

# *2019 JPAA IP Practitioners Seminar*



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February 25 – 26, 2019  
Phnom Penh, Cambodia

*Organized by*  
***The Japan Patent Attorneys Association (JPAA)***

*In cooperation with*  
*The Japan Patent Office (JPO)*  
*The Intellectual Property Association of Cambodia (IPAC)*

## Welcome Message



As the President of the Japan Patent Attorneys Association, I would like to announce that the JPAA IP Practitioners Seminar will be held in Phnom Penh, Cambodia, on February 25 and 26, 2019. The main aim of this Seminar is to provide the most up-to-date and accurate IP information to practitioners from across Asia. The Seminars have been held once every two years since 2005, and the coming Seminar will be the eighth. We are very proud to have held these Seminars continuously and successfully.

Although rules and practices for obtaining and protecting IP rights are slightly different from country to country, the core part of our work is universal. In our teaching in this Seminar, we will focus on the universal part of how to obtain and protect IP rights particularly regarding patents, design and trademarks. We believe that the Seminar will be beneficial for IP practitioners regardless of their level of

experience. Beginners as well as professionals in IP practices in Asian countries are welcome to attend.

The Seminar is sponsored and organized by the JPAA. The fee for attending the Seminar is fairly inexpensive because of this sponsorship. Many Japanese patent attorney speakers and tutors assist active discussions and eagerly teach about the practice of patents, design and trademarks. In each of the last seven Seminars, we accepted 100 or more participants.

We are looking forward to accepting a similar number for the next Seminar in 2019. We are quite sure that the next Seminar will also provide practical information and knowledge to all participants. I look forward to seeing you in Phnom Penh.

Mr. WATANABE, Keisuke  
President  
Japan Patent Attorneys Association (JPAA)



It is a great pleasure to announce that the JPAA IP Practitioners Seminar will be held in Phnom Penh, Cambodia.

We are holding this seminar continuously every 2 years and this is the 8th seminar since we held it in Singapore in 2005 for the first time. The International Activities Center, which is an affiliated organization of JPAA is the responsible body for this seminar, and about 40 patent attorneys are involved in the preparation of this seminar. As done in the past, we do our best to give the participants useful information as well as skills which would be required to be IP professionals.

The two-day seminar includes several plenary sessions for all participants, and workshops for the Patent Group and Trademark & Design Group. The workshops will provide you with unique opportunities on:

- drafting patent claims and preparing response to office actions (Patent Group), and
- learning important issues relating to trademark, design, GI and unfair competition

prevention law in Japan (Trademark & Design Group).

Many sessions, particularly workshops are planned to be done in an interactive way. Experienced members from JPAA will take care of the proceedings of the seminar. The experiences and knowledges that we got through past seminars will help us in the 8th seminar, and accordingly we are sure that we could have a useful, pleasant and enjoyable seminar this time, too.

We hope you will find the JPAA IP Practitioners Seminar rewarding in terms of education, networking, and the fostering and enjoyment of mutual friendships.

We look forward to seeing you in Phnom Penh.

Ms. HONDA, Keiko  
Director General  
International Activities Center, JPAA





The Intellectual Property Association of Cambodia is happy that the JPAA IP Practitioners Seminar will happen in Phnom Penh, Capital of Cambodia for the year 2019. We are looking forward to welcome all participants in Cambodia. It is great opportunity for all of us as IP practitioners and friends of IP to get together sometimes to get new development of IP Laws and practices in Japan and in other countries. It will also be great opportunity to get to know each other more and build our own networks or works cooperation. I experienced myself this when I participated the JPAA IP Practitioners Seminar in Hanoi in 2017. Not only I learnt new knowledge about IP but also I got to know new friends from different countries.

