

# **Role of Patent Attorney**

Japan Patent Office  
Asia-Pacific Industrial Property Center, JIII

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## I. PATENT

### 1. General Views

In viewing the developments of the patent (intellectual property) system in Japan, it may be remarkably noted that patent attorneys have played a very important role in the intermediary care of industrial property matters involving legal and technical problems between the applicant for patent and the Japan Patent Office.

A patent attorney in Japan can represent a client before the Japan Patent Office in any industrial property cases including patent, utility model, design and trademark cases, and can represent a client even before the Tokyo High Court or the Supreme Court for an appeal case against the Appeal/Trial Board decision in the Japan Patent Office (JPO). In addition, a patent attorney can give a client an infringement/validity opinion on patent, utility model, design, and trademark cases, including advice of designing around or avoiding an infringement or comprehensive advice on intellectual properties. A patent attorney can participate in an infringement lawsuit as an adviser or a counselor to a general attorney representing plaintiff/defendant before a court. A patent attorney can be an arbitrator/moderator since the Japan Patent Attorneys Association (JPAA) and the Japan Federation of the Bar Association (JFBA) jointly opened the Industrial Property Arbitration Center (the present name: the Japan Intellectual Property Arbitration Center; JIPAC) on April 1, 1998. Also, a patent attorney can handle PCT international patent applications and Madrid Protocol international registration applications.

The patent attorney system in Japan has been greatly developed over the last ten years. The social background therefore may be said as follows:

First, such recognition has rapidly spread in Japan that the 21st century will be an age of wisdom in which information and knowledge create high added value, and accordingly,

Japan must strengthen its industrial competitive power through strengthening intellectual creative activities and protecting effectually the results of such strengthened activities. Second, in such a situation, industry in Japan has strongly demanded the strengthening of its legal services so as to have both technical specialty and legal knowledge at the highest level, which users of intellectual property system seek. As a result, with regard to what the patent attorney system as the human resources for the intellectual property system should be, there have been intense discussions made especially in government councils, and on the basis of the outcome of such discussions the Patent Attorney Law has often been revised .

In 2000 an overall revision of the Patent Attorney Law was made with the aim of coping with the needs of the times. Under the new Law, some new businesses are explicitly added to the patent attorneys' business. These are: representation for seizure procedures before the Customs House relating to intellectual property rights, representation for Alternative Dispute Resolution (ADR) procedures before a designated ADR body relating to industrial property matters, layout of circuits or unfair competition matters, and representation or mediation for conclusion of various agreements relating to intellectual property matters, layout of circuits or technical secrets.

Further, under the 2002 revision of the Law, a patent attorney became able to represent a client in an infringement action in a court together with an attorney-at-law under the condition that he/she meets certain requirements, and under the 2005 revision, disputes over copyright matters were added to the scope of the disputes in which a patent attorney can represent a client.

Today in Japan, patent attorneys have been requested more and more to participate in the "Intellectual Creation Cycle". The Intellectual Creation Cycle consists of three stages; the first stage, "Creation of Intellectual properties" (R&D, inventing activities), the second

stage, “Acquisition of Intellectual property rights” (filing of industrial property applications, acquisition of rights therefrom), and the third stage, “Utilization of Rights Acquired” (exploitation, licensing, injunction of infringement, resolution of intellectual property disputes, and so on). Profits obtained in stage three are then reinvested into stage one for the further development of intellectual property.

It is now necessary for patent attorneys to participate actively in all of the three stages with their full technical expertise and legal knowledge to perform their social mission. Traditionally, the main role of the patent attorney has been in the second stage, however, today it is required that the technical expertise and legal knowledge of patent attorneys be made use of in the first and third stages as well.

Incidentally, a patent attorney in Japan, “BENRISHI” in Japanese, is not like a patent attorney nor patent agent in the U.S. There is no appropriate English translation of “ENRISHI”. However, for convenience sake, in this article, the expression “patent attorney” is used.

In addition, an attorney-at-Law is “BENGOSHI” in Japanese. “BENGOSHI” can handle all of the legal matters, including cases concerning intellectual property matters, and represent a client before the Japan Patent Office, the courts and the ADR Center mentioned above .

## 2. The Role of a Patent Attorney

The role of a patent attorney is not necessarily the same in all countries in which there is a patent attorney system, but what is common is that the patent attorney is in a position to stand alongside the applicant and fully assist him or her in the security and protection of his or her rights. To put it simply, the role of a patent attorney is to exert oneself to realize the interest of his/her client to the utmost.

One of the main professional roles of a patent attorney in Japan is to take proceedings for the acquisition of industrial property rights at the Japan Patent Office.

In connection with applications to be filed abroad, a Japanese patent attorney undertakes the same work but, of course, the filing and the prosecution with Patent Offices in foreign countries are done through a patent attorney or patent practitioner in the respective countries.

A patent attorney is expected to be available to answer a wide range of questions from his/her clients. In connection with a foreign filing in other countries, a patent attorney may be consulted as to what type of protection is available, in which countries the application should be filed, by when an application should be filed, and so forth. A patent attorney is often expected to give advice on or to be consulted as to which one of the various routes available should be used for the filing of applications in foreign countries.

As is well known in the patent field, the Patent Cooperation Treaty (PCT) route and the European Patent Convention (EPC) route are now utilized widely, and in the trademark field the Madrid Protocol route and the European Community Trademark (CTM) route are also utilized widely. In these circumstances, applicants must now give consideration as to whether they should file an application utilizing such regional system routes.

### 3. The Dialogue with Applicants

#### (1) Approach by Applicants

The first approach to a patent attorney by an applicant occurs when the applicant desires to file a patent application. By the time this approach is made, the applicant normally has decided to file an application. However, sometimes the applicant consults a patent attorney to determine whether his/her invention is patentable. In such a situation, the patent attorney is expected to study the prior art which the applicant may

have in his/her possession.

Inventors are generally skilled only in the field of the art with which they are familiar. Having a wide knowledge of intellectual property laws and practice, the patent attorney is consulted on and advises on all areas of intellectual property laws and practice and the rights that can be accrued therefrom for inventors and applicants.

For an application which a patent attorney represents overseas clients for filing in Japan, the first approach by an applicant is when he/she receives an order letter for filing an application. As to what procedures are followed after receipt of the order letter for filing will be explained later.

## (2) Conflict of Interest

Clients do not desire or wish to see their competitors' patent applications being handled by the same patent attorneys or patent attorney's firm that are handling their own applications. In every country where there is a patent system, either by law or ethical rule, double representation or mutual representation is prohibited and thus patent attorneys cannot represent both of the parties which are in conflict in the handling of proceedings inter-partes, such as, invalidation trials or any proceedings related to litigation. In Japan, "Conflict of interest" is specifically provided for in Article 31 of the Patent Attorney Law revised in 2000, which states as follows:

### Article 31 (Cases that a patent attorney may not undertake)

A patent attorney may not perform services for any of the following cases (however, as far as the case corresponding to item (iii) is concerned, he/she may do so if the client whose case is already in his/her charge has consented thereto):

- (i) the case in which the patent attorney supported the adverse party in the consultation requested, or accepted the adverse party as his/her client,

(ii) (omitted)

(iii) any other case the patent attorney is requested to undertake by the adverse party in the case he/she has already undertaken,

(iv)-(vii) (omitted)

Further, Article 32 stipulates as follows:

Article 32 (Types of disciplinary action)

When a patent attorney violates this Law or an order based on this Law, or makes serious misconduct unsuited to a patent attorney, the Minister of Economy, Trade and Industry may punish him/her as follows:

(i) Admonition,

(ii) Suspension from all or a part of practice for up to two years,

(iii) Prohibition from practice.

It is said that, according to the revised Patent Attorney Law, a severe view of conflict of interest similar to that of the Law of the Attorney-at-Law is stipulated. The above revised Law is stipulated from the viewpoint of protection of clients, the propriety of a patent attorney's business and retaining the dignity of a patent attorney.

In Article 31, the term "case" is interpreted to include a proceeding such as filing a patent application, and thus, not limited to an appeal case nor a court case.

The Patent Law also uses the term "case" in a broad sense such that it includes filing of a patent application. For example, Article 17 of the Patent Law stipulates that a person who is proceeding before the Japan Patent Office may make amendments only during the pendency of the case before the Office, and hence, it is interpreted that filing of a patent application is covered in the scope of the term "case" of Article 31(iii) of the Patent Attorney Law.

