

# Utility Model Act (Tentative translation)

(Act No. 123 of April 13, 1959)

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## Chapter I General Provisions

### (Purpose)

Article 1 The purpose of this Act is to encourage devices by promoting the protection and the utilization of devices with respect to the shape or structure of an article or to the combination of articles, and thereby to contribute to the development of industries.

### (Definitions)

Article 2 (1) "Device" in this Act shall refer to the creation of technical ideas utilizing the laws of nature.

(2) "Registered utility model" in this Act shall refer to a device for which a utility model registration has been granted.

(3) "Working" of a device in this Act shall refer to an act of manufacturing, using, assigning, leasing, exporting or importing, or offering for assignment or lease (including an act of displaying an article for the purpose of assignment or lease, the same shall apply hereinafter) an article relating to the device.

### (Amendment of procedures)

- Article 2-2 (1) Any person who undertook the procedures with respect to an application for utility model registration or a request for utility model registration or other procedures relating to utility model registration (hereinafter simply referred to as "procedures") may make an amendment thereto only where the case is pending before the Japan Patent Office; provided, however, that the person may not make an amendment to the description, the scope of claims for a utility model registration, drawing(s) or the abstract attached to the application or a document provided in Article 43, paragraph (1) of the Patent Act (Act No.121 of 1959) as applied mutatis mutandis pursuant to Article 8, paragraph (4) or Article 11, paragraph (1) (including the case where it is applied mutatis mutandis pursuant to Article 43-2, paragraph (2) as applied mutatis mutandis pursuant to Article 11, paragraph (1) (including the case where it is applied mutatis mutandis pursuant to Article 43-3, paragraph (3) of the said Act as applied mutatis mutandis pursuant to Article 11, paragraph (1)) and Article 43-3, paragraph 3 of the said Act) after a period specified by an Ordinance of the Ministry of Economy, Trade and Industry has lapsed.
- (2) Any amendment to the description, scope of claims for a utility model registration or drawings under the provisions of the main clause of paragraph (1) shall be made within the scope of matters stated in the description, scope of claims for a utility model registration or drawing(s) originally attached to the application.
- (3) Notwithstanding the provisions of paragraph (1), the corrected description, scope of claims for a utility model registration or drawing(s) attached to the written correction with respect to a correction referred to in Article 14-2, paragraph (1) may not be amended.
- (4) The Commissioner of the Patent Office may order the applicant to make an amendment of procedures, designating a reasonable period, in any of the following cases:
- (i) where the procedures violate the provisions of Articles 7, paragraphs (1) to (3) or Article 9 of the Patent Act as applied mutatis mutandis pursuant to Article 2-5, paragraph (2) of this Acts;
  - (ii) where the procedure violates the formal requirements specified by this Act or an order based thereon;
  - (iii) where registration fees payable for the procedures under the provisions of Article 32, paragraph (1) have not been paid;
  - (iv) where fees payable for the procedures under the provisions of Article 54, paragraph (1) or (2) have not been paid;
- (5) A written amendment, except in the case of the payment of registration fees or other fees, shall be submitted to make any amendment to procedures.

(Dismissal of procedures)

Article 2-3 The Commissioner of the Patent Office may dismiss the procedures where a person ordered to make an amendment thereto under the provisions of Article 2-2, paragraph (4), Article 6-2 or Article 14-3 fails to make such amendment within a period designated under the said provisions.

(Capacity of associations, etc. which are not juridical persons to undertake procedures)

Article 2-4 (1) An association or foundation which is not a juridical person but for which a representative or an administrator has been appointed may, in its name, undertake any of the following procedures:

(i) file a request for utility model technical opinion provided in Article 12, paragraph (1);

(ii) file a request for trial; or

(iii) file a request for retrial against the final and binding trial decision.

(2) An association or foundation which is not a juridical person but for which a representative or an administrator has been appointed may, in its name, receive a request for retrial against the final and binding trial decision.

(Application mutatis mutandis of the Patent Act)

Article 2-5 (1) The provisions of Articles 3 and 5 of the Patent Act shall apply mutatis mutandis to the periods and dates provided in this Act.

(2) The provisions of Articles 7 to 9, 11 to 16 and 18-2 to 24 of the Patent Act shall apply mutatis mutandis to procedures.

(3) The provisions of Article 25 of the Patent Act shall apply mutatis mutandis to utility model rights and other rights relating to utility model registrations.

(4) The provisions of Article 26 of the Patent Act shall apply mutatis mutandis to utility model registrations.

## **Chapter II Utility Model Registration and Applications for Utility Model Registration**

(Requirements for utility model registration)

Article 3 (1) A person who created a device that relates to the shape or structure of an article or a combination of articles and is industrially applicable may be entitled to obtain a utility model registration for the said device, except the following devices:

(i) the device was publicly known in Japan or a foreign country, prior to the filing of the application for utility model registration;

(ii) the device was publicly worked in Japan or a foreign country, prior to the filing of the application for utility model registration; or

(iii) the device described in a distributed publication, or a device that was made publicly available through electric telecommunication lines in Japan or a foreign country, prior to the filing of the application for utility model registration.

(2) Where, prior to the filing of the application for utility model registration, a person ordinarily skilled in the art of the device would have easily created the device based on any device listed in any of the items of the preceding paragraph, a utility model registration shall not be granted for such device notwithstanding the provisions of the preceding paragraph.

Article 3-2 Where a device claimed in an application for utility model registration is identical with a device or invention (in the case where a person who created the device or invention is identical with the creator of the device claimed in the said application for utility model registration, excluding the device or invention) stated in the description, scope of claims for a utility model registration or scope of claims for a patent or drawings (in the case of the written application in foreign language referred to in Article 36-2, paragraph (2) of the Patent Act, the document in foreign language referred to in Article 36-2, paragraph (1)) originally attached to the application of another application for utility model registration or for patent which has been filed prior to the filing date of the said application for utility model registration and published after the filing of the said application for utility model registration in the utility model gazette under the provisions of Article 14, paragraph (3) (hereinafter the "Utility Model Gazette") or in the patent gazette under the provisions of Article 66, paragraph (3) of the Patent Act stating matters listed in each of the items of the respective paragraph or for which the publication of the patent application has been effected, a utility model registration shall not be granted for such device notwithstanding the provisions of paragraph (1) of the preceding Article; provided, however, that this shall not apply where, at the time of the filing of the said application for utility model registration, the applicant of the said application and the applicant of the other application for utility model registration or for patent are the same person.

(Unregistrable devices)

Article 4 Notwithstanding the provisions of Article 3, paragraph (1), any device that is liable to injure public order, morality or public health shall not be registered as a utility model.

(Provisional non-exclusive licenses)

Article 4-2 (1) Any person who holds the right to obtain a utility model registration may grant a provisional non-exclusive license for the utility model

right to be obtained based on the right to obtain a utility model registration to any third party within the scope of the matters stated in the description, scope of claims for a utility model registration or drawings originally attached to the application of the application for the utility model registration.

- (2) Where the establishment of a utility model right has been registered for an application for utility model registration with respect to a provisional non-exclusive license under the provisions of the preceding paragraph, a non-exclusive license shall be deemed to have been granted for the utility model right to a person who holds the said provisional non-exclusive license within the scope specified by the contract granting the said provisional non-exclusive license.
- (3) The provisions of Article 33, paragraphs (2) and (3), Article 34-3, paragraphs (4) to (6) and (8) to (10) and Article 34-5 of the Patent Act shall apply mutatis mutandis to provisional non-exclusive licenses. In this case, the terms "Article 46, paragraph (1) with regard to an application for utility model registration pertaining to a provisional non-exclusive license under the provisions of Article 4-2, paragraph (1) of the Utility Model Act" in Article 34-3, paragraph (8) of the said act and "Article 46, paragraph (2)" in paragraph (9) of the said article shall be deemed to be replaced with "Article 10, paragraph (1) of the Utility Model Act with regard to a patent application pertaining to a provisional non-exclusive license under the provisions of Article 34-3, paragraph (1) or Article 34-2, paragraph (4)" and "Article 10, paragraph (2) of the Utility Model Act", respectively.

(Applications for Utility Model Registration)

- Article 5 (1) Any person who intends to obtain a utility model registration shall submit an application to the Commissioner of the Patent Office stating the following matters:
- (i) the name and address or residence of the applicant(s) of utility model registration; and
  - (ii) the name and address or residence of the creator(s) of the device.
- (2) The description, scope of claims for a utility model registration, drawing(s) and abstract shall be attached to the application.
- (3) The description referred to in the preceding paragraph shall state the following matters:
- (i) the title of the device;
  - (ii) a brief explanation of the drawing(s); and
  - (iii) a detailed explanation of the device.
- (4) The detailed explanation of the device referred to in item (iii) of the preceding paragraph shall be stated clearly and sufficiently so as to enable a person ordinarily skilled in the art to which the device belongs to work the device as

specified by an Ordinance of the Ministry of Economy, Trade and Industry.

- (5) The scope of claims for a utility model registration referred to in paragraph (2) shall divide claims and state for each claim all matters deemed to be necessary to identify the device for which the applicant intends to obtain a utility model registration. This shall not preclude the applicant from stating the same description for a device claimed in another claim as that for a device claimed in one claim.
- (6) The description of the scope of claims for a utility model registration referred to in paragraph (2) shall comply with each of the following items:
- (i) the device for which a utility model registration is sought is stated in the detailed explanation of the device;
  - (ii) the device for which a utility model is sought is clear;
  - (iii) the statement for each claim is concise; and
  - (iv) the description is stated as specified by an ordinance of the Ministry of Economy, Trade and Industry.
- (7) The abstract referred to in paragraph (2) shall state a summary of the device stated in the description, scope of claims for a utility model registration or drawing(s), and any other matters specified by an ordinance of the Ministry of Economy, Trade and Industry.

Article 6 A single application for utility model registration may be filed for two or more devices provided that these devices fall under a group of devices recognized as fulfilling the requirements of unity of device based on their technical relationship specified by an Ordinance of the Ministry of Economy, Trade and Industry.

(Order to amend)

Article 6-2 The Commissioner of the Patent Office may order the applicant to make an amendment to the description, scope of claims for a utility model registration or drawing(s) attached to the application, designating a reasonable period, if the application for utility model registration falls under any of the following items:

- (i) where the device claimed in the application for utility model registration does not pertain to the shape or structure of an article or the combination of articles;
- (ii) where the device claimed in the application for utility model registration is not registrable under the provisions of Article 4;
- (iii) where the application for utility model registration does not satisfy the requirement provided in Article 5, paragraph (6), item (iv) or in the preceding Article; or
- (iv) where the description, scope of claims for a utility model registration or

drawing(s) attached to the application does not state all of the necessary matters or is extremely unclear.

(Prior Application)

Article 7 (1) Where two or more applications for a utility model registration have been filed with regard to the same device on different dates, only the applicant who filed the application on the earliest date shall be entitled to obtain a utility model registration for the device claimed.

(2) Where two or more applications for utility model registration have been filed with regard to the same device on the same date, none of the applicants shall be entitled to obtain a utility model registration for the device claimed.

(3) Where a device claimed in an application for utility model registration and an invention claimed in an application for patent are identical and the applications for utility model registration and for patent are filed on different dates, the applicant for utility model registration may be entitled to obtain a utility model registration for the device claimed therein, only if the application for utility model registration is filed prior to the application for patent.

(4) Where an application for utility model registration or an application for patent has been waived, withdrawn or dismissed, the application for utility model registration or the application for patent shall, for the purpose of paragraphs (1) to (3), be deemed never to have been filed from the beginning.

(5) Where the examiner's decision or trial decision to the effect that a patent application is to be refused has become final and binding, the patent application shall, for the purpose of paragraph (3), be deemed never to have been filed from the beginning; provided, however, that this shall not apply to the case where the examiner's decision or trial decision to the effect that the patent application is to be refused has become final and binding on the ground that the latter sentence of Article 39, paragraph (2) of the Patent Act is applicable to the said patent application.

(6) Where no agreement is reached by consultations made under Article 39, paragraph (4) of the Patent Act or such consultations are unable to be held, the applicant for utility model registration shall not be entitled to obtain a utility model registration for the device claimed.

(Claim of priority based on an application for utility registration, etc.)

Article 8 (1) A person who intends to obtain a utility model registration may claim priority for a device claimed in the application for utility model registration, based on a device stated in the description or scope of claims for a utility model registration or patent claim, or drawings (in the case where the earlier application was a written application in foreign language referred to in Article 36-2, paragraph (2) of the Patent Act, the document in foreign language

referred to in paragraph (1) of the said Article) originally attached to the application of an earlier application filed for a utility model registration or patent over which the said person holds the right to obtain (hereinafter referred to as "earlier application"), except in the following cases: provided however, that if there is any person who holds a provisional exclusive license with regard to the earlier application, priority may be claimed only where the consent of the person is obtained at the time of filing the said application for utility model registration:

- (i) where the said application for utility model registration is not filed within one year from the date of filing of the earlier application (excluding the case where there are justifiable grounds for the failure to file the application for utility model registration within 1 year from the date of filing and it was filed within a period specified by an ordinance of the Ministry of Economy, Trade and Industry);
  - (ii) where the earlier application is a new divisional application for utility model registration with respect to an application for utility model registration under the provisions of Article 44, paragraph (1) of the Patent Act as applied mutatis mutandis pursuant to Article 11, paragraph (1), an application for utility model registration with respect to an application for utility model registration under Article 10, paragraph (1) or (2), or a new divisional patent application with respect to a patent application under Article 44, paragraph (1) of the Patent Act, a patent application with respect to a patent application under Article 46, paragraph (1) or (2) of the Patent Act or a patent application based on a utility model registration under the provisions of Article 46-2, paragraph (1) of the Patent Act;
  - (iii) where, at the time of filing the said application for utility model registration, the earlier application had been waived, withdrawn or dismissed;
  - (iv) where, at the time of filing the said application for utility model registration, the examiner's decision or the trial decision on the earlier application had become final and binding; and
  - (v) where, at the time of filing the said application for utility model registration, the establishing of a utility model right provided in Article 14, paragraph (2) had been registered with regard to the earlier application.
- (2) Among devices claimed in an application for utility model registration containing a claim of priority under the provisions of paragraph (1), for those that are stated in the description, scope of claims for a utility model registration or patent or drawings (in the case where the earlier application was an application written in foreign language referred to in Article 36-2, paragraph (2) of the Patent Act, the document in foreign language referred to in paragraph (1) of the said Article) originally attached to the application of

the earlier application on which the claim of priority is based (in the case where the earlier application contains a claim of priority under the provisions of the preceding paragraph or Article 41, paragraph (1) of the Patent Act (including the case where it is applied mutatis mutandis pursuant to Article 43-3, paragraph (3) of the said Act), or Article 43, paragraph (1) or 43-2, paragraph (1) or (2) of the Patent Act (including the case where these provisions apply mutatis mutandis pursuant to Article 11, paragraph (1) of said Act), excluding any device stated in any documents (limited to those equivalent to the description, scope of claims for a utility model registration or patent or drawings) submitted at the time of the filing of the application on which the claim of priority in the earlier application is based), the said application for utility model registration shall be deemed to have been filed at the time when the earlier application was filed with respect to the application of the provisions of Article 3, the main clause of Article 3-2, Article 7, paragraphs (1) to (3), Article 30, paragraphs (1) and (2) of the Patent Act as applied mutatis mutandis pursuant to Article 11, paragraph (1), Article 17, Articles 69, paragraph (2), item (ii) as applied mutatis mutandis pursuant to Article 26, Articles 79 and 81, Article 82, paragraph (1), and Articles 39, paragraphs (3) and (4) and Article 72 of the Patent Act, Article 26, Article 31, paragraph (2) and Article 32, paragraph (2) of the Design Act (Act No. 125 of 1959), Article 29, Article 33-2, paragraph (3) and Article 33-3, paragraph (3) of the Trademark Act (Act No. 127 of 1959) (including the case where these provisions apply mutatis mutandis pursuant to Article 68, paragraph (3) of the Trademark Act) of the Trademark Act.

- (3) Among devices stated in the description, scope of claims for a utility model registration or drawings originally attached to the application in an application for utility model registration containing a claim of priority under the provisions of paragraph (1), for those that are stated in the description, scope of claims for a utility model registration or claims or drawings (in the case where the earlier application was an application written in foreign language referred to in Article 36-2, paragraph (2) of the Patent Act, the document in foreign language referred to in paragraph (1) of the said Article) originally attached to the application of the earlier application on which the claim of priority is based (in the case where the said earlier application contains a claim of priority under the provisions of the preceding paragraph or Article 41, paragraph (1) of the Patent Act, Article 43-2, paragraph 1 (including the case where it is applied mutatis mutandis pursuant to Article 43-3, paragraph (3) of the said Act) or Article 43-3, paragraph (1) or (2) of the Patent Act (including the case where these provisions apply mutatis mutandis under Article 11, paragraph (1) of this Act), excluding any device stated in any documents (limited to those equivalent to the description, scope of claims for a utility

model registration or patent or drawings) submitted at the time of the filing of the application on which the claim of priority in the earlier application is based), the Utility Model Gazette with regard to the earlier application or the publication of the earlier application shall be deemed to have been issued or effected at the time when the Utility Model Gazette with regard to the said application for utility model registration was issued so as to apply the provisions of the main clause of Article 3-2 of the Utility Model Act or Article 29-2 of the Patent Act.

- (4) A person who intends to claim a priority under the provisions of paragraph (1) shall submit to the Commissioner of the Patent Office a document stating the effect thereof and the indication of the earlier application within a period specified by an ordinance of the Ministry of Economy, Trade and Industry.

(Withdrawal of earlier application, etc.)

Article 9 (1) An earlier application on which a claim of priority is based under the provisions of Article 8, paragraph (1) shall be deemed to have been withdrawn when a period specified by an ordinance of the Ministry of Economy, Trade and Industry has lapsed from the filing date of the said earlier application; provided, however, that this shall not apply to the case where an earlier application has been waived, withdrawn or dismissed, where the examiner's decision or trial decision on the said earlier application has become final and binding with regard to the said application, where the establishment of the said earlier application provided in Article 14, paragraph (2) has been registered or where all of the claims of priority based on the said earlier application have been withdrawn.

- (2) The applicant for utility model registration containing a claim of priority under the provisions of Article 8, paragraph (1) may not withdraw the claim of priority after a period specified by an ordinance of the Ministry of Economy, Trade and Industry has lapsed from the filing date of the earlier application.

- (3) Where an application for utility model registration containing a claim of priority under the provisions of Article 8, paragraph (1) is withdrawn within a period specified by an ordinance of the Ministry of Economy, Trade and Industry from the filing date of the earlier application, the said claim of priority shall be deemed to have been withdrawn simultaneously.

(Conversion of application)

Article 10 (1) An applicant for patent may convert his/her patent application (excluding patent applications filed based on a utility model registration under the provisions of Article 46-2, paragraph (1) of the Patent Act (including patent applications deemed to have been filed at the time of the filing of the original patent application under the provisions of Article 44, paragraph (2) of the said

- Act (including the case where it is applied mutatis mutandis pursuant to Article 46, paragraph (6) of the said Act))) into an application for utility model registration; provided, however, that this shall not apply after three months from the date on which the certified copy of the examiner's initial decision to the effect that the patent application is to be refused was served or nine years and six months from the filing date of the patent application have lapsed.
- (2) An applicant for design registration may convert his/her application for design registration (excluding applications for a design registration deemed, under the provisions of Article 10-2, paragraph (2) of the Design Act as applied mutatis mutandis pursuant to Article 13, paragraph (6) of the Design Act, to have been filed at the time of the original patent application which was filed based on an application for utility model registration under the provisions of Article 46-2, paragraph (1) of the Patent Act (including applications for design registration deemed to have been filed at the time of the filing of the original application for design registration under the provisions of Article 10-2, paragraph (2) of the Design Act)) into an application for utility model registration; provided, however, that this shall not apply after three months from the date the certified copy of the examiner's initial decision to the effect that the application for design registration is to be refused has been served or nine years and six months from the filing date of the application for design registration have lapsed.
- (3) Where an application is converted under the provisions of the preceding two paragraphs, the application for utility model registration shall be deemed to have been filed at the time of the filing of the patent application or the application for design registration; provided, however, that this shall not apply for the purposes of the application of the provisions of Article 3-2 of this Act or Article 29-2 of the Patent Act where the application for utility model registration falls under another application for utility model registration provided in Article 3-2 of this Act or an application for utility model registration provided in Article 29-2 of the Patent Act, and the application of the provisions of Article 30, paragraph (3) of the Patent Act as applied mutatis mutandis pursuant to Article 11, paragraph (1).
- (4) Where an application is converted under the provisions of paragraph (1) or (2), for the purpose of the application of the provisions of Article 43, paragraph (2) of the Patent Act as applied mutatis mutandis pursuant to Article 11, paragraph (1) (including the case where it is applied mutatis mutandis under Article 43-2, paragraph (2) of the Patent Act as applied mutatis mutandis pursuant to Article 11, paragraph (1) (including the case where it is applied mutatis mutandis pursuant to Article 43-3, paragraph (3) of the said Act as applied mutatis mutandis pursuant to Article 11, paragraph (1)) and Article 43-3, paragraph (3)), the term "within one year and four months from the

earliest of the following dates" in Article 43, paragraph (2) shall be replaced with "within one year and four months from the earliest of the following dates or three months from the filing date of the application for utility model registration with respect to the conversion of an application under the provisions of Article 10, paragraph (1) or (2) of the Utility Model Act, whichever comes later."

- (5) Where an application is converted under the provisions of paragraph (1) or (2), the patent application or the application for design registration shall be deemed to have been withdrawn.
- (6) Where the period provided in Article 121, paragraph (1) of the Patent Act is extended under the provisions of Article 4 of the said Act, the three-month period provided in the proviso to paragraph (1) shall be deemed to have been extended only for that extended period.
- (7) Where the period provided in Article 46, paragraph (1) of the Design Act is extended under the provisions of Article 4 of the Patent Act as applied mutatis mutandis pursuant to Article 68, paragraph (1) of the Design Act, the three-month period provided in the proviso to paragraph (2) shall be deemed to have been extended only for that extended period.
- (8) Where an application is converted as provided in paragraph (1), any statements or documents which have been submitted with regard to the original patent application and are required to be submitted with regard to a new application for utility model registration under the provisions of Article 8, paragraph (4) of this Act or Article 30, paragraph (3) or Article 43, paragraphs (1) and (2) of the Patent Act as applied mutatis mutandis pursuant to Article 11, paragraph (1) (including the case where these provisions apply mutatis mutandis pursuant to Article 43-2, paragraph (2) of the Patent Act as applied mutatis mutandis pursuant to Article 11, paragraph (1) (including the case where it is applied mutatis mutandis pursuant to Article 43-3, paragraph 3 of the Patent Act as applied mutatis mutandis pursuant to Article 11, paragraph 1) and Article 43-3, paragraph 3) shall be deemed to have been submitted to the Commissioner of the Patent Office simultaneously along with the new application for utility model application.
- (9) An applicant for patent, where there is a person who holds a provisional exclusive license to the said patent application, may convert the patent application pursuant to the provisions of paragraph (1), only in the case where the consent of the said person is obtained.
- (10) The provisions of paragraph (8) shall apply mutatis mutandis to the conversion of an application under the provisions of paragraph (2).

(Application mutatis mutandis of the Patent Act)

Article 11 (1) The provisions of Articles 30 (exception to lack of novelty of

- invention), 38 (joint applications) and 43 to 44 (procedures for claim of priority under the Paris Convention and division of patent applications) of the Patent Act shall apply mutatis mutandis to applications for utility model registration.
- (2) The provisions of Article 33 and Article 34, paragraphs (1), (2) and (4) to (7) (right to obtain a patent) of the Patent Act shall apply mutatis mutandis to the right to obtain a utility model registration.
- (3) The provisions of Article 35 (excluding the part with respect to provisional exclusive licenses) (Employee's Invention) of the Patent Act shall apply mutatis mutandis to devices created by employees, officers of juridical persons, or national or local public officers.

### **Chapter III Utility Model Technical Opinion**

(Request for utility model technical opinion)

- Article 12 (1) With regard to an application for utility model registration or a utility model registration, any person may file with the Commissioner of the Patent Office a request for technical opinion as to the device claimed in the application or to the registered utility model in the light of the provisions of Article 3, paragraph (1), item (iii) and Article 3, paragraph (2) (limited to its application based on the device stated in Article 3, paragraph (1), item (iii)), Article 3-2, and Article 7, paragraphs (1) to (3) and (6) (hereinafter referred to as "utility model technical opinion"). In this case, in respect of applications or registered utility models that contain two or more claims, such a request may be filed for each claim.
- (2) A request under the provisions of the preceding paragraph may be filed even after the utility model right is extinguished; provided, however, that this shall not apply after the utility model right has been invalidated in an invalidation trial of utility model registration.
- (3) Notwithstanding the preceding two paragraphs, a request under the provisions of paragraph (1) shall not be made after a patent application based on the utility model registration is filed under the provisions of Article 46-2, paragraph (1) of the Patent Act.
- (4) Where a request under the provisions of paragraph (1) is filed, the Commissioner of the Patent Office shall direct an examiner to prepare a written report containing utility model technical opinion (hereinafter referred to as a "Technical Report of Utility Model Expert Opinion").
- (5) The provisions of Article 47, paragraph (2) of the Patent Act shall apply mutatis mutandis to the preparation of the Technical Reports of Expert Opinion on Registrability of Utility Models.
- (6) A request under the provisions of paragraph (1) may not be withdrawn.
- (7) Where, a request under the provisions of paragraph (1) was filed by a person

who is neither the applicant for utility model registration nor the holder of utility model right, and then, a patent application under the provisions of Article 46-2, paragraph (1) of the Patent Act is filed based on the utility model registration with respect to which the request under the provisions of paragraph (1) was filed (including the utility model registration with respect to the application for utility model registration in the case where a request under the provisions of paragraph (1) was filed with regard thereto), the request shall be deemed not to have been filed. In this case, the Commissioner of the Patent Office shall notify thereof to the person who filed the request.

Article 13 (1) When a request for utility model technical opinion is filed prior to issuance of the utility model gazette, the Commissioner of the Patent Office shall publish the effect thereof in the utility model gazette either at the time of issuance of the said utility model gazette or thereafter without delay, and when such a request is filed after issuance of the utility model gazette, without delay after issuance of the utility model gazette.

(2) Where a request for utility model technical opinion is filed by a person who is neither the applicant for utility model registration nor the holder of utility model right, the Commissioner of the Patent Office shall notify the applicant for utility model registration or the holder of utility model right thereof.

(3) Where the Technical Reports of Expert Opinion on Registrability of Utility Models is prepared, the Commissioner of the Patent Office shall serve its certified copy, in the case where the person who filed the request is either the applicant for utility model registration or the holder of utility model right, to the person, and in the case where the person who filed the request is neither the applicant for utility model registration nor the holder of utility model right, to the person and the applicant or the holder.

## **Chapter IV Utility Model Rights**

### **Section 1 Utility Model Rights**

(Registration of establishment of utility model right)

Article 14 (1) A utility model right shall become effective upon registration of its establishment.

(2) Where an application for utility model registration has been filed, the establishment of a utility model right shall be registered, unless the application has been waived, withdrawn or dismissed.

(3) Where the registration referred to in the preceding paragraph has been effected, the following matters shall be stated in a utility model gazette.

