

# *2013 JPAA IP Practitioners Seminar*



*Tsuruma Park , Nagoya, JAPAN photo by Kenichi Morita*

March 4 - 5, 2013  
Bangkok, Thailand

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

*In cooperation with*  
*Department of Intellectual Property, Ministry of Commerce, Thailand (DIP)*  
*Japan External Trade Organization (JETRO)*  
*Intellectual Property Association of Thailand (IPAT)*

## Welcome Message



As president of the Japan Patent Attorneys Association, I would like to encourage you to attend the two-day JPAA IP Practitioners Seminar in Bangkok, Thailand, to be held on March 4 and 5, 2013.

The protection of intellectual property (IP) is a key in attracting investments from other countries and stimulating the development of domestic industries. Proper protection of IP is a tool and a driving force for moving developing economies into the next stage. This seminar will provide an important opportunity for learning up-to-date knowledge on intellectual property systems in different countries and gaining hands-on experience in patent and trademark practices.

During the two-day seminar, we will not only study the current status of IP protection in Japan and elsewhere, but we will also have small group sessions for patents and trademarks. The small group sessions will provide unique learning experiences for groups of four to eight participants on drafting patent claims and responses to office actions based on realistic scenarios, and also on issues important in protecting trademarks and taking actions against acts of unfair competition. In particular, corporate and private practitioners as well as academics and government specialists, all at the beginner and middle management levels, will benefit from this seminar, which focuses on new cutting edge issues including upcoming law and rule changes and newly emerging aspects of intellectual property protection.

The Japan Patent Attorneys Association was established in 1915 and currently has more than 9,600 members. This seminar is the fifth in a series of Asian seminars that the JPAA started in 2005. Each of these seminars attracted more than 100 participants. I hope that you will take advantage of this unique opportunity, and I look forward to seeing you in Bangkok in March 2013.

Dr. Shoichi Okuyama  
President  
Japan Patent Attorneys Association (JPAA)



It is a great pleasure to announce that the 2013 JPAA IP Practitioners Seminar will be held in Bangkok, Thailand on March 4 and 5.

It is said that there are no international borders for intellectual properties (IP), although each nation has its own legal system. Protection of IP is more important than ever before for promotion of national economy, which is, however, related to that of other countries, and IP practitioners who play a vital role in IP protection are expected to enhance their expertise from a global perspective.

In view of borderless importance of IP practitioners, the Japan Patent Attorneys Association which is an organization with a membership in excess of 9600 Japanese patent attorneys, or "benrishi", has been offering training courses on IP practices to IP practitioners in Southeast Asian countries every other year since 2005. The International Activities Center, which is one of affiliated organizations of JPAA, started preparation for the Fifth IP Practitioners Seminar and more than 30

staff members are working on it.

The two-day seminar includes sessions for all participants, and a workshop on Patent Law and a workshop on Trademark and Unfair Competition Law between which workshops participants can choose. During the sessions for all, participants will learn the latest developments in IP protection in Japan and discuss overview of IP issues in South-east Asian countries. The workshops then are designed respectively to provide participants with a scene where they discuss a specific field of IP practices in groups of a mixture of 4 to 8 participants from different countries.

On behalf of the International Activities Center, I hope that you will take this unique opportunity to further refine your practical skill and share our real world experiences in IP practice. I look forward to seeing you in Bangkok.

Dr. Shigeki Yamakawa  
Director General  
International Activities Center, JPAA





Sawasdee Krub

As President of the Intellectual Property Association of Thailand (IPAT), I would like to extend a warm Thai welcome to all participants attending the 2013 Japan Patent Attorneys Association IP Practitioners Seminar. We are most honored that Bangkok was chosen for this event and are grateful to Mr. Hideki Tanaka, Chairman of the JPAA Committee for his interest and dedication to the organization of this most worthwhile seminar.

I would like to extend a particular welcome to Mr. Tanaka, his Committee, JPAA and all of our friends and learned colleagues from Japan. I am certain that all participants will benefit from their in-depth knowledge of intellectual property—which they so generously impart to us. This seminar is a concentrated, two-day opportunity for all of us to learn new ways of looking at the issues that confront today's intellectual property professionals and practitioners. I encourage everyone to fully participate in all discussions available, both in the formal venues as well as outside the lecture halls. This is your chance to ask questions and voice your opinions.

