

Exceptions to Lack of Novelty

Legislation in JAPAN

Grace Period

To our Clients and Associates

December, 2006
OGURA & CO.

1. Exceptions to Lack of Novelty

Article 30 of the Japanese Patent Law makes exceptions to lack of novelty if and only in case an application is filed within six months from the date on which novelty is lost due to the following reasons;

- a) Conducting an experiment
- b) Making an presentation in a printed publication
- c) Making an presentation through electric telecommunication lines
- d) Making an presentation in writing at a study meeting held by a scientific body designated by the Commissioner of the Japan Patent Office (JPO)
- e) Exhibiting the invention at an exhibition held by the Government or by any local public entity, or at one which is not held by the Government but is designated by the Commissioner of the Japan Patent Office, or at an international exhibition held in the territory of a country party to the Paris Convention or of a Member of the WTO by its government or a person authorized thereby
- f) Coming to be publicly known against the will of the person having the right to obtain a patent

2. Requirement

- a) A due date for filing an application

An application must be filed within six months from the date on which the invention comes to be publicly known due to the acts constituting the above reasons for lack of novelty.

This application must be an application filed to the JPO.

Accordingly, in case an application filed to a foreign country even where it is granted (claiming) the benefit of an exception clause similar to that of Japan and also a priority claim on the basis of this foreign application is made in applying to the JPO, the application of Article 30 will be denied if it is filed in Japan after six months (even within a priority period) expired from the date on which the invention was disclosed. There has not yet been any multilateral [multinational] treaty concluded contrary to this interpretation.

b) An presentation in writing at a study meeting

The presentation at an academic conference must be a presentation at a study meeting held by scientific bodies designated by the Commissioner of the Japan Patent Office. In other words, the exception does not apply in case a presentation is made at an academic conference by a foreign scientific bodies because academic conferences are not currently designated by the Commissioner of JPO.

c) Submission of certificate

A certificate showing the application is satisfied with the following requirements must be submitted in 30 days from filing an application. If the certificate is written in foreign languages, a Japanese translation is also must be filed simultaneously.

Requirement 1: an application is filed within six months from the publication date of the invention

Requirement 2: the invention comes to be publicly known due to the acts constituting the above reasons for lack of novelty

Requirement 3: the invention comes to be publicly known by the person having the right to obtain a patent and the application for the invention is filed by the person

We will prepare a form of the certificate, and please let us have the following information.

- 1) How the invention comes to be publicly known
- 2) Publication date
- 3) Where the invention comes to be publicly known
- 4) The contents of the invention
- 5) By whom the invention comes to be publicly known
- 6) In case the inventor and the person disclosed the invention are different, the fact of transfer of a right to obtain a patent

Additionally, it is also required to file objective materials and/or certificates by a third party.

We will prepare for you specific examples for objective materials if you could give us the above information first.

Should you need further information, please do not hesitate to contact us.

OGURA & CO.
Masaaki Ogura

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