- (i) the name and the address or residence of the holder(s) of utility model right;
- (ii) the number and the filing date of the application for utility model

- registration;
- (iii) the name and the address or residence of the creator(s) of the device;
  - (iv) the matters stated in the description and scope of claims for a utility model registration attached to the application and the contents of the drawings attached to the said application;
  - (v) the matters stated in the abstract attached to the application;
  - (vi) the registration number and the date of registration of establishment; and
  - (vii) other necessary matters in addition to what is listed in the preceding items.
- (4) The provisions of Article 64, paragraph (3) of the Patent Act shall apply mutatis mutandis where the matters stated in the abstract referred to in item (v) of the preceding paragraph are published in the utility model gazette under the provisions of the preceding paragraph.

(Correction of the description, scope of claims for a utility model registration or drawings)

Article 14-2 (1) Except in the following cases, a holder of utility model right may correct the description, scope of claims for a utility model registration or drawings attached to the application only once.

- (i) where two months have lapsed from the date on which the first Technical Reports of Expert Opinion on Registrability of Utility Models was served under the provisions of Article 13, paragraph (3); and
  - (ii) where the period initially designated under the provisions of Article 39, paragraph (1) for an invalidation trial of utility model registration has lapsed.
- (2) Any correction made under the preceding paragraph shall be limited to those for the following purposes:
- (i) restriction of the scope of claims;
  - (ii) correction of errors;
  - (iii) clarification of an ambiguous statement; and
  - (iv) rewriting the statement of claims which cite the statement of another claim in a way it does not cite the statement of the said another claim.
- (3) Any correction referred to in paragraph (1) shall be made within the scope of the matters stated in the description, scope of claims for a utility model registration or drawings attached to the application (in the case of any correction for the purpose of item (ii) of the preceding paragraph, the description, scope of claims for a utility model registration or drawings originally attached to the application).
- (4) Any correction referred to in paragraph (1) shall not substantially enlarge or alter the scope of claims for a utility model registration.
- (5) The provisions of Article 4 of the Patent Act shall apply mutatis mutandis to

- the period provided in paragraph (1), item (i).
- (6) Notwithstanding the provisions of item (i) of paragraph (1), where, due to reasons beyond the control of the person who makes a correction referred to in paragraph (1), the person is unable to make the correction within the period provided in the said item, the person may make the correction within 14 days (where the applicant is an overseas resident, within two months) from the date on which the reasons ceased to exist, but not later than six months after the said period lapsed.
- (7) In addition to the case where any correction referred to in paragraph (1) is made, a holder of utility model right may correct the description, scope of claims for a utility model registration or drawings attached to the application as far as such a correction is made for the purpose of deleting a claim or claims; provided, however, that where an invalidation trial of the utility model registration is pending before the Japan Patent Office, the description, scope of claims for a utility model registration or drawings attached to the application may not be corrected after a notice is given under the provisions of Article 156, paragraph (1) of the Patent Act as applied *mutatis mutandis* pursuant to Article 41 (in the case where the proceedings have been resumed under the provisions of Article 156, paragraph (3) of the Patent Act, after further notice is given under the provisions of Article 156, paragraph (1) of the Patent Act).
- (8) Any correction referred to in paragraph (1) or (7) may be made even after a utility model right is extinguished; provided, however, that this shall not apply after the utility model registration has been invalidated in a invalidation trial of the utility model registration.
- (9) For any correction referred to in paragraph (1) or (7), a written correction shall be submitted.
- (10) For any correction referred to in paragraph (1), the corrected description, scope of claims for a utility model registration or drawings shall be attached to the written correction.
- (11) Where any correction has been made under paragraph (1) or (7), the filing of the application for utility model registration and the registration of establishment of the utility model right shall be deemed to have been made based on the corrected description, scope of claims for the utility model registration or drawings.
- (12) Where any correction has been made under paragraph (1) or (7), the matters stated in the corrected description and scope of claims for a utility model registration and the contents of the corrected drawings shall be published in the utility model gazette in the case of any correction made under paragraph (1), and the effect thereof shall be published in the utility model gazette in the case of any correction made under paragraph (7).
- (13) The provisions of Article 127 and Article 132, paragraph (3) of the Patent

Act shall apply mutatis mutandis to the cases of paragraphs (1) and (7).

(Order to amend with respect to correction)

Article 14-3 Where a written correction (limited to a correction referred to paragraph (1) of the preceding Article) has been submitted and any matter stated in the corrected description, scope of claims for a utility model registration or drawings attached to the written correction falls under any of the following items, the Commissioner of the Patent Office may order to make an amendment of the corrected description, scope of claims for a utility model registration or drawings attached to the written correction, designating a reasonable period:

- (i) where the device identified by the matters stated in the corrected scope of claims for a utility model registration attached to the written correction does not pertain to the shape or structure of an article or combination of articles;
- (ii) where the device identified by the matters stated in the corrected scope of claims for a utility model registration attached to the written correction is not registrable as a utility model under the provisions of Article 4;
- (iii) where the statement of the corrected description, scope of claims for a utility model registration or drawings attached to the written correction does not satisfy the requirement provided in Article 5, paragraph (6), item (iv) or Article 6; or
- (iv) where the corrected description, scope of claims for a utility model registration or drawings attached to the written correction does not state all the necessary matters or is extremely unclear.

(Duration of utility model right)

Article 15 The duration of a utility model right shall expire after ten years from the filing date of the application for utility model registration lapse.

(Effect of utility model right)

Article 16 A holder of utility model right shall have the exclusive right to work the registered utility model as a business; provided, however, that, where an exclusive license with regard to the utility model right is established, this shall not apply to the extent that the exclusive licensee is permitted to exclusively work the registered utility model.

(Relationship with registered utility model held by others)

Article 17 Where a registered utility model uses another person's registered utility model, patented invention, or registered design or any design similar thereto for which an application was filed prior to the filing date of the application for utility model registration, or where the utility model right is in

conflict with another person's design right or trademark right with respect to an application filed prior to the filing date of the application for utility model registration, the holder of utility model right, exclusive licensee or non-exclusive licensees may not work the registered utility model as a business.

(Special provisions for transfer of utility model right)

- Article 17-2 (1) Where a utility model registration falls under the requirements provided in Article 37, paragraph (1), item (ii) (limited to the case where the utility model registration is obtained in violation of the provisions of Article 38 of the Patent Act as applied *mutatis mutandis* pursuant to Article 11, paragraph (1)) or the requirements provided in Article 37, paragraph (1), item (v), a person who holds the right to obtain a utility model registration with regard to the device to which the said utility model registration pertain may request the holder of the utility model right to transfer the right as specified by an ordinance of the Ministry of Economy, Trade and Industry.
- (2) Where the transfer of a utility model right has been registered based on a request made under the provisions of the preceding paragraph, the utility model right shall be deemed to have belonged to a person who has obtained the said registration from the beginning.
- (3) The provisions of Article 73, paragraph (1) of the Patent Act as applied *mutatis mutandis* pursuant to Article 26 shall not apply where the share of a jointly owned utility model right is transferred based on a request made under the provisions of paragraph (1).

(Exclusive license)

- Article 18 (1) A holder of utility model right may establish an exclusive license for his/her utility model right.
- (2) An exclusive licensee shall hold an exclusive right to work the registered utility model as a business within the scope specified by the act of establishing the license.
- (3) The provisions of Articles 77, paragraphs (3) to (5) (transfer, etc.), Article 97, paragraph (2) (waiver) and Article 98, paragraph (1), item (ii) and paragraph (2) (effect of registration) of the Patent Act shall apply *mutatis mutandis* to exclusive licenses.

(Non-exclusive license)

- Article 19 (1) A holder of utility model right may grant a non-exclusive license for his/her utility model to any third party.
- (2) A non-exclusive licensee shall hold a right to work the registered utility model as a business within the scope specified by the provisions of this Act or by the act of establishing the license.

(3) The provisions of Articles 73, paragraph (1) (joint ownership), Article 97, paragraph (3) (waiver) and Article 99 (perfection of non-exclusive license) of the Patent Act shall apply mutatis mutandis to non-exclusive licenses.

(Non-exclusive license due to the working prior to the registration of the request for invalidation trial)

Article 20 (1) A person who falls under any of the following items and is conducting a business working an invention in Japan or is making preparations for such a business, before the registration of a request for invalidation trial for patent referred to in Article 123, paragraph (1) of the Patent Act (hereinafter in this paragraph simply referred to as "invalidation trial for patent"), without the knowledge that the patent falls under the requirements provided in any of the items of Article 123, paragraph (1) of the Patent Act, shall hold a non-exclusive license with regard to the utility model right or the exclusive license existing at the time of the invalidation of the patent, but only within the scope of the invention and the purpose of such a business being worked or prepared:

- (i) the original patentee in the case where a device to which a utility model registration has been granted and his/her patented invention are identical and his/her patent has been invalidated;
- (ii) the original patentee in the case where, after his/her patent has been invalidated, a utility model registration is granted to the person who is legitimately entitled to obtain a utility model registration for a device which is identical to his/her invention; and
- (iii) in the cases referred to in items (i) and (ii), a person who, at the time of the registration of the request for invalidation trial for patent, held an exclusive license with respect to the patent with respect to the invalidated patent, or a non-exclusive license with regard to the patent right or exclusive license.

(2) A holder of utility model right or an exclusive licensee shall have the right to receive reasonable compensation from the non-exclusive licensee under the provisions of the preceding paragraph.

(Ruling establishing non-exclusive license where registered utility model is not worked)

Article 21 (1) Where a registered utility model is not appropriately and continuously worked for three years or longer in Japan, a person who intends to work the registered utility model may request the holder of utility model right or the exclusive licensee to hold consultations to discuss the granting of a non-exclusive license; provided, however, that this shall not apply unless four years have lapsed from the filing date of the application of the utility model

registration on the registered utility model.

- (2) Where no agreement is reached by consultations or no consultations are able to be held as referred to in the preceding paragraph, a person who intends to work the registered utility model may request the Commissioner of the Patent Office for a ruling.
- (3) The provisions of Articles 84 to 91-2 (procedures, etc. for ruling) of the Patent Act shall apply mutatis mutandis to the ruling referred to in the preceding paragraph.

(Ruling establishing non-exclusive license to work own registered utility model)

Article 22 (1) Where a registered utility model falls under any of the cases provided in Article 17, the holder of utility model right or the exclusive licensee may request the other person referred to in the said Article to hold consultations to discuss the granting of a non-exclusive license to work the registered utility model or a non-exclusive license with regard to the patent right or the design right.

- (2) The other person referred to in Article 17 who is requested to hold consultations referred to in the preceding paragraph may request the holder of utility model right or the exclusive licensee who requested such consultations to hold consultations to discuss the granting of a non-exclusive license within the scope of the registered utility model which the said holder or exclusive licensee intends to work upon grant of a non-exclusive license with regard to the utility model right, the patent right or the design right granted through consultations.
- (3) Where no agreement is reached by consultations or no consultations are able to be held as referred to in paragraph (1), the holder of utility model right or the exclusive licensee may request the Commissioner of the Patent Office for a ruling.
- (4) Where no agreement is reached by consultations or no consultations are able to be held as referred to in paragraph (2) and where a request for ruling is filed as referred to in the preceding paragraph, the other person referred to in Article 17 may request the Commissioner of the Patent Office for a ruling only within a period for the submission of a written reply by the said other person designated by the Commissioner of the Patent Office under the provisions of Article 84 of the Patent Act as applied mutatis mutandis pursuant to paragraph (7).
- (5) In the case of paragraph (3) or (4), the Commissioner of the Patent Office shall not render a ruling to the effect that a non-exclusive license is to be established where the establishment of the non-exclusive license will be unreasonably prejudicial to the interests of the other person referred to in

Article 17, the holder of utility model right or the exclusive licensee.

- (6) In the case of paragraph (4), in addition to the case provided in the preceding paragraph, the Commissioner of the Patent Office shall not render a ruling ordering a non-exclusive license to be established if the ruling ordering the non-exclusive license to be established is not rendered with respect to the request for ruling referred to in paragraph (3).
- (7) The provisions of Articles 84, 84-2, Article 85, paragraph (1) and Articles 86 to 91-2 (procedures, etc. for ruling) of the Patent Act shall apply *mutatis mutandis* to the ruling referred to in paragraph (3).

(Ruling granting non-exclusive license for public interest)

- Article 23 (1) Where the working of a registered utility model is particularly necessary for the public interest, a person who intends to work the registered utility model may request the holder of utility model right or the exclusive licensee to hold consultations to discuss the granting of a non-exclusive license.
- (2) Where no agreement is reached by consultations or no consultations are able to be held as provided in the preceding paragraph, the person who intends to work the registered utility model may request the Minister of Economy, Trade and Industry for a ruling.
- (3) The provisions of Articles 84, 84-2, Article 85, paragraph (1) and Articles 86 to 91-2 (procedures, etc. for ruling) of the Patent Act shall apply *mutatis mutandis* to the ruling referred to in the preceding paragraph.

(Transfer of non-exclusive license)

- Article 24 (1) Except for a non-exclusive license granted by a ruling referred to in Article 21, paragraph (2), Article 22, paragraph (3) or (4), or Article 23, paragraph (2), Article 92, paragraph (3) of the Patent Act or Article 33, paragraph (3) of the Design Act, a non-exclusive license may be transferred only where the business involving the working of the relevant registered utility model is also transferred, where the consent of the holder of utility model right (or, in the case of a non-exclusive license with regard to the exclusive license, the holder of utility model right and the exclusive licensee) is obtained or where the transfer occurs as a result of inheritance or another type of general succession.
- (2) Except for a non-exclusive license granted by a ruling referred to in Article 21, paragraph (2), Article 22, paragraph (3) or (4), or Article 23, paragraph (2), Article 92, paragraph (3) of the Patent Act or Article 33, paragraph (3) of the Design Act, a non-exclusive licensee may establish a right of pledge with regard to the non-exclusive right only where the consent of the holder of utility model right (or, in the case of a non-exclusive license on the exclusive license, the holder of utility model right and the exclusive licensee) is obtained.

- (3) A non-exclusive license granted by a ruling referred to in Article 21, paragraph (2) or Article 23, paragraph (2) may be transferred only where the business involved in the working of the relevant registered utility model is also transferred.
- (4) Where a non-exclusive license is granted by a ruling referred to in Article 22, paragraph (3) of this Act, Article 92, paragraph (3) of the Patent Act, or Article 33, paragraph (3) of the Design Act, the said non-exclusive license shall be transferred together with the utility model right, patent right or design right of the non-exclusive licensee where the business involved in the working of the relevant registered utility model is also transferred, but shall be extinguished in the case where the utility model right, patent right or design right of the said non-exclusive licensee is extinguished or transferred independently of the said business.
- (5) A non-exclusive license granted by a ruling referred to in Article 22, paragraph (4) shall be transferred together with the utility model right, patent right or design right of the non-exclusive licensee, but shall be extinguished in the case where the said utility model right, patent right or design right is extinguished.

(Right of pledge)

- Article 25 (1) Unless otherwise agreed upon by contract, where a right of pledge is established for the purpose of a utility model right, exclusive license or non-exclusive license, the pledgee may not work the registered utility model.
- (2) The provisions of Article 96 (extension of a right of pledge to the proceeds of the patent right) of the Patent Act shall apply mutatis mutandis to a right of pledge established for the purpose of a utility model right, exclusive license or non-exclusive license.
- (3) The provisions of Article 98, paragraph (1), item (iii) and paragraph (2) (effect of registration) of the Patent Act shall apply mutatis mutandis to a right of pledge established for the purpose of a utility model right or exclusive license.

(Application mutatis mutandis of the Patent Act)

Article 26 The provisions of Articles 69, paragraphs (1) and (2) and Articles 70 to 71-2 (limitations of patent right and technical scope of patented invention), Article 73 (joint ownership), Article 76 (extinguishment of patent rights in absence of heir), Article 79 (non-exclusive license based on prior use), Article 79-2 (non-exclusive license due to the working of the invention prior to the registration of the transfer of a patent right), Articles 81 and 82 (non-exclusive license after expiration of duration of design right), Article 97, paragraph (1) (waiver), and Article 98, paragraph (1), items (i) and (ii) (effect of registration) shall apply mutatis mutandis to utility model rights.

## Section 2 Infringement of Rights

(Right to seek injunction)

Article 27 (1) A holder of utility model right or an exclusive licensee may request a person who infringes or is likely to infringe the said utility model right or exclusive license (hereinafter referred to as "infringer, etc.") to stop or prevent such infringement.

(2) When a request is made under the provisions of the preceding paragraph, the holder of utility model right or an exclusive licensee may request measures necessary for the prevention of such an infringement including the disposal of articles constituting such an act of infringement (including a computer program, etc. (refers to a computer program, etc. provided in Article 2, paragraph (4) of the Patent Act, the same shall apply in the following Article), the same shall apply hereinafter), the removal of facilities used for the act of infringement and other necessary measures.

(Acts deemed to constitute infringement)

Article 28 The following acts shall be deemed to constitute an infringement of the utility model right or the exclusive license:

(i) acts of, as a business, producing, assigning, etc. (assigning and leasing and, in the case where the article is a computer program, etc., including providing through electric telecommunication lines, the same shall apply hereinafter), importing or offering for assignment, etc. (including an act of displaying for the purpose of assignment, etc., the same shall apply hereinafter) any product to be used exclusively for manufacturing an article in which the registered utility model has been embodied;

(ii) acts of, as a business, producing, assigning, etc., or importing or offering for assignment, etc. any product (excluding those widely distributed in the general public within Japan) to be used for manufacturing an article in which the registered utility model has been embodied and indispensable for solving the problem by the device, knowing that the said device is a registered utility model and the said product is to be used for the working of the device and;

(iii) acts of possessing an article in which a registered utility model has been embodied for the purpose of assigning, leasing or exporting it.

(Estimation of amount of damage, etc.)

Article 29 (1) Where a holder of utility model right or an exclusive licensee claims against an infringer compensation for damage sustained as a result of the intentional or negligent infringement of the utility model right or exclusive

license, and the infringer assigned the articles that constituted the act of infringement, the amount of damage sustained by the holder or the exclusive licensee may be estimated to be the amount of profit per unit of articles which could have been sold by the holder or the exclusive licensee if there had been no such act of infringement, multiplied by the quantity (hereinafter referred to in this paragraph as the "assigned quantity") of articles assigned by the infringer, not exceeding the amount attainable by the holder or the exclusive licensee in light of the capability of the holder or the exclusive licensee to work such articles; provided, however, that if any circumstances exist under which the holder or the exclusive licensee would have been unable to sell the assigned quantity in whole or in part, the amount calculated as the number of articles which are not able to be sold due to such circumstances shall be deducted.

(2) Where a holder of utility model right or an exclusive licensee claims against an infringer compensation for his/her own damage sustained as a result of the intentional or negligent infringement of his/her own utility model right or exclusive license, and the infringer earned any profits from the act of infringement, the amount of profits earned by the infringer shall be estimated to be the amount of damage sustained by the holder of utility model right or exclusive licensee.

(3) A holder of utility model right or an exclusive licensee may claim against an infringer compensation for his/her own damage sustained as a result of the intentional or negligent infringement of his/her own utility model right or exclusive license, by regarding the amount the holder of said utility model right or exclusive licensee would have been entitled to receive for the working of the registered utility model right as the amount of damage sustained.

(4) The provisions of the preceding paragraph shall not preclude a claim for compensation of damages exceeding the amount provided therein. In this case, where the infringer did not commit the infringement of the utility model right or exclusive license intentionally or by gross negligence, the court may take these circumstances into consideration in determining the amount of compensation.

(Presentation of Technical Reports of Expert Opinion on Registrability of Utility Models)

Article 29-2 A holder of utility model right or an exclusive licensee may not exercise his/her utility model right or exclusive license against an infringer, etc. of his/her own utility model right or exclusive license unless he/she has warned by presenting the Technical Reports of Expert Opinion on Registrability of Utility Models with respect to the registered utility model.

(Liability of holder of utility model right, etc.)

Article 29-3 (1) Where a trial decision to the effect that the utility model registration is to be invalidated (excluding those rendered on the ground of Article 37, paragraph (1), item (vi)) has become final and binding after the holder of utility model right or the exclusive licensee exercised his/her right against, or gave warning thereof to, an infringer, etc., the person shall be liable to compensate damage sustained by the infringer, etc. as a result of the exercise of his/her right or the warning; provided, however, that this shall not apply where the holder or the exclusive licensee exercised his/her right or gave warning thereof based on the utility model technical opinion stated in the Technical Reports of Expert Opinion on Registrability of Utility Models (excluding those to the effect that the device claimed in the application for utility model registration or the registered utility model cannot be registered under the provisions of Article 3, paragraph (1), item (iii) and paragraph (2) (limited to those with respect to the device listed in the said item), Article 3-2, and Article 7, paragraphs (1) to (3) and (6)) or with other reasonable care.

(2) The provisions of the preceding paragraph shall apply mutatis mutandis to the case where the holder of utility model right or the exclusive licensee exercised his/her right, or gave warning thereof, based on the device which has come to fall outside the scope of claims for a utility model right at the time of the registration of the establishment of the utility model right as a result of any correction made to the description, scope of claims for a utility model right or drawing attached to the application in the application for utility model registration referred to in Article 14-2, paragraph (1) or (7).

(Application mutatis mutandis of the Patent Act)

Article 30 The provisions of Articles 104-2 to 106 (obligation to clarify the specific conditions (of infringement), restriction on exercise of rights of patentee, etc., restriction on assertion, submission of documents, etc., expert opinion on calculation of damages, determination of reasonable damages, protective order, rescission of protective order, notice, etc. of a request for inspection of record, etc., ban on open examination of parties, etc. and measures to restore credibility) of the Patent Act shall apply mutatis mutandis to infringement of utility model rights or exclusive licenses. In this case, the terms "the following decision or trial decision has become final and binding" and "the said decision or trial decision has become final and binding" in Article 104-4 of the said Act shall be deemed to be replaced with "the trial decision listed in item (i) has become final and binding, or any correction listed in item (iii) has been made" and "the said trial decision has become final and binding, or any correction has been made," respectively, and the term "a decision or a trial decision to the effect that the description, scope of claims for a utility model registration or drawings attached to the application with respect to the

said patent is to be corrected" in item (iii) of the said Article shall be deemed to be replaced with "any correction referred to in Article 14-2, paragraph (1) or (7) of the Utility Model Act of the description, scope of claims for a utility model registration or drawings attached to the application with respect to the said utility model registration."

### Section 3 Registration Fees

(Registration fees)

Article 31 (1) A person who obtains the registration of establishment of a utility model right or a holder of utility model right shall pay as registration fees the amount listed in the lower column of the following table in accordance with the category listed in the upper column, for each registered utility model and for each year from the date of the registration of establishment of the utility model right to the expiration of the duration provided in Article 15:

Period within term	Amount
First to third year	Annually 2,100 yen plus 100 yen per claim
Fourth to sixth year	Annually 6,100 yen plus 300 yen per claim
Seventh to tenth year	Annually 18,100 yen plus 900 yen per claim

- (2) The provisions of the preceding paragraph shall not apply to utility model rights belonging to the State.
- (3) Notwithstanding the provisions of paragraph (1), where a utility model right is jointly owned by persons including the State and/or a person subject to reduction of the registration fees or exemption therefrom under Article 32-2 or the provisions of any other laws and regulations (hereinafter referred to in this paragraph as "reduction/exemption"), and the portion of their respective shares of the said utility model right has been specified, the registration fees payable under paragraph (1) shall be determined as the sum of the amounts calculated for each person other than the State jointly owning the utility model right by multiplying the applicable registration fees provided in paragraph (1) (in the case of a person subject to reduction/exemption, the amount after deducting the said reduction/exemption) by the ratio of the share of each person other than the State jointly owning the utility model right, and, the persons other than the State shall pay such sum.
- (4) For the amount of registration fees calculated under the provisions of the preceding paragraph, fractional figures of less than ten yen shall be discarded.
- (5) The payment of registration fees referred to in paragraph (1) shall be made by

patent revenue stamps as specified by an ordinance of the Ministry of Economy, Trade and Industry; provided, however, that where so specified by an ordinance of the Ministry of Economy, Trade and Industry, a payment in cash thereof may be accepted.

(Time limit for payment of registration fees)

Article 32 (1) The registration fees for each year from the first to the third year under the provisions of Article 31, paragraph (1) shall be paid in a lump sum at the same time as the filing of the application for utility model registration (or, in the case where an application is converted under the provisions of Article 10, paragraph (1) or (2) or an application is divided under the provisions of Article 44, paragraph (1) of the Patent Act as applied mutatis mutandis pursuant to Article 11, paragraph (1), at the same time as the conversion or division of the application).

(2) The registration fees for each year from the fourth year to subsequent years under the provisions of Article 31, paragraph (1) shall be paid by the end of the previous year.

(3) The Commissioner of the Patent Office may, upon request from a person who is responsible for paying the registration fees, extend the period provided in paragraph (1) within a period not exceeding 30 days.

(4) Notwithstanding the provisions of paragraphs (1) and (3), where, due to reasons beyond the control of the person who pays the registration fees, he/she is unable to pay the registration fees within the extended period under the provisions of the preceding paragraph, the person may pay the registration fees within 14 days (where the applicant is an overseas resident, within two months) from the date on which the reasons ceased to exist, but not later than six months after the said period lapsed.

(Reduction/exemption or deferment of registration fees)

Article 32-2 Where a person who is responsible for paying the registration fees for each year from the first to the third year under the provisions of Article 31, paragraph (1) is the creator of the device claimed in the application for utility model registration or his/her heir, if the Commissioner of the Patent Office recognizes that the person has difficulties in paying the registration fees due to insufficient financial means, the Commissioner of the Patent Office may grant the person a reduction of, exemption from or deferment of the payment of the registration fees as specified by Cabinet Order.

(Late payment of registration fees)

Article 33 (1) Where a holder of utility model right is unable to pay the registration fees within the period provided in Article 32, paragraph (2) or the

period for deferred payment under the provisions of Article 32-2, he/she may make a late payment of the registration fees after the said period lapses, but not later than six months following the expiration of the said period.

- (2) The holder of utility model right who makes a late payment of the registration fees under the provisions of the preceding paragraph shall pay, in addition to the registration fees to be paid under the provisions of Article 31, paragraph (1), a registration surcharge in the same amount as the registration fees.
- (3) The payment of the registration surcharge referred to in the preceding paragraph shall be made by patent revenue stamps as specified by an ordinance of the Ministry of Economy, Trade and Industry; provided, however, that where so specified by an ordinance of the Ministry of Economy, Trade and Industry, a payment in cash thereof may be accepted.
- (4) Where a holder of utility model right fails to pay, within the period allowed for late payment of the registration fees under the provisions of paragraph (1), the registration fees for each year from the fourth and subsequent years under the provisions of Article 31, paragraph (1) and the registration surcharge referred to in paragraph (2), the utility model right shall be deemed to have been extinguished retroactively upon the expiration of the period provided in Article 32, paragraph (2).
- (5) Where a holder of utility model right fails to pay, within the period allowed for late payment of the registration fees under the provisions of paragraph (1), the registration fees for which deferment was granted under the provisions of Article 32-2 and the registration surcharge referred to in paragraph (2), the utility model right shall be deemed to have not existed from the beginning.

