

Japan Patent & Trademark Update



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【Updated Manual】

- 42.400.01

[Handling of Examinations Concerning Exceptions to Another Person's Registered Trademark Applied for Prior to the Filing Date of the Trademark Application Concerned](#)

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[Handling of Materials Relating to Claims under Article 4\(4\) of the Trademark Act](#)

【Updated Guidelines】

- Chapter 19

[Article 4\(4\) \(Exceptions to another person's registered trademark applied for prior to the filing date of the trademark application concerned\)](#)

The Guidelines and Manual provide detailed explanations on the criteria for the Examiner to determine that there is no likelihood of confusion arising between the marks. Based on these criteria, the applicant is required to obtain consent from the owner of the cited trademark right, and then to argue and prove that there is no likelihood of confusion arising. The final decision is made by the Examiner on a case-by-case basis; however, the Guidelines and Manual present the following two types of cases; i.e., those where there is no likelihood of confusion arising, and those where there is a likelihood of confusion arising.

Group Company Relationship

The following is the case set forth in the Manual where there is, in principle, no likelihood of confusion arising.

[Manual 42.400.01](#)

3. Specific operations in determining “no likelihood of confusion” (4) Cases where the applicant and the holder of the cited trademark right have a certain relationship (e.g., parent-subsidiary company, sibling company, etc., so-called group company relationship)

If the owner of the cited trademark right and the applicant are objectively in a so-called group company relationship, such as a parent-subsidiary company, sibling company, etc., it is determined that, in principle, there is no likelihood of confusion.

This is an expansion of the scope of application of the

1. JPO Publishes Updated Trademark Examination Manual in Relation to “Letter of Consent” System



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Introduction

In August 2024, the Japan Patent Office (“JPO”) published an updated English version of [the Trademark Examination Manual](#) (“Manual”) regarding the examination of “Letters of Consent”. This updated Manual was published following the previously published English version of [the Examination Guidelines for Trademarks](#) (“Guidelines”) in relation to the examination of “Letters of Consent,” and together, these Guidelines and the Manual have clarified the criteria for the examination of “Letters of Consent” under the newly introduced Article 4 (4).

previous treatment ([Manual 42.111.03](#) *Handling of Cases where the Applicant and the Owner of a Cited Trademark Right have a Dominance Relationship*), which states that Article 4(1)(xi) does not apply when there is a controlling relationship between the applicant and the owner of the cited trademark. It is expected that the Letter of Consent system will now be able to be utilized even more frequently between these group companies than the previous treatment (“controlling relationship”) based on [Manual 42.111.03](#) which has already been used for over 770 trademark applications since 2017.

Double Identity (Identical trademark / Identical goods and services)

On the other hand, the following is a case set forth in the Guidelines where there is, in principle, a likelihood of confusion arising.

The Guidelines ([Chapter 19, 4 \(3\) Reasons for Consideration](#)) also state that a trademark that is identical with a cited trademark (including those that differ only in scale) and used for identical designated goods or services (in the case of so-called “double identity”) is, in principle, considered to have a high likelihood of confusion. The [Manual 42.400.01](#) clarifies that it applies only when the descriptions of the designated goods or services are exactly identical.

[Manual 42.400.01](#)

3. (2) Processing of the identical trademark and the identical designated goods and services

“The statement “the identical designated goods or services” from 4. (3) of the Guidelines refers to the designated goods or designated services of the trademark as applied that have the same indication as the designated goods or designated services of the cited trademark (except for those that are conceptually included).”

This is one type of exception that cannot be registered for even if a Letter of Consent is submitted.

Conclusion

The Guidelines and the Manual have clarified the situations where the Letter of Consent system is more easily applicable and where it cannot be used, as explained above. However, most cases will continue to be examined on a case-by-case basis. As of October 2024, examinations of Letters of Consent have not yet begun, and we will be monitoring how the Guidelines and Manual are applied in actual examinations from now.

