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Opinion:

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1. Introduction

During job interviews, candidates sometimes ask me, "What kind of person is best suited to be a patent attorney?" My answer to this is always, "Someone who likes learning." This is because, as a patent attorney and as a manager responsible for human resource development of patent attorneys within the firm, I believe that a strong desire to learn is not only essential for passing the patent attorney examination, but a person cannot fulfill this job unless they enjoy learning even after getting certified. Below, I would like to describe the background of these thoughts and our firm's initiatives.

2. Reasons Why Someone Who Likes Learning is Best Suited to be a Patent Attorney

The number of successful applicants for the patent attorney examination has been steadily decreasing since its peak in fiscal year 2009, and in the fiscal year 2025 examination, there were 205 successful applicants out of 3,501 applicants. Simply dividing these numbers gives a pass rate of 5.9%, and there is no doubt that it is a highly difficult qualification. However, passing this examination alone does not guarantee that the person can remain competitive at the forefront as a patent attorney, for the following reasons.

First, the laws and standards surrounding intellectual property are frequently revised, and judicial precedents that one should be aware of are newly generated every day.

Second, since many patent attorneys handle not only domestic cases but also foreign cases, it is necessary to constantly grasp the systems, operations, and judicial precedents of not only major countries but also various other less familiar foreign countries.

Third, in order to handle foreign cases, it is essential to acquire and maintain an appropriate level of English proficiency.

Fourth, a patent attorney who handles patents, in particular, must study to acquire knowledge of new technical fields (not only cutting-edge technical fields but also technical fields in which the patent attorney in charge has no experience).

Fifth, since the patent right, trademark right, etc. handled by patent attorneys represent important strategic business assets for clients, a patent attorney must constantly keep abreast of business trends in the relevant field.

For a person who is reluctant to learn new things, the work of a patent attorney would be nothing but agony. However, for someone who likes learning, there is no profession more suitable than this. This is because one can frequently encounter situations where what they have learned can be utilized in their work. Perhaps, the broader the required knowledge is, the more opportunities one has to put it into practice. I feel that there are not many professions where the results of self-study are so directly linked to practice.

3. Self-Study and Acquisition of Practical Skills

By the way, since a patent attorney is a professional, our firm's basic stance is that the acquisition of knowledge that can be learned through self-study is based on self-help efforts. On the other hand, it is also true that there are many areas of knowledge and skills that cannot be covered by self-help efforts alone. A typical example of this is the practical expertise of a patent attorney, including the drafting of specifications for patent applications, and it is practically impossible to acquire these skills through self-study merely by reading books.

At our firm, a specific patent attorney with sufficient experience trains and mentors one new patent attorney continuously through actual cases; we equip our new patent attorneys with practical skills through a so-called "apprenticeship" style OJT. For a newcomer with no practical experience to acquire practical skills, it takes at least several years even for domestic operations alone, and normally over 5 years for both domestic and foreign operations. The business model of a patent firm is very long-term, where investment in education is continued over a long period, and recovered after the person has grown into a full-fledged professional. In particular, at our firm, it is a basic policy that patent attorneys develop by first handling domestic applications and then gradually taking charge of everything consistently up to the acquisition of rights in foreign countries. So, attorneys become "independent" only when they can complete all operations for domestic and foreign applications by themselves.

The reason for adopting this "consistent domestic and foreign" policy is, first of all, because we believe it has great merits for the client. The patent attorney in charge who is thoroughly familiar with the background at the time of the domestic application can accompany the client up to the

acquisition of rights in foreign countries. Furthermore, having a patent attorney well-versed in foreign practice handle the domestic application makes it possible to propose optimal domestic application strategies with future foreign applications in mind. For the individual patent attorney as well, experiencing both domestic and foreign practice leads to improvement in comprehensive skills, and above all, allows them to work hard every day with a fresh mindset, without their work becoming monotonous.

On the other hand, the biggest challenge of this policy is that the training/mentoring period inevitably becomes longer, and the period until independence is prolonged, compared to a "division of labor" system where, for example, domestic operations and foreign operations are assigned to separate individuals. During that time, not only is it necessary to continue the educational investment, but a "mechanism" is also needed to keep the motivation of the new patent attorney high during the long training period, and furthermore, to have them settle down for a long time even after becoming independent.

4. Measures to Stimulate the Intellectual Curiosity of a Patent Attorney

While it is naturally necessary to reward the efforts and contributions of each patent attorney in terms of monetary remuneration, the funds for this are limited. Here, we return to the point made at the beginning that "someone who likes learning is best suited to be a patent attorney." For a person who likes learning, having a mechanism in the workplace that continuously stimulates their intellectual curiosity serves as a strong motivation to continue working there. With this, a virtuous cycle can be created where the newly acquired knowledge leads to an improvement in the quality of work provided to clients.

Therefore, at our firm, we are implementing initiatives such as encouraging taking various certification examinations and holding various internal seminars. Below are some examples.

(1) Encouragement to Take Certification Examinations

We encourage patent attorneys, patent engineers, and administrative staff to take the following certification examinations, and for some of these a monthly allowance is paid to those who achieve certification. In addition, we announce the successful applicants and schedules of each examination at the monthly meetings attended by all staff members, encouraging them to actively take the exams.

1. Eiken Test in Practical English Proficiency, Grade 1
2. Intellectual Property Translation Test
3. Technical English Proficiency Test, Professional
4. Intellectual Property Management Skills Test, Grade 1 and Grade 2

5. G Test Conducted by JDLA (Generalist (certification examination concerning literacy in the utilization of AI and Deep Learning))
6. Third-Class Chief Electrical Engineer
7. Semiconductor Engineer Career Certification (SECC), Electronics Grade 3
8. Applied Information Technology Engineer Examination (AP), IT Passport Examination

Among these, numbers 5 to 7 are those for which encouragement was started in 2023 as a countermeasure to the recent situation where it has become difficult to recruit electrical and information-related engineers. The purpose is to enable a patent attorney without a background in electrical and information fields to expand their area of expertise into those fields even a little, leading to securing human resources in the future.

Moreover, since the start of the Specific Infringement Lawsuit Representation Examination system in 2003, we have encouraged each patent attorney to acquire this qualification. As a result, the acquisition rate of this qualification among the patent attorneys at our firm is maintained at a high level of 57%.

(2) Holding Internal Seminars

Taking the past year as an example, we held the following internal seminars regarding foreign intellectual property practice, English, and electrical and information-related technologies.

- * U.S. Patent Practice Seminar (held monthly): A lecture by an of-counsel U.S. attorney at law.
- * Foreign Intellectual Property Practice Lectures (over 30 times in total): Lectures regarding intellectual property practice in various foreign countries by foreign patent attorneys and attorneys at law who visited our firm.
- * Seminar on Drafting English Letters: A lecture by a native English-speaking attorney at law. English letters drafted by our patent attorneys are dispatched after being checked by this attorney, and feedback summarizing the results is regularly provided to all staff members.
- * Seminar Highlighting the Importance of English Learning: A lecture based on abundant experience, judicial precedents, etc. by a patent attorney with over 40 years of work experience at our firm.
- * Semiconductor Technology Seminar: A lecture by a patent attorney who has work experience at a semiconductor manufacturer.
- * Seminar on Semiconductor Circuits: A lecture by a patent attorney who has experience as an instructor at an electronics manufacturer.
- * Data Science Seminar: A lecture by a person who completed the Data Scientist Training Program.

We expect that the stimulation received through such seminars will lead to the participants' further desire for self-study. Additionally, we hope that by learning together, each participant will

become a "Great Teacher" as in the words of the American educator William Arthur Ward¹, and that it will serve as an opportunity to ignite the desire to learn in one another.

5. Conclusion

According to a report² published by the Japan Patent Office in 2024, the aging of patent attorneys is progressing, and the proportion of patent attorneys working in companies is increasing year by year. The number of patent attorneys belonging to a patent firm is predicted to decrease from 8,496 in 2023 by up to 1,400 by 2033, and by up to 3,500 by 2053. Under such circumstances, how to recruit and train capable human resources is a highly significant issue for a patent firm. Within our firm as well, the aging of patent attorneys is gradually progressing, and this tendency is particularly notable among personnel in charge of electrical and information fields, where the competition for acquisition is fierce.

Even in an environment where continuously evolving generative AI exists, I am convinced that a human patent attorney will be necessary. We will continue to be involved in the future in work that comprehensively analyzes unprecedented cases based on broad knowledge and experience, proposes options to our clients, determines the best strategy through collaborative discussions, and produces deliverables based on that foundation, such as the work of drafting specifications for patent applications. This is because there are innumerable ways to express a newly created invention and acquire a right for it, and we believe that a relationship of trust between the patent attorney as the service provider and the client who has the decision-making authority, is essential for the client to determine that strategy. We will continue to promote all possible measures in the future to train our patent attorneys so that our patent firm will continue to be an entity that is trusted and sought after by clients.

¹ The mediocre teacher tells.

The good teacher explains.

The superior teacher demonstrates.

The great teacher inspires.

