

Intellectual Property Rights in Japan: Overview

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PATENTS

Requirements to Obtain a Patent

1. Provide a brief definition of a patent, the key legal requirements to obtain it and the law that applies.

The Patent Act (Act No. 121 of 1959) covers exclusive rights to inventions based on technical ideas using natural laws.

The legal requirements to obtain patent rights are:

- Novelty.
- Inventive step.
- Susceptibility to industrial application.
- Non-existence of a claim under a prior application.

The categories that are excluded from patent protection are:

- Ideas that do not use the laws of nature.
- Laws of nature themselves.
- Techniques.
- Unfinished inventions.
- Medical operation processes and methods for the treatment or diagnosis of human beings.
- Matters liable to adversely affect public order, morality, or public health.

Registering a Patent

2. Which authority registers patents? Briefly outline the key stages and timing in obtaining a patent.

Patent Registration Authority

The Japan Patent Office (JPO) registers patents. The website of the JPO provides guidance on the procedure for filing patent applications, www.jpo.go.jp/e/system/patent/shutugan/index.html in English.

Process and Timing

The process and timing for obtaining a patent are described on the JPO's www.jpo.go.jp/e/system/patent/gaiyo/patent.html website.

Details on application fees and other charges are available at www.jpo.go.jp/e/system/process/tesuryo/hyou.html.

Any person can anonymously provide information to the JPO to oppose an application. The grounds for providing information include:

- Lack of novelty or inventive step.

- Interference with another patent application that has an earlier priority date.
- Violation of claim clarity, enablement, or written description requirements.
- Violation of conditions for an amendment during prosecution.

Patent Search and Information Facilities

3. What official facilities are available to conduct searches and obtain information on patents?

The JPO maintains a free, searchable online database of patents, utility models, designs, and trade marks (www.j-platpat.inpit.go.jp).

The JPO also maintains information on new applications for each type of patents, utility models, designs, and trade marks on its online database. However, there may be a time lag in the JPO's online database being updated.

It is highly advisable to consult an attorney (*bengoshi*) specialising in IP law or a patent agent/attorney (*benrishi*). *Benrishi* is a profession specifically licensed to practice IP law, which is a different qualification to that of *bengoshi*.

Enforceable Patent Protection Term

4. When does patent protection start and how long does it last?

A patent is effective on registration and lasts 20 years from the patent application filing date.

In the fields of pharmaceuticals and agrochemicals, the patent term can be extended by up to five years.

In addition, regardless of whether the patent is in the fields of pharmaceuticals and agrochemicals, the patent term can be extended for up to the period that it was unreasonably delayed by a JPO examination if either:

- The patent is registered on or after five years from the date the patent application was submitted.
- Three years have elapsed from the date on which the request for examination of an application was filed.

Maintaining Patents

5. What steps must a patent owner take to maintain the registration and legally protectable status of its patents?

A patent is effective on registration and lasts 20 years from the application filing date.

An applicant must pay annuities for the first three years in a lump sum within 30 days of receiving notice of the grant of a patent. Fees for the fourth annuity onwards must be paid annually by the end of the preceding year (or as a lump sum).

For details on registration/maintenance, see www.jpo.go.jp/e/system/patent/gaiyo/registration_patent.html. For related fees, see www.jpo.go.jp/e/system/process/tesuryo/hyou.html.

If fees are not paid on time, late payment is allowed within six months after expiration of the time limit, subject to payment of a surcharge.

If a patented invention is not sufficiently and continuously used in Japan for three years or more, a person intending to use the patented invention can request that the patent owner or exclusive licensee (*senyo-jisshi-ken-sha*) hold a meeting to discuss the grant of a non-exclusive licence. If no agreement is reached or no meeting can be arranged, the person can request that the Commissioner of the JPO grant a non-exclusive licence (except for patents filed in the preceding four years).

Patent Infringement

6. What rights does a patent give to its owner? On what grounds can a patent infringement action be brought? What are the main defences to a patent infringement action?

Rights Granted by a Patent

The patentee of a patented invention has the exclusive right to work that invention commercially.