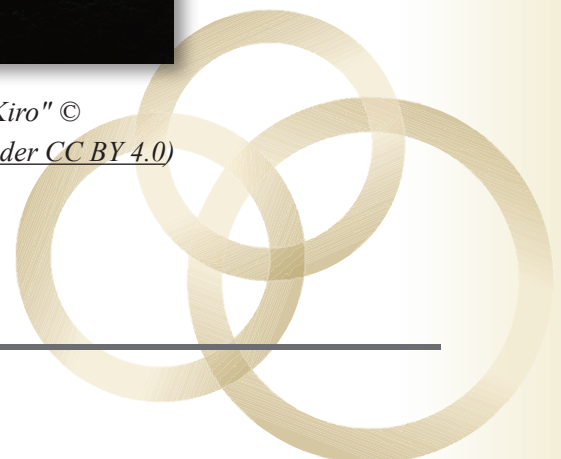
Phnom Penh is Capital of Cambodia. There are historic places to visit for your spare times such as Royal Palace, National Museum, Genocide Museum, riversides, Wat Phnom, Monument of Independence etc. Moreover, hotel rooms, foods and transportation are at good price. I hope you will enjoy your stay in Phnom Penh.

Mr. PICH, Ang

Attorney-at-Law, Trademark Attorney and Commercial Arbitrator  
President of Intellectual Property Association of Cambodia



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## Program

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During the two-day seminar, intellectual property practitioners will gain a practical overview of the Japanese intellectual property (IP) system and environment. Each session will provide applicants and their agents with specific tools and information which they can use to smooth prosecution, increase the value of the IP portfolio, and reduce overall costs. For all participants, the Monday morning sessions are designed to cover the Japanese IP system and environment in general.

On the other hand, participants may choose one of three groups, 1) Patent (Electrics and Mechanics Group), 2) Patent (Chemicals Group) or 3) Trademark & Design, starting from Monday afternoon.

1) Patent (Electrics and Mechanics Group) and 2) Patent (Chemicals Group) will be held in same room.

3) Trademark & Design Group will be simultaneously held in a different room.

Furthermore, a portion of these three group sessions will allow participants to share their real-world experiences in IP practice, and obtain feedback on the same from their fellow attendees.

A welcome reception will be conducted after the conclusion of the last Monday session. This reception will be an excellent opportunity to forge or renew acquaintances and network with each other.

## Monday, February 25

### All Participants

(Royal Ballroom (Salon 1+2))

**08:00 - 09:00 Registration**

**09:00 - 09:10 Welcoming Remarks**

**WATANABE, Keisuke**

**President, Japan Patent Attorneys Association (JPAA)**

**09:10 - 09:20**

**Welcome message from Intellectual Property Association of Cambodia (IPAC)**

**PICH, Ang**

**President of IPAC**

He would like to give all the attendees his welcome message from the IPAC.

**09:20 - 09:40**

**Welcome message from Kingdom of Cambodia**

**His Excellency CHAM, Prasidh**

**Senior Minister, Minister of Industry and Handicraft**

He would like to give all the attendees his welcome message from the Kingdom of Cambodia.

**09:40 - 10:10 Session M-1**

**JPAA's Outreach Activities for ASEAN countries**

**KURATA, Masatoshi**

**Vice President, JPAA**

In this session, we will explain the background, purpose and content of JPAA IP Seminar.

**10:10 - 10:30 Coffee Break**

**10:30 - 11:00 Session M-2**

**Activity of JPAA**

**WATANABE, Keisuke**

**President, JPAA**

We would like to explain the activities of the JPAA.

**11:00 - 12:00 Session M-3**

**JPO's Outreach Activities for ASEAN countries**

**KATO, Norihisa**

**Director, IP Department, JETRO Bangkok**

**Attache of Japan Patent Office(JPO)**

In this session, JPO's recent outreach activities for ASEAN countries

(including examination assistance to Cambodia and support for development of legal systems to Myanmar) will be explained.

**12:00 - 13:30 Lunch (Café Monivong)**

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## **Patent Group**

(Royal Ballroom (Salon 1))

### **13:30 - 14:10 Session P-1**

#### **How to Draft Claims for a Patent Application and How to Respond to an Office Action (Electrics and Mechanics)**

**IIZUKA, Takeshi**

In this session, a function of claims and general tips on how to draft claims for a patent application and how to respond to an Office Action (OA) are explained. Participants will experience practical steps for drafting claims and responding to an OA using an example case, which will help participants to prepare for the assignment to be discussed on the next day.