(Restoration of utility model right by late payment of registration fees)

- Article 33-2 (1) Where an original holder of the utility model right which was deemed to have been extinguished under the provisions of Article 33, paragraph (4), or which was deemed to have not existed from the beginning under the provisions of Article 33, paragraph (5) has justifiable reasons for having been unable to pay the registration fee or the registration surcharge provided in Article 33, paragraph (4) or (5) within the period allowed for late payment of the registration fees under the provisions of Article 33, paragraph (1), the original holder may make a late payment of the registration fees or the surcharge within two months from the date on which the reasons ceased to exist, but not later than one year following the expiration of the said period;
- (2) Where a late payment of the registration fees or the registration surcharge is made under the provisions of the preceding paragraph, the utility model right shall be deemed to have been maintained retroactively from the time of expiration of the period provided in Article 32, paragraph (2) or to have existed from the beginning.

(Restriction on effect of restored utility model right)

Article 33-3 (1) Where a utility model right has been restored under the provisions of paragraph (2) of the preceding Article, the utility model right shall not be effective on the article in which the registered utility model has been embodied which was imported into, manufactured or acquired within Japan after the period allowed for making a late payment of the registration fees has lapsed under the provisions of Article 33, paragraph (1) but before the registration of the restoration of the utility model right.

(2) A restored utility model right under the provisions of paragraph (2) of the preceding Article shall not be effective on the following acts committed after the period during which a late payment of the registration fees is allowed under the provisions of Article 33, paragraph (1) lapses but before the registration of the restoration of the utility model right:

- (i) acts of working the said device;
- (ii) acts of producing, assigning, etc., or importing or offering for assignment, etc. any product to be used for producing the article in which the registered utility model has been embodied; and
- (iii) acts of possessing an article in which the registered utility model has been embodied for the purpose of assigning, leasing or exporting it.

(Refund of already-paid registration fees)

Article 34 (1) The already paid registration fees that fall under any of the following items shall be refunded upon request from the person who paid them:

- (i) registration fees paid in error or in excess;
- (ii) registration fees in the case where the disposition to the effect that the application for utility model registration is to be dismissed has become final and binding;
- (iii) registration fees for each year following the year in which a trial decision to the effect that the utility model registration is to be invalidated has become final and binding; and
- (iv) registration fees for each year following the year in which the duration of the utility model right would have expired.

(2) A request for refund of registration fees under the provisions of the preceding paragraph may not be filed after one year from the date of payment in the case of the registration fees referred to in item (i) above, after six months from the date on which the disposition or the trial decision became final and binding in the case of the registration fees referred to in items (ii) or (iii) above, or after one year from the date on which the establishment of the utility model right was registered in the case of the registration fees referred to in items (iv) above.

(3) Notwithstanding the provisions of paragraphs (1), where, due to reasons

beyond the control of the person who files a requests for refund of registration fees under the provisions of paragraph (1), the person is unable to file the request within the period provided in the preceding paragraph, the person may file the request within 14 days (where the applicant is an overseas resident, within two months) from the date on which the reasons ceased to exist, but not later than six months after the said period lapsed.

Article 35 Deleted

(Application mutatis mutandis of the Patent Act)

Article 36 The provisions of Article 110 of the Patent Act (payment of patent fees by interested persons) shall apply mutatis mutandis to registration fees.

### **Chapter V Appeals/Trials**

(Invalidation trial of utility model registration)

Article 37 (1) Where a utility model registration falls under any of the following items, a request for invalidation trial of the utility model registration may be filed. In this case, if there are two or more claims, a request for invalidation trial of the utility model registration may be filed for each claim.

- (i) where the utility model registration has been granted with respect to an application for utility model registration with an amendment that does not comply with the requirements provided in Article 2-2, paragraph (2);
- (ii) where the utility model registration has been granted in violation of the provisions of Article 25 of the Patent Act as applied mutatis mutandis pursuant to Article 2-5, paragraph (3) of the Utility Model Act, Articles 3, 3-2, 4, Article 7, paragraphs (1) to (3) or Article 7, paragraph (6), or Article 38 of the Patent Act as applied mutatis mutandis pursuant to Article 11, paragraph (1) of the Utility Model Act (where the utility model registration has been granted in violation of Article 38 of the provisions of the Patent Act as applied mutatis mutandis pursuant to Article 11, paragraph (1) of this Act, excluding the case where the transfer of a utility model right with respect to the said utility model registration has been registered based on a request made under the provisions of Article 17-2, paragraph (1) of the Utility Model Act);
- (iii) where the utility model registration has been granted in violation of a treaty;
- (iv) where the utility model registration has been granted with respect to an application for utility model registration that does not comply with the requirements provided in Article 5, paragraph (4) or (6) (excluding item (iv));
- (v) where the said utility model registration has been granted with respect to

- an application for utility model registration filed by a person does not have any right to obtain a utility model registration for the device (excluding the case where the transfer of a utility model right with respect to the said utility model registration has been registered based on the request made under the provisions of Article 17-2, paragraph (1));
- (vi) where, after a utility model registration has been granted, the holder of utility model right has become unable to hold the utility model right under the provisions of Article 25 of the Patent Act as applied mutatis mutandis pursuant to Article 2-5, paragraph (3), or the utility model registration has come to violate a treaty; and
  - (vii) where any correction of the description, scope of claims for a utility model registration or drawings attached to the application for the utility model registration has been made in violation of the provisions of Article 14-2, paragraphs (2) to (4).
- (2) Any person may file a request for invalidation trial of utility model registration; provided, however, that where a request for invalidation trial of utility model registration is filed on the ground that the utility model registration falls under item (ii) of the preceding paragraph (limited to the case where the utility model registration is obtained in violation of Article 38 of the Patent Act as applied mutatis mutandis pursuant to Article 11, paragraph (1)) or item (v) of the preceding paragraph, only a person who holds the right to obtain a utility model registration for the device with respect to the said utility model registration may file a request for invalidation trial of utility model registration.
- (3) A request for invalidation trial of utility model registration may be filed even after the utility model right has lapsed.
- (4) Where a request for invalidation trial of utility model registration has been filed, the chief trial examiner shall notify the exclusive licensee of the utility model right and other persons who hold any registered rights relating to the utility model to the effect.

(Formal requirements of request for trial)

Article 38 (1) A person who files a request for trial shall submit a written request stating the following items to the Commissioner of the Patent Office:

- (i) the names, and the addresses or residences of the party and the representative thereof;
  - (ii) the indication of the trial case; and
  - (iii) the subject of and grounds for the request
- (2) For the grounds for the request listed in item (iii) of the preceding paragraph, the facts on which invalidation of the utility model registration is based shall be identified in concrete terms, and the relationship of each fact that is

required to be proven with the relevant evidence shall be stated.

(Amendment of request for trial)

Article 38-2 (1) Any amendment of the written request filed under the provisions of paragraph (1) of the preceding Article shall not change the gist thereof; provided, however, that this shall not apply in the event that an approval is granted by the chief trial examiner under the provisions of the following paragraph.

(2) Where any amendment of the grounds for the request listed in Article 38, paragraph (1), item (iii) changes the gist thereof, the chief trial examiner may approve such an amendment, if he/she recognizes that there is no risk that the said amendment causes unreasonable delay of the proceedings and any of the following grounds exists:

(i) correction referred to in Article 14-2, paragraph (1) has given rise to a need for making an amendment to the grounds for the request; and

(ii) other than the case listed in the preceding item, there exist reasonable grounds for not stating the grounds for the request with respect to the amendment of the request at the time of filing a request for trial, and the demandee has agreed on such an amendment.

(3) An approval for the amendment under the preceding paragraph may not be granted if a written amendment with respect to the said amendment is submitted prior to the service of a copy of the written request under the provisions of Article 39, paragraph (1).

(4) No appeal shall be filed against a decision made under paragraph (2) or inaction thereof.

(Submission of written reply, etc.)

Article 39 (1) Where a request for trial has been filed, the chief trial examiner shall serve a copy of the written request to the demandee and give him/her an opportunity to submit a written reply, designating an adequate period.

(2) Where the chief trial examiner approves an amendment of the written request under the provisions of Article 38-2, paragraph (2), he/she shall serve a copy of the written amendment with respect to the said amendment to the demandee, and shall give him/her an opportunity to submit a written reply, designating an adequate period; provided, however, that this shall not apply where special circumstances exist under which it is recognized that giving an opportunity to the demandee to submit a written reply is not required.

(3) Upon receipt of a written reply as provided in paragraph (1) or the main clause of the preceding paragraph, or where a correction as provided referred to in Article 14-2, paragraph (1) or (7) has been made while an invalidation trial of utility model registration is pending at the Japan Patent Office, the

chief trial examiner shall serve to the demandant a copy thereof.

- (4) The chief trial examiner may question the parties and the intervenors relating to the trial.
- (5) Where, after a request for invalidation trial of the utility model registration has been filed, a patent application under the provisions of Article 46-2, paragraph (1) of the Patent Act is filed based on the utility model registration, the chief trial examiner shall notify the demandant and the intervenors thereof.

(Withdrawal of request for trial)

- Article 39-2 (1) A request for trial may be withdrawn before a trial decision becomes final and binding.
- (2) A request for trial may not be withdrawn after a written reply referred to in Article 39, paragraph (1) has been submitted, unless the consent of the adverse party has not been obtained.
  - (3) Where the demandant for trial has received a notice under the provisions of Article 39, paragraph (5), notwithstanding the provisions of the preceding paragraph, he/she may withdraw the request for trial only within 30 days from the date on which he/she received the notice.
  - (4) The provisions of Article 4 of the Patent Act shall apply mutatis mutandis to the period referred to in the preceding paragraph. In this case, the term "The Commissioner of the Patent Office" in the said Article shall be deemed to be replaced with "The chief trial examiner".
  - (5) Where, due to reasons beyond the control of the demandant for trial, he/she is unable to withdraw the request for trial within the period provided in paragraph (3), the demandant may, notwithstanding the provisions of the said paragraph, withdraw the request within 14 days (in the case where the demandant is an overseas resident, within two months) from the date on which the reasons ceased to exist, but not later than six months following the expiration of the said period.
  - (6) When a request for invalidation trial of utility model registration has been filed with regard to two or more claims contained in a utility model registration containing two or more claims, the request may be withdrawn for each of the claims.

(Relationship with lawsuits)

- Article 40 (1) Where it is deemed to be necessary during a trial, the trial proceedings may be suspended until a trial decision in another trial has become final and binding or court proceedings have been concluded.
- (2) Where an action is instituted or a motion for order of provisional seizure or order of provisional disposition is filed, the court may, if it considers it to be necessary, suspend the court proceedings until the trial decision becomes final

and binding.

- (3) Where an action with respect to infringement of a utility model right or an exclusive license is instituted, the court shall notify the Commissioner of the Patent Office thereof. The same shall apply when the said court proceedings have been concluded.
- (4) Where the Commissioner of the Patent Office receives a notice provided in the preceding paragraph, he/she shall notify the court of whether a request for trial with regard to the utility model right has been filed. The same shall apply when, with regard to the trial, a decision dismissing the written request or a trial decision has been rendered or the request has been withdrawn.
- (5) Where the court receives a notice to the effect that a request for trial with regard to a utility model right has been filed under the provisions of the preceding paragraph, if a document stating a method of allegation or defense under the provisions of Article 104-3, paragraph (1) of the Patent Act as applied mutatis mutandis pursuant to Article 30 of the Utility Model Act has already been submitted in the court proceedings prior to the said notice, or if the said document is submitted for the first time after the said notice, the court shall notify the Commissioner of the Patent Office thereof.
- (6) Where the Commissioner of the Patent Office receives a notice provided in the preceding paragraph, he/she may request the court to deliver a copy of any record of the court proceedings which the trial examiner considers it to be necessary for the trial.

(Application mutatis mutandis of the Patent Act)

Article 41 The provisions of Articles 125, 132 to 133-2, 135 to 154, Article 156, paragraphs (1), (3) and (4), Articles 157, 167 and 167-2, Article 169, paragraphs (1), (2), (5) and (6), and Article 170 of the Patent Act shall apply mutatis mutandis to appeals and trials. In this case, the term "shall, in a trial other than a trial for patent invalidation, notify" in Article 156, paragraph (1) of the said Act shall be deemed to be replaced with "shall notify."

## **Chapter VI Retrial and Litigation**

(Request for retrial)

- Article 42 (1) A party or an intervenor may file a request for retrial against a final and binding trial decision.
- (2) The provisions of Articles 338, paragraphs (1) and (2) and Article 339 (grounds for retrial) of the Code of Civil Procedure (Act No109 of 1996) shall apply mutatis mutandis to requests for retrial as provided in the preceding paragraph.

Article 43 (1) Where a demandant for trial, in conspiracy with the demandee, has caused the trial decision to be rendered for the purpose of harming the right or interest of any third party, the third party may file a request for retrial against the final and binding trial decision.

(2) A request for retrial referred to in the preceding paragraph shall be filed against the demandant and the demandee in the trial as joint demandees.

(Restriction on effect of utility model right restored by retrial)

Article 44 (1) Where a utility model right with respect to an invalidated utility model registration has been restored by a retrial, such a utility model right shall not be effective on any articles relating thereto imported into, manufactured or acquired in Japan in good faith, after the trial decision became final and binding but before the registration of the request for retrial.

(2) Where a utility model right embodied in the invalidated utility model registration has been restored by a retrial, such a utility model right shall not be effective on the following acts conducted after the trial decision became final and binding but before the registration of the request for retrial:

(i) the act of working the device in good faith;

(ii) the act of producing, assigning, etc., importing or offering for assignment, etc., in good faith, any product used for manufacturing any article in which the registered utility model has been embodied; and

(iii) the act of possessing an article, in good faith, in which the registered utility model has been embodied for the purpose of assigning, leasing or exporting it.

(Application mutatis mutandis of the Patent Act)

Article 45 (1) The provisions of Articles 173 (time limit for request for retrial), 174, paragraphs (3) and (5) (application mutatis mutandis of provisions regarding trial, etc.), and 176 (non-exclusive license due to the working of the invention prior to the registration of the request for a retrial) of the Patent Act shall apply mutatis mutandis to retrials. In this case, in Article 174, paragraph (3) of the said Act, the terms "Article 131, paragraph (1), the main clause of Article 131-2, paragraph (1)," "Article 134, paragraphs (1), (3) and (4)" and "to Article 168" shall be deemed to be replaced with "Article 38, paragraph (1), the main clause of Article 38-2", "Article 39, paragraphs (1), (3) and (4) of the Utility Model Act," and "Article 167-2, Article 40 of the Utility Model Act," respectively.

(2) The provisions of Article 4 of the Patent Act shall apply mutatis mutandis to the period provided in Article 173, paragraph (1) of the said Act as applied mutatis mutandis pursuant to the preceding paragraph.

Article 46 Deleted

(Action against trial decisions, etc.)

Article 47 (1) The Tokyo High Court shall have exclusive jurisdiction over any action against a trial decision or a ruling to dismiss a written request for a trial or a retrial.

(2) The provisions of Article 178, paragraphs (2) to (6) (statute of limitations for filing an action, etc.), Articles 179 to 182-2 (appropriate party as defendant, notice of institution of action, etc., opinion of the Commissioner of the Patent Office in litigation rescinding the trial decision, rescission of the trial decision or ruling, delivery of original copy of judgment, etc., and composition of panel) of the Patent Act shall apply mutatis mutandis to actions referred to in the preceding paragraph.

(Action against the amount of compensation)

Article 48 (1) A person who has received a ruling referred to in Article 21, paragraph (2), Article 22, paragraph (3) or (4), or Article 23, paragraph (2) may, if he/she is not satisfied with the amount of compensation determined in the ruling, institute an action requesting an increase or decrease of the said amount.

(2) The provisions of Articles 183, paragraph (2) (statute of limitations for filing an action) and Article 184 (appropriate party as defendant) of the Patent Act shall apply mutatis mutandis to actions referred to in the preceding paragraph.

Article 48-2 Deleted

**Chapter VII Special Provisions Concerning International Applications  
under the Patent Cooperation Treaty**

(Application for utility model registration based on international application)

Article 48-3 (1) An international application (limited only to an application for utility model registration) to which the international filing date is accorded based on the provisions of Article 11, paragraph (1), Article 11, paragraph (2), item (b) or Article 14, paragraph (2) of the Patent Cooperation Treaty signed in Washington on June 19, 1970 (hereinafter referred to as the "Treaty" in this Chapter) and which includes Japan as a designated State under Article 4, paragraph (1), item (ii) of the Treaty shall be deemed to be an application for utility model registration filed on the said international filing date.

(2) The provisions of Article 184-3, paragraph (2) (patent application based on international application) of the Patent Act shall apply mutatis mutandis to an international application which has been deemed to be an application for

utility model registration under the provisions of the preceding paragraph (hereinafter referred to as "international application for utility model registration").

(Translations of international application for utility model registration in foreign language)

- Article 48-4 (1) An applicant of an international application for utility model registration filed in a foreign language (hereinafter referred to as "Utility Model Registration Application in a Foreign Language") shall submit to the Commissioner of the Patent Office Japanese translations of the description, scope of claims, drawings (the descriptive text in such drawings only, hereinafter the same shall apply in this Article), and the abstract, provided in Article 3, paragraph (2) of the Treaty, as of the international filing date provided in paragraph (1) of the preceding Article (hereinafter referred to as "International Application Date") within a period from the priority date referred to in Article 2 (xi) of the Treaty (hereinafter referred to as "priority date") to two years and six months (hereinafter referred to as "Time Limit for the Submission of National Documents") therefrom; provided, however, that the applicant of an international application for utility model registration in foreign language who has submitted the document provided in paragraph (1) of the following Article during the period from two months before the expiration of the period for the submission of national documents to the expiry date thereof (excluding the case where the said translations have been submitted prior to the date of submission of the said documents) may submit the said translations within two months from the date of submission of the said document (hereinafter referred to as "Special Time Limit for the Submission of Translations").
- (2) In the case of the preceding paragraph, where the applicant of the application for utility model registration in foreign language has made an amendment based on the provisions of Article 19, paragraph (1) of the Treaty, the applicant may, in lieu of the translation of the scope of claim(s) provided in the preceding paragraph, submit a translation of the amended scope of claim(s).
- (3) Where the translation of the description provided in paragraph (1) and the translation of the scope of claim(s) provided in the preceding two paragraphs (hereinafter referred to as "translations of the description, etc.") have not been submitted within the time limit for the submission of national documents (in the case of an application for utility model registration in foreign language under the proviso to paragraph (1), the special time limit for the submission of translations, hereinafter the same shall apply in this Article), the international application for utility model registration shall be deemed to have been withdrawn.

- (4) An applicant for the international application for utility model registration that was deemed to have been withdrawn pursuant to the provisions of the preceding paragraph, where there are justifiable grounds for having not been able to submit the said translation of the description, etc., within the time limit for the submission of national documents, may submit to the Commissioner of the Patent Office the translation of the description, etc. and the translations of drawings and the abstract provided in paragraph (1) only within two months from the date on which the reasons ceased to exist, but not later than one year following the expiration of the period for the submission of national documents.
- (5) The translations submitted under the provisions of the preceding paragraph shall be deemed to have been submitted to the Commissioner of the Patent Office at the time of the expiration of the time limit for the submission of national documents.
- (6) Where any amendment based on the provisions of Article 19, paragraph (1) of the Treaty has been made, an applicant who has submitted the translation of the scope of claim(s) provided in paragraph (1) may further submit a Japanese translation of the said amended scope of claim(s) no later than the date on which the time limit for the submission of national documents expires (where the applicant files a request under the provisions of Article 23, paragraph (2) or Article 40, paragraph (2) of the Treaty within the time limit for the submission of national documents (hereinafter referred to as "Request for National Processing"), the time of filing the request for national processing (hereinafter referred to as "National Processing Standard Time")).
- (7) The provisions of the main clause of Article 184-7, paragraph (3) of the Patent Act shall apply mutatis mutandis to the case where the translation provided in paragraph 2 or the preceding paragraph has not been submitted.

(Submission of documents and order to amend procedures, etc.)

Article 48-5 (1) An applicant for an international application for utility model registration shall submit a document to the Commissioner of the Patent Office within the time limit for the submission of national documents stating the following matters:

- (i) the name, and the address or residence of the applicant;
  - (ii) the name, and the address or residence of the creator of the device; and
  - (iii) the international application number and other matters specified by an ordinance of the Ministry of Economy, Trade and Industry.
- (2) The Commissioner of the Patent Office may order the applicant to make an amendment to the procedures, designating a reasonable period, in any of the following cases:
- (i) where the document to be submitted under the provisions of the preceding

- paragraph is not submitted within the time limit for the submission of national documents;
- (ii) where the procedures under the provisions of the preceding paragraph violate the provisions of Articles 7, paragraphs (1) to (3) or Article 9 of the Patent Act as applied mutatis mutandis pursuant to Article 2-5, paragraph (2);
  - (iii) where the procedure under the provisions of the preceding paragraph violates the formal requirements specified by an ordinance of the Ministry of Economy, Trade and Industry;
  - (iv) where a translation of the abstract to be submitted under the provisions of paragraph (1) of the preceding Article is not submitted within the time limit for the submission of national documents (in the case of an application for utility model registration in foreign language referred to in the proviso to paragraph (1) of the preceding Article, the special time limit for the submission of translations);
  - (v) where the registration fees payable under the provisions of Article 32, paragraph (1) are not paid within the time limit for the submission of national documents; and
  - (vi) where the fees payable under the provisions of Article 54, paragraph (2) are not paid within the time limit for the submission of national documents.
- (3) The provisions of Article 184-5, paragraph (3) of the Patent Act shall apply mutatis mutandis to the amendment ordered under the provisions of the preceding paragraph.
- (4) An applicant of an international application for utility model registration may file a request for national processing, only after he/she has paid the registration fees payable under the provisions of Article 32, paragraph (1) and fees payable under the provisions of Article 54, paragraph (2), and, in the case of an international application for utility model registration filed in Japanese language (hereinafter referred to as "application for utility model registration in Japanese language") has completed the procedures under the provisions of paragraph (1), or, in the case of an application for utility model registration in foreign language, has completed the procedures under the provisions of paragraph (1) and Article 48-4, paragraph (1).

(Effect of the application, description, etc. of international application)

Article 48-6 (1) The application included in an international application for utility model registration as of the international application date shall be deemed to be an application submitted under the provisions of Article 5, paragraph (1).

(2) The description of an application for utility model registration in Japanese language as of the international application date and translations of the

description of an application for utility model registration in foreign language as of the international application date shall be deemed to be the description submitted with the application under the provisions of Article 5, paragraph (2); the scope of claim(s) of an application for utility model registration in Japanese language as of the international application date and a translation of the scope of claim(s) of an application for utility model registration in foreign language as of the international application date shall be deemed to be the scope of claim(s) submitted with the application under the provisions of Article 5, paragraph (2); the drawing(s) of an application for utility model registration in Japanese language as of the international application date, and drawing(s) (excluding the descriptive text in the drawing(s)) and a translation of the descriptive text in the drawing(s) of an application for utility model registration in foreign language as of the international application date shall be deemed to be the drawing(s) submitted with the application under the provisions of Article 5, paragraph (2); and, the abstract of an application for utility model registration in Japanese language and a translation of the abstract of an application for utility model registration in foreign language shall be deemed to be the abstract submitted with the application under the provisions of Article 5, paragraph (2).

- (3) Where a translation of the amended scope of claim(s) based on the provisions of Article 19, paragraph (1) of the Treaty is submitted under the provisions of Article 48-4, paragraph (2) or (6), notwithstanding the provisions of the preceding paragraph, a translation of the said amended scope of claim(s) shall be deemed to be the scope of claim(s) submitted with the application under the provisions of Article 5, paragraph (2).

(Submission of drawings)

Article 48-7 (1) Where an international application for utility model registration does not include any drawing as of the international application date, the applicant thereof shall submit the drawing to the Commissioner of the Patent Office on or before the date into which the national processing standard time falls.

- (2) Where the drawing under the provisions of the preceding paragraph has not been submitted on or before the date into which the national processing standard time falls, the Commissioner of the Patent Office may order the applicant of the international application for utility model registration to submit the drawing, designating a reasonable period.

- (3) Where a person ordered to submit any drawing under the provisions of the preceding paragraph does not submit the drawing within the designated period under the provisions of the said paragraph, the Commissioner of the Patent Office may dismiss the said international application for utility model

registration.

- (4) The submission of a drawing made under the provisions of paragraph (1) or based on the order under the provisions of paragraph (2) (where a brief description of the drawing is submitted with the drawing, the submission of the drawing and the description) shall be deemed to be an amendment of procedures under the provisions of Article 2-2, paragraph (1). In this case, the provisions of the proviso to Article 2-2, paragraph (1) shall not apply to such submission.

(Special provisions concerning amendment)

- Article 48-8 (1) The provisions of the proviso to Article 2-2, paragraph (1) shall not apply to an amendment which is, under the provisions of Article 184-7, paragraph (2) and Article 184-8, paragraph (2) of the Patent Act as applied mutatis mutandis pursuant to Article 48-15, paragraph (1), deemed to have been made under the provisions of Article 2-2, paragraph (1).
- (2) The provisions of the proviso to Article 2-2, paragraph (1) shall not apply to an amendment made to an international application for utility model registration under the provisions of Article 28, paragraph (1) or Article 41, paragraph (1) of the Treaty.
- (3) With regard to the scope within which the description, scope of claims for a utility model registration or drawings included in an application for utility model registration in foreign language may be amended, the term "the description, scope of claims for a utility model registration or drawing(s) originally attached to the application" in Article 2-2, paragraph (2) shall be deemed to be replaced with "the description, scope of claims or drawing of the international application as of the international filing date referred to in Article 48-4, paragraph (1)."
- (4) The provisions of Article 184-12, paragraph (1) of the Patent Act shall apply mutatis mutandis to an amendment made to an international application for utility model registration based on the provisions of the main clause of Article 2-2, paragraph (1) or Article 28, paragraph (1) or Article 41, paragraph (1) of the Treaty. In this case, the term "Article 195, paragraph (2)" in Article 184-12, paragraph (1) of the Patent Act shall be deemed to be replaced with "registration fees payable under the provisions of Article 32, paragraph (1) of the Utility Model Act and Article 54, paragraph (2) of the said Act," and "has been paid, and after the national processing standard time has lapsed" shall be deemed to be replaced with "has been paid."

(Special provisions concerning requirements for utility model registration)

- Article 48-9 For the purpose of the application of the provisions of Article 3-2, in the case where another application for utility model registration or patent

application provided in Article 3-2 is an international application for utility model registration or an international patent application referred to in Article 184-3, paragraph (2) of the Patent Act, the term "another application for utility model registration or for patent" in Article 3-2 shall be deemed to be replaced with "another application for utility model registration or for patent (excluding an application for utility model registration application in foreign language referred to in Article 48-4, paragraph (1) of the Utility Model Act or a patent application in foreign language referred to in Article 184-4, paragraph (1) of the Patent Act which has been deemed to have been withdrawn under the provisions of Article 48-4, paragraph (3) of the Utility Model Act or Article 184-4, paragraph (3) of the Patent Act," the term "the issuance or" shall be deemed to be replaced with "the issuance," the term "or the publication of the patent application" shall be deemed to be replaced with "or the publication of the patent application, or the international publication provided in Article 21 of the Patent Cooperation Treaty signed in Washington on June 19, 1970," and the term "the description, scope of claims for a utility model registration or drawings originally attached to the written application" shall be deemed to be replaced with "the description, scope of claims for a utility model registration, or drawings of an international application as of the international filing date under Article 48-4, paragraph (1) of the Utility Model Act or Article 184-4, paragraph (1) of the Patent Act."

