

JAPAN INTELLECTUAL PROPERTY NEWS

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COURT DECISION

Publicity Right for Names of Famous Horses

Tokyo District Court rejected the 23 horse owners' claim in the law suit against the software house, Ascii Corporation. The plaintiffs claimed that Ascii used their race horse names in Ascii's popular home video game "Derby Stallion" and violated the publicity right of the horses. These horse owners had demanded that Ascii temporarily suspend production and distribution of the software and claimed 45 million yen (about \$365,000) for the damage caused.

"Exclusive rights such as a publicity right is granted only for cases where an individual right is violated," the judge pointed out. He noted that "things" such as horses are protected under laws related to the intellectual property right such as Trademark Law and that "if exclusive rights are granted without clear provisions, the nation's economical and cultural activities may be overly restricted."

Besides celebrities such as athletes and entertainers, publicity rights have



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been granted for race horses that participated in the G1 race in the law suit over a game software last Jan. at the Nagoya District Court, whose ruling was supported by the Nagoya High Court as well. "Derby Stallion" is a game whose players are given money and female horses to bear new race horses to pursue a championship at big races. The software uses names of famous race horses.

INFORMATION ON JP LAW

Revision of the Time Limit for Submitting a Request for Examination (Sept., 2001; Japan Patent Office)

The time limit for submitting a request for examination for a patent application is to be changed as of Octo-

ber 1, 2001 from "within seven years" from the filing date to "within three years" from the filing





IP LINKS

Japan Patent Office
<http://www.jpo.go.jp/indexj.htm>

Industrial Property Digital Library
http://www.ipdl.jpo.go.jp/homepg_e.ipdl

Japan Patent Attorney Association (JPAA)
<http://www.jpaa.or.jp/english/index.html>

AIPPI (International Association for the Protection of Industrial Property)
<http://www.aippi.org>

Supreme Court of Japan
<http://www.courts.go.jp/english/ehome.htm>

Institute of Intellectual Property (IIP)
<http://www.iip.or.jp/e/index.html>

date (see Section 48ter of the Japanese Patent Law).

Notes

1) The above revised time limit is to be applied for patent applications filed on or after October 1, 2001.

2) For patent applications filed on or before September 30, 2001, examination must be requested seven years from the filing date.

3) Regarding divisional or continuation applications filed on or before September 30, 2001, examination must be requested seven years from the base (original) filing date.

4) For applications claiming an internal priority and based on a previous domestic application, having a filing date of on or after October 1, 2001, examination must be requested three years from the internal priority based application.

5) For applications filed under the Paris Convention having a filing date of on or after October 1, 2001, examination must be requested three years from the Japanese filing date.

6) For international applications filed with the Japanese Patent Office acting as the International Receiving Office having a filing date of on or after October 1, 2001, examination must be requested within three years from the international filing date.



FOCUS

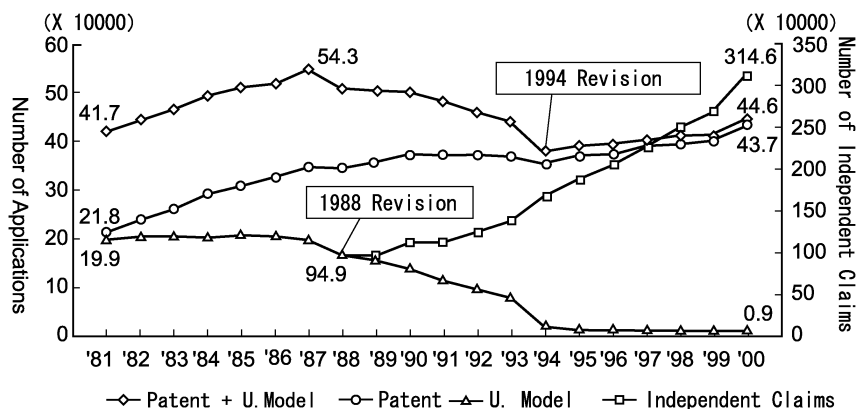
A Large Increase in the Numbers of Applications and Independent Claims Filed in Japan

1. The number of patent and utility model applications has increased 7.2% to 446,000 for the year 2000. Not since 1997 has the number of filings been so high. The most number of filings approximately, 543,000, occurred in 1987. New application filings dropped between 1988 and 1994 in view of the revised system of multiple claims (1988) and the new utility model system (1994).

