HARAKENZO
INTELLECTUAL PROPERTY LAW
Newsletter
March 2013
HARAKENZO
WORLD PATENT & TRADEMARK
INTELLECTUAL PROPERTY LAW FIRM
JAPAN

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## U.S. Soon to Enact Hybrid First-to-File Patent System
## 米国、ハイブリッド先願主義への施行が間近に

The March 16, 2013 deadline is fast approaching for the enactment of a much-scrutinized revision to U.S. Law, which will introduce a hybrid first-to-file patent system in place of the current first-to-invent system.

Fundamentally speaking, taking an application's effective filing date (or priority date) as a baseline, any inventions in said application's claims that have been granted a patent, published, been in public use or on sale before this date will not have novelty. Prior art from outside the United States will be judged on equal terms to that from within the U.S., with no geographical restrictions applied.

Further, even if the inventor(s) (and/or those people who have received information on the invention from the inventor(s)) have published the invention, there will be no loss of novelty due to publication provided that a patent application is made in the U.S. within one year from the date of publication.

Another outcome of the revision to the law that will affect working practices is a partial change in the pricing structure of the USPTO, which comes into effect on March 19, 2013[*1]. In relation to patents, there are many changes that will have an effect on working practices. For example, there will be a large increase in the Utility Examination Fee and fees for the second and subsequent RCE, etc. Conversely, the Publication Fee and Issue Fee, etc. will significantly decrease.

[*1]LINK: https://www.federalregister.gov/articles/2013/01/18/2013-00819/setting-and-adjusting-patent-fees

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米国の改正法において最も注目される先発明主義からハイブリッド先願主義への移行期限が2013年3月16日と迫っている。

基本的には、有効出願日（又は優先日）を基準とし、有効出願日（“effective filing date”）前に、クレーム発明が、特許されていたか、刊行物に開示されていたか、公然使用されていたか、あるいは販売されていた場合、当該クレーム発明は新規性を有しないことになり、また、先行技術の地理的範囲について米国内外を問わないこととなった。

さらに、発明者（発明者から発明の情報を得た者も含む）が発明を公表した場合であっても、1年以内に米国出願すれば、その公表によって新規性を喪失したものとはみなされないこととなった。

その他、実務上注目すべき変更点として、USPTOの料金体系が2013年3月19日から一部改定される点が挙げられる[*1]。特許関連では、Utility Examination Feeや2度目以降のRCE等の料金が大幅に値上げされるのに対し、Publication FeeやIssue Fee等が大幅に値下げされるなど、実務に影響を与える点も多い。

[*1]LINK: https://www.federalregister.gov/articles/2013/01/18/2013-00819/setting-and-adjusting-patent-fees

## JPO Begins PPH with Polish and Eurasian Patent Offices
## 日本国特許庁、ポーランド特許庁およびユーラシア特許庁とPPH開始

On January 31, 2013, the Japan Patent Office commenced a Patent Prosecution Highway (PPH) with the Polish Patent Office. On February 15, 2013, it also began a PPH with the Eurasian Patent Office.

A Patent Prosecution Highway is a system that allows applicants to easily request faster examination on applications that have already been granted a patent in certain other countries. With these PPHs, Japanese enterprises can receive faster examination of their patent applications in Poland as well as 8 countries of the former Commonwealth of Independent States, including Russia and Kazakhstan.

Currently Japan has PPH agreements with 25 countries and regions.

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日本国特許庁は、ポーランド特許庁との間で2013年1月31日から、ユーラシア特許庁との間で2013年2月15日から特許審査ハイウェイ(PPH)を開始した。

PPHは、ある国で特許権を取得することが可能と判断された出願について、出願人の申請により、別の国で簡易な手続で早期審査を申請することができる制度。このPPHの利用により、日本企業はロシア・カザフスタンを旧CIS8カ国やポーランドにおいて、特許出願の早期審査を受けられることが可能となる。

現在、日本がPPHを締結した国および地域は、25となっている。

## Imuraya's 'Azuki Bar' Bound for Trademark Registration
## 井村屋の「あずきバー」、商標登録へ

On January 24, 2013, the IP High Court overturned a decision by the JPO not to grant major food maker the Imuraya Group a trademark for the phrase **あずきバー** (hereinafter referred to as 'Azuki Bar.') The Imuraya group, which uses 'Azuki Bar' on its brand of ice candy containing azuki beans, had initiated a lawsuit seeking to challenge the decision by the JPO. The High Court passed a ruling approving the trademark application.