² https://www.jpo.go.jp/resources/shingikai/sangyo-kouzou/shousai/benrishi_shoi/document/20-shiryuu/02.pdf

Article

Towards Passing the National Examination: Intellectual Property Management Skills Test[®], 2nd Grade

—Analyzing Question Trends and Strategies for Success—

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1. Introduction

The Intellectual Property Management Skills Test[®] (hereinafter referred to as the "IPMST[®]") (Note 1) is divided into 1st Grade, 2nd Grade, and 3rd Grade, as described later. At Fukami Patent Office, P.C., we hold study groups for passing the 2nd Grade IPMST, targeting staff members belonging to the Business Management Department (referred to as "secretaries" at our firm). In order to protect our clients' intellectual property with a robust system, it is essential for "patent attorneys" and "secretaries" to collaborate by leveraging their respective high levels of specialized knowledge.

The study group is held at a pace of three times a year, with each term lasting four months, and through many years of effort, we have held a total of 32 terms so far. As a result, to date, 129 secretaries (as of the end of June 2026) have passed the 2nd Grade IPMST and are performing their daily duties with reliable specialized knowledge of intellectual property as 2nd Grade Certified

Specialists of Intellectual Property Management ^(Note 1).

I have been in charge of lecturing the study group since the first term. I feel that the content tested in the 2nd Grade IPMST constantly updates the highly important specialized knowledge required for managing intellectual property rights, making it a must-have national qualification in the business of managing intellectual property rights.

Therefore, in this article, I would like to introduce the content of the 2nd Grade IPMST and discuss the approach to passing the exam in the following.

2. Intellectual Property Management Skills Test

(1) History ^(Notes 2, 3, 4, 5, 6)

Dec. 2002:	Establishment of the "Association of Intellectual Property Education"
Mar. 2004:	Launch of the private certification "1st Intellectual Property Test"
Jul. 2008:	Implementation of the 1st examination of the national qualification "Intellectual Property Management Skills Test"
Nov. 2010:	Newly established 1st Grade (Content Specialist Expertise)
Oct. 2013:	Newly established 1st Grade (Brand Specialist Expertise)

(2) Classification ^(Note 2)

<3rd Grade IPMST (Beginner / Introductory Level)>

Scope of Work:	Management Services
Target Audience:	Students, new employees, general business people encountering IP for the first time, etc.
Features:	Broad and basic knowledge regarding intellectual property (fundamentals of patent, design, trademark, copyright, etc.) is tested. It is positioned as an introductory level to confirm whether the test-taker understands the minimum basic rules of IP required in the workplace.

<2nd Grade IPMST (Intermediate and Practical Level)>

Scope of Work:	Management Services
Target Audience:	Corporate IP personnel, individuals involved in practical operations in departments such as legal, development, planning, and sales.
Features:	In addition to the basic knowledge of 3rd Grade, concrete problem-solving abilities suited to practical operations are tested. Test-takers are required to demonstrate whether they can take appropriate practical actions to protect their own company's IP and avoid infringing other companies' rights.

<1st Grade IPMST (Advanced and Expert Level)>

The 1st Grade represents a highly advanced expert level for leading IP strategies within a corporation. Because the target domain is extensive and advanced, its major feature is that it is

subdivided into three specialized fields.

(i) Patent Expertise: Evaluates advanced strategic planning and management abilities centered on patents, from identifying inventions and building patent portfolios, to negotiating licensing agreements and addressing infringements.

(ii) Media Content Expertise: Evaluates practical skills in content business management and contracting, centered on copyrights, within the entertainment industry (including movies, music, anime, games, and publishing).

(iii) Brand Expertise: Evaluates brand strategy and legal affairs capabilities, centered on the Trademark Act and the Unfair Competition Prevention Act, to protect, cultivate, and utilize corporate and product brands.

3. Utilization of the *Intellectual Property Management Skills Test*

(1) "Intellectual Property Strategic Program" by the Cabinet Office (Notes 7, 8)

In the "Intellectual Property Strategic Program" formulated annually by the Intellectual Property Strategy Headquarters (headed by the Prime Minister) of the Cabinet Office, the Intellectual Property Management Skills Test is explicitly recommended by name as a key initiative for nurturing IP human resources and raising public awareness. This test is positioned as an optimal tool for disseminating basic knowledge of intellectual property, not only among a limited group of experts (such as patent attorneys and IP department staff) but also among general business professionals, students, and corporate executives. The history of its transition from a private qualification to a national qualification administered by the Ministry of Health, Labour and Welfare reflects the government's strong commitment to expanding the talent pool of "Certified Specialist of Intellectual Property Management" within industry.

(2) Utilization in Corporations

The official website of the "National Examination: Intellectual Property Management Skills Test" publishes lists such as the "Top 50 Companies and Organizations with the Highest Number of Applicants for the IPMST®" (Note 9) and "Major Companies Recommending the IPMST®" (Note 10). This demonstrates that many leading Japanese corporations actively promote and encourage their employees to obtain this certification.

4. Trend Analysis of the 2nd Grade IPMST

We analyzed the questions of the 2nd Grade IPMST (Written (400 questions) and Practical (400 questions)) from the 44th exam (conducted in March 2023) to the 53rd exam (conducted in March 2026), dividing them into: (i) Patent Act, (ii) Utility Model Act, (iii) Design Act, (iv) Trademark Act, (v) Copyright Act, (vi) Treaties, (vii) Unfair Competition Prevention Act, (viii) Antimonopoly Act, (ix) Plant Variety Protection and Seed Act, and (x) Other Legal Areas. Past exam questions for the

2nd Grade IPMST are published on the website of the "Intellectual Property Management Skills Test" (Note 2) (for the past three examinations).

(1) Trend Analysis of the Written Examination (400 questions in total)

Category	Number of Questions (Out of 400 total)	Percentage (%)
(i) Patent Act	128 questions	32.00%
(ii) Utility Model Act	1 question	0.25%
(iii) Design Act	24 questions	6.00%
(iv) Trademark Act	51 questions	12.75%
(v) Copyright Act	95 questions	23.75%
(vi) Treaties	23 questions	5.75%
(vii) Unfair Competition Prevention Act	11 questions	2.75%
(viii) Antimonopoly Act	11 questions	2.75%
(ix) Plant Variety Protection and Seed Act	10 questions	2.50%
(x) Other Legal Areas	46 questions	11.50%

- The written examination tends to broadly test legal knowledge across intellectual property in general. Even in the data across 10 examinations, it is clear that the weight of "Other Legal Areas," which go beyond the framework of intellectual property laws, remains consistently high.

- The "Patent Act" and "Copyright Act" account for approximately 55% of the total. This trend has not changed at all throughout the past 10 examinations.

- Peripheral laws such as the Unfair Competition Prevention Act, the Antimonopoly Act, and the Plant Variety Protection and Seed Act are almost guaranteed to feature one or two questions in every examination (10 or 11 questions each over 10 examinations).

- Attention should be paid to the fact that the percentage of questions from "Others (Civil Code, Customs Act, IP landscape, etc.)" is higher than that of Treaties or the Design Act. In particular, questions regarding the IP Landscape have reliably appeared in every examination in recent years.

(2) Trend Analysis of the Practical Examination (400 questions in total)

Category	Number of Questions (Out of 400 total)	Percentage (%)
(i) Patent Act	131 questions	32.75%
(ii) Utility Model Act	1 question	0.25%
(iii) Design Act	25 questions	6.25%

(iv) Trademark Act	65 questions	16.25%
(v) Copyright Act	102 questions	25.50%
(vi) Treaties	30 questions	7.50%
(vii) Unfair Competition Prevention Act	16 questions	4.00%
(viii) Antimonopoly Act	0 questions	0.00%
(ix) Plant Variety Protection and Seed Act	10 questions	2.50%
(x) Other Legal Areas	20 questions	5.00%

- The practical examination is based on concrete case studies (problem scenarios), and the proportions of the "Copyright Act" and "Trademark Act," which directly relate to matters prone to trouble in corporate practical settings, are 25.50% and 16.25%, respectively, representing a heavier weight than in the written examination (23.75% and 12.75%, respectively). Scenarios directly connected to daily operations, such as "using another person's content in a company advertisement" or "a new product name conflicting with another company's trademark rights," are tested as packaged question sets.

- Treaties (7.5%) tend to have the same question format. Treaty questions (totaling 30 questions across all 10 examinations) have always appeared in the latter half as a set of three fill-in-the-blank questions. The PCT (Patent Cooperation Treaty) procedures and the principles of the Paris Convention are the best opportunities to score points in the practical examination.

- Even looking back over the past 10 examinations (400 questions), there have been no questions (0 questions) with the "Antimonopoly Act" as the main theme in the practical examination. It can be read as a definitive trend that issues concerning restrictions on licensing agreements are tested exclusively in the written examination.

5. Approach to Passing the 2nd Grade IPMST

(1) Patent Act

The Patent Act is the most crucial subject, accounting for approximately 32% to 33% of the entire exam in both the written and practical examinations. Whether you can reliably score points here holds the key to passing the 2nd Grade.

