Issue29 (March 2025)

Japan Patent & Trademark Update

Contents

1. An Indemnification Clause for Patent Infringement in Japanese Practice

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Introduction

Recently, disputes over patent indemnity clauses have increased, due to growing production cooperation accompanying open innovation and the expansion of sales of IoT products incorporating standardized components. As the supply chain for these products becomes increasingly complex, the risk of unknowingly infringing a third party's intellectual property rights has also risen. Patent indemnity clauses are stipulations that allocate liability between contracting parties when a product infringes or is alleged to infringe a third party's intellectual property rights. These clauses are designed to distribute the risk of intellectual property infringement, but disputes often arise over their scope and the allocation of responsibility when a third party issues a warning letter. In particular, Japanese contracts often contain vague wording, making negotiations difficult and potentially time-consuming and costly to resolve. Unlike some other jurisdictions where indemnity clauses tend to be more precisely defined, Japanese agreements often leave room for interpretation, which can lead to differing expectations between the parties. This article introduces Japanese court cases in which the interpretation of these clauses was disputed, and then introduces matters to be aware of in Japanese practice.

Modem Chip Set Case (IP High Court 2015 (Ne) No.10069)

In this case, the Seller demanded that the Buyer pay for the DSLAM chipset (**"the Chipset"**) that the Seller had delivered based on the individual contract attached to the basic contract (**"the Basic Agreement"**) for the sale of goods concluded between the two parties. The Buyer received a license offer from Company W, a third party, for a total of nine patents held by the Company W in relation to the Chipset. The Buyer then entered into a license agreement with Company W and paid Company W a license fee of 200 million yen. The Buyer alleged that the Seller had violated Sections 18.1 and 18.2 of the Basic Agreement, and that the Buyer had suffered damages equivalent to the amount of the license fee paid to the third party, and therefore had the right to claim damages. The following provisions existed in Sections 18.1 and 18.2 of the Basic Agreement.

> 1.The Seller warrants to the Buyer that the Goods and the method of manufacture and use thereof do not infringe upon the industrial property rights, copyrights, or other rights of any third party (collectively, "Intellectual Property Rights").
> 2.The Seller shall, at its own expense and responsibility, settle or cooperate with the Buyer in resolving disputes with third parties arising from the infringement of Intellectual Property Rights with respect to the Goods, and shall not cause any inconvenience to the Buyer. In the event of damage to the Buyer, the Seller shall indemnify the Buyer for such damage.

The Tokyo District Court (the first instance) rejected the Buyer's arguments based on Sections 18.1 and 18.2. The Buyer then appealed to the IP High Court.

First, the judgment denied a violation of Sections 18.1, which contains a non-infringement guarantee clause, on the grounds that it was not possible to say that the Chipset infringed upon the above patent rights.

Second, in relation to Section 18.2, the judgment pointed out that there were no other specific provisions in the Basic Agreement regarding measures or methods for resolving disputes with third parties on the grounds of intellectual property infringement. The judgement further stated that Section 18.2 of the Basic Agreement merely stipulates the comprehensive obligations that the Seller should take in the event that there is a problem regarding the infringement of intellectual property rights held by a third party, and that it is reasonable to interpret that the specific obligations of the Seller should be determined according to the specific circumstances of the case, such as the nature and content of the infringement claims made by the third party and the discussions with the Buyer.

The judgement further stated that the following specific circumstances existed: (i) the Buyer had received a license offer from Company W; (ii) as soon as the Buyer requested the Seller's cooperation, the Buyer began seeking an answer as to whether the Chipset in question infringed upon the patent right.; (iii) it was confirmed that it was necessary to consider the license fee, the basis for calculating it, etc., between the Seller, the Buyer, and the Chipset vendor, and this vendor responded stating that it would offer the necessary information. The judgement then stated that the Seller had the specific obligation under Section 18.2 to (1) analyze the patents and provide an opinion on their validity and whether or not Chipset infringed upon the patents, along with supporting materials, in order to determine whether or not the Buyer needed to conclude a license agreement with the patent holder and (2) collect and provide materials necessary for calculating a reasonable license fee in the event that the Buyer enters into a license agreement with the patent holder. In conclusion, this judgment found that the Seller had breached its obligations, but also partially accepted the Buyer's argument for contributory negligence.

