WORLD TRADE ORGANIZATION

RESTRICTED

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Council for Trade-Related Aspects of Intellectual Property Rights

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REVIEW OF THE PROVISIONS OF ARTICLE 27.3(b)

Information from Members

Addendum

JAPAN

The present document represents the information requested by the Council for Trade-Related Aspects of Intellectual Property Rights which the Secretariat has received from Japan by means of a communication from its Permanent Mission, dated 9 February 1999.[1]

A. PATENT SYSTEM QUESTIONS

1. In your territory, is there any basis for denying a patent on an invention consisting of an entire plant or animal that is novel and involves an inventive step?

In principle, *there is no such basis*. However, if inventions are liable to contravene public order, morality or public health, they shall not be patented (Article 32 of the Japanese Patent Law).

2. If the answer to question 1 is "yes", please respond to the following questions:

(a) Does your system exclude entire plants or animals as inventions? If it does, please cite the legal basis for this.

(b) If your patent system does recognize entire plants and animals as inventions, does it exclude all such inventions from being patentable subject matter, or does it only exclude certain types of plants or animals? If it excludes all, please cite the legal basis for their exclusion (e.g., lack of industrial applicability). If it excludes only certain types, please identify the categories or characteristics of inventions that are excluded and cite the legal basis for their exclusion.

(c) Is there any other basis in your law that precludes the grant of a patent or any categories of plant or animal inventions that otherwise are novel, involve an inventive step and are capable of industrial application? If so, please cite the legal basis for that exclusion from patent eligibility.

Not applicable (since the answer to question 1 is no).

[1] The questions to which answers are provided are those which can be found in document IP/C/W/126.

3. Other than with respect to subject matter you defined as being ineligible to be patented under question 2, is it possible in your territory to obtain a patent claim defined in any of the following ways?

(a) A patent claim that is not limited to a specific plant or animal variety.

(b) A patent claim that is expressly limited to a plant or animal variety.

(c) A patent claim that is expressly limited to a group of plants or animals, where the group is defined through reference to a shared characteristic such as incorporation of a particular gene.

(d) If the answers you provide to question 3(a) to (c) vary, please provide the definitions of a "plant variety" and an "animal variety" that are used by your examining authority.

With regard to patent claims defined in the ways (a) to (c), there are no provisions to exclude those inventions from being patented under the Japanese Patent Law as long as they are novel, involve an inventive step and are industrially applicable. Therefore, those claims defined in the ways (a) to (c) are patentable.

4. Is it possible to obtain a patent in your territory on a microorganism that is novel, involves an inventive step and is capable of industrial application? If not, please identify the legal basis under which these inventions are deemed ineligible to be patented.

Yes.

5. Is it possible to obtain a patent in your territory on an essentially biological process for the production of a plant or animal (i.e., a process limited to those acts that are necessary for sexual or asexual reproduction of a plant or animal)? If not, please identify the legal basis under which a patent on such a process would be denied.

Yes.

6. Is it possible to obtain a patent in your territory covering subject matter that is identical to that found in nature (e.g., a plant or animal in its natural state)?

An invention is required to be a *creation* under the Japanese Patent Law. In this connection, mere discoveries, including materials existing in nature or natural phenomena, where no creation of technical ideas is made purposefully, do not fall under inventions. Therefore, *it is impossible to obtain a patent which claims materials existing in nature or natural phenomena*.

However, chemical substances, microorganisms and the like are to be regarded as creations, when they are humanly extracted from materials existing in nature. Therefore, those claims are patentable.

B. PLANT VARIETY PROTECTION SYSTEMS

7. Do the laws applicable to your territory provide for a sui generis form of protection for a new plant variety?

Yes. The Seeds and Seedlings Law (Law Number 83, promulgated on 29 May 1998) provides for a *sui generis* form of protection for a new plant variety.

8. If the answer to question 7 is "yes", does that protection conform to the standards defined in one of the Acts of the International Convention for the Protection of New Varieties of Plants (UPOV)?

Yes.

9. If the answer to question 8 is "yes", please specify the Act of the UPOV Convention upon which your legislation is based (i.e., the 1991 Act, the 1978 Act or the 1961/1972 Act).

The Law is based on the 1991 Act.

10. If sui generis protection for plant varieties is provided in your territory, would any of the following acts require the prior authorization of the right holder:

(a) acts performed for research or experimental purpose, or to develop new varieties of plants;

Acts performed for research or experimental purposes including breeding a new variety *do not require* the prior authorization of the right holder.

(b) acts performed to commercially exploit a variety distinct from the protected variety but sharing its essential characteristics;

Acts performed to commercially exploit a variety which falls under the following conditions *require* the prior authorization of the right holder;

(i) The variety was bred from an initial variety, while retaining the essential characteristics of the initial variety, by selection of variation, backcrossing, transformation by genetic engineering, etc.

(ii) The variety is clearly distinguishable from the initial variety in terms of characteristics.

(iii) The initial variety is a protected variety and is not a variety which falls under the conditions (i) and (ii).

(c) acts performed by a farmer of harvesting seed from his planting of a protected variety legitimately obtained, storage of that seed, and replanting of that seed on the farmer's land.

Where farmers legitimately obtain the seeds and seedlings of the protected variety, produce the product of the harvest by using the said seeds and seedlings, except for which belong to a plant genus or species which is propagated vegetatively and is stipulated by the Ordinance of the Ministry of Agriculture, Forestry and Fisheries, and further use the said product of harvest as the seeds and seedlings on their own holdings, *the effects of the breeder's right shall not extend to the seeds and*

seedlings and the harvested materials obtained from them, except as otherwise prescribed by a contract.

If prior authorization is not required for any of the above examples of activities, is there any requirement that the party undertaking the specified actions provide the right holder with remuneration in any form?

No.

11. Can protection be obtained for a plant variety that was known to the public, or was publicly available, prior to the application for sui generis protection for that plant variety, and, if so, under what conditions (i.e., what are the time limits during which public disclosure or availability will not preclude the grant of protection)?

A plant variety may not be protected when it is not clearly distinguishable in terms of charecteristics from any other varieties which have been publicly known in Japan or foreign countries before the filing of the application for variety registration.

A plant variety may not be protected when the seeds and seedlings or harvested materials of the applied variety have been transferred in the course of business, in Japan earlier than one year before the filing date of such an application for protection, or in foreign countries earlier than four years before the filing date of such an application for protection (or earlier than six years in the case of a variety belonging to perennial plants such as trees). However, this shall not apply where such transfer was made for the purpose of experiment or research, or where such transfer was made against the will of the breeder.

12. Can protection be predicated on identification of an unexpressed gene, on an unexpressed set of genes present in the genome of the plant variety, or on the characteristics of germplasm, rather than the expressed characteristics of plant varieties derived from such genes or germplasm?

No.

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