

Japan's interventions in SCP 32 (7-10 December, 2020)

5. Exceptions and limitations to patent rights

We would like to express our sincere appreciation to the Secretariat for its great efforts in preparing working document SCP32/3 that includes a draft of reference documents on prior user rights. Although we have already mentioned in this document, here, we would like to talk about the outline of how prior user rights are being handled in Japan.

In Japan, prior user rights are not to be registered at the JPO. When patent holders file a lawsuit against prior users for their patent infringements, the prior user rights will become effective for the patents.

Requirements for prior user rights to be granted are as follows:

Firstly, prior users have personally made identical inventions independently without knowing the details of the invention described in a patent application or learned of such inventions from a person that, without knowing the details of the invention described in a patent application, personally makes an identical invention;

Secondly, prior users have been engaging or preparing to engage in business that involves the working of their inventions;

Thirdly, prior users have been actually engaging or preparing to engage in business that involves the working of inventions at the time of the patent applications were filed by others;

Lastly, prior users have been actually engaging or preparing to engage in business that involves the working of inventions in Japan.

Regarding the effects of prior user rights, prior users can continue working the patented inventions of others at no cost and can continue their business within the extent of the inventions that the person is working or preparing to work and within the preview of the business purpose.