(Special provisions concerning claim of priority based on application for utility model registration)

Article 48-10 (1) The provisions of the proviso to Article 8, paragraph (1), Article 8, paragraph (4) and Article 9, paragraph (2) shall not apply to international applications for utility model registration.

(2) For the purpose of the application of the provisions of Article 8, paragraph (3) to applications for utility model registration in Japanese language, the term "the Utility Model Gazette with regard to the said application for utility model registration was issued" in Article 8, paragraph (3) shall be deemed to be replaced with "the Utility Model Gazette with regard to the said application for utility model registration was issued or the international publication was effected under Article 21 of the Patent Cooperation Treaty signed in Washington on June 19, 1970."

(3) For the purpose of the application of the provisions of Article 8, paragraph (3) to applications for utility model registration in foreign language, the term "in the description, scope of claims for a utility model registration or drawings originally attached to the application in an application for utility model registration" in Article 8, paragraph (3) shall be deemed to be replaced with "the description, scope of claims or drawings of an international application as

of the international filing date referred to in Article 48-4, paragraph (1)," the term "the Utility Model Gazette with regard to the earlier application or the publication of the earlier application shall be deemed to have been issued" shall be deemed to be replaced with "the Utility Model Gazette with regard to the earlier application or the publication of the earlier application shall be deemed to have been issued or the international publication provided in Article 21 of the Patent Cooperation Treaty signed in Washington on June 19, 1970."

- (4) For the purpose of the application of the provisions of Articles 8, paragraphs (1) to (3) and Article 9, paragraph (1), in the case where the earlier application referred to in Article 8, paragraph (1) of this Act is an international application for utility model registration or an international patent application referred to in Article 184-3, paragraph (2) of the Patent Act, the term "the description or scope of claims for a utility model registration or patent, or drawings originally attached to the application" in Articles 8, paragraphs (1) and (2) shall be deemed to be replaced with "the description, scope of claims or drawings of the international application as of the international application date under Article 48-4, paragraph (1) of the Utility Model Act or Article 184-4, paragraph (1) of the Patent Act," the term "the description, scope of claims for a utility model registration or patent or drawings originally attached to the application of the earlier application" in Article 8, paragraph (3) shall be deemed to be replaced with "the description, scope of claims or drawings of the international application of the earlier application as of the international application date under Article 48-4, paragraph (1) of this Act or Article 184-4, paragraph (1) of the Patent Act," the term "publication of unexamined application" in Article 8, paragraph (3) shall be deemed to be replaced with "the international publication provided in Article 21 of the Patent Cooperation Treaty signed in Washington on June 19, 1970," and the term "when a period specified by an Ordinance of the Ministry of Economy, Trade and Industry has lapsed from the application date" in Article 9, paragraph (1) shall be deemed to be replaced with "at the time of the national processing standard time referred to in Article 48-4, paragraph (6) of this Act or Article 184-4, paragraph (6) of the Patent Act or at the time when a period specified by an Ordinance of the Ministry of Economy, Trade and Industry has lapsed from the international filing date under Article 48-4, paragraph (1) of this Act or Article 184-4, paragraph (1) of the Patent Act, whichever comes later."

(Special provisions concerning conversion of application)

Article 48-11 An international application that has been deemed to be a patent application under the provisions of Article 184-3, paragraph (1) or Article 184-20, paragraph (4) of the Patent Act may be converted into an application for utility model registration, only after the fees payable under the provisions of

Article 195, paragraph (2) of the said Act have been paid (or, in the case of an international application that is deemed to be a patent application under the provisions of Article 184-20, paragraph (4) of the said Act, after the decision provided in Article 184-20, paragraph (4) has been rendered), and, in the case of a patent application in Japanese language referred to in Article 184-6, paragraph (2) of the said Act, the procedures pursuant to Article 184-5, paragraph (1) of the said Act have been completed, or, in the case of a patent application in foreign language referred to in Article 184-4, paragraph (1) of the said Act, the procedures under Articles 184-4, paragraph (1) or (4), and 184-5, paragraph (1) of the said Act have been completed.

(Special provisions concerning the time limit for payment of registration fees)  
Article 48-12 For the purpose of the payment of the registration fees of an international application for utility model registration for each year from the first to the third year, the term "at the same time as the filing of the application for utility model registration" in Article 32, paragraph (1) shall be deemed to be replaced with "within the time limit for the submission of national documents provided in Article 48-4, paragraph (1) (in the case where a request for national processing provided in Article 48-4, paragraph (6) is filed, on or before the filing of the request for national processing)."

(Restriction on the timing of filing a request for utility model technical opinion)  
Article 48-13 For the purpose of the filing of a request for utility model technical opinion with respect to an international application for utility model registration, the term "any person" in Article 12, paragraph (1) shall be deemed to be replaced with "after the national processing standard time provided in Article 48-4, paragraph (6) has lapsed, any person."

(Special provisions concerning correction)  
Article 48-13-2 For the purpose of a request for correction under the provisions of Article 14-2, paragraph (1) with respect to an application for utility model registration in foreign language, the term "the description, scope of claims for a utility model registration or drawings attached to the application" in Article 14-2, paragraph (3) shall be deemed to be replaced with "the description, scope of claims or drawings of the international application as of the international application date referred to in Article 48-4, paragraph (1)."

(Special provisions concerning grounds for invalidation)  
Article 48-14 For the purpose of an invalidation trial of utility model registration with respect to an application for utility model registration in foreign language, the term "where the utility model registration has been

granted on an application for a utility model registration with an amendment that does not comply with the requirements as provided in Article 2-2, paragraph (2)" in Article 37, paragraph (1), item (i) shall be deemed to be replaced with "where the matters stated in the description, scope of claims for a utility model registration or drawing attached to the application for the utility model registration with respect to an application for utility model registration in foreign language referred to in Article 48-4, paragraph (1) do not remain within the scope of the matters stated in the description, scope of claims or drawing of the international application as of the international application date referred to in Article 48-4, paragraph (1)."

(Application mutatis mutandis of the Patent Act)

Article 48-15 (1) Provisions of Articles 184-7 (amendment under Article 19 of the Treaty with regard to Patent Application in Japanese Language) and Article 184-8, paragraphs (1) to (3) (amendment under Article 34 of the Treaty) of the Patent Act shall apply mutatis mutandis to amendments to international applications for utility model registration made under the Treaty. In this case, the term "Article 17-2, paragraph (1)" in Articles 184-7, paragraph (2) and 184-8, paragraph (2) shall be deemed to be replaced with "Article 2-2. Paragraph (1) of the Utility Model Act."

(2) The provisions of Article 184-11 (Special provisions concerning patent administrators for overseas residents) of the Patent Act shall apply mutatis mutandis to the procedures for international applications for utility model registration.

(3) The provisions of Articles 184-9, paragraph (6) and 184-14 of the Patent Act shall apply mutatis mutandis to international applications for utility model registration.

(International application deemed to be application for utility model registration by decision)

Article 48-16 (1) Where a refusal provided in Article 25, paragraph (1), item (a) of the Treaty or a declaration provided in Article 25, paragraph (1), item (a) or (b) of the Treaty has been made by the receiving Office referred to in Article 2 (xv) of the Treaty, or a finding provided in Article 25, paragraph (1), item (a) of the Treaty has been made by the International Bureau referred to in Article 2 (xix) of the Treaty in relation to an international application referred to in Article 2 (vii) of the Treaty (limited to applications for utility model registration) which includes Japan as a designated State under Article 4 (1)(ii) of the Treaty, the applicant of the international application may make a request to the effect that the Commissioner of the Patent Office shall render a decision provided in Article 25 (2)(a) of the Treaty as specified by an Ordinance

of the Ministry of Economy, Trade and Industry within a period specified by the Ordinance of the Ministry of Economy, Trade and Industry.

- (2) Any person who makes a request referred to in the preceding paragraph with regard to an international application in foreign language shall submit, at the time of filing the request to the Commissioner of the Patent Office, Japanese translations of documents concerning the international application as specified by an Ordinance of the Ministry of Economy, Trade and Industry, including the description, scope of claims, drawings (limited to the descriptive text in the drawings), and abstract.
- (3) Upon receiving a request referred to in paragraph (1), the Commissioner of the Patent Office shall render a decision on whether the refusal, declaration or finding relating thereto may be justified in the light of the provisions of the Treaty and the Regulations under the Patent Cooperation Treaty.
- (4) Where the Commissioner of the Patent Office has rendered a decision under the provisions of the preceding paragraph to the effect that the refusal, declaration or finding referred to in the said paragraph is not justifiable in the light of the provisions of the Treaty and the Regulations under the Patent Cooperation Treaty, the international application for which the decision was rendered shall be deemed to be an application for utility model registration filed on the date which would have been recognized as the international filing date if no such refusal, declaration or finding had been made for the international application.
- (5) The provisions of Article 48-6, paragraphs (1) and (2), Article 48-7, Article 48-8, paragraph (3), Article 48-9, Article 48-10, paragraphs (1), (3) and (4), and Articles 48-12 to 48-14 of the Utility Model Act and Article 184-3, paragraph (2), Article 184-9, paragraph (6), Article 184-12, paragraph (1) and Article 184-14 of the Patent Act shall apply *mutatis mutandis* to international applications that are deemed to be an application for utility model registration under the provisions of the preceding paragraph. In this case, the technical replacement of terms necessary for the *mutatis mutandis* application of the said provisions shall be specified by Cabinet Order.

## **Chapter VIII Miscellaneous Provisions**

(Registration in the utility model registry)

Article 49 (1) The following matters shall be registered in the utility model registry maintained at the Patent Office:

- (i) the establishment, transfer, modification due to trust, lapse, restoration, or restriction on disposition of utility model rights;
- (ii) the establishment, maintenance, transfer, modification, lapse, or restriction on disposal of exclusive licenses; and

- (iii) the establishment, transfer, modification, lapse, or restriction on disposal of rights of pledge for the purpose of utility model rights or exclusive licenses.
- (2) The utility model registry may be prepared, in whole or in part, in the form of magnetic tapes (including other storage media using a method equivalent thereto that may reliably record and store certain matters, the same shall apply hereinafter).
- (3) In addition to what is provided in the Utility Model Act, matters necessary for registration shall be specified by Cabinet Order.

(Issuance of certificate of utility model registration)

Article 50 (1) The Commissioner of the Patent Office shall issue a certificate of utility model registration to the holder of utility model right when the establishment of the utility model right has been registered, when any correction referred to in Article 14-2, paragraph (1) has been made, or when the transfer of the utility model right has been registered based on a request made under the provisions of Article 17-2, paragraph (1).

(2) Matters with regard to re-issuance of certificates of utility model registration shall be specified by Ordinance of the Ministry of Economy, Trade and Industry.

(Special provisions for utility model registration or utility model right covering two or more claims)

Article 50-2 Concerning utility model registrations or utility model rights covering two or more claims, for the purposes of the application of the provisions of Article 12, paragraph (2), Article 14-2, paragraph (8) of the Utility Model Act, Article 97, paragraph (1) or Article 98, paragraph (1), item (i) of the Patent Act as applied mutatis mutandis pursuant to Article 26 of this Act, Article 34, paragraph (1), item (iii), Article 37, paragraph (3), Article 125 of the Patent Act as applied mutatis mutandis pursuant to Article 41 of this Act, Article 132, paragraph (1) of the Patent Act as applied mutatis mutandis in Article 174, paragraph (3) of the Patent Act as applied mutatis mutandis pursuant to Article 41 or Article 45, paragraph (1) of this Act, Article 44 of this Act, Article 176 of the Patent Act as applied mutatis mutandis pursuant to Article 45, paragraph (1) of this Act, Article 49, paragraph (1), item (i) of this Act, or Article 193, paragraph (2), item (v) of the Patent Act as applied mutatis mutandis pursuant to Article 53, paragraph (2) of this Act, the utility model registration shall be deemed to have been granted, or the utility model right shall be deemed to exist, for each claim.

(Indication of utility model registration)

Article 51 A holder of utility model right, exclusive licensee or non-exclusive licensee shall make efforts to place an indication (hereinafter referred to as an

"indication of utility model registration") as specified by an ordinance of the Ministry of Economy, Trade and Industry, on an article in which a registered utility model has been embodied, or package thereof, indicating to the effect that a registered utility model has been embodied in the article.

(Prohibition of false indication)

Article 52 No person shall commit any of the following acts.

- (i) an act of placing an indication of utility model registration or an indication that is liable to cause confusion therewith on an article in which a registered utility model has not been embodied or on the package thereof;
- (ii) an act of assigning, leasing or displaying for the purpose of assigning or leasing an article in which a registered utility model has not been embodied, or place an indication of utility model registration or an indication that is liable to cause confusion therewith on the article or on the package thereof;  
or
- (iii) Regarding an article in which a registered utility model has not been embodied, an act of placing in an advertisement an indication to the effect that the registered utility model has been embodied in the article or an indication that is liable to cause confusion therewith, for the purpose of having the article manufactured or used, or assigning or leasing the article.

(Utility model gazette)

Article 53 (1) The Patent Office shall publish a utility model gazette.

(2) The provisions of Article 193, paragraph (2) (limited to the parts with respect to items (iv) to (vi), (viii) and (ix)) shall apply mutatis mutandis to the utility model gazettes.

(Fees)

Article 54 (1) The following persons shall pay the amount of fees specified by Cabinet Order in view of the actual costs:

- (i) persons who file a request for extension of the duration under the provisions of Article 5, paragraph (1) of the Patent Act as applied mutatis mutandis pursuant to Article 2-5, paragraph (1) of this Act, Article 32, paragraph (3) of this Act, or Article 4 of the Patent Act as applied mutatis mutandis pursuant to Article 14-2, paragraph (5), Article 39-2, paragraph (4), Article 45, paragraph (2) or Article 54-2, paragraph (5) of this Act, or a request for change of the date under the provisions of Article 5, paragraph (2) of the Patent Act as applied mutatis mutandis pursuant to Article 2-5, paragraph (1) of this Act;
- (ii) persons who notify of succession under the provisions of Article 34, paragraph (4) of the Patent Act as applied mutatis mutandis pursuant to

- Article 11, paragraph (2) of this Act;
- (iii) persons who file a request for re-issuance of a certificate of utility model registration;
  - (iv) persons who file a request for issuance of a certificate under the provisions of Article 186, paragraph (1) of the Patent Act as applied mutatis mutandis pursuant to Article 55, paragraph (1) of this Act;
  - (v) persons who file a request for issuance of a certified copy of documents or an extract of documents under the provisions of Article 186, paragraph (1) of the Patent Act as applied mutatis mutandis pursuant to Article 55, paragraph (1) of this Act;
  - (vi) persons who file a request for inspection or copy of documents under the provisions of Article 186, paragraph (1) of the Patent Act as applied mutatis mutandis pursuant to Article 55, paragraph (1); or
  - (vii) persons who file a request for issuance of documents stating matters stored on the part made of the magnetic tapes in the utility model registry under the provisions of Article 186, paragraph (1) of the Patent Act as applied mutatis mutandis pursuant to Article 55, paragraph (1) of this Act.
- (2) The persons listed in the middle column of the appended table shall pay the amount of fees specified by Cabinet Order within the scope listed in the lower column of the table.
- (3) The provisions of the preceding two paragraphs shall not apply where a person who should pay the fee under these provisions is the State.
- (4) Where the State has joint ownership of a utility model right or the right to obtain a utility model registration with person(s) other than the State, and the portion of their respective shares of the said right has been agreed on, notwithstanding the provisions of paragraph (1) or (2), the fees payable by the State and other persons for their utility model right or right to obtain a utility model registration under the provisions of paragraph (1) or (2) (limited to the fees specified by Cabinet Order other than the fees for the filing of a request for utility model technical opinion) shall be determined as the sum of the fees provided in such provisions multiplied by the ratios of the share of each person other than the State, and, the person(s) other than the State shall pay such sum.
- (5) Where the State or a person entitled to receive a reduction of the fees for the request for utility model technical opinion or exemption therefrom under the provisions of paragraph (8) or of any other laws and regulations (hereinafter referred to as "reduction/exemption" in this paragraph) has joint ownership of a utility model right or the right to obtain a utility model registration with other person(s), and the portion of their respective shares of said right has been agreed on, notwithstanding the provisions of paragraph (2), the fees for the request for utility model technical opinion payable by such persons for

their utility model right or right to obtain a utility model registration under the provisions of paragraph (2) shall be determined as the sum of the amounts calculated for each person other than the State jointly owning the right, by multiplying the applicable fees for the request for utility model technical opinion provided in paragraph (2) (in the case of a person who receives the reduction/exemption, the amount obtained after applying the said reduction/exemption) by the ratios of the share of each person other than the State, and the person(s) other than the State shall pay such sum.

- (6) Where the amount of the fees calculated under the provisions of the two preceding paragraphs has fractional figures less than ten yen, the said portion shall be discarded.
- (7) The payment of the fees referred to in paragraphs (1) and (2) shall be made by patent revenue stamps as specified by an ordinance of the Ministry of Economy, Trade and Industry; provided, however, that where so provided by an Ordinance of the Ministry of Economy, Trade and Industry, a payment in cash thereof may be accepted.
- (8) Where the creator of a device claimed in an application for utility model registration or of a registered utility model, or his/her heir, files a request for utility model technical opinion with regard to the device claimed in the application for utility model registration or the registered utility model, if the Commissioner of the Patent Office recognizes that the person has difficulties in paying the fees for the request for utility model technical opinion to be paid under the provisions of paragraph (2) due to insufficient financial means, he/she may grant the person a reduction of or exemption from the payment of the fees as specified by Cabinet Order.

(Refund of fees)

- Article 54-2 (1) After a request for utility model technical opinion has been filed, where the request is deemed not to have been filed under the provisions of Article 12, paragraph (7), the fees for the request paid under the provisions of Article 54, paragraph (2) shall be refunded to the person.
- (2) Where a request for invalidation trial of utility model registration has been withdrawn within the period provided in Article 39-2, paragraph (3) or (5) (or, in the case where the period provided in Article 39-2, paragraph (3) has been extended under the provisions of Article 4 of the Patent Act as applied mutatis mutandis pursuant to Article 39-2, paragraph (4), within the extended period), the fees for the request for invalidation trial paid under the provisions of Article 54, paragraph (2) shall be refunded to the person upon his/her request.
- (3) No request for refund of the fees under the provisions of the preceding paragraph may be filed after six months have elapsed from the date on which the request for invalidation trial of utility model registration was withdrawn.

- (4) Where an intervenor of an invalidation trial of utility model registration has withdrawn his/her application for intervention within 30 days from the receipt of notice under the provisions of Article 39, paragraph (5), the fees for filing the application for intervention paid by the intervenor under the provisions of Article 54, paragraph (2) shall be refunded to the intervenor upon his/her request.
- (5) The provisions of Article 4 of the Patent Act shall apply mutatis mutandis to the period provided in paragraph (4). In this case, the term "The Commissioner of the Patent Office" in the said Article shall be deemed to be replaced with "The chief trial examiner."
- (6) Where, due to reasons beyond the control of an intervenor of an invalidation trial of utility model registration, he/she is unable to withdraw the application for intervention within the period provided in paragraph (4), if the intervenor has withdrawn the application within 14 days (in the case where the intervenor is an overseas resident, within two months) from the date on which the reasons ceased to exist and not later than six months following the expiration of the said period, notwithstanding the provisions of the said paragraph, the fees for filing the application for intervention paid by the intervenor under the provisions of Article 54, paragraph (2) shall be refunded to the intervenor upon his/her request.
- (7) No request for refund of the fees under the provisions of paragraphs (4) and (6) may be filed after six months have lapsed from the date on which the application for intervention was withdrawn.
- (8) Where an intervenor of an invalidation trial of utility model registration has not withdrawn his/her application for intervention, if the request for trial is withdrawn within the period provided in paragraph (4) or (6) (or, in the case where the period provided in paragraph (4) has been extended under the provisions of Article 4 of the Patent Act as applied mutatis mutandis pursuant to paragraph (5), within the extended period), the fees for the application for intervention paid by the intervenor under Article 54, paragraph (2) shall be refunded to the intervenor upon his/her request; provided, however, that this shall not apply where the trial procedures have been continued under the provisions of 148, paragraph (2) of the Patent Act as applied mutatis mutandis pursuant to Article 41.
- (9) No request for refund of the fees under the provisions of the preceding paragraph may be filed after one year has lapsed from the date on which the request for invalidation trial of utility model registration was withdrawn.
- (10) Fees paid in excess or in error shall be refunded upon the request of the person who made a payment thereof.
- (11) No request for refund of the fees under the provisions of paragraph (11) may be filed after one year has lapsed from the date on which the payment thereof

has been made.

- (12) Where, due to reasons beyond the control of a person who files a request for refund of fees under the provisions of paragraphs (2), (4) or (6), (8) or (10), within the period provided in paragraphs (3), (7), (9) or (11), notwithstanding the provisions of these paragraphs, the person may file such a request within 14 days (in the case where the person is an overseas resident, within two months) from the date on which the reasons ceased to exist and not later than six months following the expiration of the period provided in these provisions.

(Application mutatis mutandis of the Patent Act)

- Article 55 (1) The provisions of Article 186 (request for certificate, etc.) of the Patent Act shall apply mutatis mutandis to utility model registrations.
- (2) The provisions of Articles 189 to 192 (service) of the Patent Act shall apply mutatis mutandis to services under the provisions of this Act.
- (3) The provisions of Article 194 of the Patent Act shall apply mutatis mutandis to the procedures. In this case, the term "an examination" in paragraph (2) of the said Article shall be deemed to be replaced with "a utility model technical opinion provided in Article 12, paragraph (1) of the Utility Model Act."
- (4) The provisions of Article 195-3 of the Patent Act shall apply mutatis mutandis to dispositions under the provisions of this Act or regulations for order issued based on this Act.
- (5) The provisions of Article 195-4 (Restriction on request for examination under the provisions of the Administrative Appeal Act) of the Patent Act shall apply mutatis mutandis to trial decisions, decisions dismissing a written request for trial or retrial, and dispositions against which no appeal may be filed or inaction under the provisions of this Act.

## **Chapter IX Penal Provisions**

(Crime of infringement)

- Article 56 Any person who infringes a utility model right or exclusive license shall be punished by imprisonment with work for a term not exceeding five years or a fine not exceeding 5,000,000 yen or combination thereof.

(Crime of fraud)

- Article 57 Any person who has obtained a utility model registration or a trial decision by means of a fraudulent act shall be punished by imprisonment with work for a term not exceeding one year or a fine not exceeding 1,000,000 yen.

(Crime of placing false indication)

- Article 58 Any person who violates the provisions of Article 52 shall be punished

by imprisonment with work for a term not exceeding one year or a fine not exceeding 1,000,000 yen.

(Crime of perjury, etc.)

Article 59 (1) Any witness, expert witness or interpreter who has sworn under the provisions of this Act and made a false statement or given a false expert opinion or interpretation to the Patent Office or the court commissioned thereby shall be punished by imprisonment with work for a term not less than three months but not exceeding ten years.

(2) Where any person who has committed a crime referred to in the preceding paragraph has made a voluntary confession before a certified copy of the judgment relating to the case has been served or a trial decision has become final and binding, the punishment may be reduced or exculpated.

(Crime of divulging secrets)

Article 60 Any present or former official of the Patent Office who has divulged or misappropriated any secret relating to a device claimed in a pending application for utility model registration that has become known to him/her in the course of performing his/her duties shall be punished by imprisonment with work for a term not exceeding one year or a fine not exceeding 500,000 yen.

(Crime of violation of protective order)

Article 60-2 (1) Any person who violates a protective order under the provisions of Article 105-4, paragraph 1 of the Patent Act as applied mutatis mutandis pursuant to Article 30 shall be punished by imprisonment with work for a term not exceeding five years or a fine not exceeding 5,000,000 yen or combination thereof.

(2) The public prosecution of the crime referred to in the preceding paragraph may not be instituted unless a complaint is filed.

(3) The crime referred to in paragraph (1) shall apply to any person who commits the crime outside Japan.

(Dual liability)

Article 61 (1) Where a representative of a juridical person, or an agent, employee or other worker of a juridical person or an individual has committed, in the course of performing his/her duties for the juridical person or individual, any act in violation of the provisions listed in any of the following items, in addition to the offender, the juridical person shall be punished by a fine as specified in the respective items and the individual shall be punished by a fine as referred to in the Article:

- (i) Article 56 or 60-2, paragraph (1), a fine not exceeding 300 million yen; and
  - (ii) Article 57 or 58, a fine not exceeding 30 million yen.
- (2) In the case of the preceding paragraph, a complaint referred to in Article 60-2, paragraph (2) against the offender shall also have effect on the juridical person or individual and a complaint against the juridical person or individual shall also have effect on the offender.
- (3) Where a fine is imposed on any juridical person or individual under the provisions of paragraph (1) with regard to any act committed in violation of Article 56 or 60-2, paragraph (1), the period of prescription provided for the crime in these Articles shall apply.

(Civil fine)

Article 62 Where any person who has sworn under the provisions of Article 207, paragraph (1) of the Code of Civil Procedure as applied *mutatis mutandis* under Article 151 of the Patent Act which is applied *mutatis mutandis* under Articles 71, paragraph (3) of the Patent Act as applied *mutatis mutandis* pursuant to Article 26 of this Act, is applied *mutatis mutandis* under Article 41 of this Act, or is applied *mutatis mutandis* under Article 174, paragraph (3) of the Patent Act as applied *mutatis mutandis* pursuant to Article 45, paragraph (1) of this Act has made a false statement before the Patent Office or a court commissioned thereby, the said person shall be punished by a civil fine not exceeding 100,000 yen.

Article 63 Any person who has been summoned by the Patent Office or a court commissioned thereby under the provisions of this Act, and fails to appear or refuses to swear, make a statement, testify, give an expert opinion or interpret, without a justifiable ground, shall be punished by a civil fine not exceeding 100,000 yen.

Article 64 Any person who has been ordered by the Patent Office or a court commissioned thereby to submit or present documents or other materials for the purpose of examination or preservation of evidence under the provisions of this Act and fails to comply with the order, without a justifiable ground, shall be punished by a civil fine not exceeding 100,000 yen.

### **Supplementary Provisions**

The effective date of this Act shall be prescribed separately by an Act.

