

Key Changes in Japanese IP law, Act and Practice - Design & Trademark

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Digitalization of procedures related to international design applications (Hague-route applications) and international trademark applications (Madrid-route applications)

(i) Decisions for registration are delivered electronically for international design applications (effective from October 1, 2022) and international trademark applications (effective from April 1, 2023)

Previously, the JPO delivered to overseas applicants of international design applications and international trademark applications certified copies of decisions for registration for such applications via international mail. The JPO also electronically delivered to these applicants statements of grant of protection concerning these applications through WIPO (World Intellectual Property Organization). The JPO granted rights to these applicants after these certified copies were delivered.

However, the COVID-19 pandemic disrupted international mail services and delayed the delivery of certified copies of decisions for registration. These delays resulted in the failure to grant rights to some overseas applicants, putting them at a disadvantage.

To address this issue, the Design Act and the Trademark Act were amended to allow the delivery of certified copies of decisions for registration to be included in the WIPO-route electronic delivery.

(ii) The two-stage fee payment system for international trademark applications is abolished (effective from April 1, 2023)

Most contracting parties of the Madrid Protocol require applicants to pay international trademark application fees at the time they file an application for international registration (international application). Meanwhile, Japan has implemented a two-payment system requiring the first part of the individual fee to be paid when the international application is filed and the second part of the fee to be paid as a grant fee. Because not all applicants were aware of this system, many Japanese designations of international applications have lapsed on account of failure to pay the grant fee.

As a remedy, Japan decided to abolish the two-payment system and only require a lump-sum payment at the filing stage.

(iii) A new submission option for Certificates of Exception to Lack of Novelty in international design applications becomes available (effective from October 1, 2021)

An application for international registration under the Hague Agreement (international application) must be submitted to the *WIPO*.

If the designs claimed in the international application have already been publicly disclosed and thus have lost their novelty, the applicant in principle may request a grace period (exception to lack of novelty) for that design. To benefit from the grace period, the applicant must submit a “Certificate of Exception to Lack of Novelty,” which must be submitted to the *JPO* within a specific period after a certain time has passed since the filing of the international application.

Before the revision, some Japanese designations could not benefit from the grace period because of the applicant’s failure to submit the certificate. In many cases, such failure occurred because the international application and the certificate each had to be submitted to a different office and at a different time. In addition, the disruption of international mail services due to the COVID-19 pandemic made the timely delivery of the certificate difficult in some cases.

To resolve this issue, the Design Act was revised to allow applicants to submit both the international application and the certificate to the *WIPO*.