

Japan Patent & Trademark Update



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1. Protection of a Brand Name Consisting of the Designer's Name



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Introduction

When a fashion designer uses his or her own name as a brand name, it is extremely challenging to register such brand name as a trademark in today's Japan. The Trademark Act lists "a trademark that contains the portrait of another person, or the name, famous pseudonym, professional name or pen name of another person, or famous abbreviation thereof (except those the registration

of which has been approved by the person concerned)" as one of the types of trademarks that cannot be registered (Article 4(1)(viii)). The purpose of this provision is to protect the personal interests of others in relation to their names, etc. (Supreme Court, No. 2003 (Gyo-hi) 265), and to protect the interests of others from having their names, etc. used as trademarks without their consent (Supreme Court, No. 2004 (Gyo-hi) 343).

Examination Practice

When examining an application for a trademark that contains the name of a natural person, the Japan Patent Office ("JPO") searches for that name in telephone directories published across Japan as well as on the Internet. If the search results show only one individual with that name, the JPO requires the applicant to submit evidence that such individual has agreed to allow the applicant to register the trademark containing his or her name in Japan. On the other hand, if the search results show that there are two or more individuals whose name is contained in the composition of the applied-for mark, the applicant will not be able to register the trademark unless it submits documents to the JPO proving that all of the other individuals have agreed to the registration of the trademark containing their own name.

Issues in the Examination at the JPO

Under the examination practice as described above, a trademark containing a rare name is more likely to be registered, while a trademark containing a common name faces difficulties in achieving registration, even if the applicant is a natural person who has that name. Even if the JPO cites two or more individuals who have the name contained in the applied-for mark from telephone directories, the applicant could overcome such citation by submitting a letter of consent signed by each

cited individual. However, obtaining the consent of all individuals in Japan who have the same name is not practical as it requires a great deal of effort on the part of the applicant. Traditionally, the JPO had been more flexible in determining whether or not a trademark containing the name of a natural person falls under Article 4(1)(viii) of the Trademark Act, taking into account the degree of well-known status of the name pertaining to a particular person or assuming that the issues can be resolved through opposition and/or invalidation proceedings after the trademark rights have been granted.

However, in recent years, an increasing number of individuals, such as fashion designers or corporate founders, have applied for their own names as trademarks, and many of these applications have been rejected by the JPO on the grounds that they fall under Article 4(1)(viii) of the Trademark Act. Particularly for the fashion industry, where the designer's full name is often used as the brand name, it is of great concern that as long as the current examination practice is in place, they will not be able to properly protect their own brand under the Trademark Act.

Court Decisions

Since 2019, the Intellectual Property High Court (the "IPHC") has issued some pertinent decisions on the registrability of trademarks that contain the names of natural persons in their composition.

(1) "KENKIKUCHI" (IPHC, No. 2019 (Gyo-ke) 10037)

In 2019, the IPHC rendered a decision supporting the JPO's appeal decision that the application for the following trademark filed by jewelry designer Ken Kikuchi fell under Article 4(1)(viii) of the Trademark Act because the applied-for mark contained "another person's name," "KEN KIKUCHI" (IPHC, No. 2019 (Gyo-ke) 10037).



App. No. 2017-069467

In the decision, the IPHC stated that: (i) the "KENKIKUCHI" portion of the applied-for mark could be objectively understood as the name of a person which reads as "KIKUCHI (last name) KEN (first name)"; (ii) this name was not limited to the name of the plaintiff; and (iii) even if the applied-for mark had a certain degree of fame as the logo of the plaintiff's brand "KENKIKUCHI," such fact did not affect the above finding. The IPHC also stated that, given the purpose of Article 4(1)(viii) of the Trademark Act and

its wording, it is difficult to understand that the "name of another person" in the said item is limited to those that are famous or rare, and that, as long as the applied-for mark contains the "name of another person," it is not necessary to consider the well-known status of the mark.