**Supplementary Provisions [Act No. 140 of May 16, 1962 Extract] [Extract]**

- (1) This Act shall come into effect as from October 1, 1962.
- (2) Unless otherwise provided for in the Supplementary Provisions, the provisions revised by this Act shall also apply to any matters that have arisen prior to the enforcement of this Act; provided, however, that this shall not preclude the effect that has arisen under the provisions prior to revision by this Act.
- (3) With regard to lawsuits actually pending at the time of the enforcement of this Act, the provisions then in force shall remain applicable, notwithstanding the provisions revised by this Act to the effect that the lawsuits may not be filed.
- (4) With regard to jurisdiction over lawsuits actually pending at the time of the enforcement of this Act, the provisions then in force shall remain applicable, notwithstanding the provisions revised by this Act to the effect that the jurisdiction shall be the exclusive jurisdiction.
- (5) With regard to the statute of limitations for filing a lawsuit concerning a disposition or determination, for which the statute of limitations for filing a lawsuit pursuant to the provisions prior to revision by this Act has actually progressed at the time of the enforcement of this Act, the provisions then in force shall remain applicable; provided, however, that this shall be limited to the cases where the statute of limitations for filing a lawsuit pursuant to the provisions revised by this Act is shorter than that pursuant to the provisions prior to revision by this Act.
- (6) The statute of limitations for filing a party suit concerning a disposition imposed or a determination made prior to the enforcement of this Act, for which the statute of limitations has come to be set due to the revision by this Act, shall be counted from the date of enforcement of this Act.
- (7) With regard to actions seeking rescission of a disposition or determination that are actually pending at the time of the enforcement of this Act, the provisions then in force shall remain applicable, notwithstanding the provisions revised by this Act to the effect that one party to the legal relationship shall be the defendant; provided, however, that the court may, upon the plaintiff's application, permit to change the action into a party suit by its ruling.
- (8) The provisions of the second sentence of Article 18, and Article 21, paragraphs (2) to (5) inclusive of the Administrative Case Litigation Act shall apply mutatis mutandis to the cases referred to in the proviso to the preceding paragraph.

**Supplementary Provisions [Act No. 161 of September 15, 1962 Extract]  
[Extract]**

- (1) This Act shall come into effect as from October 1, 1962.
- (2) The provisions revised by this Act shall also apply to the dispositions by an administrative agency taken prior to the enforcement of this Act, the inaction by an administrative agency pertaining to an application filed prior to the enforcement of this Act or other matters that have arisen prior to the enforcement of this Act, except as otherwise provided for in these Supplementary Provisions; provided, however, that those provisions shall not preclude the effect that has arisen pursuant to the provisions prior to revision by this Act.
- (3) With regard to petitions, applications for examination, objections or other appeals (hereinafter referred to as "Petitions, etc.") filed prior to the enforcement of this Act, the provisions then in force shall remain applicable even after the enforcement of this Act. The same shall apply to Petitions, etc. filed in the case of dissatisfaction with determinations, rulings or other dispositions on Petitions, etc., which have been made prior to the enforcement of this Act (hereinafter referred to as "Determinations, etc."), or a judgment, etc., made after the enforcement of this Act in regard to Petitions, etc., filed prior to the enforcement of this Act.
- (4) The Petitions, etc. prescribed in the preceding paragraph that relate to a disposition on which an appeal may be filed pursuant to the Administrative Appeal Act after this Act comes into effect shall be deemed to be appeals pursuant to the Administrative Appeal Act with regard to the application of the Acts other than said Act.
- (5) No appeal pursuant to the Administrative Appeal Act may be entered against the Determinations, etc. on an application for examination, an objection or other appeals filed after this Act comes into effect pursuant to the provision of paragraph (3).
- (6) With regard to a disposition imposed by an administrative agency prior to the enforcement of this Act, on which the Petitions, etc. may be filed pursuant to the provisions prior to revision by this Act and for which the statute of limitations has not been set, the statute of limitations for filing an appeal pursuant to the Administrative Appeal Act shall be counted from the date of enforcement of this Act.
- (8) With regard to the application of penal provisions to acts committed prior to the enforcement of this Act, the provisions then in force shall remain applicable.
- (9) In addition to what is prescribed for in the foregoing eight paragraphs, transitional measures necessary for the enforcement of this Act shall be specified by a Cabinet Order.

**Supplementary Provisions [Act No. 148 of July 4, 1964]**

This Act shall come into effect as from the date specified by a Cabinet Order within a period not exceeding nine months from the date of promulgation.

**Supplementary Provisions [Act No. 81 of May 24, 1965 Extract] [Extract]**

This Act shall come into effect as from the date on which the Accession to the Paris Convention for the Protection of Industrial Property of March 20, 1883, as revised at Brussels on December 14, 1900, at Washington on June 2, 1911, at Hague on November 6, 1925, at London on June 2, 1934, at Lisbon on October 31, 1958, and at Stockholm on July 14, 1967.

**Supplementary Provisions [Act No. 91 of May 22, 1970 Extract] [Extract]**

(Effective date)

Article 1 This Act shall come into effect as from January 1, 1971.

(Application to the Patent Act prior to revision)

Article 2 With regard to patent applications actually pending before the Japan Patent Office at the time of the enforcement of this Act, until the examiner's decision or a trial decision for the patent applications becomes final and binding, the provisions then in force shall remain applicable, except where it has otherwise been provided for.

(Patent fees)

Article 3 With regard to patent fees that have been paid or should be paid prior to the enforcement of this Act, notwithstanding Article 107, paragraph (1) of the revised Patent Act (hereinafter, referred to as the "New Patent Act"), the provisions then in force shall remain applicable.

(Grounds for invalidation of a patent)

Article 4 With regard to grounds for invalidation of patent applications that have been filed prior to the enforcement of this Act, the provisions then in force shall remain applicable notwithstanding Article 29-2 and Article 123, paragraph (1), item (i) of the new Patent Act.

(Fees for filing a patent application)

Article 5 Provisions of Article 195, paragraph (1) of the new Patent Act shall apply to fees to be paid after the enforcement of this Act; provided, however, that, with respect to fees of item (iv) of the appended table of the new Patent Act, those shall not apply to the patent applications filed prior to the

enforcement of this Act.

(Transitional measures upon revision of the Utility Model Act)

Article 6 Provisions of Article 2 through the preceding Article of the Supplementary Provisions shall apply mutatis mutandis with respect to transitional measures upon revision of the Utility Model Act pursuant to the provision of Article 2.

(Delegation to a Cabinet Order)

Article 9 In addition to what is prescribed by the preceding Articles, transitional measures necessary for the enforcement of this Act shall be specified by a Cabinet Order.

**Supplementary Provisions [Act No. 96: June 1, 1971 Extract] [Extract]**

(Effective date, etc.)

(1) This Act shall come into effect as from the date of promulgation.

**Supplementary Provisions [Act No. 46: June 1, 1975 Extract] [Extract]**

(Effective date)

Article 1 This Act shall come into effect as from January 1, 1976; provided, however, that the revising provisions listed as follows shall come into effect as from the date listed in the relevant item:

- (i) The date of promulgation of :the revised provisions of the table of Article 107 (1) of the Patent Act and of the appended table of the Patent Act, among provisions of Article 1; the revised provisions of Article 31, paragraph (1) of the Utility Model Act and of the appended table of the Utility Model Act, among provisions of Article 2; the revised provisions of Articles 42, paragraphs (1) and (2) of the Utility Model Act and of the appended table of the Utility Model Act, among provisions of Article 3; the revised provisions of Articles 40, paragraphs (1) and (2) of the Trademark Act and of the appended table of the Trademark Act, among provisions of Article 4; and the provisions of paragraph (2) of the following Article and of Articles 3, paragraph (1), and 4 of the Supplementary Provisions.
- (ii) The effective date of the revised provisions of the proviso to Article 17, paragraph (1) (excluding the part revising "and Article 64" to "Articles 17-3 and 64"), among provisions of Article 1; the revised provisions Article 13-2, paragraph (1) of the Utility Model Act among provisions of Article 2; the revised provisions of Article 4, paragraph (1) item (ii), Article 9, paragraph (1) among provisions of Article 4 and the provisions of Article 5; and the

provisions of Articles 1 to 12 of the Paris Convention pursuant to the provisions of Article 20, paragraph (2), item (C) of the Paris Convention for the Protection of Industrial Property of March 20, 1883, as revised at Brussels on December 14, 1900, at Washington on June 2, 1911, at Hague on November 6, 1925, at London on June 2, 1934, at Lisbon on October 31, 1958, and at Stockholm on July 14, 1967.

(Transitional measures upon revision of the Patent Act)

- Article 2 (1) With respect to patent applications actually pending at the time of enforcement of this Act, the provision then in force shall remain applicable until the examiner's decision or trial decision for the patent applications has become final and binding, except the fees that should be paid pursuant to the provision of Article 195, paragraph (1) of the revised Patent Act.
- (2) With respect to patent fees that have been paid or should be paid prior to the date prescribed by item (i) of the proviso through the preceding Article, the provisions then in force shall remain applicable, notwithstanding the provision of Article 107, paragraph (1) of the revised Patent Act.
- (3) With respect to grounds for invalidation of patent applications that have been filed prior to the enforcement of this Act, the provisions then in force shall remain applicable.

(Transitional measures upon revision of the Utility Model Act)

- Article 3 (1) The provision of paragraph (1) of the preceding Article shall apply mutatis mutandis to utility model applications actually pending before the Japan Patent Office at the time of the enforcement of this Act, and the provision of paragraph (3) of the preceding Article shall apply mutatis mutandis to ground for invalidation of utility model registrations pertaining to utility models that have been filed prior to the enforcement of this Act.
- (2) The provisions of the paragraph (2) of the preceding Article shall apply mutatis mutandis to registration fees that have been paid or should be paid prior to the date prescribed by item (i) of the proviso to Article 1 of Supplementary Provisions.

### **Supplementary Provisions [Act No. 27 of April 24, 1978 Extract] [Extract]**

(Effective date)

- (1) This Act shall come into effect as from the date of promulgation; provided, however, that the revised provisions of paragraph (1) of Article 11 of the Act on Real Estate Appraising and Valuation in Article 1 of this Act, the provisions of Articles 2, 3, 5 and 6, the revised provisions of paragraph (1) of Article 107 of the Patent Act in Article 19 of this Act, the revised provisions of paragraph (1)

of Article 31 of the Utility Model Act in Article 20 of this Act, the revised provisions of paragraphs (1) and (2) of Article 42 of the Design Act in Article 21 of this Act, the revised provisions of paragraphs (1) and (2) of Article 40 of the Trademark Act in Article 22 of this Act, the revised provisions of paragraph (2) of Article 5 of the Guide Interpreter Act in Article 28 of this Act, and the provisions of Articles 29 and 30 shall come into effect as from May 1, 1978.

(Transitional measures)

(2) With regard to the following examination fees, etc., the provisions then in force shall remain applicable.

(i) to (iii) snipped

(iv) The registration fees that have been paid or should be paid prior to the enforcement of the revised provisions of Article 31, paragraph (1) of the Utility Model Act.

#### **Supplementary Provisions [Act No. 30 of April 26, 1978 Extract] [Extract]**

(Effective date)

Article 1 This Act shall come into effect as from the day when the Convention becomes effective in Japan; provided however, that the provisions of Chapter III shall come into effect as from the day when the agreement prescribed by Article 16 (3)(b) of the Convention comes into effect in the Japan Patent Office, and the provisions of Chapter IV and the following Article shall come into effect as from the day when the agreement prescribed by Article 16 (3)(b) of the Convention as applied mutatis mutandis pursuant to Article 32 (3) of the Convention comes into effect in the Japan Patent Office.

#### **Supplementary Provisions [Act No. 30 of May 19, 1981 Extract] [Extract]**

(Effective date)

(1) This Act shall come into effect as from the date of promulgation; provided however, that the revised provisions of Article 11, paragraph (1) of the Act on Real Estate Appraising and Valuation in Article 1 of this Act, the provisions of Articles 2, 3, 5 and 6, the revised provisions of Article 107, paragraph (1) of the Patent Act in Article 19 of this Act, the revised provisions of Article 31, paragraph (1) of the Utility Model Act in Article 20 of this Act, the revised provisions of Article 42, paragraphs (1) and (2) of the Design Act in Article 21 of this Act, the revised provisions of Article 40, paragraphs (1) and (2) of the Trademark Act in Article 22 of this Act, the revised provisions of paragraph (2) of Article 5, paragraph (2) of the Guide Interpreter Act in Article 29 of this Act, and the provisions of Articles 30 shall come into effect as from June 1, 1981.

(Transitional measures)

(2) With regard to the following examination fees, etc., the provisions then in force shall remain applicable.

(i) to (iii) snipped

(iv) The registration fees that have been paid or should be paid prior to the enforcement of the revised provisions of Article 31, paragraph (1) of the Utility Model Act.

**Supplementary Provisions [Act No. 23 of May 1, 1984 Extract] [Extract]**

(Effective date)

(1) This Act shall come into effect as from the date on which twenty days have lapsed from the date of promulgation; provided however, that the provisions of Articles 24 through 27 and paragraphs (3) and (4) of Supplementary Provisions shall come into effect as from August 1, 1984.

(Transitional measures)

(2) With regard to the following examination fees, etc., the provisions then in force shall remain applicable.

(i) and (ii) snipped

(iii) The registration fees that have been paid or should be paid prior to the enforcement of the revised provisions of Article 31, paragraph (1) of the Utility Model Act.

**Supplementary Provisions [Act No. 24 of May 1, 1984 Extract] [Extract]**

(Effective date)

Article 1 This Act shall come into effect as from July 1, 1984.

(Transitional Measures upon the start of payment by patent revenue stamps)

Article 8 Notwithstanding the provisions of the Patent Act, the revised Utility Model Act, the revised Design Act, the revised Trademark Act or the revised Act on the International Applications under the Patent Cooperation Treaty that are revised pursuant to Article 3 through the preceding Article of Supplementary Provisions, when patent fees, patent surcharges, fees, registration fees, or registration surcharges are paid within two weeks as from the date of enforcement of this Act, revenue stamps or patent stamps may be used.

**Supplementary Provisions [Act No. 41 of May 28, 1985 Extract] [Extract]**

(Effective date)

Article 1 This Act shall come into effect as from the date to be specified by a Cabinet Order within a period not exceeding six months from the date of promulgation.

(Transitional measures)

Article 3 With respect to amendments on the description or the drawings attached to an application for patent or utility model registration (limited to those filed prior to the service of a certified copy of ruling that publication of an unexamined application should be done), which have been filed prior to the enforcement of this Act and have been dismissed by a ruling that they change the gist of the description or drawings attached to the said application, the provisions of the Patent Act and the Utility Model Act prior to revision by this Act shall remain applicable even after the enforcement of this Act.

Article 4 With regard to the application of penal provisions to acts committed prior to the enforcement of this Act, the provisions then in force shall remain applicable

(Delegation to a Cabinet Order)

Article 5 In addition to what is prescribed by the preceding Articles, transitional measures necessary for the enforcement of this Act shall be specified by a Cabinet Order.

### **Supplementary Provisions [Act No. 27 of May 25, 1987 Extract] [Extract]**

(Effective date)

Article 1 This Act shall come into effect as from January 1, 1988; provided, however, that the provisions listed as follows shall come into effect as from the date listed in the relevant item:

- (i) The revised provisions adding a second sentence to Article 15, paragraph (1) of the Design Act, the revised provisions of Article 42, paragraphs (1) and (2) of the said Act, the revised provisions of Article 49 of the said Act and the revised provisions of the appended table of the said Act, in the provisions of Articles 1, 3 and 5 of this Act; the revised provisions adding a second sentence to Article 13, paragraph (1) of the Trademark Act, the revised provisions of Article 40, paragraphs (1) and (2) of the said Act, and the revised provisions of the appended table of the said Act, in the provisions of Article 6 of this Act; and the revisions of the next Article, Articles 4, 6, 7, 8 and 11 of Supplementary Provisions: June 1, 1987

(ii) The provisions for revising Article 184-4, paragraphs (1) to (4) of the Patent Act, the provisions for revising Article 184-5, paragraphs (1) and (2), items (i) and (iv) of the said Act, the provisions for revising Article 184-6, paragraph (2) of the said Act, the provisions for revising Article 184-7, paragraph (1) of the said Act, the provisions for revising Article 184-8 of the said Act, the provisions for revising Article 184-9, paragraph (1) of the said Act, the provisions for revising Article 184-10-2, paragraphs (1) and (2) of the said Act, the provisions for revising Article 184-11, paragraph (1) of the said Act, the provisions for revising Article 184-11-2 of the said Act, the provisions for revising Article 184-11-3, paragraph (4) of the said Act, the provisions for revising Article 184-12 of the said Act, the provisions for revising Article 184-13 of the said Act and the provisions for revising Article 184-16, paragraph (5) of the said Act, in the provisions of Article 2 of this Act; the provisions for revising Articles 48-4, paragraphs (1) to (4) of the Utility Model Act, the provisions for revising Article 48-5, paragraphs (1) and (2), items (i) and (iv) of the said Act, the provisions for revising Article 48-6, paragraph (2) of the said Act, the provisions for revising Article 48-7, paragraphs (1) and (2), the provisions for revising Article 48-8, paragraph (1) of the said Act, the provisions for revising Article 48-8-2, paragraph (4) of the said Act, the provisions for revising Article 48-9 of the said Act, the revisions for revising 48-10 of the said Act, and the provisions for revising Article 48-14, paragraphs (5) of the said Act in the provisions of Article 4 of this Act; and provisions for revising Article 13-2, paragraphs (1) and (2) of the Design Act, in the provisions of Article 5 of this Act: the day when the revocation of the declaration under the Article 64, paragraph (2), item (a) of the Patent Cooperation Treaty provided for in said Article, paragraph (6) (b) of the Treaty signed in Washington on June 19, 1970 pursuant to the provisions of Article 64, paragraph (6), item (b) of the said Act becomes effective

(Transitional measures upon revision of the Utility Model Act pursuant to the provisions of Article 3)

- Article 4 (1) With regard to registration fees that have already been paid prior to the date prescribed by item (i) in the proviso of Article 1 of the Supplementary Provisions or those that should be paid prior to the same date, of which payment is deferred pursuant to the provisions of Article 109 of the Patent Act applied *mutatis mutandis* in Article 34 of the Utility Model Act (limited to those to be paid within the grace period thereof), the provisions then in force shall remain applicable, notwithstanding the provisions of Article 31, paragraph (1) of the Utility Model Act revised by the provisions of Article 3.
- (2) With regard to the trial of Article 37, paragraph (1) pertaining to the utility model right of which establishment has been registered prior to the date

prescribed by item (i) in the proviso of Article 1 of Supplementary Provisions, the provisions of Article 38 of the Utility Model Act prior to revision pursuant to the provisions of Article 3 shall remain applicable even after the said date

(Transitional measures upon revision of the Utility Model Act pursuant to the provisions of Article 4)

Article 5 (1) The provisions of Article 5, paragraph (4), Article 6, Article 11, item (iii), Article 37, paragraph (1) the non-itemized part thereof, item (iii), Article 41, Article 50-2 and Article 54, paragraph (3) of the revised Utility Model Act pursuant to the provisions of Article 4 (hereinafter referred to as the "new Utility Model Act") shall apply to applications of utility model registration filed after the enforcement of this Act, and with regard to applications of utility model registration filed prior to the enforcement of this Act, the provisions then in force shall remain applicable.

(2) With regard to the application of the provisions of Article 31, paragraph (1) of the new Utility Model Act regarding the payment of registration fees pertaining to applications of utility model registration filed prior to the enforcement of this Act, the amounts of registration fees listed in the table of the said paragraph shall be the amounts listed in the following table.

Period within term	Amount
First to third year	Annually 2,100 yen plus 100 yen per claim
Fourth to sixth year	Annually 6,100 yen plus 300 yen per claim
Seventh to tenth year	Annually 18,100 yen plus 900 yen per claim

(3) With regard to the application of the provisions of paragraph (2) of Article 54 of the new Utility Model Act regarding the payment of fees pertaining to applications of utility model registration filed prior to the enforcement of this Act, in item (iv) of the appended table "31,000 yen plus 1,000 yen per claim" shall be "32,000 yen", and in item (ix) of the same table "39,600 yen plus 4,400 yen per claim" shall be "44,000 yen".

(Delegation to a Cabinet Order)

Article 11 In addition to what is prescribed by Articles 2 to 6 and 8 of Supplementary Provisions, transitional measures necessary for the enforcement of this Act shall be specified by a Cabinet Order.

**Supplementary Provisions [Act No. 30 of June 13, 1990 Extract] [Extract]**

(Effective date)

Article 1 This Act shall come into effect as from the date to be specified by a Cabinet Order within a period not exceeding one year from the date of promulgation; provided however, that the provisions of Articles 9 and 14, Article 15, paragraph (2), Article 16 (excluding the parts pertaining to application mutatis mutandis of Articles 15, paragraphs (1) and (3)), Articles 17 to 19, 21, 22, 24 to 29, and 30 (excluding item (iii)), Articles 32, 34, 36, 37, and 39 (excluding the parts pertaining to application mutatis mutandis of Articles 23, 30, 31 and 35), Articles 41 and 42, Article 44, item (ii) and Article 9 of Supplementary Provisions, and the provisions for revising Article 2, paragraph (2) of the Act on Payment of money for national revenue by revenue stamps (Act No. 142 of 1948) in Article 2, paragraph (2) of Supplementary Provisions shall come into effect as from the date to be specified by a Cabinet Order within a period not exceeding six months from the date of promulgation.

(Delegation to a Cabinet Order)

Article 9 Procedures for consolidating Electronic Data Processing System prior to the date of enforcement of this Act and other transitional measures necessary for the enforcement of this Act shall be specified by a Cabinet Order.

### **Supplementary Provisions [Act No. 26 of April 23, 1993 Extract] [Extract]**

(Effective date)

Article 1 This Act shall come into effect as from the date to be specified by a Cabinet Order within a period not exceeding one year from the date of promulgation; provided however, that the provisions for revising the table of Article 107, paragraph (1), the provisions for revising the appended table of the said Act (excluding a part deleting "(including opposition pertaining to publication of request" in item (vi) of the same table), and a part changing item (xii) of the same table to item (xiii) of the same table and adding item (i) next to (xi) of the same table); the provisions of Article 2 in the provisions of Article 1 of this Act; the revised provisions in Article 42, paragraphs (1) and (2) of the Design Act, and the provisions for revising the appended table of the said Act in the provisions of Article 4 of this Act; in the provisions of Article 5, the provisions for revising Article 40, paragraphs (1) and (2) of the Trademark Act and the provisions for revising the appended table of the said Act; and the provisions of paragraph (3) of the following Article and Articles 3, 6 to 10 and 17 of Supplementary Provisions shall come into effect as from July 1, 1993.

(Transitional measures upon revision of the Utility Model Act pursuant to the provisions of Article 2)

Article 3 With regard to registration fees that have already been paid prior to the date prescribed by the proviso to Article 1 of the Supplementary Provisions under the provisions of Article 31, paragraph (1) of the Utility Model Act prior to revision pursuant to Article 2 or those that should be paid prior to the same date under the said paragraph, of which payment is deferred pursuant to the provisions of Article 109 of the former Patent Act applied mutatis mutandis in Article 34 of the Utility Model (limited to those to be paid within the grace period thereof), the provisions then in force shall remain applicable, notwithstanding the provisions of Article 31, paragraph (1), of the Utility Model Act revised by the provisions of Article 2.

(Transitional measures upon revision of the Utility Model Act pursuant to the provisions of Article 3)

Article 4 (1) With regard to utility model applications (excluding those filed under the former Utility Model Act prescribed in paragraph (1) of the following Article) actually pending at the time of the enforcement of this Act or the utility model registration, the utility model right, the examiner's decision or the trial decision pertaining to a utility model application filed prior to the enforcement of this Act, the provisions of the Utility Model Act prior to revision (hereinafter referred to as "the former Utility Model Act") pursuant to the provisions of Article 3, the Patent Attorneys Act prior to revision (Act No. 100 of 1921) pursuant to the provisions of Article 11 of Supplementary Provisions, the Export Commodities Design Act prior to the revision pursuant to the provisions of Article 12 of Supplementary Provisions (Act No. 106 of 1959), the former Patent Act, the Design Act prior to revision pursuant to the provisions of Article 4 and the Act on Special Provisions of Procedures, etc. concerning Industrial Property Rights prior to revision pursuant to Article 15 of Supplementary Provisions (Act No. 30 of 1990, hereinafter referred to as "the former Special Act" in this paragraph) shall remain applicable. In this case, the term "Ordinance of Ministry of International Trade and Industry" in Article 54, paragraph (5) of the former Utility Model Act and in Articles 6, paragraph (3), Article 7, paragraph (1), and Article 8, paragraph (1) of the former Patent Act, shall be replaced with "Ordinance of the Ministry of Economy, Trade and Industry."

(2) In a case of the preceding paragraph, with regard to a trial under Article 37, paragraph (1), Article 39, paragraph (1) or, Article 48-12, paragraph (1) of the former Utility Model Act appealed after the enforcement of the Partial Amendment of the Patent Act (Act No. 63 of 2011, hereinafter referred to as "2011 Amendment Act"), in the provisions listed in the left-hand column of the following table of the former Utility Model Act, which shall remain in force pursuant to the provisions of the preceding paragraph, the terms and phrases

listed in the middle column shall be deemed to be replaced with the terms and phrases listed in the right-hand column of the same table, and any other technical replacement of terms necessary for application of the provisions of the said paragraph shall be specified by a Cabinet Order.

Article 7-2, paragraph (2)	and Article 39, paragraph (3)	and Article 39, paragraph (7) (including cases where applied mutatis mutandis pursuant to paragraph (9) of Article 40-2)
Article 37	<p>Article 37 (1) Where a utility model registration falls under any of the following items, a request for a trial for invalidation of utility model registration may be filed. In the event of two or more claims, a request for a trial for invalidation of utility model registration may be filed for each claim.</p> <p>(i) where the utility model registration has been granted in violation of Article 25 of the Patent Act as applied mutatis mutandis pursuant to Article 2-5 (3) of this Act, Article 3, Article 3-2, Article 4, paragraphs (1) to (3) of Article 7 or Article 7(7) of this Act, or Article 38 of the Patent Act as applied mutatis mutandis pursuant to Article 11(1) of this Act;</p> <p>(ii) where the utility model registration has been granted in violation of a treaty;</p>	<p>Article 37 (1) Where a utility model registration falls under any of the following items, a request for a trial for invalidation of utility model registration may be filed. In the event of two or more claims, a request for a trial for invalidation of utility model registration may be filed for each claim.</p> <p>(i) where the utility model registration has been granted in violation of Article 25 of the Patent Act as applied mutatis mutandis pursuant to Article 2-5 (3) of this Act, Article 3, Article 3-2, Article 4, paragraphs (1) to (3) of Article 7 or Article 7(7) of this Act, or Article 38 of the Patent Act as applied mutatis mutandis pursuant to Article 11(1) of this Act;</p> <p>(ii) where the utility model registration has been granted in violation of a treaty;</p> <p>(ii)-2 where the correction of the description or the drawings attached to the application of the utility model registration has been made in violation of the provisions of Article 39, paragraph (1), the proviso or paragraphs (5) through (7) (including cases where applied mutatis mutandis pursuant to Article 40-2, paragraph (9)), or Article 40-2, paragraph (1), the proviso;</p>

(iii) where the utility model registration has been granted with respect to an application for utility model registration that does not comply with the requirements provided in Article 5, paragraphs (4) or (5) (excluding item (iii)) and (6);  
(iv) where the utility model registration has been granted on an application for a utility model registration filed by a person who is not the creator of the device and has not succeeded to the right to obtain a utility model registration for the said device; and  
(v) where, after the grant of a utility model registration, the holder of utility model right has become unable to hold a utility model right under Article 25 of the Patent Act as applied mutatis mutandis pursuant to Article 55, paragraph (3), or the utility model registration has become in violation of a treaty.  
(2) A request for the trial of the preceding paragraph may be filed even after the utility model right has lapsed.