A. Written Examination

In the written examination, it is tested whether you have accurately memorized the "timing," "subject," and "conditions" of procedures unique to the Patent Act.

(a) Exception to Loss of Novelty (Frequency: Very High)

The timeframe requirement—where an application must be filed "within one year" from the

date the invention became publicly known due to an act of the person who has the right to obtain a patent—is frequently tested. The exam also targets requirements such as submitting a document stating to that effect at the time of filing the application, or submitting a certificate within 30 days from filing to benefit from the exception. It is best to organize key points such as the "within one year" timeframe and that disclosures made through publication in a patent gazette are excluded from the scope of the exception.

(b) Employee Inventions (Frequency: High)

The definition of an employee invention (an invention that falls within the scope of the employer's business and pertains to the employee's duties) and the rule that the employee has the right to receive "reasonable money or other economic benefits (reasonable benefits)" when there is a contract allowing the employer to acquire the right to obtain a patent are frequently tested. Please master the rules of "when" and "to whom" the attribution of rights shifts, as well as the "statutory non-exclusive license" obtained by the employer.

(c) Restrictions on Amendments to Procedures (Frequency: High)

In particular, restrictions regarding amendments after receiving the "final notification of reasons for refusal" are frequently tested. The exam tests the strict limitations placed on amendments, such as the deletion of claims, restriction of the scope of claims, and correction of clerical errors. The golden rule is to contrast and memorize how the allowable range of amendments differs between the "first notification of reasons for refusal" and the "final notification of reasons for refusal."

(d) Trial for Patent Invalidation (Frequency: Medium to High)

The points that only an "interested party" can request a trial for patent invalidation and that it can be requested even "after the patent right has expired" are repeatedly tested. It is effective to create a comparative table so as not to confuse the "eligible parties" (whether anyone can file, or only interested parties) with other trials (such as a trial against an examiner's decision of refusal), trials under the Trademark Act, or oppositions.

B. Practical Examination

In the practical examination, appropriate responses are required based on concrete cases (case studies).

(a) Unity of Invention and Description Requirements of the Specification (Frequency: High)

Multiple claims are tested (e.g., "a product comprising apparatus A and apparatus B" and "a product comprising apparatus A, apparatus B, and apparatus C"), and the exam tests whether these possess the "same special technical feature" and satisfy the unity of invention. The point that adding matters not described in the specification to the claims (addition of new matter) becomes a reason for refusal is also a classic exam topic. Train yourself to discern whether the "Special Technical Feature (STF) = a new feature not present in prior art" is common to all claims.

(b) Calculation Problems: Examination Request Fees and Patent Fees (Frequency: Very High)

The Patent Act is most frequently chosen for the descriptive calculation problems unique to the practical examination, which require answers to be written in Arabic numerals. You will be asked to calculate the examination request fee or the patent annuities (patent fees) for a patent right based on the provided table provided and the "number of claims." The calculation formula (basic fee + number of claims $\times$ volume unit price) is always provided in the problem text. To avoid calculation mistakes or digit errors with zeros, make sure to double-check your calculations during the actual exam.

(c) Determination of Patent Infringement and Defenses (Frequency: High)

In response to a warning that your company's product infringes on another company's patent right, the exam tests whether a "prior use right" is established (whether one was "working the invention" or "preparing for the working of the invention" prior to the filing) or whether one can escape infringement on the grounds of working the invention for "experimental or research purposes." It is also necessary to confirm the difference in requirements from the "prior use right" of trademark rights. In practice, it is important to simulate the flow of actions to take upon receiving a warning (checking the patent register, investigating the validity of the right, proving prior use rights, etc.).

(2) Utility Model Act

Questions with the Utility Model Act as the main theme are extremely few, accounting for only 0.25% of the entire exam combining written and practical examinations (just two questions over the past 10 examinations—1 written and 1 practical). However, because it frequently appears as a "comparison with the Patent Act (trick options)" within patent or design law questions, it is a subject that can never be ignored. Pinpoint memorization of "how it differs from the Patent Act" is the most time-efficient strategy for the Utility Model Act.

A. Written Examination

The written examination directly tests the "subject matter of protection" and "conditions for exercising rights" unique to the Utility Model Act.

(a) Limitation of the Subject Matter of Protection (Frequency: Very High)

The Utility Model Act protects only "devices relating to the shape, structure, or combination of articles." Therefore, "manufacturing methods," "programs," "chemical substances," etc., are outside the subject matter of protection. Memorize clearly that "methods are no good, programs are no good, only the shape or structure of articles." In past questions, the point that "a method is not a subject of protection under the Utility Model Act" has been directly tested.

(b) Non-Examination System (No Substantive Examination)

In order to grant rights early, the Utility Model Act adopts a system (non-examination system) where registration is made "without conducting a substantive examination" for novelty, inventive step, etc. It is good to grasp this decisive difference from the Patent Act: under the Utility Model Act, "if you file an application (as long as it satisfies procedural requirements), it will in

principle be registered as is."

(c) Conditions for Exercising Rights (Presentation of a Report of Technical Opinion on Utility Model)

Because registration is granted without a substantive examination, the validity of the right is unstable. Therefore, a strict condition is imposed: before exercising rights (such as filing a claim for an injunction) against another company, one must first present a "Utility Model Technical Opinion Report" prepared by the Japan Patent Office and issue a warning. Memorize this in contrast: "Patent = immediate warning is OK (claims for compensation require a warning)" and "Utility Model = warning is NG without the Utility Model Technical Opinion Report."

B. Practical Examination

In the practical examination, questions are prepared as a case study of filing strategies in a corporate IP department, such as "whether to protect your company's new product via a patent or a utility model."

(a) Duration and Maintenance Decisions

The duration of a utility model right is "10 years from the filing date." Questions often test your ability to compare the 20-year term for patents and 25-year term for designs. Understanding its practical positioning as a system suited for products with short lifecycles (toys, daily sundries, etc.) makes it easier to decipher the context of the case studies.

(b) Conversion of a Patent Application to a Utility Model Registration Application and Domestic Priority

Questions test the coordination of application procedures, such as whether a patent application already filed can be converted into a utility model registration application (possible, but not applicable to method inventions), or whether domestic priority can be claimed for a patent application based on a utility model registration application (possible).

(c) Application Mutatis Mutandis of Employee Invention Provisions

The point that the provisions regarding "employee inventions" in the Patent Act apply mutatis mutandis (the same rules apply) under the Utility Model Act is also tested.

(3) Design Act

The Design Act accounts for approximately 6% of the total in both written and practical examinations (around two to three questions per exam). Although the number of questions is small, "rules unique to the Design Act" are clearly set compared to the Patent Act or Trademark Act, making it a "hidden source of points" that is very easy to prepare for.

A. Written Examination

In the written examination, the "requirements for registration (what can be registered and what cannot be registered)" and "criteria for determining similarity" under the Design Act are directly

asked.

(a) Designs That Cannot Be Registered (Grounds for Unregistrability) (Frequency: Very High)

The point that "a design consisting solely of a shape indispensable for securing the functions of an article" cannot receive a design registration even if it does not cause confusion with articles relating to another person's business is repeatedly tested as a trick choice in past questions. This is a provision intended to demarcate the Design Act from the Patent Act (protection of technical ideas). It is best to understand that shapes determined inevitably from function rather than design (aesthetic impression) are not protected under the Design Act.

(b) Difficulty of Creation and Determination of Similarity (Frequency: High)

Questions test the rule that a design that could have been "easily created" by a person skilled in the art (a specialist in that field) based on a combination of "publicly known shapes or patterns" will not be registered. The rule that the similarity (whether they resemble each other) between designs is judged based on the "aesthetic impression evoked through the visual perception of consumers," rather than that of the creator, is also a highly frequent topic. What corresponds to the "inventive step" of a patent is the "difficulty of creation" of a design. Please ensure you remember that the criterion for judging similarity is the "perspective of the person who buys it (consumer)."

(c) Scope of a Registered Design (Frequency: Medium)

Questions test statutory knowledge that the scope of a registered design is determined based on the design represented in the "statement in the application (article to which the design pertains)" and the "drawings attached to the application (or photographs, models, samples)."

B. Practical Examination

In the practical examination, questions test "design protection strategies" through case studies, such as how to protect the design of a new product or how to eliminate competitor imitations.

(a) Utilization of Special Design Systems (Related Designs, Partial Designs, Secret Designs) (Frequency: Very High)

Selecting application strategies based on purposes is a staple, such as "products with different variations under the same design concept (Related Designs)," "protection of only a characteristic handle part (Partial Designs)," or "wanting to hide the design until the release date (Secret Designs)." The key is to understand the "purpose" of each system. In particular, the system of secret design is a powerful system unique to the Design Act that does not exist under patent or trademark law, and the fact that it can be requested not only at the time of filing but also "at the time of paying the registration fee for the first year" is tested as a practical trick choice.

(b) Period and Procedures for Exceptions to Loss of Novelty (Frequency: High)

Questions test the requirement that when filing a design registration application after exhibiting at an exhibition or conducting test sales, the application must be filed "within one year" from the date of that public disclosure. Just like under the Patent Act, this grace period is "one year."