### **14:10 - 14:30 Session P-2**

#### **How to Draft Claims for a Patent Application and How to Respond to an Office Action (Chemistry)**

**SHIBATA, Fujiko**

Claim Drafting & Response to the Office Action for a chemical case are explained, because there are differences from those in electrical or mechanical cases. In this session, such differences between chemical cases and other cases belonging to other fields are explained, including points to focus on for drafting claims and preparing a response to the OA.

### **14:30 - 15:00 Session P-3**

#### **Explanation for Claim Drafting (Electrics and Mechanics)**

**UEDA, Shinichi**

This session explains how to find out a feature of an invention which is not disclosed and suggested by prior art. The client letter and the prior art of the assignment as well as some tips for claim drafting will be explained.

### **15:00 - 15:30 Coffee Break**

### **15:30 - 16:00 Session P-4**

#### **Explanation for Claim Drafting (Chemistry)**

**OHTANI, Kimio**

In this session, the materials and information necessary for the next day's group discussion will be explained. This session will help you in understanding the gist of an invention and the contents of prior arts. From the viewpoint of claim drafting, how to interpret the contents of "Example" that is specific to the chemical field will also be explained.

### **16:00 - 16:30 Session P-5**

#### **Explanation for How to Respond to an Office Action (Electrics and Mechanics)**

**KAMEYAMA, Ikuya**

In this session, a mock patent case at an Office Action stage will be explained. Specifically, a summary of an invention, an Office Action and Citations will be explained, which will help participants to prepare a set of an amendment and a summary of an argument on the next day.

### **16:30 - 17:00 Session P-6**

#### **Explanation for How to Respond to an Office Action (Chemistry)**

**SAKASHITA, Noriko**

In this session, participants will receive explanations on a summary of an Office Action with an invention and Citations. Each group will be required to prepare a draft claim amendment and the gist of arguments for the next day.

**18:00 - 21:00 Welcome Reception for all participants (Pool side Garden)**

## **Trademark & Design Group**

(Royal Ballroom (Salon 2))

### **13:30 - 15:00 Session T-1**

#### **Design Law and Practice in Japan**

**KUROKAWA, Tomoya**

This session will provide you with an outline of the design law and practice in Japan from both prosecution and enforcement aspects. Further, the speaker will discuss with the audience how design protection can be used to protect technology and to protect brands, and filing strategy of the same.

### **15:00 - 15:30 Coffee Break**

### **15:30 - 16:15 Session T-2**

#### **Non-Traditional Trademark Protection in Japan**

**TSUCHIYA, Fumihiko**

This session reviews progress in Non-Traditional trademarks, such as sound, motion, hologram, color and position trademarks that have been protected from 2015 in Japan and introduces registered cases especially for color trademarks and sound trademarks without word elements.

### **16:15 - 17:00 Session T-3**

#### **Introduction of Geographical Indications Protect System in Japan**

**INOUE, Hironori**

In this session, outlines of two GI (geographical indication) protection systems in Japan, the GI registration system legalized in 2016 and the Regional Collective Trademark System in trademark law, will be provided. Further, latest utilization and problems of the GI registration system will be discussed.

**18:00 - 21:00 Welcome Reception for all participants (Pool side Garden)**



## Tuesday, February 26

### Patent Group

(Royal Ballroom (Salon 1))

#### Training of Patent Practice

Participants in these sessions P-7 to P-10 for patent practice will have group discussions on how to draft claims and how to respond to office actions through two inventions. Finally, each group will give a presentation about their discussion for all the participants.

#### 9:00 - 10:30 Session P-7

##### Training of Claim Drafting ①

INOUE, Seiichi

In this session, participants will discuss how to draft claims for an invention in their group. They will prepare draft claims for their group based on the explanation of the gist of the invention and the prior arts.