Topic1

BIO INTERNATIONAL CONVENTION 2024 in San Diego

In June, three of our attorneys; Hiroshi Nemoto and Sayaka Ueno from the Tokyo office, who specialize in IP and Healthcare, as well as Mizuo Kimiya from our Silicon Valley office, who is experienced in assisting bio venture companies, attended BIO International Conference 2024 in San Diego. Our team had a productive and enjoyable experience actively participating in various networking events in and around the conference. They connected with industry professionals, fellow international attorneys, as well as current and prospective clients, with whom they discussed potential collaborations and future contributions. Despite the weather exhibiting “June gloom”, San Diego was filled with energy from the bio-industry.



TMI proudly supports medical, healthcare, and biotech industries worldwide, from patent prosecution and navigating complex regulatory issues to handling litigation involving highly technical discussions. Our diverse team of healthcare and IP professionals, combined with our global network, enables us to provide comprehensive legal services.

2. Overview of Recent Trademark Cases Court Decisions in Japan



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Introduction

This article provides an overview of recent court cases related to trademarks, focusing on some noteworthy cases among all the 63 cases in 2023, divided into 25 civil lawsuits (mainly trademark infringement lawsuits) and 38 administrative lawsuits (lawsuits for rescinding decisions, etc.).

Civil Lawsuits

Among 25 civil lawsuits, trademark infringement was recognized in 18 cases, and non-infringement was determined in 7 cases.

The “Unnoticeable Double Eyelid (*Barenai Futae*) Case” (Dec.26.2023 IPHC2023(Ne)10011) involved the plaintiff, who is the trademark owner of “Unnoticeable Double Eyelid” marks in Japanese hiragana and katakana, for goods such as “cosmetics for double eyelid formation, double eyelid surgery stretch tape,” suing the defendant for using the “Unnoticeable Double Eyelid” mark in Japanese katakana and kanji for trademark infringement. The Intellectual Property High Court (IPHC) dismissed the claim, finding that both marks are not similar in appearance, despite having the same pronunciation and connotation, considering that the expression “unnoticeable double eyelid” was a common term describing the quality and efficacy of the cosmetics in question, and that consumers would identify the source of the goods through the manner of external display (such as visible characters, patterns, colors) on the product or its packaging.

The “Heat Countermeasures Emergency Kit (*Necchu Taisaku Oukyu Kit*) Case” (Dec.19.2023 OsakaDC2022 (Wa)9818) involved the plaintiff, who holds trademark rights for goods such as “supplements, card-type thermometers,” under the mark “Heat Countermeasures Emergency Kit” in Japanese, filing a case against the defendant who sold products corresponding to the specified goods in a set under the same mark. The

Osaka District Court recognized the defendant’s argument that the trademark registration should be invalidated because the term “heat countermeasures” was generally understood to mean “countermeasures against heatstroke”, and “Heat Countermeasures Emergency Kit” was recognized as meaning a set of items or goods to be used for heatstroke countermeasures or first aid. The mark was ruled to fall under “trademarks consisting solely of a mark indicating, in a common manner, the quality, intended purpose, etc., of the goods”, and therefore the trademark right could not be exercised.

In the “Maruchu Yamada/Tsunagiya Case” (Mar.6.2023 IPHC2022(Ne)10091), the original court’s decision that the exercise of rights such as an injunction and damages claim for trademark infringement constituted an abuse of rights was upheld by the IPHC. It was identified that, despite being aware of the long-standing usage of the trademark among family members, both parties continued their businesses without specifically raising the issue until more than ten years after the trademark application, prompted by a matter entirely unrelated to the trademark rights, such as inheritance division discussions.

Administrative Lawsuits

There were 38 administrative lawsuits (lawsuits to rescind decisions, etc.), with 30 decisions being upheld and 8 being overturned, where distinctiveness or similarity / likelihood of confusion was the issue.