On behalf of IPAT, it is with great pleasure that I welcome you to the 2013 JPAA IP Practitioners Seminar in Bangkok.

Mr. Satyapon Sachdecha  
President  
Intellectual Property Association of Thailand



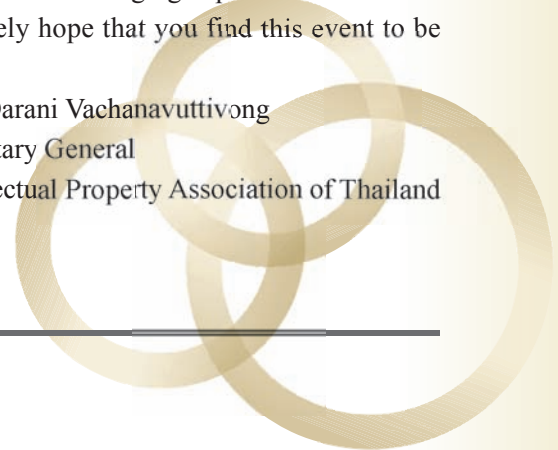
All of us in the Thai IP community are honored that Thailand has once again been given a great opportunity to host one of the most valuable seminars held in our region. The Japan Patent Attorneys Association (JPAA), in cooperation with the Department of Intellectual Property of Thailand and the Intellectual Property Association of Thailand, have been very kind in arranging the 2013 JPAA IP Practitioners Seminar in Bangkok during March 4-5, 2013.

I am confident that the program developed by Mr. Hideki Tanaka, Chairman of the JPAA Committee, will be very useful to all participants. I know that Mr. Tanaka and his team members have dedicated a great deal of hard work in organizing this seminar, and they deserve to be commended for their efforts.

The two-day program has been developed for all participants to gain important insights in intellectual property laws, case studies, and workshops in relation to patent, design, trademark, and copyright. We will have an opportunity to draw on the substantial knowledge and practical experience of the lecturers and guest speakers, who will provide a great platform for discussing, sharing, and exchanging expertise.

On behalf of the Intellectual Property Association of Thailand, I sincerely hope that you find this event to be beneficial to your practice.

Ms. Darani Vachanavuttivong  
Secretary General  
Intellectual Property Association of Thailand



## Program

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During the two-day seminar, intellectual property practitioners and creators 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 the two tracks, 1) Patent group or 2) Trade-mark group, starting from Monday afternoon.** These two group sessions will be simultaneously held in different rooms.

Furthermore, a portion of these two track 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 while enjoying performances, entertainment, and an abundant supply of food and drinks.

## Monday, March 4

### *All Participants*

(GRAND HALL PLAZA ATHENEE I on LEVEL 2)

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

**09:00-09:30 Welcoming Remarks**

**09:30-10:00 Session M-1**

*History and future of patent attorneys in Japan*

**OKUYAMA, Shoichi**

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

We would like to review the role of patent attorneys in Japan by looking at the history of patent attorneys and IP systems in Japan, and consider the importance and future prospects of the patent attorney profession.

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

*ASEAN and Japan: Further IP Interaction through AEC*

**OHKUMA, Yasuo**

**Director, IP Department for South East Asia**

**Japan External Trade Organization (JETRO)**

This session will overview the future prospects and challenges of ASEAN and Japan in the IP field through the establishment of the ASEAN Economic Community and further mutual interaction.

**10:30-11:00 Coffee Break**

**11:00-11:30 Session M-3**

*Trends and Developments Regarding Japan's Intellectual-Property Laws, Patent Filing Strategy and Related Topics*

**NAGAOKA, Shigeyuki**

Patent Law Amendment

IP High Court Decisions

Patent Filing Strategy

**11:30-12:30 Session M-4**

*How to obtain IP protections before putting a product in the market in each country.*

**Moderator: OHNISHI, Shogo**

**Speakers: TANI, Yoshikazu, JAPAN**

**TBA, Thailand**

**TBA, Indonesia**

Each panelist talks about how to get IP protections in each panelist's country. Like last seminar, three panelists from Japan, Thailand and Indonesia explain how to obtain IP rights (patents, designs and trademarks) in his/her country using an actual sample.

