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Opinion

Intellectual Property Law
– Learning and Practice –

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Encounter with Intellectual Property Law

My first encounter with intellectual property was more than 20 years ago when I worked in a research department of a company and needed to read patent documents in the process of developing new products. When I read a patent publication for the first time, I found that, although it was written in Japanese, terms used therein were difficult, and each sentence was too long to understand which word a modifier modified, so I could not entirely understand the patent publication even by reading it many times. However, while I repeatedly read it, my understanding gradually deepened, and I gained a feeling of satisfaction. As I read many patent publications without having enough knowledge, I noticed tips about how to read them and points to be read, and came to feel joy rather than frustration.

After a while, I transferred from the research department to an intellectual property department. One of my main tasks there was to pursue a patent for an invention invented by a research department member, and I went to a patent office together with the research department member and a senior intellectual property department member to have a meeting with a patent attorney. Although our conversation there was in Japanese, I could not understand technical terms, follow along the conversation, nor serve as a bridge between the patent attorney and the research department member, which made me feel embarrassed. I

keenly felt the necessity of immediately acquiring legal knowledge and learning technical terms necessary to communicate with patent attorneys at any rate, and I started going to a preparatory school for the patent attorney examination, thinking that it would be the most effective way.

Learning

What I learned at the school were, firstly, the purpose of the intellectual property laws, and the definition, intent, essence, specific procedures and legal effects for each IP system. Each system was clearly summarized in one sheet of resume, and I was fascinated by the beauty thereof. As I went to the school, I was influenced by surrounding students preparing for the examination, and naturally aimed at passing the patent attorney examination myself.

To pass the patent attorney examination, input alone is not enough. Through output, especially through practicing writing essays, I deeply felt how the articles of the IP laws are logically composed, and was attracted to the text of the laws with a feeling completely different from that with which I read the patent publication for the first time. I learned the importance and difficulty of writing logical texts using accurate terms and grammar.

Practice

Thereafter, I passed the examination, became a patent attorney, and acquired a fair knowledge of the IP law and technical terms. However, I did not feel a good response in practice. I felt a limitation in the activity of finding inventions while dealing with ordinary intellectual property tasks such as preparing a response to a notice of grounds of rejection. I was perplexed on how to utilize the acquired legal knowledge in the context of research and development, and how to apply the legal knowledge to find patentable inventions.

Looking back on that time, now I realize that I learned the IP law away from its applicable context, and did not know how to practically apply my legal knowledge. Without having such an understanding, I came up with the idea of educating some members doing research and development to serve as intellectual property key persons and having them perform the activity of finding inventions, and I offered an in-house course for the selected members to learn patent law.

However, no matter how earnestly I described the legal system and its intent, procedures, and effects, the members expressed little interest, as might be expected. To draw their interest, it was necessary to let them know how legal knowledge to be learned in this course would be utilized in actual practice within the context of research and development.

Accordingly, I shifted my approach to an approach of applying the law to specific and common cases. For example, regarding exception to lack of novelty, instead of teaching the intent and essence of the system based on the text of the law, I cited, as a practical example, an urgent situation where a patent application is not filed yet immediately before a conference presentation. Then, I taught under what conditions and through what procedure the patent application can be filed after the conference presentation, without giving up filing the patent application, and confirmed the supporting articles. Further, for example, instead of teaching limitative listing of the grounds of rejection based on the text of the law, I provided an exemplary case of a request for a trial for invalidation filed by a competitor, and adopted a role-playing game style to analyze the grounds of invalidation argued by the competitor, construct our argument, and then predict the development of the trial and a trial decision by a trial examiner, and the like. Then, I had the members discuss what a strong patent for which a request for a trial for invalidation would not be filed is, and confirmed the support thereof (limitative listing of the grounds of invalidation and limitative listing of the grounds of rejection) based on the text of the law. This approach worked effectively and succeeded in drawing the interest of the selected members, giving me a feeling that this approach helped raise awareness of intellectual property and the level of practice. In addition, it seemed to me that the selected members played a role as intellectual property key persons within the context of research and development, and that fostering the awareness of intellectual property became widespread to all research department members working with them.

What I keep in mind now

When I have a meeting with or propose a procedure to a person in charge of intellectual property of a client company, as a patent attorney working for a patent office I keep in mind to make an effort to understand the policy and standpoint of the client company, grasp the questions or worries of the person in charge of intellectual property, and perform practice in consideration of both the law and the specific context, rather than proudly describing legal knowledge or legal theory. I believe that patent attorneys will not be

replaced by artificial intelligence as long as we continue to perform practice while maintaining balance between the law and its applicable context.

Article

Introduction of Timestamp and its Utilization

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1. Introduction

With the transition of information recording media from physical paper to electronic files, induced by expansion of electronic commerce and the like from the latter half of 1990s, there arises a concern about the reliability of information (electronic data). In particular, it is important in various areas since when certain information has existed without being falsified.

For example, the electronic signature function can be used to identify the creator of electronic data. The electronic signature, however, does not have a capability of providing information on "since when electronic data with a signature has existed" and "whether or not the content of the electronic data has been changed."