The “Curly Bangs Curler (*Kurunto Maegami Curler*) Case” (Sep.7.2023 IPHC2023(Gyo-Ke)10030) was the only case where the JPO’s decision was overturned at the IPHC regarding distinctiveness issue. The JPO did not recognize the invalidation claim against the “Curly Bangs Curler” mark and acknowledged its distinctiveness. However, the IPHC found that the mark was perceived by consumers to simply mean a “curler for creating curly bangs,” and lacked distinctiveness, only describing the functionality of the goods “hair curlers, not electric.”



In the “Red Soles for Women’s High-Heels Case” (Jan.31.2023 IPHC2022 (Gyo-Ke)10089), the applied-for trademark consisted solely of a single color, i.e., red color, and specified its application location to the soles of women’s high-heeled shoes. It was acknowledged that “shoes with red soles” were recognized by a certain consumer group, especially women interested

in luxury brands, as indicating the plaintiff's brand. However, the IPHC did not recognize the trademark as having acquired the level of distinctiveness (monopoly suitability) necessary for recognition as a public interest exception, considering factors such as the non-unique configuration of the trademark, the recognizability of the brand from logos like "Christian Louboutin" on the insoles of the plaintiff's shoes, the use of red soles by other brands, and the limited survey-deduced awareness of the trademark.

In the "Very Dark Red (Color Alone) Case" ([Jan.24.2023 IPHC2022 \(Gyo-Ke\)10062](#)), the applied-for trademark consisted solely of a single color, i.e., very dark red, without contour, for goods such as "pencils (excluding color pencils)".



While the recognition of the plaintiff's products was acknowledged among consumers, since other colors and texts also marked the plaintiff's products, and similar colors, such as Bordeaux and Burgundy, were widely used on writing instruments, it could not be concluded that consumers recognized the origin of the plaintiff's products from the single color alone. The IPHC did not recognize the single color as a source-identification mark for the plaintiff.



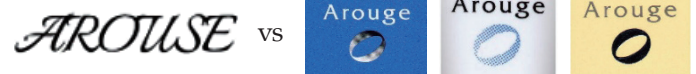
In the "Yellow Stitch (Position) Case" (Aug.10.2023 IPHC2023(Gyo-Ke)10003), the applied-for trademark consisted of a dashed yellow pattern applied along the border between the upper and sole parts of shoes around the shoe's perimeter.

While the trademark was recognized as being highly visible and noticeable when applied to black leather shoes or boots and as having achieved a considerable degree of recognition among consumers, there was no evidence proving the level of recognition when applied to shoes of other colors. Since the trademark description in the application did not limit the background to black, the IPHC concluded that it was inappropriate to assess the trademark's level of recognition based solely on its use on black shoes, and did not acknowledge the trademark's acquired distinctiveness through use.

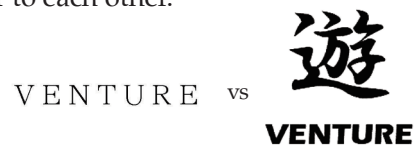
The "Sakuhoku Curry Case" ([Mar.9.2023 IPHC2022 \(Gyo-Ke\)10122](#)) concerned an appeal against the refusal of the "Sakuhoku Curry" mark in Japanese kanji and katakana, where the similarity with the prior "Sakuhoku" mark in Japanese katakana was at issue. Unlike the JPO's decision, the IPHC identified "Sakuhoku" in Japanese kanji as having the meaning "northern area" or "north land" while deeming

"Sakuhoku" in Japanese katakana to be a coined term with no particular meaning, leading to the conclusion that there was no likelihood of confusion.

In the "AROUSE Case" (Jan.17.2023 IPHC 2022 (Gyo-Ke)10078) involved the right holder of the prior marks "Arouge with device" seeking invalidation of the "AROUSE (stylized)" mark. The IPHC overturned the JPO's dismissal decision, acknowledging phonetic similarity of the marks, not emphasizing the visual differences.



The "VENTURE Case" ([Nov.30.2023 IPHC2023 \(Gyo-Ke\)10063](#)) dealt with an appeal against the refusal of the "VENTURE" (standard character) mark, contending the similarity with the prior "VENTURE with Japanese kanji character" mark. The IPHC recognized "VENTURE" as merely part of the overall appearance of the prior mark and lacking significant independent presence, concluding that both marks are not similar to each other.



