EU – JAPAN EPA

“Intellectual Property Rights”

This presentation has been prepared with the sole purpose of simplifying the understanding of some parts of the EU-Japan EPA and bears no legal standing.
About the speaker

• Almost 20 years in the innovation ecosystem (EU, USA, Japan)
• Worked for unis, companies, consulting firms, etc.
• Mentoring startups/students
• Project Manager at the EU-Japan Centre for Industrial Cooperation running the EU-Japan Technology Transfer Helpdesk (www.eu-jp-tthelpdesk.eu)
Although European firms already have access to the Japanese IP ecosystem by also having the opportunity to protect and enforce their IPRs, the EU-Japan EPA provides additional *ad hoc* provisions on:

- Geographical indications
- Copyright
- Trademarks
- Industrial Design
- Trade secrets
- Rules for patent term extension
- Rules for regulatory test data protection for pharmaceuticals
- Regulatory test data protection for plant protection products
- Enforcement
1. In order to facilitate the production and commercialization of innovative and creative products and the provision of services between the Parties and to increase the benefits from trade and investment, the Parties shall grant and ensure adequate, effective and non-discriminatory protection of intellectual property and provide for measures for the enforcement of intellectual property rights against infringement thereof, including counterfeiting and piracy, in accordance with the provisions of this Chapter and of the international agreements to which both Parties are party.
2. A Party may, but shall not be obliged to, provide more extensive protection for, or enforcement of, intellectual property rights under its law than is required by this Chapter, provided that such protection or enforcement does not contravene the provisions of this Chapter.
3. For the purposes of this Chapter, "intellectual property" means all categories of intellectual property that are covered by Articles 14.8 to 14.39 of this Chapter or Sections 1 to 7 of Part II of the TRIPS Agreement. The protection of intellectual property includes protection against unfair competition as referred to in Article 10bis of the Paris Convention for the Protection of Industrial Property, done at Paris on 20 March 1883 (hereinafter referred to as "the Paris Convention").

4. The objectives and principles set out in Part I of the TRIPS Agreement, in particular in Articles 7 and 8, shall apply to this Chapter, mutatis mutandis.
Article 14.2 - Agreed principles

Having regard to the underlying public policy objectives of domestic systems, the Parties recognise the need to:

(a) **promote innovation** and **creativity**;

(b) **facilitate the diffusion of information, knowledge, technology**, culture and the arts; and

(c) **foster competition** and open and efficient markets,

through their respective intellectual property systems, while respecting the principles of, inter alia, **transparency** and **non-discrimination**, and taking into account the interests of relevant stakeholders including right holders and users.
Article 14.4 - National treatment

1. In respect of all categories of intellectual property covered by this Chapter, each Party shall accord to nationals of the other Party treatment no less favourable than the treatment it accords to its own nationals with regard to the protection of intellectual property subject to the exceptions already provided for in, respectively, the Paris Convention, the Berne Convention, the Rome Convention and the Treaty on Intellectual Property in Respect of Integrated Circuits, adopted at Washington on 26 May 1989. In respect of performers, producers of phonograms and broadcasting organisations, this obligation only applies in respect of the rights provided for under this Agreement.
Article 14.5 - Most-favoured-nation treatment

Each Party shall immediately and unconditionally accord to nationals of the other Party treatment no less favorable than the treatment it accords to the nationals of a third country with regard to the protection of intellectual property, subject to the exceptions provided for in Articles 4 and 5 of the TRIPS Agreement.
Article 14.7 - Promotion of public awareness concerning protection of intellectual property

Each Party shall take necessary measures to continue promoting public awareness of protection of intellectual property including educational and dissemination projects on the use of intellectual property as well as on the enforcement of intellectual property rights.
Rights for:
- Authors
- Performers
- Producers of phonograms
- Broadcasting organizations
1. The term of protection for rights of an author of a literary or artistic work within the meaning of Article 2 of the Berne Convention shall run for the life of the author and for 70 years after the author's death, irrespective of the date when the work is lawfully made available to the public. If the term of protection for those rights is counted on a basis other than the life of a natural person, such term shall be no less than 70 years after the work is lawfully made available to the public. Failing such making available within 70 years after the creation of the work, the term of protection shall be no less than 70 years from the work's creation.
2. The term of protection for rights of performers shall be no less than 50 years after the performance.