2. The number of independent claims filed reached a new all time high, 3,146,000, a 17.4 % increase from

the previous year.

Transition in number of independent claims and application filings in Japan



Source: Japan Patent Office Annual Report
Patent Administration Annual Report, etc.

Transition of the Number of Application Filings/Registrations with the JPO

PATENT

	Patent			
	Number of Filing		Number of Registration	
	Japanese	From overseas	Japanese	From overseas
1991	335933	33463	30453	5647
1992	338019	33875	78993	13107
1993	332345	34141	77311	11089
1994	319938	33363	72757	9643
1995	334612	34603	94804	14296
1996	340101	36514	187681	27419
1997	350807	40765	129937	17749
1998	359381	42551	125704	15744
1999	360180	45475	133960	16099
2000	387364	49501	112269	13611

UTILITY MODEL

	Utility Model			
	Number of Filing		Number of Registration	
	Japanese	From overseas	Japanese	From overseas
1994	15761	859	8314	471
1995	13065	1045	12744	1022
1996	12302	1152	11873	1108
1997	10428	1280	10106	1250
1998	9450	1193	9158	1248
1999	8877	1301	8702	1257
2000	7880	1670	7429	1609

DESIGN

	Design			
	Number of Filing		Number of Registration	
	Japanese	From overseas	Japanese	From overseas
1991	38486	1648	27875	979
1992	37678	1492	36619	1385
1993	39188	1571	37441	1267
1994	38791	1815	33599	1349
1995	38257	1810	33562	1325
1996	38456	1736	34001	1494
1997	37766	2099	35844	1574
1998	37340	2012	34882	1382
1999	35235	2133	39317	2038
2000	36070	2426	37939	2098

TRADEMARK

	Trademark			
	Number of Filing		Number of Registration	
	Japanese	From overseas	Japanese	From overseas
1991	149163	18743	87231	8098
1992	288357	22654	141472	14568
1993	154774	19811	145229	13456
1994	152708	20151	135902	11289
1995	156790	22899	136883	8028
1996	163518	24642	165544	12707
1997	114389	18727	221830	31442
1998	96845	15624	114895	17171
1999	104252	17609	106036	17620
2000	124361	21307	79462	14907

Japan Intellectual Property Association (JIPA)
<http://www.jipa.or.jp/english/index.html>

Japan Patent Information Organization (JPIO)
<http://www.jprio.or.jp/welcome2.html>

License Exchange Society Japan (LES)
<http://www.lesj.org>

Asia-Pacific Industrial Property Center (APIC)
<http://www.apic.jiii.or.jp>



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COLUMN

General Information on Obtaining Patents in Japan (Part 1)

1. Who may apply for a patent

Inventor or his/her assignee may apply.

In Japan, it is common for the assignee to file a patent application as well as a PCT international application.

An assignment is required only when requested by the examiner. No assignment is required if the inventor is an employee of the assignee company.

If the employee individually obtains a patent for an invention which was created within the scope of the employer's business, the employer may obtain a license-free, non-exclusive right to use the patent.

2. Ownership Rights

In Japan, there is a special provision for inventions created by company employees (Japanese Patent Law, Article 35)

In order for an employer to apply

for a patent for an invention created by his/her employee within the scope of the employer's business, the employer must pay the employee a reasonable compensation separately from his/her salary.

3. Representation

Article 8 stipulates that an applicant who does not have a domicile or residence in Japan must appoint a patent administrator who does have a domicile or residence in Japan.

However, the new Patent Law Treaty as of this June no longer forces an applicant to appoint a patent administrator for a patent application.

For this reason, Article 8 will be deleted from the Japanese Patent Law in 2 to 3 years. As a result, an applicant will be able to apply for a Japanese patent from America without using a Japanese patent attorney since the Japanese Patent Office (JPO) has an electronic filing system.

OUR OFFICE

Patents and Trademarks

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Our Services in the U.S.A.

- preparation of Japanese specifications to be filed with Japanese Patent Office, based upon translation and review of English specifications.
- review of drafts of Japanese specifications.
- translation of specifications, laid-open publications and other technical documents from Japanese into English.
- research on Japanese patents, licenses and trademarks.
- preparation of opinions on Japanese patents, licenses and trademarks.