

## Japan IP Enforcement & Transactions Newsletter

アンダーソン・毛利・友常法律事務所  
知的財産権プラクティスグループ

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[Japanese IP Topic 2008 No. 6 (English)]

#### **Proposed Amendment to Registration System for Patent License**

In February 2008, the cabinet proposed a bill to amend the patent law in relation to the registration system for patent license. It is expected that the bill will pass the parliament before summer.

#### **Effect of Registration**

Under Japanese Patent Law, patent license can be registered in the Japan Patent Office when both the licensor and licensee agree to the registration. Once registration is made, the registered license is valid against (i) a person to whom the licensor has subsequently assigned the patent or rights thereof, and (ii) a bankruptcy trustee appointed for or by the licensor. Currently, license registration is available only for granted patents.

#### **Registration for the License of Pending Patent Application**

The Cabinet proposed to amend the registration system in order to make the license registration available not only for granted patents but also for pending patent applications. This proposed amendment to the registration system will bring some advantages to the registered licensee of pending patent application, the investors and other financial institutions which invest in such licensee for the value of the business under the license.

As stated above, (i) even if the licensor assigns the pending patent application to a third party, the assignee will not be able to enforce the patent, and (ii) even if the licensor goes into bankruptcy, the bankruptcy trustee cannot terminate or cancel the license.

#### **Limitation on the Scope of Disclosure**

Under the current registration system, (i) the identity of a licensee, (ii) the scope of the license and (iii) the amount of consideration paid for the license are required to be specified in the register, which is open to the public. This statutory disclosure of the details of the license has been criticized for its inconvenience in the registration system. Some of the registered items are now deemed not appropriate to be opened to the public. Therefore, there are proposal to amend the registration system to the effects that the identity of the licensee and the scope of the license will be available only to certain stakeholders, such as purchaser of the patent or patent applications under which the license is granted, and that the amount of consideration paid for the license need not be disclosed in the register.



Wakako Sekiyama  
関山和華子  
wakako.sekiyama@amt-law.com

[Foreign IP Topic 2008 No. 2 (Japanese)]

**インドにおけるライセンス規制**

日本企業を含む外国企業がインドに事業進出するにあたり、現地法人（合弁会社を含む）との間で、外国企業をライセンサー、現地法人をライセンシーとする、技術、ノウハウ、商標、デザインその他についてのライセンス契約を締結し、ロイヤリティ収入を得るという手法をとることがあります。インド法上、ライセンス契約の内容を直接に規制する法令はなく、一般の商慣習に従ったライセンス契約であれば、その内容がインド法上無効とされることは通常ありません。

しかし、ライセンス契約に基づくインド内国会社（ライセンシー）から外国会社（ライセンサー）へのロイヤリティの支払いは、インド国内財産の外国移転という側面を有しているため、ライセンス契約の準拠法をどのように定めるかにかかわらず、インド外国為替管理法（Foreign Exchange Management Act, 1999）の規制に服します。

ライセンス対象が技術やノウハウ（国内または国外で登録を受けているかどうかを問いません。後述の商標等につき同じ）である場合、①一括して支払う金額が200万米ドルを超えず、かつ②ライセンシーであるインド現地法人の国内売上（税額控除後税抜額。以下「売上」という文言につき全て同じ）の5%および輸出売上の8%を超えない限度では、インド内国会社から外国ライセンサーに対するロイヤリティ支払いは特に規制を受けず、当局の承認や届出等は不要とされています。他方、ロイヤリティの支払額が上記金額を超える場合、送金および支払受領について、契約内容に従ってプロジェクト承認委員会（Project Approval Board）または外国投資促進委員会（Foreign Investment Promotion Board）といったインド政府機関の事前承認が必要となります。

また、ライセンス契約の内容が、商標やデザインを許諾するものである場合、ロイヤリティの金額がライセンシーであるインド内国会社の国内売上の1%および輸出売上の2%を超えるかどうか、上記事前承認が必要となるかどうかの基準となります。

当局からの事前承認の取得には手間と時

間がかかるため、インド内国会社をライセンシーとしてライセンス契約を締結する場合、上記限度額を意識してロイヤリティ金額を設定することが必要といえます。



Ryo Kotoura  
琴浦 諒  
在ムンバイ Amarchand  
法律事務所出向中

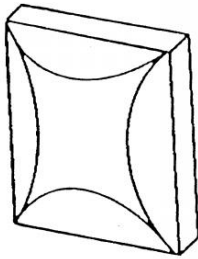
[Japanese IP Topic 2008 No. 7 (English)]

**How to Determine the Similarities between a Three-Dimensional Trademark and a Plain Trademark**

Since April 1, 1996, applicants have been able to file and register three-dimensional trademarks under the Japanese Trademark Act. However, there have not been a significant number of applications for three-dimensional trademarks as the Japan Patent Office has often rejected them on the basis that their shapes are indispensable to their function. As a result, there are not many court cases or appeal decisions involving disputes about similarities between a three-dimensional and a plain trademark. The Examination Guideline for Trademarks standardizes the determination of similarities of different types of marks. In principle, a three-dimensional trademark is judged as similar in appearance to a plain trademark when its appearance is the same or similar if viewed from a specific angle.