Wall Catcher Case (IP High Court 2023 (Ne) No.10064)

This case involved a warning issued on the grounds that the product, which was manufactured by the Buyer and sold to the Seller, infringed upon the patent rights held by the auxiliary intervenor. The Buyer claimed damages from the Seller for breach of the following special clause of the contract (the **"Special Clause"**), on the grounds that the Buyer would no longer be able to purchase the product from the Seller and sell it to a third party in the future.

> The Seller warrants that the Goods do not infringe on any industrial property rights such as the patents and trademarks of third parties. In the event of any infringement, the Seller shall handle and resolve such infringement at its own expense and responsibility and shall not cause any damage to the Buyer.

The court stated that, while it cannot be said that there was a specific exchange of words or content regarding the Special Clause at the time of the conclusion of the contract, based on a general interpretation of the intent of the Special Clause, it was judged that the Special Clause was primarily intended to stipulate the Seller's obligation to compensate for losses in the event that it was confirmed that the product subject to the contract had infringed on a patent and that the Buyer had suffered damage. Following this, the court judged that the terms of the Special Clause, such as the phrase "in the event of any infringement", and the fact that the Seller was in a position to have more technical knowledge and other information than the Buyer as the manufacturer of the goods, meant that the Special Clause not only stipulated a post-incident financial compensation obligation, but also an obligation for the Seller to actively resolve and handle the dispute at its own expense and responsibility. However, the court ultimately dismissed the Buyer's claim against the Seller, as it found that the Seller had not violated the above obligation.

Practice Considerations based on the Court Cases

As these court decisions indicate, the Seller's obligations under indemnity and dispute resolution clauses can vary depending not only on the contract wording but also on the circumstances of the parties' negotiations and their respective technical expertise. In the Wall Catcher Case, despite the clause stating "in the event of any infringement", the court ruled that the Seller was obligated to provide information even at the stage where a third party merely alleged infringement of intellectual property rights. The legal approach taken in these court cases might be unique to Japanese practice, where there is no custom of including an Entire Agreement Clause in general.

However, this does not mean that the indemnification or dispute handling obligations will be determined solely based on external circumstances other than the wording of the contract. In other words, because the clauses in dispute in these court cases were somewhat abstract, it can be said that the courts considered circumstances other than the wording of the contract. Therefore, one practical point that can be understood from these court cases is that, especially for the Seller, the content of the obligation to compensate and to deal with disputes should be clearly stated in the contract as specifically as possible. For example, it is desirable for the Seller to clearly define in the regulations what specific actions the Seller is obliged to take, such as infringement evaluations, validity evaluations, examination of design change proposals, and obtaining licenses. Furthermore, if the Seller intends to avoid bearing the obligation to act in the event of an infringement of intellectual property rights that has not yet been determined, it is preferable to specifically specify the point at which infringement will be determined to be confirmed, and then clearly stipulate that the seller has no obligation to respond to disputes prior to that point.

In addition, in Japanese practice, there are many provisions that do not clearly state the scope of the Seller's liability for compensation. However, from the perspective of both the Seller and the Buyer, it is important to clearly state the scope of the Seller's liability for compensation in order to avoid future disputes, and in particular, it is desirable to clearly state the burden of expenses for attorneys and patent attorneys, which may prove to be expensive.

Conclusion

As described above, in Japanese practice, there is a tendency to broadly recognize the obligations of the Seller by actively considering circumstances other than the wording of the contract, especially in cases where the wording of the contract is abstract. Therefore, it is especially important for overseas companies in particular, to draft patent indemnity clauses and dispute response clauses with reference to the above court cases when concluding contracts in accordance with Japanese law as the Seller.