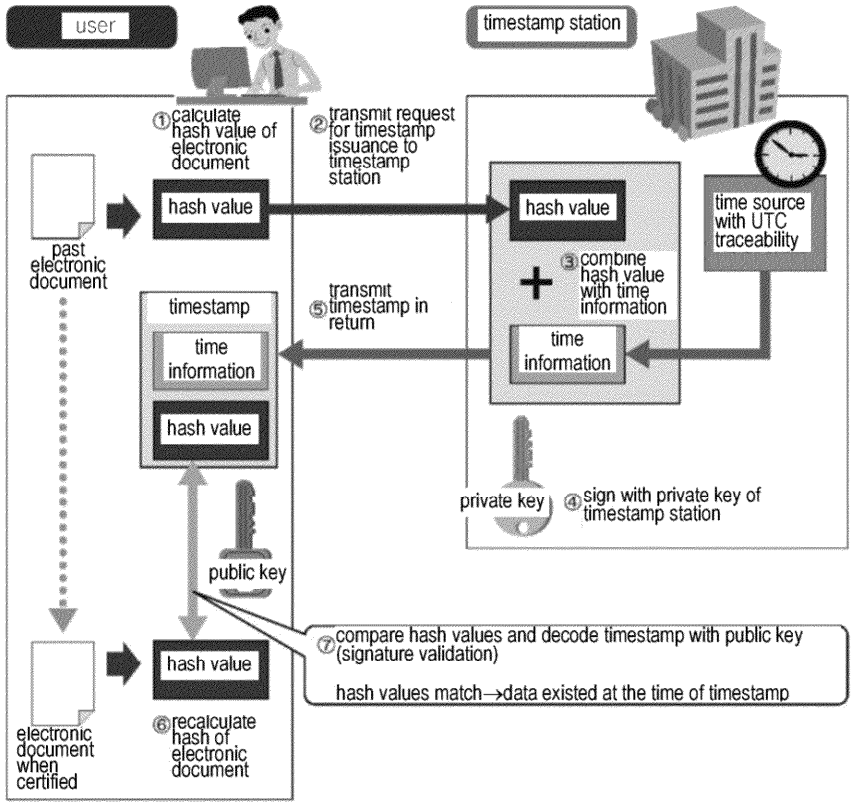
Under such circumstances, the Ministry of Internal Affairs and Communications in Japan released in 2004 "Guidelines for Time Business [1]" for the safe use of networks and to secure long-term storage of electronic data. "Time business" is a general term for time distribution business and time authentication business. This paper discusses "timestamps" serving as a means for implementing the time business, having become more and more important in recent years.

2. Overview of timestamping

(1) Timestamping is a technique of attaching, to electronic data, information on the time of day, for proving that the electronic data existed at the time (proof of existence) and proving that the electronic data has not been falsified since that time (proof of non-falsification). The timestamping service is a commercial service, and the Ministry of

Internal Affairs and Communications in Japan will certify a timestamp issuance service satisfying certain criteria as a certified time authentication service. At present, only four services: "Seiko Timestamp Service," "MIND Timestamp Service," "Amano Time-stamp Service 3161," and "GlobalSign Japan Accredited Timestamping" have been certified as a "certified time authentication service."

(2) The following provides an overview of requesting, issuing, and verifying a timestamp, with reference to the diagram below.



JPO, Smooth Utilization of the First-to-Use System (second edition)

May 2016 (revised in April 2022), page 72

(i) Request for and issuance of timestamp

Step 1: A user operates a terminal storing electronic data (electronic document) to cause the terminal to calculate a hash value of the electronic data. The hash value is a value of a fixed number of digits generated based on a hash function. Since the hash function is idempotent, the same hash value is always generated from the same data. Since the hash function is unidirectional, it is extremely difficult to restore the original data from the hash value.

Step 2: The user uses the terminal to request a timestamp station to issue a timestamp. At this time, the terminal transmits only the hash value without transmitting the electronic data. The timestamp station is a service (provider) that performs a certified time authentication service.

Step 3: The timestamp station assigns time information to the hash value.

Step 4: The timestamp station encrypts, with a secret key, data including time information and the hash value to which the time information is assigned.

Step 5: The timestamp station transmits the encrypted data (timestamp) to the terminal of the user. The terminal associates the timestamp with the electronic data.

(ii) Verification of timestamp

Step 6: In order to verify whether the electronic data has been falsified or not, the user performs a predetermined operation on the terminal for the electronic data to be verified. In response, the terminal calculates a hash value of the electronic data to be verified.

Step 7: The terminal decrypts the timestamp associated with the electronic data to be verified, using a public key of the timestamp station acquired in advance. The terminal compares the hash value calculated in Step 6 with the hash value in the decoded data. If they match each other, it is proved that the target electronic data has not been falsified (proof of non-falsification). In addition, based on the time information in the decoded timestamp, it is proven that the electronic data existed at the time indicated by the time information (proof of existence). In contrast, if they do not match each other, it can be seen that the target electronic data was falsified after the time when the timestamp was assigned to the electronic data.

(3) The operation of timestamping electronic data is extremely simple. The following is an example case where one or more pieces of electronic data are attached to an electronic file in a PDF (Portable Document Format) (hereinafter referred to as "PDF file"). Specifically, the following is a case where Adobe Acrobat Reader[2] (the version released in 2025) is used. As a precondition, the user needs to hold, in advance, a contract to use the timestamping service, with a business owner like those mentioned above.

The user opens the PDF file and selects "Attach file" from an additional dialog displayed on the screen. Next, the user selects an electronic file to attach. Accordingly, the electronic data is attached to the PDF file. When a plurality of electronic files are to be attached to the PDF file, the user repeats such a series of operations for selection.

There is no mandatory information to be described in the text of the PDF file.