Conflict of interest of Article 31(iii) often occurs during prosecution of a patent attorneys' business. For example, when a patent attorney represents a case of an adversarial system such as an invalidation trial or an infringement suit with reference to a patent or a registered trademark, and at the same time represents the filing of a patent application or a trademark application of the other party of the adversarial system case, then the patent attorney's conduct will fall under Conflict of Interest of Article 31(iii).

Thus, in order to avoid Conflict of Interest of Article 31(iii), it is considered to be essential for a patent attorney to make up conflict check lists and to check the lists before receiving and proceeding with a new case. An example of a possible check list may be as follows:

Kind of case	Date of receipt of the case	Plaintiff (Client)	Defendant (The other party)	Ref. number	Registration number	Case number
Invalidation Trial						
Opposition						
Revocation Trial						
Infringement Suit						
Offer of Information						

A checklist where the client is a defendant would also be needed.

Once the problem does occur, the patent attorneys would need to have careful dialogue with one or both of the parties involved as to how the problem should be resolved. The courses of action which can be taken would include the following:

- (a) Explaining the conflict situation to both parties and withdrawing from representing either or both of the parties for the particular cases which has brought about the conflict.

- (b) Explaining the conflict situation to the junior party (i.e., the later coming client) and withdrawing from representing that party for the particular cases or, depending on the party's decision, for all their cases.

When patent attorneys have to withdraw from representation of one or both parties due to conflict during prosecution of applications, naturally they must extend cooperation in the smooth transfer of the cases to the new attorneys the parties may select.

If the party concerned has no ideas for the selection of a new patent attorney, the withdrawing patent attorneys should cooperate by introducing a possible or suitable new patent attorney or attorneys.

### (3) Responsibilities of Patent Attorneys

As soon as patent attorneys have committed themselves to take instructions for filing a patent application, their responsibilities as representatives begin and this means that patent attorneys must not only perform high quality work but also keep the case safely pending under all circumstances.

When instructions are received from abroad for clients' cases through foreign attorneys, those attorneys become responsible for the charges and costs incurred and for settlement of the debits rendered. Incidentally, could a patent attorney be allowed to let any relevant cases become abandoned for the reason of non-payment? No, not until everything possible has been done to protect the interest of the ultimate client and this means that the cases concerned must be kept in force and patent attorneys must try everything possible to continue to communicate with instructing attorneys or, depending on the situation, directly with the ultimate client. How and when patent attorneys can withdraw from the representation under such circumstance vary

depending on the situations involved.

#### 4. Search

Many large companies in Japan conduct prior art searches before filing applications using their own Patent Departments so as to avoid filing invalid applications. Small enterprises or individual inventors tend to file applications without conducting complete searches because, unfortunately, the cost would normally be much higher than the fees for filing applications.

However, clients often look for services of patent attorneys for uncovering prior art references when they face the need, for example, of demanding an invalidation trial against a competitor's patent.

Another situation wherein any pertinent prior art references detected could be effectively used is the procedure called "Presentation of Information" which may be relied upon to show that an invention claimed in a third party's pending application is not patentable.

For conducting searches with regard to Japanese patents or patent applications, we rely heavily on "IPDL" (Intellectual Property Digital Library) which is offered by the Japan Patent Office free of charge through the Internet, and "PATOLIS" (Patent On-line Information System) which is a commercial on-line patent information service system. Where the searches should cover patent publications in foreign countries, the commercial system "DIALOG" and the public system esp@cenet, which is offered by the European Patent Office (EPO) free of charge, are useful.

#### 5. Preparation and Filing of Patent Applications

##### (1) Documents Required

In Japan, now a power of attorney (or certificate for representation) is not required at the time of filing an application. However, power of attorney is still required in some cases later, for example, at the time of appealing against a decision of refusal by an Examiner. Therefore, it is desirable to obtain power of attorney from a client when receiving an order letter for filing an application. In addition, in Japan, neither notarization nor legalization is required for executing power of attorney.

Normally, power of attorney alone is sufficient, but when, judged merely from the name of the applicant, it is not clear whether the applicant is a legal entity or not, submission of a notarized corporation certificate will be required.

Another formal document which is important is a "certified copy of the original application" for claiming the Paris Convention priority. If this document is not filed within the statutory period (16 months), the convention priority claim is lost. Therefore, where an application is filed claiming convention priority, it is necessary for the applicant to start requesting the priority document from the Patent Office concerned at the earliest date possible.

However, in the case where the original application for claiming priority is a European patent application under the European Patent Convention, it is not necessary to file such certified copy thereof with the Japan Patent Office as of several years ago, in accordance with an agreement between the Japan Patent Office and the European Patent Office. This agreement has been very welcomed. Also, it is not necessary to file such a certified copy in the case of a priority claim based on a Korean patent application.

For applications that are to be filed in Patent Offices abroad, a patent attorney assists the applicant to complete the formal papers that are required in a given country. Therefore, a patent attorney must always keep updated information as to the

requirements for filing applications in various countries.

(2) The Task of a Patent Attorney

The most important professional task of a patent attorney at the stage of preparation of an application is to draft and prepare the specification, claims and drawings which can give the broadest patent protection to the applicant. The patent attorney's task is to put an inventor's idea into a properly written document using easily understandable patent terminology and make sure that the description and claims meet all legal requirements.

The applicant may discuss or disclose to his/her patent attorney any confidential information without fear of it being divulged or misused because patent attorneys are bound by the Patent Attorney Law to strictly keep to themselves any confidential information which comes to their knowledge in the course of performance of their business. In view of this protected relationship, communications between the applicant and patent attorneys are considered privileged, that is, patent attorneys are immune or protected from any request or demand for disclosure of any confidential information even in litigation. The relevant provision in the Patent Attorney Law is Articles 30, 77 and 80 which are as follows:

Article 30 (Duty to maintain secrecy)

A patent attorney, or a person who was previously a patent attorney shall not divulge nor illicitly utilize secrets that he/she came to know in the course of performance of his/her services without legitimate grounds.

Article 77 (Duty to maintain secrecy of employees etc. of patent attorneys)

An associate or other employee of a patent attorney or a patent profession corporation, or a person who was previously such an associate or employee, shall not

divulge nor illicitly utilize secrets that he/she came to know in assisting in the services under Article 4 to Article 6-2, without legitimate grounds.

#### Article 80 (Penalties)

(1) A person who violates the provisions of Article 16-5(1), Article 30, or Article 77 shall be punished by imprisonment with labor for not more than six months or by a fine of not more than five hundred thousand yen.

(2) The offence of the preceding paragraph may not be prosecuted unless a complaint is filed.

#### (3) Order Letter

When a patent attorney represent overseas clients for filing applications with the Japan Patent Office, he/she normally receives by mail an order letter accompanied by all the necessary documents such as the specification and claims (normally in English), drawings, power of attorney, etc.

For a Japanese patent attorney to be able to effect the timely filing of an application, it is important to ensure that the order letter includes the following information:

- a. Title of the invention
- b. Full name and address of the inventor(s)
- c. Full name and address of the applicant(s)
- d. Nationality of the applicant(s)
- e. Representative of the applicant in the case where the applicant is a corporation (the signatory to a power of attorney)
- f. Date and number of the basic application and the country in which such application was filed in the case of a Convention priority application(s)
- g. The share proportion of each applicant if such share is fixed in the case of an

application in joint names.

## 6. Prosecution of Applications

The prosecution includes patent attorneys' correspondence with the Patent Office and begins from the filing of an application.

### (1) Office Actions on Formality Matters

When this type of Office Action is issued, a patent attorney must quickly inform his/her client because the time limit for filing a proper document is only thirty (30) days and no extension is obtainable.

### (2) Office Actions on Substantive Matters

A patent attorney requires extensive cooperation from an applicant or inventor when he/she receives an Office Action giving reasons for rejection of an application.

When a patent attorney receives an Office Action, he/she first checks the Office Action and then quickly reports it to the applicant and must receive instructions as to whether he/she should:

- a. file an argument, and if so, what kind of argument,
- b. file amendments to the specification, claims or drawings or supporting materials to overcome the reasons for rejection, and if so, what amendments and what materials are required,
- c. file a divisional application, and if so, what claim or claims should be used.