Topic1

NYSBA 2024 Seoul Global Conference

Hiroshi Nemoto (Partner, Attorney) and Tomohiro Kuribayashi (Attorney) participated in a panel discussion titled "The Principle of Territoriality and Cross-Border Infringement of Intellectual Property Rights: A Comparison of the Approaches in Japan, South Korea, Thailand and the U.S." alongside three other attorneys from overseas.

Topic2

Federal Circuit Bar Association "Global Series" in Singapore

Toyotaka Abe (partner, patent attorney) participated in a panel discussion on "Navigating Patentable Subject Matter Across Borders in Software & Technology" at the Federal Circuit Bar Association "Global series" held at the Fullerton Hotel Singapore from May 15 - 18, 2024. Other panelists were from US, Korea, Singapore, and Brazil.

2. Looking Back on the First 10 Years of "Color Trademarks" and "Position Trademarks" in Japan -Part 1-

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Introduction

The 2014 amendment to the Japanese Trademark Law has made it possible to register Non-Traditional Marks ("NTMs") that were previously unprotected, such as "color trademarks" and "position trademarks." Now, 10 years have passed since the introduction of the NTMs and examinations and court cases are gradually accumulating. In this article, I will review the statistical information and the actual registrations of "color trademarks" and "position trademarks" during these first 10 years.

Statistical information on "Color Trademarks" and "Position Trademarks"

Number of applications

In 2015, when the NTMs started, a considerable number of applications were filed. According to the "Trademark Application Trend Survey 2019"[1] and "Trademark Application Trend Survey 2023"[2] by the JPO, the filing number of "color trademarks" was 448 and the filing number of "position trademarks" was 260 in 2015. After the first rush of applications ended, the number of applications has somewhat stabilized. Recently, however, the number of applications has decreased considerably. According to the JPO's survey, the filing number of "color trademarks" was 7 and the filing number of "position trademarks" was 30 in 2022.

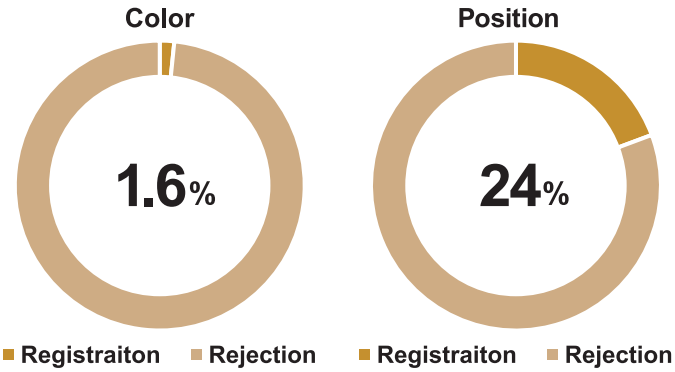
	2015	2016	2017	2018
Color	448	43	23	20
Position	260	82	55	43

	2019	2020	2021	2022
Color	6	5	8	7
Position	44	40	44	30

The statistical information indicates that the "color trademarks" and "position trademarks" are not being used very actively.

Registration rate

The registration rate for "color trademarks" and "position trademarks" is quite low. The rate for "color trademarks" is 1.6% and the rate for "position trademarks" is 24%. Of these, no registration for "trademarks consisting solely of a single color" has been approved in the last 10 years.[3]



Reasons for refusal

The main reason for refusal of "color trademarks" and "position trademarks" is lack of distinctiveness. Around 500 "color trademarks" have been refused due to lack of distinctiveness and more than 350 "position trademarks" have been refused due to lack of distinctiveness as indicated in the below chart.

