

### Exceptions and limitations to patent rights

The JPO would like to update its reply to the question 39 of the questionnaire on exceptions and limitations to patent rights as follows.

(The updated reply to the question 39)

Article 79bis (1) of the Japanese Patent Act stipulates that where a person who has had the patent right, the exclusive license on the patent right, or the non-exclusive license on the patent right or the exclusive license existing at the time of the registration of assignment of the patent right based on the request under Article 74 (1) and has been working the invention in Japan in the course of one's business, or has been making preparations for one's business, prior to such registration of assignment of the patent right without knowing that the patent falls under the requirements of Article 123 (1) (ii) (limited to cases in which the patent has been granted in violation of Article 38) or the requirements of Article 123 (1) (vi), such person shall have a non-exclusive license on the patent right limited to the extent of the patent which is being worked or for which preparations for working are made and to the purpose of such working or preparations.

Article 80(1) of the Japanese Patent Act stipulates that a person falling under any of the following items, who is doing a business working an invention in Japan or preparing such business, before the registration of a request for a trial for patent invalidation, without knowledge that the patent falls under any of the paragraphs of Article 123(1), shall have a non-exclusive license regarding the invalidated patent right or the exclusive license existing at the time of the invalidation, only to the extent of the invention and the purpose of such business worked or prepared:

- (i) the original patentee in the case where one of two or more patents granted for the same invention has been invalidated;
- (ii) the original patentee in the case where, after a patent has been invalidated, a patent is granted to the person who is entitled to obtain a patent for the same invention; and
- (iii) in the case referred to in items (i) and (ii), a person that, at the time of the registration of the request for a trial for patent invalidation, has an exclusive license regarding the patent right to be invalidated, or a non-exclusive license effective under Article 99(1) regarding the patent right or an exclusive license on the patent right.

Article 81 of the Japanese Patent Act stipulates that where a design right with regard to an application for a design registration filed on or before the date of filing of a patent application is in conflict with the patent right with regard to the patent application, the

original holder of design right shall, upon expiration of the duration of the design right, have a non-exclusive license on the said patent right or on the exclusive license actually existing at the time of expiration of the duration of the design right, limited to the extent of the original design right.

Article 82(1) of the Japanese Patent Act stipulates that where a design right with regard to an application for a design registration filed on or before the date of filing of a patent application is in conflict with the patent right with regard to the patent application, a person who, at the time of expiration of the duration of the design right, actually owns the exclusive license on the design right, or a non-exclusive license having effect under Article 99(1) of the Patent Act as applied under Article 28(3) of the Design Act on the design right or on the exclusive license shall, upon expiration of the duration of the design right, have a non-exclusive license on the patent right or on the exclusive license actually existing at the time of expiration of the duration of the design right, limited to the extent of the original right.

#### Quality of patents

The following are the main work sharing programs Japan is taking part in.

##### - JP-FIRST (JP-Fast Information Release Strategy)

The JP-FIRST is a program under which the JPO prioritizes examinations of applications used as a basis for filing applications abroad from Japan (i.e. applications that serve as a basis of the priority under the Paris Convention) and releases its FA results to the world.

The following outcomes can be expected from this program:

##### (1) Support for acquiring appropriate rights abroad

Examiners in various IP offices will be able to use examination results provided by Japan under this program. By doing so, it is anticipated that those examiners will be able to conduct high-quality examination. As a result, applicants can acquire strong and stable rights abroad.

##### (2) Reducing the examination workload worldwide

Over the long term, the examination workload at each IP office is expected to be reduced because of the progress being made in work-sharing among countries. When the efficiency of examination processes is improved, the waiting period for examination can be shortened all over the world, including Japan.

- AIPN (Advanced Industrial Property Network)

The AIPN is a system that provides examination information in Japan to intellectual property offices in other countries. The purpose is to reduce the duplication of work at intellectual property offices by effectively using examination results of corresponding patent applications in Japan so as to expedite the acquisition of rights by applicants at these other offices. The AIPN enables examiners at intellectual property offices outside Japan to obtain information online in English on documents used for examination procedures, as well as information on the legal status of patent applications, cited documents, documents on examinations of post-grant claims, and patent families. In addition, the AIPN was equipped with a multilingual machine translation function in March 2013, and now users can use languages other than English to access the AIPN. As of April 2013, the AIPN was available to 61 countries/organizations.

-PPH (Patent Prosecution Highway)

PPH is explained in document SCP/19/4.

Confidentiality of communication between clients and their patent advisors

There is no additional or updated information regarding documents SCP/14/2, SCP/16/4 Rev., SCP/17/5, and SCP/18/6.

Transfer of technology

There is no information on practical examples and experiences on patent-related incentives and impediments to transfer technology.