(2) "TAKAHIROMIYASHITATheSoloist." (IPHC, No. 2020 (Gyo-ke) 10006)

The IPHC rendered another decision in 2020 supporting the JPO's appeal decision that the application for "TAKAHIROMIYASHITATheSoloist." in standard characters filed by K.K. Soloist, which is represented by fashion designer Takahiro Miyashita, fell under Article 4(1)(viii) of the Trademark Act (IPHC, No. 2020 (Gyo-ke) 10006).

TAKAHIROMIYASHITATheSoloist.

App. No. 2017-126259

In its decision, the IPHC confirmed that the letters "TAKAHIROMIYASHITA" in the composition of the applied-for mark could be recognized as the name of a person which reads as "MIYASHITA (last name) TAKAHIRO (first name)" and that the applied-for mark therefore contained the "name of a person." In response to the plaintiff's objection that: (i) there would be differences in the registrability of a trademark depending on factors beyond the applicant's control, such as the existence of others who have the same name as that contained in the composition of the trademark; and (ii) unless the name is quite rare, it may be virtually impossible to register a trademark containing the name of a natural person, especially in the case where a trademark contains a Romanized name of a natural person, as the applicant needs to obtain consent from many others owning the name pronounced the same, the IPHC stated that under Article 4(1)(viii) of the Trademark Act, it is expected that what is described in (i) and (ii) above will occur to a certain extent, and that this cannot be immediately said to be unfair or contrary to the purpose of Article 1 of the Trademark Act (i.e. contribution to the development of the industry and protection of the interests of consumers).

The IPHC also stated that since Article 4(1)(viii) of the Trademark Act does not require actual or possible infringement of personal interests, it cannot be interpreted that a well-known brand that does not remind others of the same name does not fall under this item just because there is no risk of damage to personal interests.

(3) "MATSUMOTOKIYOSHI" (Sound Trademark) (IPHC, No. 2020 (Gyo-ke) 10126)

In its decision issued on August 30, 2021, the IPHC overturned the JPO's appeal decision that the application for "MATSUMOTOKIYOSHI" (Sound Trademark) filed by Matsumotokiyoshi Holdings Co., Ltd. fell under Article 4(1)(viii) of the Trademark Act (IPHC, No. 2020 (Gyo-ke) 10126).



In its decision, the IPHC confirmed that: (i) the indication of "マツモトキヨシ" (MATSUMOTOKIYOSHI in katakana) was famous throughout Japan as the name of a drugstore, etc.; and (ii) the sound identical or similar to the applied-for mark, including the linguistic element "MATSUMOTOKIYOSHI," has been used in TV commercials, etc., and as a result, it has become widely known as a phrase in the commercial song of the "MATSUMOTOKIYOSHI" drugstore. Based on the above, the IPHC stated that consumers who come into contact with the applied-for mark would easily associate the sound which consists of the linguistic elements, "MATSUMOTOKIYOSHI," with the name of the drugstore, and not with a person's name, and concluded that the applied-for mark did not constitute a trademark that includes the "name of another person" as specified in Article 4(1)(viii) of the Trademark Act.

Conclusion

In its most recent decision on the registrability of a trademark that includes the name of a natural person in its composition, the IPHC stated, unlike in its previous two decisions, that the purpose of Article 4(1)(viii) of the Trademark Act is to reconcile the applicant's interest in obtaining trademark registration with the personal interest pertaining to another person's name and held that if the applied-for mark is well known to the extent that it does not associate with a person's name, it does not fall under Article 4(1)(viii) of the Trademark Act. In view of this recent decision, it will be interesting to see how the IPHC, as well as the JPO, will determine the registrability of a trademark containing the name of a natural person, for example, a mark containing the name of a person who is not so well known among consumers. Considering the fact that a large number of trademarks containing designers' names are already used, in particular in the fashion industry, it will be necessary to interpret Article 4(1)(viii) of the Trademark Act in a direction that places more importance on the applicant's interest in obtaining trademark registration.