Color		Position	
Intent to Use	28	Intent to Use	15
Lack of Distinctiveness	496	Lack of Distinctiveness	360
Citation of Prior Mark(s)	91	Citation of Prior Mark(s)	22
Problematic Description(s)	2	Problematic Description(s)	3

1. "Trademark Application Trend Survey 2019"
https://www.jpo.go.jp/resources/report/gidou-houkoku/document/isyou_syouhyou-houkoku/2019shohyo_macro.pdf
2. "Trademark Application Trend Survey 2023"
https://www.jpo.go.jp/resources/report/gidou- houkoku/document/isyou_syouhyou-houkoku/2023shohyo_macro.pdf
3. "No Single-Color Marks Registered Yet (Shunji Sato)"
https://www.tmi.gr.jp/eyes/newsletter/2020/12063.html

Please note that there may be multiple reasons for rejection for a single application.

Registrations of "Color Trademarks" and "Position Trademarks"

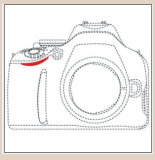
The above statistical information indicates that the hurdle for registering "color trademarks" and "position trademarks" is extremely high. However, in some cases, the applicants were able to successfully prove the secondary meaning of their marks in response to the Refusal due to lack of distinctiveness and lead their marks to registration.

For Reg. No. 5930334, TOMBOW PENCIL CO., LTD. ("TOMBOW") filed a trademark application for the color combination of their erasers designating erasers in Class 16 on April 1, 2015. In response to the Office Action due to lack of distinctiveness, TOMBOW argued secondary meaning and submitted evidential materials including the period of use (more than 35 years), sales amount (more than 15 billion yen) and market share (1st place). The JPO eventually admitted the secondary meaning and the mark was registered on March 10, 2017.

For Reg. No. 5933289, SEVEN-ELEVEN JAPAN CO., LTD. ("SEVEN-ELEVEN") filed a trademark application for the color combination of their corporate brand designating various retail services in Class 35 on April 1, 2015. In response to the Office Action due to lack of distinctiveness, SEVEN-ELEVEN argued secondary meaning and submitted evidential materials including the period of use (more than 30 years), number of stores (more than 16000), sales amount (more than 3.5 trillion yen) and consumer surveys (around 88% awareness). The JPO eventually admitted the secondary meaning and the mark was registered on March 17, 2017.

For Reg. No. 6034112, NISSIN FOODS HOLDINGS CO., LTD. ("NISSIN") filed a trademark application for a "position trademark" for their instant noodle's packaging designating instant noodles with cup-shaped ingredients and soup, etc. in Class 30 on August 4, 2015. In response to the Office Action due to lack of distinctiveness, NISSIN argued secondary meaning and submitted evidential materials including the period of use (more than 45 years), sales volume (more than 22.5 billion packs), market share (1st place) and consumer surveys (around 85% awareness). The JPO eventually admitted the secondary meaning and the mark was registered on April 6, 2018.

For Reg. No. 6118238, NIKON CORPORATION ("NIKON") filed a trademark application for the position of their camera designating single-lens digital cameras in Class 9 on April 1, 2015. In response to the Office Action due to lack of distinctiveness, NIKON argued secondary meaning and submitted evidential materials including period of use (more than 8 years), sales volume (more than 376,000 units), sales amount (more than 18.4 billion yen), market share (37%) and advertising cost (around 1.7 billion yen). At the examination stage, the JPO did not admit such argument and issued a Decision of Rejection. Nikon appealed against the Decision and in the trial, the

Reg. No.	5930334	5933289	6034112	6118238	6534071
Trademark	 [Color mark]	 [Color mark]	 [Position mark]	 [Position mark]	 [Color mark]
Period of use	35 years	30 years	45 years	8 years	60 years
Sales volume	N/A	16000 stores	22.5 billion packs	376,000 units	4.5 billion packs
Sales amount	15 billion yen	3.5 trillion yen	N/A	18.4 billion yen	N/A
Market share	1st place	N/A	1st place	37%	6-10%
Consumer survey	N/A	88%	85%	N/A	87%
Advertising cost	N/A	N/A	N/A	1.7 billion yen	N/A

trial board eventually admitted the secondary meaning and the mark was registered on February 1, 2019.