"Working" an invention means the following acts:

- For a product patent (including a computer program): the production, use, assignment, lease, export, import, or the offer for assignment or lease, of the product.
- For a process patent: the use of the process.
- For a process patent for manufacturing a product: the use, assignment, lease, export, import, or offer for assignment or lease, of the product manufactured by the process, in addition to the use of the process.

Grounds for Patent Infringement

The grounds include:

- **Direct infringement.** This includes producing, using, or assigning patented products or using patented methods.
- **Indirect infringement.** This includes producing or assigning products exclusively used for patented products or patented methods for commercial purposes.

Defences to a Patent Infringement Action

Defences include:

- Use for experimental or research purposes.
- Patent invalidity.
- Prior user's right.
- No infringement.
- Patent exhaustion. Depending on the specific circumstances, domestic exhaustion (that is, exhaustion by an authorised sale within Japan) and international exhaustion (that is, exhaustion by an authorised sale outside Japan) is admitted.

7. Which courts have jurisdiction over patent infringement actions? Is there a fast-track and/or a small-claims procedure?

The courts dealing with patent infringement are:

- The Tokyo and Osaka District Courts at first instance.
- The Intellectual Property High Court on appeal.
- The Supreme Court in the last instance.

There is no fast-track or small-claims procedure for patent infringement actions.

8. What are the remedies in patent infringement actions?

Remedies include:

- Injunctions (including both preliminary and permanent measures necessary to suspend and prevent infringement).
- Compensation for damage.
- Measures to restore credibility.

Monitoring Patent Infringement

9. What steps can a party take to monitor whether another party is infringing its patents?

For patents, utility model rights, trade marks, and design rights, it is highly recommended to conduct a search for prior patents, utility model rights, trade marks, and design rights before conducting business. Any person can search for prior rights using the JPO's free online database (www.j-platpat.inpit.go.jp).

Under the Patent Act, any party can file with the JPO an opposition to a granted patent within six months of publication of the patent in the *Official Gazette*. An invalidation action can also be commenced, but only by interested parties. For example, if a person or company is aware of a prior art similar to a newly granted patent of a competitor, it can either:

- File an opposition.
- File an invalidation action as an interested party.

There is no official JPO system to monitor infringements of patents, utility model rights, trade marks, and design rights by competitors.

Patent Revocation

10. On what grounds can third parties challenge a patent through invalidation, cancellation, or revocation proceedings?

Under the Patent Act, any party can file with the JPO an opposition to a granted patent within six months after publication of the patent in the *Official Gazette*.

A party can also file for an invalidation trial at any time. However, only interested parties have standing under the Patent Act.

The grounds for opposition and invalidation are listed in the Patent and include lack of novelty or inventive step.

UTILITY MODELS

11. Is utility model protection available in your jurisdiction?

Legal Conditions for Utility Model Protection

The Utility Model Act (Act No. 123 of 13 April 1959) confers exclusive rights over devices based on technical ideas using natural laws in connection with a device's shape or structure, as well as combinations of devices.

The key legal requirements to obtain utility model protection are the same as for patents (see *Question 1*). However, the level of technical complexity required for utility models is lower than that required for patents.

Registration Authority

The JPO registers utility models. The JPO's website provides guidance on the application requirements and procedure (www.jpo.go.jp/e/system/utility/gayo-utility.html).

Process and Timing

Information is available on the JPO's website (www.jpo.go.jp/e/system/utility/index.html).

Utility Model Search and Information Facilities

See *Question 3*.

Enforceable Utility Model Protection Term

A utility model is effective on registration and lasts ten years from the utility model application filing date.

Maintaining Utility Models

An applicant must pay the annuities for the first three years in a lump sum at the time of the application. Fees for the fourth annuity onwards must be paid annually by the end of the preceding year (or as a lump sum).

Details of maintenance and other fees are available on the JPO's website (www.jpo.go.jp/e/system/process/tesuryo/hyou.html).

Utility Model Infringement

The Utility Model Act confers exclusive rights over devices based on technical ideas using natural laws in connection with a device's shape or structure, as well as combinations of devices.

A utility model infringement action can be brought on the following grounds:

- **Direct infringement.** Producing, using, or assigning products protected by a utility model.
- **Indirect infringement.** Producing or assigning products exclusively used for products protected by a utility model for commercial purposes.