The "5252byO!Oi Case" ([Dec.4.2023 IPHC2023 \(Gyo-Ke\)10067](#)) involved the rights holder of the prior mark "O!OI" seeking invalidation of the registered mark "5252byO!Oi" on the grounds of similarity. The consideration that the "O!OI" portion of the registered mark formed a key part and was similar to the prior mark resulted in the recognition of similarity at the IPHC.



Conclusion

In 2023, there were 63 court cases related to trademarks, an increase from the 56 cases seen in 2022. The number of cases has remained stable in the range of 50 to 70 over the past few years, with no significant changes observed. Since the JPO started to accept a single color mark application in 2015, there has been no case where a single color mark has successfully been registered so far. The above-mentioned cases seeking a single color registration drew attention and were expected to make a breakthrough, but neither was recognized as having acquired distinctiveness through use and successfully registered. This shows that there remains an extremely high bar to registration of a single color mark in Japan.

3. Japanese Patent Act Article 93: Probable First Request for Award Granting Non-Exclusive License in the Public Interest



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Introduction

Article 93 of the Patent Act of Japan provides for the granting of awards of non-exclusive (compulsory) patent licenses in the public interest. Despite this provision, no such license has ever been granted. This article examines the probable first case in which companies have successfully requested such an award, ultimately resulting in a settlement between the related parties where the patent holders are obliged not to exercise the patent against certain working of the patented invention.

Overview of the Awards Granting Non-Exclusive Licenses for Patents in the Public Interest

The Patent Act of Japan (the “**Patent Act**”) has established the provision of awards granting non-exclusive (compulsory) licenses, including through Article 93 of the Patent Act. Article 93, Paragraphs 1 and 2 stipulate: “(1) If the working of a patented invention is particularly necessary to the public interest, a person intending to work the patented invention may request the patentee or the exclusive licensee to hold discussions toward an agreement to grant the person a non-exclusive license. (2) If the agreement referred to in the preceding paragraph is not reached or if discussion toward such an agreement cannot be held, the person intending to work the patented invention may request the Minister of Economy, Trade and Industry to grant an award.”

The Industrial Property Council (the “**Council**”), established under the Act for Establishment of the Ministry of Economy, Trade and Industry, published the “Operational Guidelines for Award System” which provides primary examples of what constitutes being “particularly necessary to the public interest.” However, interpretation of this requirement remains elusive.

Prior to rendering an award, the Minister of Economy, Trade and Industry (the “**Minister**”) must listen to

opinions from a council or other body as prescribed by Japanese law (Article 93, Paragraph 3 and Article 85, Paragraph 1).

Article 93 allows for the granting of non-exclusive licenses of patents even against the patent holders’ will, provided that the working of a patented invention is particularly necessary to the public interest and the Minister renders the award. However, no such award has been granted to date

Chronology of Probable First Case and its Settlement

Date	Events
July 13, 2021	The Request was made
Dec. 2, 2021 – Nov. 16, 2023	Deliberations in the Invention Implementation Subcommittee
Dec. 24, 2023 - May 30, 2024	Deliberations in the Industrial Property Council
May 30, 2024	Settlement between related parties and Withdrawal of the Request

On July 13, 2021, Vision Care Inc. and VC Cell Therapy (the “**Requesters**”), represented by one of the inventors of a Japanese iPS-related patent (Patent No. 6518878, titled “Methods of producing retinal pigmented epithelium cells”) (the “**Patent**”), requested the Minister to grant a non-exclusive license under Article 93, Paragraph 2 of the Patent Act, in relation to the Patent (the “**Request**”). The holders of the Patent are the Institute of Physical and Chemical Research, Osaka University, and Healios K.K. (collectively, the “**Patent Holders**”). This is likely to have been the first request ever made under Article 93, Paragraph 2.