Attention is required for questions testing procedural requirements, such as "submitting a document stating that one seeks the application of the exception at the same time as filing the application." The certificate must be submitted within 30 days from filing.

(c) Determination of Infringement and Dissimilarity of Articles (Frequency: Medium to High)

The scope to which the effect of a design right extends is the range where "articles are identical or similar" and "shapes are identical or similar." For example, with a "passenger car" and a "toy passenger car," the point that if the articles are completely different, it does not constitute an infringement of the design right even if the shapes are completely identical is tested. How to differentiate this from the Unfair Competition Prevention Act (acts of imitating the configuration of goods) is also frequently tested.

(4) Trademark Act

The Trademark Act is the "third pillar," accounting for 12.75% (51 questions) in the written examination and 16.25% (65 questions) in the practical examination. Especially in the practical examination, many troubleshooting examples directly linked to corporate activities, such as product naming or receiving warnings from other companies, are tested. The consent system introduced by legislative amendments is a frequent question in recent years. While the aforementioned Patent Act, Utility Model Act, and Design Act are laws that protect creations, the Trademark Act is a law that protects business credibility, which means its content regarding registration requirements is completely different. When studying the Trademark Act, it is important to be conscious of this point and shift your perspective. For instance, considering why a trial for rescission of trademark registration is provided in the Trademark Act (whereas a trial for rescission of trademark registration is not provided in the Patent Act) is important for deeply understanding the Trademark Act.

A. Written Examination

In the written examination, questions test accurate knowledge regarding "registration requirements" and "procedures (renewals, trials)" unique to trademarks.

(a) Various Trials and Oppositions to Registration (Frequency: Very High)

The point that a "trial for rescission of trademark registration based on non-use" can be requested by "anyone" if the trademark has not been used continuously for three years or more in Japan is frequently tested. The fact that the burden of proof rests with the trademark right holder is also a key topic. Questions frequently test the fact that an "opposition to registration" can be filed by "anyone" within "two months" from the date of publication in the trademark gazette. It is essential to organize these options into a matrix table to clarify who (anyone / interested parties only) and by when (at any time / within 5 years from registration / within two months from gazette publication, etc.) they can be requested.

(b) Renewal Registration of the Duration (Frequency: High)

This is a system unique to trademark rights. The points that applications for renewal registration must be filed from "six months" prior to the expiration of the duration up to the date of expiration, and the fact that the renewal itself is permitted even if the trademark is not in use, are frequently tested as trick choices.

(c) Registration Requirements (Distinctiveness and Grounds for Unregistrability) (Frequency: Medium to High)

The points that "common surnames" or "common names of goods (including abbreviations)" are unregistrable in principle due to a lack of distinctiveness, and that a trademark consisting solely of a three-dimensional shape indispensable for securing the functions of goods is unregistrable, are tested.

B. Practical Examination

In the practical examination, specific calendars (dates) or situations are given, and questions testing "what kind of action can be taken right now" are a staple.

(a) Determination of Time Limits (Calendar Problems) (Frequency: Very High)

Problems that require you to judge "whether an opposition to registration can be filed at the present point" or "whether a trial for invalidation can be requested" based on a concretely presented timeline—such as the filing date, registration date, and gazette publication date—are featured in almost every examination. If dates appear in the problem text, first make it a habit to calculate "whether it is within two months from the gazette publication date."

(b) Trademark Searches and Determination of Similarity (Frequency: High)

In searches using J-PlatPat, it is tested that searches by pronunciation or concept can be performed. The point that even if the classes of goods and services differ, they are presumed to be similar in principle if the same "similarity group code" is attached is extremely frequently tested as a practical trap.

(c) Requirements for Establishment of Prior Use Rights (Frequency: Medium)

As a defense when receiving a warning from another company, a case study where whether prior use rights can be successfully established hinges on whether your company's trademark was "well-known" at the time of the opponent's "filing" is important.

(5) Copyright Act

The Copyright Act accounts for 23.75% (95 questions) in the written examination and 25.50% (102 questions) in the practical examination, standing alongside the Patent Act as one of the "two giants of the examination." Unlike the Patent Act or Trademark Act, because it has the characteristic that rights arise under the "principle of automatic protection (non-formalism)" without registration or application, it is very frequently tested through familiar troubles lurking in daily operations or SNS utilization.

A. Written Examination

In the written examination, the subject and content of rights—specifically "who holds what right"—and "cases permitted as exceptions" are directly tested.

(a) Types and Content of Rights (Frequency: Very High)

The details of "individual rights comprised in a copyright (property rights)" such as reproduction rights, public transmission rights, transfer rights, lending rights, and screening rights, as well as "moral rights of authors (right of making the work public, right of indicating the author's name, right of preserving integrity)" are tested. In particular, exceptions such as "distribution rights" applying to cinematographic works while "transfer rights" do not apply often become trick choices. It is important to first distinguish which rights are "property rights" and which rights are "moral rights." The point that moral rights of authors are exclusively personal and inalienable (cannot be transferred or inherited) is also an extremely frequent topic.

(b) Identification of Authors and Attribution of Rights (Frequency: Very High)

Requirements for "work made for hire (corporate copyright)" to be established (at the initiative of a corporation, creation in the course of duties, publication under the name of the corporation, etc.) are repeatedly tested. For a "joint work" involving multiple people, the point that unanimous consent is required to exercise rights is a staple. The distinction between the author (director, etc.) of a "cinematographic work" and the copyright owner (the maker of a cinematographic work, such as a movie company, based on a "contract to participate in production") is also a frequent theme, so it is highly recommended to keep these concepts organized.

(c) Neighboring Rights (Frequency: High)

These are rights of performers, record producers, broadcasting organizations, etc. The respective terms of protection for these rights are tested (in principle "70 years" from the performance or publication of the record, "50 years" for broadcasting; the start of the term for records is "when the sound is first fixed on the record").

(d) Limitations on Copyright (Frequency: High)

Requirements for a "quotation" to be established (conforming to fair practice, having a primary-subordinate relationship, and clearly indicating the source, etc.) are frequently tested.

B. Practical Examination

In the practical examination, concrete case studies (scenario-based questions) regarding corporate activities or individual internet use are tested.

(a) Rights Processing in Outsourcing and Contracts (Frequency: Very High)

When outsourcing the development of a promotional video or software to a production company, the issue that "the author and copyright holder remains with the production company (contractor)" unless there is a special provision is very frequently tested. Keeping in mind the practical rule that "just because you paid money does not automatically mean it becomes your company's right" makes it easier to choose the correct answer.

(b) Troubles on SNS, Video Streaming, and Internal Operations (Frequency: Very High)

The point that the act of filming a performance or recording background music with a smartphone and uploading it to a blog or SNS without permission constitutes an infringement of reproduction rights, public transmission rights, or performers' rights is tested. Additionally, problems that test whether the act of "copying someone else's illustrations or Supreme Court rulings without permission as meeting materials for all members" constitutes copyright infringement (outside the scope of private use) are also a staple. "Reproduction for private use" is strictly within "a limited scope such as oneself or one's family." It is good to remember that distribution at an internal meeting constitutes an infringement.

(c) Use of Music at Events, etc. (Commercial and Non-Commercial) (Frequency: Medium to High)

In live performances, etc., cases where one cannot perform a song without permission unless all three requirements are met— (i) not for commercial purposes, (ii) not charging a fee from the audience, and (iii) no remuneration is paid to the performers—are tested in scenarios.

(6) Treaties

Treaties account for 5.75% (23 questions) in the written examination and 7.50% (30 questions) in the practical examination. At first glance, this field seems difficult and tends to be avoided by examinees, but it is actually a field where the content and format tested are highly standardized, making it the most time-efficient area to turn into a secure source of points.

A. Written Examination

In the written examination, whether you can correctly link the "basic characteristics (subject matter)" of each treaty with its "principles and terms" is tested.

(a) Paris Convention (Fundamentals of Industrial Property) (Frequency: Very High)

The definitions of the three major principles of the Paris Convention—"principle of national treatment," "priority system," and "principle of independence of patents"—are tested. Regarding priority periods, trick questions regarding these numbers such as "12 months for patents and utility models" and "6 months for designs and trademarks" are a staple. It is best to clearly understand the powerful advantage of priority, where filing within 12 months from the first application made in a member country grants the same benefits (yields the same effect).

(b) Patent Cooperation Treaty / PCT (Frequency: Very High)

The timeline from international application to national procedures (national phase entry) in each country is tested.

It is very important to fully memorize the following numbers and keywords:

- 18 months: "International publication" takes place after 18 months have elapsed from the priority date.

- 30 months: The time limit for "national phase entry" for designated countries where acquisition of rights is aimed.

- International Search Report: Conducted for all international applications. It aims to discover relevant prior art and is sent to the applicant. A Written Opinion of the International Searching Authority is also created at the same time.

- Article 19 Amendment: Amendment of the claims is possible once.

- Article 34 Amendment: Amendments to parts other than the claims are also possible.