For Reg. No. 6534071, NISSIN FOODS HOLDINGS CO., LTD. ("NISSIN") filed a trademark application for the color of their instant noodle's packaging designating instant noodles in Class 30 on July 12, 2018. In response to the Office Action due to lack of distinctiveness, NISSIN argued secondary meaning and submitted evidential materials including the period of use (more than 60 years), sales volume (more than 4.5 billion packs), market share (6-10%) and consumer survey (around 87% awareness). The JPO eventually admitted the secondary meaning and the mark was registered on March 25, 2022.

Conclusion

In recent years, it appears that "color trademarks" and "position trademarks" are not being used very actively - the statistical information indicates that the high hurdles for registration are thought to be one factor for this situation. However, now that 10 years have passed, there are multiple examples of secondary meaning being recognized and registration being granted through appropriate arguments and evidence. Now, we can learn the practical points from actual registrations, especially pointers for proving secondary meaning. In a subsequent issue, I will introduce examples of court cases for "color trademarks" and "position trademarks".

Topic3

WTR 1000 2025 Recognition

TMI received high praise in the WTR (World Trademark Review) 1000 2025:

- *Prosecution and Strategy – Gold*
- *Enforcement and Litigation – Gold*
- *Licensing and Transactions – Highly-recommended*

We appreciate this recognition and our clients' support.

WTR 1000 TMI Associates Recommended Firm 2025

3. Protecting Designs in the Metaverse

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Protection for Metaverse under the Japanese Design Act

The **metaverse** is an evolving digital space where users can interact, create, and engage in various activities through virtual environments. As businesses and individuals increasingly develop virtual objects, avatars, and icons within these spaces, the need for intellectual property protection becomes more critical.

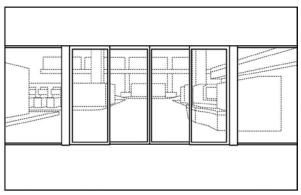
In this article, we introduce how the metaverse may be protected under the Japanese Design Act.

In Japan, the revised Design Act (the "Revised Act"), which came into effect in 2020, has brought increasing attention to the legal protection of graphic image designs in the metaverse. Even designs used in a virtual space may be registered if such designs fall within the category of "graphic image" as defined in the Revised Act.

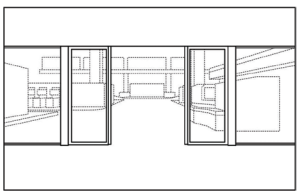
In the Revised Act, a design is defined as follows: *"'Design' in this Act shall mean… a graphic image (limited to one provided for use in the operation of the device or one displayed as a result of the device performing its function, and including a part of a graphic image)… that creates an aesthetic impression through the eye."*
Thus, designs used in the metaverse is protectable under the Revised Act if the designs are classified as "graphic images" to be used either "for operation" or "for display." It should be noted that graphic images with no functional purpose, such as wallpaper, paintings, characters, etc., are not protectable, as such designs are created/designed for aesthetic purposes only.
As such, under the Revised Act, graphic image designs

that appear to be intended for use in the metaverse can be registered if certain conditions are satisfied.

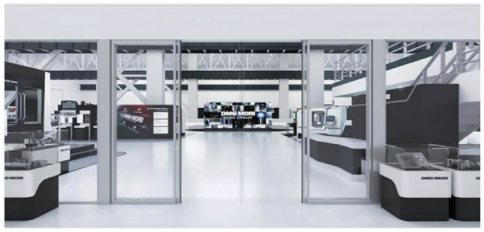
The following example, JP1715416 for "Image for displaying guidance for a digital showroom" by DMG MORI CO., LTD., is a case registered after the revision. The example illustrates the use of an image designed to serve as a navigation tool within a digital showroom displayed on a monitor. When the user interacts with "Graphic Image 1", it transitions to "Graphic Image 2", where the door icon appears to open as shown in "Graphic Image 3".