2. Handling of Applications with Artificial Intelligence (AI) as an Inventor



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Introduction

On July 30, 2021, a notice entitled "Regarding the Indication of Inventors" was posted on the Japan Patent Office ("JPO") website. In this notice, the JPO has stated that "The indication of inventors is considered to be limited to natural persons, and it is not permitted to indicate a statement wherein an entity other than a natural person is indicated in the inventor column in the application form, for example, a machine including artificial intelligence (AI) as an inventor."

Background to this Notice

A PCT application involving an AI called DABUS (Device for the Autonomous Bootstrapping of Unified Sentience) as the inventor (International Publication No. WO 2020/079499 as shown on the next page) has entered the national phase in various countries, and national phase applications are currently being examined. The United States Patent and Trademark Office (USPTO), the UK Patent Office (UKIPO) and the European Patent Office (EPO) have so far issued decisions stating that DABUS cannot be an inventor. On the other hand, in South Africa, a patent recognizing DABUS as an inventor was registered in July 2021. In Australia, after the Australian Patent Office determined that AI cannot be an inventor, the Federal Court of Australia determined that AI can be named as an inventor on a patent application. This application has also been filed in Japan, and attention has been focused on how the JPO will judge such matter. The July 30 notice appears to have been posted against this background.

Determination of Inventors in Japan

The Japanese Patent Act provides that an inventor has the right to obtain a patent (Article 29 (1) first paragraph), but there is no explicit provision as to what constitutes an inventor. Practitioners have been of the opinion that an applicant was allowed to be an entity other than a natural person, such as a juridical person, while the inventor should be

limited to a natural person. The JPO's July 30 notice is consistent with such thoughts and although there is no explicit provision defining inventors in the Japanese Patent Act, the JPO has expressed its official opinion that the indication of inventors is limited to natural persons and that a machine including AI, etc. is not permitted to be described as an inventor. In the same notice, the JPO analyzed the consistency of interpreting an inventor as a natural person by quoting the following article and concluded that "These provisions, which provide that an inventor is the entity having the right to obtain a patent upon completion of the invention and that an inventor having the right to obtain a patent may transfer the right before filing the application, presume that an inventor is a natural person as a person who has the capacity to hold rights and can be an applicant."

- An inventor of an invention that is industrially applicable may be entitled to obtain a patent for the said invention (Article 29 (1) first paragraph).
- The right to obtain a patent may be transferred (Article 33 (1)).
- The succession to the right to obtain a patent prior to the filing of the patent application shall have no effect on any third party unless the successor in title files the patent application (Article 34 (1)).



Expected Development of Patent Applications with DABUS as an Inventor in Japan

In cases where AI is indicated in the inventor column, an order for amendment will be notified to the applicant in the formality examination, on the ground that something other than a natural person is indicated as an inventor. The amendment order will require the submission of an amendment to correct the deficiency within a specified period. If the applicant corrects the inventor as a natural person by way of such amendment, the patent application will then comply with the formality requirements, but if AI is left as it is without correcting the inventor, the patent

application will be dismissed. At present, the history of patent applications in Japan with DABUS as an inventor has not been disclosed. However, in view of the abrupt notification regarding inventors from the JPO, an amendment order may have already been issued for patent applications with DABUS as an inventor. The issue is how will the applicant respond to this amendment order ... In the United States and the United Kingdom, where examinations are preceding, notifications equivalent to the amendment order in Japan have been issued. However, the applicant has proceeded with the examination without amending the inventor. Thus, even in Japan, it is expected that the applicant will not take procedures to amend the inventor in response to the amendment order, and the patent applications will be dismissed. Thereafter, if the applicant is dissatisfied with the dismissal of the application, the applicant will either file a request for review under the Administrative Appeals Act with the Commissioner of the JPO or institute an action against the State to dispute the inventorship of AI. However, it would be difficult to have AI recognized as an inventor under the current provisions of the Japanese Patent Act.