(c) Berne Convention (Fundamentals of Copyright) (Frequency: High)

The "principle of automatic protection," which requires no fulfillment of any formality for the subsistence of copyright, and the "principle of national treatment," which grants protection in member countries other than the country of origin of the work, are frequently tested.

(d) Other Treaties (Frequency: Medium to High)

The Madrid Protocol concerns the simplification of international registration procedures for "trademarks" (with a term of protection of 10 years). The point that a trademark registration application cannot be filed based on the PCT is tested. The Hague Agreement concerns "designs." For the TRIPS Agreement, the availability of the WTO (World Trade Organization) dispute settlement mechanism and the adoption of the principle of most-favored-nation treatment are tested.

B. Practical Examination

In the practical examination, questions on treaties are tested in the exact same format 10 times out of 10, as a "three-part fill-in-the-blank question in Question 6 of the latter half (Q35 to Q37)." It is an essential source of points.

(a) Fill-in-the-Blank in Conversation Format for PCT Applications (Frequency: Very High)

In the format of a conversation between an inventor and an IP department member, examinees are asked to fill in the blanks for the flow of procedures for a PCT application. It is good to be able to immediately provide standard answers such as "filing to the Japan Patent Office is possible in Japanese and English," "international publication is 18 months from the priority date (or international filing date)," and "national phase entry is 30 months from the priority date (or international filing date)."

(b) Matching Treaty Names (Frequency: High)

Questions in a conversation format asking examinees to link each treaty and its subject matter are also frequently tested, such as "What is handled by the WTO? (TRIPS Agreement)," "What is the international registration system for trademarks? (Madrid Protocol)," or "What is the international registration system for designs? (Hague Agreement)."

(c) Fill-in-the-Blank for Principles of the Paris Convention (Frequency: Medium)

The understanding of provisions is tested, such as "granting to nationals of other countries advantages which it now grants or may hereafter grant to its own nationals" for the principle of national

treatment and "patents applied for in different member countries for the same invention shall be independent of each other" for the principle of independence of patents.

(7) Unfair Competition Prevention Act

The Unfair Competition Prevention Act accounts for 2.75% (11 questions) in the written examination and 4.00% (16 questions) in the practical examination. Compared to the Patent Act or Copyright Act, the number of questions is small (around one or two questions per exam), but the themes tested are extremely limited, making it a "highly rewarding subject" that can surely be turned into a source of points with just a little preparation.

A. Written Examination

In the written examination, the "definition" of each type of unfair competition act or "requirements (trick questions)" for protection are directly tested.

(a) The Three Requirements of Trade Secrets and Pitfalls (Frequency: Very High)

The three requirements for protection as a trade secret—"secret management," "usefulness," and "non-public knowledge"—are frequently tested. The point that a choice stating "negative information such as past failure examples in product development does not constitute a trade secret because it lacks usefulness" is often presented, and this choice is "inappropriate." Failure data is also useful in business activities in the sense that "it can reduce the time and cost for other companies to avoid the same failure," and is subject to legal protection.

(b) Acts of Creating Confusion with Well-Known Indication (Frequency: High)

Acts of creating confusion by using another person's "well-known" indication of goods, etc., are tested. It is tested as a practical trick question that "well-known" here does not necessarily need to be famous nationwide, and it is sufficient if it is widely recognized in a single region. The point that even unregistered trademarks or designs can be subject to protection is also important.

(c) Acts of Commercial Disparagement (Frequency: Medium)

An act of commercial disparagement is an act of announcing or circulating false facts that injure the business reputation of another company in a competitive relationship. In examinations, a choice stating that "an act of announcing or circulating objective truths (true things) constitutes an act of unfair competition" is often presented, but this is "inappropriate." Please make sure to remember that what is regulated as an act of unfair competition is strictly limited to cases where "false facts (lies)" are circulated.

B. Practical Examination

In the practical examination, case studies requiring your judgment as a corporate IP department member are frequently tested, such as "how to fill a gap that cannot be covered by other intellectual property rights" under laws such as the Design Act or the Patent Act.

(a) Acts of Imitating the Configuration of Goods (Exclusion of Dead Copies) vs. Design Act

(Frequency: Very High)

Injunction cases concerning acts of selling products that exactly imitate the configuration of another company's product are frequently tested. Being able to receive protection even without a design registration is a strength, but the fact that there is a strict time limit where this act cannot be regulated unless it is "within three years" from the date it was first sold in Japan is often tested. The limitation that it does not apply (cannot exclude) in cases where another company did not copy it but arrived at a "coincidental resemblance" as a result of independent development is also a staple of questions.

(b) Patent Application vs. Trade Secret (Secretization) Strategy (Frequency: High)

Problems that require you to choose whether a newly developed technology should be patented or kept hidden inside the company as a trade secret are featured. The standard strategy is that "things whose structure can be easily understood by reverse-engineering a sold product" should be protected by filing for a patent, and "things used only inside a manufacturing factory whose manufacturing method cannot be understood from the finished product" should be protected as a trade secret. The practical trade-off is tested where, if a patent application is filed, the application will, in principle, be laid open one year and 6 months later, meaning that non-public knowledge will be lost from then on and protection as a trade secret can no longer be obtained.

(c) Comparative Advertising and Quality Misrepresentation Troubles (Frequency: Medium to High)

Scenarios where a company compares its own product with a rival company's product and broadcasts commercials or advertisements stating "our company is superior" based on false experimental results are tested. Such acts fall under quality misrepresentation or commercial disparagement, and the point that the side that suffered damage can demand not only compensation for damages but also "measures to restore business reputation (apology advertisements, etc.)" is tested.

(8) Antimonopoly Act

The Antimonopoly Act has an extremely skewed percentage of questions, accounting for 2.75% (11 questions) in the written examination and 0.00% (0 questions) in the practical examination. In other words, an iron rule exists where "it is never tested in the practical examination, and exactly one question is always asked in the written examination." The themes tested are also almost completely narrowed down to "unfair trade practices in patent licensing agreements," and questions where 1 point can surely be secured with minimal preparation are tested.

A. Written Examination

In the written examination, prohibited clauses (unfair trade practices) in licensing agreements based on the "Guidelines for the Use of Intellectual Property under the Antimonopoly Act (IP Guidelines)" ^(Note 11) and basic relief measures of the Antimonopoly Act are directly tested. By

mastering the following three themes, you can cover almost all past questions.

(a) "Black Clauses" in Licensing Agreements (Frequency: Very High)

The point that the following clauses, which unfairly bind the business activities of a licensee and hinder market competition, are "problematic (violating)" under the Antimonopoly Act is frequently tested.

- **Restrictions on Sales Price:** A licensor restricting the sales price of a licensed product is, without exception, problematic. It appears as a choice almost every single time across the past 10 examinations.

- **Restrictions on Research and Development:** Prohibiting a licensee from developing competing technology themselves or conducting joint research and development with a third party is problematic.

- **Restrictions After Expiration of Patent Rights:** Restricting the use of technology or imposing an obligation to pay royalties despite the fact that the duration of the patent right has expired is problematic.

- **Attribution of Rights for Improved Inventions (Grant-Back):** Obligating a licensee to attribute rights to the licensor or grant an exclusive license regarding an improved invention completed by the licensee is problematic.

(b) Clauses "Unlikely to Be Problematic (White Clauses)" (Frequency: High)

As a counterpart to black clauses, questions asking you to choose "acts with a low possibility of falling under unfair trade practices under the Antimonopoly Act" are also a staple.

- **Restrictions on Export Regions and Sales Regions:** Restricting the regions where a licensed product can be exported or sold is considered less likely to be problematic compared to price restrictions.

(c) General Rules and Relief Measures of the Antimonopoly Act (Frequency: Medium)

- **Subject of Reporting:** Regarding facts suspected of violating the Antimonopoly Act, not only interested parties but "anyone" can report to the Fair Trade Commission and seek measures. A trick stating that it is limited to interested parties is tested.

- **Relief for Victims:** In addition to cease and desist orders or surcharge payment orders by the Fair Trade Commission, it is also possible for an affected party to file civil "claims for an injunction" or "claims for damages."

- **Misconception of Private Monopolization:** If a single company monopolizes a market simply through legitimate corporate efforts such as "supplying superior products cheaply," it does not fall under illegal private monopolization.

B. Practical Examination

Over the past 10 practical examinations (400 questions in total), there has been no question at all with the Antimonopoly Act as the main theme. Because the practical examination prioritizes daily troubleshooting in corporate IP departments (such as imitation countermeasures or conflicts with

other companies' trademarks), advanced legal matters like competition law violations in licensing are customarily tested exclusively in the written examination. Therefore, preparation for the Antimonopoly Act directed toward the practical examination can be said to be unnecessary. Even in the unlikely event that it is tested, preparation for the written examination can sufficiently enable handling such issues should they arise.

(9) Plant Variety Protection and Seed Act

The Plant Variety Protection and Seed Act accounts for 2.50% (10 questions) in the written examination and 2.50% (10 questions) in the practical examination. As you can see from the numbers, an extremely regular rule exists where "exactly one question is always tested in both the written and practical examinations each time." Because the issues tested are also completely fixed in a rotation of a few patterns, two points (one point each for the written and practical examinations) can surely be secured with minimal preparation.

