. 	
<p>1/1/1996</p>	<p>1. Abolishment of Second pre-grant Publication (kokoku)</p> <p>A patent application will be granted patent unless reasons for rejection can be found by an examiner. Third party are provided chances to file an opposition to the patent after the patent is published.</p> <p>Relevant to this, the following amendments are made:</p> <ol style="list-style-type: none"> (1) Publication shall be published after the registration. (Article 29bis is also amended accordingly) (2) Amendments of specifications are allowed in principle until Grant of Patent. (3) Article 40 (Amendments made after kokoku is judged to be invalid after registration, the patent is deemed to be filed at the time of amendments) was deleted. <p>2. Adoption of Post-Grant Opposition</p> <p>Oppositions may be filed within six months from the publication of a patent. Examination procedure of Oppositions are ex-perte Procedure. Like invalidation trials, demand for</p>	<p>Re: 1</p> <p>Old law remain to be applicable to patents, trials and retrial relating to patent applications which is pending as of the date of enactment and was received Decision of Kokoku, or patent applications which had received the Decision before the date of enactment.</p> <p>Re: 1(1)</p> <p>Old law (29bis) remains to be applicable to a patent application filed before the date when all the publications for patent applications which had received Decisions of Kokoku before the date of enactment were finished.</p> <p>Re: 2</p> <p>Oppositions against patent relating to patent applications filed before 1/1/1988 can be withdrawn</p>

	<p>trial of correction is prohibited while the opposition is pending, and opposition can be filed and withdraw claim by claim.</p>	<p>invention by invention.</p>
<p>1/1/1999</p>	<p>1. Adoption of simplified damage calculation in patent infringement law suits for reduction of the burden of proof of a patentee</p> <p>The patentee is entitled to calculate the amount of damage by multiplying the number of products sold by the infringer with the profit per unit the patentee can expect for the product as far as the number of the products sold by the infringer does not exceed the patentee's capability of production.</p> <p>2. Other major amendments</p> <p>(1) Patent applications relating to the same inventions and having been filed on the same date are for the purpose of first-file rule still deemed to have been made even if examiner's or trial's decision of refusal has become final and conclusive(Article 36(5)). These Patent applications are to be published for preventing further patent applications of the same invention from others.</p>	<p>Re: 1</p> <p>Old provisions remain to be applicable to reasons for filing oppositions or invalidation trials against patents relating patent applications which were filed before the date of enactment.</p> <p>Re: 2</p> <p>Old provisions remain to be applicable to patent applications , trials or retrials pending as of the date of enactment until decisions concerning above become final and conclusive.</p>
<p>1/1/2000 except for the amendment ※1 ※1: effective date: /10/2001</p>	<p>1. Shortening term for requesting examination※1</p> <p>The term for requesting examination is shortened to 3 years from the filing date.</p> <p>Relevant to this, the terms for</p>	<p>Re: 1</p> <p>Applicable to all the patent applications having filing dates on or after 1/10/2001.</p> <p>Applicable to all the applications for utility model or design registrations</p>

	<p>conversion of applications (from an application for utility model registration or design registration into an patent application) are also amended accordingly.</p> <p>2. New provisions on infringement law suits Following provisions are newly added to the law for the reduction of burden of proof of patentee in lawsuits.</p> <p>(1) Obligation to clarify relevant act in concrete manner.</p> <p>(2) Production of documents. the Court may invite a party of a infringement lawsuit to present the party's possessing documents necessary for the proof of alleged infringements.</p> <p>(3) Expert opinion for proof of damage</p> <p>(4) Award of reasonable of damages</p> <p>3. Introduction of Request for laying open of applications This provision is made for an applicant who wishes to generate the right to demand compensation as fast as possible. Relevant to this, applicants of PCT Applications can also obtain the rights within 1 and a half year from the international filing date. (See relevant amendments of Article 184novies and 184decies described below in 6(2)).</p> <p>4. Loss of novelty of an invention Inventions which were publicly known in Japan or elsewhere, and publicly</p>	<p>having filing dates on or after 1/10/2001.</p> <p>Re: 2 New provisions are applicable to matters which had occurred before the date of enactment. However, the new provisions will not affect the legal effects which had become effective by old provisions.</p> <p>Re: 3 Applicable to all patent applications pending as of 1/1/2000</p> <p>Re: 4 Applicable to all patent applications</p>
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	<p>know over the internet prior to the filing of the patent application also lose the novelty.</p> <p>5. Abolishment of restrictions against the deadline for filing the extension of the term of a patent. Patentee can enjoy the extension of the patent term even if its term of non-working of the invention because of the delay of issuance of an administrative disposition referred to by the Cabinet order under Article 62(2) is less than two years. Relevant to this, for third party's interests, public announcements may be effected for some applications of the extension of the term of patent.</p> <p>6. Other major amendments</p> <p>(1) documents which shall be submitted with respect to a divisional patent application are deemed to have been submitted if these are already submitted with respect to the original patent application.</p> <p>(2) Amendments of provisions for PCT applications relevant to the introduction of Request for Laying Open of Applications</p> <ul style="list-style-type: none">• 184novies a national publication of the translation of PCT application of foreign language can be effected shortly after the request for examination has been made where	<p>pending as of 1/1/2000.</p> <p>Re: 5 Applicable to all applications for the extension of the term of a patent filed on and after 1/1/2000.</p> <p>Re: 6(1) New provision is also applicable to a divisional application which is deemed to have been filed at the filing date of the original application under Article 44 paragraph2.</p>
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	<p>the international publication under the Article 21 of the treaty has been effected (i.e., even before 1 and a half year from the priority date).</p> <ul style="list-style-type: none">• 184decies Rights to demand compensation for a PCT application of foreign language can be generated in Japan after the international publication has been effected (i.e., even before 1 and a half year from the priority date). <p>(3) Corporate body may apply for the reduction or deferment of payment of annual fees and request for examination fees or exemption therefrom</p>	<p>Re: 6(2): amendment of 184decies Applicable to the PCT applications of which an international application is effected after 1/1/2000. Regarding to the PCT Applications of which an international application is effected before 1/1/2000, see supplementary provision Article 2 paragraph 11 of the Law for Amending the Patent Law.</p>
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