



SHIGA
INTERNATIONAL
PATENT
OFFICE
JAPAN

SHIGA IP NEWS

Volume 61 July 2021

IN THIS ISSUE

- ◆ **Bill for Revisions to Japanese Patent Law Approved**
- ◆ **Good News for Patentees! Obtaining Consent from Non-Exclusive Licensees will No Longer be Required**
- ◆ *Amicus Curiae* Brief System to be Introduced
- ◆ **JPO Technical Trend Report: Self-Driving and MaaS**

Bill for Revisions to Japanese Patent Law Approved

A bill for revisions to the Japanese Patent Law received Cabinet approval and was passed in the ordinary Diet session on May 14, 2021. The revisions will come into force in the spring of 2022. The main points of the revisions are as follows.

- (1) Further implementation of the process of digitalization
- (2) Review of the protection of IP rights so as to adapt to changes in corporate activities that accommodate acceleration of digitalization
- (3) Enhancement of the foundations of the IP system including a review of litigation procedures and fee schedules

In this issue, we briefly discuss two of these points.

- (2) Review of the protection of IP rights

Currently, a patentee must obtain consent from all licensees in order to make corrections to the claims, specification and/or drawings of a licensed patent. As patent licensing has become more complicated (in cases where there are many licensees, obtaining consent from all of them may be impractical), this revision will abolish the need to obtain consent from non-exclusive licensees. Consent from exclusive licensees will still be required after

this revision.

- (3) Enhancement of the foundations of the IP system

A new system which allows courts to call for opinions from third parties in litigation will be implemented. (See the separate article on *amicus curiae* briefs in this issue.)

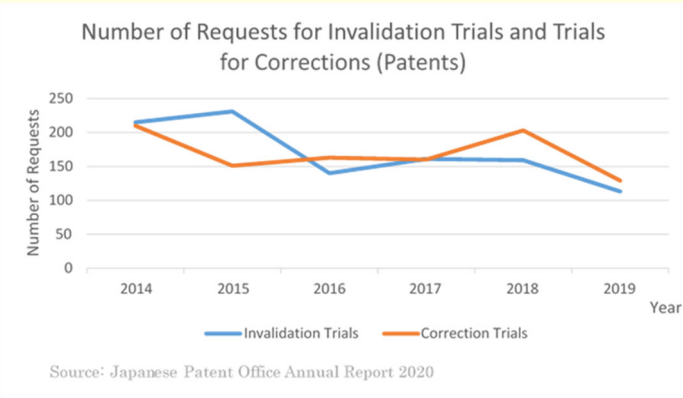
Good News for Patentees! Obtaining Consent from Non-Exclusive Licensees will No Longer be Required

One of the recently-approved revisions to the Japanese Patent Law is the abolishment of the stipulation which requires a patentee to obtain consent from all non-exclusive licensees whenever the patentee corrects the content of a patent.

During an invalidation trial, etc., a patentee sometimes needs to make corrections to the content of a patent in order to avoid invalidation of the patent. As shown in the chart below, such corrections are often used as an effective defensive measure in patent disputes.

Under the present law, a patentee has to obtain consent from all exclusive and/or non-exclusive licensees when filing a request for corrections during an invalidation trial

or a request for a trial for corrections. However, there sometimes may be hundreds of non-exclusive licensees on a single patent right, and more and more complicated licensing situations are arising due to the existence of patent pools and so on. In such cases, it has been practically difficult to obtain consent from all non-exclusive licensees. In light of such inconveniences, after this revision, while consent is still required from an exclusive licensee, obtaining consent from non-exclusive licensees will no longer be required.



Amicus Curiae Brief System to be Introduced

The *amicus curiae* brief system is where a court calls for the submission of opinions from third parties that could be effective and supportive to the court. In the U.S., *amicus curiae* briefs are often submitted to the Court of Appeals for the Federal Circuit (CAFC) and the Supreme Court.

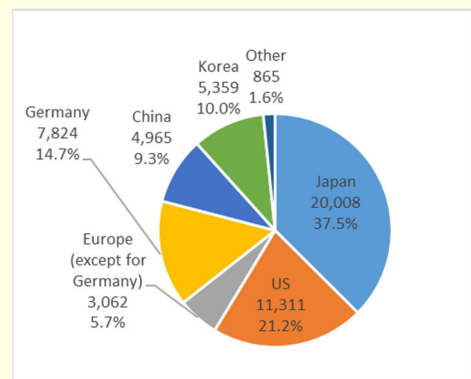
In Japan, with the cooperation of involved parties, a court used to seek opinions from third parties when a disputed point was considered to be domestically/internationally important and a court decision might significantly impact future R&D and corporate activities. For example, the Intellectual Property High Court (IPHC) collected a wide range of public comments on the Apple vs. Samsung SEP (standard essential patent) litigation of 2014. (Case No. 2014-[ne]-10043 was reviewed by the IPHC Grand Panel, and the judgment thereof was issued on May 16, 2014.)

However, in patent infringement litigation, it is often difficult for the parties involved to collect evidence related to real business situations in other industries. This *amicus curiae* brief system, to be newly-implemented in Japan, will provide courts with the opportunity to collect public opinions and will enable parties to use such third party opinions as evidence. Even in patent infringement litigation where cases often require more advanced and complicated technical knowledge, it is expected that it will be easier to make decisions based on actual situations with reference to such opinions from third parties.

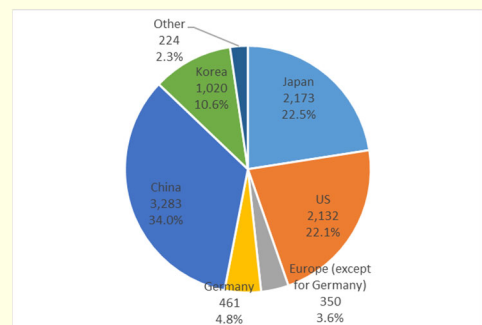
JPO Technical Trend Report: Self-Driving and MaaS

The Japanese Patent Office (JPO) annually compiles technical trend reports that feature promising technologies which will create and boost the markets of those technologies. This year, the JPO has featured machine translation, smart-farming, MaaS correlated with self-driving, recycling of plastic resources, etc. This article will briefly introduce the report on MaaS correlated with self-driving. The two pie charts below illustrate the number and percentage of self-driving/MaaS patent applications by country. The data from 2014 to 2018 was collected from the following major IP offices: Japan, the U.S., Europe (except for Germany), Germany, China and Korea between 2014 and 2018.

[Self-Driving]



[MaaS]



The above two charts prove that Japanese companies have actively engaged in developing self-driving technology while they focus less on MaaS. In contrast, Chinese companies focused more on developing a wide range of MaaS technologies rather than self-driving technology itself. The JPO report shows that Chinese companies surpass other applicants in the number of applications filed for various MaaS technologies ranging from ride-hailing to data analysis.