

How to Use Japanese Utility Model Registrations



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Utility Models Are Registered Quickly

- Typically, within three months from the filing
- No substantial examination

cf. Patents: 14 months from request for
the examination

Prosecution Fees Are Lower

(JPY)

	Utility Models	cf. Patents
Filing excluding translation	140,000	160,000
Request for the examination	---	150,000~200,000
Office actions	---	30,000~250,000 x 1~3
Registration	30,000	Service Fees + Office Fees

However, Enforcement is Restricted

A proprietor may NOT enforce the right, unless:

- obtaining a technical opinion from the JPO; and
- giving warning by presenting the opinion. (Art. 29bis)

Utility Model Owner Owes Responsibility for Damages

A proprietor is generally responsible for damages, if the utility model registration is invalidated after the enforcement or warnings.(Art. 29ter.1)

* responsible even if the registration is invalidated based on known/publicly-used techniques.

* NOT responsible, in case of:

- a positive technical opinion; and
- the enforcement or warnings with “due care”

(Art. 29ter.1 proviso)

It is Difficult to Prove “Due Care”

We recommend:

1. Prior art searches; and
2. Professional opinion on validity.

Validity: novelty, inventive steps,
no addition of new matters

- Professional opinion fees are high.

Utility Model Rights Are Rarely Used in Japan

1. Small number of applications
2. Small number of court cases

We recommend filing a utility model application :
- not for enforcing the rights, but
- for indicating “registered utility model”
on the products or advertisement.

Converting to Patent Application for more amendments

Amendment opportunities of utility model:

- only within one month from filing, or
- only once after registration

Can be converted from utility model registration as well within 3 years from the utility model filing date

The original application/registration is withdrawn

Filing utility model and patent applications for the same inventions on the same date

Patent is rejected,
because the utility model is registered earlier.

If claims of the patent application are slightly limited:

- Patent is allowed (inventive step is not required over the utility model registration.)

Filing a patent, then a utility model for the same inventions

Both applications are allowed, because
the utility model is not substantially examined.
This is achieved, if only patent claims priority.
Utility model registration can be invalidated,
after the patent issues (no problem).