Defences to utility model infringement actions include:

- Use for experimental or research purposes.
- Invalidity.
- Prior user's right.
- No infringement.
- Utility model exhaustion.

See *Question 7* for the courts dealing with utility model infringement. There is no fast-track or small-claims procedure for utility model infringement actions.

See *Question 8* for the remedies available in utility model infringement actions.

Monitoring Utility Model Infringement

See *Question 9*.

TRADE MARKS

Legal Requirements to Obtain a Trade Mark

12. Provide a brief definition of a trade mark, the key legal requirements to obtain it and the law that applies.

Under the Trade Mark Act (Act No. 127 of 13 April 1959), any mark that consists of a character, figure, sign, three-dimensional shape, or colour, or any combination of them, or a sound, that is used in connection with goods or services for commercial purposes, can be registered and protected.

Unregistered Trade Marks

13. Is there protection for unregistered trade marks?

Unregistered marks that are widely recognised or well known can be protected under either or both the Unfair Competition Prevention Act (Act No. 47 of 19 May 1993) and the Civil Code. To obtain protection, the claimant must show that its mark is widely recognised or well known.

Registration with the JPO is necessary for protection under the Trade Mark Act and is highly recommended for the protection of trade marks.

Registering a Trade Mark

14. Which authority registers trade marks? Briefly outline the key stages and timing to obtain a registered trade mark.

Trade Mark Registration Authority

The JPO registers trade marks. The JPO's website provides guidance on the procedure for filing trade mark applications, in English (www.jpo.go.jp/e/system/trademark/index.html).

Process and Timing

The process and timing for obtaining a trade mark are described on the JPO's website (www.jpo.go.jp/e/system/trademark/gaiyo/trademark.html).

For application fees and other charges, see www.jpo.go.jp/e/system/process/tesuryo/hyou.html.

Trade Mark Search and Information Facilities

15. What official facilities are available to conduct searches and obtain information on trade marks?

See *Question 3*.

16. On what grounds can the authority refuse to register a trade mark? On what grounds can third parties challenge a trade mark application?

Grounds for an Authority Refusing to Register a Trade Mark

The JPO can refuse to register a trade mark on the grounds that it:

- Has no distinctive character.
- Is identical or similar to the mark of a national or international organisation.

- Is identical or similar to a registered or well-known mark.
- Is likely to cause confusion in connection with the goods or services pertaining to the business of another person.

Third Party Grounds for Challenging a Trade Mark Application before Registration

Any person can anonymously provide information to oppose an application with the JPO. The grounds for providing information include all the grounds for refusal of registration stated above.

Enforceable Trade Mark Protection Term

17. When does trade mark protection start and how long does it last?

Protection under the Trade Mark Act arises on registration and lasts for ten years. Registration can be renewed indefinitely every ten years, by filing a renewal application and paying a fee.

Maintaining Trade Marks

18. What steps must a trade mark registrant take to maintain the registration and legally protectable status of its trade marks?

An applicant must pay the registration fee within 30 days after receiving notice of the grant of a trade mark.

A registered trade mark expires on the ten-year anniversary of its registration and can be renewed by the holder of the trade mark filing a renewal application.

Details of maintenance and other fees are available on the JPO's website (www.jpo.go.jp/e/system/process/tesuryo/hyou.html).

If a registered trade mark has not been used in Japan for three consecutive years or more by the holder or a licensee without reasonable cause, any person can file an application to cancel the trade mark registration. See *Question 19* for the meaning of "use" in this context.

Trade Mark Violations

19. What rights does a trade mark give to its owner? Identify and describe the available claims for trade mark violations? What are the main defences to trade mark actions?

Rights Granted by a Trade Mark

The owner of a registered trade mark has the exclusive right to use that trade mark in connection with the designated goods or services.

"Use" with respect to a mark means any of the following acts:

- Affixing the mark to goods or packages of goods.
- Assigning, delivering, displaying for the purpose of assignment or delivery, exporting, importing, or providing through means of electric telecommunications goods or packages of goods to which the mark is affixed.
- In the course of the provision of services, affixing the mark to articles to be used by a person who receives the services (including articles to be assigned or leased).
- Providing services by using articles to which the mark is affixed and which are to be used by a person who receives the services.