The Imuraya Group applied for a trademark for 'Azuki Bar' in 2010. The JPO's trial decision of refusal was based on its judgment that the phrase lacked distinctiveness. In the recent IP High Court ruling, it was judged that although the term 'Azuki Bar' describes the product in basic terms (i.e. its ingredients and shape) and therefore should not have distinctiveness, as the Imuraya Group's 'Azuki Bar' was a well-known brand that had been on sale for over 40 years with over 200 million bars sold, it is generally understood that 'Azuki Bar' refers to the Imuraya Group's product. Therefore, the trademark was approved for registration.

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大手食品メーカー「井村屋グループ」が、あずきを使用したアイスキャンディー「あずきバー」の商標登録を求めた審決取消訴訟で、知財高裁は2013年1月24日、登録を認めなかった特許庁の審決を取り消し、請求を認める旨の判決を言い渡した。

井村屋グループは、2010年に商標「あずきバー」を出願。特許庁の判断では識別性がないとして拒絶審決を受けた。今回の判決では、「あずきバー」の語自体は商品の品質(原材料、形状)を表わしたものであり識別力はないとしたものの、同社の「あずきバー」の認知度が高いこと、40年以上販売しており年間販売本数が2億本を超えることなどから、『「あずきバー」は井村屋の商品を指すものとして認識されている』と判断され、登録が認められた。

## Decision of Suspension and Order to Pay Compensation for Companies Forwarding Transmissions of TV Programs Overseas
## TV番組海外転送、差し止め・損害賠償を命じた判決確定

On February 13, 2013, the Second Petty Bench of the Supreme Court issued a decision rejecting the final appeal of the two defendants in a case brought by Japan's national broadcaster NHK along with commercial channels. The plaintiffs had sought to fine and suspend the service of the defendants, who were forwarding broadcasts of Japanese television programs via the internet that could then be viewed overseas. As a result of the rejection by the Supreme Court, the decision reverts to that of the previous appeal, which was to suspend the defendant's services and order them to pay compensation for infringement.

This case was fought over the point of who was the main source of the forwarded transmissions. The Supreme Court's previous decision in January 2011 was that the defendant companies were the main source, not the users of their services, and therefore upheld the claim that the defendants had breached copyright. The case was then remanded to the Intellectual Property High Court for a trial to determine the amount the defendants should be ordered to pay.

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日本のテレビ番組をインターネットを通じて海外に転送し視聴可能にしたサービスが著作権侵害に当たるとして、NHKと民放各社が業者2社にサービス停止と損害賠償を求めていた訴訟で、最高裁第2小法廷は2013年2月13日、業者2社の上告を棄却する決定を行った。これにより、サービス差し止めと損害賠償を命じた差し戻し控訴審判決が確定した。

本件については送信主体が誰であるかが争点となっていたが、最高裁は2011年1月に、送信主体は利用者ではなく業者2社であるとして著作権侵害を認め、賠償額算定のために審理を知財高裁に差し戻していた。

## Settlement Reached in 'Omoshiroi Koibito' Lawsuit
## 「面白い恋人」訴訟、和解成立

Ishiya Co., Ltd., the manufacturer of 白い恋人 ('Shiroi Koibito'), which are popular sweets known as a specialty of Japan's northern island of Hokkaido, reached a settlement with Yoshimoto Kogyo at the Sapporo District Court on February 13, 2013. Ishiya Co., Ltd. had brought a trademark infringement case seeking suspension of sales and compensation for infringement over Yoshimoto Kogyo's 面白い恋人 ('Omoshiroi Koibito') sweets.

According to both parties, Yoshimoto Kogyo will continue sales of its sweets, but will change the design of its packaging and limit sales to six prefectures in the Kansai area of Japan. Further, sales at product exhibitions at department stores, etc. will be permitted 36 times per year (except in Hokkaido and Aomori).

During this case, Ishiya Co., Ltd. claimed that the name and packaging of Yoshimoto Kogyo's product was similar and therefore infringed its trademark. However with this settlement they state that with the change of packaging and the limit on sales territory, fears that the two products could be confused have been assuaged.

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北海道土産として人気の菓子「白い恋人」を製造販売する石屋製菓が、吉本興業が販売する菓子「面白い恋人」に対して、商標権を侵害されたとして販売差し止めと損害賠償を求めていた訴訟は、2013年2月13日、札幌地裁で和解が成立した。

両者によると、吉本興業側は販売を継続するが、パッケージの図柄を変更し、販売を原則として関西6府県に限る。また、百貨店で行われる物産展には、北海道と青森を除き、年36回の販売が認められる。

訴訟において石屋製菓側は、名称や箱の図柄が似ており商標権侵害であるとの主張を行っていたが、「パッケージ変更や販売地域限定により誤認混同のおそれがなくなった」として和解に至った。

Please contact us if you have any comments or require any information.

Please acknowledge that the purpose of our column is to provide general information on the field of intellectual property, and that the description here does not represent our legal opinion on a specific theme.

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