The common grounds which Japanese Examiners use for issuing Office Actions rejecting applications are as follows:

- a. Anticipation by prior publication of the same invention (Patent Law, Section

29(1)(iii))

- b. "Easily thought of" or obviousness (Section 29(2))
- c. Prior claiming in an earlier application (Section 39)
- d. Prior disclosure (but not claimed) in an earlier application (Section 29bis)
- e. Defects in the description (Section 36)
- f. Lack of unity of invention (Section 37)

In dealing with the first two grounds, namely, anticipation and obviousness, which are based on prior art reference, there are two different types of instructions by applicants as to how the patent attorneys should report the action. On the one hand, some applicants expect that the patent attorneys report an Office Action to them without the need of studying the substance of the prior art cited by the Examiner. On the other hand, some applicants expect patent attorneys to study the prior art and make whatever substantive comments they may be able to offer at the time of reporting Office Actions. The former way of handling may be more economical because the applicant or inventor should be in the best position to analyze the differences between the claimed invention and the prior art references cited by the Examiner. In fact, this manner of operations is more common due to economic reasons. However, some clients require comments on official actions, and a draft amendment and/or argument.

However, patent attorneys would be in a position to put the inventors' or applicants' idea into an effective argument and/or amendment bearing in mind that any differences to be emphasized must be related to the objects of the invention. When the distinction over the prior art is not clear from the existing claims, it is always advisable to consider making amendments to the claims so as to bring out a clearer distinction over the prior art.

In dealing with an Office Action relating to prior claiming or prior disclosure in a

pending published patent application, patent attorneys are able to provide applicants with some concrete guidelines as to how the claims could be amended to overcome the Office Action. Normally, applicants must make amendments to the claims together with arguments, but in some rare situations only arguments showing the distinctions between the invention claimed in their application and that claimed in the cited application are sufficient.

With respect to the objections due to defects in the description in the specification and/or claims, patent attorneys are expected to make comments as to how they could be overcome. A number of communications between the patent attorneys and the applicants are often required in order to clarify or confirm the nature of the Examiner's objections and the amendments to be made to overcome such objections.

Sometimes, it may be necessary to interview the Examiner to clarify the objections and in this respect the Japan Patent Office cooperates with patent attorneys and encourages interviews.

Objections relating to lack of unity may be overcome by amendment of the claims, or by the filing of a divisional application.

When an application is finally rejected by the Examiner, the patent attorney makes a report with comments as to what further action can be taken by the applicant for appealing against the Examiners' decision of rejection. An appeal against the Examiners' decision goes to the Trial Examiners at the Patent Office. The Trial Examiners' decision may be appealed to the Tokyo High Court. Finally, a further appeal from the Tokyo High Court judgment may be made to the Supreme Court if the question relates to a matter of law. In all these appeals, the Japanese patent attorney is entitled to represent the applicant, all the way up to and including the Supreme Court.

The general progress of patent applications is as shown in Annex 1 attached to this

text.

### (3) Time Limits for Various Procedures

One of the most important tasks of patent attorneys is to ensure that all necessary steps are taken timely.

Example of steps of procedures for which time limits must be watched and in respect of which patent attorneys and applicants usually exchange a number of communications are as follows:

#### 1) Convention Priority Date

Both when patent attorneys file Convention applications abroad on behalf of Japanese domestic clients and when they file Japanese applications on behalf of overseas clients, they must ensure that the 12 month Convention period is met.

In this connection, applicants must further file a certified copy of the basic application within 16 months from the priority date.

In contrast, when a PCT application for which a certified copy of the basic application has been filed with the International Bureau proceeds to the national phase in Japan, it is of course unnecessary to file a further certified copy.

#### 2) Six Month Grace Period

In Japan, there is a six (6) month grace period for filing a valid application after the applicant's own publication of his/her invention. This must be claimed on the filing date. A copy of the publication must be filed within thirty (30) days of the filing of the Japanese application. An application becomes invalid unless the timely and proper filing is effected.

This six month grace period appears to be unique to Japan as applicants must satisfy the above conditions and procedures and thus this period must be distinguished from the one (1) year grace period found under U.S. Patent Law.

### 3) Request for Examination

A request for examination of a patent application must be made within three (3) years from the actual filing date in Japan. It should be understood that the Patent Office uses both the date of the filing of the request for examination and the filing date of the application as the basis for determining the order of examination of applications.

To monitor the deadlines for making a request for examination, many patent attorneys utilize computer docketing systems. Before being able to receive timely instructions from the client, patent attorneys need to send out regular reminders, since it is the duty of patent attorneys not to allow any application to become abandoned.

### 4) Amendments

In Japan, previously, applicants could make amendments to the specification, claims or drawings only at a very specific time or in a very limited period.

However, by the recent revision of the Patent Law, as to those applications filed on or after July 1, 1995, the applicant may make an amendment anytime up to the time allowed for the reply to a first Office Action. However, introduction of so-called “new matter” is strictly prohibited. Any amendment must remain within the scope of the features disclosed in the specification or drawings as filed.

Further, applicants may make amendments in the period allowed for the reply to

a final Office Action or within 30 days from the date of demanding a trial against an Examiner's decision of refusal, however, such amendment is limited to ( i ) cancellation of claim(s), ( ii ) restriction of claim(s), ( iii ) correction of errors and ( iv ) clarification of an ambiguous description.

#### 5) Response to Office Actions

An Office Action relating to formality requirements must be responded to within thirty (30) days of the mailing date of the Office Action.

An Office Action issued on the merit of an application must be responded to within sixty (60) days of the mailing date of such Office Action. This term in the case of an overseas applicant is three (3) months from the mailing date of an Office Action, however, he/she may request a one-month extension a maximum of three times if he/she requires considerable time to prepare a translation necessary for responding to the Office Action.

#### 6) Appeals

When an application is finally rejected, applicants may file an appeal to the Trial Board of the Patent Office within thirty (30) days from the transmittal of the decision of rejection. This period is thirty (30) days plus sixty (60) days for overseas applicants.

### 7. Maintenance and Enforcement of Patents

#### (1) Registration Fee

The prosecution of a patent application ends with the grant of a patent. There is an important duty for patent attorneys when the decision to grant a patent is issued. Patent

attorneys immediately report this to clients and must make payment to the Patent Office of a registration fee consisting of the first three years annuities within thirty days from the issuance of the decision to grant a patent. Since the time limit within which the payment of the registration fee must be made is quite short, patent attorneys make this payment without awaiting payment instructions from clients unless there are standing instructions to the contrary.

(2) Annuities

Patent attorneys' duties as already explained in relation to the registration fee generally applies to the payment of annuities for the 4th year onwards, which is required to keep a patent in force. However, in terms of the duty and responsibility of patent attorneys, there is one difference between the payment of the registration fee and that of annuities. As for annuities, clients do not necessarily need to rely on the attorneys who prosecuted the application to attend to the payment of the same. Sometimes clients may choose to use a company which specializes in the payment of annuities by using a computer reminder system.

(3) Invalidation Trial to a Patent

Invalidation Trial may be demanded at any time after a patent grant, even after expiration of the patent. Please also see the next paragraph (4).

(N.B.: The post-grant opposition system, once adopted in Japan, was abolished as of January 1, 2004.)

(4) Enforcement of Patent

The preparations for enforcing a patent or defense against the enforcement will

require the advice and assistance of patent attorneys. An infringement suit requires an attorney-at-law and also patent attorneys as technical specialists to assist the attorney-at-law.

The invalidity of a patent cannot be challenged directly as a defense in an infringement suit in Japan. Thus, the only recourse for defendants is to file an invalidation trial against the patent at the Japan Patent Office. (The patentee may demand to correct the relevant claim, description or drawings of the patent in the same invalidation trial procedure, though such correction is limited to restriction of claim(s), etc.)

However, the above circumstances have changed since the Kilby Supreme Court Judgment (Supreme Court (Third Petit Bench)/1998(O)No.364/April 11, 2000/ Texas Instruments Inc. vs. Fujitsu Inc. (the so-called “Kilby” case, named after the inventor Jack Kilby). In the Kilby case, the Supreme Court rendered the demand for injunction and for compensation for damages would constitute an abuse of right and could not be allowed since the demand is based on the patent clearly having a ground for invalidation.

Since the issuance of this judgment, there have been an increasing number of cases in which the courts handle invalidation issues, which mean that the Japanese patent litigation practice has become similar to the U.S. practice in this regard. Therefore, both parties should pay much attention to the invalidation problem in infringement lawsuits, in parallel with invalidation proceedings before the Japan Patent Office.

## II. TRADEMARK

### 1. Introductory Remarks

The role of a patent attorney in trademark matters is basically the same as in patent matters stated above. In this chapter, some concrete examples unique to the trademark field will be explained.