- Displaying articles to which the mark is affixed to be used for the provision of the services (including articles to be used by a person who receives the services).
- Affixing the mark to articles belonging to a person who receives services.
- Using an electromagnetic device (meaning any electronic, magnetic, or other method that is not recognisable by human perception) to provide services by displaying the mark on an image viewer.
- Displaying or distributing advertising materials, price lists, or transaction documents relating to goods or services to which the mark is affixed, or providing information on such content to which the mark is affixed by an electromagnetic device.

Grounds for and Elements of Trade Mark Infringement Claims

Infringement claims can be brought on the following grounds:

- Using a mark that is identical or similar to a registered trade mark, for goods or services that are identical or similar to the designated goods or services.
- Possessing goods with a mark on the goods or packaging that is identical or similar to a registered trade mark, for the purpose of assignment.

Other Trade Mark Causes of Action

A person whose business interests were infringed by conduct prohibited by the Unfair Competition Prevention Act can seek compensation for damages.

A person whose business interests were infringed by a tort can also seek compensation for damages from the tortfeasor based on the Civil Code (tort law).

In addition, if an unregistered trade mark is protected by the Unfair Competition Prevention Act (see *Question 13*), a person whose business interests have been infringed or are likely to be infringed can seek an injunction against the (potential) infringer.

Defences to Trade Mark Claims

Defences include:

- Using a person's own name or famous abbreviations.
- Not using the mark as a trade mark.
- Invalid right.
- Prior user's right.
- No infringement.

20. Which courts have jurisdiction over trade mark infringement actions? Is there a fast-track and/or a small-claims procedure?

The courts dealing with trade mark infringement actions are:

- The district courts, with the Tokyo and Osaka District Courts having concurrent jurisdiction, at first instance.
- The high courts or the Intellectual Property High Court on appeal.
- The Supreme Court in the last instance.

There is no fast-track or small-claims procedure for trade mark infringement actions.

21. What are the remedies in trade mark infringement actions?

See *Question 8*.

Challenging a Trade Mark After Registration

22. On what grounds can third parties challenge a registered trade mark through invalidation, cancellation or revocation proceedings (after registration)?

Any party can file an opposition to a trade mark registration with the JPO within two months after publication of the trade mark in the *Official Gazette*.

Any interested party can also file invalidation proceedings with the courts.

The grounds to challenge a registered trade mark include those listed in *Question 16, Grounds for an Authority Refusing to Register a Trade Mark*.

Monitoring Trade Mark Infringement

23. What steps can a trade mark owner take to monitor whether another party is infringing its trade mark rights?

See *Question 9*.

A licence agreement may require a trade mark owner to monitor possible infringements. However, trade mark owners are not legally required to do so. Failure to monitor or to take action against potential/actual infringement will not directly affect the validity of a trade mark as long as the trade mark owner continues to use the trade mark.

COPYRIGHT

Categories of Subject Matter Eligible for Copyright Protection

24. What categories of subject matter are eligible for copyright protection?

The categories of subject matter eligible for protection include:

- Literary works.
- Musical works.
- Choreographic works.
- Artistic works.
- Architectural works.
- Diagrammatical works.
- Cinematographic works.
- Photographic works.
- Computer programs.

Legal Requirements to Obtain Copyright Protection

25. What are the legal requirements for a work to be protected by copyright?

Copyright arises automatically on creation of a work in which thoughts are expressed in a creative way and which is in the literary, academic, artistic, or musical domain (Article 2, paragraph 1, item 1, Copyright Act (Act No. 48 of 6 May 1970)).

Copyright Registration

26. Can copyright be registered?

The author's name and first publication date of a copyrighted work, as well as assignment of the copyright, can be registered with the *Agency for Cultural Affairs* (or the *Software Information Center (SOFTIC)* for computer programs). An assignment of copyright cannot be enforced against third parties unless it has been registered.

Registration must be made by submitting an application with supporting information. There is no online guidance on the application procedures available in English.

Copyright registration is optional, and there are no registration fees.

Fees are payable for registration of assignment agreements (see www.bunka.go.jp/seisaku/chosakuken/seidokaisetsu/toroku_seid_o/faq.html#faq03 (in Japanese)).

