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March 2023

IP Friends Connections

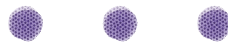
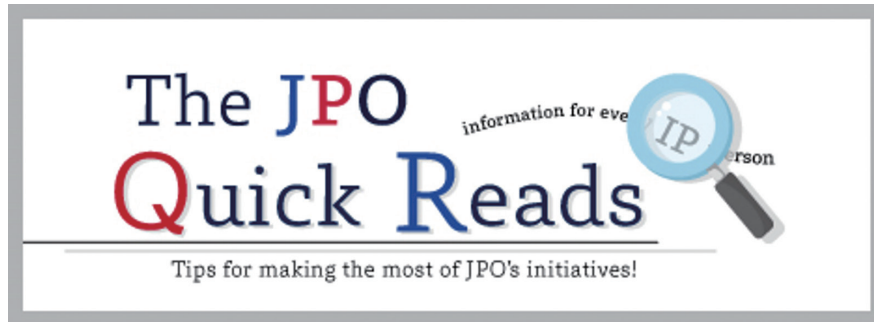
This Magazine is published as part of the Intellectual Property Cooperation in Human Resource Development Program of the Japan Patent Office.

The aim of this Magazine is to follow up on training programs through the dissemination of information to IP Friends, those who have completed training courses of the above program.

We very much hope that the information in this publication related to intellectual property, and the comments from either IP Friends or lectures, will prove beneficial to you in your work.



JAPAN PATENT OFFICE



In “the JPO Quick Reads”, the JPO introduces its initiatives and relevant information mainly in relation to patent examinations. Its weekly updates would help users to understand various JPO measures and to take advantage of using them. We also hope users feel welcome to the JPO service. We have received some good feedback from our users, through Twitter and LinkedIn, saying that the JPO Quick Reads are informative and enlightening with frequent updates. The URL and some popular topics are as follows:

[The JPO Quick Reads]

<https://www.jpo.go.jp/e/news/quickreads/index.html>

Reference:

Updates posted on the JPO English website, including topics of “the JPO Quick Reads” will also be posted on the following social media.

[JPO Official Twitter]: https://twitter.com/JPO_JPN

[JPO Official LinkedIn]: <https://jp.linkedin.com/company/japan-patent-office>

[Popular topics]

- Trilateral Heads of Office Meeting 2022 (29 November 2022)
The heads of Patent Trilateral met together offline for their annual meeting!

Early this month, the Trilateral Offices -(the JPO, the EPO and the USPTO)- held their 40th Conference hosted by the USPTO. At the meeting, which took place in a physical format for the first time in three years, the heads addressed topics of mutual interest, with an emphasis on the aspect of SMEs and IP ecosystem.

- ID5 Annual Meeting 2022 (22 November 2022)
The JPO has been a proactive collaborator in the Industrial Design 5 Forum (ID5)!

Late last month, the eighth Annual Meeting by the IP offices of Industrial Design 5 (ID5) was held in a hybrid format hosted by the EUIPO. At the conference, twelve cooperation projects were

discussed, including three JPO-(co-)led items, namely, “Study on the Admissibility of Internet Information as Legitimate Disclosure for Novelty Examinations”, “ID5 Statistics” and “ID5 Recommended Design Practices.” In addition, four new projects were approved, including “Indication for Registered Designs” co-led by the JPO and USPTO.

- Enhanced US-JP Collaborative Search Pilot Program (6 December 2022)
Petition filing for the US-JP Collaborative Search Pilot Program has been simplified!

Running third phase of the US-JP Collaborative Search Pilot Program (CSP), which was scheduled to expire at the end of October this year, has been extended for another two years. The avenue continues to be available for applicants who cross-file patent applications in both jurisdictions, providing examination results in an expeditious and concurrent manner.

Remarkable improvement in this context is that the offices concerned (the USPTO and the JPO) agreed to introduce a single petition form for the Pilot. Now applicants wishing to take advantage of the benefits of this CSP can get on track by simply submitting a single form to either of the two offices.

- Patent Examination Guidelines in Manga -Non-English version- (20 December 2022)
JPO’s “Examination Guidelines in Manga: AI/IoT Edition” is now available in a couple of Asian languages!

As reported here previously (on 30 November 2021), English version of Manga explaining our AI/IoT examination guidelines has been available on our website since October last year. We have recently released two more different translations in collaboration with our partner organizations for international cooperation.

In more concrete terms, Vietnamese and Thai were added to the list of languages available; the former was prepared in liaison with the Japan International Cooperation Agency (JICA) and the latter with Japan External Trade Organization (JETRO).

We wish to invite overseas users, especially those in ASEAN region, to try reading the cartoon in a more familiar language than English.

- JPO-DIP Thailand Patent Examination Training Program (13 December 2022)
JPO’s on-site training for patent examiners in emerging countries resumed!

As previously indicated in these columns (posted on 6 September 2022), early last month, our Global Patent Academy (GPA) provided a patent examination training course in a physical format for the Department of Intellectual Property (DIP) of Thailand.

It was the first overseas on-site training opportunity since the outbreak of COVID-19. Four International Training Instructors of the GPA were invited as lecturers, communicating interactively with DIP patent examiners.

FY2022 Training Courses Completed (Yearbook)



Training was conducted in three ways - online, in-person and in a hybrid style - and the number of trainees who completed each course is shown below.

Participant Numbers

◆ Online Courses

Course Title	*Number of participants who completed the course
Trademark Examination Under the Madrid System	18
Academia-Industry Collaboration and Technology Transfer	24
Patent Examination (Basic Program)	25
Patent Examination Management for Managers	15
Patent Examination for Middle Eastern and African Countries	21
Information Technology	13
General IP Office Management	14
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◆ Hybrid Courses

Practitioners Specializing in Trademarks	16
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◆ In-person Courses

Anti-Counterfeiting Measures for Practitioners	19
IP Trainers	17
Trial and Appeal Systems	13
Substantive Examination of Trademarks	19
Design Substantive Examination and Accession to the Hague Agreement	23

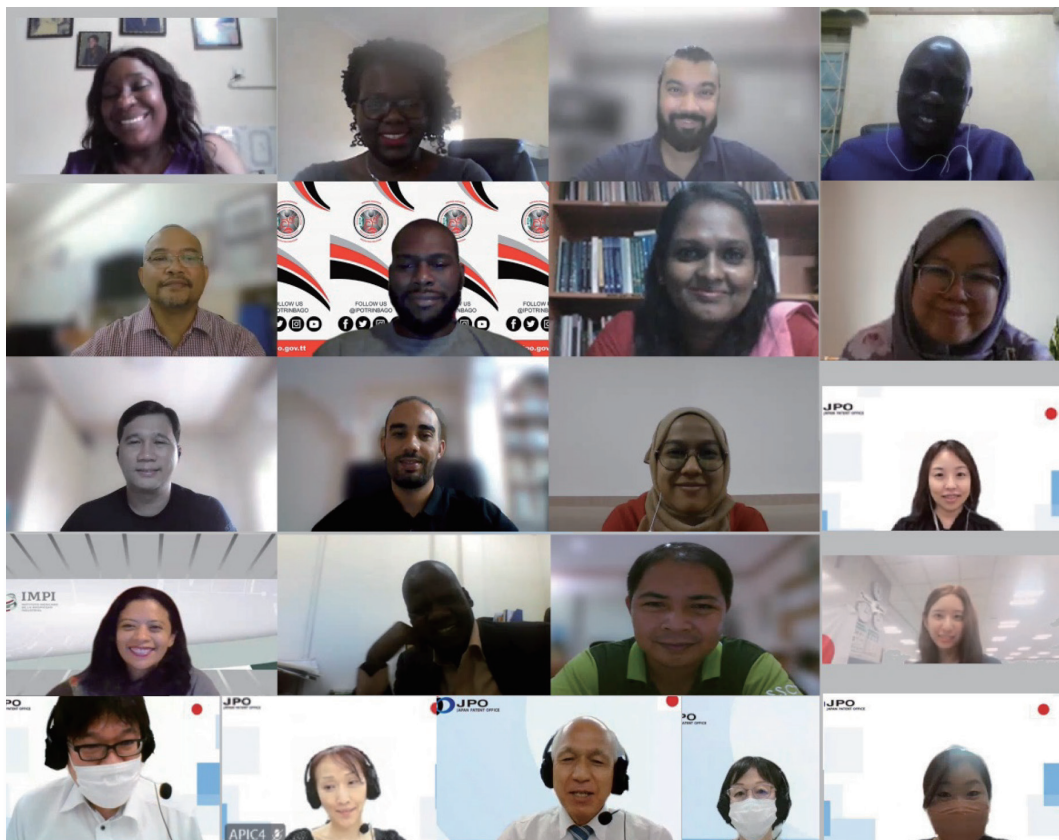
Group Photos

* Only those who gave permission to post their photos are shown here.

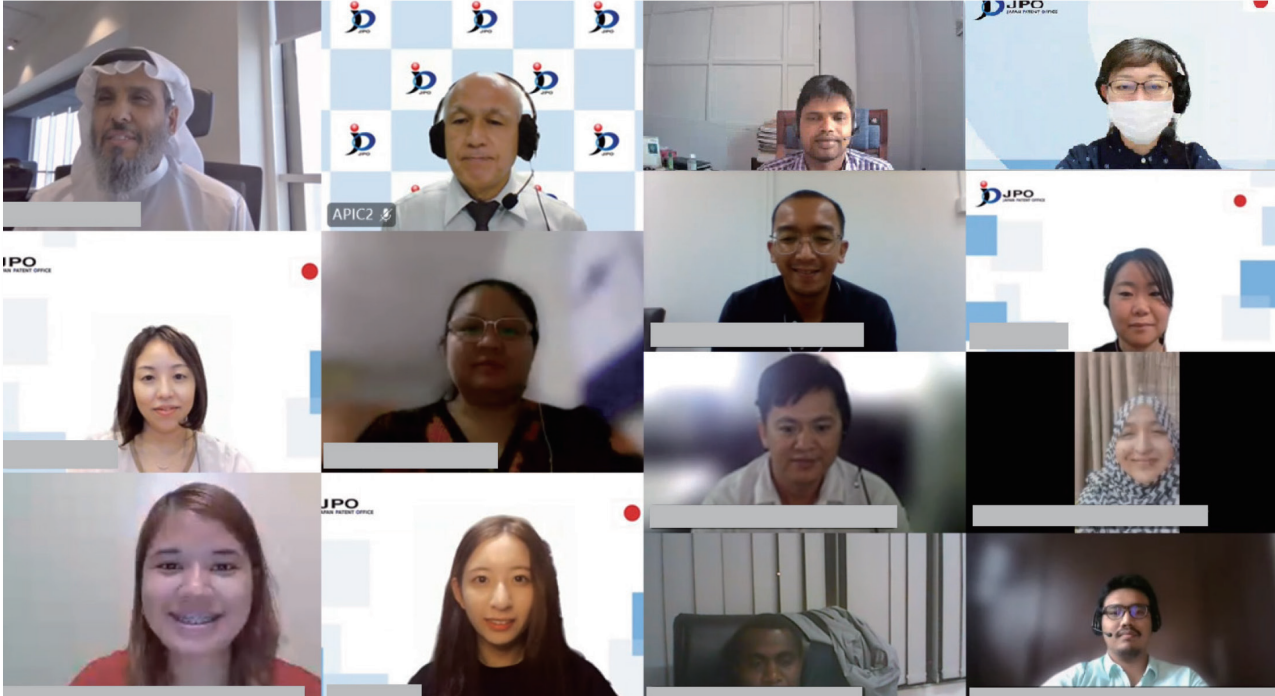
◆ Online Courses



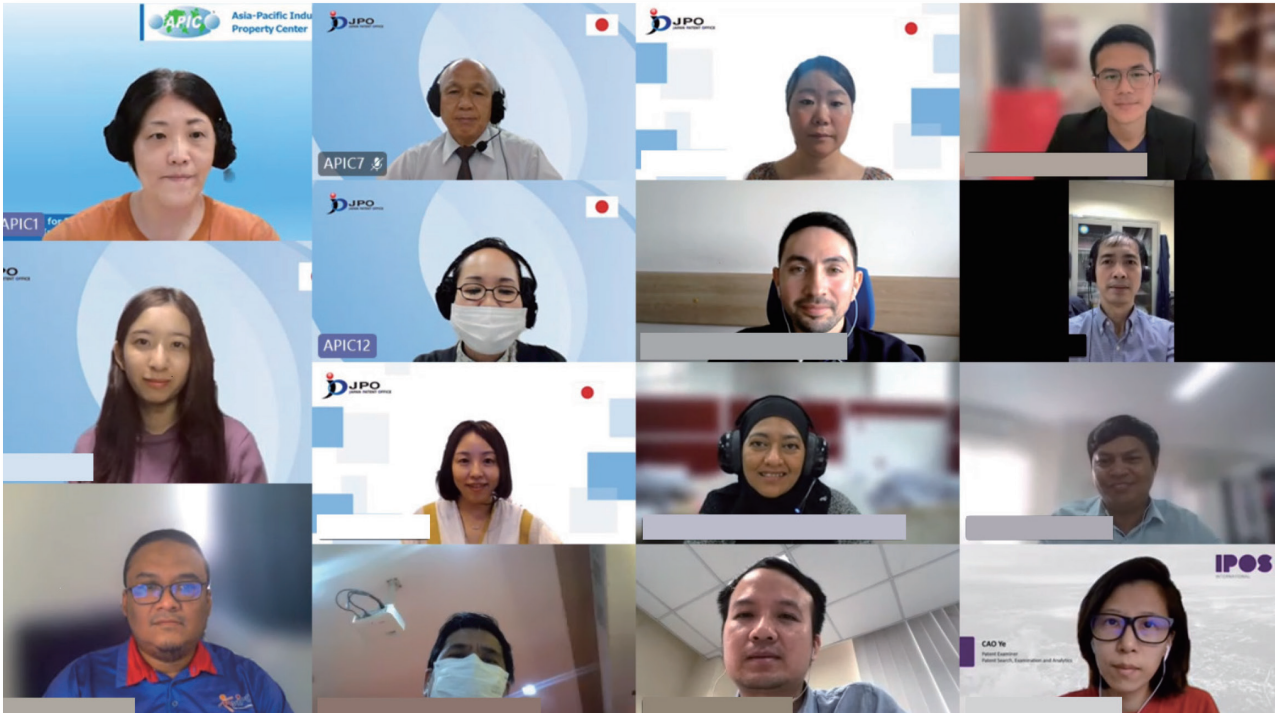
Trademark Examination Under the Madrid System