(iii) where the utility model registration has been granted with respect to an application for utility model registration that does not comply with the requirements provided in Article 5, paragraphs (4) or (5) (excluding item (iii)) and (6);  
(iv) where the utility model registration has been granted on an application for a utility model registration filed by a person who is not the creator of the device and has not succeeded to the right to obtain a utility model registration for the said device; and  
(v) where, after the grant of a utility model registration, the holder of utility model right has become unable to hold a utility model right under Article 25 of the Patent Act as applied mutatis mutandis pursuant to Article 55, paragraph (3), or the utility model registration has become in violation of a treaty.  
(2) Any person may file a request for the trial of the preceding paragraph; provided, however, that where a request for invalidation trial of utility model registration is filed on the ground that the utility model registration falls under item (i) of the said paragraph (limited to the case where the utility model registration is obtained in violation of Article 38 of the Patent Act as applied mutatis mutandis pursuant to Article 9, paragraph (1)) or item (iv) of the preceding paragraph), only an interested person may file a request for the trial.

	<p>(3) Where a request for the trial of paragraph (1) has been filed, the chief trial examiner shall notify the exclusive licensee of the utility model right and other persons who have any registered rights relating to the utility model.</p>	<p>(3) A request for the trial of paragraph (1) may be filed even after the utility model right has lapsed.</p> <p>(4) Where a request for the trial of paragraph (1) has been filed, the chief trial examiner shall notify the exclusive licensee of the utility model right and other persons who have any registered rights relating to the utility model.</p>
<p>Articles 39 through 41</p>	<p>Articles 39 The holder of utility model right may file a request for a trial regarding correction of the description or drawings attached to the application, only for the following purposes.</p> <p>(i) restriction of the scope of claims;  (ii) correction of errors; and  (iii) clarification of an ambiguous statement.</p> <p>(2) Any correction of the description or drawings referred to in the preceding paragraph shall not substantially enlarge or alter the scope of claims for a utility model registration.</p>	<p>Articles 39 The holder of utility model right may file a request for a trial regarding correction of the description or drawings attached to the application; provided however, that the correction shall be limited to those for the following purposes:  (i) restriction of the scope of claims;  (ii) correction of errors;  (iii) clarification of an ambiguous statement; and  (iv) rewriting the statement of claims which cite the statement of another claim in a way it does not cite the statement of the said another claim.</p> <p>(2) The request for a trial of the preceding paragraph may not be filed from the time the trial under Article 39, paragraph (1) has become pending before the Japan Patent Office to the time the trial decision (in a case where the request is filed for each of claims, all of the trial decisions) has become final and binding.</p>

(3) In the case of paragraph (1), item (i), a device constituted by the matters described in the corrected scope of claims must be one which could have been entitled to obtain a utility model registration for the said device independently at the time of filing of the utility model application.

(4) The request for the trial of paragraph (1) may be filed even after the utility model right has lapsed; provided however, that this shall not apply after the utility model right has been invalidated in the trial of Article 37, paragraph (1).

(3) In a case where correction of matters listed in Article 5, paragraph (3), item (iv) in description attached to the application pertaining to two or more claims are made, the request under the provisions of paragraph (1) may be filed for each claim. In this case, if a group of claims having any relation cited by another claim and other relations prescribed by the Ordinance of the Ministry of Economy, Trade and Industry (hereinafter referred to as "the group of claims") is present, the said request shall be filed for each of the said group of claims.

(4) In a case where correction of matters listed in Article 5, paragraph (3), items (i) to (iii) in description attached to the application or the drawings, if the request under the provisions of paragraph (1) is intended the said request shall be filed for all claims pertaining to the said correction of the description or the drawings (for all of the group of claims including claims pertaining to the said correction of the description or the drawings, where the request under paragraph (1) is filed for each of the group of claims pursuant to the provisions in the second sentence of the preceding paragraph).

(5) The correction of the description or the drawings under paragraph (1) shall be made within the scope of matters described in the description or the drawings attached to the application.

	<p>(6) Any correction of the description or drawings referred to in paragraph (1) shall not substantially enlarge or alter the scope of claims for a utility model registration.</p> <p>(7) In the case of correction for any of the purposes as provided in item (i) of the proviso to paragraph (1), the device constituted by the matters stated in the corrected scope of claims shall be entitled to independently obtain a utility model registration for said device.</p> <p>(8) The request for the trial of paragraph (1) may be filed even after the utility model right has lapsed; provided however, that this shall not apply after the utility model right has been invalidated in the trial of Article 37, paragraph (1).</p>
<p>(Trial for invalidation of correction)  Article 40 (1) In a case where the correction of the description or drawings attached to the application violates the provisions of the preceding Article, paragraphs (1) to (3), a request for a trial for invalidating the correction may be filed.</p>	<p>(Submission of written reply, etc.)  Article 40 (1) Where a request for trial has been filed, the chief trial examiner shall serve a copy of the written request to the demandee and give him/her an opportunity to submit a written reply, designating an adequate period.</p>

(2) The provisions of Article 37, paragraphs (2) and (3) shall be applied mutatis mutandis to the request for trial under the preceding paragraph.

(2) Where the chief trial examiner approves an amendment of the written request under the provisions of Article 38-2, paragraph (2), he/she shall serve a copy of the written amendment with respect to the said amendment to the demandee, and shall give him/her an opportunity to submit a written reply, designating an adequate period; provided, however, that this shall not apply where special circumstances exist under which it is recognized that giving an opportunity to the demandee to submit a written reply is not required.

(3) Upon receipt of a written reply as provided in paragraph (1) or the main clause of the preceding paragraph, the chief trial examiner shall serve to the demandant a copy thereof.

(4) The chief trial examiner may question the parties and the intervenors relating to the trial.  
(Request for correction)

Article 40-2 (1) The demandee in a trial under Article 37, paragraph (1), or Article 48-12, paragraph (1) may file a request for a correction of the description, scope of claims or drawing(s) attached to the application only within the time limit designated in accordance with Article 153, paragraph (2) or Article 164-2, paragraph (2) of the revised Patent Act of 2011 applied mutatis mutandis in the preceding Article paragraph (1) or (2), or the following Article or Article 41, respectively; provided, however, that such correction shall be limited to the following purposes:

- (i) restriction of the scope of claims;
- (ii) correction of errors in the description;
- (iii) clarification of an ambiguous description; and
- (iv) making the description of a claim citing the description of other claims one not citing the said description of other claims.

(2) Where correction of the matter listed in Article 5, paragraph (3), item (iv) in the description attached to the application pertaining to two or more claims, the request for correction under the preceding paragraph may be filed for each claim; provided however, that where the request for trial under Article, paragraph (1) or Article 48-12, paragraph (1) has been filed for each claim, the request for correction under the preceding paragraph shall be filed for each claim.

In the case prescribed in the preceding paragraph, where there is a group of claims in the claims concerned, the petition shall be filed for each claim in the group of claims.

(4) Upon receipt of a written request for correction as provided in paragraph (1) and corrected description and drawings attached thereto, the chief trial examiner shall serve to the demandant copies thereof.

(5) The trial examiner may examine the grounds that have not been pleaded by a party in the case or an intervenor in determining whether the request for correction under paragraph (1) is not for any of the purposes provided in the items of the proviso to the said paragraph, or does not conform the provisions of Article 39, paragraphs (5) to (7) that shall be applied mutatis mutandis by replacing the terms under paragraph (9). In this case, where the request for correction on the above grounds is not approved of, the chief trial examiner shall notify the parties in the case and the intervenors of the result of the proceedings and shall give them an opportunity to state their opinions, designating an adequate time limit.

(6) Where a request for correction under paragraph (1) is made, if another request for correction has been previously made in the said trial, the said previous request shall be deemed to have been withdrawn.

(7) The request for correction under paragraph (1) may be withdrawn only within an allowable period for amendments under Article 17, paragraph (1) of the Patent Act applied mutatis mutandis by replacing the terms under Article 55, paragraph (2) regarding the corrected description or drawings appended to the written request for correction under the said paragraph. In this case, if the request for correction under paragraph (1) have been filed for each claim or for each group of claims pursuant to the provisions of paragraph (2) or (3), all of these requests shall be withdrawn.

(8) Where the request for the trial under Article 37, paragraph (1), or Article 48-12, paragraph (1) has been withdrawn for each claim pursuant to the provisions of Article 155, paragraph (3) of the revised Patent Act of 2011 applied mutatis mutandis in Article 41, the request for correction under paragraph (1) shall be deemed to have been withdrawn for each of the said claims, and where all of the requests pertaining to a trial case of the trial under Article 37, paragraph (1), or Article 48-12, paragraph (1) have been withdrawn, all of the requests for correction under paragraph (1) pertaining to the said trial case shall be deemed to have been withdrawn.

	<p>(9) The provisions of Article 39, paragraphs (4) to (8), Articles 127, 128 and 132, paragraphs (3) and (4) of the Patent Act, and Article 131, paragraphs (1), (3) and (4), Article 131-2, paragraph (1), and Article 133, paragraphs (1), (3) and (4) shall apply mutatis mutandis to the case of paragraph (1). In this case, "paragraph (1), proviso, item (i)" in Article 39, paragraph (7) shall be replaced with "paragraph (1), proviso, item (i) pertaining to a claim for which a request for the trial under Article 37, paragraph (1), or Article 48-12, paragraph (1) has not been filed".          (Request for correction in the case of rescission judgment)          Article 40-3 Where a judgment rescinding a trial decision in a trial under Article 37, paragraph (1), or Article 48-12, paragraph (1) (limited to a trial decision concluding that the request for a trial is groundless) under Article 181, paragraph (1) of revised Patent Act of 2011 applied mutatis mutandis in article 47, paragraph (2) has become final and binding, and following which proceedings are initiated under paragraph (2) of the said Article, the chief trial examiner may designate to the demandee an adequate period for filing a request for correction of the description, scope of the claims or the drawings attached to the application, only if such motion is made by the demandee within one week from the date when the judgment became final and binding.</p>
(Mutatis mutandis application of the Patent Act)	(Mutatis mutandis application of the Patent Act)

	Article 41 The provisions of Articles 125, 127, 128, and 130 to 170 of the Patent Act (effect of trial decision, request for trial, trial examiner, trial procedures, relation to litigation, and costs of trial) shall apply mutatis mutandis to a trial.	Article 41 The provisions of Articles 125, 127, 128, 132, 135 to 154, and 157 to 163, Article 164, paragraph (1), Article 166, and Articles 168 to 170 of the Patent Act, and Articles 131, 131-2, 133, 155, 156, 164-2, 167, and 167-2 of the revised Patent Act of 2011 (effect of trial decision, request for trial, trial examiner, trial procedures, relation to litigation, and costs of trial) shall apply mutatis mutandis to a trial.
Article 45	, Article 174 (Application mutatis mutandis of provisions regarding trial, etc.) and Article 176 (Non-exclusive license due to the working of the invention prior to the registration of the request for a retrial)	and Article 176 (non-exclusive license due to the working of the invention prior to the registration of the request for a retrial), and article 174 of the revised Patent Act of 2011 (application mutatis mutandis of provisions regarding trial, etc.)
Article 47, paragraph (1)	a written request for a trial or a retrial	a written request for a trial or a retrial or a written request for correction under Article 40-2, paragraph (1)
Article 47, paragraph (2)	Article 178, paragraphs (2) to (6) (Period of institution of action, etc.), and Articles 179 to 182 (Appropriate party as defendant, notice of institution of action, rescission of the trial decision or ruling, and delivery of original copy of judgment)	Article 179 of the Patent Act (Appropriate party as defendant) and Article 178, paragraphs (2) to (6) (Period of institution of action, etc.), and Articles 180, 181 and 182 (notice of institution of action, etc., rescission of the trial decision or ruling, and delivery of original copy of judgment, etc.) of the revised Patent Act of 2011
Article 48-12, paragraph (2)	"Article 37, paragraph (1)" in Article 39, paragraph (4) shall be replaced with "Article 37, paragraph (1) or Article 48-12, paragraph (1)"	"Article 37, paragraph (1)" in Article 39, paragraphs (2) and (8) shall be replaced with "Article 37, paragraph (1) or Article 48-12, paragraph (1)"

Article 48-12, paragraph (3)	the provisions of Article 37, paragraphs (2) and (3) and Article 184-15, paragraphs (2) and (4) (a trial for invalidation of a patent based on grounds inherent in an international patent application)	the provisions of Article 37, paragraphs (1), second sentence, (3) and (4), and Article 184-15, paragraph (4)
Article 50-2	Article 125 of the Patent Act applied mutatis mutandis in Article 37, paragraph (2) (including cases applied mutatis mutandis in Article 40, paragraph (2), and Article 48-12, paragraph (3))	Article 128 of the Patent Act applied mutatis mutandis in Article 37, paragraph (3) (including cases applied mutatis mutandis in Article 48-12, paragraph (3)), Article 39, paragraph (8) (including a case applied mutatis mutandis in Articles 40-2, paragraph (9)), Article 40-2, paragraph (9) and Article 41, Article 125 of the Patent Act applied mutatis mutandis in Article 41

<p>Article 55, paragraph (2)</p>	<p>apply mutatis mutandis.</p>	<p>apply mutatis mutandis. In this case, "and after a certified copy of a ruling that publication of request shall be done have been served" shall be replaced with, "after a period designated by the provisions of Article 40, paragraph (1) of the Utility Model Act in a trial under Article 37, paragraph (1), or Article 48-12, paragraph (1) of the said Act has lapsed (in a case where a period is designated under the provisions of Article 153, paragraph (2) of the Patent Act or Article 164-2, paragraph (2) of the revised Patent Act of 2011 applied mutatis mutandis in Article 40, paragraph (1), Article 40-2 paragraph (5), Article 40-3, or Article 41 of the Utility Model Act, after the said period lapsed) and after a notice under the provisions of Article 156, paragraph (1) of the revised Patent Act of 2011 applied mutatis mutandis in Article 41 of the Utility Model Act in a trial under Article 39, paragraph (1) of the said Act (in the case where the proceedings have been resumed under the provisions of Article 156, paragraph (3) of the Patent Act, after further notice is given under the provisions of Article 156, paragraph (1) of the Patent Act, after ) is given", and "a trial" shall be replaced with "a trial or correction under Article 40-2, paragraph (1) of the Utility Model Act."</p>
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Article 55, paragraph (6)	the provisions of Article 195-3 (restriction on appeals under Administrative Appeal Act) of the patent Act are a decision of dismissal of amendment, a decision of dismissal of written requests of an examiner's decision, a trial decision and a trial or a retrial pursuant to the provisions of this Act	the provisions of Article 195-4 (restriction on appeals under Administrative Appeal Act) of the revised Patent Act of 2011 are a decision of dismissal of amendment, a decision of dismissal of written requests of an examiner's decision, a trial decision and a trial or a retrial, or a written request for correction under Article 40-2, paragraph (1) pursuant to the provisions of this Act
Appendix table, item (v)	A person filing an opposition to registration (including an opposition pertaining to publication of request)	A person filing an opposition to registration
Appendix table, item (ix)	A person filing a request for a trial or a retrial	A person filing a request for a trial or a retrial

(3) In a case where the decision on an opposition to registration under Article 113 (hereinafter, simply, referred to as "opposition to registration") of the revised Patent Act under the provisions of Article 2 of 1994 Amending Act applied mutatis mutandis in Article 9, paragraph (2) of Supplementary Provisions of the Partial Amendment of the Patent Act (Act No. 116 of 1994, hereinafter referred to as "1994 Amendment Act") before revision under the provisions of Article 14 of Supplementary Provisions of 2003 Amendment Act issued prior to the enforcement of 2003 Amendment Act, does not become final, with regard to application of the provisions of Article 39, paragraph (2) of the former Utility Model Act pertaining to a utility model registration, which is to be corrected after the enforcement of 2003 Amendment Act, and which has been replaced in the preceding paragraph, "the trial under Article 37, paragraph (1)" shall be replaced with "the trial on the opposition to registration under Article 113 of the revised Patent Act under the provisions of Article 2 of 1994 Amending Act (hereinafter referred to as "the revised Patent Act of 1994") applied mutatis mutandis in Article 9, paragraph (2) of Supplementary Provisions of the Partial Amendment of the Patent Act ,etc. (Act No. 116 of 1994, hereinafter referred to as "1994 Amendment Act") prior to revision under the provisions of Article 14 of Supplementary Provisions of the Partial Amendment of the Patent Act ,etc. (Act No. 47 of 2003), (hereinafter, simply, referred to as "the opposition to registration"), or the trial under Article 37, paragraph (1)"; "the trial decision" shall be replaced with "the decision or trial decision"; "against the decision of the trial of the said paragraph" shall be replaced with "against

the revocation decision under Article 114, paragraph (2) hereinafter, simply, referred to as "revocation decision") of the Patent Act revised in 1994 applied mutatis mutandis in Article 9, paragraph (2) of Supplementary Provisions of 1994 Amending Act regarding opposition to registration or the trial decision under Article 37, paragraph (1)"; and "the judicial decision of revocation of a trial decision" shall be replaced with "the revocation decision or the judicial decision of revocation of a trial decision", in the said paragraph.

- (4) In a case where an appeal against the opposition to registration requested prior to the enforcement of 2003 Amendment Act, or the revocation decision or the trial decision under Article 114, paragraph (2) of the revised Patent Act of 1994 applied mutatis mutandis in Article 9, paragraph (2) of Supplementary Provisions of 1994 Amendment Act pertaining to the trial under Article 37, paragraph (1), or Article 48-12, paragraph (1) of the former Utility Model Act, is pending before any court at the time of enforcement of 2003 Amendment Act, with regard to the application of the provisions of Article 39, paragraph (2) of the former Utility Model Act pertaining to a utility model registration, which is to be corrected after the enforcement of 2003 Amendment Act to the time the judicial decision to the said appeal has become final and binding, and which has been replaced in paragraph (2), notwithstanding the provisions of the preceding paragraph, in Article 39, paragraph (2) of the former Utility Model Act which has been replaced in paragraph (2), "after the trial under Article 37, paragraph (1) has been pending before the Japan Patent Office to the time the trial decision has been final and binding" shall be replaced with "in a case where the trial on the opposition to registration under Article 113 of the revised Patent Act under the provisions of Article 2 of 1994 Amending Act applied mutatis mutandis in Article 9, paragraph (2) of Supplementary Provisions of the Partial Amendment of the Patent Act ,etc. (Act No. 116 of 1994) prior to the revision under the provisions of Article 14 of Supplementary Provisions of the Partial Amendment of the Patent Act ,etc. (Act No. 47 of 2003), or the trial under Article 37, paragraph (1) or under Article 48-12, paragraph (1) is pending before the Japan Patent Office", and the provisions of the proviso of the said paragraph shall not be applied.

Article 5 (1) An applicant for a utility model registration may let an application for a utility model registration (excluding an application for a utility model registration where five and a half years have been lapsed from the date of filing of the application for a utility model registration) which has been pending before the Japan Patent Office at the time of enforcement of this Act and notified to the Commissioner of the Japan Patent Office as being come under the provisions of the revised Utility Model Act (hereinafter, referred to as "the New Utility Model Act") pursuant to Article 3, pursuant to the

provisions of an Ordinance of the Ministry of International Trade and Industry (hereinafter, referred to as "the former application for a utility model registration") as an application for a utility model registration being come under the provisions of the New Utility Model Act (hereinafter, referred to as "the new application for a utility model registration").

- (2) In the case of the preceding paragraph, the new application for a utility model registration shall be deemed to have been filed at the time of filing the former application for a utility model registration. In this case, "filing date of a utility model registration application" in the proviso to Article 2-2, paragraph (1) of the New Utility Model Act, shall be replaced with "the date of notification pursuant to the provisions of Article 5, paragraph (1) of Supplementary Provisions of the Partial Amendment of the Patent Act (Act No. 26 of 1993) (hereinafter referred to as "notification of Change")," and "at the time of filing of the application for a utility model registration" shall be replaced with "along with the notification of Change."
- (3) Where there is a notification under paragraph (1), the former application for design registration shall be deemed to have been withdrawn.
- (4) With regard to a notification under paragraph (1) pertaining to an international application which has been deemed to be an application for a utility model registration under the registration of Article 48-3, paragraph (1) or Article 48-14, paragraph (4) of the Former Utility Model Act, it may be received only after the registration fees payable under the provisions of Article 54, paragraph (2) have been paid (with regard to an international application which is deemed to be an application for a utility model registration under the provisions of Article 48-14, paragraph (4), after the decision under the said paragraph), and, in the case of a Utility Model Registration Application in Japanese Language under Article 48-6, paragraph (2) of the Former Utility Model Act, after the procedures under the provisions of Article 48-5, paragraph (1) of the former Utility Model Act have been completed, or in the case of a Utility Model Registration Application in Foreign Language under Article 48-14, paragraph (4) of the former Utility Model Act, after the procedures under the provisions of the said paragraph and Article 48-5, paragraph (1) of the former Utility Model Act have been completed.
- (5) An applicant for a patent or an applicant for a design registration may convert his/her application (excluding patent applications or design registrations where five and a half years have been lapsed from the date of filing of the patent applications or design registrations) which has been pending before the Japan Patent Office at the time of enforcement of this Act and notified to the Commissioner of the Japan Patent Office as being come under the provisions of the New Utility Model Act, into a new application for a utility model registration being come under the provisions of the new Utility

Model Act.

(6) The provisions of paragraphs (2) and (3) shall apply mutatis mutandis to the case of the preceding paragraph.

(Transitional measures concerning application of penal provisions)

Article 16 With regard to the application of penal provisions to acts committed prior to the enforcement of this Act, the provisions then in force shall remain applicable.

(Delegation to a Cabinet Order)

Article 17 In addition to what is prescribed by Articles 2 to 6, 8 and 10 and the preceding Article of Supplementary Provisions, transitional measures necessary for the enforcement of this Act shall be specified by a Cabinet Order.

**Supplementary Provisions [Act No. 89 of November 12, 1993 Extract]  
[Extract]**

(Effective date)

Article 1 This Act shall come into effect as from the date of enforcement of Administrative Procedure Act (Act No. 88 of 1993).

(Transitional measures concerning adverse dispositions following consultation, etc.)

Article 2 In the case where a request for consultation or any other request has been made based on laws and regulations prior to the enforcement of this Act to a council or any other consultative organ to carry out a procedure equivalent to the procedure for the hearing or the grant of an opportunity for an explanation or any other procedure for hearing statements of opinion prescribed in Article 13 of the Administrative Procedure Act, with regard to the procedure of an adverse disposition to which said request for consultation or any other respect pertains, the provisions then in force shall remain applicable, notwithstanding the provisions of the relevant Act after the revision by this Act.

(Transitional measures concerning penal provisions)

Article 13 With regard to the application of penal provisions to acts committed prior to the enforcement of this Act, the provisions then in force shall remain applicable.

(Transitional measures upon arrangement of provisions on hearings)

Article 14 Proceedings for hearing (excluding those pertaining to adverse

dispositions) implemented pursuant to the provisions of Acts prior to the enforcement of this Act or procedures for these shall be deemed to have been implemented pursuant to the equivalent provisions of the related Acts revised by this Act.

(Delegation to a Cabinet Order)

Article 15 In addition to what is prescribed for in Articles 2 through the preceding Article of the Supplementary Provisions, transitional measures necessary for the enforcement of this Act shall be specified by a Cabinet Order.

**Supplementary Provisions [Act No. 116 of December 14, 1994 Extract]  
[Extract]**

(Effective date)

Article 1 This Act shall come into effect as from June 1, 1995; provided, however, that the provisions listed as follows shall come into effect as from the date listed in the relevant item:

(ii) The provisions of Article 2; in Article 3, the provisions for revising Article 3-2, paragraph (1) of the Utility Model Act (limited to the portion changing "publication of an unexamined application" to "issuance of the patent gazette containing matters listed in each of items of Article 66, paragraph (3) of the Patent Act under the provisions of the said paragraph"), the provisions of Article 10, paragraphs (5) and (6), Article 14, paragraph (4), and Article 39, paragraph (3) of the said Act, the revised provisions of Article 45 of the said Act (excluding the portion adding paragraph (1) to the same Article), the revised provisions of Article 50-2 of the said Act (limited to the portions changing "Article 174, paragraph (2)" to "Article 174, paragraph (3)", and "Article 193, paragraph (2), (v)" to "Article 193, paragraph (2), (iv)"), the revised provisions of Article 53, paragraph (2) of the said Act, and the revised provisions of Article 62 of the said Act (limited to the portion changing "Article 174, paragraph (2)" to "Article 174, paragraph (3)"); in Article 4, the revised provisions of Article 13, paragraph (3), Article 19, Article 58, Article 68, paragraph (1), Article 75 of the Design Act; the provisions of Article 6; in Article 7, the revised provisions of Article 5 of Patent Attorneys Act; and the provisions of Article 8, Article 9, Article 10, paragraph (2), Article 17, and Article 19 of Supplementary Provisions: January 1, 1996

(Transitional measures upon revision of the Utility Model Act)

Article 10 (1) With regard to utility model applications actually pending at the time of the enforcement of this Act or the examiner's decision or the trial

decision pertaining to a utility model application filed prior to the enforcement of this Act, excluding the provisions of Article 173, paragraph (2) of the new Patent Act applied mutatis mutandis in Article 45, paragraph (2) and Article 54, paragraph (1) of the new Utility Model, the provisions then in force shall remain applicable.

(2) With regard to application of the provisions of Article 3-2 of the new Utility Model Act to applications for utility model registration filed prior to the date on which all publications of an examined application of which certified copy of the ruling has been served, finish prior to the enforcement of the provisions of Article 2 and the preceding Article, paragraph (1), in the same Article, "issuance or" shall be replaced with "issuance", and "publication of an examined application" shall be replaced with "publication of an examined application or publication of an unexamined application."

(3) The provisions of Article 33-2 of the new Utility Model Act shall not apply to the utility model right that have been deemed to be lapsed or non-existent from the beginning pursuant to Article 33, paragraph (4) or (5) of the former Utility Model Act.

(Transitional measures concerning application of penal provisions)

Article 13 With regard to the application of penal provisions to acts committed prior to the enforcement of the revised provisions of this Act and acts committed after the enforcement of the revised provisions of this Act pertaining to the matters to which the provisions then in force, the provisions then in force shall remain applicable.

(Delegation to a Cabinet Order)

Article 14 In addition to what is prescribed by Articles 2 through the preceding Article of Supplementary Provisions, transitional measures necessary for the enforcement of this Act shall be specified by a Cabinet Order.

#### **Supplementary Provisions [Act No. 91 of May 12, 1995 Extract] [Extract]**

(Effective date)

Article 1 This Act shall come into effect as from the date on which twenty days have lapsed from the date of promulgation.

#### **Supplementary Provisions [Act No. 68 of June 12, 1996 Extract] [Extract]**

(Effective date)

Article 1 This Act shall come into effect as from April 1, 1997; provided, however, that the revising provisions listed as follows shall come into effect as from the

date listed in the relevant item.

(ii) The revised provisions adding the proviso to Article 40, paragraph (4) and Article 76, paragraph (4) of the Trademark Act, in Article 1 of this Act; the revised provisions adding the proviso to Article 107, paragraph (3), Article 112, paragraph (3) and Article 195, paragraph (5) of the Patent Act, in Article 2 of this Act; the revised provisions adding the proviso to Article 31, paragraph (3), Article 33, paragraph (3) and Article 54, paragraph (4) of the Utility Model Act, in Article 3 of this Act; in Article 4, the revised provisions adding the proviso to Article 42, paragraph (4), Article 44, paragraph (3) and Article 67, paragraph (4) of the Design Act, in Article 4 of this Act; the revised provisions adding the proviso to Article 40, paragraph (4) of the Act on Special Provisions of Procedures, etc. concerning Industrial Property Rights in Article 5 of this Act; and the provisions of Article 27 of Supplementary Provisions: October 1, 1996

(Transitional measures concerning application of penal provisions)

Article 20 With regard to the application of penal provisions to acts committed prior to the enforcement of provisions of this Act and acts committed after the enforcement of provisions of this Act pertaining to the matters to which the provisions then in force, the provisions then in force shall remain applicable.