The type and the amount of electronic data attached to the PDF file are not particularly limited. Various kinds of electronic data such as electronic files generated by Microsoft Word, PowerPoint[3], and the like, other PDF files, still image data, moving image data, audio data, and the like can be attached to the PDF file. Regarding these electronic data, for the sake of utilizing the timestamp described later herein, it is necessary to record, in the data, information for identifying a person(s) involved in the data, such as the provider of the information and the creator of the data.

Subsequently, the user selects "use certificate" from a tool panel of the screen of the Adobe Acrobat Reader. This causes a "timestamp" icon to be displayed in the tool panel. When the user selects this icon, a timestamp is automatically given to the PDF file. Note that operations to be performed on the screen for adding a timestamp to a PDF file without attaching electronic data to the PDF file are the same as those described above.

When at least a part of the attached electronic data is changed after the timestamp is given to the PDF file, the hash value of the PDF file after this change is different from the hash value at the time when the timestamp was given. Therefore, in this case, it is found that the attached data has been falsified/altered.

3. Areas of use of timestamps

Timestamps having the above-described functions are frequently used for intellectual-property-related activities. The following are several areas where timestamps are used.

(1) First-to-use

Timestamps can be used as evidence for proving "first-to-use." This is a typical use of timestamps in the field of intellectual property.

For example, a timestamp can be attached to electronic data in which the technical content to be managed as know-how or a technical idea that has not been filed in a patent application is recorded, so that the electronic data can be used for proving "first-to-use." It is preferable to attach a series of timestamps to respective pieces of electronic data (experimental data, meeting minutes) indicating respective processes from research and development to commercialization. Timestamps can be used suitably for the close strategy of the open and close strategy.

A specific method for proving the first-to-use of a company is described on pages 77 to 78 of "The Japan Patent Office-Smooth Utilization of the First-to-Use System (Second Edition), May 2016 (revised April 2022)."

(2) Usurped Application

The timestamp can also be used to address an usurped application. It is assumed, for example, that an employee making an invention transfers to the employer company the overall right to be granted a patent for the invention, in accordance with the employee invention regulations of the company. We can then consider the case that such an employee thereafter leaves the company and then files a patent application for the invention previously made as an employee. In this case the patent application is an usurped application because the former employee does not have the right to be granted a patent. In this situation the company is required to prove that the patent application is a usurped application.

In view of such a situation, it would be preferable for the company (user) to constantly instruct its employees to attach timestamps to electronic data, such as the business diary of the inventor, having content that may be filed in a patent application in the future. By reviewing the content of the electronic data on the basis of the time information, the user can prove the existence of the invention completed by the former employee while an employee of the company. This makes it extremely easy to prove that the application is an usurped application in a lawsuit or the like.

(3) Abuse of Dominant Position

Abuse of Dominant Position refers to an act, performed by a party whose position in transaction is superior to a counterparty, of using its dominant position to impose undue disadvantages on the counterparty in light of normal commercial practice. The Antimonopoly Act prohibits such actions, as a typical unfair transaction. There is also the Act against Delay in Payment of Subcontract Proceeds, etc. to Subcontractors (the Subcontract Act) established for prohibiting a large procuring enterprise from abusing its power over a subcontractor, as a complementary act to the Antimonopoly Act.

The Kansai Branch of the Japan Patent Attorneys Association, one of regional branches thereof, has an IP Management Promotion Committee. This committee studies the effectiveness of timestamps as a tool against abuses of power, through lectures given by the Kinki-Chugoku-Shikoku Office of the Japan Fair Trade Commission. The present author is involved in this committee and now provides a brief description about the effectiveness of timestamps in connection with the facts published already.

Subcontractors, including freelancers, are generally in a weaker position than contractors. It is assumed, for example, that a subcontractor that is a parts manufacturer has devised a unique technology for a part ordered by an assembly manufacturer. It is further assumed that the parts manufacturer provides the assembly manufacturer with materials describing their unique technology as well as an oral description about the part and the technology.

In such a case, the assembly manufacturer may request the parts manufacturer to transfer a part or the whole of the right to be granted a patent. In some cases, the parts manufacturer may be urged to transfer the right without monetary exchange. In a more malicious case, the assembly manufacturer to which the right is not transferred may file a patent application for the technology, while knowing that this may be an act of abuse of its dominant position.

Such a situation can occur not only to patents but also to designs. Many designers are working successfully as freelancers. As such, there is a high possibility that designers could be forced into a weaker position as compared with part manufacturers. It is thus necessary for a designer to prevent its own design from being stolen by its client.

Stamps can be used as means for preventing occurrence of such a situation. For example, if the materials provided from the parts manufacturer to the assembly manufacturer include timestamps together with written names of the manufacturer, the department in charge, and the person(s) in charge, what actions can be taken by the assembly manufacturer for the technology described in the materials?

It is expected that the presence of the timestamps reveals that the parts manufacturer is paying attention to the handling of its intellectual properties, and therefore, the assembly manufacturer must take proceed carefully, as compared with the case where timestamps are absent. It is accordingly expected that timestamps will improve the position of the subcontractors.

(4) Other areas of use

Timestamps can also be used in areas other than those described above. The following is a brief description about some of such areas.

(i) AMANO Secure Japan Corporation offering AMANO Time-stamp Service 3161 indicates on their web page titled "Intellectual Property and Timestamp[4]" timestamps are recently used for "establishment of evidence at the time of development of PB (private brand)," "establishment of evidence at the time of joint research and joint development," and "establishment of evidence for web information."