Academia-Industry Collaboration and Technology Transfer



Patent Examination (Basic Program)



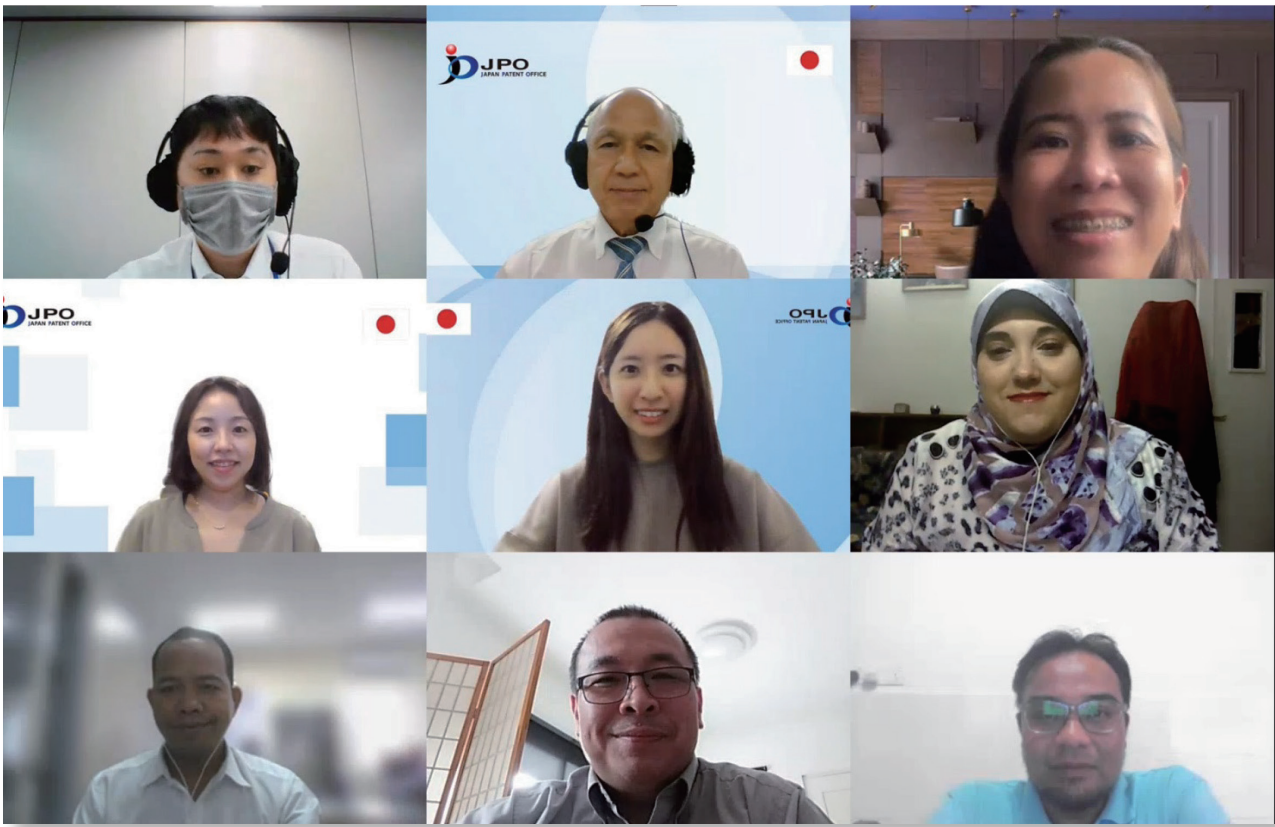
Patent Examination Management for Managers



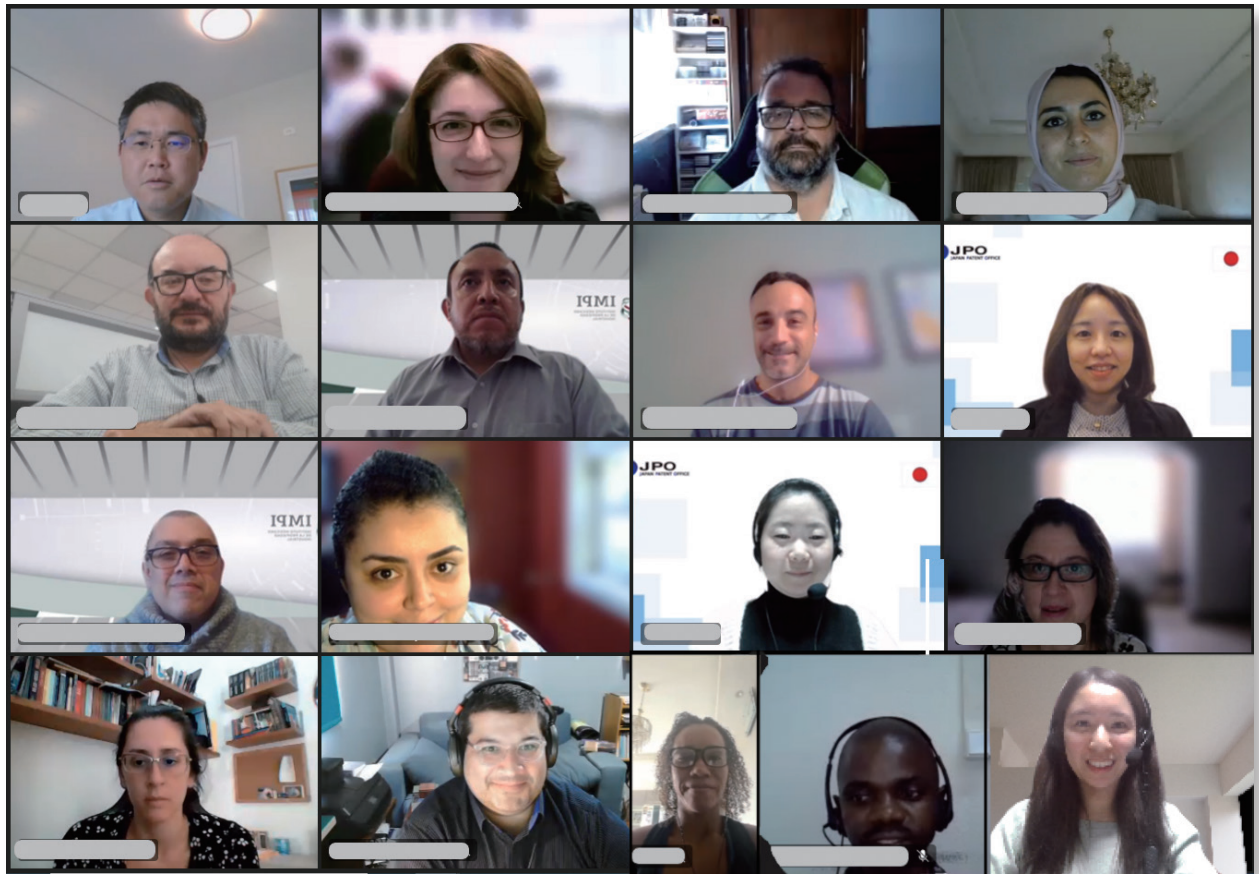
Patent Examination for Middle Eastern and African Countries



Information Technology



General IP Office Management



Patent Examination in Specific Technical Fields

◆ Hybrid Courses



Practitioners Specializing in Trademarks



Practitioners Specializing in Patents



Operational Patent Examination Training Program (OPET)

◆ In-person Courses



Anti-Counterfeiting Measures for Practitioners



IP Trainers



Trial and Appeal Systems



Substantive Examination of Trademarks



Design Substantive Examination and Accession to the Hague Agreement

FY2022 Follow-up Seminars



Follow-up Seminar Held in Cambodia

A seminar was held in Phnom Penh, Cambodia on October 25, 2022. It was organized by the Japan Patent Office in cooperation with the Department of Intellectual Property (DIP) in Cambodia's Ministry of Commerce, and conducted by the Japan Institute for Promoting Invention and Innovation. This was the third time the seminar has been held in Cambodia, having been held previously in 2015 and 2018. The 2022 seminar was attended mainly by DIP personnel, but also by participants from universities, research institutes and law firms. Many training course alumni also attended, with approximately 60 participants in total.

Based on a request from the DIP, this seminar focused on trademark registration and the mechanism of IP administrative enforcement.

H.E. OUK Prachea, Secretary of State of the Ministry of Commerce, began the seminar by stating that although Cambodia is making consistent progress in the field of IP, there is still room for improvement in raising public awareness of IP. He also noted that the seminar was very timely from the perspective of taking full advantage of IP's potential benefits. Mr. Masaki Okamoto, Regional Cooperation Office Director of the Japan Patent Office (JPO) International Cooperation Division, commented that Cambodia is making steady and proactive efforts in the examination and utilization of both intellectual property and administrative enforcement, and that he hoped this seminar would help strengthen this.

The Japanese side gave a broad introduction to the trademark registration examination process and system, as well as anti-counterfeiting measures in Japan; while the Cambodian side spoke on the trademark registration system, trademark infringement, and remedies.

The morning and afternoon sessions each had 50 minutes allocated for questions and answers. Many questions were posed right up until the end of the session, indicating the high level of interest among participants. In addition, after the Japanese lecture on raising public awareness, a lecture on raising awareness in Cambodia was added at short notice on the day of the seminar. This made the seminar even more beneficial for the participants, who were able to obtain information on raising awareness in both countries.

Opening Ceremony



H.E. OUK Prachea, Secretary of State, Ministry of Commerce (fifth from left) and Mr. OKAMOTO Masaki, Director, Regional Cooperation Office, International Cooperation Division, JPO (fifth from right) with other seminar organizers

Seminar in progress



Follow-up Seminar Held in India

A seminar was held in New Delhi, India on December 17, 2022. It was hosted by the Japan Patent Office (JPO) in cooperation with Cell for IPR Promotion and Management (CIPAM) of India, and implemented by the Japan Institute for Promoting Invention and Innovation. This seminar marked the tenth such event held in India.

Under the theme of "Considering Attractive Designs," this year's seminar included design creation activities for junior and high school students, in addition to serving as a follow-up seminar for past trainees.

The morning session of the seminar began with opening remarks by Dr. Aruna Tiwari, Assistant Vice President of CIPAM, and Mr. TOMISAWA Takeshi, Director of the International Cooperation Division of the JPO. Lectures were then given by Mr. YOSHIOKA Yuji, a designer from TOTO LTD. and Mr. Anuj Prasad, a designer and CEO of DESMANIA, India. The designers next engaged in a dialogue, wherein they stated their agreement on the elements that are important when considering design. First, they said that design should have a consumer's perspective, and be eco-friendly. They also noted that minimalist design should be kept in mind, but not superficially; since functionality and aesthetics should be given full consideration and made as minimalist as possible. Finally, they said that in order to ensure originality, the designers should first procure the designs to be selected and then characterize them by exchanging opinions with the people involved. After a short break, Mr. HIRATA Tetsuya of the JPO and Mr. Sanjaykumar Patel, a patent attorney at EXCELON IP in India, gave presentations on the design systems in their respective countries. Finally, the instructor of the afternoon design creation activities, Mr. Vatsal Agrawal of The Design Village, gave a lecture on the impact of design. The seminar was attended by about 80 participants, mainly lawyers and IP attorneys from private law firms, universities, and research institutes, as well as government agencies involved in fashion, science and technology.

A total of 85 students in grades 8-12 from two different schools participated in the afternoon design creation activities. Divided into groups of seven to eight students, they worked together in their groups to design and complete a task under the topic of "creating an amusement park". At the end, when each group's work was gathered in one place for assessment, it looked like a lively amusement park with a variety of colorful and unique playground equipment. The students enjoyed themselves so much that they did not even take the break that had originally been planned.

Group photo of seminar speakers

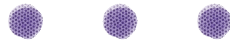


Mr. TOMISAWA Takeshi, Director, International Cooperation Division, JPO (fourth from left) and **Dr. Aruna Tiwari**, Assistant Vice President, CIPAM (fourth from right) with other seminar organizers

Design creation activities



Introduction of FY 2022 Long Term Fellowship Researchers



Knowledge is the Rising Sun



Mr. Eugenio Alegria (Brazil)



“Saúde e alegria!” Health and joy! These are some of the wishes and gifts that we seek to share with our peers in this moment of overcoming that unites all humanity. Thanks to solidarity and science, whose industrial property and innovation are also raw materials for this journal, researchers from the four corners of the Earth, like me, are once again able to enjoy the opportunity traditionally offered by Japan to this rich exchange of knowledge. After 4 doses of vaccine and with the “alegria” that I carry in my name, I arrived in the Land of the Rising Sun to learn a little more about everything that attracts me so much to Japan, among which the subject of Trademarks is one that stands out.

My name is Eugenio, last name Alegria, an inspiring word that means “joy” in the 9 Portuguese-speaking countries that are spread over 4 continents. My country is called “Land of Carnival and Soccer”, also known as Brazil, and is more than 17,000 km from Japan and about 40 hours away by plane. The sun, however, takes less time to make this journey between the two countries (about 12 hours) so in Brazil, we see the sun arriving 12 hours after its rise in Japan every day.

On the other side of the planet, I work as a trademark examiner at the Trademarks Department of the National Institute of Industrial Property (INPI), the federal authority responsible for analyzing trademark applications. I have been carrying out this strategic function as a federal civil servant since 2006, when I was admitted through a public tender a few days after completing my last degree in Cinema and Video. At our Institute, as at the Japan Patent Office, one of the riches we enjoy is the possibility of interacting and learning with trademark examiners from different backgrounds, such as dentists, engineers, publicists, lawyers, pharmacists, and even filmmakers. This plurality of academic and professional backgrounds helps us to support decisions in the vastly different market segments targeted by the nearly 400,000 trademarks applied for annually in Brazil. With regard specifically to the subject of “classifica-

tion of goods and services”, our team’s qualifications favor the extension and depth of discussions for a better understanding of those goods and services, their innovations and the interactions that are established between them and between their market segments.