A. Written Examination

In the written examination, "requirements for variety registration" based on the Plant Variety Protection and Seed Act and the "duration (a common trick involving patents)" are directly tested.

(a) Tricks Involving Duration (Frequency: Very High)

The duration of a breeder's right is in principle "25 years from the date of variety registration" for general plants, and "30 years" for perennial plants such as fruit trees (if a bill to amend the Plant Variety Protection and Seed Act submitted in April 2026 passes, the duration of intellectual property rights (breeder's rights) for new varieties is scheduled to be extended by 10 years uniformly, expanding to 35 years for general plants and 40 years for perennial plants such as fruit trees and forest trees). Tricks designed to confuse this with patent rights, such as stating it is "20 years from the filing date" or that "an extension system for the duration exists (when it actually does not)," frequently appear. Remember: "25 years / 30 years from the registration date, with no extension."

(b) Requirements for Variety Registration (Frequency: Very High)

Because there is no requirement corresponding to the "inventive step" of a patent, a plausible option stating that "a variety cannot be registered unless it is superior to existing varieties" is frequently presented, and this choice is "inappropriate." Instead, what is required is that it can be clearly distinguished from existing varieties by its characteristics (distinctness).

(c) Requirement of Non-Assignment (Frequency: High)

As a requirement for novelty, if the seeds or seedlings of the applied variety have been "assigned as a business in Japan prior to the day tracing back one year from the filing date," in principle, the variety cannot be registered. Conversely, if it is within one year from assignment, application is possible.

B. Practical Examination

In the practical examination, a case study asking "whether the scope of a breeder's right extends to the act (whether it constitutes an infringement) when a third party uses a registered variety without permission" is tested.

(a) Scope of Effect and Limitations of Breeder's Rights (Frequency: Very High)

Whether infringement is established in the following three cases is tested in a rotation.

- Use for Trial and Research: Acts of using for research or trials for breeding new varieties do not fall under the effect of a breeder's right (no infringement).

- Self-Propagation: Due to legislative amendments, the act where a farmer uses a part of the harvest obtained from legitimately purchased seeds or seedlings for the next crop season (self-propagation) has in principle come to fall under the effect of a breeder's right (doing it without permission constitutes infringement).

- Exhaustion of Rights: Acts of purchasing seeds or seedlings legitimately sold and simply reselling (assigning) them as they are do not in principle fall under the effect (no infringement).

(b) Intersection with the Patent Act (Frequency: Medium to High)

New varieties of plants may be protected under both the Patent Act (invention) and the Plant Variety Protection and Seed Act (variety registration) if the respective requirements are met.

(c) Tricks Involving Procedural Time Limits (Frequency: Medium)

A fake rule stating that "an application must be filed within one year after completing the breeding of the said variety" is frequently tested as a trick option. There is no particular time limit for filing an application (please do not confuse it with the aforementioned "within one year from assignment").

(10) Other Legal Areas, etc. (Civil Code, Customs Act, Patent Attorney Act, etc.)

The "Others" category includes peripheral regulations such as the Civil Code, Customs Act, and Patent Attorney Act, as well as recent IP management trends like IP Landscape, Corporate Governance Code, and Foreign Exchange and Foreign Trade Act (FEFTA). Accounting for 11.50% (46 questions) in the written examination and 5.00% (20 questions) in the practical examination, it is an important source of points that can be called the "fourth subject," with more questions than the Utility Model Act, Design Act, or Treaties. Although the themes tested are wide-ranging, the issues tested are very frequently recycled from past exams, so it is most efficient to focus your preparation on the following six important themes.

(a) IP Landscape (Frequency: Very High)

The point that this is the IP management trend most emphasized in recent 2nd Grade IPMST examinations is always tested in both written and practical examinations.

- Purpose and Target Audience: Rather than passive purposes like "not failing in research and development" or completion within an IP department, questions frequently focus on the fact that it is

for "formulating active corporate strategies and business strategies" to be "presented to management executives and business managers."

- Utilization Scenarios: Scenarios using it for exploring candidate companies for M&A or selecting alliance partners (cooperation partners) are tested.

- Information Sources: The point that "IP information" such as patent information and "non-IP information (business information)" such as marketing and stock market trends and financial data are integrated and analyzed is tested.

(b) Civil Code (Manifestation of Intent and Contracts) (Frequency: High)

This is basic knowledge of the Civil Code forming the bedrock of IP licensing or assignment contracts. There is no need to study deeply; just master the tested keywords.

- Defects in Manifestation of Intent: It is important to remember that a manifestation of intent based on "mistake," "fraud," or "duress" can be rescinded, while a "collusive false manifestation of intent" made in collusion with the other party is "void."

- Non-performance and Rescission of Contracts: Questions frequently test the point that when a contract is "rescinded" due to the other party's non-performance of obligations, the contract loses its effect retroactively (retroactive effect).

(c) Customs Act (Border Enforcement) (Frequency: High)

Procedures at customs to prevent counterfeit and pirated goods from flowing into the country.

- Subject and Authority of Control: When the Director-General of Customs determines that goods fall under intellectual property infringing goods, they can "confiscate and destroy" those cargos. Be careful of trick options concerning whether ordering reshipment (sending back) is possible (appropriate) or impossible (inappropriate).

- Subjects of Protection: Questions frequently test the point that not only patent rights, design rights, trademark rights, and copyrights, but also goods infringing "neighboring rights" are included in the subjects of control.

- Procedure for Hearing Opinions: In determination procedures, patent right holders, etc., can request the Director-General of Customs to "seek the opinion of the Commissioner of the Japan Patent Office."

(d) Patent Attorney Act (Scope of Exclusive Services) (Frequency: Medium)

Questions frequently test the distinction between services restricted to patent attorneys (exclusive services) and services that anyone can perform.

- Exclusive Services: "Representation in application procedures" for patents, designs, or trademarks before the Japan Patent Office or "representation of trials for patent invalidation" are exclusive services of patent attorneys, etc. (= patent attorneys, patent attorney corporations, attorneys-at-law, legal corporations).

- Non-exclusive Services: Mere "procedures for paying patent fees (or design registration fees)"

can be conducted as a business even without being a patent attorney, etc. This "payment procedure" is a classic trick option. Note that the "renewal procedure (application for renewal registration of duration)" under the Trademark Act becomes an exclusive service. It is helpful to remember a simple rule: while mere "payment" of money can be done by anyone, if the word "application" is attached, it becomes an exclusive service of patent attorneys, etc.

- Payment procedure for ○○ = Can be done by anyone (Non-exclusive service)
- Application, Request and Trial for ○○ = Restricted to patent attorneys, etc. (Exclusive Service)

(e) Corporate Governance Code (Frequency: Low to Medium)

Guidelines outlining how listed companies should approach IP investment. Questions frequently test the points that the board of directors should oversee investments in intellectual property, and that "information regarding investments and strategies of intellectual property should be disclosed," including IP Landscape activities.

(f) Foreign Exchange and Foreign Trade Act (FEFTA) (Frequency: Low to Medium)

The FEFTA has a basic structure of "free in principle, with restrictions as exceptions." You can ensure maximum scores by mastering points such as catch-all controls (end-use and end-user requirements), differences from list controls, and the fact that provision of technology is also treated as export. Studying past exam questions will give you peace of mind.

(11) Summary

The recent pass rate of the 2nd Grade IPMST (conducted in March 2026) was 45.0% for the written examination and 31.4% for the practical examination, showing that it is by no means an easy certification exam. The largest key to passing is consolidating the fundamentals of the "Patent Act" and "Copyright Act," which account for approximately 55% or more of the questions. In the Patent Act, accurate understanding of procedural time limits and employee inventions, and in the Copyright Act, requirements for the establishment of works made for hire and limitation provisions (such as quotations or private use), are the deciding factors between passing and failing. In the practical examination, issues exist where question patterns are completely fixed. Period calculations under the Trademark Act (within two months from gazette publication, etc.), fill-in-the-blank for PCT procedures of treaties, and calculation problems for patent fees are sources of points that can absolutely must be remembered. Furthermore, peripheral fields such as the Unfair Competition Prevention Act (the three requirements of trade secrets, etc.), the Plant Variety Protection and Seed Act (durations of 25 years / 30 years), and the IP Landscape which is a recent trend, have extremely limited themes tested. Repetitive practice of past exam questions is the royal road to securing high scores with minimal effort.

6. Conclusion

Passing the 2nd Grade IPMST is by no means the goal. We believe that having secretaries equipped with specialized knowledge proceed with practical operations in perfect unison with patent attorneys improves the accuracy and speed of procedures, and is directly related to providing higher quality services to our clients. We will continue to further raise the underlying strength of Fukami Patent Office, P.C. through this study group, and support the clients' businesses and precious intellectual property with our utmost dedication.

(Notes)

(1) "Intellectual Property Management Skills Test," "Intellectual Property Test," "IPMST," and "Certified Specialist of Intellectual Property Management" are registered trademarks of the Foundation for Intellectual Property.