From December 2, 2021, to November 16, 2023, consistent with the provisions of the Patent Act, the Invention Implementation Subcommittee of the Council (the “**Subcommittee**”) convened twenty-two meetings to deliberate on the Request. The Subcommittee examined opinions, evidence, etc. provided by the Requesters and Healios K.K., and prepared a draft report for the Council’s consideration. From December 25, 2023, the Council itself held meetings to deliberate on the Request. However, the Council did not reach a conclusion before the Requesters reached a settlement with the Patent Holders and withdrew the Request on May 30, 2024.

This deliberation in the Subcommittee was prolonged as it was necessary to discuss, from scratch, a suitable framework for determining whether “the working of a patented invention is particularly necessary to the public interest” (*The First Award Request Concerning Public Interest for iPS-Related Patents: Lessons Learned*

from a Professor Involved in the Deliberation [iPS 関連特許で公共利益めぐり初の裁定請求、審議の教授が語る教訓], Asahi Shinbun (June 7, 2024), <https://www.asahi.com/articles/ASS662QB3S66PLBJ001M.html>)

On May 30, 2024, the Requesters and the Patent Holders, etc. executed a settlement agreement after a subcommittee member informed related parties including the Requesters and Healios K.K., which planned to grant an exclusive license of the Patent to another company, that there was a possibility that a partial license would be granted as requested in the Request, and solicited negotiations between the parties (Appendix 1 of Settlement Agreement [和解契約書別紙1] (May 30, 2024), https://www.healios.co.jp/pdf/20240522_2.pdf). In this agreement, the Requesters are obliged to withdraw the Request and the Patent Holders are obliged not to exercise the Patent against limited work of the patented invention (Settlement Agreement [和解契約書] (May 30, 2024), https://www.healios.co.jp/pdf/20240522_1.pdf). The Requesters withdrew the Request due to the settlement later.

Undisclosed Deliberations on the Interpretations of Article 93, Paragraphs 1 and 2

Due to the proceedings of the Council and the Subcommittee being held in closed session and the withdrawal of the Request before the Minister rendered an award, the contents of the deliberations in the Council and the Subcommittee remain undisclosed. In addition, while the Japan Patent Office published a statement on May 30, 2024, regarding the withdrawal of the Request, in which it stated that the Council and the Subcommittee had deliberated on viewpoints including whether the Requests satisfied the requirements of being “particularly necessary to the public interest” in Article 93, Paragraphs 1 and 2, no specific arguments or interpretations of Article 93 were unveiled (Japan Patent Office, *Statement Regarding Withdrawal of Patent Petition 2021-1* [裁定請求2021-1の取下げについて] (May 30, 2024), <https://www.jpo.go.jp/resources/shingikai/kogyo-sho-yu/award2021-1.html> (last visited October 9, 2024)).

Consequently, the interpretation of “particularly necessary to the public interest” in Article 93, Paragraphs 1 and 2 remains a subject of legal ambiguity.

Conclusion

The chronology of this case suggests that the Request contributed to reaching the settlement agreement between the related parties. This outcome demonstrates

the potential efficacy of requesting an award for the granting of a non-exclusive patent license in the public interest, despite the apparent difficulty in obtaining such awards which have, to date, never been granted. While this case spanned approximately three years, it is anticipated that the future proceedings before the Council and the Subcommittee may be expedited, due to the likelihood of there having been a detailed examination of the interpretations of Article 93 in the whole process.

Therefore, in situations where alternative approaches, including license negotiations with patent holders, appear unfeasible, requesting an award granting a non-exclusive patent license in the public interest may be a viable strategic consideration for those who cannot obtain patent licenses from patent holders with patents related to the public interest.