**12:30-14:00 Lunch**

**("THE REFLEXIONS" ON LEVEL 3)**

## ***Group For Discussing Patents***

**(GRAND HALL PLAZA ATHENEE I on LEVEL 2)**

### **14:00-14:45 Session P-1**

#### ***How to draft claims for a patent application?***

**TASAKA, Kazuaki**

How to draft claims for a patent application is discussed through comprehension of the essence of an invention, technical background, requirements for obtaining the patent, etc.

### **14:45-15:30 Session P-2**

#### ***How to Respond Office Action?***

**KONISHI, Kay**

This session will address granting procedure after patent application filing at Japan Patent Office. Then briefly to be addressed is how to overcome typical grounds for rejection, i.e., lack of novelty, non-inventive-step, non-unity and inadequate claiming/description.

### **15:30-16:00 Coffee Break**

### **16:00-16:30 Session P-3**

#### ***Explanation of the target invention for claim drafting practice***

**ENDO, Shusa**

Before claim drafting, the technical background of the target invention, problems of the prior arts and products (examples of the invention) will be explained. Then, basic approaches to drafting claims are briefly introduced.

### **16:30-17:00 Session P-4**

#### ***Explanation of the invention and the Office Action of the Sample for drafting remarks and amendment***

**TAKAHASHI, Yoshifumi**

The invention and the Office Action issued by Examiner of the Sample for drafting remarks and amendment will be explained in this session.

### **18:00-21:00 Welcome Reception for all participants ("THE VIEW" – POOL BAR ON LEVEL 4)**

## ***Group For Discussing Trademark***

**(GRAND HALL PLAZA ATHENEE II on LEVEL 2)**

### **14:00-14:30 Session T-1**

#### ***Distinctiveness of trademarks in Japan***

**TAKEUCHI, Kozo**

This session will focus on how to find distinctiveness of trademarks and how to treat distinctiveness under the Japan Trademark Law. Interesting board decision and court decision cases regarding distinctiveness of trademarks will be introduced.

### **14:30-15:00 Session T-2**

#### ***Madrid system in Japan***

**ASHIHARA, Emi**

This session gives an overview of current circumstances of use of Madrid system in Japan, its advantages and disadvantages.

### **15:00-15:30 Session T-3**

#### ***Trademark registered under Bad Will & Protection from Counterfeit***

**HIROSE, Fumihiko**

How to invalidate and get back stolen trademark which is registered under bad will. Utilize effective evidence to show registrant's evil intention.

The way and endeavor to eliminate counterfeit products.

### **15:30-16:00 Coffee Break**

### **16:00-17:00 Session T-4**

#### ***Trademark Registration Invalidation Trial***

**SAITO, Junko**

What if your well known trademark is registered in Japan by a party who used to be your licensee?

This session will introduce Japanese trademark invalidation system and discuss the grounds for invalidation in a short skit.

### **18:00-21:00 Welcome Reception for all participants ("THE VIEW" – POOL BAR ON LEVEL 4)**



## Tuesday, March 5

### Group For Discussing Patents

(GRAND HALL PLAZA ATHENEE I on LEVEL 2)

#### Training of patent practice

Participants of these sessions P - 5 to P - 8 for patent practice will have group discussions how to draft claims and how to respond to official actions through two inventions. Finally each group will give a presentation about their discussion for all the participants.

#### 09:00-10:30 Session P-5

##### Training of claim drafting ①

TASAKA, Kazuaki

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

#### 10:30-11:00 Coffee Break

#### 11:00-12:30 Session P-6

##### Training of claim drafting ②

TASAKA, Kazuaki

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 groups.

#### 12:30-14:00 Lunch

#### How to respond to the office action 14:00-17:00

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

#### 14:00-15:00 Session P-7

KOSHIKAWA, Takao

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

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

#### 15:30-17:00 Session P-8

KOSHIKAWA, Takao

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 groups.