We will now examine an example of a typical appeal case at the Japanese Patent Office, which uses the standardized examination method in the Examination Guideline for Trademarks. In the appeal case (*fufuku* No. 2002-65052), the applicant appealed the Examiner's decision that the trademark application (International Trademark Registration No. 745658) was not registrable on the ground it was similar to another person's prior trademark (Japanese Trademark Registration No. 4458521). The trial examiners at the Japanese Patent Office issued their appeal decision on June 16, 2004 and the applicant was successful. The trial examiners held that the two trademarks were dissimilar to each other and therefore, the trademark was registrable. The trial examiners found that three-dimensional trademarks were of a special nature because they present a different appearance from specific angles. Therefore, the

examiners tried to judge the similarity in the appearance of a three-dimensional trademark to another trademark from an analysis of all available angles. Since only one drawing was submitted for the prior three-dimensional mark as indicated below (Japanese Trademark Registration No. 4458521), the appearance of other angles was unknown. Therefore, the trial examiner could only assess the prior trademark by viewing it from a limited perspective. Accordingly, the two trademarks were deemed to be dissimilar to each other.



Japanese Trademark Registration No. 4458521  
(a cited trademark)



International Registration No. 745658



Chikako Mori  
森智香子  
chikako.mori@amt-law.com  
Phone: +81-3-6888-1199



Takahiro Kitaguchi  
北口貴大  
takahiro.kitaguchi@amt-law.com  
Phone: +81-3-6888-1200

[Japanese IP Topic 2008 No. 8 (Japanese)]

### 仮通常実施権制度に関する注意点

本ニュースレターの冒頭で紹介したように（英文）、特許出願中の発明についてのライセンスを「仮通常実施権」として特許法に取り込む特許法改正案が閣議決定されています。この改正の目的は、特許出願中の発明のライセンスについて登録を認めることで、ライセンシーの立場を強化するという点にあります。しかし、他方で、その結果として、特許出願中の発明のライセンスが、登録の有無を問わず特許法の規律を受けることとされますので、注意が必要です。具体的には、次の各点に注意を要し、特許法と異なる効果を生じさせる意思を契約当事者が有するのであれば、その旨を契約書に明記することが必要になります。

◎ライセンス対象の特許出願に基づき分割出願がなされたときは、当該分割出願もライセンス対象に含まれることとなります（34条の3第5項）。

◎ライセンス対象の特許出願について放棄・取り下げをするには、ライセンシーの承諾が必要になります（38条の2）。

◎ライセンス対象の特許出願に基づき国内優先権主張出願をする場合には、ライセンシーの承諾が必要になります（41条1項）。

◎出願人の同意のある場合の外、事業譲渡とともにする場合にも、ライセンスを移転することができることとされています（34条の3第4項）。

◎ライセンス対象の特許出願が登録された場合、「仮通常実施権」は消滅し（34条の3第7項）、「通常実施権」が許諾されたものとみなされます（34条の3第2項）。この点で、例えばロイヤルティ支払対象製品の範囲等についての契約条項が同一性を保って効力を維持するのか等、疑義が生じるおそれがあります。

(城山執筆)

[Japanese IP Topic 2008 No. 9 (English)]

**IP High Court's criticizing decisions regarding the JPO practice**

In 2007, the 3rd Division of the Intellectual Property High Court ("the IPHC") led by Chief Judge Toshiaki Iimura issued a number of decisions criticizing the practices of the Japan Patent Office ("the JPO").