In this regard, it is assumed, for example, that Company A and Company B made an agreement on a joint development. In this case, timestamps may be attached to materials in which respective technologies developed by these companies are recorded, or timestamps may be attached to the proceedings of a joint development conference both companies attended, for example, and the materials/proceedings may be shared by these companies, so that respective technologies developed by Company A and Company B can be clearly distinguished from each other. In this way, the timestamps can prevent a

situation where a conflict occurs between the companies.

Thus, timestamps can be used to clearly distinguish a company's own technology from a technology of the other company, which makes it possible to prevent contamination of information of one company by the other company.

(ii) A patent attorney, an acquaintance of the present author, heard from a company employee: "the company stores an enormous amount of electronic data to which timestamps are attached, but some of the electronic data are not used effectively and are eventually treated as trash." Such electronic data may only cause a lack of capacity of the company's server, and therefore, it is necessary to effectively utilize the electronic data.

Regarding this problem, the patent attorney says: "The electronic data can be utilized effectively because the electronic data are time-stamped. Since the electronic data have time information, the electronic data can be input to a generative AI system to obtain a hint about creation of new products/works in consideration of the trend of their products/works." Especially in the field of design, effective use of such electronic data is expected. For example, a user may input to a generative AI system an instruction to output designs to be created by the user's company X years later. Then, the generative AI system may determine the trend of transitions in designs of the user's company, to output predicted designs to be created by the company X years later. Thus, there is a high possibility that timestamps can be used not only as a defensive tool but also as an offensive tool.

4. Relevant judicial precedent

In my department's regular meeting held every week, patent attorneys belonging to the department make presentations, in turn, of topics about judicial precedents, law revisions, and IP practices. The following is a judicial precedent that would be useful for considering effective use of timestamps, presented in the meeting held this year.

The plaintiff of this case is the owner of Japanese Utility Model Registration No. 3198778 (Air-conditioned Clothing Wearable with Harness-type Safety Belt[5]). The plaintiff requested the defendant to stop the manufacture, transfer, etc. of defendant's products and discard manufactured products, and also requested the defendant to compensate for damages. The original trial court admitted part of the plaintiff's claim. The defendant (appellant), not satisfied with the decision, appealed to a higher court. As a result, the appeal was dismissed.

In the appeal trial (Reiwa 2 (2019) (Ne) 10038: Appeal case claiming prohibition etc. of infringement of utility model right), nine issues were discussed. Among them,

the fourth issue was "whether or not the invalidity defense is admissible." It included "grounds for invalidation of usurped application (issue 4-1)" and "grounds for invalidation of joint application infringement (issue 4-2)." The fifth issue was "whether the appellant has a right to use an ordinary license by virtue of its prior use, or whether the appellant can claim its parent company's right to use an ordinary license by virtue of its prior use." In the appeal trial for this case as well, the usurped application, the joint application infringement, and the right of prior use were discussed.

Regarding this case, the appellant (as well as the appellant's parent company) and the appellee made a basic transaction agreement, and the appellant and the appellant's parent company also made a commodity transaction agreement and a basic outsourcing agreement. Further, the appellant started "Committee on Air-Conditioned Clothing" aiming at social contribution through heatstroke prevention by distribution of air-conditioned clothing, and discussed issues necessary for achieving the aim, and thereafter regularly held committee meetings with the appellant's customers. The appellee was also a member of the committee until a certain time. Thus, the relationship between the appellant (defendant) and the appellee (plaintiff) in this case is complicated.

The original trial court concluded "the application of the registered utility model was neither a usurped application nor joint application infringement." The appeal trial court also concluded "there is no grounds for invalidation of usurped application and invalidation of joint application infringement, for the application of the registered utility model."

Regarding this case, the issues of the usurped application and the joint application infringement might not have arisen if electronic data was prepared at each of transaction stages and timestamps were attached to the data. Moreover, if such data was submitted at least to the original trial court, these issues might not have been discussed in the appeal court trial.

The appeal court stated, as to the fifth issue, "at the time the product sample was prepared, the specs of the defendant's product were not specified, and therefore, the business details had not been determined. The appeal court further stated "No arguments or evidence have been submitted as to the process of manufacture ordering, manufacturing, and delivery for defendants' product, in the period from March and April, 2015 when the sample was prepared and tried on, to May 2016 when sales of the defendant's products was started by the appellant. In this respect as well, it is determined that the business details were not determined at the time of May 11, 2015 on which the utility model application was filed."

Accordingly, it was concluded "Since preparations for the business involved in

the product, identical to the utility model, had not been made, the appellant's argument that the appellant has a right to use an ordinary license by virtue of its prior use of the utility model, is supported by no grounds." If details of the business were determined and timestamps were used for proving that fact, there is a possibility that the appellant would have been regarded as having the right to prior use.

5. Differences from electronic notarization

If a certificate signed by a private individual (document prepared by the private individual) was submitted to a notary public office and stamped with a certified date, it can later be certified officially that the certificate/document existed at least on the certified date. There is also an electronic notarization system having functions of certifying the authenticity of an electronic document (electronic file) and affixing the certified date to the document (file).

In contrast, the above-described timestamp can be applied to an electronic file of a large size, and is not limited in terms of the file format. The timestamp is available from a personal computer at hand 24 hours a day and 365 days a year, and it is unnecessary to send the data itself to be timestamped. In these respects, timestamps are more convenient than electronic notarization. There would be no reason not to make use of timestamps.