Enforceable Copyright Protection Term

27. When does copyright protection start and how long does it last?

Copyright protection starts from the creation of a work and lasts 70 years after the death of the author (for a cinematographic work, 70 years from publication).

Copyright protection cannot be renewed.

Maintaining Copyright

28. What steps must a copyright owner take to maintain the registration, if applicable, and legally protectable status of its copyright?

Registration is not necessary to obtain copyright protection, and no fee is required (see *Question 26*).

For certainty, the following can be registered with the *Agency for Cultural Affairs* (or *SOFTIC* for computer programs):

- Assignment of a copyright.
- Establishment of publication rights.
- Authors' names and dates of publication for anonymous works.
- Date of creation of a copyrighted program.

An assignment of copyright cannot be enforced against third parties unless it has been registered, but is effective between the assignor and assignee.

Copyright Search and Information Facilities

29. What official facilities are available to conduct searches and obtain information on copyright?

The Agency for Cultural Affairs and SOFTIC maintain information on registered copyrights. They have a free online database searchable by name and registration number. This database is only available in Japanese and detailed information on copyright registrations is only available on request for a handling fee.

Monitoring Copyright Infringement

30. What steps can a copyright owner take to monitor whether another party is infringing its copyright?

There is no specific step a copyright owner can take to monitor infringement.

Copyright Infringement

31. What rights does copyright grant? On what grounds can a copyright infringement action be brought? What are the defences to copyright infringement actions?

Rights Granted by Copyright

A copyright owner has the exclusive rights to:

- Reproduce, publicly perform, broadcast, publicly transmit, make available, translate, arrange, and adapt a copyrighted work.
- Publicly recite a literary work.
- Publicly exhibit the original of an artistic work or an unpublished photographic work.
- Distribute a cinematographic work.
- Transfer the original or a reproduction of a copyrighted work other than a cinematographic work.
- Rent a reproduction of a copyrighted work other than a cinematographic work.

Copyright also grants moral rights that are exclusive to the author (see *Question 34*).

Grounds for and Elements of Copyright Infringement Claims

A copyright infringement claim can be brought on the following grounds:

- Infringement of the exclusive rights of reproduction, recitation, and exhibition.
- Infringement of the author's moral rights.
- Deemed infringement, such as importing goods produced by infringing means for commercial purposes.

Defences to a Copyright Infringement Action

Defences include:

- Reproduction for private or citation use, non-commercial purposes, reporting a current event, or judicial proceedings.
- Non-infringement.
- Exhaustion of right.

32. Which courts have jurisdiction over copyright infringement actions? Is there a fast-track or a small-claims procedure?

See *Question 7*. For computer programs, see *Question 20*.

There is no fast-track or small-claims procedure for copyright infringement actions.

33. What are the remedies in copyright infringement actions?

See *Question 8*.

Moral Rights

34. Are moral rights protected?

Moral rights protected under the Copyright Act include the:

- Right to make the work public.
- Right to determine the indication of the author's name.
- Right to maintain the integrity of the work.

Moral rights arise automatically on creation of a copyright work and can be asserted against third parties without copyright registration.

Moral rights are exclusive to the author and cannot be assigned or licensed. While there is a debate over the validity of waivers of moral rights, covenants not to exercise moral rights are common in practice and are generally considered valid.

REGISTERED DESIGN RIGHTS Basis of Registered Design Protection

35. Is design right protection available through registration? What are the legal conditions to obtain a registered design?

Registration of designs with the JPO is necessary for protection under the Design Act (Act No. 125 of 13 April 1959).

The legal conditions to obtain a registered design are:

- Industrial applicability.
- Novelty.
- Creativity.
- Distinctiveness and dissimilarity with any design previously filed.

Registering a Design

36. Which authority registers designs? Briefly outline the key stages and timing in obtaining a registered design.

Design Registration Authority

The JPO registers designs. The JPO's website provides guidance on the procedure for filing registration applications (www.jpo.go.jp/e/system/design/index.html).

Process and Timing

For information on the key stages and timing for registering a design, see www.jpo.go.jp/e/system/design/gaiyo/design.html.

