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Canadian Intellectual Property Office

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Office de la propriété intellectuelle du Canada



DOING BUSINESS ABROAD

Protecting your IP in Japan



Canada

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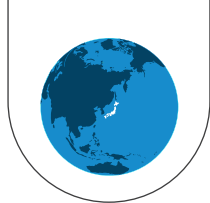
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Cat. No. Iu71-4/73-2019E-PDF
ISBN 978-0-660-33070-9

Aussi offert en français sous le titre *Protéger votre PI au Japon*.





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焼肉・冷麺

水上ビル

水上ビル

キングエイワ 8F

パラスロのデパート グリンピース

レイク

三和ファイナ

北の家族

ドンキホーテ

高額買取
安心確実! カンタン!

カラオケ & ハーティー館

RESTAURANT & KARAOKE

歌舞伎町
Kabukicho

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DOING BUSINESS ABROAD

Protecting your IP in Japan

Intellectual property (IP) is a valuable asset that can support your business expansion abroad. A Canadian patent, trademark or industrial design does not secure your rights outside Canada. You should consider obtaining IP protection in the countries where you plan on doing business, including selling products online or manufacturing products overseas.

Japan is one of Canada's most important economic partners, with trade relations continuing to deepen between the countries.

There are important differences between Canada and Japan in the protection and registration of IP. In Japan, you can apply for trademark, patent, utility model, design, copyright and geographical indication protection.







Where is IP registered?

The Japan Patent Office (JPO) is the Japanese government agency responsible for granting trademark, patent, utility model and design rights. The agency is composed of a number of departments, including the Trademark, Design and Administrative Affairs Department. Copyright registration is administered by the Japan Copyright Office.

If you do not have an existing business entity in Japan, you will be required to obtain the services of a local IP expert to conduct any procedures with the JPO. In addition to helping you with the IP processes, experts can also assist in understanding local culture to prevent misunderstandings that could become obstacles for businesses expanding into Japan.

Applications for IP rights can be filed electronically at jpo.go.jp. A good first step is to search existing IP to check whether your anticipated IP use may conflict with or infringe on someone's prior rights. A Canadian IP professional may be able to coordinate work with an IP professional in Japan.

Trademarks

- In Japan, a trademark is any character, figure, sign, 3-dimensional shape, sound or colour, or any combination thereof, that is used in connection with a person or company's goods or services.
- Japan follows a "first-to-file" system for trademark rights. This means that whoever registers a trademark first holds the exclusive right to the use of the trademark. Foregoing trademark registration in Japan may leave a business vulnerable to the risk of others registering the trademark.
- A trademark can be filed directly with the JPO or through the Madrid System for the International Registration of Marks.

- In Japan, a trademark is registered for 10 years and can be renewed every 10 years.
- If you are not regularly using your trademark in the Japanese marketplace, it may be subject to a dispute or challenged for non-use. Cancellation of trademark registration may be requested if the trademark is not used for more than 3 consecutive years.
- For **more information** on trademarks and applying for a trademark registration, visit www.jpo.go.jp/e/faq/yokuaru/trademark.html.

Patents

- In Japan, an invention meets the patentability requirement if it was created with the use of technical concepts and the laws of nature. The patent must also be industrially applicable.
- There are 2 ways to file an application: send it directly to the JPO or apply through the Patent Cooperation Treaty (PCT).
- If you do not have a permanent address or office in Japan, you are required to have legal representation by a patent administrator who holds a permanent address in Japan. All procedures except for the initial application and payment of fees must be conducted

through the representative. The JPO recommends that the representative be a patent attorney, to ensure they are familiar with the legal procedures and customs of Japan.

- Applications that are filed in English must include a Japanese translation. The translation must be sent within a month of the submission of the initial application.
- Effective June 9, 2018, applicants have a 1-year period from a public disclosure to file a patent application. If the application is filed within this grace period, the disclosure will not be considered as an opposable prior art.
- A request for examination must be filed within 3 years from the initial application filing date. The request notifies the JPO that the invention is ready for examination. If you fail to send the request within that time, the application will be considered withdrawn.
- In Japan, plant varieties can be patented if the requirements for patentability are met.
- In Japan, patent protection generally lasts for up to 20 years from the filing date. However, the term of protection for patent applications relating to agricultural chemicals and pharmaceuticals may be extended for an additional 5 years.
- Japan has a “first-to-file” patent system, meaning that a patent is granted to the first person who files for patent protection.
- Canadian applicants can use the Global Patent Prosecution Highway to speed up the examination process for corresponding patent applications filed in Japan.
- The PCT makes it possible to secure the rights to an invention in a large number of countries by filing a single international application instead of several separate applications.

- For **more information** on patents and applying for patent protection, visit www.jpo.go.jp/e/faq/yokuaru/patent.html.

