

The Utility Model Practices in Japan

The revised Utility Model Law (JUML) will be effective from April 1, 2005. Please be informed that dual applications for the same invention are not employed in this revision, unlike e.g. German or Korean system. No dual applications or no branching off. The following items 2, 6, 7 and 8 show the new revisions, while the remaining items 1, 3, 4 and 5 explain the current and future practices (no change).

1. Subject Matter

The subject matter of the JUML is "idea" (small inventions) relating to shape or construction of articles or combinations thereof. Methods, computer programs or materials are not protected by the JUML.

2. Term of a Utility Model Right

While the current JUML permits a 6 years protection term starting from the filing date of a utility model application, it will be extended to 10 years.

3. Automatic Registration

No substantive examination is performed as a prerequisite for registration. Unlike the patent system, no examination is performed as a prerequisite for registration. If a utility model application meets formality requirements as well as basic requirements such as unity and clarity, the "idea" will be registered, regardless of novelty and inventive step.

4. Technical Opinion

The registrant (owner) or the applicant of utility model can request to the Commissioner of the JPO a Technical Opinion regarding the durability (i.e. novelty, inventive step, and non-identicalness with earlier applications). This Opinion is a prerequisite for enforcing the utility model right. That is, before sending a warning letter or entering into an infringement action, the utility model right holder should obtain the Opinion.

5. Amendment

It is possible to file a voluntary amendment within 2 months from the filing date of the utility model application. It is not permitted to add a new matter by the amendment.

6. Correction

The current JUML permits only cancellation of the claims as correction after registration. Under the 2005 revision, it will be permitted to make the correction for limiting the scope of the claims or correction of a clerical error or clarification of unclear description, although the correction is permitted only once. Also, the correction should be made within the scope of the matters described in the original specification or the drawings or the claims as registered.

7. Conversion into a patent application from a utility model application/registration

The current JUML permits a conversion from a utility model application to a patent application only before the utility model is registered. Under the 2005 revision, however, it will be newly permitted to convert a utility model to a patent application even after the utility model is registered.

7.1. A converted patent application can be filed within 3 years from the filing date of the utility model application,:

- 1) before the applicant of the utility model application or the owner of the utility model right requests a Technical Opinion, or
- 2) within 30 days after the applicant received a notice of a Technical Opinion requested by a third party, or
- 3) within a period of time that the first written reply can be filed in a utility model invalidation trial.

It will still be permitted to convert a utility model application into patent application before it is registered. Under the current practice, a utility model application is registered within approximately 5 months from the filing date, so that there seems to be no sufficient time for an applicant to review the possibility of conversion from a utility model application into a patent application. It is expected that the owner of a utility model right would enjoy an extended time for consideration after this new revision.

7.2. Contents of a patent application converted from a utility model registration should be within the scope of the original disclosure of the utility model registration. Therefore, it is not permitted to include a new matter in a patent application based on a utility model application/registration.

7.3. A divisional patent application which is divided from a patent application

based on the registered Utility Model can be filed. Please note a patent application based on the registration of Utility Model or a divisional application from a patent application based on registration of Utility Model can not be converted back into a utility model application.

7.4. If a patent application based on a utility model registration is filed, the basic utility model registration should be abandoned, and also, it will no longer be possible to request a Technical Opinion regarding the utility model and thus will not be able to enforce the utility model right to a third party. Please note that the utility model application is deemed to be withdrawn when the utility model application is converted to a patent application.

7.5. It is not possible to convert a utility model registration into a patent application without consent of the licensee.

8. Annual Fees

Annual official fees for the maintenance of utility model registration will be drastically reduced, as follows:

Term	Current	After April 1, 2005
1st to 3rd years	7,600 yen, plus 700 yen multiplied by the number of claims	2,100 yen, plus 100 yen multiplied by the number of claims
4th to 6th years	15,100 yen, plus 1400 yen multiplied by the number of claims	6,100 yen, plus 300 yen multiplied by the number of claims
7th to 10th years	None	18,100 yen, plus 900 yen multiplied by the number of claims