The INPI Trademarks Department has had a Goods and Services Classification Committee since 1999, initially dedicated to facilitating the transition from the old national classification of goods and services to the Nice International Classification in the filing and examination of trademark applications in Brazil. Although not a signatory to the Nice Agreement, Brazil has voluntarily adopted the International Classification since the year 2000. This Committee, of which I have been a member since 2010, is also responsible for formally advising the Trademarks Department and procedural committees on national and international issues related to the classification of goods and services and market similarities, as well as for guiding trademark examiners and external users of INPI services on classification and specification of goods and services.

Since 2013, the year in which I had the opportunity to assume the position of Vice-Coordinator of the Committee, the Trademarks Department has dedicated greater attention to the theme “marketing affinity”, subsidized by studies by the Committee. The main goal is to obtain objective and clear criteria and uniform and predictable decisions regarding the evaluation of similarity between trademarks and the similarity between goods or services targeted by the trademarks. Starting on some fundamental premises of Marketing theory, established by Neil Borden and developed by Philip Kotler and Jerome McCarthy, known as Marketing Mix (or the 4Ps and the 7Ps of Marketing), our classification team suggested the premises of similarities among goods and services. Subsequently, the resonance of these principles was sought in the practices of other offices, such as the EUIPO, as well as in the history of applicants and their application of trademarks in their segments and the decisions published by the Department of Trademarks. The conclusions were later treated by our procedures team to be incorporated into the Trademarks Manual. The Committee also started the design of an illustrative matrix of similarities among Nice classes that would later be used as the basis of a taxonomy of goods and services.

Our Committee has been attentive to Similar Group Codes (SGC), developed by the JPO, for at least nine years. This system, that prioritizes the grouping of goods, services and trademarks based on similarities of goods and services and not based on the coincidence of Nice classes, has always seemed to us an effective way of searching for conflictive prior trademarks by means of reliable, fair and predictable parameters, with great impact in the quality and the speed of decisions by trademarks examiners. In the past few years, we have been able to receive some information from the JPO on this matter through several ways. At least 2 colleagues at INPI who attended the JPO/APIC courses in Japan could share with us preliminary information about SGC. Along with this, a training course given by the JPO’s trademarks examiners at INPI headquarters and an online lecture given by Mr. Hikaru Nakajima from the Japan Consulate in Rio de Janeiro, in 2021, offered some additional information about this subject. Since then, the vanguardist Japanese experience in this matter has stood out in our discussions.

Unfortunately, the urgent necessity of fighting against a recurrent growth in the backlog of applications due to a recurrent mismatch between the number of examiners and the number of applications interrupted the progression of our studies. Nevertheless, the unique opportunity provided to me by the JPO and APIC, and supported by INPI’s Directorship, to attend this fellowship program named “Trial Introduction of Similar Group Codes”, reignites this subject in the Brazilian IP office. As soon as we can manage our backlog of applications and lack of employees, the objective to be pursued by the Classification Committee is going deeper in the organization of a similar group codes project at INPI.

As I mentioned at the beginning of this article, “Trademarks” is just one of the many interests that Japan has awakened in me since I was a child. Maybe that’s why I believe with such conviction that

Japanese traditions and culture have a lot to contribute to the formation and maturation of a young country that is still taking its first steps and starting to exercise its independence to walk in territories other than just the domestic one. Brazil has the largest Japanese community outside of Japan, made up of around 2,000,000 Japanese and Japanese descendants. This in itself means that Japanese culture is very familiar to all Brazilians, in addition to its world-renowned technological and innovative facet and its widely recognized brands of cars, home appliances and video games.

Judo and Jujitsu are two of the most popular sports among Brazilian children and through these arts, we learn to reconcile past and present, we learn respect for elders and masters and the value of our health. Japanese martial arts reflected in *Tokusatsu*, such as *Super Sentai*, expand our understanding of the value to be given to all kinds of life and teamwork. Those who were born in the 1970s and 1980s in Brazil probably had one of their first contacts with the concept of ecology watching a famous Japanese *Tokusatsu* in our country called *Spectreman*.

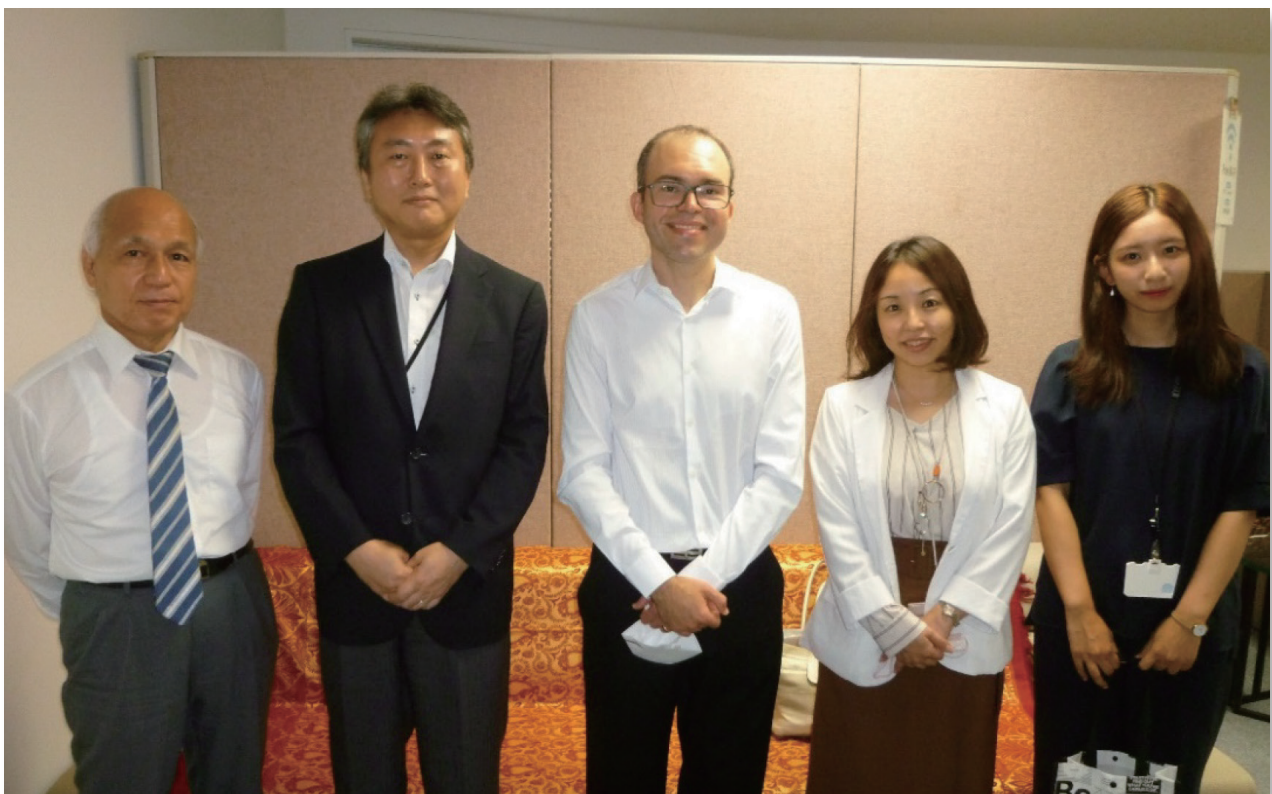
Going beyond, through the great master of Japanese Cinema Akira Kurosawa, we discover that behind profound cultural differences, there remains the same human being, in the East or in the West, imperfect, but equally valiant and dreamy. And as far as dreams are concerned, few like Hayao Miyasaki are able to prove to us the truth of the verses of one of our famous sambas that says that “dreaming costs nothing”. To a poor and suffering people like the Brazilians, Yasugiro Ozu comforts us with his perspective of beauty in the simple everyday life and in the simple affective relationships of ordinary families. And Mizoguchi inspires us to overcome the injustices that separate men and women in a profoundly unequal society.

My admiration and gratitude for so much that Japan has offered me for more than 30 years would make me go on for many more pages, but here I end by highlighting the value of Osamu Tezuka, who I consider to integrate all these perspectives into a monumental work, universal and timeless, accessible to children and adults, ranging from Buddha’s story to the technological vanguard of *Astroboy* and passing through the “girl power” and the ecological conscience of the *Princess Safiri* story

Dōmo arigatō, Nihon! Having overcome the suffering that has united humanity in recent years, let us extract knowledge from it as the main ingredient of our union in the coming years. May the JPO and APIC initiative be a rising sun on that horizon. Only love and knowledge unite and free us.

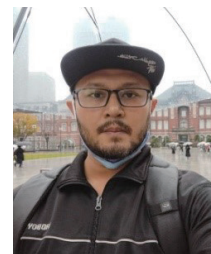


At Mt. Takao (October, 2022)



From left: **Mr. OGIYA Takao**, Director general, APIC; **Mr. TOMISAWA Takeshi**, Director, International Cooperation Division JPO; **Mr. ALEGRIA Eugenio (author)**; **Ms. ONO Sayaka**, Deputy Director International Cooperation Division, JPO; **Ms. KOBAYASHI Suzu**, International Cooperation Division, JPO

Improving Patent Examination Guidelines in the Field of Biotechnology in Malaysia



Mr. Mohd Sukri bin Mohd Nor (Malaysia)



Hi! I am Mohd Sukri bin Mohd Nor from Malaysia. Currently, I am working as a Patent Examiner at the Intellectual Property Corporation of Malaysia (MyIPO). Before joining MyIPO in 2008, I worked at several places. I worked at McDonald's restaurant as Trainee Floor Manager for a year, and then worked at Duopharma Biotech Sdn. Bhd, a pharmaceutical company producing generic drugs in Malaysia, as a Management Trainee in the Quality Assurance Unit. I was there for almost one year before I got the offer to join MyIPO. This was a blessing, because I have been exposed to intellectual property since my bachelor's degree study, and I also happened to choose a patent examiner position in the government job portal during my final year of university. The rest is history.

There are now 77 patent examiners in total at MyIPO, of which 42 are in the Patent Engineering Division, and the rest in the Patent Science and Traditional Knowledge (TK) Division. Each division is divided into smaller units of specific technical fields with 17 units altogether, among which ten are under the Patent Engineering Division, while seven are in the Patent Science & TK Division. I am currently holding the Head of Unit position for the Phytochemistry and Traditional Knowledge Unit, which is one unit besides six others under the Patent Science and TK Division.

My current responsibilities as Head of Unit are to conduct Quality Unit Control checks (QuC) for the substantive examination reports that are submitted to the patent applicants, as well as to perform substantive examination work for patent applications related to biotechnology and traditional knowledge-related inventions, preparing monthly reports for the Malaysia Traditional Knowledge Digital Library (MyTKDL), and presenting progress reports during monthly meetings of the Division/Unit Heads. In addition, I am responsible for planning and monitoring MyTKDL activities throughout the year, training newly-hired examiners, providing lectures to the public, and performing other functions and projects as may be assigned by the Senior Director of the Patent Science & Traditional Knowledge Division.

Before coming to Japan, I was actually working on the Examination Guidelines in the Biotechnology Field with my other teammates on the Biotechnology Guidelines Committee. Our task to establish our own biotechnology guidelines was very challenging, since we never had one before. MyIPO actually has a draft biotechnology guideline created by a consultant from the European Patent Office (EPO) in the

early 2000s, so we use this as our working draft when conducting comparative studies on the practices of the Japan Patent Office (JPO) and EPO. This is an essential step, because we are then able to identify the differences that might exist with these two competent offices. In fact, early this year we sought feedback and opinions from both offices regarding our working draft, since it was more than ten years old, and we wondered whether some practices could have already become obsolete and required amendments.

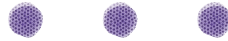
Fast forward to now, where I have been doing my research in Japan for the past two months on improving examination guidelines in the biotechnology field. I am honoured to participate in this Long-Term Research Fellowship Program by the JPO, and I would like to express my gratitude to MyIPO for choosing me for this program. I would also like to give special thanks to the JPO, and to the Asia Pacific Industrial Property Center (APIC) as a host, for accepting me to do this research.

One of my goals here is to do a comparative study on JPO practices in the examination of a bio-related invention, and to recommend that my office improve the guidelines currently used in Malaysia. I have been given many resources to help with my research, including the JPO's Bio Guidelines, Examination Handbook Chapter 2, and many others. With the supervision of Dr. SUWA Yorimasa, and guidance from my advisors Mr. FUJITA Takashi and Ms. MIZUOCHI Tokiko, I hope that I will be able to achieve the objectives of my study, and that I will be able to apply the knowledge gained here to my workplace.



From left: **Mr. TAMURA Naohiro**, Deputy Director, Regional Cooperation Office International Cooperation Division, JPO; **Mr. Mohd Sukri bin Mohd Nor (author)**; **Mr. TOMISAWA Takeshi**, Director, International Cooperation Division, JPO; **Ms. ONO Sayaka**, Deputy Director International Cooperation Division, JPO

Articles from Former Trainees



Patent Validity and Extension in Mexico



Mr. Cesar Eduardo Castaneda Montiel (Mexico)

Partner, BASHAM, RINGE Y CORREA S.C.

JPO/IPR Training Course for Practitioners Specializing in Patents
(October 28 – December 13, 2021)



A. Introduction

On November 5, 2020, a new Mexican Industrial Property law (IPL) entered into force, which contains numerous modifications to the previous law. This completely new Mexican IP law incorporates many practices currently carried out by the Mexican Patent Office (IMPI) and clarifies many gray areas that were present in the previous law. Regarding inventions, this new law incorporated several positive changes, which are consistent with the requirements of the new United States, Mexico, Canada Treaty (USMCA). One of the changes is the possibility of requesting an adjustment in the validity of a patent in the case of unreasonable delays (more than five years between the filing date in Mexico and the grant date), directly attributable to the IMPI during the process of a patent application. Of course, this was well received by intellectual property professionals and owners of patent rights. In addition, it shows that Mexico is moving towards a more harmonious IP protection system that complies with international standards.

On the other hand, in the context of COVID-19, patent term extensions have become a worrying issue for some countries, such as Brazil, where its Supreme Court ruled that patent extensions are unconstitutional and applied this provision retroactively for pharmaceutical patents.