### Group For Discussing Trademark

(GRAND HALL PLAZA ATHENEE II on LEVEL 2)

#### 09:00-09:30 Session T-5

##### Non-Traditional Trademark in Japan

MURAI, Koji

Some new types of trademark, non-traditional trademark, have been discussed in Japan recently. At this occasion, we would like to review what current traditional trademarks are, and which non-traditional trademarks are discussed to be protected in Japan.

#### 09:30-10:00 Session T-6

##### Protection of well-known trademarks in Japan

TAKEUCHI, Kozo

This session will discuss what are well-known trademarks, how to determine the well-known trademarks and how to protect them in the registration procedure and infringement actions.

#### 10:00-10:30 Session T-7

##### Trademark issues over the Internet

SUZUKI, Yasuhito

SUZUKI, Yasuhito raises several trademark issues over the Internet not only from a viewpoint of trademark owners but also a third party who would be involved in trademark infringement issues.

#### 10:30-11:00 Coffee Break

#### 11:00-11:30 Session T-8

##### Recent developments and problems in Japanese trademark law and Geographical indications

OZAKI, Takahiro

This session will show an overview of proposed law amendment with respect to new types of trademark, regionally based collective trademark, and geographical indications.

#### 11:30-12:30 Session T-9

##### Basic knowledge about Madrid Protocol

ASHIHARA, Emi

This session will show when to use the Madrid system, how to draft an application and to respond to a provisional refusal.

#### 12:30-14:00 Lunch

#### 14:00-14:30 Session T-10

##### Question & Answer

HIROSE, Fumihiko

Many topics are going to be discussed in this seminar concerning protection of the trademarks. If participants have any questions or topics to be discussed, please write it down in the attached sheet so that the answer will be discussed by the member of the committee.

#### 14:30-15:00 Session T-11

##### The Strategy for filing trademark applications against Japan

ARAI, Tamotsu

This session will discuss how to obtain trademark rights covering as broad coverage of the goods as possible without submitting any evidence, and discuss points to be paid attention during negotiation with licensee.

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

#### 15:30-16:00 Session T-12

##### Copyright Law and Practice in Japan

KONISHI, Kay

This session will address long experienced copyright law, practice and dos and don'ts in Japan, and in particular focus on a possibility of copyright protection for industrial design which Asian practitioner must know.

#### 16:00-17:00 Session T-13

##### Trademark Table Topics: Consent, non-traditional marks, service mark protection

MURAI, Koji

Please join one of three table topics. Attendees are requested to choose one of three table topics when they apply for seminar registrations. The proposed topics are "consent", "non-traditional marks", and "service mark protection". Active discussions expected among the attendees.



## General Information

### Location

**Plaza Athénée Bangkok, A Royal Meridien**  
61 Wireless Road (Witthayu), Bangkok 10330 Thailand  
TEL: +66 2 650 8800  
FAX: +66 2 650 8500  
URL: <http://www.starwoodhotels.com/lemeridien>

### Dates

March 4 and 5, 2013

### Language

English only

### Registration and Seminar Fees

Applications and payment of the registration fee of **USD100** - per person will be accepted online only, on a first come, first served basis and will be closed on February 22, 2013. Applications after the deadline can be made on the availability basis. However, any attendee information received after the deadline might not be included on the List of Attendees. Links to the online registration form and additional information can be found on the JPAA website:

[www.jpaa.or.jp/english/index.html](http://www.jpaa.or.jp/english/index.html)

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. A block of rooms at Plaza Athénée Bangkok, A Royal Meridien have been reserved at a discounted rate of **THB 5,000** - per night for a deluxe single room including a breakfast, hi-speed internet, taxes and service charge; attendees wishing to stay at Plaza Athénée Bangkok, A Royal Meridien are requested to contact the hotel directly to make reservations with the above mentioned discounted rate. The discounted rate (THB 5,000-) is applied until **January 31, 2013** on a "first come-first serve" basis. After February 1, 2013, any room reservation request will depend on the hotel availability.