Conclusion

As mentioned above, the current situation in Japan is that an inventor is required to be a natural person, and it is not possible to obtain a patent with AI as an inventor. When trying to obtain a patent for an invention using AI in Japan, it is necessary to file an application with the natural persons involved in the invention as inventors, as in the case where AI is not used. Breakthroughs in AI technology have created a number of problems that will need to be resolved, including whether AI can be an inventor. However, there is no doubt that our lives will become further enriched through the appropriate utilization of advanced AI technologies. We are keen to continue assisting you to obtain patents in Japan for all of your creative inventions.

<p>(12) INTERNATIONAL APPLICATION PUBLISHED UNDER THE PATENT COOPERATION TREATY (PCT)</p> <p>(19) World Intellectual Property Organization International Bureau</p> <p>(43) International Publication Date 23 April 2020 (23.04.2020)</p>			 <p>(10) International Publication Number WO 2020/079499 A1</p>
<p>(51) International Patent Classification: <i>B65D 6/02</i> (2006.01) <i>B65D 21/02</i> (2006.01) <i>B65D 8/00</i> (2006.01) <i>B65D 1/02</i> (2006.01) <i>B65D 6/00</i> (2006.01) <i>A61M 16/00</i> (2006.01) <i>B65D 13/02</i> (2006.01) <i>A61M 21/00</i> (2006.01)</p>		<p>(71) Applicant: THALER, Stephen L. [US/US]; 1767 Waterfall Dr., St Charles, Missouri 63303 (US).</p>	
<p>(21) International Application Number: PCT/IB2019/057809</p>		<p>(72) Inventor: DABUS, The invention was autonomously generated by an artificial intelligence; 1767 Waterfall Dr., St Charles, Missouri 63303 (US).</p>	
		<p>(74) Agent: ABBOTT, Ryan; 11601 Wilshire Blvd #2080, Los Angel, CA 90024 (US).</p>	

3. Examples of Design Registrations under the Revised Design Act in Japan - Part 1-



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Introduction

One-and-a-half years have passed since the revised Design Act (the “Revised Act”) came into effect. Many applications for subject matter newly protected by the Revised Act (GUIs, buildings, and interior designs) have now been registered. In this article, we introduce an updated on the number of design applications and registrations as well as the entities which have registered designs for newly protected subject matter.

Number of Applications and Registrations

The Japan Patent Office (“JPO”) updated the number of design applications and registrations for subject matter newly protected under the Revised Act as October 1, 2021, as follows:

	GUIs	Buildings	Interiors
Number of design applications	1585	530	336
Number of design registrations	540	247	94

(Source: https://www.jpo.go.jp/system/design/gaiyo/seidogaiyo/document/isyou_kaisei_2019/shutsugan-jokyo.pdf)

Over the past years, the number of applications filed in Japan has increased at a steady pace. In particular, as the number of the applications for subject matter newly protected under the Revised Act has also been increased continuously by about 1,000 for GUIs, 300 for buildings, and 200 for interiors since the Revised Act came into effect, these applications obviously helped to support this trend. On the other hand, so far, the registrability of the applications for newly protected subject matter are a bit lower than average; about 35% for GUIs, about 40% for buildings, and about 30% for interiors.

Registrants of Newly Protected Articles

In this section, we discuss the types of entities that have registered designs for newly protected subject matter. The following tables show the top 10 entities in the number of design registrations for all newly protected subject matter. It is interesting to point out that most of the entities with a large number of design registrations for buildings and interiors are

domestic companies. While it may be because foreign entities are not simply interested in protection in these fields, it could also be true that foreign entities are not fully informed of the Revised Act. If that is the case, we and the JPO must be more proactive in informing foreign entities of the Revised Act.

[GUIs]

No.	Registrant	Number of Registrations	Nationality
1	Apple Inc.	46	US
2	MITSUBISHI ELECTRIC Corporation	40	JP
3	TKC Corporation	20	JP
4	TOSHIBA CORPORATION et al.	18	JP
5	Yahoo Japan Corporation	15	JP
6	Sony Interactive Entertainment	14	JP
7	micware Co., Ltd.	11	JP
8	East Japan Railway Company	10	JP
9	Google LLC	10	US
10	TOSHIBA TEC CORPORATION	10	JP

Apple has the most GUI registrations and is actively filing applications under the Revised Act. However, Apple and Google are the only foreign entities that have many GUI design registrations.