### 2. Conditions for a Good Trademark

First, a trademark must be easy to remember, leave a good impression and have a good image for consumers. Second, a trademark should be distinctive and dissimilar to another trademark.

The best trademark is one comprising a completely coined word, for example, CANON, CASIO. The second best is a mark not descriptive but suggestive of the nature of the goods or the origin of the goods, for example, TELECOPIER for facsimile machines, which is suggestive of machines producing copies through telecommunication systems. Another example is PANAFAX for the same goods as the above TELECOPIER, which reminds us immediately of the origin of the goods because PANASONIC CORPORATION owns many trademarks with the prefix PANA, such as PANASONIC, PANAFIX, PANARACER, etc. Therefore, PANAFAX will produce the image that the goods are manufactured by the PANASONIC CORPORATION.

### 3. Search

In order to decide on a mark, patent attorneys are sometimes requested to conduct a search by clients and give them opinions based on their expertise. In Japan there is no system of an Official Search being conducted, as there is in some other countries.

As to a word-mark search, patent attorneys usually use either of some on-line search systems offered through IPDL (Industrial Property Digital Library) by the Japan Patent Office (JPO) or some private corporation.

For a trademark search, patent attorneys must bear in mind the following points:

- ( i ) Patent attorneys must understand the nature, type and use of the goods on which the proposed trademark is to be used.

Especially in the case where the goods in question are very new and there have been no similar goods, patent attorneys must pay careful attention to the goods. Otherwise, they may search in a class different from the pertinent goods which will prove useless.

We will follow in detail one of our clients' marks. With respect to facsimile equipment, we received an order for conducting a search in 1968 when such equipment was not familiar to the general public and was not listed in the Official Classification of Goods for Trademark Registration published by the JPO. We wondered whether the equipment belonged to Japanese Old Class 11 (Electrical communication machines) or in Japanese Old Class 9 (Office machines), and as a result, decided to make a search in Japanese Old Class 11. It was later confirmed that the goods belonged to Japanese Old Class 11.

- ( ii ) Patent Attorneys must study whether or not the proposed trademark is descriptive, or commonly used on the goods in the trade.

A descriptive mark should not be monopolized by particular parties and therefore such marks are not registrable. We were instructed on the search with two trademarks as candidates, COPIFACS and PANAFAX, but COPIFACS appeared to be weak on the point of distinctiveness.

- ( iii ) It must be carefully checked whether there are any trademarks identical with or similar to a proposed trademark which are likely to cause a conflict.

This is the most difficult work connected with a search and requires much experience and expertise.

As a result of a search, "PANAFAX" was decided on as the trademark to be used in Japan.

#### 4. Obtaining of Registrations

When a trademark has been decided on, a trademark application must be filed with the JPO in order to obtain registration thereof. In Japan, a trademark right becomes effective only upon its registration. A mark can be easily protected by and through a trademark registration, while a well-known mark being un-registered has some powers preventing others from using confusingly similar marks by virtue of the Unfair Competition Prevention Law.

Thus, obtaining the registration is very important for clients and, naturally, procedures for obtaining registration are the most important business of patent attorneys concerned with trademark rights.

Over five million trademarks have been registered since the trademark registration system was introduced in Japan. In 2007 over one hundred and forty thousand applications were filed, and 96 thousand marks were registered at the JPO. About 70% of the applications were filed through patent attorneys.

As you can see, about 30% are not filed through patent attorneys. The Trademark Law allows filing applications without the intermediary care of a patent attorney. This is advantageous for small companies and individuals by keeping costs lower, although the demerits of the lack of experience and professional expertise of applicants must be carefully weighed.

(1) Filing of Applications (First-to-file principle)

The party that is entitled to obtain a trademark registration is the first applicant for a trademark registration, and not the first user thereof. Therefore, if a trademark is intended to be used in Japan, it is desirable for the applicant that an application therefor is filed as early as possible, and, naturally, we patent attorneys have to very quickly take steps for the filing of an application.

(2) Response to Official Actions

An application for a trademark is usually filed through the e-filing system since 2000 and is given an application number promptly.

The period for responding to an Official Action for formality requirements is 30 days and is not extensible. In the event that the applicant fails to answer the Official Action fully and correctly in time, the application will be nullified.

After the application has passed formality examination, applications are placed under examination with regard to whether it is registrable for distinctiveness of the applied-for trademark prescribed under Article 3 of the Trademark Law, with regard to conflict with any other persons' rights under Article 4 of the Trademark Law, and also for the specification of goods/services.

In Japan, it was once possible to file an application claiming all goods of a Class, and therefore in the PANAFAX case previously mentioned, we filed the application with the specification of goods "transmitting and receiving equipment for producing facsimile copies of documents and all other goods included in Japanese Old Class 11."

At present, it is required to specify actual goods/services on which the applicant has an intent to use his trademark. It is no longer possible to use the abbreviated expression such as "and all other goods included in this class" to cover extensive goods/services

in a class, although it is possible to cover multi-classes in a trademark application.

Against the application "PANAFAX," we received the following two Official Actions which are very typical actions.

( i ) Lack of Distinctiveness

The Official Action stated that the applied-for trademark was descriptive for the specified goods because PAN means "all, comprising or of" and FAX is an easily understandable abbreviation of "facsimile." Consequently, the applied-for trademark consisted only of a mark indicating in a customary manner the quality of the goods.

Against the official objection based on lack of distinctiveness, we filed an argument strongly contesting the Examiner's opinion. Although we successfully overcame the objection, generally speaking, it is very difficult to overcome an official action based on lack of distinctiveness by filing an argument unless we can prove the mark has obtained secondary meaning through long and extensive use in Japan.

( ii ) Conflict with Other Persons' Prior Trademark

The Examiner considered that PANAFAX is confusingly similar to PANAFFASS for electric materials registered prior to the applied-for trademark.

With respect to this second objection, we restricted the specification of goods by deleting the phrase "and all other goods included in Japanese Old Class 11." According to the "Examination Standards" edited by the JPO, "electrical communication machines and apparatus" and "electric materials" are dissimilar goods to each other.

When a cited trademark is not used on goods/services specified by either the registrant or his licensee, without good reason for three consecutive years in Japan,

it will be possible to demand a cancellation trial for non-use against the cited trademark to overcome an official action. A defendant must prove actual use of his/her trademark to avoid a cancellation of his/her trademark registration at the Trial Board of the JPO.

For the purpose of overcoming such an official action, a letter of consent from the registered trademark owner as substitution for deletion of the specified goods or services or for arguing about similarity has no effect under the law in persuading an Examiner.

Please note that there are no provisions with respect to a "letter of consent" in the Japanese Trademark Law. This basically comes from the thought that in Japan protection of the general public consumers should be more heavily stressed than protection of the trademark owner's interest from the point of confusion with regard to the origin of goods. Besides, it is a principle that trademarks cited by the Examiner as a result of examination are limited to a trademark confusingly similar to the applied-for trademark, and consequently there is no room for the subjective view of the owner of the cited trademark(s) to be taken into account.

Apart from the above, may an applicant of a mark expect the JPO to reconsider the citation by presenting foreign conflicting judgments on the same case?

No, this is not effective. It appears that the JPO stands by the fact that similarity or dissimilarity of trademarks must be considered independently from judgments made in other countries, in view of the fact that in Japan only the Japanese language is used generally and officially. Under these circumstances, applicants should pay attention to the particular characters used for their trademarks in relation to the phonetic sounds of the Japanese language.

### (3) Defending against Opposition

When an application passes examination, and the trademark is registered, such a trademark is published in the Official Gazette. The opposition period is two months from the publication date, and within this period, any third party may file an opposition to a registered trademark. No one may obtain any extension of the statutory opposition period of two months. When a trial examiner intends to revoke the registration, the trademark owner is notified to that effect, being given an opportunity to respond.

When a trial examiner concludes to revoke, a decision of revocation is rendered. On the other hand, when the conclusion is against an opponent, there is no way for the opponent to contest the decision. However, it will be possible for the opponent to demand a new invalidation or cancellation trial against the trademark registration at the Trial Board of the JPO.

### (4) Appeals

An applicant dissatisfied with a rejection of his/her application may appeal within ninety (90) days from the date of the notice of rejection at the Appeal Board of the JPO. Further, an appeal may be taken to the Intellectual Property High Court within one hundred and twenty (120) days. (These time limits are for foreign applicants. Only thirty (30) days is given for domestic applicants.)