Any person can request an appeal examination for invalidation to challenge the validity of a registered design right. For more information, see: www.jpo.go.jp/e/system/design/index.html.

Design Search and Information Facilities

37. What official facilities are available to conduct searches and obtain information on design rights?

See *Question 3*.

Enforceable Registered Design Right Protection Term

38. When does registered design protection start and how long does it last?

Design protection arises on registration and lasts for 25 years from the application date. Design protection cannot be renewed.

Maintaining Design Rights

39. What steps must a registered design right owner take to maintain the registration and legally protectable status of its design rights?

Design rights are registered on payment of the registration fee for the first year. The registration fee must be paid within 30 days after receiving notice of the grant of the rights. The registration fees for the second year onwards must be paid annually by the end of the preceding year.

The protection of design rights expires after 25 years from the application date and cannot be renewed. The duration of design rights was extended from 20 years from the registration date to 25 years from the application filing date by amendments to the Design Act that came into force on 1 April 2020.

For details on registration/maintenance, see www.jpo.go.jp/e/system/design/gaiyo/registration_design.html. For details of fees, see www.jpo.go.jp/e/system/process/tesuryo/hyou.html.

If fees are not paid on time, late payment is allowed within six months after expiration of the time limit, subject to payment of a surcharge.

A registered design right cannot be cancelled for non-use.

Registered Design Right Infringement

40. What rights does a registered design give to its owner? On what grounds can a registered design infringement action be brought? What are the defences to design infringement actions?

Rights Granted by Registered Design Rights

The owner of a registered design has the exclusive right to use that design and designs similar thereto as a business.

"Use" of a design means manufacturing, using, assigning, leasing, exporting or importing, or offering for assignment or lease (including displaying for the purpose of assignment or lease) an article made to the design.

Grounds for Registered Design Right Infringement

A registered design right infringement action can be brought on the following grounds:

- **Direct infringement.** Manufacturing or selling a registered design or any similar design for commercial purposes.
- **Indirect infringement.** Producing or assigning any product to be used exclusively for the production of a product using a registered or similar design for commercial purposes. Manufacturing or importing a component may also be deemed indirect infringement in certain circumstances.

Defences to a Registered Design Right Infringement Action

Defences include:

- Use for experimental or research purposes.
- Invalidity.
- Prior user's right.
- Non-infringement.
- Exhaustion of rights.

41. Which courts have jurisdiction over registered design infringement actions? Is there a fast-track and/or a small-claims procedure?

See *Question 20*.

There is no fast-track or small-claims procedure for registered design infringement actions.

42. What are the remedies in registered design infringement actions?

See *Question 8*.

Monitoring Design Infringement

43. What steps can a party take to monitor whether another party is infringing its design rights?

See *Question 9*.

UNREGISTERED DESIGNS

44. Is there protection for unregistered designs in your jurisdiction?

Basis for Protection/Legal Conditions for Unregistered Design Rights

Under the Unfair Competition Prevention Act, designs can be protected as a configuration of goods, which means the external and internal shape of goods and the pattern, colour, gloss, and texture combined with this shape, that can be perceived by consumers in normal use.

Designs may also be protected under the Copyright Act if the applicable requirements are met (see *Question 25*). It is under discussion whether applied arts need to be more original than fine arts to be protected by the Copyright Act.

Duration of Unregistered Design Protection

Protection under the Unfair Competition Prevention Act arises on creation and lasts for three years from the date the relevant article is first sold in Japan.

Unregistered Design Infringement

An unregistered design can be protected under the Unfair Competition Prevention Act and/or the Copyright Act if the applicable requirements are met.

An infringement action can be brought against any person acquiring, leasing, or displaying for the purpose of assigning or leasing, or exporting/importing goods that imitate the configuration of another person's goods.

Defences to unregistered design infringement actions include:

- No imitation.
- The configuration is indispensable for ensuring the function of the goods.
- Three years have passed since the goods were sold in Japan.
- Not knowing, and not being grossly negligent of, the fact that the goods imitate another person's design at the time the goods are acquired.

For information on the courts with jurisdiction over unregistered design right infringement actions, see *Question 20* (claims under the Unfair Competition Prevention Act) and *Question 32* (claims based on copyright infringement).