3. The term of protection for rights of producers of phonograms shall be no less than 70 years after the phonogram was published. Failing such publication within at least 50 years from the fixation of the phonogram, the term of protection shall be no less than 50 years after the fixation was made.
Article 14.18 - Rights conferred by a trademark

Each Party shall ensure that the owner of a registered trademark has the exclusive right to prevent all third parties not having the owner's consent from using in the course of trade identical or similar signs for goods or services which are identical or similar to those in respect of which the trademark is registered, where such use would result in a likelihood of confusion. In the case of the use of an identical sign for identical goods or services, a likelihood of confusion shall be presumed. The rights described above shall not prejudice any existing prior rights nor shall they affect the possibility of a Party to make rights available on the basis of use.
Article 14.20 - Preparatory acts deemed as infringement

With regard to labels and packaging, each Party shall provide that at least each of the following preparatory acts are deemed as an infringement of a registered trademark if the act has been performed without the consent of the registered trademark owner:

(a) the manufacture;
(b) the importation; and
(c) the presentation

of labels or packaging bearing a sign which is identical or similar to the registered trademark, for the purpose of using such sign or causing it to be used in the course of trade for goods or services which are identical or similar to those in respect of which the trademark is registered.
1. This Sub-Section applies to the recognition and protection of geographical indications for wines, spirits and other alcoholic beverages as well as agricultural products which originate in the Parties.

2. For the purposes of this Chapter, "geographical indications" means indications which identify a good as originating in the territory of a Party, or a region or locality in that Party's territory, where a given quality, reputation or other characteristic of the good is essentially attributable to its geographical origin.
Article 14.22 (GIs) - Scope

3. Geographical indications of a Party listed in Annex 14-B shall be protected by the other Party under this Agreement if they fall within the types of goods that the other Party protects in accordance with its laws and regulations as listed in Annex 14-A.
1. Each Party shall establish or maintain a system for the registration and protection of geographical indications in its territory.

2. The system referred to in paragraph 1 shall contain at least the following elements:

   (a) *an official means* to make available to the public the list of registered geographical indications;
Article 14.23 - System of protection of geographical indications

(b) an **administrative process** to verify that a geographical indication to be registered as referred to in subparagraph (a) **identifies** a good as originating in the territory of a Party, or a region or locality in that Party's territory, where a given quality, reputation or other characteristic of the good is essentially attributable to its geographical origin;

(c) an **opposition procedure** that allows the legitimate interests of third parties to be taken into account; and

(d) a procedure for the **cancellation** of the protection of a geographical indication, taking into account the legitimate interests of third parties and the users of the registered geographical indications in question.
Omissis

5. Notwithstanding the specifications of geographical indication referred to in subparagraph 1(a), for a period of seven years from the date of entry into force of this Agreement, the protection provided for under this Sub-Section for a particular geographical indication of the European Union as listed in Annex 14-B shall not preclude, with regard to the good identified with such geographical indication, the possibility that operations comprised of grating, slicing and packaging, including cutting into portions and inner packaging, could be carried out within the territory of Japan, provided that such good is destined for the Japanese market and not for the purpose of re-exportation.
Article 14.27 - Relationship with trademarks

1. If a geographical indication is protected under this Sub-Section, each Party shall refuse to register a trademark the use of which would be likely to mislead as to the quality of the good, provided that an application to register the trademark is submitted after the applicable date for protection of the geographical indication in the territory concerned as referred to in paragraphs 2 and 3. Trademarks registered in breach of this paragraph shall be invalidated.

Omissis

4. The Parties acknowledge that the existence of a prior conflicting trademark in a Party would not completely preclude the protection under this Agreement of a subsequent geographical indication for like goods in that Party.
5. If a **trademark** has been **applied for** or **registered in good faith**, or if rights to a trademark have been acquired **through use** in good faith, in a Party, before a geographical indication is protected under this Agreement in that Party, measures adopted to implement this Sub-Section shall not prejudice the **eligibility** for or the **validity of the registration of the trademark**, or the right to use the trademark, on the basis that such a trademark is **identical** with, or **similar** to, the geographical indication.
1. The Parties agree on the possibility to amend the lists of geographical indications in Annex 14-B in accordance with paragraphs 3 and 4 of Article 14.53 after having completed the opposition procedure and after having examined the geographical indications as referred to in Article 14.24 to the satisfaction of both Parties.
1. Each Party shall provide for the protection of independently created **industrial designs** that are **new** and **original**, including designs of a **part of a product**, regardless of whether or not the part can be **separated from the product**. This protection shall be provided by registration and shall confer an exclusive right upon their holders in accordance with the provisions of this Article.

*Omissis*

5. Each Party shall ensure that an owner of a protected industrial design has **at least** the right to prevent third parties not having the owner's consent from **making, selling, importing or exporting** articles bearing or embodying a design which is **identical** or **similar** to the protected design, when such act is undertaken for **commercial purposes**.
6. Each Party shall provide that an applicant for an industrial design registration may request the competent authority to maintain the design unpublished for a period designated by the applicant not exceeding the period provided for in its laws and regulations.

7. Each Party shall ensure that the total term of protection available for industrial designs is no less than 20 years.
Article 14.32 - Unregistered appearance of products

1. The Parties recognise that the appearance of products may be protected through industrial designs, copyright or unfair competition prevention legislation.