Firstly, regarding the JPO's patent practice, the 3rd Division made remarks regarding the scope and finality of JPO decisions in cases where only a part of a JPO decision invalidating a certain claim is appealed. Under Japanese patent law, an invalidation action may be filed against individual claims, where there exists more than one claim in a patent, as a result of which it is possible for only part of the claims to be invalidated, while the remaining claims stays valid. In this regard, the question as to whether, and as to what extent, a JPO decision is finalized has not been resolved. The Japan Patent Act is silent on this matter and opinions have differed; One view (seemingly supported by the JPO) is that in this situation the JPO decision, as a whole, is not finalized. By contrast, another view is that the part of the JPO decision, which maintains the validity of the claims and which was not appealed, is final. The 3rd panel of the 3rd Division handed down decisions in line with the second view, criticizing the JPO practice. (IPHC decisions of June 20, 2007 (Case No. 2007 (Gyo-ke) 10081), July 23, 2007 (Case No. 2007 (Gyo-ke) 10099), and September 12, 2007 (Case No. 2006 (Gyo-ke) 10421))

Secondly, the panel rendered decisions criticizing the practice of the JPO regarding trademark cancellation and invalidation actions. Petitioners of these trademark actions have occasionally sought cancellation or invalidation of the trademark registration, identifying the classes of goods/services of their cancellation or invalidation claim with specified goods/services "*and goods/services similar to the foregoing goods/services*", a practice that seems to have been endorsed by the JPO. The third panel of the IPHC stated in dicta that such practice is not appropriate and should be changed. (IPHC decisions of June 27, 2007 (Case No. 2007 (Gyo-ke) 10084), October 31, 2007 (Case No. 2007 (Gyo-ke) 10158), and November 28, 2007 (Case No. 2007 (Gyo-ke) 10172))

Thirdly, the panel reversed a JPO decision regarding the registrability of a design application,

requiring that the JPO board of examiners disclose the logical process through which it reached a conclusion that the application lacked the requisite creativity. (IPHC decision of December 26, 2007 (Case No. 2007 (Gyo-ke) 10209))

It will be interesting to observe the reaction of the JPO following those decisions.

Please see Yoshikazu Iwase's article entitled "Passing judgment on Japan's IP court," which was firstly published in the Managing Intellectual Property, March 2008 issue, for more details. (Y. Iwase)

[Japanese IP Topic 2008 No. 10 (Chinese)]

**早期电影著作权存续期间之计算**

关于早期电影著作权存续期间之计算方式, 东京地方法院近日于一贩卖、租售早期卓别林(Charlie Chaplin)电影D V D之案件中, 表示如下见解。

首先, 目前日本关于早期电影之著作权存续期间, 会因是否适用1970年修正前著作权法而有不同。依据日本著作权法附则第7条之规定, 于1971年1月1日以前公开之作品, 计算其著作权存续期间时, 系以修正前后著作权法之存续期间相比较, 并以其较长者准。依据旧法规定, 以著作人名义公开之著作物, 系以著作人生存时及其死后38年为存续期间。而依据现行著作权法规定, 著作权之存续期间则为公开后70年。

由于本案作品遍及卓别林自1919年起至1952年公开之作品, 因此作品之存续期间亦因上述计算方式而有不同。法院于判决中表示, 由于卓别林于1977年12月25日过世, 因此如依旧法规定, 卓别林电影之著作权存续期间为至2015年年底为止。而以新法计算期间时, 1940年以前公开之涉案作品, 由于其届期日较旧法计算时为早, 故保护期间仍依旧法计算, 亦即以2015年年底为此等作品存续期间届满日。至于1947年公开之凡尔杜先生(Monsieur Verdoux)与1952年公开之舞台春秋(Limelight), 因依据新法规定计算时, 其届期日较旧法为晚, 故存续期间仍依新法计算, 亦即为该等电影公开后之70年。

法院于结论中表示, 本案之卓别林电影著作

权存续期间均未届满，从事租售之被告应赔偿本案原告日币 1053 万 8000 圆及利息。本案被告并向知识产权高等法院提起上诉，但法院于 2 月 28 日在判决中表示，东京地方法院之前述见解并无违误。

随着近年吹起之怀旧风，租售著作权存续期间过期之 DVD 已形成一种新的商业模式。但从事相关营业时，前述案件所揭示之著作权保护期间计算方式，值得相关业者注意。



Yih-Lin Chung  
鍾亦琳

### Editors



Yasufumi Shiroyama  
城山康文  
yasufumi.shiroyama@amt-law.com  
Phone: +81-3-6888-1060



Yoshikazu Iwase  
岩瀬吉和  
yoshikazu.iwase@amt-law.com  
Phone: +81-3-6888-1069



Naoki Iguchi  
井口直樹  
naoki.iguchi@amt-law.com  
Phone: +81-3-6888-1089

## ANDERSON MŌRI & TOMOTSUNE

Izumi Garden Tower, 6-1 Roppongi 1 chome  
Minato-ku, Tokyo 106-6036 Japan

<http://www.andersonmoritomotsune.com/>

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