[Buildings]

No.	Registrant	Buildings	Houses	Bridges	TOTAL
1	Sekisui House, Ltd.	1	61		62
2	OBUYASHI CORPORATION	29			29
3	Daito Trust Construction Co., Ltd.		21		21
4	Asahi Kasei Homes Corporation		16		16
5	MISAWA HOMES CO., LTD.	4	7		11
6	Daiwa House Industry Co., Ltd.		8		8
7	NIPPON STEEL ENGINEERING CO., LTD.	2		5	7
8	SEKISUI CHEMICAL CO., LTD.		6		6
9	R.C.CORE CO., LTD.		5		5
10	Sumitomo Forestry Co., Ltd.		5		5

[Interiors]

No.	Registrant	Offices	Houses	Shops	TOTAL
1	Seiko Epson Corporation	13		1	14
2	Sinku Consulting Co.		10		10
3	Sekisui House, Ltd.		7		7
4	OKAMURA CORPORATION	7			7
5	ITOKI CORPORATION	5			5
6	Nitori Holdings Co., Ltd.			4	4
7	POLA Inc.			3	3
8	SOLEIL Co.			3	3
9	NTT DOCOMO, INC.			3	3
10	MITSUBISHI ESTATE CO., LTD.	3			3
11	TOSHIBA TEC CORPORATION	1		2	3
12	KOKUYO Co., Ltd.	3			3

No foreign entities can be found in the list of design registrations for buildings and interiors. The largest number of building registrations are related to housing, and companies that previously

registered their house designs as “PREFABRICATED HOUSES,” an article design under the act before the revision, have begun to register their house designs as “HOUSES,” a building design under the Revised Act.

Conclusion

The latest statistics released by the JPO clearly shows that design applications for newly protected subject matter are well received by the domestic companies, but not fully utilized by foreign users. In the next and subsequent issues, we will discuss examples of design registrations for newly protected subject matter to promote the understanding of foreign users of how to utilize the Revised Act.

Topics

Hiroshi Nemoto Spoke at Licensing Executives Society JAPAN’s Webinar

On September 29, **Hiroshi Nemoto**, a partner specialized in patent law, spoke at the virtually-hosted Monthly Seminar on “*Planning IP Due Diligence for M&A*” organized by Licensing Executives Society JAPAN (LES).

4. Update to the Doctrine of Equivalents in Japan



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Introduction

This article provides a general overview of the history of judicial decisions with respect to infringement under the Doctrine of Equivalents (“DOE”) in Japan and introduces recent practical operations thereof in lower courts.

Ball Spline Case¹ --- Dawn of the DOE

Like in many other countries, a patentee can enjoy protection under the DOE in Japan. More than 20 years have passed since the Supreme Court of Japan first recognized the theory of the DOE in the Ball Spline Case. The Supreme Court held that, where there is a part of an accused product/process that is different from a claimed element, patent infringement may still be established as an “equivalent” if the following requirements are satisfied: (i) the different part is not essential to

the patented invention; (ii) the purpose of the patented invention can be achieved and the same function and effect can be obtained if said part is replaced with the corresponding part of the accused product/process; (iii) a person having ordinary skill in the art (“PHOSITA”) could have easily conceived of the replacement at the time of the manufacture of the accused product or use of the accused process; (iv) the accused product/process was neither identical to prior art at the time the application for the patented invention was filed nor was it one that a PHOSITA could have easily conceived of at the time of said filing in light of the prior art; and (v) there are no special circumstances, such as the fact that the accused product/process was intentionally excluded from the scope of the claims during prosecution.