Utility models

- Utility models are similar to patents in that they protect industrially applicable creative technological concepts. However, unlike patents, utility model protection only covers the creative features relating to the shape or construction of a device.
- Utility models are registered without a substantive examination from the JPO, as long as the basic and formal application requirements are met.
- Since utility models are registered without examination, the JPO requires the registrant to obtain a registrability report to enforce their utility model rights. A registrability report is prepared by a JPO examiner, who provides an opinion on the registration’s validity.
- In Japan, utility models are protected for 10 years from the date of filing.
- For **more information** on utility models and utility model protection, visit www.jpo.go.jp/e/faq/yokuaru/utility.html.

Designs

- In Japan, a design is any shape, pattern or colour of an article, or any combination of those. A design must be new and innovative in its form. Ensure that you do not publish or disclose your design before filing an application, because once a design is disclosed to the public, it may be deemed as non-novel and barred from being registered.
- In the event that a design has been publicly disclosed before filing, the applicant may be entitled to a 1-year grace period under certain circumstances.

- In Japan, designs are granted on a “first to file” principle. Under this principle, if multiple design applications for an identical or a similar design are filed on different dates, only the earlier application is entitled to registration.
- Some designs, such as those that go against public order or those deemed immoral by the JPO, cannot be registered.
- In Japan, designs are protected for 20 years from the registration date, with no option for extension.
- Applications must be made directly with the JPO or through the Hague System for the International Registration of Industrial Designs.
- For **more information** on designs and design protection, visit www.jpo.go.jp/e/faq/yokuaru/design.html.
- Applications must be made directly with the Ministry of Agriculture, Forestry and Fisheries.
- GIs are a different type of IP than the “Regional Collective Trademark” (RCT), which is issued by the JPO as a trademark.
- GIs differ from RCTs primarily in that an applicant for a GI must define how the geographical origin of their product affects the product's quality and must establish a quality control process to ensure the product meets the defined standards.
- For **more information** on GIs, visit www.maff.go.jp/e/policies/intel/gi_act.

Copyright

- In Japan, copyright protects original literary, scientific, artistic or musical works in which thoughts or sentiments are expressed in a creative way.
- Like in Canada, copyright protection in Japan automatically applies to a work upon its creation and for the duration of the author's life, plus 50 years. As in Canada, there are some exceptions to this general rule.
- For **more information** on copyright, visit bunka.go.jp.

Geographical indications

- In Japan, the geographical indication (GI) system protects certain products related to the agricultural, forestry and fishery industries that originate in a particular region and whose characteristics are linked to their geographical origin.





IP enforcement

There are several ways to enforce your rights against unauthorized use of your IP in Japan:

- Japan maintains a strong framework of enforcement measures to protect against IP infringement. IP owners can send a warning letter to notify the infringer of their actions. The letter is intended as a first step for IP owners. The optimal result is for the infringer to cease all wrongful actions.
- If you believe your IP rights are being infringed upon in Japan, you should consult a lawyer licensed to practise in Japan or an IP professional to discuss the next steps.
- In cases where a warning letter is not sufficient, it may be best to seek legal action.
- IP right holders can request a provisional injunction to prevent infringing acts from continuing until the case is resolved.
- In 2016, Japan established the Intellectual Property High Court to shorten the duration of civil procedures related to IP.
- The Japan Customs tariff law gives IP owners the option of filing for custom suspension of infringing goods. If the goods are found to be infringing, the company may face a fine of up to USD 100,000.
- Japan also provides the option of ADR processes, such as mediation and arbitration. ADR processes are generally more informal, less adversarial, cheaper and settlement-focused. They can be used before or as an alternative to going to court.
- Before taking any action, you may wish to consult a qualified IP professional who is familiar with Japan's legal system to explore the various enforcement mechanisms available.



Tips: Important notes

- IP rights are important, so take the time to determine what IP can be registered and what rights can be enforced.
- Remember that the protection of IP rights (such as patents, trademarks, industrial designs and copyrights) registered in Canada does not extend to Japan.
- Align your IP strategy with your business strategy. Identify business goals, protectable IP, regional requirements, potential partners and the capacity to expand into your target markets.
- Routinely monitor the marketplace for unauthorized use of your IP.
- Before proceeding with any of the enforcement methods outlined above, consider contacting a qualified legal representative to discuss options, including a warning letter.

For more help

- For information about IP protection in Japan, please see the JPO website at jpo.go.jp.
- For information related to IP enforcement rights in Japan, please see the Intellectual Property Right Border Enforcement website at http://www.customs.go.jp/mizugiwa/chiteki/index_e.htm
- For material relating to the export of goods to Japan, please see the Canadian Trade Commissioner Service website at tradecommissioner.gc.ca.
- Visit the Global Affairs Canada website at international.gc.ca for more information about doing business in Japan.
- For IP tools, resources and information for businesses, visit Canada.ca/ip-for-business.
- For more information on going global with your IP, visit Canada.ca/export-ip.
- Find more programs and support for Canadian businesses and innovators at innovation.canada.ca.

*The information provided above is meant as an educational resource only and should not be construed as legal advice.



Canada.ca/export-IP