(2) National Examination: Intellectual Property Management Skills Test®

[<https://www.kentei-info-ip-edu.org/>]

(3) Foundation for Intellectual Property "History"

[<http://fdn-ip.or.jp/aboutus/fip/history/>]

(4) Association of Intellectual Property Education "(Old) Intellectual Property Test® / Special Training Course"

[<https://ip-edu.org/archive>]

(5) INPIT (National Center for Industrial Property Information and Training) "The 10th Anniversary of Intellectual Property Management Skills Test®"

[<https://www.inpit.go.jp/content/100867047.pdf>]

(6) LEC Tokyo Legal Mind "Exam Overview - Intellectual Property Management Skills Test®"

[<https://www.lec-jp.com/chizai/about/>]

(7) Cabinet Office "Intellectual Property Strategic Program 2025"

[https://www.cao.go.jp/press/new_wave/20250826.html]

(8) Cabinet Secretariat "Intellectual Property Strategy Headquarters"

[<https://www.cas.go.jp/jp/seisakukaigi/titeki2/index.html>]

(9) "Top 50 Companies and Organizations with the Highest Number of Applicants for the Intellectual Property Management Skills Test®"

[https://www.kentei-info-ip-edu.org/exam_kekka_dantai]

(10) "Major Companies Recommending the Intellectual Property Management Skills Test®"

[https://www.kentei-info-ip-edu.org/exam_kekka_dantai#kigyuu_02]

(11) Japan Fair Trade Commission "Guidelines for the Use of Intellectual Property under the Antimonopoly Act (IP Guidelines)"

[<https://www.jftc.go.jp/dk/guideline/unyoukijun/chitekizaisan.html>]

Expectations for the Deepening of the Arguments on Goods and Services in the Japanese Trademark System

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1. Introduction

It is widely known that the scope of a trademark right is determined by the combination of a registered trademark and its designated goods and services. In this paper, discussions regarding the similarity, distinctiveness, identity, and other aspects of trademarks will be referred to as the "Arguments on Trademarks," and discussions regarding the similarity, appropriateness of indications, categories, and other aspects of goods and services will be referred to as the "Arguments on Goods and Services."

As a practitioner specializing primarily in trademark practice, I have the impression that while discussions are relatively active about the Arguments on Trademarks in Japan, the Arguments on Goods and Services is comparatively underdiscussed. Of course, this does not mean that there is no discussion about goods and services, as evidenced by examples shown in (1) through (3) below. However, given that goods and services are critical elements concerning the scope of trademark rights, I believe this area deserves more active discussion.

[Examples of the Arguments on Goods and Services]

(1) Court decisions in which the contents and nature of goods and services were contested (e.g., the "ARIKA" case, where the meaning and contents of a service "providing information concerning commercial sales" were contested (judgment of Supreme Court, 2009, (Gyo Hi) No. 217))

(2) Cases of trial decisions, etc., in which goods and services were determined to be dissimilar despite having the same similar group codes (e.g., the trial decision in which "archery implements" (similar group code: 24C01) and "golf equipment" (similar group code: 24C01) were regarded as dissimilar (Appeal No. 2019-7187))

(3) Discussions accompanying the introduction of new systems and concepts (e.g., the publication of the "Guidelines for Designated Goods and Services Related to Virtual Environments and Non-Fungible Tokens (NFTs)" by the Japan Patent Office (JPO) (dated March 29, 2024))

However, the need for active discussion regarding goods and services within the trademark system should not be confined to exceptional cases contested in courts or trials, or novel cases involving new systems and concepts, as seen in the examples above. It is required even at the level of daily practice. From this point of view, this paper will examine several points below.

2. Issues Related to the Examination Guidelines

In our daily trademark practice as patent attorneys -who act as intellectual property agents- it is essential to understand and refer to the Examination Guidelines published by the JPO. Main parts related to the Arguments on Goods and Services include: the descriptions of "Regarding the judgment of the similarity of goods or services" (specifically, "Regarding the similarity of goods," "Regarding the similarity of services" and "Regarding the similarity of goods and services") in item "Article 4(1)(xi) (Another person's registered trademark applied for prior to the filing date of the trademark application concerned)," and the descriptions of the item "Article 6 (Single trademark on each application)" in the "Examination Guidelines for Trademarks" compiled by the JPO; and the "Examination Guidelines for Similar Goods and Services" compiled by the JPO. The "Examination Guidelines for Similar Goods and Services" is essentially a system that organizes similarity relations using the concept of "similar group codes," so that the criteria for judging the similarity of goods and services in the "Examination Guidelines for Trademarks" can be easily applied at a practical level.

According to the "Examination Guidelines for Similar Goods and Services," the similar group codes are defined as "the published codes for designated goods and services that are presumed to be similar to each other, categorized as 'a group of similar goods' or 'a group of similar services,'" and "are used to check for the following: 'prior applications/existing registrations,' 'amendments of designated goods or services to eliminate any reasons for refusal,' and 'determination of rights infringements of another person's registered trademark,' etc." While countries and regions that

adopt systems resembling the similar group codes, such as China, South Korea, and Taiwan, are well known outside of Japan, they are relatively few from a global perspective. Consequently, similar group codes are an important concept characterizing the Japanese trademark system. Thus, we frequently refer to the "Examination Guidelines for Similar Goods and Services" in our day-to-day trademark practice.

However, while the "Examination Guidelines for Similar Goods and Services" is highly useful in practice, there are points to keep in mind regarding its use from the perspective of the Arguments on Goods and Services. Several such examples are discussed below.

Example 1: Regarding "Cases for Smartphones" (Class 9)

"Cases for smartphones" are interpreted as accessories for smartphones, and are assigned the same similar group codes 11B01 and 11C01 as "smartphones" themselves.

The issue here is that the "Examination Guidelines for Similar Goods and Services" contains the following description:

携帯情報端末		personal digital assistants	1 1 B 0 1	1 1 C 0 1
国際分類表 [2, 7 類]				
1	携帯情報端末	personal digital assistants		
	腕時計型携帯情報端末	personal digital assistants in the shape of a watch		
	スマートフォン	smartphones	N	090719
2	携帯情報端末の部品及び附属品	parts and accessories for personal digital assistants		
	携帯情報端末用カバー	covers for personal digital assistants		
	携帯情報端末用ケース	cases for personal digital assistants		
	携帯情報端末用ストラップ	straps for personal digital assistants		
	スマートフォン用カバー	covers for smartphones	N	090740
	<u>スマートフォン用ケース</u>	cases for smartphones	N	090741
	スマートフォン用ストラップ	straps for smartphones		

Source: "Examination Guidelines for Similar Goods and Services" compiled by the JPO

In Class 9, "personal digital assistants" are listed as the heading indication (enclosed in a solid-line rectangle) for similar group codes 11B01 and 11C01, and "1. personal digital assistants" and "2. parts and accessories for personal digital assistants" are listed as items included therein. It is understood that "smartphones" are goods belonging to the category of "personal digital assistants," and "cases for smartphones" are goods belonging to the category of "parts and accessories for personal digital assistants." According to the "Explanatory Notes on the Classification of Goods

and Services" compiled by the Trademark Division of the JPO, it is explained, regarding "personal digital assistants" (11B01, 11C01), that "this item includes goods such as 'personal digital assistants in the shape of a watch,' 'smartphones,' and 'parts and accessories for personal digital assistants.'"

In other words, according to the "Examination Guidelines for Similar Goods and Services," "cases for smartphones," i.e., "parts and accessories for personal digital assistants," are included in "personal digital assistants." In short, "cases for smartphones" end up being treated as a subordinate concept of "personal digital assistants." However, this is illogical when considering the actual nature of the goods, because "personal digital assistants" are the devices themselves, and they never include cases for them within their concept of goods.

Suppose that an applicant wishing to protect the goods "cases for smartphones" files a trademark application and acquires a registered right based on the above description in the "Examination Guidelines for Similar Goods and Services," assuming that the goods will be sufficiently protected by designating only "personal digital assistants," which is the heading indication, because "personal digital assistants" are a superordinate concept of "cases for smartphones." What problems might arise in such a scenario?

In principle, the scope of goods and services covered by a trademark right should be interpreted based on the wording of the goods and services. From this standpoint of strict literal interpretation, given that the registered indication of the designated goods is "personal digital assistants," the goods refer to the devices themselves, regardless of how the wording of the goods is interpreted. Therefore, it must be concluded that there is no room to include "cases for smartphones." According to the "Examination Guidelines for Similar Goods and Services," "personal digital assistants" and "cases for smartphones" are assigned the same similar group codes, and there is no dispute that they are similar to each other. However, they have no inclusion relation (relation of superordinate concept-subordinate concept). Consequently, it is considered that, while such goods may be protected under a prohibitive right within the similar scope, they remain unprotected under an exclusive right within the identical scope.