Since then, multiple lower courts throughout the country have adopted these rulings; however, it must be said that many courts have denied patentees’ assertions under the DOE due to lack of meeting the 1st and/or 5th requirement, which has been criticized in academic circles. Furthermore, practitioners and scholars have been split in the understanding of the 5th requirement, and there has been increased demand for definite criteria thereof.

Maxacalcitol Case^{2,3} --- Springtime for Patentees

The IP High Court (Grand Panel) and the Supreme Court responded to this issue in the Maxacalcitol Case and clarified the criteria for the 1st and 5th requirements as follows.

■ The “essential part” of the 1st Requirement

Regarding the 1st requirement, the IP High Court ruled that the essential part of a patented invention therein means a unique technical idea not seen in the prior art found based on the descriptions of the specification and claims, comparison to the prior art, and the degree of contribution thereof. More specifically, the IP High Court held that: (i) the essential part of a patented invention should be recognized based on the descriptions of the specification and the claims, especially from a comparison to the prior art described in the specification; and (ii) if the degree of contribution of the patented invention is evaluated as greater than that of the prior art, the essential part is recognized as being a superordinate concept, while if not, the essential part is instead recognized as being almost the same as the description of the claims. The IP High Court further ruled that (iii) if the problem described in the specification as a problem that could not be solved by the prior art is objectively insufficient in light of the prior art at the time of the application, the essential part of the patented invention that constitutes a unique technical idea not found in the prior art should be recognized in consideration of the prior art not described in the specification. In such a case, the essential part of the patented invention will be more closely related to the descriptions of the claims, and the

scope of the DOE will be narrower.

■ The “special circumstances” of the 5th Requirement

Regarding the 5th requirement, the Supreme Court basically upheld the ruling of the IP High Court, stating that “special circumstances” are not always found, even if an applicant did not include a structure that could have been easily conceived at the time of filing as substantially identical to the structure stated in the claims; provided, however, that, if it is “objectively and visibly clear” that the applicant indicated that the structure of the accused product is a substitute for the one described in the claims but intentionally did not describe it in the claims, a “special circumstance” will be found. These rulings are widely accepted and considered to greatly contribute to appropriate protection under the DOE.

Lower Court Operation after Maxacalcitol - Canyon Mind Co., Ltd. v. Shichida Educational Inst., Inc.⁴




The title of the patent-in-suit is “Learning tool, learning information presentation method, and learning information presentation system.” The specification states that this invention relates to a learning tool, etc., which enables users to unconsciously memorize the shape of a certain area (e.g. country, prefecture) or the pattern of a certain national flag, while having fun. The claimed invention has the following elements: (i) a medium on which a plurality of sets of image data consisting of (a) an original picture, (b) a first related image (*abstract painting*) having a corresponding phrase, and contours that are similar to the outline of or suggestive of the original picture, and (c) a second related image (*cartoon*) having contours that are similar to the outline of or suggestive of the original picture and the first related image and having a corresponding phrase, are recorded; (ii) image selection means for selecting one (1) set of image data from a plurality of sets of image data recorded on the medium (“Element B2”); and (iii) image display means for displaying the first related image, the second related image, and the original picture in that order using the selected set of image data, among others. The Osaka District Court found no literal infringement, as the accused products merely displayed all prefectures or each region in order and did not select and display individual prefectures, which did not meet Element B2.

Next, referring to the above Supreme Court rulings, the District Court found infringement under the DOE.









With regard to the 1st requirement, the court recognized the essential part in the structure of recording sets of image data and displaying the sets of image data in a given order, etc., not in selecting one (1) set of image data, by referring not only to the prior art described in the specification but also to prior art not described in the specification and concluded that the 1st requirement was satisfied.