There is no fast-track or small-claims procedure for violation of the Unfair Competition Prevention Act or copyright infringement actions.

For remedies in unregistered design right infringement actions, see *Question 8*.

TRADE SECRETS AND CONFIDENTIAL INFORMATION

45. Is there specific protection for trade secrets and confidential information in your jurisdiction?

Confidential information can be protected as trade secrets under the Unfair Competition Prevention Act. A trade secret is defined as technical or business information useful for commercial activities (such as manufacturing or marketing methods) that is kept secret and is not publicly known.

There is no registration system or form of protection for confidential information.

Maintaining Trade Secrets and Confidential Information

46. What steps must an owner of trade secrets and confidential information take to maintain the legally protectable status of their trade secrets and confidential information?

There is no registration system for trade secrets or confidential information. To be protectable, confidential information must be kept secret (see *Question 45*).

Monitoring Infringement of Trade Secrets and Confidential Information

47. What steps can a party with rights protecting confidential information and trade secrets take to monitor whether another party is disclosing or using its trade secrets and confidential information?

There are no special steps a party can take to monitor infringement of trade secrets or confidential information.

48. What rights do trade secrets and confidential information provide? On what grounds can an action for unauthorised disclosure or use of confidential information or trade secrets be brought? What are the defences to such actions?

Rights Granted

A person whose business interests have been infringed or are likely to be infringed due to unauthorised use or disclosure of a trade secret can seek an injunction against the person who has infringed or is likely to infringe those business interests.

In addition, a person whose business interests were infringed due to unauthorised use or disclosure of a trade secret can seek compensation for damages from the person who infringed those business interests.

Grounds for Unauthorised Use

An action for unauthorised disclosure or use can be brought on the following grounds:

- Acquiring, using, or disclosing through wrongful acquisition.
- Acquiring, using, or disclosing and knowing or being grossly negligent of the fact that the secret was acquired through improper means.
- Using or disclosing and knowing after acquisition or being grossly negligent of the fact that the secret was acquired through improper means.
- Using or disclosing a trade secret, disclosed by the business operator holding the trade secret, for the purpose of acquiring illicit gains or causing injury to the holder.
- Assigning, delivering, displaying for the purpose of assignment or delivery, exporting, importing, or providing through a telecommunications line articles manufactured by using a technical secret that was acquired wrongfully, except when these actions are carried out by a person that did not know that the articles originated from wrongful acquisition, and was not grossly negligent in not knowing so at the time of receiving them.

Defences

Defences include:

- The alleged secret does not fall within the definition of trade secret under the Unfair Competition Prevention Act (see *Question 45*).
- No unauthorised use.
- The trade secret was used or disclosed under a right acquired by the defendant.

49. Which courts have jurisdiction over actions for unauthorised disclosure or use of confidential information or trade secrets? Is there a fast-track and/or a small-claims procedure? What are the remedies in such actions?

Courts

See *Question 20*.

There is no fast-track or small-claims procedure for actions for unauthorised use of confidential information.

Remedies

See *Question 8*.

DOMAIN NAMES

50. Can an action be brought to protect a domain name?

There is no domain name registration regime. If a third party's action qualifies as unfair competition, violation of a trade mark right, and/or tort, an action can be brought based on the Unfair Competition Prevention Act, the Trade Mark Act, and/or the Civil Code.

DATABASE RIGHTS

51. Is there protection for database rights?

There is no database rights registration regime. A database that, by reason of the selection or systematic construction of information contained in the database, constitutes a creation is protected as a work under the Copyright Act (see *Question 24 to 34*).

INTERNATIONAL IP TREATIES

52. Is your jurisdiction party to international treaties that facilitate the recognition of foreign IPRs in your jurisdiction?

Patents

Japan is party to the Paris Convention for the Protection of Industrial Property 1883 (Paris Convention). Under the Paris Convention, an international application can be entitled to a priority right, based on the filing of a patent application for the same invention in a Paris Convention country in the preceding 12 months.

The JPO also accepts requests for the restoration of priority rights.

In addition, Japan is party to the *Patent Cooperation Treaty 1970 (PCT)*, under which the filing date of an international application is considered to be the actual filing date in each designated state and has the effect of a national application.