(Delegation to a Cabinet Order)

Article 21 In addition to what is prescribed by Articles 2 through the preceding Article of Supplementary Provisions, transitional measures necessary for the enforcement of this Act shall be specified by a Cabinet Order.

**Supplementary Provisions [Act No. 110 of June 26, 1996 Extract]  
[Extract]**

This Act shall come into effect as from the date of the enforcement of the new Code of Civil Procedure; provided, however, that the revising provisions listed as follows shall come into effect as from the date listed in the relevant item:

(ii) In Article 30, the provisions for revising Article 10; in Article 32, the provisions for revising Article 2-5, paragraph (2) of the Utility Model Act; in Article 33, the provisions for revising Article 68, paragraph (2) of the Design Act; in Article 34, the provisions for revising Article 77, paragraph (2) of the Trademark Act, Articles 27, paragraph (2) and 30 of Supplementary Provisions; and the provisions for revising Article 41, paragraph (2) of the Act on Special Provisions of Procedures, etc. concerning Industrial Property Rights: the latter of the dates of April 1, 1998 and the date of the enforcement of the new Code of Civil Procedure.

## Supplementary Provisions [Act No. 51: May 6, 1998 Extract] [Extract]

(Effective date)

Article 1 This Act shall come into effect as from January 1, 1999; provided, however, that the revising provisions listed as follows shall come into effect as from the date listed in the relevant item.

(ii) The provisions for revising Article 107 of the Patent Act (excluding the provisions for revising the table of paragraph (1) of the said Article), and the provisions for revising Article 195 of the said Act (excluding the provisions for revising paragraph (1), items (iv) to (vii)), in Article 1 of this Act; the provisions for revising Article 31 of the Utility Model Act and the provisions for revising Article 54 of the said Act (excluding the provisions for revising paragraph (1), items (iv) to (vii)); the provisions of Article 4, in Article 2 of this Act; the provisions for revising Article 40, Article 41-2, paragraph (5) and Article 65-7, paragraph (3), and the provisions for revising Article 76 of the said Act (excluding the provisions for revising the paragraph (1) of the said Article), in Article 5 of this Act; the provisions for revising Article 40 of the Act on Special Provisions of Procedures, etc. concerning Industrial Property Rights, and provisions of paragraph (2) of the following Article, Article 3, paragraph (2), Article 5 and Article 6, paragraph (2) of Supplementary Provisions, in Article 6 of this Act; the provisions for revising Article 15, paragraph (2), of Supplementary Provisions of the Act for Partial Revision of the Trademark Act, etc. (Act No. 68 of 1996), in Article 14 of Supplementary Provisions; and the provisions of Article 18 of Supplementary Provisions: April 1, in 1999.

(Transitional measures upon revision of the Utility Model Act)

Article 3 (1) With regard to utility model applications actually pending at the time of the enforcement of this Act, until the examiner's decision or a trial decision for the utility model applications becomes final and binding, the provisions then in force shall remain applicable, except where it has otherwise been provided for.

(2) With regard to registration fees that have already been paid prior to the date prescribed by Article 1, item (ii) of Supplementary Provisions or should have been paid prior to the that date, the provisions then in force shall remain applicable, notwithstanding the provisions of Article 31, paragraphs (3) and (4) of the revised Utility Model pursuant to the provisions of Article 2 (hereinafter, referred to as "the new Utility Model Act").

(3) With regard to the grounds for opposition or invalidity to a utility model registration pertaining to applications for utility model registration filed prior

to the enforcement of this Act, the provisions then in force shall remain applicable.

(Transitional measures concerning application of penal provisions)

Article 7 With regard to the application of penal provisions to acts committed prior to the enforcement of this Act and acts committed after the enforcement of this Act pertaining to the matters to which the provisions then in force, the provisions then in force shall remain applicable.

(Delegation to a Cabinet Order)

Article 8 In addition to what is prescribed by Articles 2 through the preceding Article of Supplementary Provisions, transitional measures necessary for the enforcement of this Act shall be specified by a Cabinet Order.

### **Supplementary Provisions [Act No. 41 of May 14, 1999 Extract] [Extract]**

(Effective date)

Article 1 This Act shall come into effect as from January 1, 2000; provided, however, that the provisions listed in the following items shall come into effect as from the date prescribed respectively in those items.

(i) The provisions revising the table of Article 107, paragraph (1) of the Patent Act and the provisions adding two paragraphs in Article 168 of the said Act in Article 1; the provisions revising the table of Article 31, paragraph (1) of the Utility Model Act and the provisions adding two paragraphs in Article 40 of the said Act in Article 2; and the provisions of the following Article, paragraph (10), Article 3, paragraph (6) of these Supplementary Provisions and Articles 7 through 12 of these Supplementary Provisions: the date specified by a Cabinet Order within a period not exceeding one month from the date of the promulgation

(Transitional measures accompanying revision of the Utility Model Act)

Article 3 (1) With regard to novelty requirement for a device pertaining to an application for utility model registration actually pending before the Japan Patent Office at the time of the enforcement of this Act, the provisions then in force shall remain applicable until the establishment concerning the application for utility model registration is registered.

(2) The provisions of Article 10, paragraphs (8) and (9) of the Utility Model Act revised by the provisions of Article 2 (hereinafter referred to as the "new Utility Model Act") shall be applied to an application for utility model registration which has been filed after the enforcement of this Act, and is deemed to have been filed pursuant to the provisions of Article 10, paragraph

- (3) of the Utility Model Act, prior to the enforcement.
- (3) With regard to judgment concerning a technical scope of a registered utility model required prior to the enforcement of this Act, the provisions then in force shall remain applicable.
- (4) The provisions of Chapter 4, Section 2 of the new Utility Model Act, except as otherwise provided, shall be applied also to the matters which occurred prior to the enforcement of this Act; provided, however, that this shall not preclude an effect raised by the provisions of Chapter 4, Section 2 of the Utility Model Act prior to revision by the provisions of Article 2 (hereinafter referred to as the "former Utility Model Act").
- (5) The provisions of Article 105-3 of the New Patent Act applied mutatis mutandis in Article 30 of the New Utility Model Act shall not be applied to a case for which oral arguments before a high court or a district court that constitutes a court of second instance has finished prior to the enforcement of this Act, and a case for which, before this Act comes into effect, parties reserve the right to a final appeal against a judgment made by a summary court or a judgment made by a district court as a court of first instance, and have agreed not to appeal to the court of second instance.
- (6) With regard to registration fees which have already be paid prior to the date prescribed in Article 1, item (i) of the Supplementary Provisions or should have been paid prior to the same date (including registration fees the payment of which was deferred pursuant to the provisions of Article 109 of the former Patent Act applied mutatis mutandis in Article 36 of the former Utility Model Act); notwithstanding the provisions of Article 31, paragraph (1) of the new Utility Model Act, the provisions then in force shall remain applicable.
- (7) With regard to grounds for invalidation concerning utility model registration pertaining to applications for utility model registration filed prior to the enforcement of this Act, the provisions then in force shall remain applicable.

(Partial revision of the former Utility Model Act of 1993)

Article 11 Part of the Utility Model Act prior to revision (hereinafter referred to as the "former Utility Model Act of 1993") by the provisions of Article 3 of the Act for Partial Revision of the Patent Act, etc. (Act No. 26 of 1993; hereinafter referred to as the "Amendment Act of 1993") which then in force shall have remained applicable pursuant to the provisions of Article 4, paragraph (1) of the Supplementary Provisions of the Act for Partial Revision of the Patent Act, etc. shall be revised as follows:

"One thousand yen", "two thousand yen" and "four thousand yen" in the table of Article 31, paragraph (1) shall be changed to "eight hundred yen", "one thousand six hundred yen" and "three thousand two hundred yen", respectively.

(Transitional measures accompanying partial revision of the former Utility Model Act of 1993)

Article 12 With regard to registration fees which have been already paid prior to the date prescribed in Article 1, item (i) of the Supplementary Provisions, pursuant to the provisions of Article 31, paragraph (1) of the former Utility Model Act of 1993 prior to revision by the provisions of the preceding Article, or with regard to registration fees which should have been paid prior to the same date, pursuant to the provisions of the said paragraph (including registration fees the payment of which was deferred pursuant to the provisions of Article 109 of the Patent Act prior to revision by the provisions of Article 1 of the Amendment Act of 1993 which then in force shall have remained applicable pursuant to the provisions of Article 4, paragraph (1) of the Supplementary Provisions of the Amendment Act of 1993 applied mutatis mutandis in Article 34 of the former Utility Model Act of 1993); notwithstanding the provisions of Article 31, paragraph (1) of the former Utility Model Act of 1993 revised by the provisions of the preceding Article, the provisions then in force shall remain applicable.

(Transitional measures relating to application of penal provisions)

Article 18 With regard to the application of penal provisions to acts conducted prior to the enforcement of this Act, and acts conducted after the enforcement of this Act pertaining to matters with regard to which the provisions then in force shall remain applicable pursuant to the provisions of these Supplementary Provisions; each of the provisions then in force shall remain applicable.

(Delegation to Cabinet Order)

Article 19 In addition to what is prescribed in Articles 2 through 6, 8, 10, 12 and the preceding Article of these Supplementary Provisions, necessary transitional measures relating to the enforcement of this Act shall be specified by a Cabinet Order.

**Supplementary Provisions [Act No. 160 of December 22, 1999 Extract]  
[Extract]**

(Effective date)

Article 1 This Act (excluding Articles 2 and 3) shall come into effect as from January 6, 2001.

**Supplementary Provisions [Act No. 220 of December 22, 1999 Extract]  
[Extract]**

(Effective date)

Article 1 This Act (excluding Article 1) shall come into force as from January 6, 2001.

(Delegation to Cabinet Order)

Article 4 In addition to what is prescribed in the preceding 2 articles, necessary matters relating to the enforcement of this Act shall be specified by a Cabinet Order.

### **Supplementary Provisions [Act No. 24 of April 17, 2002 Extract] [Extract]**

(Effective date)

Article 1 This Act shall come into effect as from the date specified by a Cabinet Order within a period not exceeding six months from the date of the promulgation; provided, however, that the provisions listed in the following items shall come into effect as from the date prescribed respectively in those items.

- (i) The provisions revising Article 101, Article 112-3, paragraph (2) and Article 175, paragraph (2) of the Patent Act in Article 2; the provisions revising Article 28 and Article 33-3, paragraph (2), item (ii) and Article 44, paragraph (2), item (ii) of the Utility Model Act in Article 4; and the provisions revising Article 68-19, paragraph (1), Articles 68-30 and 68-35 of the Trademark Act in Article 6; and the provisions revising Article 6 of these Supplementary Provisions: the date specified by a Cabinet Order within a period not exceeding one year from the date of the promulgation
- (ii) The provisions of Article 2 (excluding the provisions revising Article 101, Article 112-3, paragraph (2) and Article 175, paragraph (2) of the Patent Act) and the provisions of Article 4 (excluding the provisions revising Article 28 and Article 33-3, paragraph (2), item (ii) and Article 44, paragraph (2), item (ii) of the Utility Model Act) and the provisions of Articles 3 and 5 of these Supplementary Provisions: the date specified by a Cabinet Order within a period not exceeding one year and six months from the date of the promulgation

(Transitional measures accompanying revision of the Utility Model Act by provisions of Article 3)

Article 4 With regard to the Period for the Submission of National Documents and the National Processing Standard Time pertaining to Application for Utility Model Registration in Japanese Language for which the procedure is performed prior to the enforcement of this Act, pursuant to the provisions of

Article 48-5, paragraph (1) of the Utility Model Act prior to revision by the provisions of Article 3, and Application for Utility Model Registration in Foreign Language for which the procedure is performed prior to the enforcement of this Act, pursuant to the provisions of Article 48-4, paragraph (1) and Article 48-5, paragraph (1) of the said Act; the provisions then in force shall remain applicable.

(Transitional measures accompanying revision of the Utility Model Act by provisions of Article 4)

Article 5 (1) The provisions of the Utility Model Act (hereinafter referred to as the "new Utility Model Act" in this Article) revised by the provisions of Article 4 (excluding the provisions revising Article 28 and Article 33-3, paragraph (2), item (ii) and Article 44, paragraph (2), item (ii) of the Utility Model Act) shall be applied to applications for utility model registration being filed on and after the Effective Date (including applications for utility model registration being filed on and after the Effective Date, which are deemed to have been filed prior to the Effective Date pursuant to the provisions of Article 10, paragraph (3) of the Utility Model Act or the provisions of Article 44, paragraph (2) of the Patent Act applied mutatis mutandis in Article 11 paragraph (1) of the Utility Model Act (hereinafter referred to as an "application for utility model registration pertaining to division, etc. of an application for utility model registration prior to the Effective Date" in this paragraph)); and with regard to applications for utility model registration filed prior to the Effective Date (excluding applications for utility model registration pertaining to division, etc. of an application for utility model registration prior to the Effective Date), the provisions then in force shall remain applicable.

(2) With regard to the application of Article 3-2 of the new Utility Model Act in a case where an application for utility model registration or for patent filed prior to the Effective Date is another application for utility model registration or for patent prescribed in the said Article, the term "the description, scope of claims for a utility model registration or scope of claims for a patent" in the said Article shall be deemed to be replaced with "the description".

(3) With regard to the application of Article 8, paragraphs (1) through (3) of the new Utility Model Act in a case where an application for utility model registration or an application for patent filed prior to the Effective Date is an Earlier Application prescribed in Article 8, paragraph (1) of the said Act, the term "the description, scope of claims for a utility model registration or patent" in these provisions shall be deemed to be replaced with "the description".

(Transitional measures relating to application of penal provisions)

Article 7 With regard to the application of penal provisions to acts conducted

prior to the enforcement of this Act, the provisions then in force shall remain applicable.

(Delegation to Cabinet Order)

Article 8 In addition to what is prescribed in Articles 2 through the preceding Article of these Supplementary Provisions, necessary transitional measures relating to the enforcement of this Act shall be specified by a Cabinet Order.

### **Supplementary Provisions [Act No. 47 of May 23, 2003 Extract] [Extract]**

(Effective date)

Article 1 This Act shall come into effect as from January 1, 2004; provided, however, that the provisions listed in the following items shall come into effect as from the date prescribed respectively in those items.

(i) The provisions of Article 18 of these Supplementary Provisions: the date of the promulgation

(ii) The provisions revising Articles 107 and 195 and Appended Table items (i) through (iv) and (vi) of the Patent Act in Article 1; the provisions revising Articles 31 and 54 of the Utility Model Act in Article 2; the provisions revising Articles 42 and 67 of the Design Act in Article 3; the provisions revising Articles 40, 41-2, 65-7 and 76 of the Trademark Act in Article 4; the provisions revising Article 18 of the Act on International Applications under the Patent Cooperation Treaty in Article 5; the provisions revising Article 40 of the Act on Special Provisions for Procedures related to Industrial Property Rights in Article 6 (excluding the part pertaining to paragraph (1) of the said Article); and the provisions of Articles 7 and 8; and the provisions of Article 2, paragraphs (2) through (6), Article 3, paragraphs (2) and (3), Article 4, paragraph (1), Article 5, paragraph (1), Articles 7 through 11, Articles 16 and 19 of these Supplementary Provisions: April 1, 2004

(Transitional measures accompanying revision of the Utility Model Act)

Article 3 (1) The provisions of Article 6 of the Utility Model Act revised by the provisions of Article 2 (hereinafter referred to as the "new Utility Model Act" in this Article) shall be applied to applications for utility model registration being filed after the enforcement of this Act; and with regard to applications for utility model registration filed prior to the enforcement of this Act, the provisions then in force shall remain applicable.

(2) With regard to the application of the provisions of Article 31, paragraphs (2) and (3) of the new Utility Model Act concerning the payment of registration fees pertaining to an application for utility model registration partially filed prior to the Enforcement Date (excluding applications for utility model

registration being partially filed on and after the Enforcement Date, which are deemed to have been partially filed prior to the Enforcement Date pursuant to the provisions of Article 10, paragraph (3) of the Utility Model Act, or the provisions of the Article 44, paragraph (2) of the Patent Act applied mutatis mutandis in Article 11, paragraph (1) of the Utility Model Act (hereinafter referred to as "applications for utility model registration pertaining to the division, etc. of an application for utility model registration prior to the Partial Enforcement Date "); and with regard to the application of the provisions of Article 54, paragraphs (3) through (5) of the new Utility Model Act concerning the payment of fees pertaining to the same application; the term "the State" in these provisions shall be deemed to be replaced with "the State, etc. (meaning the State, etc. prescribed in Article 31, paragraph (4) of the Utility Model Act prior to revision by the provisions of Article 2 of the Act for Partial Revision of the Patent Act, etc. (Act No. 47 of 2003))."

- (3) With regard to registration fees, concerning a jointly owned utility model right, which were already paid partially or required to be paid partially prior to the Enforcement Date (including registration fees the payment of which was deferred pursuant to the provisions of Article 32-2 of the Utility Model Act prior to revision by the provisions of Article 2); notwithstanding the provisions of Article 31, paragraph (3) of the new Utility Model Act, the provisions then in force shall remain applicable.
- (4) With regard to a trial or a retrial requested prior to the enforcement of this Act, the provisions then in force shall remain applicable until the decision becomes final and binding.
- (5) With regard to a retrial against a final and binding decision on a trial requested prior to the enforcement of this Act, the provisions then in force shall remain applicable.

(Transitional measures accompanying partial revision of the Amendment Act of 1993)

- Article 13 (1) With regard to a trial which was requested prior to the enforcement of this Act, and is under Article 37, paragraph (1), Article 39, paragraph (1) or Article 48-12, paragraph (1) of the Utility Model Act prior to revision by the provisions of the Amendment Act of 1993 (hereinafter referred to as the "former Utility Model Act"); the provisions then in force shall remain applicable until the decision becomes final and binding.
- (2) The provisions of Article 181 of the New Patent Act applied mutatis mutandis in Article 47, paragraph (2) of the former Utility Model Act replaced in Article 4 paragraph (2) of the Supplementary Provisions of the Amendment Act of 1993 revised by the provisions of the preceding Article shall be applied to an action against a decision on a trial which is requested after the enforcement of

this Act and is under Article 37, paragraph (1) or Article 48-12, paragraph (1) of the former Utility Model Act; and with regard to an action against a decision on a trial which has been requested prior to the enforcement of this Act and is under Article 37, paragraph (1) or Article 48-12, paragraph (1) of the former Utility Model Act, the provisions then in force shall remain applicable.

(Transitional measures relating to application of penal provisions)

Article 17 With regard to applications of penal provisions to acts conducted prior to the enforcement of this Act, and acts which were conducted after the enforcement of this Act and are pertaining to matters with regard to which the provisions then in force shall remain applicable pursuant to the provisions of these Supplementary Provisions; each of the provisions then in force shall remain applicable.

(Delegation to Cabinet Order)

Article 18 In addition to what is prescribed in Articles 2 through the preceding Article of these Supplementary Provisions, necessary transitional measures relating to the enforcement of this Act shall be specified by a Cabinet Order.

(Review)

Article 19 The Government shall, when five years have passed from the enforcement of the provisions listed in Article 1, item (ii) of these Supplementary Provisions, review the status of enforcement of the provisions of Article 107, paragraph (1) and Appended Tables 1 through 4 and 6 of the New Patent Act and take necessary measures based on the results thereof.

### **Supplementary Provisions [Act No. 108 of July 16, 2003 Extract] [Extract]**

(Effective Date)

Article 1 This Act shall come into effect as from the date specified by a Cabinet Order within a period not exceeding one year from the date of the promulgation; provided, however, that the provisions of Article 3 shall come into effect as from the date of the enforcement of the Act for Partial Revision of the Patent Act, etc. (Act No. 47 of 2003) or the date of the enforcement of this Act, whichever comes later.

(Transitional measures relating to jurisdiction, etc. over litigation pertaining to actions relating to patent right, etc. and design right, etc.)

Article 3 (1) With regard to jurisdiction and transfer of litigation pertaining to actions actually pending at the time of the enforcement of this Act: actions

relating to patent rights, utility model rights, layout-design exploitation rights or author's rights over computer programs (referred to as "actions relating to patent rights, etc." in paragraph (4)), and actions relating to design rights, trademark rights, author's rights (excluding author's rights over computer programs), publication rights, neighboring rights or breeder's rights, or actions pertaining to the infringement of business interests due to unfair competition (meaning unfair competition prescribed in Article 2, paragraph (1) of the Unfair Competition Prevention Act (Act No. 47 of 1993)); the provisions then in force shall remain applicable.

- (2) The provisions of Articles 269-2 and 310-2 of the Code of Civil Procedure revised by the provisions of Article 1, and the provisions of Article 182-2 of the Patent Act revised by the provisions of Article 2 (including cases where Article 182-2 of the Patent Act are applied mutatis mutandis in Article 47, paragraph (2) of the Utility Model Act revised by the provisions of Article 3) shall not be applied to cases actually pending at the time of the enforcement of this Act.
- (3) The provisions of Article 182-2 of the Patent Act revised by the provisions of Article 2 shall, except in the case prescribed in the preceding paragraph, be applied to cases pertaining to actions with regard to which the provisions then in force shall remain applicable pursuant to the provisions of Article 2, paragraph (9) of the supplementary provisions of the Act for Partial Revision of the Patent Act, etc., and which are under Article 178, paragraph (1) of the Patent Act prior to revision by the provisions of Article 1 of the Act for Partial Revision of the Patent Act, etc. and are against rescission decisions concerning patent oppositions or decisions of dismissal of written patent oppositions.
- (4) With regard to jurisdiction over a case where a temporary restraining order is pertaining to a petition submitted prior to the enforcement of this Act and an action on the merits is an action relating to a patent right, etc., the provisions then in force shall remain applicable.

(Transitional measures relating to the Utility Model Act)

Article 5 (1) In cases where the date of the enforcement of this Act is before the date of the enforcement of the Act for Partial Revision of the Patent Act, etc., with regard to the application of the provisions of Article 47, paragraph (2) of the Utility Model Act until the date preceding the date of the enforcement of the Act for Partial Revision of the Patent Act, etc., the terms "Article 182" and "and delivery of original copy of judgment" shall be deemed to be replaced with "Article 182-2", and "and, delivery of original copy of judgment and composition of panel", respectively.

- (2) In the case referred to in the preceding paragraph, the provisions of Article 182-2 of the Patent Act revised by the provisions of Article 2 and applied mutatis mutandis in Article 47, paragraph (2) of the Utility Model Act which

shall be deemed to be replaced in the preceding paragraph and applied shall not be applied to a case actually pending at the time of the enforcement of this Act.

**Supplementary Provisions [Act No. 79 of June 4, 2004 Extract] [Extract]**

(Effective date)

Article 1 This Act shall come into effect as from April 1, 2005; provided, however, that the provisions listed in the following items shall come into effect as from the date prescribed respectively in those items.

(i) The provisions of Article 6 of these Supplementary Provisions: the date of the promulgation

(ii) The provisions revising Article 195, paragraph (7) of the Patent Act in Article 1; the provisions revising Article 54, paragraph (6) of the Utility Model Act in Article 2; and the provisions revising Articles 14 through 16 of the Act on Special Provisions for Procedures related to Industrial Property Rights in Article 3; and the provisions of Article 4, paragraph (1) of these Supplementary Provisions: the date of the promulgation or April 1, 2004, whichever comes later

(Transitional measures accompanying revision of the Utility Model Act)

Article 3 The provisions of the Utility Model Act revised by the provisions of Article 2 (excluding the provisions revising Article 54, paragraph (6) of the Utility Model Act) shall be applied to applications for utility model registration being filed after the enforcement of this Act; and with regard to applications for utility model registration filed prior to the enforcement of this Act, the provisions then in force shall remain applicable.

(Delegation to Cabinet Order)

Article 6 In addition to what is prescribed in Articles 2 through the preceding Article of these Supplementary Provisions, necessary transitional measures relating to the enforcement of this Act shall be specified by a Cabinet Order.

(Review)

Article 7 The Government shall, when five years have passed from the enforcement of this Act and it finds the necessity by taking into account the status of enforcement of the provisions of Chapter 4, Section 3 of the Newly Revised Act on Special Provisions, review the provisions of the same section and take necessary measures based on the results thereof.

**Supplementary Provisions [Act No. 102 of June 18, 2004 Extract]**

(Effective date)

Article 1 This Act shall come into effect as from April 1, 2005.

(Principle of transitional measures)

Article 2 The provisions (excluding the penal provisions) of the Court Act, the Code of Civil Procedure, the Act on Costs of Civil Procedure, the Patent Act, the Utility Model Act, the Design Act, the Trademark Act, the Unfair Competition Prevention Act and the Copyright Act revised by this Act shall, except as otherwise provided in these Supplementary Provisions, be applied also to the matters which occurred prior to the enforcement of this Act; provided, however, that this shall not preclude an effect raised prior to revision by this Act by the provisions of these Acts.

(Transitional measures accompanying partial revision of the former Utility Model Act of 1993)

Article 5 (1) The provisions (excluding the penal provisions) of the former Utility Model Act of 1993 revised by this Act shall, except in the case prescribed in the following paragraph, also be applied also to the matters which occurred prior to the enforcement of this Act; provided, however, that this shall not preclude an effect raised by the provisions of the former Utility Model Act of 1993 prior to revision by this Act.

(2) The following provisions shall not be applied to cases where litigation has completed prior to the enforcement of this Act, cases where oral arguments before a high court or a district court that constitutes a court of second instance have finished prior to the enforcement of this Act, or cases where parties, prior to the enforcement of this Act, have agreed to reserve rights to a final appeal against the summary court judgment or the judgment that the district court has made as a court of first instance and not to appeal to the court of second instance:

- (i) The provisions of Articles 104-3, 105-4 through 105-6 and Article 168, paragraph (5) and (6) of the New Patent Act applied mutatis mutandis in Article 13-3, paragraph (4) of the former Utility Model Act of 1993 revised by this Act (including cases where they are applied mutatis mutandis in Article 48-13, paragraph (2) of the former Utility Model Act of 1993 revised by this Act)
- (ii) The provisions of Articles 105-4, through 105-6 of the New Patent Act applied mutatis mutandis in Article 30 of the former Utility Model Act of 1993 revised by this Act

**Supplementary Provisions [Act No. 75 of June 29, 2005 Extract] [Extract]**

(Effective date)

Article 1 This Act shall come into effect as from the date specified by a Cabinet Order within a period not exceeding one year from the date of the promulgation.

(Transitional measures)

Article 2 The provisions of Article 2, paragraph (1), item (iii) of the Unfair Competition Prevention Act revised by the provisions of Article 1 shall be applied to the acts listed in the said item, which were conducted after the enforcement of this Act; and with regard to the acts which have been conducted prior to the enforcement of this Act and are listed in Article 2, paragraph (1), item (iii) of the Unfair Competition Prevention Act prior to revision by the provisions of Article 1, the provisions then in force shall remain applicable.