(Graphic Image 1)



(Graphic Image 2)

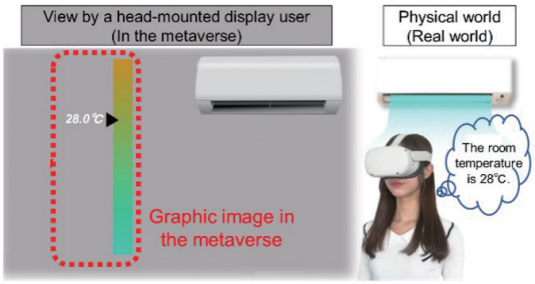


(Graphic Image 3)

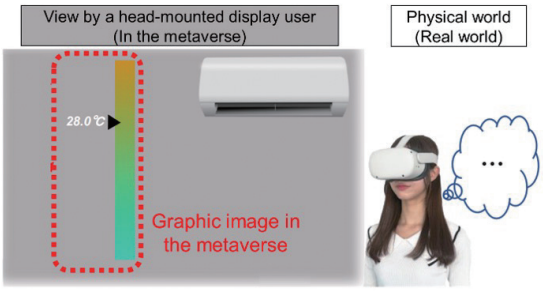
Recent Updates to Design Examination Guidelines

With the increasing number of design registrations related to the metaverse, the needs arise to clarify the conditions for registration. More specifically, while the Revised Act requires that the design be related to the operation or function of a device in the real world, there have been instances of registrations where this relationship is not necessarily clear, and the needs arise to clarify such relationships.

In light of this situation, a partial revision of the Design Examination Guidelines was published on December 15, 2024. The revision clarifies that graphic images in the metaverse can only be registered if they are related to the operation or function of a physical device (real device). That is, graphic images in the metaverse can be registered if they are used for operating a real device or displayed as a result of a real device performing its function.
One example presented over the course of the discussion for the revision of the Design Examination Guidelines is an icon displayed on a head-mounted display below. The icon shows the temperature along with the air conditioner icon.



Under the revised guidelines, this icon can be registered if, for example, it is used to display the temperature of an air conditioner in the real world, or if it is used to show the room temperature as a result of a head-mounted display with a temperature measurement function performing its function.
On the other hand, as shown in the following illustration, if the icon is simply used to display the temperature of the air conditioner in the metaverse, it cannot be registered because it is not related to a device in the real world.



Thus, it was made clear under the revised guidelines that designs in the metaverse can be registered as graphic image designs only if they are related to a device in the real world.

Conclusion

The Revised Act has provided a pathway for graphic image designs in the metaverse to be protected by Design Act, but only under specific conditions. As the metaverse technology continues to evolve, the legal framework for protecting digital designs will also need to be updated according to the changes.
As the metaverse becomes more a part of daily life and business, legal discussions on protecting digital designs will continue. Companies and creators should keep up with these legal changes to protect their innovations properly.

Topic4

JPM WEEK 2025 in San Francisco

JPM Week is one of the largest and most informative opportunities in the healthcare industry. Centered around the premier JP Morgan Annual Healthcare Conference, the week is filled with numerous surrounding conferences and networking events inside San Francisco city, where global industry leaders, emerging innovative entrepreneurs and the investment community gather to discuss key industry topics and innovations. During the week of January 13, Sayaka Ueno, a counsel attorney-at-law from our Tokyo office specializing in IP and Healthcare, was on-site in San Francisco for JPM Week. Joined by colleagues from our Silicon Valley office, Atsushi Sato, a partner patent attorney, and Mizuo Kimiya, a corporate lawyer who is experienced in assisting biotech ventures, they actively participated in various events to meet with people in the industry, current and prospective clients, and fellow international attorneys, to exchange insights and share TMI's enthusiasm in supporting the industry.
TMI is proud to support 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.