With regard to the 5th requirement, the applicant deleted

the configuration of “displaying a set of images sequentially or altogether” and instead added Element B2. The court stated, however, that the applicant made such amendments mainly for the purpose of excluding the human aspects of the work in relation to the clarity requirement and concluded that it was not “objectively and visibly clear” that the patentee indicated that the said configuration should be excluded from the technical scope of the invention and thus there were no “special circumstances.”

cartoon	abstract painting	original picture
		
gigantic elephant's	broken nose	Kyoto prefecture

Patented invention

Prefecture	Illustration	Shape and illustration	Prefectural shape	Prefecture Location
Hokkaido	 "Hokka hoka" (meaning: warm)	 "Zo-dayo" (meaning: it's an elephant.)	 "Hokkaido"	 Hokkaido region
Aomori	 "Aomuke" (meaning: face up)	 "Mori-mori" (meaning: Muscular)	 "Aomori-ken"	 Aomori prefecture Tohoku-region

Accused Products

* Referenced from the judgment of the Osaka District Court, 25 March 2021, Heisei 31 (Wa) No.3273, and translated into English by TMI

Conclusion

The above lower court judgment can be viewed as a judgment on the “essential part” of the 1st requirement, taking into consideration prior art not described in the specification where “the prior art is objectively insufficient in light of the prior art at the time of the application,” as held by the Maxacalcitol Case. Moreover, this judgment can be referred to as a judgment on the “objectively and visibly clear” requirement of the 5th requirement. The Supreme Court rulings in the Ball Spline Case and Maxacalcitol Case have been widely accepted and used by lower courts. Now that not all claims are entitled to the same range of protection under the DOE, a pioneer invention that marks a significant step forward in the relevant art will be entitled to a broad range of protection under the DOE, while an invention mingling with the crowd will be limited to a narrow range of protection, if any. This will give appropriate protection to patentees. On the other hand, descriptions in specifications will become increasingly important, so practitioners of patent prosecution are required to be even more careful and cautious when drafting and amending specifications.

1 See Supreme Court, 24 February 1998, Heisei 6 (O) No. 1083.

2 See IP High Court (Grand Panel), 25 March 2016, Heisei 27 (Ne) No. 10014.

3 See Supreme Court, 24 March 2017, Heisei 28 (Ju) No. 1242.

4 See Osaka District Court, 25 March 2021, Heisei 31 (Wa) No. 3273.

5. About TMI

Since our establishment on October 1, 1990, TMI Associates has grown rapidly to become a full-service law firm that offers valuable and comprehensive legal services of the highest quality at all times. Among TMI's practice areas, intellectual property (IP) – including patents, designs and trademarks – has been a vital part of our firm from the beginning, and we boast an unrivaled level of experience and achievement in this area.

Organizational Structure of TMI

TMI, has a total of more than 1,000 employees worldwide, including over 620 IP/Legal professionals, comprised of 491 attorneys (Bengoshi), 85 patent/trademark attorneys (Benrishi), and 43 foreign law professionals.

Attorneys (Bengoshi)	491
Patent / Trademark Attorneys (Benrishi)	84
Foreign Law Counsels	8
Foreign Attorneys	37
Advisors	7
Management Officers	2
Patent Engineers, Staff	419
Total	1,048

(As of November 1, 2021)

Areas of Expertise

TMI's practice covers all aspects of IP, including patent/trademark prosecution, transactions (e.g., patent sales, acquisitions and licensing), litigation, invalidation trials, oppositions, due diligence activities and import suspension at Customs. TMI handles over 8,200 patent/trademark/design applications and over 20 IP lawsuits per year and TMI's patent team covers all technical fields, including electronics, computer software, telecommunications, semiconductors, chemicals, biotechnology, pharmaceuticals, and mechanical fields.

Electronics	27	Chemical	15
Mechanical	16	Bio, Pharma	5
Design	6	Trademark	21
overlap included			
IP Lawyers	80		

Awards

TMI and its attorneys-at-law/patent and trademark attorneys have been the proud recipients of prestigious awards every year. Here is a selected list of just some of the many awards and recognitions. In 2021, it is a great honor that TMI was ranked in *IAM Patent 1000* in the highest tier in all categories - patent prosecution, litigation and transactions!



TMI Associates



TMI Associates



Contact and Global Offices

If you have any questions or requests regarding our services, please contact our attorneys and patent attorneys who you regularly communicate with or use our representative address.

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