Below is part of the history of patent validity adjustments in Mexico, since this has not been an isolated experience.

B. The first experience in Mexico

Before 1991, the IP law that was in force had been in force since 1976. This 1976 law was significantly limited and pharmaceutical inventions, among others, were not considered patentable subject matter.

At the time, Mexico was negotiating the North American Free Trade Agreement (NAFTA) with the United States and Canada. This situation caused a drastic change in IP in Mexico, with a new IP law that was published in the Official Gazette of the Federation on June 27, 1991, which was later modernized to generally comply with the IP chapter of NAFTA.

In this new law, pharmaceutical inventions, among others, were now considered patentable. This 1991 law contained a new concept to provide the so-called “pipeline protection” for patents that had passed into the public domain since they had not been considered patentable in the previous law of 1976, which was included in Article 12 Transitory of the IP Law of 1991.

In the 1991 Law, the conditions for obtaining protection were as follows:

- The corresponding Mexican patent application had to be filed within 12 months following the enactment of the law and must have been filed by the first applicant of the corresponding foreign application or by his successor in title.
- The applicant had to show that he had filed the application in one of the Patent Cooperation Treaty (PCT) member countries or had to show that he had obtained the corresponding patent.
- The exploitation of the invention, or the importation on a commercial scale of the patented product or of the product obtained by the patented process, should not have been initiated by any person in Mexico before the filing of the application in said country.

The last paragraph of transitory article 12 of the IP Law of 1991 established: *“The term of patents granted under the provisions of this article shall end on the same date as the patent granted in the country where the first application was filed, but the term will never exceed 20 years counted from the filing date in Mexico.”*

Based on the previous provision, patents were granted after the term granted in the country where the first application was filed, and a correction of up to 20 years might be granted, from the date of filing in Mexico, by the Federal Courts as a consequence of the litigation.

This was Mexico’s first experience with adjustments to the validity of patents and it ended many years ago, since the patents that qualified for said adjustment also ended many years ago.

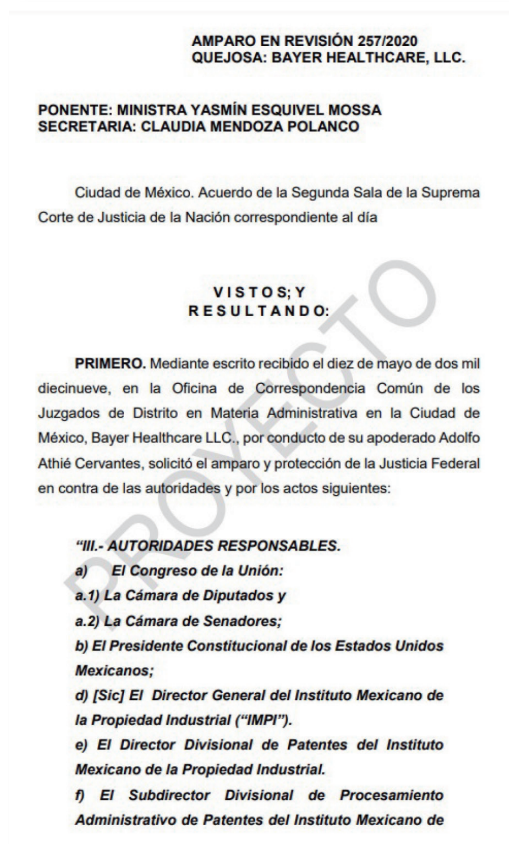
C. Case of the Supreme Court of Justice. Compensation for unjustified delays

On October 14, 2020, the Supreme Court of Mexico ruled, for the first time, that a patent holder (in this case Bayer) must be compensated with an adjustment in the validity of the patent due to unreasonable delays on the part of the Patent Office. It is important to clarify that this decision of the Supreme Court was divided (3 vs 2), and since it was not unanimous, it did not become case law and was not binding. Therefore, any other party seeking such compensation would have to litigate it independently. This case was handled by our law firm.

The fundamental reason of the Supreme Court was that NAFTA provided that the validity of a patent could be 17 years from the date of grant of the patent. Therefore, it was appropriate to adjust the term of the specific patent that is the subject of that litigation (which was granted under NAFTA and the previous IP Act of 1991) so that it is valid for 17 years, from the date of grant, due to unjustified delays during the patent process.

In Mexico, international treaties such as NAFTA are higher on the hierarchy than national legislation, which was a key factor in this decision.

The Supreme Court ordered the IMPI to issue an official statement and establish the term of the specific patent, in that particular case, in accordance with the 17 years counted from the date of granting, as established by NAFTA.



Pic. 1: Patent Ruling Draft / Ruling Draft issued by the Supreme Court granting the extension



Pic. 2: Supreme Court

Since the decision was not binding on the IMPI, it is expected that the IMPI will not adopt the criteria to offset patents from now on in similar cases without a court order. For the Mexican courts, the precedent is also not binding, but it is very persuasive.

The decision was surprising to all, especially considering that the new IP Law of Mexico had already been approved by the Congress and the Senate of Mexico and was scheduled to be published on November 05, 2020. The new IP Law already contemplated adjustments in the validity of patents due to unreasonable delays on the part of the Patent Office and even specified the specific times to decide when the adjustments in the validity of the patents would be applied.

D. Complementary certificate for correction of validity due to delays in processing.

On November 5, 2020, the new IP Law entered into force in Mexico, which included a scheme to address adjustments to the validity of patents derived from unjustified delays by the IMPI in the processing and granting of patents through a “*complementary certificate*”.

The main characteristics of this complementary certificate are the following:

- The duration of the complementary certificate must not exceed five years.
- The owner of the patent may request a complementary certificate only once by means of a document that meets the requirements established in the IP Law and its Regulations.
- The application must be submitted independently when responding to the award notice.
- When the granting of the complementary certificate is authorized, the IMPI will notify the applicant so that, within one month, they present proof of payment of the fees corresponding to the issuance of the title of the certificate.

In addition, for the processing and resolution of the request of an applicant for a complementary certificate filed with the IMPI, the following conditions must be met:

- The processing of the patent must have exceeded five years, otherwise, the IMPI will resolve the inadmissibility of the petition.
- If the processing of the patent has exceeded five years, the IMPI will determine the amount of time that corresponds to “reasonable delays” and will subtract that amount from the processing period.
- If the time calculated for reasonable delays is less than five years, IMPI will reject the request for a complementary certificate.
- If the time calculated after considering reasonable delays is still greater than five years, the IMPI will determine the number of days that corresponds to an unreasonable delay, which will be included in the extension listed in the complementary certificate, as an extension valid for one

day for every two days of unreasonable delay.

The new IP Law considers that the following delays are reasonable:

- I. The term that elapses between the filing date and the date of the favorable resolution of the formal examination;
- II. The deadlines attributable to actions or omissions of the applicant, tending to delay the process of granting the patent and the extensions to respond to the deadlines;
- III. The periods not attributable to actions or omissions of the IMPI or that are beyond its control, such as those that elapse in the substantiation of any means of administrative or jurisdictional challenge or that are derived from them, and
- IV. Periods attributable to force majeure or fortuitous events.

Any other delay attributable to the IMPI will be considered unreasonable and will be taken into account for the complementary certificate. An example is if the IMPI issues the first official letter more than six years after the filing date in Mexico.

These new provisions applies to patent applications filed on or after November 5, 2020, so it will be quite some time before we see a petition for a patent term adjustment under the new IP law. We look forward to seeing how this will work out in practice and of course welcome that patent owners can now be compensated for unreasonable delays directly attributable to the IMPI.

E. Current processing scenario in Mexico and future expectations.

The IMPI has significantly reduced the processing times of patent applications and is issuing the first official action in some cases in less than two years after the filing date in Mexico.

In addition, options to accelerate the granting, such as the well-known Patent Prosecution Highway (PPH) agreements that the IMPI has with several patent offices around the world, have proven very useful so that patent applications are granted as soon as 2-3 months after that said PPH request be submitted.

Furthermore, the IMPI has recently signed a Parallel Patent Grant (PPG) agreement with the United States Patent and Trademark Office, which provides for the possibility of obtaining an accelerated grant in Mexico based on a published US patent. Unlike the PPH, the applicant does not request participation in the PPG program. In the PPG, the IMPI will issue an official action in which it will invite the applicant to participate in this program and adapt the claims to those granted in the corresponding US patent. This letter is one of the four letters that the IMPI issues for each application, and if the applicant agrees to participate in the PPG program, the award notice will be





Pic. 3: MX Patent Certificate

received shortly. Although it is not necessary to file an application for participation in the PPG, if the applicant is interested in voluntarily participating in the PPG program, he or she may do so by filing a voluntary amendment and adaptation of the Mexican claims to those of the corresponding United States patent.

It can be said that Mexico is on the fast track to have several options to speed up the granting, and for those cases that do end up being forgotten, the applicant will now have options to receive compensation through the issuance of the Complementary Certificate.

One issue remains pending in Mexico's new IP law, and that is the adjustment of patent validity due to regulatory delays. Since this is also contemplated in the recently signed USMCA, Mexican law must incorporate it within the next four and a half years, from the date of entry into force of the USMCA, on July 1, 2020.

From a Stitching Design to a Well-known Non-traditional Trademark in India

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JPO/IPR Training Course for Practitioners Specializing in Trademarks
(September 3 – October 11, 2021)



The '*Arcuate Stitching Design*' from Levi Strauss & Co. (Levi's) is now a well-known trademark in India. The Delhi High Court (Court) recently declared in the case of LEVI STRAUSS AND CO. vs. IMPERIAL ONLINE SERVICES PRIVATE LIMITED & ORS¹ that the signature '*Arcuate Stitching Design*' of the US apparel brand Levi's has become well-known to the public through adjudication for an infringement suit in favor of the company.

History

Levi Strauss & Co. (Levi's) is an American clothing company known worldwide for its Levi's brand of denim jeans. Since the creation of the first pair of jeans in 1873, Levi's has adopted a distinctive stitching design known as the '*Arcuate Stitching Design*' mark, and uses it on all of its textiles including denim jeans.



Pic 1: Levi's '*Arcuate Stitching Design*' marks

¹ CS (COMM) 657/2021 & I.A. 16736/2021 (Date: 24th March, 2022)

Dispute

Levi's was aggrieved by the fact that Imperial Online Services Private Limited (Imperial), an Indian company, was also selling denim jeans with an identical '*Arcuate Stitching Design*' mark through the website www.urbanfashion.com, as well as other e-commerce platforms such as Amazon, Flipkart, Nykaa Fashion, Myntra, Snapdeal, etc.



Pic 2: Stitching design mark used by Imperial

Levi's issued legal notices to Imperial, in response to which Imperial executed undertakings on 16th February, 2021 acknowledging the sole and exclusive right of Levi's in the '*Arcuate Stitching Design*' mark. In addition, Imperial also agreed to remove within six months from the date of undertakings all of the infringing products, and promised to stop any further manufacturing, distribution or sale of goods (including denim jeans) with the infringing mark that was similar to Levi's '*Arcuate Stitching Design*' mark.

This notwithstanding, however, Imperial continued to manufacture and sell the denim jeans with Levi's "Arcuate Stitching Design" mark. Consequently, Levi's filed a suit in the Delhi High Court (Court) seeking injunction against Imperial for infringing its trademark.

The Court thereby granted an ad-interim injunction in favor of Levi's, and restrained Imperial from manufacturing, marketing, offering for sale or selling any goods (whether through online or offline modes) that contained any mark which would be deceptively similar to Levi's '*Arcuate Stitching Design*' mark.

In response to the ad-interim injunction, Imperial filed a written statement and explained that the initial extension of six months was sought for disposal of stocks which could not be diligently adhered due to the impact of the ongoing pandemic and lockdown. Imperial further mentioned that it had cleared all of the stock containing the '*Arcuate Stitching Design*' mark, and was in process of updating its product listings across e-commerce platforms to reflect its updated designs in compliance with its obligations as per the undertakings.

In the meantime, Levi's sent a takedown request to Imperial for its product listings on Amazon, alleging violations by Imperial with respect to its obligations vis-à-vis the undertakings. Imperial responded to Levi's explaining the reasons for the delay in updating the product listings, and sought an additional period of three weeks to effectuate the removal. Levi's permitted Imperial to cease any and all use of the '*Arcuate Stitching Design*' mark by 15th October 2021.

Levi's claimed that Imperial did not remove its disputed product listings from various e-commerce websites, including Amazon, despite the undertakings and the ad interim injunction granted by the Delhi High Court on an earlier date, and were hence guilty of contempt.

On the other hand, Imperial submitted that they had no intention of manufacturing or offering for sale any fabrics, textiles or garments with Levi's 'Arcuate Stitching Design' mark, and were willing to suffer the decree of permanent injunction. However, Imperial objected to the demand of Rs. 8.5 lakhs as legal cost and damages.

Issue

The primary issue before the Delhi High Court was the question of whether the mere appearance of the said 'Arcuate Stitching Design' pattern would perform a trademark function, i.e., associate the jeans with Levi's.

Decision

While deciding the matter, the Delhi High Court observed that Levi's had sought protection for the 'Arcuate Stitching Design' mark, being encompassed under Section 2(m) of the Trademark Act, 1999, which defines a *mark* as being: "a device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of goods, packaging, or combination of colours or any combination thereof".

Under the law of trademarks, the definition of a mark has evolved over time. Traditionally, trademarks included names, words, devices, logos, labels, packaging, letters, numerals, etc. However, this list has expanded over time to include colors, combinations of colors, shapes of goods, patterns of products, smell and sound marks, etc. These two broad categories of marks are loosely referred to as traditional and non-traditional trademarks.

In the present case, Levi's 'Arcuate Stitching Design' mark relates to a stitching pattern that is not a product design, but a pattern which is incorporated on Levi's denim jeans.

The Delhi High Court observed that there may be a large number of stitching patterns which may be merely for aesthetic or visual appeal. However, when a trademark owner's stitching pattern per se identifies the jeans, even without a name or a logo, the intention of the proprietor is for the pattern to perform the function of a trademark. In such a case, the Court would have to examine whether the stitching pattern has an 'acquired meaning', or is distinctive, per se. The test of acquired meaning is similar to the test of secondary meaning as applied to descriptive words.