## 5. Renewal and Re-Classification of Goods

### (1) Renewal

A registered trademark may be effective for the period of ten (10) years from its registration date. The Owner of the registered trademark can continually renew its

registration for ten (10) year periods by paying official fees within the prescribed period of six (6) months prior to the expiration date of the registration, or six (6) months from the expiration date with additional official fees. There is no requirement on the use of the registered trademark.

## (2) Re-Classification of Goods

Before adoption of the International Classification of Goods and Services in 1992, local Classifications were used in Japan. A registered trademark which had been registered under the old local Classifications may be re-classified as to its specified goods so as to adapt and reconcile them with the International Classification. This procedure has to be done within eighteen (18) months; i.e. from six (6) months prior to the expiration date to twelve months (12) from the expiration date. This procedure is separate and independent from the procedure of renewal. The person who makes the renewal procedure is not always required to take the procedure of such re-classification. A registered trademark which has been renewed but not re-classified will be effective only for the period of ten (10) years, however, it can not be renewed again when the next renewal term comes.

A registered mark which covers only one (1) old local class may be re-classified into one or more International Class(es), not expanding the scope of the original specification of goods. Even if being re-classified into plural classes, the mark is considered as one (1) registration covering multi classes. However, the owner of some registrations for the same mark, even if the registration dates thereof are the same, cannot combine this mark as one (1) registration at the re-classification procedure.

## 6. Protection, Enforcement and Defense of Trademark Rights

Once the trademark is registered and in use, the owner and patent attorneys must pay attention to the following.

### (1) To Prevent a Trademark from Becoming a Generic Name

In the case where the goods are very new, it can happen that the trademark will become a generic name. The trademark “ESCALATOR”, may be a very famous and typical example. The trademark “TELECOPIER” for facsimile equipment owned by Xerox Corporation may be another example. The trademark TELECOPIER seems to be often used as if it were a generic name for facsimile equipment around the world.

It will be of value to repeatedly advertise a phrase “XXXX is a registered trademark” for the owner of a trademark which is likely to become a generic word. Further, patent attorneys should send a warning letter to any person who uses the registered trademark as if it were a generic name, in order to call his/her attention to the fact that the trademark in question is registered and therefore it must not be carelessly used by them.

### (2) Trademarks for Which Use Has Ceased

When a trademark is not used on goods/services specified by either of the registrant or his licensee without good reason for three consecutive years in Japan, the registered trademark may be jeopardized and it is possible to have it cancelled. A cancellation trial may be demanded at any time during the life of a trademark registration at the Trial Board of the JPO.

## 7. International Registration through the Madrid Protocol

Japan has become bound by the Madrid Protocol concerning the International Registration of Marks since March 2000. Parties abroad, who can enjoy the benefits

of the Madrid Protocol have, therefore, the option of obtaining protection of their trademarks in Japan by virtue of the international registration under the Madrid Protocol, in addition to the ordinary, traditional and national application at the JPO. The JPO conducts an examination when it receives a notice of the international registration designating Japan from WIPO and decides whether or not the trademark may be accepted in Japan. The applicant of the international registration designating Japan can make a reply to the Notification of Provisional Refusal issued by the JPO through Japanese patent attorneys within three months from the date of pronouncement of the notification.

#### 8. Trademarks in Overseas Countries

In our experience, the important trademarks of large scale companies in Japan are occasionally filed for registration in over 180 nations and territories in the world. This is nearly equal to the number of the United Nations member countries.

Consultation and patent attorney activities in overseas countries are in principle the same as our work for the foreign clients in our own country. Activities in common include searches, filing applications, suggestions for proper use, issuing expert opinions for countermeasures against infringement or counterfeiting, etc. However, it is legally and practically impossible to make a national application for trademark registration in overseas countries by ourselves. It is possible to make an application for international registration to designate other countries under the Madrid Protocol, but we must appoint an associate to respond to a Provisional Refusal in other countries. Therefore, it is very important for us to make use of the services of expert and knowledgeable attorneys and we must maintain close relationships with associates in foreign countries.

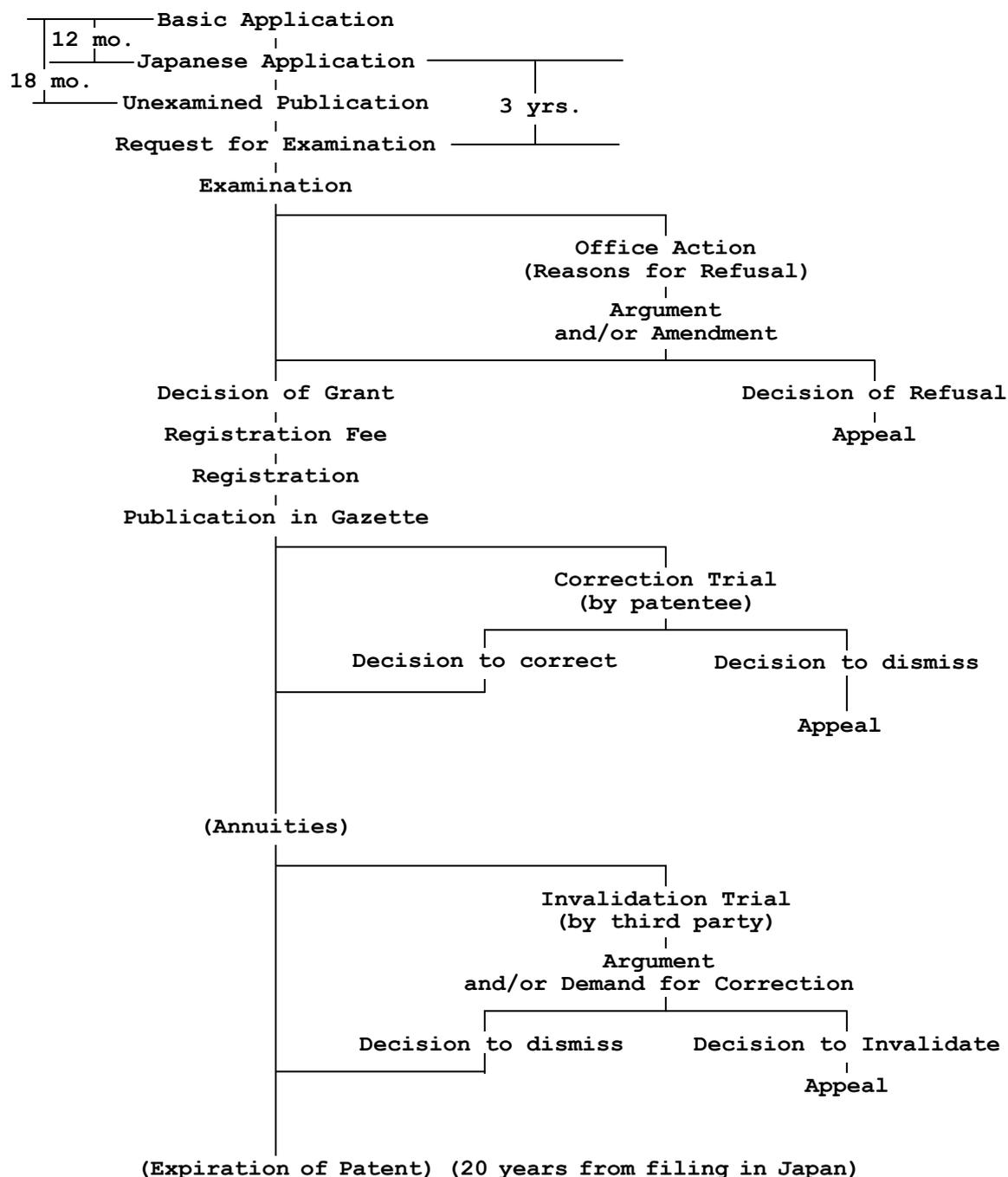
It is needless to say that we must understand the legal systems in as much detail as

possible for the protection of trademark rights. You are certainly aware that the Japanese trademark system is somewhat different from those of your own countries.

Further, heretofore, trademark owners often face difficulties to prove ACTUAL USE. However, it is expected that such difficulties will be eliminated as most countries observe the TRIPs Agreement.

Finally, knowledge of various other laws relating to trademarks is very useful for consultation and patent attorney activities in overseas countries.