Article 3 Deletion

Article 4 Deletion

(Delegation to Cabinet Order)

Article 5 In addition to what is prescribed in Article 2 of these Supplementary Provisions, necessary transitional measures relating to the enforcement of this Act shall be specified by a Cabinet Order.

### **Supplementary Provisions [Act No. 55 of June 7, 2006 Extract] [Extract]**

(Effective date)

Article 1 (i) This Act shall come into effect as from the date specified by a Cabinet Order within a period not exceeding one year from the date of the promulgation; provided, however, that the provisions listed in the following items shall come into effect as from the date prescribed respectively in those items.

(ii) The provisions revising Article 2, paragraph (3), Articles 38, 44-3 and 55, the provisions deleting the heading of Article 69, the provisions adding the heading prior to the said Article, the provisions revising the said Article, the provisions adding one Article next to the said Article and the provisions revising Article 74 of the Design Act in Article 1; the provisions revising Articles 2, 101, 102-3 and 175, the provisions deleting the heading of Article 196, the provisions adding the heading prior to the said Article, the provisions revising the said Article, the provisions adding one Article next to the said Article and the provisions revising Article 201 of the Patent Act in Article 2; the provisions of Article 3; the provisions revising Article 2,

paragraph (3), Articles 37 and 67, the provisions deleting the heading of Article 78, the provisions adding the heading prior to the said Article, the provisions revising the said Article, the provisions adding one Article next to the said Article and the provisions revising Article 82 of the Trademark Act in Article 4; and the provisions of Article 5; and the provisions of the following Article, paragraph (3) and Article 3, paragraph (2), Article 4, Article 5, paragraph (2), Articles 9, 12, 13 and 16 of these Supplementary Provisions: January 1, 2007

(Transitional measures accompanying revision of the Utility Model Act)

Article 4 The provisions of Articles 2, 28, 33-3 and 44 of the Utility Model Act revised by the provisions of Article 3 shall be applied to acts partially conducted on and after the Enforcement Date; and with regard to acts partially conducted prior to the Enforcement Date, the provisions then in force shall remain applicable.

Article 9 Deletion

Article 10 Deletion

(Transitional measures accompanying partial revision of the former Utility Model Act of 1993)

Article 13 The provisions of Articles 2 and 28 of the former Utility Model Act of 1993 revised by the provisions of the preceding Article shall be applied to acts partially conducted on and after the Enforcement Date; and with regard to acts partially conducted prior to the Enforcement Date, the provisions then in force shall remain applicable.

(Delegation to Cabinet Order)

Article 14 In addition to what is prescribed in Articles 2 through 11 and the preceding Article of these Supplementary Provisions, necessary transitional measures relating to the enforcement of this Act shall be specified by a Cabinet Order.

### **Supplementary Provisions [Act No. 16 of April 18, 2008 Extract] [Extract]**

(Effective date)

Article 1 This Act shall come into effect as from the date specified by a Cabinet Order within a period not exceeding one year from the date of the promulgation; provided, however, that the provisions listed in the following items shall come into effect as from the date prescribed respectively in those

items.

- (i) The provisions of Article 6 of these Supplementary Provisions: the date of the promulgation
- (iii) The provisions revising Article 27, paragraph (1), item (i) and Article 98, paragraph (1), item (i) of the Patent Act in Article 1; the provisions revising Article 49, paragraph (1), item (i) of the Utility Model Act in Article 2; the provisions revising Article 61, paragraph (1), item (i) of the Design Act in Article 3; and the provisions revising Article 68-27, paragraphs (1) and (2) of the Trademark Act in Article 4: September 30, 2008

(Transitional measures accompanying revision of the Utility Model Act)

Article 3 (1) The provisions of Article 10, paragraph (1), proviso and paragraph (6) of the new Utility Model Act shall be applied to an application for patent concerning which a certified copy of the examiner's initial decision is to be served on or after the date of the enforcement of this Act to the effect that the application for patent should be refused; and with regard to an application for patent concerning which a certified copy of the examiner's initial decision has been served prior to the date of the enforcement of this Act to the effect that the application for patent should have been refused, the provisions then in force shall remain applicable.

(2) The provisions of Article 10, paragraph (2), proviso and paragraph (7) of the new Utility Model Act shall be applied to an application for design registration concerning which a certified copy of the examiner's initial decision is to be served on or after the date of the enforcement of this Act to the effect that the application for design registration should be refused; and with regard to an application for design registration concerning which a certified copy of the examiner's initial decision has been served prior to the date of the enforcement of this Act to the effect that the application for design registration should have been refused, the provisions then in force shall remain applicable.

(Delegation to Cabinet Order)

Article 6 In addition to what is prescribed in Article 2 to the preceding Article of these Supplementary Provisions, necessary transitional measures relating to the enforcement of this Act shall be specified by a Cabinet Order.

### **Supplementary Provisions [Act No. 63 of June 8, 2011 Extract] [Extract]**

(Effective date)

Article 1 This Act shall come into effect as from the date specified by a Cabinet Order within a period not exceeding one year from the date of the promulgation.

- (Transitional measures accompanying partial revision of the Utility Model Act)
- Article 3 (1) The provisions of Article 34-3, paragraph (5) of the New Patent Act applied mutatis mutandis in Article 4-2, paragraph (3) of the Utility Model Act revised by the provisions of Article 2 (hereinafter referred to as the "new Utility Model Act") shall not be applied in a case where a priority has been claimed pursuant to the provisions of Article 8, paragraph (1) of the new Utility Model Act prior to the date of the enforcement of this Act.
- (2) The provisions of Article 7 of the new Utility Model Act shall be applied to applications for utility model registration or applications for patent filed on and after the date of the enforcement of this Act, and with regard to applications for utility model registration or applications for patent filed prior to the date of the enforcement of this Act, the provisions then in force shall remain applicable.
- (3) In a case where a person has a provisional non-exclusive license registered concerning an application for patent actually pending before the Japan Patent Office at the time of the enforcement of this Act, with regard to consent pertaining to a priority claim which is based on the application for patent and is pursuant to the provisions of Article 8, paragraph (1) of the new Utility Model Act, or a conversion of an application which is based on the application for patent and is pursuant to the provisions of Article 10, paragraph (1) of the new Utility Model Act, notwithstanding the provisions of Article 8, paragraph (1), proviso or Article 10, paragraph (9) of the new Utility Model Act, the provisions then in force shall remain applicable.
- (4) The provisions of Article 30 of the New Patent Act applied mutatis mutandis in Article 11, paragraph (1) of the new Utility Model Act shall, except in the case prescribed in the following paragraph, be applied to devices pertaining to applications for utility model registration filed on and after the date of the enforcement of this Act, and with regard to devices pertaining to applications for utility model registration filed prior to the date of the enforcement of this Act, the provisions then in force shall remain applicable.
- (5) In a case where an application for utility model registration filed on and after the date of the enforcement of this Act is accompanied with a priority claim pursuant to the provisions of Article 8, paragraph (1) of the new Utility Model Act, and the Earlier Application prescribed in the said paragraph, which has been deemed to be the basis for the priority claim, has been filed prior to the date of the enforcement of this Act; with regard to a device pertaining to the Earlier Application among devices pertaining to the application for utility model registration, notwithstanding the provisions of Article 30 of the New Patent Act applied mutatis mutandis in Article 11, paragraph (1) of the new Utility Model Act, the provisions then in force shall remain applicable.
- (6) The provisions of Article 17-2 of the new Utility Model Act, Article 104-3,

paragraph (3) of the New Patent Act applied mutatis mutandis in Article 30 of the new Utility Model Act and Article 37, paragraph (1), item (v) and paragraph (2) of the new Utility Model Act shall be applied to applications for utility model registration filed on and after the date of the enforcement of this Act, and with regard to applications for utility model registration filed prior to the date the enforcement of this Act, the provisions then in force shall remain applicable.

(7) The provisions of Article 99 of the New Patent Act and Article 20, paragraph (1) of the new Utility Model Act which are applied mutatis mutandis in Article 19, paragraph (3) of the new Utility Model Act shall be applied also to the non-exclusive licenses actually existing at the time of the enforcement of this Act.

(8) In cases where a registration has been carried out prior to the date of the enforcement of this Act, under Article 99, paragraph (3) of the former Patent Act (including the registration in a case where a registration has been deemed to be carried out under Article 99, paragraph (3) of the former Patent Act applied mutatis mutandis in Article 19, paragraph (3) of the former Utility Model Act, pursuant to the provisions of Article 58, paragraph (2) of the former Industrial Revitalization Act) applied mutatis mutandis in Article 19, paragraph (3) or Article 25, paragraph (4) of the Utility Model Act prior to revision by the provisions of Article 2 (hereinafter referred to as the "former Utility Model Act") pertaining to the transfer, modification, extinction or restriction on disposition of a non-exclusive license, or the establishment, transfer, modification, extinction or restriction on disposition of a right of pledge on a non-exclusive license; with regard to the effect of the registration to third parties, the provisions then in force shall remain applicable.

(9) The provisions of Article 82, paragraph (1) of the New Patent Act applied mutatis mutandis in Article 26 of the new Utility Model Act shall be applied also to non-exclusive licenses concerning design rights or exclusive licenses thereof which actually exist at the time of the enforcement of this Act.

(10) The provisions of Article 104-4 of the New Patent Act applied mutatis mutandis in Article 30 of the new Utility Model Act shall be applied to claims in actions for retrial filed on and after the date of the enforcement of this Act (limited to actions for retrial pertaining to lawsuits to which applied are the provisions of Article 104-3, paragraph (1) of the Revised Patent Act of 2004 applied mutatis mutandis in Article 30 of the Utility Model Act revised by the provisions of the Article 5 of the Act for Partial Revision of the Court Act, etc. (Act No. 120 of 2004)).

(11) The provisions of Article 33-2, paragraph (1) of the new Utility Model Act shall be applied to utility model rights deemed to have extinguished or from the beginning to have been non-existent pursuant to the provisions of Article 33, paragraph (4) or (5) of the new Utility Model Act on and after the date of

the enforcement of this Act, and with regard to utility model rights deemed to have extinguished or from the beginning to have been non-existent pursuant to the provisions of Article 33, paragraph (4) or (5) of the former Utility Model Act prior to the date of the enforcement of this Act, the provisions then in force shall remain applicable.

- (12) With regard to a trial or a retrial requested prior to the date of the enforcement of this Act, the provisions then in force shall remain applicable until the decision become final and binding.
- (13) With regard to a retrial against a final and binding decision on a trial requested prior to the date of the enforcement of this Act, the provisions then in force shall remain applicable.
- (14) With regard to invalidation of a utility model registration (limited to invalidation pertaining to Article 37, paragraph (1), item (vii) of the former Utility Model Act) pertaining to correction which has been made under Article 14-2, paragraph (1) of the former Utility Model Act, prior to the date of the enforcement of this Act (including corrections which is made on and after the date of the enforcement of this Act, and with regard to which the provisions then in force shall remain applicable pursuant to the provisions of paragraph (12)); the provisions then in force shall remain applicable.
- (15) The provisions of Article 167 of the new Utility Model Act applied mutatis mutandis in Article 41 of the new Utility Model Act shall be applied to a trial based on the same facts and same evidence as a trial a final and binding decision of which has been registered on and after the date of the enforcement of this Act, and with regard to a trial based on the same facts and same evidence as a trial a final and binding decision of which has been registered prior to the date of the enforcement of this Act, the provisions then in force shall remain applicable.
- (16) The provisions of Article 181 of the New Patent Act applied mutatis mutandis in of Article 47, paragraph (2) of the new Utility Model Act shall be applied to actions against decisions on trials requested on and after the date of the enforcement of this Act, and with regard to actions against decisions on trials requested prior to the date of the enforcement of this Act, the provisions then in force shall remain applicable.
- (17) The provisions of Article 48-4, paragraphs (4) and (5) of the new Utility Model Act shall not be applied to International Applications for Utility Model Registration deemed to have been withdrawn pursuant to the provisions of Article 48-4, paragraph (3) of the former Utility Model Act prior to the date of the enforcement of this Act.
- (18) With regard to certification, etc. for information which is pertaining to non-exclusive licenses registered prior to the date of the enforcement of this Act, and for which certification, etc. has been not to be made pursuant to the

provisions of Article 186, paragraph (3) of the former Patent Act applied mutatis mutandis in Article 55, paragraph (1) of the former Utility Model Act, notwithstanding the provisions of the main clause of Article 186, paragraph (1) of the New Patent Act applied mutatis mutandis in Article 55, paragraph (1) of the new Utility Model Act, the provisions then in force shall remain applicable.

(Delegation to Cabinet Order)

Article 11 In addition to what is prescribed in Articles 2 through the preceding Article of these Supplementary Provisions, necessary transitional measures relating to the enforcement of this Act shall be specified by a Cabinet Order.

(Transitional measures accompanying partial revision of the former Utility Model Act of 1993)

Article 18 The provisions of Article 104-4 of the New Patent Act applied mutatis mutandis in Article 13-3, paragraph (4) of the former Utility Model Act of 1993 revised by the provisions of the preceding Article (hereinafter referred to as the "the Revised former Utility Model Act of 1993") shall be applied to claims in actions for retrial filed on and after the date of the enforcement of this Act (limited to actions for retrial pertaining to lawsuits to which applied are the provisions of Article 104-3, paragraph (1) of the Revised Patent Act of 2004 applied mutatis mutandis in Article 13-3, paragraph (4) of the former Utility Model Act of 1993 revised by the provisions of Article 4 of the Supplementary Provisions of the Act for Partial Revision of the Court Act, etc. (Act No. 120 of 2004)).

(Transitional measures accompanying partial revision of the Amendment Act of 1993)

Article 20 (1) With regard to a trial or a retrial which has been requested prior to the date of the enforcement of this Act, and is under Article 37, paragraph (1), Article 39, paragraph (1) or Article 48-12, paragraph (1) of the former Utility Model Act of 1993 prior to revision by the provisions of Article 17 of the Supplementary Provisions (hereinafter referred to as the "former Utility Model Act of 1993 prior to Revision"); the provisions then in force shall remain applicable until the decision becomes final and binding.

(2) With regard to trials concerning the correction of a description or drawings attached to an application for utility model registration pertaining to a trial which has been requested prior to the date of the enforcement of this Act, and is under Article 37, paragraph (1) or Article 48-12, paragraph (1) of the former Utility Model Act of 1993 prior to Revision, and the decision of which is not final and binding (referred to as a "trial for correction " in the following paragraph); the provisions then in force shall remain applicable until the

decision becomes final and binding.

- (3) With regard to retrials against final and binding decisions on trials which have been requested prior to the date of the enforcement of this Act and are under Article 37, paragraph (1), Article 39, paragraph (1) or Article 48-12, paragraph (1) of the former Utility Model Act of 1993 prior to Revision, and with regard to retrials against final and binding decisions on trials for correction being requested under the provisions then in force pursuant to the provisions of the preceding paragraph on and after the date of the enforcement of this Act; the provisions then in force shall remain applicable.
- (4) With regard to invalidation of a utility model registration (limited to invalidation pertaining to Article 37, paragraph (1), item (ii)-2 of the former Utility Model Act of 1993 prior to Revision) pertaining to correction which has been made prior to the date of the enforcement of this Act and is pursuant to the provisions of Article 39, paragraph (1) or Article 40-2, paragraph (1) of the former Utility Model Act of 1993 prior to Revision (including correction which is made on and after the date of the enforcement of this Act, and with regard to which the provisions then in force shall remain applicable pursuant to the provisions of paragraph (1) or (2)); the provisions then in force shall remain applicable.
- (5) The provisions of Article 167 applied mutatis mutandis in Article 41 of the Revised former Utility Model Act of 1993 replaced in Article 4, paragraph (2) of the Supplementary Provisions of the Amendment Act of 1993 revised by the provisions of the preceding Article (hereinafter referred to as the "Replaced Revised former Utility Model Act of 1993") shall be applied to a trial based on the same facts and same evidence as a trial the final and binding decision of which has been registered on and after the date of the enforcement of this Act; and with regard to a trial based on the same facts and same evidence as a trial the final and binding decision of which has been registered prior to the date of the enforcement of this Act, the provisions then in force shall remain applicable.
- (6) The provisions of Article 195-4 of the New Patent Act applied mutatis mutandis in Article 47, paragraph (1) of the Revised former Utility Model Act of 1993 and Article 55, paragraph (6) of Replaced Revised former Utility Model Act of 1993 shall be applied to a decision of dismissal of a written request for correction which has been requested on and after the date the enforcement of this Act, and which is made pursuant to the provisions of Article 133, paragraph (3) of the New Patent Act applied mutatis mutandis in Article 41 of the Replaced Revised former Utility Model Act of 1993 pertaining to a trial under Article 37, paragraph (1) or Article 48-12, paragraph (1) of the Revised former Utility Model Act of 1993, and is under Article 40-2, paragraph (1) of the Revised former Utility Model Act of 1993; and with regard to a decision of

dismissal of a written request for correction which has been requested prior to the date of the enforcement of this Act, and which is made pursuant to the provisions of Article 133, paragraph (3) of the former Patent Act applied mutatis mutandis in Article 41 of the former Utility Model Act of 1993 prior to Revision pertaining to a trial under Article 37, paragraph (1) or Article 48-12, paragraph (1) of the former Utility Model Act of 1993 prior to Revision, and is under Article 40-2, paragraph (1) of the former Utility Model Act of 1993 prior to Revision, the provisions then in force shall remain applicable.

(7) The provisions of Article 181 of the New Patent Act applied mutatis mutandis in Article 47, paragraph (2) of Replaced Revised former Utility Model Act of 1993 shall be applied to an action against a decision concerning a trial which is requested on and after the date of the enforcement of this Act, and is under Article 37, paragraph (1), Article 39, paragraph (1) or Article 48-12, paragraph (1) of the Revised former Utility Model Act of 1993; and with regard to an action against a decision on a trial which has been requested prior to the date of the enforcement of this Act, and is under Article 37, paragraph (1), Article 39, paragraph (1) or Article 48-12, paragraph (1) of the former Utility Model Act of 1993 prior to Revision, the provisions then in force shall remain applicable.

(8) The provisions of Appended Tables 9 of the Revised former Utility Model Act of 1993 shall be applied to fees pertaining to a trial which is requested on and after the date of the enforcement of this Act, and is under Article 37, paragraph (1) or Article 48-12, paragraph (1) of the Revised former Utility Model Act of 1993; and with regard to fees pertaining to a trial which is requested prior to the date of the enforcement of this Act and is under Article 37, paragraph (1) or Article 48-12, paragraph (1) of the Former Utility Model Act of 1993 prior to Revision, the provisions of Appended Tables 9 of the former Utility Model Act of 1993 prior to Revision shall remain applicable.

#### **Supplementary Provisions [Act No. 74 of June 24, 2011 Extract] [Extract]**

(Effective date)

Article 1 This Act shall come into effect as from the date to which 20 days have elapsed from the date of the promulgation.

#### **Supplementary Provisions [Act No. 36 of May 14, 2014 Extract] [Extract]**

(Effective date)

Article 1 This Act shall come into effect as from the date specified by a Cabinet Order within a period not exceeding one year from the date of the promulgation; provided, however, that the provisions listed in the following

items shall come into effect as from the date prescribed respectively in those items.

(i) The provisions of Article 9 of these Supplementary Provisions: the date of the promulgation

(Transitional measures accompanying partial revision of the Utility Model Act)

Article 3 (1) The provisions of Article 2-2, paragraph (1), proviso of the Utility Model Act revised by the provisions of Article 2 (hereinafter referred to as the "new Utility Model Act") shall be applied to applications for utility model registration filed after the enforcement of this Act, and with regard to applications for utility model registration filed prior to the enforcement of this Act, the provisions then in force shall remain applicable.

(2) The provisions of Article 8, paragraphs (1) and (4) of the new Utility Model Act shall be applied to priority claims accompanying applications for utility model registration filed after the enforcement of this Act, and with regard to priority claims accompanying applications for utility model registration filed prior to the enforcement of this Act, the provisions then in force shall remain applicable.

(3) The provisions of Article 9, paragraph (1) of the new Utility Model Act shall be applied to an early application which has been made to be the basis of a priority claim which accompanies an application for utility model registration filed after the enforcement of this Act, and which is prescribed in Article 8, paragraph (1) of the new Utility Model Act; and with regard to an early application which has been made to be the basis of a priority claim which accompanies an application for utility model registration filed prior to the enforcement of this Act, and which is prescribed in Article 8, paragraph (1) of the Utility Model Act prior to revision by the provisions of Article 2 (hereinafter referred to as the "former Utility Model Act"), the provisions then in force shall remain applicable.

(4) The provisions of Article 9, paragraphs (2) and (3) of the new Utility Model Act shall be applied to a priority claim accompanying an application for utility model registration being filed after the enforcement of this Act; and with regard to a priority claim accompanying an application for utility model registration filed prior to the enforcement of this Act, the provisions then in force shall remain applicable.

(5) The provisions of Article 30, paragraph (4) of the New Patent Act applied mutatis mutandis in Article 11, paragraph (1) of the new Utility Model Act shall not be applied in a case where no certificate prescribed in Article 30, paragraph (3) of the former Patent Act has been submitted within the period prescribed in the said paragraph applied mutatis mutandis in Article 11, paragraph (1) of the former Utility Model Act prior to the enforcement of this

Act.

- (6) The provisions of Article 43, paragraph (1) of the New Patent Act applied mutatis mutandis in Article 11, paragraph (1) of the new Utility Model Act (including cases where Article 43, paragraph (1) of the New Patent Act is applied mutatis mutandis in Article 43-4, paragraph (3) of the New Patent Act applied mutatis mutandis in Article 11, paragraph (1) of the new Utility Model Act) shall be applied to a priority claim accompanying an application for utility model registration being filed after the enforcement of this Act; and with regard to a priority claim accompanying an application for utility model registration filed prior to the enforcement of this Act, the provisions then in force shall remain applicable.
- (7) The provisions of Article 43, paragraph (6) of the New Patent Act applied mutatis mutandis in Article 11, paragraph (1) of the new Utility Model Act (including cases where Article 43, paragraph (6) of the New Patent Act is applied mutatis mutandis in Article 43-3, paragraph (3) of the New Patent Act applied mutatis mutandis in Article 11, paragraph (1) of the new Utility Model Act) shall not be applied in a case where, prior to the enforcement of this Act, no documents prescribed in Article 43, paragraph (2) of the former Patent Act applied mutatis mutandis in Article 11, paragraph (1) of the former Utility Model Act (including cases where Article 43, paragraph (2) of the former Patent Act is applied mutatis mutandis in Article 43-2, paragraph (3) of the former Patent Act applied mutatis mutandis in Article 11, paragraph (1) of the former Utility Model Act; hereinafter the same shall be applied in this paragraph), within the period prescribed in Article 43, paragraph (2) of the former Patent Act applied mutatis mutandis in Article 11, paragraph (1) of the former Utility Model Act, nor letters prescribed in Article 43, paragraph (5) of the former Patent Act applied mutatis mutandis in Article 11, paragraph (1) of the former Utility Model Act (including cases where Article 43, paragraph (5) of the former Patent Act is applied mutatis mutandis in Article 43-2, paragraph (3) of the former Patent Act applied mutatis mutandis in Article 11, paragraph (1) of the former Utility Model Act) have been submitted.
- (8) The provisions of Article 43-2 of the New Patent Act applied mutatis mutandis in Article 11, paragraph (1) of the new Utility Model Act (including cases where Article 43-2 of the New Patent Act is applied mutatis mutandis in Article 43-3, paragraph (3) of the New Patent Act applied mutatis mutandis in Article 11, paragraph (1) of the new Utility Model Act) shall not be applied to a priority claim accompanying an application for utility model registration filed prior to the enforcement of this Act.
- (9) The provisions of Article 32, paragraph (4) of the new Utility Model Act shall not be applied in cases where registration fees have not been paid within the period extended pursuant to the provisions of Article 32, paragraph (3) of the

former Utility Model Act, prior to the enforcement of this Act.

(10) The provisions of Article 34, paragraph (3) of the new Utility Model Act shall not be applied in cases where a return of registration fees pursuant to the provisions of Article 34, paragraph (1) of the former Utility Model Act has not been requested within the period prescribed in paragraph (2) of the said Article prior to the enforcement of this Act.

(11) With regard to the amendment of procedures concerning an international application deemed to be an application for utility model registration filed pursuant to the provisions of Article 48-16, paragraph (4) of the Utility Model Act, prior to the enforcement of this Act, the provisions then in force shall remain applicable.

(12) The provisions of Article 54-2, paragraph (12) of the new Utility Model Act shall not be applied in cases where a return of fees pursuant to the provisions of Article 54-2, paragraph (2), (4) or (6), (8) or (10) of the former Utility Model Act has not been requested within the period prescribed in paragraph (3), (7), (9) or (11) of the said Article prior to the enforcement of this Act.

(Transitional measures relating to penal provisions)

Article 8 With regard to application of penal provisions to acts conducted prior to the enforcement of this Act, the provisions then in force shall remain applicable.

(Delegation to Cabinet Order)

Article 9 In addition to what is prescribed in Articles 2 through the preceding Article and Article 19 of these Supplementary Provisions, necessary transitional measures relating to the enforcement of this Act shall be specified by a Cabinet Order.

(Review)

Article 10 The Government shall, when five years have passed from the enforcement of this Act and it finds the necessity by taking into account the status of enforcement of the Patent Attorney Act revised by the provisions of Article 6 (hereinafter referred to as the "New Patent Attorney Act" in this Article), review the provisions of the New Patent Attorney Act and take necessary measures based on the results thereof.

### **Supplementary Provisions [Act No. 69 of June 13, 2014 Extract] [Extract]**

(Effective date)

Article 1 This Act shall come into effect as from the date of the enforcement of the Administrative Appeal Act (Act No. 68 of 2014).

**Supplementary Provisions [Act No. 55 of July 10, 2015 Extract] [Extract]**

(Effective date)

Article 1 This Act shall come into effect as from the date specified by a Cabinet Order within a period not exceeding one year from the date of the promulgation.

(Delegation to Cabinet Order)

Article 5 In addition to what is prescribed in the preceding 3 articles and Article 9 of these Supplementary Provisions, necessary transitional measures relating to the enforcement of this Act shall be specified by a Cabinet Order.

Appended table (relating to Article 54)

	Person responsible for payment	Amount of Money
1	Person filing application for utility model registration	14,000 yen per case
2	Person responsible for procedures pursuant to provisions of Article 48-5, paragraph (1)	14,000 yen per case
3	Person offering pursuant to provisions of Article 48-16, paragraph (1)	14,000 yen per case
4	Person requesting extension of period pursuant to provisions of Article 5, paragraph (3) of the Patent Act applied mutatis mutandis in Article 2-5, paragraph (1)	4,200 yen per case
5	Person requesting Utility Model Technical Opinion	42,000 yen per case, plus 1,300 yen per claim
6	Person correcting description, scope of claims for a utility model registration, or drawings	1,400 yen per case
7	Person requesting judgment pursuant to provisions of Article 71, paragraph (1) of the Patent Act applied mutatis mutandis in Article 26	40,000 yen per case
8	Person requesting ruling	55,000 yen per case
9	Person requesting rescission of ruling	27,500 yen per case
10	Person requesting trial or retrial	49,500 yen per case, plus 5,500 yen per claim
11	Person applying for intervention in trial or retrial.	55,000 yen per case