Utility Models

Under the Paris Convention, an international application for a utility model is entitled to a priority right, based on the filing of an application for the utility model in a Paris Convention country in the preceding 12 months.

Under the PCT, the filing date of an international application is considered to be the actual filing date in each designated state and has the effect of a normal national application.

Trade Marks

Under the Paris Convention, an international application for a trade mark can be entitled to a priority right, based on the filing of an application for the same trade mark in a Paris Convention country in the preceding six months.

In addition, Japan is party to the Protocol Relating to the *Madrid Agreement Concerning the International Registration of Marks 1891* (Madrid Protocol). Under the Madrid Protocol, when an international registration application has been filed, the person whose name that application has been made in can obtain protection for their mark in the territory of the Madrid Protocol countries.

Copyright

Japan is party to the *Berne Convention for the Protection of Literary and Artistic Works 1971* (Berne Convention). Foreign copyright holders whose states are party to the Berne Convention enjoy the same rights as Japanese nationals.

Design Rights

Under the Paris Convention, an international application for a design right can be entitled to a priority right, based on the filing of an application for the same design right in a Paris Convention country in the preceding six months.

In addition, Japan is party to the Geneva Act of the *Hague Agreement Concerning the International Registration of Industrial Designs 1925*. Under the Geneva Act, an international registration will, from the date of the international registration, have at least the same effect in each designated contracting party as a regularly-filed application for industrial design protection.

REFORM

53. Summarise any proposals for reform to the main IPR laws and any recently enacted major reforms.

Amendments to the Patent Act, Utility Model Act, Design Act, and Trade Mark Act were passed by the Diet on 14 May 2021 and promulgated on 21 May 2021. An amendment to the Copyright Act was also passed by the Diet on 26 May 2021 and promulgated on 2 June 2021. The key changes are summarised below.

Patent Act, Utility Model Act, Design Act. and Trade Mark Act

Enhancement of intellectual property protection. Under the pre-amended acts, for patents, utility models, and designs, a patentee (licensor) was not able to amend a patent without obtaining consent from all its licensees. This was overly burdensome for patentees, especially in the case of complex licensing arrangements. To address this issue, the amended acts abolished the requirement to obtain consent from non-exclusive licensees. This amendment came into force on 1 April 2022.

To address the increase in counterfeit products being imported by individuals who claim that the items are for private use, the amended acts provide that the sending of counterfeit products to Japan via postal mail by overseas businesses to individual importers constitute design or trade mark right infringement. This amendment will come into force within 18 months after 21 May 2021 (that is, the date of promulgation).

For patents, utility models, designs, and trade marks, the amended acts relax the requirements that rights holders must meet to restore their rights if these have lapsed due to expiration of the due dates for renewal. This amendment will come into force within 24 months after 21 May 2021 (that is, the date of promulgation).

Introduction of amicus brief-like system. For patents and utility models, a new system allows the courts to broadly call for opinions from third parties on request by a party in infringement litigation at first instance (Tokyo District Court and the Osaka District Court) and before the Intellectual Property High Court. To call for third party opinions, the court must hear the other party's opinion but does not need to obtain their consent. This amendment came into force on 1 April 2022.

Copyright Act

Under the amended Copyright Act, when a copyright holder has entered into a licensing agreement granting the right to broadcast particular works on television, the copyright holder is presumed to have also granted permission to use those works in simultaneous distribution, unless the copyright holder expressly provides otherwise.

In addition, the scope of the provisions of the Copyright Act that provide exceptional treatment for the use of copyrighted works in broadcast programmes has been extended to programmes aired simultaneously on the Internet. Accordingly:

- Use of some copyrighted works in certain programmes (for example, educational programmes, public announcements, and so on) is permitted without obtaining permission under certain conditions.
- Use of phonograms and phonographic performances in simultaneous distribution is permitted without obtaining prior permission, subject to payment of additional royalties.
- For visual performances, where permission has been obtained for initial distribution, unless otherwise agreed, no permission is

required for rebroadcasting subject to payment of a fee equivalent to that paid the first time.

It is possible to request a ruling from the Agency for Cultural Affairs where a distributor cannot reach an agreement with the rights holder.

These amendments came into force on 1 April 2022.

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