## HOW PATENT APPLICATIONS ARE PROCESSED IN JAPAN



- (Remarks)
1. As to a PCT route application, the period for request for examination and the term of patent are counted from the international filing date. Further, the Japanese translation thereof is published by the JPO.
  2. Once an invalidation trial is pending, a correction trial may not be demanded until the decision on the invalidation trial has become final and conclusive, but with some exception.

## Outline of the Patent Attorney System in Japan

## 1. Brief History

- 1885 The first law concerning patent, “the Cabinet Order concerning Patent”, was enforced.
- 1899 The first law concerning registration of patent professional, “the Imperial Ordinance concerning Registration of Patent Agent”, was enforced. A total number of 138 patent professionals were registered.
- 1909 The 1899 Imperial Ordinance was abolished and the Imperial Ordinance concerning Patent Attorneys was enforced.
- 1922 The 1909 Imperial Ordinance was abolished and “the Patent Attorney Law” was enforced. The Japan Patent Attorneys Association (JPAA) was established.
- 1948 By a partial amendment of the Patent Attorney Law, patent attorneys became able to act as litigation representatives before the court in litigation against decisions rendered by the Board of Appeals and Trials of the Japan Patent Office.
- 1960 By a partial revision of the Patent Attorney Law, the administration of registration of patent attorneys was transferred to the JPAA.
- 1978 The Patent Cooperation Treaty was entered into force. By a partial revision of the Patent Attorney Law, the business of representation for PCT applications was added to the jurisdiction of patent attorneys.
- 1979 The JPAA Training Institute was established.
- 1996 The JPAA Intellectual Property Research Institute was established.

- 1998 The Industrial Property Arbitration Center (The present name: the Japan Intellectual Property Arbitration Center) was established jointly by JPAA and the Japan Federation of Bar Associations.
- 1999 The JPAA held a ceremony in celebration of the centennial of the Japanese patent attorney system. The JPAA Intellectual Property Assistance and Support Center was established.
- 2000 Japan acceded to the Madrid Protocol. By a partial revision of the Patent Attorney Law, the business of representation for Madrid Protocol applications was added to the jurisdiction of patent attorneys.
- An overall revision was made to the Patent Attorney Law. The new Patent Attorney Law went into force on January 6, 2001 except for a limited portion thereof.
- 2003 By the 2002 partial revision of the Patent Attorney Law, authority to act as counsel in intellectual property right infringement lawsuits was granted to patent attorneys under the condition that he/she should pass the prescribed examination which confirms the effects of the specific training regarding practice in civil suit procedures.
- 2005 By the 2005 partial revision of the Patent Attorney Law, the business of representation for the ADR procedures on disputes over copyright matters was added to the jurisdiction of patent attorneys

## 2. Outline of the Patent Attorney Law

### 1) The 2000 Revision

An overall revision of the Patent Attorney Law was made after about an eighty year

interval. The new Patent Attorney Law was promulgated on April 26, 2000 and entered into force on January 6, 2001, except for very limited provisions thereof.

The aim of the revision was to improve the services offered by patent attorneys for the public and promote competition through deregulation in response to the needs of the times.

The main general points of the revision are as follows;

- (1) Improvement in the scope of business of patent attorneys
  - (i) Enlargement of the scope of professional business of patent attorneys in intellectual property matters to cope with the user's need or public needs
  - (ii) Partial liberalization of the exclusive scope of the business of patent attorneys
- (2) Reformation of the patent attorney qualification examination system towards an increase in the number of patent attorneys
- (3) Admission of incorporation of patent attorneys' firms to provide more comprehensive services of patent attorneys

## 2) The 2002 Revision

The aim of the revision was to provide a patent attorney with the authority to represent a client in an infringement action in a court thereby meeting demands from the intellectual property world for strengthening dispute resolution services offered by a patent attorney specializing in intellectual property.

The main points of the revision are as follows:

- (1) The authority, as mentioned above, is provided to a patent attorney who has passed the specific examination relating to representation on intellectual property right infringement suit procedures.
- (2) The patent attorney provided with the above authority can represent a client in an infringement action in a court together with an attorney-at-law (The patent attorney

above is different from a patent attorney who only acts, together with an attorney-at-law, as a legal assistant before the enforcement of the above revised Law.) Further, if a court so allows, the patent attorney can appear in the court independently.

### 3. Business of Patent Attorneys

Under the Patent Attorney Law, the professional business of patent attorneys is as follows:

- (1) Representation before the Japan Patent Office of the proceedings relating to patents, utility models, designs, trademarks, PCT applications or Madrid Protocol applications
- (2) Representation before the Minister of Economy, Trade and Industry, of the proceedings concerning administrative appeals or arbitration decisions relating to patents, utility models, designs or trademarks
- (3) Preparation of expert opinions or other services concerning the matters relating to the proceedings as referred to in (1) or (2) above
- (4) Representation before the Head of the Customs House or the Minister of Financial Affairs of the proceedings to be taken by owners of patent rights, utility model rights, design rights or trademark rights in order to obtain seizure on importation or exportation

(Note) This was newly introduced under the 2000 revision. Under the 2007 revision, representation of the proceedings to be taken by the exporting or importing person or entity concerned was included.

(5) Representation before the arbitration body designated by the Minister of Economy, Trade and Industry, of the proceedings (including the following amicable settlement) in arbitration cases relating to patents, utility models, designs, trademarks, layout of circuits, certain kind of unfair competition under the Unfair Competition Prohibition Law

(Note) This was newly introduced under the 2000 revision. Under the 2005 revision a certain kind of works under the Copyright Law was included.

(6) Representation or mediation of conclusion of purchase-sale contracts, licensing contracts or other contracts concerning rights relating to patents, utility models, designs, trademarks, layout of circuits or certain works under the Copyright Law or technical secrets, or consultations concerning the above matters.

(Note) This was newly introduced under the 2000 revision.

(7) Appearance with the party or its litigation representative and statement or interrogation as its assistant before the court, with regard to the matters relating to patents, utility models, designs, trademarks, PCT applications, Madrid Protocol applications, layout of circuits or certain kinds of unfair competition.

(Note) The matters relating to layout of circuits or certain kinds of unfair competition were newly introduced under the 2000 revision.

(8) Action as a litigation representative before the court, with regard to litigation against the decision rendered by the Board of Appeals and Trials of the Japan Patent Office.

(Note) This has been allowed since 1948.

(9) Representation of the party in certain infringement lawsuits

This qualification is granted only to the patent attorney who has passed the prescribed examination and registered to that effect in the Patent Attorney Register only for infringement lawsuits in which an attorney-at-law has been entrusted.

(Note) This was newly introduced under the 2002 revision.

On the other hand, some business activities which had been in the realm of the patent attorney profession under the previous Patent Attorney Law prior to the 2000 revision and had been considered the formal business necessitating a relatively low level of expertise (such as payment of registration fees or annuities, requests for certification or inspection, requests for change of registration concerning patent right etc, requests for registration of licensing concerning patent right etc.), was opened to other persons.

#### 4. Qualification for Patent Attorney

In order for a person to be qualified as a patent attorney under the current Law, he/she must meet one or more of the following requirements, and further must go through the prescribed training program:

- (1) To have passed the qualification examination
- (2) To have qualified as an attorney at law
- (3) To have had seven years or more experience engaged in appeal/trial examination or in examination, as an appeal/trial examiner or as an examiner in the Japan Patent Office.

(Note) The previous conditions, (i) to be a Japanese national or approved foreign national and (ii) to be domiciled in Japan, were cancelled under the 2000 revision.

The requirement to go through the prescribed training course was implemented on October 1, 2008.

## 5. Qualification examination

The qualification examination under the current Patent Attorney Law consists of the following:

- (1) Short answer written examination (including multiple choice examination) on the Patent Law, Utility Model Law, Design Law, Trademark Law, the conventions concerning industrial property, the Copyright Law and the Unfair Competition Prohibition Law
- (2) Thesis examination on the Patent Law, Utility Model Law, Design Law, Trademark Law, and one subject selected by the examinee from the subjects relating to technology or law prescribed in the concerned ordinance of the Ministry of Economy and Industry
- (3) Oral examination on the Patent Law, Utility Model Law, Design Law and Trademark Law

(Note)

- (i) Under the 2000 revision, the scope of the subject for thesis and oral examination was narrowed, and the scope of the subject for short answer written examination was widened to include the Copyright Law and the Unfair Competition Prohibition Law.
- (ii) The thesis examination on the one subject to be selected by the examinee may be exempted for those examinees having national qualification in certain

technological or legal fields.