While data on the electronically certified date is stored 50 years, the validity period of the timestamp is shorter, i.e., 10 years at maximum, which is defined in consideration of the possibility of decryption in the future. However, since the validity period is extendable, the period may be updated appropriately.

6. Conclusion

If electronic data accessible on the web is timestamped, this broadens the possibility for the electronic data to be used as evidence for proving invalidation of a patent at trial. While the present author sometimes accesses manufactures' instruction manuals and academic papers published by universities available on the web, they often lack dates of issuance. The lack of timestamps is disappointing at times. It is expected that the time will come when an electronic file is timestamped by an operation like clicking the overwrite save button for the electronic file. Implementation of digital trust in society will be promoted more and more, aiming at reliable and free data distribution.

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1 MIC Guidelines for time business (November 5, 2004)

<URL:https://www.soumu.go.jp/main_content/000485112.pdf>

2 Adobe Acrobat Reader is a registered trademark of Adobe Systems Incorporated in US and other countries.

3 Word and PowerPoint are registered trademarks of Microsoft Corporation in US and other countries.

4 Intellectual property and timestamp <URL:https://www.e-timing.ne.jp/info/how-to-use/intellectual-property/>

5 KUCHO-FUKU is a registered trademark of SFT LABORATORY Co., Ltd. and KUCHOFUKU Co., Ltd. in Japan.

Article

Claim Drafting for Patent Applications by Universities

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1. Introduction

I usually handle patent applications requested by manufacturing companies in the electrical and information field. However, I have opportunities to handle basic-research-based patent applications by universities, because I studied at the Faculty of Science. Though there are various technical fields in universities, what is envisioned here is not the pure ICT technology such as AI and IoT but a technology for having a physical effect on a target system, a technology for performing computational processing in accordance with the result of a physical effect, or a technology for improving the performance of a physically substantial device or element based on new findings.

Generally speaking, basic-research-based patent applications by universities seem to have the following tendencies:

- how to achieve practical utilization and commercialization is uncertain;
- whether or not to file foreign applications is undecided; and
- cost constraints are strict.

Given these circumstances, when preparing specifications for basic-research-based patent applications by universities, there seem to be points to consider different from those for patent applications by companies. In this article, from the standpoint of a patent office in charge of claim drafting, I would like to express my opinion mainly on category selection.

2. Category Selection

(1) Product Invention and Method Invention

Under the Patent Act, the patent right of a "method invention" is effective only for the use of the method, whereas the patent right of a "product invention" is effective for producing, using, assigning, etc., exporting or importing, or offering for assignment, etc. the product. In addition, evidence or traces of working the invention are less likely to remain and discovering and proving infringement and proving the amount of damages (infringer's profits) are difficult in the case of a "method invention", whereas these are relatively easy in the case of a "product invention". Therefore, it is generally said that a "product invention" is protected more extensively than a "method invention".

	Product invention	Method invention
Act of working	many	not many
Discovering and proving infringement	easy	difficult
Proving amount of damages	easy	difficult

(2) Patent Applications by Companies

Since companies work their extensively protected "product inventions" by manufacturing and selling products, claim drafting for patent applications by companies in the electrical and information field is in many cases performed in such a way as to draft an apparatus claim as a main claim and draft a method claim to complementarily protect a matter that cannot be protected by the apparatus claim. Typically, an apparatus claim is drafted as claim 1, dependent claims of the apparatus claim are drafted, an independent method claim corresponding to claim 1 is drafted, and depending on the contents of an invention, a program claim is drafted. Since the patent examination fee and the grant patent fee are charged based on the number of claims in Japan, dependent claims of the method claim and the program claim are often omitted.

(3) Patent Applications by Universities

From my experience, I have a feeling that a method claim is effective for basic-research-based patent applications by universities. The following is an explanation about reasons why it is effective to draft a method claim as a main claim.

(i) Possible to prepare a claim that is not dependent on a physical configuration

In the case of patent applications by companies, because of the presence of their own products and competitive products, it is not often necessary to vacillate over what an

apparatus claim is targeted at and what an apparatus configuration should be like, when drafting the apparatus claim. In contrast, in the case of basic-research-based patent applications by universities, "findings" at a laboratory constitute an embodiment, and thus, it is sometimes unclear what physical apparatus configuration a product will have when these findings are put into practical use in the future. In addition, despite the intention of generalizing the apparatus configuration in the embodiment into a more generic concept, intrinsically unnecessary limitations may be introduced by the embodiment.

An apparatus claim cannot in some cases deal with variations in apparatus configuration because its technical scope is dependent on an apparatus configuration. A method claim can cover unexpected variations in apparatus configuration because its technical scope includes different apparatus configurations as long as the same processing is performed.

I have a feeling that the number of patent applications including method claims as main claims is larger in the United States than in Japan. Actually, in the patent applications by the five leading IT companies in the United States, the so-called GAFAM, method claims are utilized more than apparatus claims and it is reported that about a half of the categories of claim 1 are method claims. This is probably because the function in the ICT technology is often implemented by execution of a program by a CPU, and thus, processing performed by the program is drafted as a method claim, which serves as a main claim. The idea behind this seems to be that hardware changes with the times and a method claim that is free from a hardware configuration is suitable when an invention is characterized by its function.