### Organizing Committee

Director General, JPAA International Activities Center  
**YAMAKAWA, Shigeki**, YAMAKAWA International Patent Office

Chair, Organizing Committee  
**TANAKA, Hideki**, IBUKI IP-Law Partners

Advisory Members  
**TANI, Yoshikazu**, TANI & ABE, p.c.  
**OHNISHI, Shogo**, S.OHNISHI & ASSOCIATES  
**KOSHIKAWA, Takao**, KOSHIKAWA & Co.  
**NAGAOKA, Shigeyuki**, Fujimura Patent Bureau, P.C.  
**HIROSE, Fumihiko**, HIROSE Int'l Patent & Trademark  
**TAKEUCHI, kozo**, Fukami Patent Office

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

Panelist  
**TANI, Yoshikazu**, TANI & ABE, p.c.

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61 Wireless Road, Bangkok 10330 Thailand  
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FAX: +66 2 650 8500

Reservations:  
<https://www.starwoodmeeting.com/Book/Japan>

In addition, the following hotel is available at a discounted rate of **THB 3,300 -net** per night.

Novotel Bangkok Ploenchit Sukhumvit  
566 Ploenchit Road,  
Lumpini, Patumwan,  
Bangkok 10330, Thailand  
TEL: +66 2 305 6000  
FAX: +66 2 305 6001  
Email: [H7176-SL@accor.com](mailto:H7176-SL@accor.com)

Reservations:  
Please download the application form the JPAA website [www.jpaa.or.jp/english/index.html](http://www.jpaa.or.jp/english/index.html), and send the form directly to Novotel Bangkok Ploenchit Sukhumvit after filling out the necessary information of the attendees. Room reservation is a "first come-first serve" basis.

### 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

A foreign visitor who wishes to enter the Kingdom of Thailand is required to hold a passport with at least 6 month validity from the arrival date. Certain countries' nationals are required to obtain a visa when entering the Kingdom. For more information, please visit the website [www.mfa.go.th/main/en/services](http://www.mfa.go.th/main/en/services).

### Smoking Policy

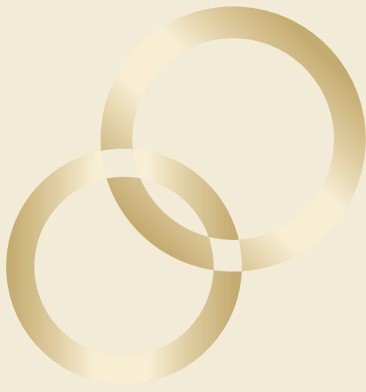
Smoking is only permitted in designated smoking areas.

### Speakers

**ARAI, Tamotsu**, Fuji Patent Law Firm  
**ASHIHARA, Emi**, YKI Patent Attorneys  
**ENDO, Shusa**, AKIT patent and trademark attorneys  
**HIROSE, Fumihiko**, HIROSE Int'l Patent & Trademark  
**KONISHI, Kay**, NICHIEI Patent and Trademark Attorneys, P.C.  
**KOSHIKAWA, Takao**, KOSHIKAWA & Co.  
**MURAI, Koji**, Shinjyu GLOBAL IP  
**NAGAOKA, Shigeyuki**, Fujimura Patent Bureau, P.C.  
**OZAKI, Takahiro**, Ozaki Patent Firm  
**SAITO, Junko**, Ishida & Associates  
**SUZUKI, Yasuhito**, ABE, IKUBO & KATAYAMA  
**TAKAHASHI, Yoshifumi**, Willfort International Patent Firm  
**TAKEUCHI, kozo**, Fukami Patent Office  
**TASAKA, Kazuaki**, Nagasawa Patent Firm/The Tokyo-Marunouchi Law Offices

### Tutors

**INOUE, Seiichi**, Urban International Patent Firm  
**IWAKIRI, Atsushi**, Corporate IP Professional  
**KATAYAMA, Ken-ichi**, OHNO & PARTNERS  
**MORI, Toshinari**, S. KITAMURA PATENT OFFICE  
**MORITA, Kenichi**, SO-A International Patent Firm  
**SHIMA, Miyuki**, Otsuka Pharmaceutical Factory, Inc.  
**SUZUKI, Yasuhiro**, YOSHIDA, YOSHITAKE & ARITA PATENT OFFICE  
**YOSHIZAWA, Hiroshi**, OKABE INTERNATIONAL PATENT OFFICE



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