2. Each Party shall provide legal means to prevent the use of the unregistered appearance of a product, if such use results from copying the unregistered appearance of the product to the extent provided by its laws and regulations. Such use shall at least cover offering for sale, putting on the market, importing or exporting the product.

3. The duration of protection available for the unregistered appearance of a product shall amount to at least three years according to the respective laws and regulations of the Parties.
1. Each Party shall ensure that a patent confers on its owner exclusive rights:

(a) where the **subject matter** of a patent is a **product**, to prevent third parties not having the owner's consent from **making, using, offering for sale, selling or importing** for these purposes that product; and

(b) where the subject matter of a patent is a **process**, to prevent third parties not having the owner's consent from **using the process, and from using, offering for sale, selling or importing** for these purposes at least the product obtained directly by that process.
Omissis

3. The Parties recognise the importance of providing a unitary patent protection system including a unitary judicial system in their respective territory.

4. The Parties shall continue to cooperate to enhance international substantive patent law harmonisation, inter alia on grace period, prior user rights and publication of pending patent applications.

Omissis
Article 14.35 – Extension of the period of protection

With respect to the patents which are granted for inventions related to **pharmaceutical products** or **agricultural chemical products**, each Party shall, subject to the terms and conditions of its applicable laws and regulations, provide for a **compensatory term of protection** for a period during which a patented invention cannot be worked due to **marketing approval process**. As of the date of signing of this Agreement, the **maximum** compensatory term is stipulated as being **five years** by the relevant laws and regulations of each Party.
Article 14.36 - Scope of protection of trade secrets

1. Each Party shall ensure in its laws and regulations adequate and effective protection of trade secrets in accordance with paragraph 2 of Article 39 of the TRIPS Agreement.

2. For the purposes of this Article and Sub-Section 3 of Section C:
   (a) "trade secret" means information that:
      (i) is secret in the sense that it is not, as a body or in the precise configuration and assembly of its components, generally known among or readily accessible to persons within the circles that normally deal with the kind of information in question;
      (ii) has commercial value because it is secret; and
      (iii) has been subject to reasonable steps under the circumstances, by the person lawfully in control of the information, to keep it secret; and
   (b) "trade secret holder" means any person lawfully in control of a trade secret.

Omissis
1. Each Party shall **prevent** applicants for **marketing approval for pharmaceutical products** which utilise **new** active pharmaceutical ingredients **from relying on or referring to undisclosed test or other data submitted to its competent authority** by the first applicant for a certain period of time counted from the **date of approval of that application**. As of the date of entry into force of this Agreement, such period of time is stipulated as being **no less than six years** by the relevant laws and regulations of each Party.
2. If a Party requires as a condition for approving the marketing of agricultural chemical products which utilise new chemical entities, the submission of undisclosed test or other data, the origination of which involves a considerable effort, that Party shall ensure that, in accordance with its relevant laws and regulations, applicants for marketing approval are either:

(a) prevented from relying on or referring to such data submitted to its competent authority by the first applicant for a period of at least 10 years counted from the date of approval of that application; or

(b) generally required to submit a full set of test data, even in cases where there was a prior application for the same product, for a period of at least 10 years, counted from the date of approval of a prior application.
1. The Parties affirm their commitments under the TRIPS Agreement and in particular Part III thereof. Each Party shall provide for the following complementary measures, procedures and remedies necessary to ensure the enforcement of intellectual property rights. The measures, procedures and remedies shall be fair and equitable, and shall not be unnecessarily complicated or costly, or entail unreasonable time-limits or unwarranted delays.
Article 14.51 - Enforcement – border measures

1. With respect to goods imported or exported, each Party shall adopt or maintain procedures under which a right holder may submit applications requesting its customs authority to suspend the release of or detain goods suspected of infringing trademarks, copyrights and related rights, geographical indications, patents, utility models, industrial designs, and plant variety rights (hereinafter referred to in this Article as "suspect goods") in its customs territory.

Omissis
1. The Parties, recognizing the growing importance of the protection of intellectual property in further promoting trade and investment between them, shall cooperate on intellectual property, including by exchange information on relations of a Party with third countries on matters concerning intellectual property, in accordance with their respective laws and regulations and subject to their available resources.

2. For the purpose of paragraph 1, cooperation may include exchange of information, sharing of experiences and skills and any other form of cooperation or activities as may be agreed between the Parties. Such cooperation may cover areas such as:

(a) developments in domestic and international intellectual property policy;
Article 14.52 - Cooperation

(b) intellectual property administration and registration systems;
(c) **education and awareness** relating to intellectual property;
(d) intellectual property issues relevant to:
   (i) **small and medium-sized enterprises**;
   (ii) science, technology and innovation activities; and
   (iii) **the generation, transfer and dissemination of technology**;
(e) policies involving the use of intellectual property for research, innovation and economic growth;
(f) the implementation of multilateral intellectual property agreements, such as those concluded or administered under the auspices of the WIPO;
(g) technical assistance for developing countries;

(h) best practices, projects and programmes related to the fight against infringements of intellectual property rights; and

(i) exploration of the possibility for further work on common efforts against infringements of intellectual property rights worldwide.