- (iii) Those patent attorneys registered under the previous Patent Attorney Law must participate in the training held by the Japan Patent Attorneys Association concerning the Copyright Law, the Unfair Competition Prohibition Law and other matters necessary for conduct of the businesses referred to in (4), (5) and (6) of the above item “3. Business of Patent Attorneys”.

## 6. Incorporation of Patent Attorney Firm

Under the 2000 revision, it is allowed for patent attorneys to establish a legal entity for conducting a patent related business.

According to the provisions of the law, two or more patent attorneys may, as partners, jointly establish a “TOKKYO GYOUMU HOUJIN” (patent profession corporation; hereinafter, the corporation).

All of the partners of the corporation must be patent attorneys.

The name of the corporation must include the term “TOKKYO GYOUMU HOUJIN”.

The corporation must have the articles thereof jointly prepared by the patent attorneys as the partners thereof.

The corporation may conduct all or part of the business activities referred to in (4), (5) and (6) of the above item “3. Business of Patent Attorney” on the basis of the prescription of the articles, in addition to the business activities referred to in (1), (2), (3), (7) and (8) of same item.

The corporation must be registered.

The corporation, when established, must notify the Minister of Economy, Trade and Industry to that effect within two weeks from the establishment, attaching a certified copy

of the Register and the Articles.

The corporation may employ patent attorney(s).

The corporation must not allow an employee who is not a patent attorney conduct the business activities of patent a attorney thereof.

### Outline of the Japan Patent Attorneys Association

The Japan Patent Attorneys Association (JPAA) is a single public interest corporation for patent attorneys in Japan and was established in May, 1922.

The profession of the patent attorney, however, was started earlier under the Imperial Ordinance concerning the Registration of Patent Agents of July 1, 1899. Therefore, the patent attorney system in Japan has a history of more than one hundred years.

In order for a person to become a patent attorney in Japan, he/she must take a strict qualification examination, including a state examination, the Patent Attorneys Examination prescribed in the Patent Attorneys Law. A person having the qualification as a patent attorney may, however, become a patent attorney only after he/she has registered as a patent attorney in the Patent Attorneys Register maintained at the JPAA. All patent attorneys are, therefore, members of the JPAA.

As the services of patent attorneys relate to new technologies and various laws, the JPAA established, as its affiliated organization, “the Education Institute”, with the aims to make guidance and liaison for its members in order to maintain the dignity of patent attorneys and improve and advance the services of patent attorneys, and holds continuous training programs for its members so as to support the study and progress of ability, of its members. Further, the JPAA has multiple committees and conducts multiple activities, such as making studies and promotion of industrial property systems, making studies on revision of industrial property laws and examination standards and presenting proposals to competent authorities.

Further, consultation with the Japan Patent Office on the management of industrial property systems and association with foreign patent attorney organizations

also have become important activities of the JPAA.

In this way, the JPAA contributes to the development of industry and establishment of a fair trade system and plays a broad part in making a better future.

With regard to the JPAA, there are basic provisions in the Patent Attorneys Law, Chapter VII, which follow;

The Patent Attorneys Law

Chapter VII. Japan Patent Attorneys Association

Article 56. (Establishment, object, and legal personality)

1. Patent attorneys shall establish a single Japan Patent Attorneys Association covering the entire country (hereinafter in this chapter referred to as the "Patent Attorneys Association", based on the stipulations of this Law.
2. The Patent Attorneys Association shall have as its object, in view of the mission and duties of patent attorneys, to manage matters relating to the guidance, liaison, and supervision of members in order to maintain the dignity of patent attorneys and improve and advance the services of patent attorneys and to manage matters relating to the registration of patent attorneys.
3. The Patent Attorneys Association shall be a judicial person.

Article 57. (Articles of Association)

The Patent Attorneys Association shall formulate Articles of Association and stipulate the following matters in them:

- (1) Name and location of its office;
- (2) Rules pertaining to admission of membership in and withdrawal from the association;
- (3) Rules pertaining to the type of members and their rights and duties;

- (4) Rules pertaining to the officers;
- (5) Rules pertaining to meetings;
- (6) Rules pertaining to branches;
- (7) Rules pertaining to the registration of patent attorneys
- (8) Rules pertaining to the Registration Screening Board;
- (9) Rules pertaining to the maintenance of dignity of its members;
- (10) Rules pertaining to the training of its members;
- (11) Rules pertaining to the training course on practice;
- (12) Rules pertaining to the settlement of disputes in connection with its members' profession;
- (13) Rules pertaining to the provision of information relating to the Patent Attorneys Association and its members;
- (14) Rules pertaining to membership fees;
- (15) Rules pertaining to accounts and assets;
- (16) Rules pertaining to the secretariat; and
- (17) Other rules necessary for achieving the aims of the Patent Attorneys Association.

2. Establishment or change of the Articles of Association (only changes relating to important matters stipulated by Cabinet Order) shall not come into effect unless approved by the Minister of Economy, Trade, and Industry.

#### Article 58. (Branches)

The Patent Attorneys Association may establish branches when it is necessary for achieving its aims.

#### Article 59. (Registration)

1. The Patent Attorneys Association shall be registered as stipulated by Cabinet Order.

2. Matters that shall be registered under the preceding paragraph cannot be set up against a third party until and unless they have been registered.

Article 60. (Admission and withdrawal)

A patent attorney and Patent Profession Corporation shall automatically become a member of the Patent Attorneys Association. When a patent attorney has his/her registration struck off or when the Patent Profession Corporation is dissolved, he/she or it shall automatically be withdrawn from the Patent Attorneys Association.

Article 61. (Action expelling a member from the Patent Attorneys Association)

The Patent Attorneys Association may expel a member liable to harm the good order or reputation of the Patent Attorneys Association upon receiving the approval of the Minister of Economy, Trade, and Industry.

Article 62. (Duty to observe the Articles of Association)

Members shall observe the Articles of Association of the Patent Attorneys Association.

Article 63. (Officers)

1. The Patent Attorneys Association shall appoint a president, vice-president, and other officers stipulated by the Articles of Association.
2. The president shall represent the Patent Attorneys Association and administer its activities.
3. The vice-president shall assist the president as stipulated by the president and shall represent the president in his/her duties in the event of an accident and perform the duties of president when that post is vacant.
4. The officers may delegate representation of a specific act to other persons, unless it is

prohibited by the Articles of the Association or by a resolution of a general meeting

Article 64. (General meeting)

1. The Patent Attorneys Association shall hold an ordinary general meeting every year.
2. The Patent Attorneys Association may convene an extraordinary general meeting when it deems it necessary.

Article 65. (Matters requiring a resolution of a general meeting)

Any amendment of the Articles of Association, budgets, and settlement of accounts must be approved by a resolution of a general meeting.

Article 66. (Report on resolutions etc. of a general meeting)

The Patent Attorneys Association shall report to the Commissioner of the Patent Office on resolutions adopted by its general meeting, on its officers taking office and on their retirement.

Article 67. (Mediation of disputes)

The Patent Attorneys Association may, upon request of a member, the party in question, or other interested person, mediate any dispute regarding the duties of its members.

Article 68. (Proposals and replies)

The Patent Attorneys Association may present its proposals, or make its reply to a request for consultation, to the Minister of Economy, Trade, and Industry or the Commissioner of the Patent Office regarding its professional affairs or system of patent attorneys.

Article 69. (Report of fact falling under disciplinary action)

1. The Patent Attorneys Association shall report to the Minister of Economy, Trade, and Industry any fact of a member deemed to fall under Article 32 or Article 54
2. The provision of Article 33, paragraph 2 shall apply mutatis mutandis to the case where there is a report of the preceding paragraph.

Article 70. (Registration Screening Board)

1. A Registration Screening Board shall be established in the Patent Attorneys Association.
2. The Registration Screening Board shall, upon the request of the Patent Attorneys Association, conduct an investigation required for rejection of registration under Article 19, paragraph 1, rescission of registration under Article 23, paragraph 1, or striking off of registration under Article 25, paragraph 1.
3. The Registration Screening Board shall consist of the president and four board members.
4. The president of the Patent Attorneys Association shall become the president of the Board.
5. Board members shall be appointed by the president from amongst patent attorneys, officers of the Ministry of Economy, Trade, and Industry engaged in administrative work concerning patent attorneys, and persons of learning and experience approved by the Minister of Economy, Trade, and Industry.
6. The term of office of board members shall be two years; provided, however, that the term of office of members appointed to fill vacancies shall be the remaining period of office of the members whom they are replacing.
7. Required matters concerning the organization and operation of the Registration Screening Board other than those stipulated in the preceding paragraphs shall be stipulated by Cabinet Order.