Topic2

Calculation of Damages under Japanese Patent Law



We have released a new episode on our Podcast channel “TMI Podcast - Intellectual Property in Japan” which is available on [Apple Podcasts](#), and [Spotify](#). In this episode, we provide an overview of the calculation of damages in patent infringement cases under Japanese law. Especially, we examine the key provisions of Japanese Patent Act Article 102, covering the three main methods for determining damages: lost profits, the infringer’s profits, and reasonable royalties. We also discuss recent legislative amendments aimed at enhancing patent protection, including the 2020 revisions, as well as significant rulings from the Intellectual Property High Court. This episode is essential listening for patent professionals and anyone interested in the evolving framework of Japanese patent litigation. We invite you to tune in and stay informed on these critical developments.

4. Examples of Design Registrations under the Revised Design Act in Japan -Part 5-: Related Designs



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Introduction

We have introduced various examples of design registrations which were newly registered after the introduction of the revised Design Act enacted in April 2020 (the “Revised Act”) in past newsletters (Japan Patent & Trademark Update Issue [19](#), [20](#), [21](#), [22](#), and [23](#)). In Issue [24](#), while we have provided an overview of the related design system under the Revised Act, we continue to introduce examples of registered related designs in this article.

Related Design System Under the Revised Act

As previously introduced in newsletters issue 24, the related design system is an exception of so-called double patenting. With the related design system, an applicant may obtain design registration of a design similar to a “principal” design as “related” design under Article 10 within 10 years from the filing of the principal design, and variations of the “principal” design may be registered, even if the “principal” design has already been made public. September 10, 2024 on the number of design applications based on the related design system is as follows:

Number of related designs filing before publication of principal design	Number of related designs filing after publication of principal design
14,555	3,595

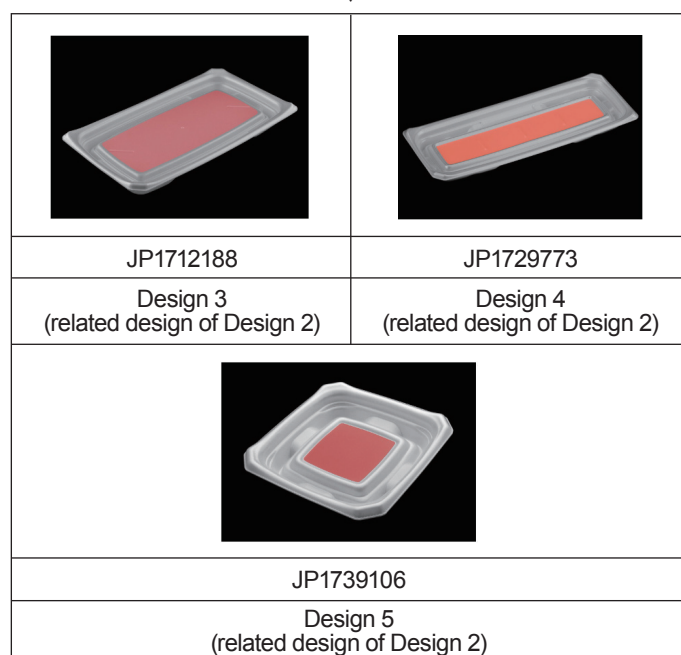
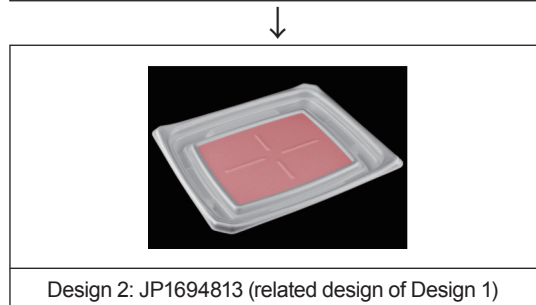
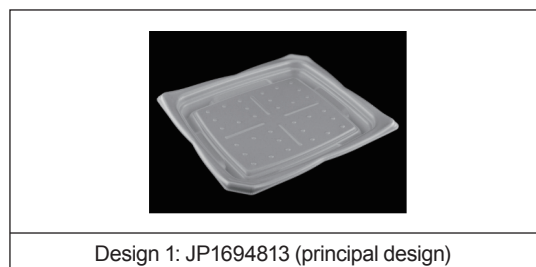
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Examples of Registrations of Related Design

We present below some examples of related design registrations which may be of some interests.