(ii) Low necessity to identify a subject of an action in each step

According to examination in Japan, when an invention is determined as falling under a computer software-related invention, patent eligibility and clarity can become an issue if a subject of an action in each step of a method claim may include a human being. However, when basic research involves a physical interaction with a system, even if it includes processing by software, it falls under "those concretely performing control of an apparatus …, or processing with respect to the control" or "those concretely performing information processing based on the technical properties such as physical, chemical, biological or electric properties of an object …". Therefore, patent eligibility and clarity are less of an issue, and in many cases, a method claim can be drafted without limiting a component that is a subject of an action in each step.

In the United States, Europe and China, it is not required to identify a subject of an action in each step of a method claim. Therefore, if the subject of an action is not

recited when a Japanese application serving as a basic application is prepared, the application can be filed in each of these countries without any change.

(iii) Easier to avoid claim interpretation under 35 U.S.C. 112(f)

According to the Japanese patent practice, it is widely accepted to recite a component of an apparatus claim in a functional way. Therefore, by using a more generic expression such as position adjustment means or a phase conversion unit, an apparatus claim that is not limited to an apparatus configuration in an embodiment can be drafted.

In contrast, in the United States, when a claim is determined as a functional claim typified by a means-plus-function claim during examination, its technical scope is limited to the embodiment in the specification and its equivalents. Therefore, though whether to file a foreign application is undecided at the time of claim drafting, it is required to consider the name of each component in terms of whether there is a structural English expression suitable for avoiding the determination as a functional claim, in consideration of the possibility of filing a U.S. application. However, it seems to be difficult to achieve both generalizing an apparatus configuration in an embodiment into a more generic concept and finding a structural expression that can avoid the determination as a functional claim.

Thus, by using a method claim, the difficulty in claim drafting can be significantly reduced because simply reciting “adjusting a position” or “converting a phase” is sufficient.

(iv) Easier to enable the Examiner to understand an invention

In the case of patent applications by universities, though the contents of an invention are technical and unfamiliar to the Examiner, a request for appeal, a divisional application and the like are often difficult due to cost constraints. Therefore, in order to achieve smooth examination, it is important to enable the Examiner to fully understand the contents of an invention simply by reading the recitation of claim 1.

In the case of an apparatus claim, the recitations for identifying the components of the apparatus lead to an increase in amount of recitations. This is pronounced when a component serving as a main constituent that performs processing changes in the middle or when a plurality of components perform the same processing in cooperation with each other. In contrast, a method claim is not restricted by an apparatus configuration, and thus, a series of processing can be recited concisely. Particularly, depending on the situation, when a method claim is drafted first, the features of an invention can be

expressed straightforwardly without being restricted by an apparatus configuration in an embodiment.

In addition, the order of recitation that is consistent for an apparatus claim does not necessarily match the order of recitation that is consistent for a method claim. It is difficult to recite the processing in the actual order in the case of an apparatus claim, whereas the series of processing can often be naturally recited in chronological order in the case of a method claim.

Based on these differences, I think that a method claim is suitable for claim drafting that is understandable for the Examiner. I personally feel that particularly in the foreign applications, drafting a method claim as a main claim has led to a decrease in unnecessary grounds of rejection.

(v) Small disadvantages relating to exercise of a patent right

When a method claim is determined as having patentability, an apparatus claim also tends to be determined as having patentability accordingly. By also obtaining patent protection for the apparatus claim, the disadvantages relating to the act of working, discovering and proving infringement, and the like can be mitigated.

In the case of an invention characterized by a function of computational processing or apparatus design, the function is often implemented by a program, and thus, drafting a program claim is considered in Japan. Since a typical program causes a computer to sequentially perform a series of processing, there are many points in common between a program claim and a method claim and it is easy to draft the program claim after drafting the method claim. The act of working in the program invention includes an act of providing the program through electric telecommunication lines such as the Internet, and thus, the program claim has advantages that the method claim does not have.

When filing a foreign application (particularly, in the United States or in China), drafting a recording medium claim is considered within the range of the number of claims for which an excess fee is not charged. Since the recording medium claim is not limited to any specific hardware, various storage devices can be included in its technical scope. In addition, in the United States, direct infringement does not occur when all of the steps are not actually performed in the case of the method claim, whereas direct infringement may occur even when each of the steps is not actually performed in the case of the recording medium claim.

	Japan	USA	Europe	China
Program claim	accepted	prohibited	possible	accepted

Computer readable medium claim	accepted	accepted	accepted	accepted
Number of claims for which excess fee is charged	—	20	15	10

By omitting the recitations that make it difficult to prove infringement, with future disputes in mind, it may become difficult to express the differences from the prior art, which may raise the hurdle of acquiring a patent right. Universities seldom dispute infringement of their patent rights and the main objectives of patent applications by universities are to promote joint research with companies and to grant licenses to companies. In recent years, compliance has been strictly enforced in companies and it has been widely recognized that infringement of a patent right is a compliance violation, and thus, an act of infringing a patent right seems unlikely to be approved in corporate decision making. In the case of patent applications at the stage of basic research, priority may be given to smooth acquisition of a patent right based, to some extent, on the ethical doctrine that human nature is fundamentally good, rather than based on the premise that the other party denies infringement.

3. Conclusion

As described above, in the case of basic-research-based patent applications by universities, I think that appropriate claim drafting and smooth acquisition of a patent right can be achieved by straightforwardly defining the features of an invention with a method claim and reliably protecting a currently imaginable apparatus configuration with an apparatus claim. There are few disadvantages in drafting a method claim as a main claim, and thus, it is advisable to focus on the advantages of the method claim and actively use the method claim.