Topic5

The Third Local Office in Europe has opened in Brussels

In November 2024, TMI opened a new branch office in Brussels, Belgium, as the third establishment in Europe, following London and Paris. Brussels is a key location acting as the center of the European Union; where the headquarters for the Council of the European Union, the European Commission, and other institutions are located. The branch office is titled "TMI Associates Europe S.R.L." and will serve as an office that can promptly inform clients of the latest developments in EU law.

Brussels Office Locations | Our Firm | TMI Associates

Topic6

#8: AI as Inventor : IP High Court Decision on the DABUS Application

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 update on the DABUS case in Japan, where an AI system was listed as the inventor in a patent application. Last year, we covered the Tokyo District Court's ruling rejecting AI inventorship. Recently, the Intellectual Property High Court upheld this decision, reaffirming that only natural persons can be inventors under Japanese law. We explore the court's reasoning, how it aligns with global trends, and the implications for AI-generated inventions. As AI innovation advances, countries face the challenge of adapting their patent systems. Japan's approach provides valuable insights into this evolving legal landscape. Join us as we examine the latest developments and what they mean for the future of AI and patent law worldwide.

4. This year's promotion

Seiji Kurishita | Partner

Trademark Attorney | Japan

- Trademarks
- IP Consulting
- IP Litigation
- Brand Management

Seiji Kurishita is a highly experienced trademark attorney with over twenty years of expertise in the field of intellectual property, specializing in trademark law. Throughout his career, he has provided comprehensive legal support to both domestic and international clients, helping them protect and enforce their trademarks in Japan and across the globe.

Seiji's expertise covers the entire trademark registration process, including conducting thorough trademark searches, preparing and filing applications, handling office actions, and guiding clients through to successful registration. He also advises on post-registration matters, such as oppositions, cancellations, and infringement disputes.

In addition to his extensive experience in Japan, Seiji has gained valuable international exposure through his work in the United States. He spent two years immersed in the U.S. intellectual property system, first as a student at the University of Colorado School of Law, where he studied U.S. law with a focus on intellectual property, and then as an international lawyer at a prominent U.S. law firm.

Seiji is also an active member of the International Trademark Association (INTA) and has been appointed to INTA's Non-Traditional Trademark Committee for the 2024-2025 term.

With his extensive experience, global perspective, and dedication to client success, Seiji Kurishita is a trusted advisor in the field of trademark law.

Koji Akanegakubo | Partner

Patent Attorney | Japan

- Designs & Patents
- Unfair Competition Prevention Act
- IP Litigation
- IP Transactions
- IP Valuations
- Customs Procedures

Koji Akanegakubo has been actively engaged in intellectual property law for over two decades, with a particular focus on design law. Since joining TMI Associates in 2013, he has been dedicated to assisting both domestic and international clients in securing and enforcing their intellectual property rights. His practice covers a wide range of IP matters, including design and patent prosecution, unfair competition law, IP disputes, legal opinions, IP transactions, IP valuation, and customs procedures.

Koji was registered as a patent attorney in 2002 and has since played an instrumental role in Japan's intellectual property landscape. Prior to joining TMI Associates, he worked at Sonderhoff & Einsel Law and Patent Office, where he gained extensive experience in handling global intellectual property matters.

Koji has also been actively involved in various professional and governmental committees. He served as an Executive Director of the Japan Patent Attorneys Association (JPAA) from 2019 to 2020 and as its Vice President from 2020 to 2021. He has been a member of the Design committee of the Intellectual Property Committee under the Industrial Structure Council since 2020. Furthermore, he contributed to the development of Japan's intellectual property system as an examiner for the patent attorney examination at the Industrial Property Council.