(1) “Packaging container” by FP Corporation

These designs are all directed to “packaging containers”, and the parts of the designs colored red are disclaimed. Design 2 shown below was registered as the related design of Design 1 (principal design) though Design 2 was filed after Design 1 was made public. Further, Designs 3, 4, and 5 as shown below were registered as the related designs of Design 2, meaning that Designs 3, 4 and 5 are similar to design 2.


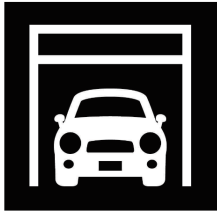


These multiple designs, registered as related designs, allow learning about the following points:

- The scope of protection of the design registrations for these package designs is not significantly affected by whether the package is rectangular or square.
- What is distinctive about these designs is the shape of the edges.

2) "Image for garage shutter device" by Bunka Shutter Co., Ltd.

These designs show an example of the related design registration for GUIs, specifically icons. There are directed to images for operating the shutter curtain of the garage shutter system to fully open or for displaying that the shutter curtain has fully opened.

	
JP1684394	JP1684458
(principal design)	(related design)

Icons may change in design due to product type or version upgrades. By registering icons with design variations as related designs, it can be confirmed that minor changes such as color variations or slight modifications resembling shutter patterns fall within the scope of similarity. These registrations are considered advantageous in this regard.

Conclusion

Related design system is unique in a way that is not available in many countries. Under the Revised Act, it became possible to obtain a design registration by utilizing the related design system, even if one's own design has already been published. By using the related design system, a company can enhance its branding by turning the design of a product that has been sold for a long time with repeated minor changes into a symbolic representation of the company. Consequently, the related design system becomes as an important tool for companies to brand themselves through design, making it crucial to consider taking advantage of this system.

Topic3

The 13th Japan-China-Korea Design Forum in Seoul

On September 3, 2024, Koji Akanegakubo, representing the Japan Patent Attorneys Association, attended the 13th Japan-China-Korea Design Forum held at the FKI Conference Center in Seoul, Korea. He gave a presentation on "Design for Space: Protection of Interior Design / Architectural Design in Japan".

The Forum has been held annually since 2010, alternating between the Japan Patent Office (JPO), the Korean Intellectual Property Office (KIPO), and the China National Intellectual Property Administration (CNIPA). This year's forum was hosted by KIPO to commemorate the 10th anniversary of Korea's accession to the Hague Agreement in 2014.

During the presentation, he highlighted examples of architectural and interior design protection under the Japanese Design Act. The discussion included 18 registered examples, illustrating that design registrations for a space design are not only for rights enforcement, but also for purposes such as business promotion, enhancing the status and motivation of designers, improving corporate image, adding value to products, and rightsizing services (business models). The participants, mainly Korean patent attorneys and lawyers, asked many questions on the spot.



New Professionals

Tamotsu Shoji

Advisor (Attorney)

Tamotsu Shoji is a former presiding judge at the Intellectual Property High Court of Japan (the IP High Court) and a legal professional with an extensive career in intellectual property (IP) law. For decades after being appointed an assistant judge of the Tokyo District Court in 1989, Shoji served as a judge in several district courts and family courts across Japan, developing broad legal expertise. Shoji's specialization in intellectual property began in 2002 when he was appointed as a judge in the Intellectual Property Rights Division (the IP Division) at the Tokyo District Court. He then served as a judge of the IP High Court from 2009 to 2012, and from 2012 to 2017 he served as a presiding judge of the Tokyo District Court IP division. In 2021, Shoji was appointed as a presiding judge at the

IP High Court Third Division, where he presided over IP-related key cases involving complex patent and trademark disputes. Throughout his career, Shoji has been recognized for his expertise and contributions to Japan's IP legal framework. In 2012 he was appointed as a member of the Bar Examination Committee for Intellectual Property, then in 2015 as a temporary member of the Industrial Property Council on Patents and in 2016 joined the Industrial Structure Council of the Ministry of Economy, Trade, and Industry. By 2021, his experience included overseeing numerous landmark IP cases and contributing to the development of Japan's IP law through both his judicial and advisory roles. After retiring from the IP High Court, Shoji joined TMI Associates in September 2024.