Article

Change in Manner of Determination as to Distinctiveness of Trademark in Recent Years

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1. Introduction

In dealing with trademark affairs on daily basis, I strongly feel that the distinctiveness of a trademark of an application for trademark registration has been determined very strictly in recent years in Japan. I also hear similar opinions from other professionals. Here, a brief review on this matter will be presented with reference to specific examples (typical examples of appeal decisions in appeals against examiners' decisions of rejection).

In the present article, cases regarding distinctiveness of trademarks will be discussed only in relation with Paragraph 1(iii) of Article 3 of the Trademark Act (indication as to quality, etc.).

2. Specific Examples of Manner of Determination as to Distinctiveness of Trademark

(1) Typical Examples Until Several Years Ago

Until several years ago, many appeal decisions have been made as follows. First, the meaning of the trademark arising from constituent letters of the trademark is identified. Then, the trademark is recognized as not directly and specifically indicating quality etc., in relation with the designated goods and services. Next, it is stated that there is not such a fact that the letters above are generally used in transactions as an indication of quality, etc., in

industries that handle the designated goods and services. Then, it is concluded that each of the filed trademarks has distinctiveness. In each of such appeal decisions, it is a significant factor that the constituent letters of the filed trademark are not actually used as an indication of quality, etc., of the designated goods and services. Specific examples are as follows.

(1) Appeal No. 2020-16593 (Application No. 2019-85647)

Trademark	Designated Goods and Services
企業経営カウンセラー	Class 35 "Management Consulting", etc.
Determination by Board of Appeal (excerpt)	
The trademark of the present application is obtained by combining the letters"企業経営" (which means business management) and "カウンセラー" (which means "counselor"). In view of the entirety of the trademark of the present application, it is difficult to say that the trademark is immediately recognizable as directly and specifically indicating the quality etc., of a service in relation with the designated services of the present application. Moreover, even though the board of appeal conducted investigations on its authority, there was not found a fact that the letters "企業経営カウンセラー" are generally used as an indication of quality, etc., of a specific service in industries that handle the designated services of the present application. Further, there was not found a reason why it should be said that dealers or consumers, who encounter the trademark of the present application, recognize the letters as the indication of quality, etc., of the service.	

(2) Appeal No. 2019-11360 (Application No. 2018-29496)

Trademark	Designated Goods and Services
エコシート (standard letters)	Class 21 "Cleaning paper and sheet for wiping wooden floor", etc.
Determination by Board of Appeal (excerpt)	
In view of the entirety of the letters "エコシート" (which is literally translated as "eco sheet"), one may understand the meaning stated in the statement of the original decision (*writer's note: environmentally friendly sheet-shaped product*), but may still merely conceive a sheet-shaped product having a vague effect such as "environmental friendliness". It is difficult to say that dealers or consumers immediately recognize that the trademark directly and specifically indicates the quality, etc., of the designated goods of the present application. Moreover, even though the board of appeal conducted investigations on its authority, there was not found a fact that the letters "エコシート" are	

generally used as an indication of specific quality, etc., of goods in industries that handle the designated goods of the present application. Further, there was not found a reason why it should be said that dealers or consumers, who encounter the trademark of the present application, recognize the letters as the indication of quality, etc., of the goods.

(3) Appeal No. 2018-3500 (Application No. 2016-86056)

Trademark	Designated Goods and Services
ＬＩＧＨＴ (standard letters)	Class 20 "hose reel" etc.
Determination by Board of Appeal (excerpt)	
Even though the word "LIGHT" has the meaning "light in weight" or the like, the specific meaning is not unambiguously determined from the trademark of the present application. It cannot be said that consumers or dealers, who encounter the trademark of the present application, immediately recognize and understand the meaning "light-weight product" or the like. Therefore, it is difficult to say that one understands that the trademark specifically and directly indicates the quality etc., of the goods with regard to the designated goods of the trademark of the present application. ... Even though the board of appeal conducted investigations on its authority, there was not found a fact sufficient to recognize that the alphabetic letters "LIGHT" are generally used in transactions as an indication of specific quality etc., of goods in industries that handle the designated goods of the trademark of the present application.	

(2) Typical Examples in Recent Years

In recent years, however, many appeal decisions have not necessarily determined that each of the filed trademarks has distinctiveness even when the constituent letters of the trademark are not actually used as an indication of quality, etc., of the designated goods and services. In each of such appeal decisions, after the meaning of the letters is identified, even when the letters themselves are not actually used as an indication of quality, etc., of the designated goods and services, it is concluded that the trademark does not have distinctiveness in the case where dealers or consumers are considered to understand or recognize the filed trademark as an indication of quality, etc., of the designated goods and services in consideration of a plurality of industry situations and transaction situations (such as use of related letters). Specific examples are as follows.

(1) Appeal No. 2024-18260 (Application No. 2023-114237)

Trademark	Designated Goods and Services
美眉筆 (standard letters)	Class 3 "Cosmetic" etc.
Determination by Board of Appeal (excerpt)	
The letters "美眉" are widely used and understood as a word having the meaning "beautiful eyebrow" in industries that handle the designated goods of the present application. Moreover, ..., in the industries that handle the designated goods of the present application, a product purporting to draw a "beautiful eyebrow" is produced and sold. In description or the like of such a product, it is recognized that the letters "美眉" are actually used frequently. Moreover, in the industries that handle the designated goods of the present application, a "brush (筆) type product (product in which a cosmetic and a brush-shaped portion used together with the cosmetic are integrated)" is generally produced and sold. ... It is recognized that the same applies to the product purporting to draw a "beautiful eyebrow". In view of the above, when the trademark of the present application is used for the designated goods, it is reasonable to consider that dealers or consumers, who encounter the trademark, readily recognize the meaning "brush by which a beautiful eyebrow is drawn", and understand that the product is a "brush type cosmetic for eyebrow by which a beautiful eyebrow can be drawn", i.e., understand that the trademark is an indication of quality of the goods. ...	