#### 10:30 - 10:50 Coffee Break

#### 10:50 - 12:20 Session P-8

##### Training of Claim Drafting ②

INOUE, Seiichi

The leader appointed in each group will present the draft claims in front of all participants. The tutor of the group will comment on the presented draft response and finally a commentator will review the presented draft responses by the groups.

#### 12:20 - 13:50 Lunch (Café Monivong)

#### How to Respond to Office Actions 13:50 -17:10

In this session, the participants will discuss how to effectively respond to office actions, especially focusing on rejections as to novelty, inventive step, and description requirement. Some points for obtaining a strong patent with suitable broadness of invention will be discussed and explained.

#### 13:50 - 15:20 Session P-9

ARAI, Tamotsu

Participants will review the office action and prepare a draft response in a group.

#### 15:20 - 15:40 Coffee Break

#### 15:40 - 17:10 Session P-10

ARAI, Tamotsu

The leader appointed in each group will present the draft response in front of all participants. The tutor of the group will comment on the presented draft response and finally a commentator will review the presented draft responses by the groups.

### Trademark & Design Group

(Royal Ballroom (Salon 2))

#### 9:00 - 9:45 Session T-4

##### Introduction of Unfair Competition Act in Japan

MURAI, Koji

This session will provide you with basic information on Japanese unfair competition prevention law. Especially, unfair competition acts relating to use of another person's famous indication of goods/services will be discussed with some cases.

#### 9:45 - 10:30 Session T-5

##### Distinctiveness in Japanese Trademark Examination Guidelines

MASUDA, Ayaka

This session will provide you with an outline of the JPO's Examination Guidelines, focusing on the distinctiveness of trademarks. The distinctiveness of non-traditional trademarks, such as color marks, will be also discussed.

#### 10:30 - 10:50 Coffee Break

#### 10:50 - 12:20 Session T-6

##### Similarity judgement in Japan

TSUTSUI, Shoko

We will firstly study the conditions for similarity judgement of trademarks and goods/services according to the guidelines provided by the JPO. Secondly, we will study some recent appeal cases in an exercise style. Your outspoken participation is highly appreciated.

#### 12:20 - 13:50 Lunch (Café Monivong)

#### 13:50 - 14:35 Session T-7

##### Likelihood of Confusion - How do the courts decide?

SATO, Shunji

This session reviews several recent IP High Court decisions on the likelihood of confusion and compares those decisions to find out what factors were important to reach each decision.

#### 14:35 - 15:20 Session T-8

##### Mock Trial 1 (Trademark registration invalidation)

Moderator: MURAI, Koji

This session will provide you with basic information on a mock trial of a hypothetical trademark registration invalidation case, together with a presentation and lecture on ordinary trademark registration and invalidation under the Japanese trademark system.

#### 15:20 - 15:40 Coffee Break

#### 15:40 - 17:10 Session T-9

##### Mock Trial 2 (Trademark registration invalidation)

Moderator: MURAI, Koji

This session will conduct a mock trial of a hypothetical trademark registration invalidation case, together with participants.

## General Information

### Location

Raffles Hotel Le Royal  
92 Rukhak Vithei Daun Penh, Sangkat Wat Phnom, Phnom Penh, Cambodia  
Phone: + 855 23 981 888  
Fax: + 855 23 981 189  
URL: <https://www.raftles.com/phnom-penh/>

### Dates

February 25 and 26, 2019

### Language

English only

### Registration and Seminar Fees

Applications and payment of the registration fee of USD 200/person will be accepted online only on a first-come-first-served basis and will be open on December 17, 2018, and closed on February 8, 2019. If the number of applications reaches the limit, the registration will be closed before February 8. Links to the online registration form and additional information can be found on the JPAA website:

<https://www.jpaa.or.jp/old/?p=37838>

The registration fee includes all seminar materials, coffee breaks, lunches, and the Welcoming Reception. All other expenses, such as accommodation fees, are the responsibility of the attendees.

### Accommodations

Attendees are responsible for their own accommodations at Raffles Hotel Le Royal or other hotels. The attendees can book their own accommodations at Raffles Hotel Le Royal with following URL.  
<https://www.raftles.com/phnom-penh/>

### Cancellation and Liability

Attendees are encouraged to purchase travel insurance as the organizers will assume no liability and the registration fee is not refundable.