With his in-depth expertise in design law and intellectual property strategy, Koji provides comprehensive legal support tailored to the evolving needs of clients across different industries. His experience and leadership in the IP field make him a valuable asset in guiding clients through the complexities of intellectual property protection and enforcement.

Yoshiyuki Takanashi | Partner

Attorney-at-law | Japan & California

- Patent Disputes
- Information and Communication Technology
- IP transactions

Yoshiyuki Takanashi has been engaged in working on numerous patent cases, such as patent litigations, patent invalidation trials before the Japan Patent Office, and patent licensing cases. He has dealt with patent matters involving a wide range of technologies. In particular, based on his in-depth knowledge gained through his background in engineering, he has an expertise on patent issues relating to IT—particularly, telecommunications technologies.

Based on his technical background, he especially has developed proficiency in Standard Essential Patents (SEPs). He has represented various clients in patent disputes and licensing cases involving SEPs. His area of specialization spans a diverse range of SEP-related technologies, including 5G and 4G, Wi-Fi, and codec standards.

He also possesses extensive experience in cross-border patent disputes, collaborating with attorneys around the world, including the United States, Europe, and Asia. Notably, he has supported a Japanese company in a complex U.S. patent litigation and IPR matter, on both technical and procedural aspects.

Yoshiyuki has also been involved in numerous IT-related matters. He has given advice to IT companies, including startups, on patent and general corporate issues, as well as conducted litigations on disputes over system development projects.

He earned a master's degree in science in engineering and J.D. in Japan as well as LL.M. from University of California, Berkeley.

His unique combination of legal and technical knowledge enables him to provide our clients with remarkable value.

Sayaka Ueno | Counsel

Attorney-at-law | Japan

- IP/Patent
- IP transactions
- Pharmaceutical regulations
- Healthcare and biotechnology industries

Sayaka Ueno is an experienced attorney-at-law with a robust scientific background, specializing in Patent law, pharmaceutical regulations, and healthcare.
In the field of Patent, Sayaka has a proven track record in legal counseling and patent disputes, including infringement litigation, invalidation trials at the Japan Patent Office, and appellate litigation before the IP High Court. She also handles civil litigation involving complex technical issues. Her technical expertise spans a wide range of fields, including pharmaceuticals, medical devices, biotechnology, and genetic engineering.
She holds a Master's degree in pharmaceutical science. Her commitment to bridging science and law throughout her career is demonstrated by her passion for supporting the pharmaceutical, biotechnology, and health-tech industries. Sayaka serves on multiple committees at Japan's Ministry of Health, Labour and Welfare, contributing to policies on the National Project of Whole Genome Analysis, genomic medicine, the Genome Medicine Promotion Act, regenerative medicine, clinical research, and medical care.
With a global clientele, Sayaka provides legal support tailored to international business needs. She earned an LL.M. from the University of California, Berkeley School of Law, trained at a U.S.-based IP law firm, and gained experience in the U.K. as an external legal counsel for a biopharma company. Her in-house experience includes a two-year secondment to the IP division of a Japanese company, where she guided inventors in strategic patent applications and supported global IP defense efforts.
With her diverse background and comprehensive expertise, Sayaka Ueno is eager to deliver exceptional value to clients worldwide.

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 700 IP/Legal professionals, comprised of 570 attorneys (Bengoshi), 101 patent/trademark attorneys (Benrishi), and 62 foreign law professionals.

Attorneys (Bengoshi)	570
Patent / Trademark Attorneys (Benrishi)	101
Foreign Law Counsels	8
Foreign Attorneys	54
Advisors	16
Management Officers	2
Patent Engineers, Staff	481
Total	1,232

(As of March 2025)

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	33	Chemical	22
Mechanical	17	Bio, Pharma	7
Design (overlap included)	6	Trademark	22
IP Lawyers	110		

Awards

TMI, along with its attorneys, and its patent and trademark attorneys, has proudly received prestigious awards annually. Last 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 "The Global IP Awards 2024" at the WTR.

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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