

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
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Table of Contents

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

Article 14.1 - Initial Provisions

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.

Article 14.1 - Initial Provisions

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.

Article 14.1 - Initial Provisions

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.

SUB-SECTION 1 - Copyright and related rights

Rights for:

- Authors
- Performers
- Producers of phonograms
- Broadcasting organizations

Article 14.13 - Term of protection

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**.

Article - 14.13 Term of protection

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.

Article 14.22 (GIs) - Scope

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.**

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.

Article 14.23 - System of protection of geographical indications

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.

Article 14.23 - System of protection of geographical indications

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.

Article 14.27 - Relationship with trademarks

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.

Article 14.31 - Industrial designs

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.

Article 14.31 - Industrial designs

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**.

Article 14.31 - Industrial designs

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.

Article 14.33 - Patents

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

Article 14.37 - Treatment of test data in marketing approval procedure

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.

Article 14.37 - Treatment of test data in marketing approval procedure

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.

Article 14.37 - Treatment of test data in marketing approval procedure

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

Article 14.52 - Cooperation

1. The Parties, **recognising 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;



Article 14.52 - Cooperation

- (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;

Article 14.53 - Committee on Intellectual Property

- (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.

Article 14.53 - Committee on Intellectual Property

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.
4. Each Party shall examine any request of the other Party concerning the amendment of Annex 14-B, in accordance with Article 14.30.
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.

Synopsis of selected topics

Topic	EPA provision	Benefit/current situation
Trade secrets	General harmonization of trade secret definition	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
Patent extension	Common rules for patent extension (duration, definition, etc.) for pharma & plant protection	In Japan this term is now up to 5 years
Test data in the pharma and plant protection	Common rules for test data for pharma & plant protection	In Japan this term is 8 years (as a result of pharma-related procedures) and 15 years for agricultural chemical products
Copyright	Duration of 70 years after author's death	Already in force in Japan from 30 December 2018 (because of the "Comprehensive and Progressive Agreement for Trans-Pacific Partnership")
Trademarks	Specific provisions on trademarks, and product appearance protectable as unregistered design or through unfair competition rules	Same standard of protection already offered by Japanese unfair competition law
Respect of other international treaties	TRIPS, Berne, etc.	Generally applicable
Enforcement	Minimum civil enforcement provisions (for damages, etc.)	Almost everything is already provided for in the existing relevant provisions in Japan
Promotion of IP awareness	Engagement of both parties to promote	Yes, Japan is basically party to all of the major IP-related agreements administered by WIPO.

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>
- General page on the Agreement including factsheets, statistics, reports:
<http://ec.europa.eu/trade/policy/in-focus/eu-japan-economic-partnership-agreement/>
- Factsheets about the Agreement: <http://trade.ec.europa.eu/doclib/press/index.cfm?id=1697>
- 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>
- Official page of REX (Registered Exporter system):
https://ec.europa.eu/taxation_customs/business/calculation-customs-duties/rules-origin/general-aspects-preferential-origin/arrangements-list/generalised-system-preferences/the_register_exporter_system_en
- EU database of geographical indications: <https://ec.europa.eu/info/food-farming-fisheries/food-safety-and-quality/certification/quality-labels/geographical-indications-register/>

Japan-related Links

- Ministry of Foreign Affairs website (in Japanese, more updated):
https://www.mofa.go.jp/mofaj/gaiko/page6_000042.html
- Ministry of Foreign Affairs website (general page on the EPA):
https://www.mofa.go.jp/policy/economy/page6e_000013.html
- Ministry of Foreign Affairs website (page on SMEs):
https://www.mofa.go.jp/ecm/ie/page23e_000546.html
- Ministry of Economy Trade and Investment:
https://www.meti.go.jp/english/policy/external_economy/trade/FTA_EPA/index.html#eu
- Ministry of Agriculture, Forestry, and Fisheries (geographical indications database)
<http://www.maff.go.jp/e/index.html>
- Japan Patent office: <https://www.jpo.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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