The Delhi High Court discussed the ruling passed in *Lois Sportswear, USA, Inc. v. Levi Strauss & Co.*, 631 F. Supp.735 (S.D.N.Y. 1985), wherein the United States District Court for the Southern District of New York held as follows: "Based on the foregoing analysis, 'Arcuate Stitching Design' mark of Levi is a strong mark that qualifies for a high degree of protection." In addition, the Levi's 'Arcuate Stitching Design' mark was held to be a fanciful design that serves no purpose other than as a source indicator by the US District Court. This decision was further upheld by the United States Court of Appeals, Second Circuit in *Lois Sportswear, U.S.A., Inc., v. Levi Strauss & Co.* 799 F.2d 867 (1986).

In the further referred case of *Levi Strauss Co. v. Abercrombie Fitch*, 633 F.3d 1158 (9th Cir. 2011), the United States Court of Appeals, Ninth Circuit, while considering the aspects of dilution of Levi's 'Arcuate Stitching Design' mark had observed as follows: *Levi's holds a federally registered trademark on the 'Arcuate Stitching Design'. In addition, the sale of garments bearing Levi's 'Arcuate Stitching Design' mark have accounted for more than ninety five percent of Levi's revenue for the past 30 years and roughly equals to 50 billion dollars. Further, Levi's actively monitors the use of competing stitching designs, and enforces its trademark rights against perceived infringers.*

The Delhi High Court observed that since Levi's stitching pattern uniquely identified the jeans as emanating from Levi Strauss Co., even in the absence of a corresponding name or a logo, the pattern fulfilled its purpose in serving as a trademark.

Also considering all of the submissions and several precedents relied upon by Levi's, the Delhi High Court further observed that the '*Arcuate Stitching Design*' mark had acquired a secondary meaning based on the following facts:

- There has been a long and continuous usage of the '*Arcuate Stitching Design*' mark on Levi's jeans, pants, and trousers since the company created its first pair of jeans in 1873.
- The first trademark registration for the '*Arcuate Stitching Design*' mark dates back to 1943 (granted in the U.S.), and Levi's has registered the mark as a trademark in several countries since then.
- The mark has also been a registered trademark in India in class 25 since 1999.

Hence, the Delhi High Court passed a decree in favor of Levi's, and awarded it a nominal cost of Rs. 4 Lakhs in order to end the matter expeditiously. In addition, the Delhi High court also passed a decree declaring Levi's '*Arcuate Stitching Design*' as a well-known mark. All of the e-commerce platforms were directed to remove any and all unauthorized product/goods listings, as well as the sale of garments, bearing Levi's '*Arcuate Stitching Design*' mark.

Conclusion

The present decision is an important step toward recognition and protection of new non-traditional trademarks in India, and will serve as a landmark precedent to be relied upon in future matters related to similar subject matters in trademark jurisprudence. This recognition by the courts of a stitching design on denim jeans as an indicator of source as a well-known nontraditional trademark can serve as a positive ray of hope for other source-indicating patterns to be actively recognized as non-traditional trademarks, which can help to create a stronger protection regime against infringement and counterfeiting. Additionally, the proactive role of courts in recognizing the genuine rights of holders, and taking strict action against infringers, is a good sign for the future of intellectual property-driven markets.

**The images used in this article are taken from the Court's judgment and are for representational and educational purposes only. No copyright is claimed in the images used.*

The Importance of Intellectual Property Audit in the University Technology Transfer Office

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The University Technology Transfer Office (UTTO) is responsible for ensuring that the intellectual property (IP) of the university is properly managed and protected. Hence, an effective IP audit is essential to the UTTO's ability to fulfill its mission. An IP audit provides the UTTO with valuable information about the university's IP portfolio. The audit can identify IP that is not properly protected and can help the UTTO to develop strategies for protecting the university's valuable IP assets. The audit can also help the UTTO to identify opportunities for commercializing the university's IP. An effective IP audit can therefore be an important tool for promoting the university's economic development.

Why Would the UTTO Need to Conduct an IP Audit?

In order to ensure that the university is adhering to its IP policy and that all IP assets are properly accounted for, the UTTO would need to conduct an IP audit. This would allow the technology transfer office to identify any gaps in the university's IP protection and to ensure that all IP assets are being properly managed. An IP audit would typically involve a review of the university's IP protection strategy, its IP assets, and its IP management procedures. The audit would also assess the university's compliance with its IP policy. In addition to assessing the university's current IP strategy, the audit would also identify any potential improvements that could be made to the university's IP strategy.

Effective intellectual property management requires accurate data and knowledge of how products are being developed. The more effort you put into managing your intellectual property, the less you have to spend on legal and other professional services. In addition, an effective strategy will help you to protect your intellectual property and prevent others from using it without your permission. For example, if you own a patent, and you know that your product will be used by a large number of people, then you'll most likely want to ensure that it is properly filed. It is always advisable to conduct a thorough novelty search before filing a patent application. This is to ensure that the invention is new and not already patented by someone else. A freedom to operate search is important to avoid infringement of existing patents that could cost you lots of money and time to overcome the haunting during prosecution.

When you are unsure whether or not to conduct an IP audit, there are a few key benefits that you might want to consider. IP audits help you to identify potential issues and weaknesses in your IP strategy and can help you to avoid costly mistakes. Additionally, if you are facing potential litigation, an IP audit can give you a clear picture of your strengths and weaknesses. Finally, if you are planning on selling your business, an IP audit can help to increase its value.

How is an IP Audit Conducted in the UTTO?

The University Technology Transfer Office is responsible for the transfer of university-developed technology to the private sector. In order to ensure that this process is conducted smoothly and effectively, an IP audit should be conducted on a regular basis. The IP audit can be done before the IP is filed and after the IP is filed.

IP Audit at Pre-Filing Stage

There are a few steps that should be taken in order to conduct an IP audit in the UTTO. First, all university-developed technology should be reviewed and evaluated. This includes identifying the invention, assessing its potential value, and determining whether or not it is ready for commercialization. At our University (Universiti Malaya), we are using the WIPO Ten Points Assessment to evaluate inventions during the disclosure stage. The assessment is conducted by interviewing the inventors based on the questions in the checklist as shown in Table 1. This allows us to score the inventions and screen them before entering them into the evaluation process by the independent committee team.

Table 1: WIPO Ten-Point Technology Scoring

Categories / Criteria		Score
1.	Description of Invention and Inventiveness	
2.	Potential Value of Intellectual Property	
3.	Market Relevance	
4.	Market Size & Characteristics	
5.	Value Proposition/Potential for Reasonable Business Model	
6.	Potential for Significant Economic Value	
7.	Stage of Development/Technology Readiness	
8.	Scale-up Feasibility	
9.	Support, Funding and Resources	
10.	Existing or Potential for Private-sector Partnerships	
Total Score (out of 50)		

Note:

Scoring the Categories:

Each Technology Summary to be evaluated should be scored across each of the ten categories, on a scale of 1 to 5.

The 1 to 5 scoring scale is as follows:

- 1 = Very unfavorable;
- 2 = Unfavorable;
- 3 = Neutral;
- 4 = Favorable;
- 5 = Very Favorable.

(Source: WIPO Enabling Innovation Environment (EIE) IP and Technology Support Project, Ten-Point Technology Scoring Template (for Commercialization Potential))

Once the invention has been assessed and it is determined that it has potential value, the next step is to determine if it is ready for commercialization. This includes determining if the technology is mature enough to be transferred to the industry, assessing the market potential, and identifying any potential partners. If all of these criteria are met, then the technology is ready to be commercialized. Finally, financial analysis should be conducted in order to assess the potential profitability of the technology. This financial analysis will enable the university to understand the real off-market value of the technology and also establish a level of comfort with the investment.

IP Audit at Post-Filing Stage

The process of auditing existing IPs in the university can be quite daunting, but there are a few methods that can be used in order to make the process more manageable. First and foremost, it is important to create a list of all of the IPs that the university currently holds. Once this list has been created, it is then possible to begin auditing each IP individually. It is important to check for things such as whether or not the IP is still valid, and if it is, whether or not it is being utilized by the university. If an IP is no longer valid, or if it is not being utilized, then it may be possible to get rid of it. This can help to save the university money, and it can also help to keep costs down for students.

At Universiti Malaya, we have a significant number of patents that need to be maintained on an annual basis. As can be seen from the graph in Figure 1, the number of patents has been increasing steadily over the past five years, and a substantial amount of money is required to maintain the granted patents each year. In order to manage this financial burden, an IP audit was conducted in 2021 in order to assess the situation and determine which patent should be renewed and which should be allowed to lapse. The assessment was conducted by interviewing the inventors with a series of questions created in-house (as shown in Table 2), and scores were given to each patent to determine whether it should be renewed or allowed to lapse. Based on this exercise, in the year 2021, we were successful in removing approximately 140 patents, reducing the number of granted patents in our portfolio from 433 to 293 and saving up to RM 280,000 in yearly IP maintenance fees.

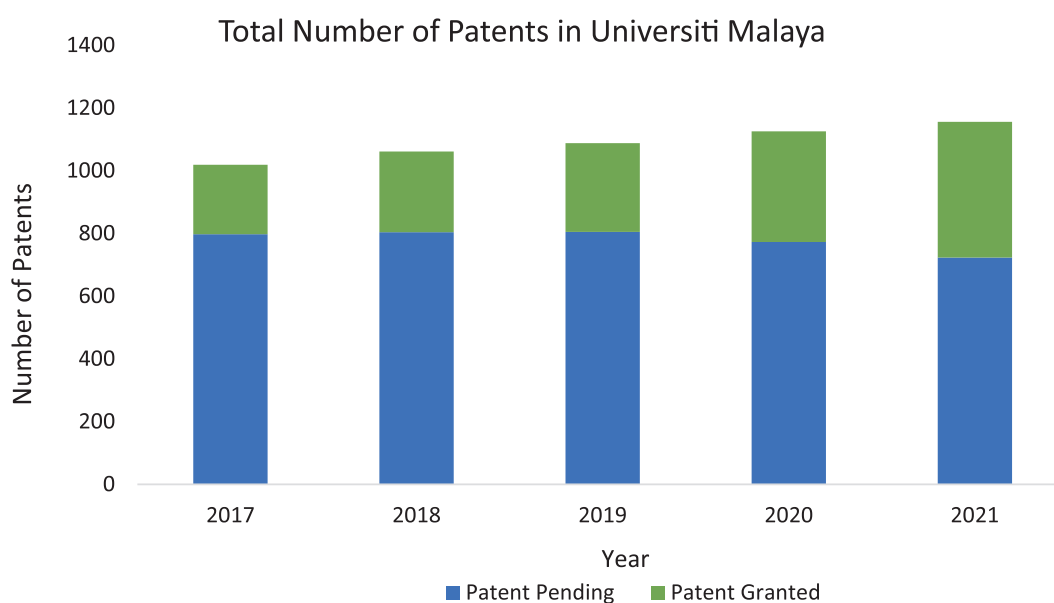


Figure 1: Total number of patents in Universiti Malaya

Table 2: In-house created questionnaire for IP audit

Categories / Criteria		Score
Technology		
1.	Current technology readiness level (TRL)	
2.	Duration to move from current TRL to the next TRL	
People		
1.	Age of the inventor	
2.	Number of students in this project/ invention	
3.	Co-researcher in this project/ invention	
4.	Successor of this project/ invention after the inventor retired	
Market		
1.	Market size of the invention	
2.	Existing potential collaborator/ industry partner	
3.	Future plan	

Conclusion

From the discussion above, it is evident that IP Audit plays an essential role in the University Technology Transfer Office. The process of IP Audit provides the University with an opportunity to scrutinize its intellectual property portfolio and make necessary changes to ensure that it is best able to meet the needs of the University. An IP audit can help to determine which technology transfer opportunities are the most promising. This is important because it can help the university to focus its resources on the most promising projects, and avoid wasting time and money on projects that are not likely to be successful. In addition, an IP audit can help to safeguard the university's IP assets. This is important because the university's IP assets are a valuable part of its overall intellectual property portfolio, and it is important to protect them from potential threats.

Examining Unfair Competition in Trademark Filing Systems

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Abstract

This paper seeks to examine the unfair competition in the trademark filing systems as practised in the different jurisdictions of the world. The research aims to shed light on the consequences of first to file vs. first to use a trademark as is obtainable in various legal systems. In addition, it examines the concept and legal framework of unfair competition, and how this impacts the trademark filing system in Nigeria.

What Is A Trademark?

Trademarks form one of the genres of Intellectual Property¹ (IP) that are used to distinguish a service or product of a company from another. The World Intellectual Property Organisation (WIPO) defines a trademark² as a sign that is capable of distinguishing the goods or services of one enterprise from those of other enterprises. Like most other forms of IP, a trademark is territorial, and requires registration in order for rights to exist. That is, marks must be applied for in the countries of interest, which are determined by factors such as place of nationality, place of business, business expansion and market visibility. Trademark registration in most jurisdictions of the world is regulated by the International Nice Classification administered by WIPO, which divides marks into the two categories of products and services. Marks which are applied to products are called trademarks, and those applied to services are called service marks.

Legal protection gives the right holder exclusive control over the protected mark to the exclusion of third parties, without the fear of being undermined by unfair competition in the market thereby gaining consumers' trust in the brand. Registration is prima facie proof of ownership in the face of litigation. Thus, a trademark is a shield that protects you from infringement without a right for compensation, and a weapon to prevent others from using your mark without consideration. Therefore, trademark registration for business entities is essential.

When Is The Appropriate Time For A Trademark To Be Registered?

Depending on what is obtainable in a particular legal system, a prospective right holder may need to prove the use of a mark before registering it. In other places, however, registration is a prerequisite to its application in commerce. Globally, these filing systems create a divide among nations; leaving an IP enthusiast to ponder which process is better.

First To Use Vs. First To File

The first to use or apply a mark in commerce simply refers to the bona fide use of a mark in the ordinary course of trade. It is predominant in many countries, such as Canada and Australia. Rights of priority and protection are accorded to the business that can prove to be the first to use a mark usually through evidence of sales, reports by stakeholders, or advert placements. This principle is founded on Common Law, and the first to file for trademark registration does not enjoy the right of priority if another entity—whether registered or not—can prove to be the first to use the mark in commerce. The United States, unlike other jurisdictions, can be said to operate two different systems: first-to-use and first-to-file (with an intent to use).³ But the spirit of the Act favours first to use marks in commerce, since in order to apply for trademark registration, applicants that seek registration based on intent to use the mark must prove the use of the mark in commerce within the grace period before the approval of the mark for publication, or within six months of the Notice of Allowance issue date, or during the extension of time obtained after the Notice of Allowance issue date⁴. Therefore, in the U.S it is the actual use of a designation as a mark that creates rights and priority over others and not the registration of a mark.