### Immigration and Visa Information

Attendees who wish to enter Cambodia should confirm visa information, such as visa exemption to Cambodia. Please check with the Cambodia embassy homepage in your countries to acquire more information.

### Smoking Policy

Smoking is only permitted in designated smoking areas.

### Organizing Committee

#### President

**WATANABE, Keisuke**, HOEI PATENT OFFICE

#### Vice President

**KURATA, Masatoshi**, SUZUYE & SUZUYE

#### Director General, JPAA International Activities Center

**HONDA, Keiko**, HONDA INTERNATIONAL PATENT & TRADE-MARK OFFICE

#### Chair, Organizing Committee

**INOUE, Seiichi**, Urban International Patent Firm

#### Vice-Chair, Organizing Committee

**MURAI, Koji**, Shinjyu GLOBAL IP

#### Speakers

**ARAI, Tamotsu**, Fuji Patent Law Firm  
**INOUE, Hironari**, AIWIL PATENT LAW FIRM  
**IIZUKA, Takeshi**, Iizuka International Patent Office  
**KAMEYAMA, Ikuya**, Asamura Patent Office, p.c.  
**KUROKAWA, Tomoya**, SOEI Patent & Law Firm  
**MASUDA, Ayaka**, AKIYAMA & ASSOCIATES  
**OHTANI, Kimio**, SEIWA PATENT & LAW  
**SAKASHITA, Noriko**, Alpha International Patent Firm

**SATO, Shunji**, TMI Associates

**SHIBATA, Fujiko**, Ayafune International Patents & Trademarks, PPC

**TSUCHIYA, Fumihiko**, Tsuchiya Patent Office

**TSUTSUI, Shoko**, TSUTSUI & ASSOCIATES

**UEDA, Shinichi**, GOTOH & PARTNERS

#### Tutors

**HASHIMOTO, Yukari**, NAGOYA INTERNATIONAL PATENT FIRM

**HIROTO, Kentaro**, Shiga International Patent Office

**KONISHI, Kay**, KONISHI & NAGAOKA IP Firm

**KOSHIKAWA, Takao**, KOSHIKAWA & Co.

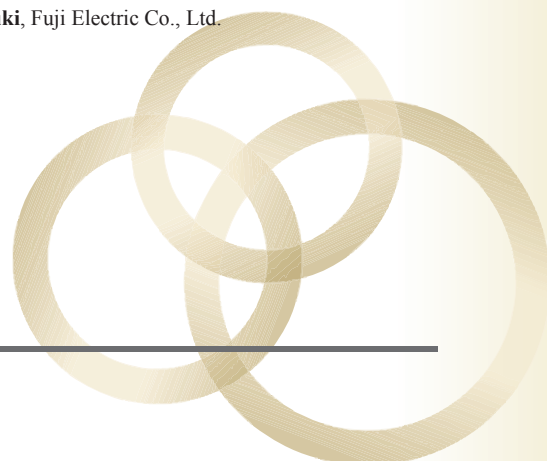
**LI, Jun**, LI PATENTS AND TRADEMARKS

**MIURA, Atsuko**, Okawa International Patent Firm

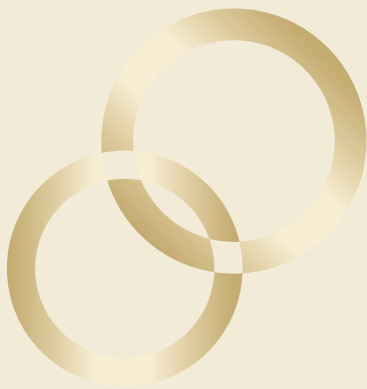
**NINOMIYA, Hiroyasu**, Sonderhoff & Einsel Law and Patent Office

**OHNISHI, Shogo**, S. OHNISHI & ASSOCIATES

**TANAKA, Hideyuki**, Fuji Electric Co., Ltd.







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