Article 71. (Report and inspection)

1. The Minister of Economy, Trade, and Industry may seek submission of a report or materials from the Patent Attorneys Association or have its officers enter the office of the Patent Attorneys Association to inspect the books and other materials when deemed necessary to ensure the suitable operation of the Patent Attorneys Association.
2. The officers carrying out the on-site inspection under the preceding paragraph shall carry certification indicating their identity and shall present the same upon the request of an interested party.
3. The authority for on-site inspection under paragraph 1 shall not be construed as being recognized for criminal investigations.

Article 72. (Rescission of resolution of general meeting and dismissal of officers)

The Minister of Economy, Trade, and Industry may order the rescission of a resolution of a general meeting of the Patent Attorneys Association or dismissal of its officers when the resolution of the general meeting or an act of its officers violates the law or Articles of Association of the Patent Attorneys Association or otherwise is detrimental to the public interest.

Article 73. (Application mutatis mutandis of the Law concerning general corporations and general foundations)

(Omitted)

Article 74. (Reliance on the Ministry of Economy, Trade, and Industry)

(Omitted)

## Number of Patent Attorneys in Japan

Year	Newly-registered Patent Attorneys	Total Numbers	Year	Newly-registered Patent Attorneys	Total numbers
1931	249	2,838	1971	92	1,821
32	222	3,092	72	137	1,927
33	260	3,318	73	147	2,037
34	258	3,557	74	113	2,112
35	301	3,836	75	132	2,200
1936	312	4,113	1976	143	2,293
37	319	4,389	77	127	2,370
38	261	2,604	78	110	2,410
39	180	2,672	79	121	2,476
40	115	2,693	80	118	2,536
1941	76	2,683	1981	114	2,586
42	44	2,594	82	118	2,653
43	29	2,081	83	144	2,733
44	15	1,828	84	122	2,815
45	3	1,690	85	141	2,900
1946	61	1,289	1986	120	2,947
47	67	1,238	87	155	3,048
48	51	1,178	88	138	3,131
49	47	1,029	89	144	3,224
50	43	1,026	90	174	3,342
1951	35	929	1991	145	3,436
52	42	936	92	150	3,529
53	32	926	93	162	3,634
54	38	931	94	136	3,704
55	50	940	95	153	3,795
1956	49	965	1996	172	3,916
57	53	983	97	172	4,011
58	51	1,014	98	182	4,102
59	82	1,070	99	233	4,278
60	83	1,089	2000	303	4,503
1961	64	1,122	2001	353	4,776
62	62	1,155	02	424	5,121
63	102	1,223	03	529	5,548
64	107	1,297	04	559	6,002
65	90	1,348	05	665	6,552
1966	105	1,425	2006	642	7,061
67	150	1,536	07	637	7,571
68	89	1,598			
69	123	1,687			
70	101	1,763			

Note: The numbers include accumulated numbers of registered patent attorneys in Japan as of the end of each year.

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## Membership Statistics of the Japan Patent Attorneys Association

As of November 30, 2008

Total 7,809

1. Male members	6,859	6. Type of Status	
Female members	950	Owner of Patent Firm	2,258
(Patent profession corporation)	102)	Co-owner of Patent Firm	738
		Employee in Patent Firm	2,661
		Employee in Business Firm	1,374
		Employee in General Law Firm	51
		Owner of patent Profession Corporation	257
		Employee in Patent Profession Corporation	378
		Others	92
2. Age		7. Size of Patent Firm	
20 to 29	254	Number of Patent Attorney	Number of Patent Firm
30 to 39	2,268	1	2,376
40 to 49	1,885	2	524
50 to 59	1,357	3-5	410
60 to 69	1,364	6-9	112
70 to 79	512	10-19	64
80 to 89	139	20-29	13
90 and above	30	30-39	5
		40-59	8
		60-	5
3. Education		8. Qualified for Conducting Specified Infringement Litigation Representation Service	
Legal	1,674	Male members	1,746
Scientific or Engineering	6,016	Female members	249
Others	119		
4. Manner of qualifying			
Examination	6,733		
Qualification prior to Present Law	15		
Patent Office Service Attorney-at-Law	678		
Others	381		
	2		
5. Area			
Kanto	5,426		
(including Tokyo,	4,564)		
Kinki	1,627		
(including Osaka,	1,246)		
Tokai	500		
Others	256		
(including foreign countries)	34)		

## Number of Applicants and Passers of Qualifying Examination in Japan

Year	Applicants	Passers	Year	Applicants	Passers
1951	72	6	1981	3,100	77
52	96	12	82	3,023	77
53	77	11	83	3,007	83
54	164	12	84	3,104	84
55	271	19	85	2,937	76
1956	301	26	1986	2,872	84
57	342	33	87	2,933	86
58	495	43	88	2,856	93
59	493	27	89	2,976	96
60	497	56	90	3,099	101
1961	571	27	1991	3,217	96
62	655	68	92	3,279	100
63	729	63	93	3,727	111
64	985	48	94	3,999	113
65	1,073	51	95	4,177	116
1966	1,329	49	1996	4,390	120
67	1,417	47	97	4,564	135
68	1,844	49	98	4,650	146
69	2,138	48	99	5,002	211
70	2,366	49	2000	5,531	255
1971	2,507	65	2001	5,963	315
72	2,918	84	02	7,176	466
73	2,852	81	03	8,569	550
74	2,802	84	04	9,642	633
75	2,912	84	05	9,863	711
1976	3,022	91	2006	10,060	635
77	3,205	91	07	9,865	613
78	3,237	88	08	10,494	574
79	3,144	87			
80	3,042	82			

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## Trends in the Number of Applications in Japan

Year	Total number of applications	Ratio represented by patent attorneys	Number of patent applications	Number of utility model applications	Number of design applications	Number of trademark applications
1975	548,200 (404,440)	73.8	159,821 (133,826)	180,600 (134,139)	52,250 (33,402)	155,469 (103,073)
1980	565,587 (451,086)	79.8	191,020 (167,852)	191,785 (155,112)	55,631 (35,517)	127,151 (92,605)
1985	724,593 (591,196)	81.6	302,995 (272,651)	204,815 (168,893)	55,237 (35,861)	161,546 (113,791)
1990	721,900 (598,293)	82.9	367,590 (331,209)	138,294 (111,967)	44,290 (30,291)	171,726 (124,826)
1995	603,857 (485,648)	80.4	369,215 (318,243)	14,886 (10,124)	40,067 (26,995)	179,689 (130,286)
1996	619,049 (495,937)	80.1	376,615 (322,858)	14,082 (9,315)	40,192 (25,993)	188,160 (137,771)
1997	576,601 (466,658)	80.9	391,572 (337,762)	12,048 (8,059)	39,865 (25,926)	133,116 (94,911)
1998	564,670 (454,461)	80.5	401,932 (346,497)	10,917 (7,139)	39,352 (24,969)	112,469 (75,856)
1999	575,167 (460,741)	80.1	405,655 (347,237)	10,283 (6,705)	37,368 (24,741)	121,861 (82,058)
2000	628,041 (501,245)	79.8	436,865 (373,989)	9,587 (6,375)	38,496 (25,064)	143,093 (95,817)
2001	605,450 (490,076)	80.9	439,175 (378,399)	8,806 (5,756)	39,423 (26,512)	118,046 (79,409)
2002	579,013 (469,871)	81.2	421,044 (364,345)	8,602 (5,532)	37,230 (25,165)	112,137 (74,829)
2003	578,519 (467,042)	80.7	413,092 (357,721)	8,169 (5,347)	39,267 (25,866)	117,991 (78,108)
2004	593,506 (484,490)	81.6	423,081 (371,550)	7,986 (5,280)	40,756 (27,597)	121,683 (80,063)
2005	603,506 (495,901)	82.2	427,078 (379,283)	11,367 (7,388)	39,254 (26,291)	125,807 (82,939)
2006	580,346 (482,109)	83.1	408,674 (367,578)	10,965 (7,195)	36,724 (24,855)	123,983 (82,481)
2007	574,076 (479,025)	83.4	396,291 (358,279)	10,315 (6,786)	36,544 (25,389)	130,926 (88,571)

Note: ( ): Number of applications represented by patent attorneys

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