The first to file principle connotes that a jurisdiction accords rights, priority and protection to the business entity that has the earliest filing date on the trademark register, irrespective of whether the marks had earlier been applied by that entity, or by another. We see this in places like the UK, China, Japan, Germany and the European Union. For instance, Article 31⁵ of the Trademark Law of the People's Republic of China states as follows: *“Where two or more applicants apply for the registration of identical or similar trademarks for the same or similar goods, the preliminary approval, after examination, and the publication shall be made for the trademark which was first filed. Where applications are filed on the same day, the preliminary approval, after examination, and the publication shall be made for the trademark which was the earliest used, and the applications of the others shall be refused and their trademarks shall not be published.”* Article 32⁶ provides that *“the application for trademark registration shall not be allowed to harm other person's prior rights, and no pre-emptive application by any unfair means of a trademark which has been used by another person and has a certain influence shall be allowed for registration.”*

Similar to both filing systems obtainable in different jurisdictions is that registration is a prerequisite for trademark protection, and serves as prima facie proof of ownership. But whether the protection is sought before or after it is used in commerce leaves a business most times at the hands of unfair competitors.

Examining The Concept Of Unfair Competition In IP

Unfair Competition is defined as “any act or practice, in the course of industrial or commercial activities, that causes, or is likely to cause, confusion to another’s enterprise or its activities, in particular, the products or services offered by such enterprise, shall constitute an act of unfair competition.”⁷ Unfair competition is usually aimed to mislead consumers, dilute the brand of a competitor, leverage the goodwill of the right holder, stifle invention, and negatively affect real competition in the market.



The determinant of what would amount to misleading is restricted to those indications that might cause misconceptions or confusion on the part of the consumers. Confusion may be caused to a trade dress or trademark; whether registered or not, a trading name, a business identifier other than a trademark or trade name, the appearance of a product, the presentation of products or services, or a celebrity or a well-known fictional character. Unfair Competition laws prohibit acts such as the unauthorized use of well-known marks, disclosure of trade secrets, imitation of product forms, illegal

acquisition or use, a false impression of a competitor’s products or services, discrediting competitors, exploitation of another’s reputation, and comparative advertising.

Different jurisdictions have legal frameworks for the prohibition of acts of unfair competition which are aimed to protect credibility, trade secrets, and other such commercial assets by regulating acts of competition in real markets. The Chinese Anti-Unfair Competition Act 1993 forbids unfair competition in intellectual property rights, and defends operators and citizens from unfair competition practices. The Standing Committee of the National People’s Congress on April 23, 2019, announced amendments that apply to six articles that went into effect on November 1, 2019, which are specifically directed at deterring bad-faith trademark registrations. Article 4 was amended to read: “Applications for the registration of trademarks in bad faith that are not intended to be used should be rejected,” and Article 63 saw an increment in the statutory and punitive damages for trademark infringement. The Federal Competition and Consumer Protection Act, 2018 was enacted to address anti-competitive trade practices in Nigeria, among other legal frameworks to protect consumers, entrepreneurs and the economy.

The Nigeria Trademark Filing System

The Nigeria Trademark Act suggests the register to use filing system⁸. Section 3⁹ provides that “No person shall be entitled to institute any proceeding to prevent, or to recover damages for, the infringement of an unregistered trade mark; but nothing in this Act shall be taken to affect rights of action against any person for passing off goods as the goods of another person or the remedies in respect thereof.” The rights to use a trademark are birthed by registration.¹⁰ This simply means that to enjoy rights to a trademark in Nigeria, a business entity must apply to the Registrar of trademark for the registration of such marks before applying the same in commerce.

The Act, however, recognizes that some marks could exist without registration. It accords the rights of passing off to such rightsholders,¹¹ while also restricting the rights derived from the registration of a mark, if a person can establish the use of the same or a similar mark” in commerce in accordance with the following:¹²



- (a) from a date previous to when the registered owner first used the trademark
- (b) from a date previous to the registration of the trade mark with respect to those goods
- (c) use of a person’s name as nothing can preclude bonafide use by a person of his/her name or the name of his/her business.

However, in the case of honest concurrent use, the parties may be allowed to co-use on terms that the Court or the Trademark Registrar may so impose.¹³

Unfair Competition

It would seem that the Act recognizes and protects the right of first use, but this is effective at the mercy of the interpretation of the judiciary, and in instances where concrete evidence can be adduced. Too many businesses exist in Nigeria on a low-cost, low-budget basis, with no advertising and little or no record-keeping. Hence, such proof though minute tasks is almost unavailable. In *VIRGIN ENTERPRISES LTD v. RICHDAY BEVERAGES (NIG) LTD*¹⁴, the Court of Appeal interpreted Section 5(2) of the Trade Mark Act by stating the two guiding tests to determine whether there is an infringement as follows: 1) whether the registered trade mark is identical with the unregistered mark, and 2) whether the Defendant has adopted any essential features of the plaintiff’s trademarks to confuse and deceive the public by making an overall similarity in the respective trademarks. The Respondents (Defendants) applied to register “VIRGIN TABLE WATER” all in capital letters, and were issued an Acceptance Form dated 1-7-99. Exhibit C, tendered in evidence, is the label in use by the Respondent with the distinctive feature “VIRGIN”, written in bold capital letters, whilst the Appellant registered a trademark as the single word “virgin” in lowercase letters. DW1 in evidence stated that “virgin table water” has been in the market since July 1999, and has outlets in about 11 states of the Federation of Nigeria producing; food beverages and water products. The Court held inter-alia that the Appellant has shown that the Respondent infringed on his trade mark “virgin” and that *the right vested on the proprietor of a trade mark is not by long use of the product but by registration.*

Due to the length of litigation processes and the absence of special IP courts, first users most often don’t approach the court to enforce their rights, and are unjustly bullied by big businesses who steal their marks. Also, this filing system has led to widespread trademark squatting, wherein ignorant businesses that delay in applying to register their marks risk being overtaken and bullied by trademark squatters. Trademark squatting refers to the acts of dishonest entities that are the first to register marks which are in use by others, so as to either profit off the marks’ goodwill or to extort settlement sums when the rightful owners make a move to register their marks, wherein they may also send cease and desist letters just to get them to bargain.



Owing to ignorance and low funds, there are many businesses, particularly in rural areas, that go into partnership with bigger entities without properly negotiating their terms or protecting their know-how and trademarks. These bigger companies merely obtain a trademark in their name, without royalty payment to their first users.

As a result of the delay in the publication of journals, a business that files to register a mark may abandon the process due to frustration, as well as obliviousness after having used the acceptance letter to process other administrative procedures needed by start-ups, such as the National Agency for Food and Drug Administration and Control (NAFDAC) registration. Moreover, a business that abandons its application at the acceptance stage can only sue for passing off,¹⁵ but can't be entitled to the exclusive right to use the mark. In *Zeneca Ltd. & Ors vs. Jagal Pharma Ltd*¹⁶, the position of the Court of Appeal was that mere application for registration does not confer the proprietary right of the trade mark upon the applicant.

The WIPO administered treaties such as the Madrid Agreement¹⁷ which allows for a claim of priority by members from the date of an international registration effective in all contracting countries, as if the marks are registered locally in each of these countries, will seem inapplicable in Nigeria. For an international treaty to have the force of law in Nigeria, it must first be assented to, and second, be domesticated by the National Assembly.¹⁸ Hence, it is expected that foreign entities who intend to expand and have their marks protected in Nigeria must go beyond reliance on the Madrid Systems and take up trademark registrations in Nigeria.

Recommendations

From the totality of the foregoing, entities that want to expand abroad and thrive in Nigeria must bear these challenges in mind, and seek proper protection through the following:

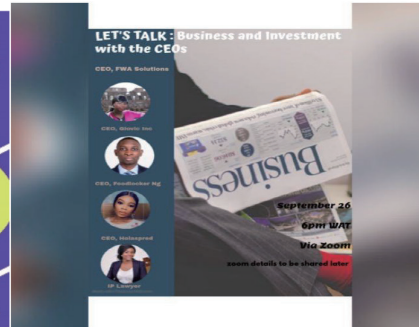
1. Carrying out due diligence to ensure there are no existing interests
2. Obtaining registration of their marks up to the issuance of certificates in the appropriate classes
3. Investing in entities that take IP protection seriously
4. Applying to obtain registration of their marks individually in countries that have not acceded to or domesticated the Madrid System
5. Negotiating the contract terms properly, and including restrictive covenants as appropriate
6. Making use of indigenous IP lawyers

Conclusion

Unarguably, no one filing system is better than another. Different systems have their merits and demerits, and although some jurisdictions adopt a particular trademark filing system, they still use the other as a safeguard in breaking the tie where two rights co-exist. As such, IP Offices should consistently collaborate with lawmakers and the judiciary by seeking to block the challenges and the loopholes envisaged in their trademark filing systems, as this will deter the unfair dealings envisaged in a competitive market.



ENGAGING UNIVERSITY STUDENTS ON IP RIGHTS & ENFORCEMENT VIA JIIPCC



ONYEKACHI ENGAGES IN IP AWARENESS CREATION THROUGH VARIOUS MEDIA

References

- 1 https://www.wipo.int/edocs/pubdocs/en/wipo_pub_450_2020.pdf
- 2 Trademarks (wipo.int)
- 3 Section 1(a & b) of the Lanham Act, 5 U.S.C. § 1051
- 4 USPTO's Section 1(b) timeline.
- 5 Trademark Law of the People's Republic of China (2013 Revision) - China Patent Agent (H.K.) Ltd. (cpahkltd.com)
- 6 Trademark Law of the People's Republic of China (2013 Revision) - China Patent Agent (H.K.) Ltd. (cpahkltd.com)
- 7 <https://wipolex.wipo.int/es/text/130015>
- 8 Section 4 Trademark Act Cap 436 LFN 2004.
- 9 Section 3 Trademark Act Cap 436 LFN 2004
- 10 Section 5(3) Trademark Act Cap 436 LFN 2004.
- 11 Section 3 Trademark Act Cap 436 LFN 2004.
- 12 Section 7 & 8 (a) Trademark Act Cap 436 LFN 2004.
- 13 Section 13(2) Trademark Act Cap 436 LFN 2004.
- 14 (2009) LPELR-8187 (CA)
- 15 Section 3 Trademark Act Cap 436 LFN 2004.
- 16 (2007) LPELR-8384 (CA)
- 17 Article 4 Madrid Agreement
- 18 Section 12. (1) No treaty between the Federation and any other country shall have the force of law to the extent to which any such treaty has been enacted into law by the National Assembly.

WIPO - Technology and Innovation Support Center Concept and Stimulating Innovation Eco-systems in Developing Economies



Mr. Nalinda Atapattu (Sri Lanka)

Assistant Director (Information & Examination), Patents & Industrial Designs
National Intellectual Property Office of Sri Lanka (NIPOS)

JPO/IPR Training Course on Academia-Industry Collaboration and Technology Transfer
(July 29 – September 2, 2021)



In the modern day world, a patent is considered an exclusive right given to an owner of an invention for a certain time period by the government of the subject territory. It excludes others from carrying out certain actions with regard to the patented product or process without the permission of the owner of the patented invention. The oldest statutory found is the Venetian Patent Statute of 1474. This states that patents be granted to “any new and ingenious device that was not previously made” subject to its usefulness¹. This concept was the basis for the modern-day patent system.

The world is divided and identified in many ways. One such identification is that of “developed and developing nations”². Most of the developed nations are also industrialized and wealthy. One of the salient natures of these economies is proper management in Intellectual Property creations, and the arrangements made regarding GDP contributions by IP-related industries and merchandise. Contributions by IP related industries to the U.S. economy account for about 40%, providing around 15.5 million jobs in related industries³. Inventions and patents are contributing considerably to the IP of countries whose main policy objectives are those of innovation-based economies.

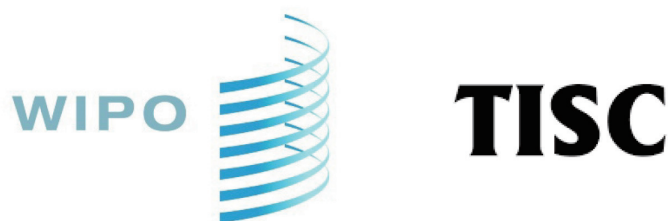
Developing nations, on the other hand, are again divided into two categories: developing and least developed. Except for some emerging economies, most of the developing and least-developed nations fail to bring IP creations to their respective economies. In other words, they fail to manage IP creations in an innovative manner in order to get full use out of them—thereby resulting in a typical scenario of brain-drain.

1 https://en.wikipedia.org/wiki/Venetian_Patent_Statute .

2 <https://keydifferences.com/difference-between-developed-countries-and-developing-countries.html#:~:text=The%20countries%20which%20are%20independent,as%20compared%20to%20Developing%20Countries.>

3 <https://www.uspto.gov/ip-policy/economic-research/intellectual-property-and-us-economy> .

WIPO⁴ introduced the concept of a Technology and Innovation Support Center (TISC)⁵ to developing countries in or around 2013 in order to provide inventors, scientists and researchers with access to locally-based, high-quality patent information services⁶.



Role of the TISC within the innovation eco-system

The TISC network of a country is considered to be an effective tool for stimulating an innovation eco-system. Most people have their basic education in their own country's local language, and encounter barriers with respect to language, and sometimes also to technology, due to a lack of knowledge in a foreign language and the use of Information Technology, respectively.

The national IP office is the main focal point for the project, and it is therefore easy to identify bottlenecks in the country's patenting and innovation system. The hosting institutes are mostly the technology-related faculties/departments of universities and R&D institutes. These entities are mostly capable of finding competent persons in the TISC with the required facilities to assist the target group. Therefore, those with technology and language barriers can obtain the required relevant information from TISC staff.