Yoshihito Fujimoto

Counsel (Patent Attorney)

Mechanical Engineering / Control Engineering / Electrical Engineering / Information and Communication Technology / Semiconductors / Optics
Yoshihito Fujimoto, earned his Bachelor of Engineering in Applied Physics from Waseda University in 1989, after which he joined the Japanese Patent Office (JPO) in 1990. In 2003, Fujimoto became an Appeal Examiner for the 6th Board of Appeals, marking the beginning of his career focus on patent appeals. During this period, he pursued further academic achievements, including earning an LL.M. from the University of Tokyo in 2005. In 2007, Fujimoto was promoted to Senior Examiner in the Business Machinery Division. By 2008, he became the Associate Managing Examiner, further developing his leadership and decision-making roles within the JPO. Fujimoto's expertise in patent examination continued to grow, and in 2011, he was appointed Managing Examiner, during which he oversaw patent cases in a specialized area. Fujimoto's career trajectory continued upward when he became Senior Appeal Examiner for the 7th Board of Appeals in 2013 and was appointed Principal Appeal Examiner in 2017, followed by his promotion to Presiding Appeals Examiner in 2019. By 2021, Fujimoto had risen to the position of Director of the 7th Board of Appeals, and in 2023, he was named Senior Director. Finally in September 2024, he joined TMI Associates.

Takeo Takiuchi

Counsel (Patent Attorney)

Mechanical Engineering / Electrical Engineering / Information and Communication Technology / Semiconductors / Materials
Takeo Takiuchi has had a distinguished career in intellectual property. Takiuchi joined the Japanese Patent Office (JPO) in 1990, after earning his M.S. in Resources and Materials Engineering from Waseda University. Early in his career, he served as an examiner in the Semiconductor Division, specializing in advanced technologies. In 1999, Takiuchi became a visiting fellow at Stanford University's Asia/Pacific Research Center, giving him the opportunity to broaden his global perspective, after which he returned to the JPO in 2000. While back at the JPO Takiuchi became an Appeal Examiner in 2004, focusing on semiconductor cases. His leadership continued to grow with his promotion to Director of Information Storage Division in 2013, where he oversaw the examination of data storage technologies. In 2015, Takiuchi was appointed Senior Director of the Video System Division, followed by a role as Deputy Director-General of Electronic Commerce Technology Division in 2016. His work in these positions involved handling complex patent cases in rapidly evolving technological fields. From 2019, Takiuchi served as a Judicial Research Official at the Intellectual Property High Court. In 2022, he took on senior roles at the 33rd and the 29th Boards of Appeals, overseeing patents in digital communications and electronic devices. Finally in October 2024, he joined TMI Associates.

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








TMI has a total of more than 1,200 employees worldwide, including over 600 IP/Legal professionals, comprised of 572 attorneys (Bengoshi), 100 patent/trademark attorneys (Benrishi), and 55 foreign law professionals.

Attorneys (Bengoshi)	572
Patent / Trademark Attorneys (Benrishi)	100
Foreign Law Counsels	9
Foreign Attorneys	46
Advisors	15
Management Officers	2
Patent Engineers, Staff	484
Total	1,228

(As of November 1, 2024)

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 9,000 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	34	 Chemical	19
 Mechanical	16	 Bio, Pharma	9
 Design	6	 Trademark	22
overlap included			
 IP Lawyers	110		

Awards

TMI, along with its attorneys, and its patent and trademark attorneys, has proudly received prestigious awards annually. This year, TMI was named "Japan Firm of the Year - Patent Disputes" at the Managing IP Asia-Pacific Awards 2024 and "Patent Prosecution Firm of the Year" at the IAM and WTR "The Global IP Awards 2024."



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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