(2) Appeal No. 2023-13211 (Application No. 2021-93227)

Trademark	Designated Goods and Services
ａｔｈｌｅｔｅ　Ｃｈｉｆｆｏｎ (standard letters)	Class 30 "sweets (except for those mainly composed of fruits, vegetables, beans, or nuts)", etc.
Determination by Board of Appeal (excerpt)	
In industries that handle the designated goods of the present application, it is recognized that the letters "アスリート" (which means athlete), "athlete" or ... are put at the first part of a word such as "アスリートケーキ" or "athlete cake", and such a word is actually used widely as a word indicating that the product is intended for an athlete because necessary nutrients and nutritional values can be supplied. In this case, it is reasonable to consider that dealers or consumers readily recognize and understand that the trademark indicates that the product, i.e., the latter part of the word after the part "athlete" is "for an athlete". On the other hand, in the same industries, the letters "--- chiffon (--- represents the sales target to which the chiffon cake is intended to be sold)" are actually used widely as a word in which the letters representing the sales target are put at the first part of a word such as	

“お子さまシフォン”or “Kids Chiffon”. Hence, when the letters representing the sales target are put at the first part of the word, it is reasonable to consider that one readily recognizes and understands that the first part of the word before the letters of the latter part,“シフォン” or “chiffon”, indicates a type and concept of the “chiffon (abbreviation of chiffon cake)”. Therefore, dealers or consumers, who encounter the trademark of the present application consisting of the letters “athlete Chiffon”, recognize and understand the meaning “chiffon cake for an athlete”. Hence, even when the trademark is used for the “chiffon cake for an athlete” among the designated goods, the dealers or consumers, who encounter the trademark, merely recognize an indication of quality of the goods ... .

(3) Appeal No. 2022-6745 (Application No. 2020-102212)

Trademark	Designated Goods and Services
BRAND SEARCH	Class 45 “Advice for trademark license”, etc.
Determination by Board of Appeal (excerpt)	
In view of the entirety of the composition of the trademark of the present application, the meaning “investigation of brand (trademark)” is readily recognized. ... In industries related to intellectual properties, it is recognized that there is a business entity that uses the words “Brand Mark Search” and “ブランドマークサーチ” for trademark investigations. Also, it is recognized that the word “--- Search” (--- represents a term related to intellectual properties), such as “Trademark Search”, is widely used in investigating various intellectual properties. Therefore, in the industries related to intellectual properties, it is reasonable to consider that dealers or consumers, who encounter the word “--- Search” (--- represents a term related to intellectual properties), recognize that the trademark represents an investigation of ---. Hence, when the trademark of the present application consisting of the letters “BRAND SEARCH” is used for the services of class 45 among the designated services, the dealers or consumers, who encounter the trademark, recognize the meaning “investigation of brand (trademark)”. It should be generally recognized that the trademark indicates the quality of the investigation or the service intended for the investigation.	

(3) Analysis

Even in the past, we sometimes saw that the distinctiveness of a filed trademark is denied in “combination” with a plurality of industry situations and transaction situations as in the appeal cases exemplified above in (2), i.e., even when the trademark is not actually used as an indication of quality, etc., of designated goods and services. There is, however, an

impression such that such decisions have been apparently frequently made in appeal cases recently and have now become typical examples of decisions.

Here, the actual use is not always a requirement for the denial of the distinctiveness of the filed trademark. That is, regardless of whether or not it is actually used, it is sufficient to deny the distinctiveness of the filed trademark when dealers or consumers of the designated goods and services understand or recognize the filed trademark as an indication of quality etc., thereof. Therefore, it may be appropriate to say that the manner of determination as to the distinctiveness of a trademark appears to have changed "very strictly" in recent years but has actually "reverted to a manner in which the distinctiveness should have been determined in the first place although it had been determined loosely".

In any case, although many might recognize "even a trademark, which is slightly weak in distinctiveness, can be registered as long as it is not actually used", it can be said that it is now time to change this recognition in view of current circumstances in which the distinctiveness of a filed trademark is denied by the "combination" described above. Moreover, when selecting and filing a trademark, it is considered to become necessary to check and know industry situations and transaction situations for goods and services more comprehensively by not only reviewing and checking use examples of constituent letters themselves of the trademark but also reviewing and checking use examples of related letters or the like with regard to the industry situations and transaction situations.

3. Conclusion

When it is understood that the manner of determination as to the distinctiveness of a trademark has changed to be "reverted to the manner in which the determination should have been made in the first place", it is very important and necessary to conduct trademark practice based on a premise that the manner of determination thus changed is estimated to be maintained for a long period of time in future. Due to this change, it has become more difficult to obtain a trademark registration than before. In this regard, I have to say that this is a negative event. On the other hand, however, this also gives an opportunity to create, register, and use a trademark having strong distinctiveness so as to sufficiently exhibit essential functions of trademark, such as the function of distinguishing goods and services from those of competitors and the function of indicating the origin thereof, and accumulate business reputation, rather than a trademark having a difficulty in obtaining registration due to not having strong distinctiveness. In that sense, this may be considered as a positive event when taken in a long-term view.