This process eliminates the repetition of research efforts, and helps users to decide the starting point with their innovation efforts. When such systems are absent, people repeat innovations that already exist, and vest their time and money into developing such existing technologies and filing patent applications with a higher probability of rejection due to anticipation or lack of inventiveness.

TISCs not only facilitate technological information, but also assist with the patenting process by providing necessary information about local patent systems. Since the focal point of the TISC network is the national IP office, a link is established automatically between the TISC and the patent division staff. Most of the member countries in this project additionally have a TISC in their national IP office.

Platforms and Tools with WIPO-TISC

eTISC

Social platforms are very famous today in terms of connecting people who have similar ideas or thought. eTISC⁷ is such a platform, since it connects the TISC community with experts in order to answer and share questions and experiences related to innovations or IP management in the broader sense.

4 Abbreviation used for World Intellectual Property Organization, one of the 15 specialized organizations of the UN

5 <https://www.wipo.int/tisc/en/>

6 The concept has now expanded to IP management, technology commercialization and marketing. Please visit the link <https://www.wipo.int/tisc/en/> .

7 <https://etisc.wipo.int/>

WIPO Inspire

WIPO Inspire⁸ provides a collection of reports about patent databases, and such information and data are very important for the users of TISCs. It further provides patent analytics, technology transfer, and institutional IP policies, combining reference data with expert insights into resources, tools, and good practice recommendations.

Patent Register Portal

The Patent Register Portal⁹ is a gateway to patent registers and gazettes in more than 200 jurisdictions. This includes up-to-date online information on patents and patent applications.

Is it a new concept while Technology Transfer Offices (TTO) are in place?

It is evident that there are TTOs in some universities and R&D institutes in developing countries¹⁰. But these rarely or never focus on assisting inventors, researchers and scientists by providing access to technological information. TTOs are focused on financial gain through research, not in assisting before or during the research works. This vacuum has made most developing economies invest in technically unfeasible innovations and patenting processes. Some developing nations are keen on integrating innovation policies within their national development agenda, and since there is a clear linkage between innovation and economic development, the previously-mentioned repetition of efforts must be eliminated. The concept of TISC is one of the best tools with which to close existing technical and language barriers with respect to the target groups. The TISC concept was not there with the TOT concept, and is therefore considered a new and effective tool within the planning stage of research and innovation.

TISCs in Sri Lanka

Sri Lanka held an introductory seminar on the project with the participation of universities and research and development institutes in 2013¹¹. As the focal point to this project, NIPO entered into a service level agreement (SLA) in 2014 with WIPO to start a TISC network in the country. The network of TISC centers in Sri Lanka increased to a total of 25 by the end of 2021, and includes almost all of the country's government universities, as well as some private universities and R&D institutes.

As part of national development initiatives, about 15 IP and TISC awareness programs were conducted in five districts in 2019, including the districts of Mulativu and Jaffna, which were two of the most affected areas during the country's 30 years of civil war. The TISC project reached all nine provinces in the country when the IP office and World Bank funded the Accelerating Higher Education Expansion and Development (AHEAD) project, which joined hands to establish TISC centers at every University Business Linkage Cell (UBL) in the same year. The project has slowed down in recent years due to restrictions from the pandemic, but is still expanding to support innovation.

TISCs at universities and R&D institutes have paved the way to minimize the number of defective applications within formality and substantive examinations. Patent applications are required to gather reports about inventions, and applicants were guided by TISC staff to include relevant prior art details. Inventors were therefore able to develop concepts from where the state-of-the art has left off. It has also

8 <https://inspire.wipo.int/>

9 <https://inspire.wipo.int/patent-register-portal#tab1/en/index.html>

10 University technology transfer offices - Wikipedia

11 Technology and Innovation Support Center (TISC) (nipo.gov.lk)

saved time and investments on the part of inventors and financial support bodies with respect to innovation efforts, while innovations were additionally made marketable.

TISC staff were also provided with some intensive trainings, including scholarships for WIPO distance learning courses to develop their skills relating to IP. NIPO is additionally receiving scholarships from countries including the USA, Japan and Korea, and enrolled TISC staff in those opportunities. Accordingly, an IP-rich community has been created within Sri Lanka's TISC network.

Intellectual property management, technology transfer and commercialization were also recently included within the TISCs project document.

Conclusion

The TISC concept is further developed to manage IP, promote technology transfer, and market IP creations (or, as it is commonly called, commercialization). TISCs are already promoting access to technological and patent information prior to research and starting the patent process. Modern TISC will be a center point for all implementations up to commercialization, since the patent and technological information searches that are carried out through the TISC connect industries with academic and R&D institutes by providing searches for novelty, infringement, validity and state-of-the art for those sectors. Accordingly, the WIPO-TISC concept and the incorporated platforms are perfect tools for developing economies in order to stimulate innovation eco-systems in their respective countries.



Picture Source : <https://www.weforum.org/agenda/2015/11/is-the-term-developing-world-outdated/>



Get to Know your IP Friends



This is the final installment of the questionnaire results from trainees who contributed to the Enishi Magazine this fiscal year.

Participants could not come to Japan for the training courses during the past two years (FY 2020 and 2021), since all courses at this time were conducted online. As indicated in your responses, we hope you will have the chance to visit Japan and experience the food and culture someday!

Q: Where would you like to visit next? (Including places outside of Japan)

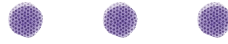
- Hokkaido or Tokyo (*Malaysia*)
- I would like to visit Tokyo and in particular Tokyo University and the National Institute of Advanced Industrial Science and Technology. (*Kenya*)
- In Japan, I would like to visit Osaka, Okayama and Sapporo (Hokkaido). I would like to visit Tokyo and Kyoto one more time. Outside of Japan, I would like to visit Australia, Greece, England and Italy. (*Brazil*)
- Tokyo and Paris (*Nigeria*)
- Mt. Fuji (*Sri Lanka*)
- I am a mountain biker and I use Shimano bicycle components on all my bikes. This is why I'd love to visit the Shimano headquarters in Sakai, Osaka. I'm also into cars made in Japan and it would be very interesting to visit the Toyota, Honda and Suzuki plants in Japan. (*Philippines*)
- Indeed, my plans during the next few months is to visit Japan again. I have been 3 times and I am always surprised by the incredible culture, history and novelty of the country. I am a big fan of Japanese characters, manga and shows. I would like to do more sightseeing in the south of Japan and buy a lot of stuff. (*Mexico*)

- Tokyo, Japan and Texas, USA (*Nigeria*)
- Tokyo - to see the modern technology, Meiji Shrine, Imperial Palace and Museums.
Osaka - to view the modern port city
Kyoto (*Kenya*)
- 1. Kasumigaseki, Chiyoda, Tokyo,
2. Geneva, Switzerland,
3. Alexandria, Virginia, USA,
4. Munich, Germany, and
5. South Wales, UK.
(*Nigeria*)



- Tokyo has always been my first choice since 2010 when I was a university student. I love the places, people and food there. Now, as I am an intellectual property lawyer, I always dream of visiting the JPO to see how the IP system works in Japan. (*Vietnam*)
- I did not have the opportunity to go to Japan, as a consequence of the pandemic, therefore, I would love to go to Tokyo and Okinawa. Likewise, I would love to go to Kuala Lumpur in Malaysia, if I had the opportunity to visit a place outside of Japan. (*Mexico*)
- I would definitely love to visit Tokyo and Osaka. (*Philippines*)
- I would like to visit Hokkaido in Japan and Greece. (*Brazil*)
- I have mostly visited various countries in Asia including Singapore, Malaysia, Indonesia, the Philippines, Hong Kong, Macau, Vietnam, Cambodia, Laos and Thailand. As of now, I plan to visit other major countries in Asia including Japan, South Korea and China. (*India*)
- I am planning to go to Korea or Japan with my family. (*Malaysia*)

Message from Lecturer



FY 2022 JPO/IPR Training Course for Practitioners Specializing in Trademarks: Findings from Assignment Presentations



Ms. KANEMARU Yumi

Manager, Intellectual Property Division
Kewpie Corporation

I am writing to express my gratitude for the opportunity to participate in the FY 2022 JPO/IPR Training Course for Practitioners Specializing in Trademarks, which was held for the first time in three years; and also to have gained knowledge and insights that are difficult to obtain through the course of daily work.

The FY 2022 JPO/IPR Training Course for Practitioners Specializing in Trademarks consisted of seven online training sessions and six days of invitational training. Using our company's trademark usage as a topic, the 16 trainees from eight countries studied the differences between the legal systems in Japan and their home countries, trademark application strategies, and means of trademark protection. On the last day of the program, each trainee then made a presentation as a summary of the training in the form of a proposal to our company.

During the invitational period, the participants visited Sengawa Kewport in Sengawa-cho, Chofu City as a fieldwork site, where they observed the actual use of trademarks through a tour of the office, an explanation of our trademark strategy, and a visit to MAYOTERRACE, which is a tour facility for customers.

Each trainee carefully investigated our company's business development in his/her own country, as well as rights protection and sales (in-store, as well as via the Internet). Based on this, they then came up with effective strategy proposals for our company, which they presented enthusiastically.

We were greatly impressed by the proposal of a method to protect the entire product not only by utilizing traditional rights protection for the mark alone, such as the "KEWPIE" character trademark and the "Kewpie doll" figure trademark, but also by using new types of trademarks. The suggestions given helped us to realize that many products can be protected in a broader and more multi-faceted way. Such suggestions included rights protection for the label as a whole, the use of series trademarks, and new

methods of protection through three-dimensional and positional trademarks. In addition, we felt that these strategies would make it easier to eliminate counterfeit products, which is a considerable source of concern.

The trainees also proposed the use of peripheral laws and regulations such as the Unfair Competition Prevention Act, copyrights and design rights, and individual countries' approaches to parallel imports and the use of customs offices. This helped us to realize that we must think more deeply about how we can implement a protection system that is tailored to each country's particular situation, and not simply stop at trademark protection.

Furthermore, it was a very interesting opportunity to hear a variety of opinions not only on legal issues, but also on forms of business, marketing channels, and consideration of public opinion.

Although we have limited resources, the feedback that we received also helped our team members to renew their commitment toward deepening and developing strategies for trademark applications and product protection that is tailored to the specific business situation in individual countries.

We would like to express our sincere gratitude to all trainees for their passion shown toward our company through this training assignment, as well as to JPO staff, patent attorney Reiko Toyosaki, and everyone else involved with this very valuable opportunity. We hope to return the favor by further developing our business overseas.



Lecture at the Kewpie Corporation



Trainee presentation



Tour of MAYOTERRACE



Group photo with course members



Returning Kindness

Mr. OGIYA Takao
Director General of APIC



There is a Japanese folktale called “Kasa Jizo” that tells the story of a kind-hearted old man and woman who lived deep in the mountains. The two lived by selling conical hats, but were too poor to prepare for New Year’s celebrations. The old man went out to the town to sell hats even on a snowy New Year’s Eve, but not a single hat was sold.

When the old man had no choice but to return with the hats, he noticed along the road home six Jizo statues*, whose shoulders and heads were covered with snow. The old man felt sorry for them, so he brushed off the snow and put the hats onto their heads. Since there were only five hats, however, he was one short; and so he draped his own hand towel over the head of the last Jizo statue. (Image 1)



(Image 1) Kasa Jizo - 1

When the old man returned home, he told his wife about the Jizo statues. Instead of scolding him, however, she rejoiced and praised him for doing such a good thing. Even though they had no New Year’s rice cakes, they spent the New Year’s Eve at peace.

Just after midnight, the old man and woman woke up after hearing footsteps approaching outside. They peeked through the doorway, and to their surprise, they saw a mountain of New Year's decorations, rice cakes, and other treats piled up in front of the house.

The startled old man and woman peered around, and saw what looked like six figures walking across the street. Five of the figures were wearing conical hats, and the last one was wearing an old man's hand towel on its head. The Jizo had come to deliver rice cakes and other treats in appreciation for the hats. (Image 2)

In this way, the old man and woman were able to have a successful New Year's celebration.



(Image 2) Kasa Jizo - 2

This story is about Jizo statues who returned many things in gratitude for the kindness and good deeds of an old man. More generally, however, the act of returning kindness that was shown by the Jizo statues is known and respected in Japan in what is known as *ongaeshi*.

Moral education was emphasized in Japan from the Meiji period until around World War II, when the virtues of the “ideal Japanese person” were characterized by diligence and hard work, honesty, kindness, patience, and gratitude. And it seems that folktales were used to enhance this educational effect. Among these virtues, kindness and gratitude are closely related to “returning kindness”. We have been taught since childhood that it is important to be kind to others, and when people are kind to us, we should not forget the favor.

The message contained in this “Kasa Jizo” folktale, therefore, is to be kind to others. If you do so, that kindness will eventually come back to you in the form of happiness. It may seem a bit excessive to give a mountain of New Year's delicacies in return for five conical hats and a hand towel, but this was probably an attempt to teach children that “returning kindness” was an extremely important act.

There is a tricky problem with this idea of “returning kindness”, however, since its meaning changes depending on how the recipient perceives such an act. It is said that there are three main types of feelings that recipients have in response to an act of kindness: (1) gratitude, (2) indebtedness, and (3) socially-enforced obligation.

Gratitude, which is extremely healthy, is a feeling expressed in the form of either a verbal “thank you”, or a return of goods or money wherein gratitude is honestly conveyed to the giver of the favor.

In the case of feeling indebtedness, the recipient of the favor is reminded of the burden and sacrifice of the one who gave the favor, and feels “sorry” or “apologetic”. That ought to be enough, but the recipient still feels like they must resolve this debt, and worries about trying to return more than they received. Even if the one who gave the favor does not think it was such a big deal, the one who received the favor overreacts, and the one who gave the favor also feels stress.

The Jizo statues of Kasa Jizo must have “returned kindness” out of pure gratitude, but because they returned so much, this exerts casual pressure on the reader's mind, escalating the feeling of guilt in the Japanese mind and perhaps encouraging one to feel that if they owe someone something, they must return more than they received.



(Image 3) Mid-year and year-end gifts

often treated more like a socially-accepted norm than as a gesture of gratitude. Such acts are called *giri* (obligation), and have become superficial and ritualistic. Many organizations are therefore now discontinuing the custom of giving mid-year and year-end gifts.