3. The Parties shall seek to cooperate with regard to activities for improving the international intellectual property regulatory framework, including by encouraging further ratification of existing international agreements and by fostering international harmonisation, administration and enforcement of intellectual property rights and on activities in international organisations including the WTO and the WIPO.
Article 14.53 - Committee on Intellectual Property

1. The **Committee on Intellectual Property** established pursuant to Article 22.3 (hereinafter referred to in this Article as "the Committee") shall be responsible for the effective implementation and operation of this Chapter.

2. The Committee shall have the **following functions:**
   (a) **reviewing** and **monitoring** the implementation and **operation** of this Chapter;

   (b) **exchanging information on legislative and policy developments on geographical indications** and on any other matter of mutual interest in the area of geographical indications, including any matter arising from applicable requirements of specifications of geographical indications listed in Annex 14-B with respect to their protection under this Agreement;
(c) discussing any issues related to intellectual property with a view to *enhancing protection* of intellectual property and *enforcement of intellectual property rights* and to *promoting* efficient and transparent administration of intellectual property systems;

(d) *reporting its findings* and the outcomes of its discussions to the *Joint Committee*; and

(e) carrying out other functions as may be delegated by the Joint Committee pursuant to subparagraph 5(b) of Article 22.1.
3. The Committee shall make **recommendations** to the Joint Committee **on amendments** to Annex 14-A and Annex 14-B on request of a Party.


5. The Committee may invite representatives of relevant entities other than the Parties, including from the private sector, with the necessary expertise relevant to the issues to be discussed.
<table>
<thead>
<tr>
<th>Topic</th>
<th>EPA provision</th>
<th>Benefit/current situation</th>
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<tbody>
<tr>
<td><strong>Trade secrets</strong></td>
<td>General harmonization of trade secret definition</td>
<td>Companies will know that within the two territories the definition of trade secret, and its protection/enforceability shall be basically the same. This kind of standard is already provided for in Japan</td>
</tr>
<tr>
<td><strong>Patent extension</strong></td>
<td>Common rules for patent extension (duration, definition, etc.) for pharma &amp; plant protection</td>
<td>In Japan this term is now up to 5 years</td>
</tr>
<tr>
<td><strong>Test data in the pharma and plant protection</strong></td>
<td>Common rules for test data for pharma &amp; plant protection</td>
<td>In Japan this term is 8 years (as a result of pharma-related procedures) and 15 years for agricultural chemical products</td>
</tr>
<tr>
<td><strong>Copyright</strong></td>
<td>Duration of 70 years after author’s death</td>
<td>Already in force in Japan from 30 December 2018 (because of the “Comprehensive and Progressive Agreement for Trans-Pacific Partnership”)</td>
</tr>
<tr>
<td><strong>Trademarks</strong></td>
<td>Specific provisions on trademarks, and product appearance protectable as unregistered design or through unfair competition rules</td>
<td>Same standard of protection already offered by Japanese unfair competition law</td>
</tr>
<tr>
<td><strong>Respect of other international treatises</strong></td>
<td>TRIPS, Berne, etc.</td>
<td>Generally applicable</td>
</tr>
<tr>
<td><strong>Enforcement</strong></td>
<td>Minimum civil enforcement provisions (for damages, etc.)</td>
<td>Almost everything is already provided for in the existing relevant provisions in Japan</td>
</tr>
<tr>
<td><strong>Promotion of IP awareness</strong></td>
<td>Engagement of both parties to promote</td>
<td>Yes, Japan is basically party to all of the major IP-related agreements administered by WIPO.</td>
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INFORMATION SOURCES

EU-related Links

- The complete text of the EPA, and Annexes can be found on the following website of the European Commission: http://trade.ec.europa.eu/doclib/press/index.cfm?id=1684


- Factsheet about GIs: https://www.eubusinessinjapan.eu/library/publication/factsheet-epa-geographical-indications

- Other sources related to the EPA and IPRs (guidelines, and webinar): https://www.eubusinessinjapan.eu/issues/economic-partnership-agreement/epa-ipr


INFORMATION SOURCES

Japan-related Links


- Ministry of Agriculture, Forestry, and Fisheries (geographical indications database) http://www.maff.go.jp/e/index.html


- EU-Japan Centre for Industrial Cooperation: https://www.eu-japan.eu

- EU-Japan Technology Transfer helpdesk: http://www.eu-jp-tthelpdesk.eu
Thank you for your attention

LUCA ESCOFFIER

Questions ?

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