This type of superficial and ritualistic social compulsion may be the reason why the majority of Valentine's Day chocolate gifts in Japan these days are *giri* chocolates (Image 4).

In order to promote a more healthy exchange, it would be more appropriate to receive an act of kindness with an open heart and be thankful from the bottom of one's heart, and just leave it at that.

A further way of thinking about this response of gratitude is the concept of "pay it forward". If you receive a favor or kindness from someone, instead of returning the favor to the recipient, you should act kindly or gently toward someone else.

A person who receives a favor from another person in turn bestows favors onto others, who then subsequently provide various favors to still other people. In this way, the baton of that warm compassion connects from person to person endlessly, resulting in better relationships in workplaces, schools and society as a whole.

The old man in the Kasa Jizo story did not offer the Jizo statues hats because he wanted something in return. In other words, it was an act of pure kindness, generosity or free love. The old woman also praised this act of love by the old man.

Personally, I believe that the folktale of Kasa Jizo was originally intended to teach children the beauty within the act of free love, rather than being a story about returning kindness.

Kindness and generosity without asking for anything in return, free love, sincere gratitude for acts of love, and the spirit of beneficence are needed today more than ever.

*Jizo statues represent the guardian deity of children.

The case of socially-enforced obligation is even more troublesome. Typical examples of this are mid-year (summertime) and year-end gifts, which is a traditional Japanese custom of giving gifts twice a year as a token of gratitude to those who have bestowed favors upon you. (Image 3)

If it is only for people who are truly indebted to you, there is no problem. When the gift is given to your boss or business partner at work, however, it is



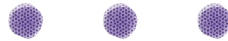
(Image 4) Obligatory chocolate



Let's Explore Japanese Culture!!



In this section, the editorial department has been independently selecting and featuring tourist spots in Japan. Of course, all of these places are open to the general public. There are many fascinating places in Japan, and we hope that you will find this information useful in deciding which places to visit when touring Japan!



Toei Animation Museum (Nerima City, Tokyo)

Japanese manga and anime have been translated into many languages and become popular overseas during recent years, attracting the interest of many trainees.

Today I visited the Toei Animation Museum, which is the company that has produced familiar titles such as *One Piece*, *Dragon Ball*, *Slam Dunk* and *Pretty Cure*, along with more recent classics including *UFO Robot Grendizer*, *Miraculous Ladybug* and *Cat Noir*.

Nerima City, the mecca of anime

Nerima City, located in the northwestern part of Tokyo, is where Japan's first color feature-length animated films, TV animations and many manga were created. This is said to be the birthplace of Japanese animation, and various masterpieces have continued to be produced there since this time.

Toei Animation is the company that produced Japan's first color feature-length animation film, and there is also a Toei Animation Museum onsite. The nearest train station is Oizumi-gakuen on the Seibu Ikebukuro Line. Just outside the north exit ticket gates is the Oizumi Anime Gate, where familiar characters greet visitors and welcome them into the world of animation.

- > <https://www.gotokyo.org/en/spot/1696/index.html>



©Tezuka Productions ©Leiji Matsumoto/Leijisha, Toei Animation
©Asao Takamori, Tetsuya Chiba / Kodansha ©Rumiko Takahashi/Shogakukan

What is the Toei Animation Museum?



This is the corporate museum of Toei Animation, which produced Japan's first color feature-length animated film. The company's mascot is Pero, who was the main character in the animated feature film *The Wonderful World of Puss 'N Boots*, which was produced by the company in 1969 and became a huge hit.

The Toei Animation Gallery, which is the museum's predecessor, opened in the Oizumi Studio in March 2003 for the purpose of exhibiting archived materials of animations produced by the company. The Oizumi Studio was built in 1956, the year of the company's founding, and was a revolutionary building at the time. It was nicknamed the "air-conditioned white palace," but was rebuilt after more than 50 years due to deterioration.

Construction of the new Oizumi Studio began in 2014, and was completed in 2017. The Toei Animation Gallery was renamed the Toei Animation Museum to match the new studio, and opened on July 23, 2018. Along with the name change, the concept of the museum was also slightly modified. It was

designed not only to exhibit archived animation materials, but also to provide a space where children—who comprise animation’s main target audience—can play with goods and other items; and where the production staff can visit in order to experience the works and determine how to make them more enjoyable for children.

Upon arrival, visitors are greeted by the Pero Fountain. I heard that something happens at the fountain once an hour, but the fountain was unfortunately frozen when I visited due to blisteringly cold temperatures, so I was unable to see what would happen.

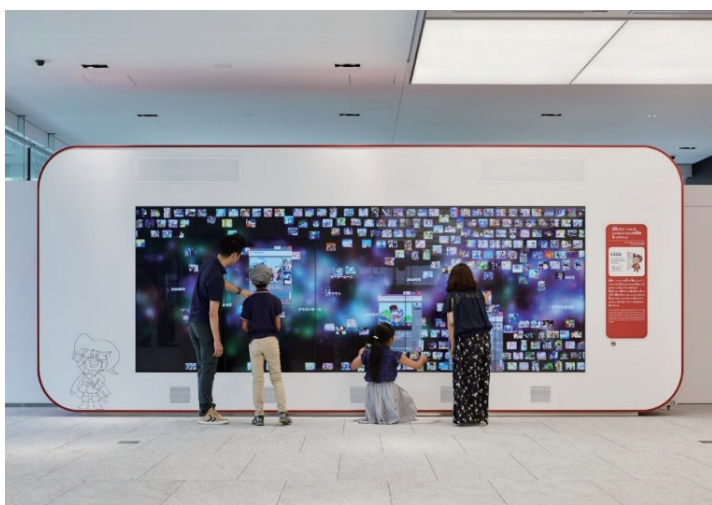


The garden has a variety of quirks that can make you chuckle when you notice them. I hope that you’ll visit the museum and look for them yourselves.



Also onsite is the iconic Space Pod, which Vegeta© (a member of the Saiyan and Bulma’s husband in Dragon Ball) rode in, and apparently landed at this location. I was disappointed that I could not meet him in person.

The Toei Animation Museum is divided into two sections: one for exhibitions, and another for experiences. The history and production process of animation are displayed in the exhibition section, along with secret behind-the-scenes stories of popular animated films. Numerous past icons of animated films produced by the company are floating on the screen of a large monitor in the back of the room, and visitors can see detailed information about the films by touching these icons. The screen, which features many of the company’s works from its more than 60-year history, is filled with so much delightful information that you will lose track of time and become immersed in browsing, regardless of your age.



Please check this URL to see what kind of films Toei Animation is producing, and to rediscover Toei Animation’s many titles from throughout the years:

<https://lineup.toei-anim.co.jp/en/>

There is also a dance corner in the experience section where you can dance along with the images, as well as a photo spot, and a kids' space that is very popular among children.

I was also able to take pictures of myself fighting with different characters from Dragon Ball©.

In addition to the museum, there is also a store with souvenirs available for purchase, and various kinds of exclusive museum merchandise that are only available here.



©Bird Studio/Shueisha, Toei Animation

What is Toei Animation Co., Ltd.?

Toei Animation was Japan's first full-scale animation production company. Toei, a major motion picture company, was founded in 1956 as Toei Doga Co., Ltd. with the goal of becoming the "Disney of the East", and Hiroshi Okawa was appointed President and Representative Director. Toei enjoyed a period of growth after President Okawa restructured the company, and due to the popularity of Disney's animated films after they were imported to Japan, an animation company was established in the Toei Group in order to expand into the production of internationally-accepted animation as a new business venture.

A new and revolutionary animation production studio was built inside Toei's Tokyo Studio in 1956 to produce the first feature-length animated color film in Japan. Titled *Hakujaden* (The White Snake Enchantress), this was a pure story of genuine love between a young man and a beautiful girl who was a white snake fairy. In addition, this was an action film whose characters encountered pandas and other cute friends, and overcame numerous difficulties together in order to fight.

Post-scoring, wherein animation pictures are produced first and voices are then recorded on the completed picture, has become the mainstream in Japan. This contrasts with pre-scoring, whereby animation pictures are produced after voices are first recorded, which is the mainstream overseas.

Hakujaden was initially prepared for production with the pre-scoring method. Given the existing technology of the time, however, it was difficult to produce a video on a previously-recorded recording, and so the film was eventually produced using the post-scoring method. In addition, since there was no profession of voice acting at that time, two well-known actors with strong acting skills had to use different voice tones for all of the eight characters.

As for the actual animals from the film, the emphasis was on reproducing their voices as faithfully as possible. And while pandas are well-known animals today, they were totally unknown in Japan at that time. Pandas were also rarely published in books, so the artist famously used a single photograph as a clue in order to reproduce the panda in the film. The name "Panda" was also used as the character's name. Pandas first came to Japan in 1972—which was 14 years after *Hakujaden's* release—so it would not be an exaggeration to say that the first time Japanese people encountered pandas was in this film.

(<https://www.toei-video.co.jp/special/hakujaden/>) (Japanese only)

This 79-minute color feature-length animated film took two years to make. Released on October 22, 1958, it marked the birth of the first full-scale animated film in Japan. October 22 is therefore now known as “Anime Day” in Japan (although it is unfortunately not a public holiday).

Animation as the culmination of many people’s skills

Did you know that 24 frames per second are required to produce an animation? When superimposed, it is calculated that 36,000 frames are in fact needed to produce a 25-minute animated films. In order to provide viewers with the joy and entertainment of animation, many people are involved in the production process. This includes not only those who draw the frames, but also those who plan the animation, write the story, draw the backgrounds, film, edit, add voices, create sound, and direct everyone involved.

It is truly mind-boggling, therefore, to consider the number of feature films which were produced at the time. I am deeply moved when I think of animation as a comprehensive art form created with the skills of so many people.

Animation and intellectual property

Toei Animation Co., Ltd., which produces many of the Japanese animations you know and love, is one of the world’s leading animation production companies.

The protection of intellectual property is extremely important, and business expansion and globalization are based on these intellectual property rights. Because invisible ideas and concepts nurture culture, while also emphasizing the importance of intellectual property to protect them, the company is a leader in expanding and developing Japanese animation worldwide as a part of Japanese culture without compromising quality. This results in spreading the importance of intellectual property (respect for human ideas) in Japan.

When you visit Japan, please stop by the Toei Animation Museum, one of the sacred sites of Japanese animation, which is full of its origins. Nerima Ward, as the birthplace of Japanese animation, has also published a guidebook introducing Tokyo’s animation mecca, and the production of anime, which you can see here:

<https://www.sangyo-rodo.metro.tokyo.lg.jp/tourism/shisaku/animation-guide/index.html>

■ **Toei Animation Museum** <https://museum.toei-anim.co.jp/>

2-10-5 Higashiōzumi, Nerima City, Tokyo 178-0063

(15-minute walk from the north exit of Oizumi-gakuen Station on the Seibu Ikebukuro Line.

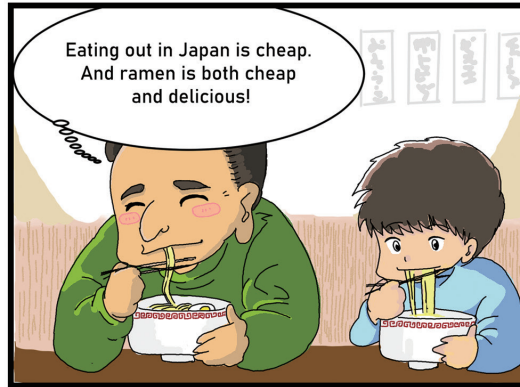
Approximately 7 minutes by bus or taxi)

Admission: Free

* Advance reservations: Required

<https://museum.toei-anim.co.jp/reservation/> (Japanese only)

Happenings in Japan



©Hakama

* Many ramen shops in Japan keep their prices down, but then need to produce a high customer turn-over rate.

Editor's Note



Hello. This is Mitty. In October, we resumed holding our training courses in-person. We started with just a handful of courses as the world is still dealing with COVID-19. The new regulations may have been difficult for those who had visited Japan in the past or for those with different regulations in their own country. Given the challenging circumstances, we did our best to make all participants feel welcome and to offer the best hospitality we could at this time. What I felt was the biggest difference with online training was being able to make meaningful eye contact. I was surprised at how my facial expressions changed depending on the presence of eye contact. Yes, I smiled more. Moreover, I was very happy to see smiling faces. This is the last edition of this fiscal year, and it includes photos of the closing ceremony. I hope the training courses will continue to bring smiles in the next fiscal year. Thank you very much for all your support this year.



Hello everyone, it's Ken here! January and February are Japan's coldest months, with the warmth returning in March. Although our country would not normally be so cold given its latitude, the fact that we are an island nation means that we are subject to numerous wind systems. In addition, we have four distinct seasons. Although I myself have rarely visited places in Japan with heavy snowfall, a media report from the United States revealed that the world's top three cities with populations over 100,000 that have the highest snowfall are located in Japan—with the number one spot being the city of Aomori. Another interesting fact about Japan is it is regularly hit by tropical cyclones with high wind speeds, called "Typhoons", every year. In my view, Japan is an extremely unique country. And finally, although this may be an unrelated fact, it is also extremely safe. I hope everyone will come here to see us!



Hello! This is Minori. When I read all the responses to the question 'Where would you like to visit next?' asked in the 'Get to know your IP Friends' section, it made me want to go travelling too. I have never been to a majority of the countries where the trainees are from and I would like to visit them one day.

This fiscal year, I was in charge of two hybrid courses as a coordinator. The first half of both courses consisted of online lectures and the second half consisted of lectures with participants in Japan.

I was very happy to see the people I had only seen on screen in the training room in person. We were able to meet face-to-face and talk about various topics, which was a wonderful experience, different to that of online situations. I hope that even more trainees will come to Japan next fiscal year and enjoy Japanese culture, food and sightseeing along with their training!

[The meaning of 縁 (Enishi)]

“Enishi” refers to the bond created between people when encountering someone they were destined to meet. We have chosen this term as the title for our publication because we are all members of the Intellectual Property community, and the bonds created between us extend beyond national borders. We hope that you will use this informative publication to deepen the “Enishi” you have created with your IP Friends.

Publication of this magazine is consigned by the Japan Patent Office to the Japan Institute for Promoting Invention and Innovation.

[Consigner]



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