Under these circumstances, what would happen if a third party files a request for a trial for revocation for non-use of registered trademarks in order to revoke the trademark registration for the designated goods "personal digital assistants"? As long as the right holder manufactures and sells "cases for smartphones," they will be able to submit evidence of use regarding such goods. However, can such evidence of use of "cases for smartphones" successfully maintain the registration

for the designated goods "personal digital assistants"? At the trial stage before the JPO, the two might be treated as having inclusion relation based on the "Examination Guidelines for Similar Goods and Services." In a suit against the trial decision, however, if the plaintiff challenges the decision by arguing that there is literally no room for the indication of goods "personal digital assistants" to include "cases for smartphones," there may be a significant risk that the registration will be revoked on the grounds that it does not constitute use under the exclusive right.

Therefore, to ensure protection for the goods "cases for smartphones," the applicant must not be swayed by the description of the "Examination Guidelines for Similar Goods and Services," but should proactively specify "cases for smartphones" themselves as the indication of the designated goods.

Additionally, to prevent such misunderstandings, the heading indication in the "Examination Guidelines for Similar Goods and Services" should be revised to something like "personal digital assistants, and parts and accessories therefor."

Example 2: Regarding "Computer Programs" (Class 9)

While this case is similar to Example 1 above, this section examines "computer programs." The relevant description in the "Examination Guidelines for Similar Goods and Services" is as follows:

電子応用機械器具及びその部品		11C01	11C02
電子応用機械器具（「ガイガー計数器・サイクロトロン・産業用X線機械器具・産業用ベータートロン・磁気探鉱機・磁気探知機・地震探鉱機械器具・水中聴音機械器具・超音波応用測深器・超音波応用探傷器・超音波応用探知機・電子応用扉自動開閉装置・電子顕微鏡」を除く。）		11C01	
電子管	electron tubes		
半導体素子	semi-conductor elements		
電子回路（「電子計算機用プログラムを記憶させた電子回路」を除く。）	electronic circuits, not including those recorded with computer programs		
<u>電子計算機用プログラム</u>	computer programs		

国際分類表 [2 類]

ガイガー計数器	geiger counters	1 1 C 0 2
サイクロトロン	cyclotrons, not for medical purposes	
産業用X線機械器具	industrial X-ray machines and apparatus, not for medical use	
産業用ベータートロン	industrial betatrons, not for medical use	
磁気探鉱機	magnetic prospecting machines	
磁気探知機	magnetic object detectors	
地震探鉱機械器具	seismic exploration machines and apparatus	
水中聴音機械器具	hydrophone machines and apparatus	
超音波応用測深器	echo sounders	
超音波応用探傷器	ultrasonic flaw detectors	
超音波応用探知機	ultrasonic sensors	
電子応用扉自動開閉装置	electronic door opening and closing control systems	
電子顕微鏡	electron microscopes	

国際分類表 [7 類]

Source: "Examination Guidelines for Similar Goods and Services" compiled by the JPO

The "Examination Guidelines for Similar Goods and Services" states that "the scope of a comprehensive concept indication that groups together a plurality of groups of similar goods (services)" is enclosed in a dash-dotted line box. In other words, in the above, "electronic machines, apparatus and their parts" serve as a comprehensive concept indication that comprehensively includes their subordinate concepts. Given the heading indication "electronic machines and apparatus [not including geiger counters, cyclotrons, industrial X-ray machines and apparatus, industrial betatrons, magnetic prospecting machines, magnetic object detectors, seismic exploration machines and apparatus, hydrophone machines and apparatus, echo sounders, ultrasonic flaw detectors, ultrasonic sensors, electronic door opening and closing controls systems and electron microscopes]," it is understood that "parts of electronic machines and apparatus" would correspond to items such as "electron tubes," "semi-conductor elements," "electronic circuits [not including those recorded with computer programs]," and "computer programs."

However, a question may arise as to whether "computer programs" can be called as "'parts' of electronic machines and apparatus" (note: according to the Kojien dictionary published by Iwanami Shoten, a "part" is an abbreviation for a "component part" and is defined as "an item that constitutes a certain portion of a machine"). In this regard, as with the example of "cases for smartphones" mentioned above, if the goal is to protect "computer programs," rather than simply specifying "electronic machines, apparatus and their parts" just because it is the comprehensive concept indication, one should proactively specify "computer programs" as the designated goods so

that no question arises in terms of literal interpretation.

Example 3: Regarding Filing of Foreign Applications Based on Japanese Applications/Registrations

Although this strays from the topic of applications and registrations in Japan, it is common practice to claim priority under the Paris Convention or file an international application under the Madrid Protocol based on a Japanese application or registration. In such cases, the designated goods and services in Japan need to be appropriately translated into English or other applicable languages. As the designated goods and services of the basic Japanese application or registration are often listed based on the "Examination Guidelines for Similar Goods and Services," certain precautions may be required in practice.

As an example, if Class 25 "clothing," which is a comprehensive concept indication in the "Examination Guidelines for Similar Goods and Services," is designated for a Japanese application/registration, it may not be appropriate to simply translate it to "clothing" in English for foreign applications. In China, for example, the Chinese indication of goods "服装," which corresponds to "clothing," does not include items such as "短袜(socks)," "长袜(stockings)," "手套 (服装) (gloves [clothing])," "连指手套(mittens)," and "帽 (头戴物) (headwear)," and these items are not even considered to be similar to "服装." This shows that while the comprehensive concept indication "clothing" includes "socks," "gloves," "headwear" and the like according to the "Examination Guidelines for Similar Goods and Services" in Japan, such conceptual inclusion relations do not necessarily hold true in other countries.

As another example, if Class 18 "bags, pouches," which is a heading indication in the "Examination Guidelines for Similar Goods and Services," is designated for a Japanese application/registration, it may not be appropriate to simply translate it to "bags; pouches" in English for foreign applications. A question may arise as to whether the English concept of "bags" includes items such as "suitcases" and "trunks." Furthermore, it seems highly likely that the English concept of "pouches" does not include items such as "card cases [notecases]," "key cases," "wallets," and the like. Although the heading indication "bags, pouches" includes "suitcases," "trunks," "card cases [notecases]," "key cases," "wallets" and the like according to the "Examination Guidelines for Similar Goods and Services" in Japan, if the heading indication cannot be appropriately translated to include its conceptual category, a situation could arise where the intended goods fail to be covered.

In other words, even if the inclusion relations of goods and services are explicitly specified

in the Japanese "Examination Guidelines for Similar Goods and Services," it is necessary to bear in mind that the same relations may not apply depending on the practices of other countries or the concepts of the translated terms. To avoid such situations, it may be advisable to consult with foreign associates in advance, as necessary, regarding local practices concerning the concepts and categories of indications of goods and services. As a fundamental approach, in cases where doubts still remain as to whether the goods and services are covered even after examining appropriate translated terms, it would be desirable to proactively specify the goods and services intended for protection in English or other applicable languages.

What we have discussed above is merely an example of precautions to be taken related to the "Examination Guidelines for Similar Goods and Services." Given that the Guidelines are of high importance for us trademark practitioners to refer to on a daily basis, it is necessary to be aware that there are certain matters requiring a degree of caution when utilizing the Guidelines to consider the indications of goods and services for filing. First and foremost, one must always bear in mind that the "Examination Guidelines for Similar Goods and Services" is merely an examination standard for the JPO, and the scope of a trademark right should, in principle, be determined in accordance with the literal wording of indications of the designated goods and services.

3. Issues Related to the JPO's Examination Operations

In trademark practice, goods and services are classified into 45 classes according to the Nice Classification. Regarding this classification, the Japan Trademark Act stipulates that goods or services "shall be designated in accordance with the classification of goods and services specified by cabinet order" (Article 6(2)), and that "the class of goods and services" specified by cabinet order "shall not be perceived as prescribing the scope of similarities of goods or services" (Article 6(3)). However, in determining the scope of a trademark right, it remains somewhat unclear to what extent or in what manner the class of designated goods and services is taken into consideration.

For example, "sanitary masks" are currently classified as Class 10 goods. According to the "Examination Guidelines for Similar Goods and Services" compiled by the JPO, however, they had been categorized under Class 5 until December 31, 2021. Such changes in the classification of goods are a relatively common occurrence. If an application for "sanitary masks" is filed in Class 5 under the current practice, the application would obviously receive a Notification of Reasons for

Refusal for failing to meet the requirements of Article 6(2) of the Trademark Act. However, what would happen if the examiner overlooked this and mistakenly registered the "sanitary masks" in Class 5? While Article 6(2) of the Trademark Act constitutes a reason for refusal, it does not constitute a reason for opposition or invalidation; therefore, it naturally does not fall under any reasons that would render the trademark right invalid. Since the contents and scope themselves are clear with the indication of the designated goods being "sanitary masks," the scope of the trademark right should undoubtedly be determined without being bound by its classification in any way. In other words, a trademark right ought to be interpreted with greater emphasis placed on the indication itself of the goods and services rather than on the classification.

On the other hand, under the JPO's current practice, it is stipulated that "In cases where there is no description of the materials or use, etc. with regard to the designated goods or services described in the application but the materials or use, etc. can be specified by taking the classification into consideration, such application for trademark registration is determined to satisfy the requirements provided in Article 6(1) or (2)" (46.01 "Administration of Examinations of Designated Goods or Services" of the Trademark Examination Manual). The JPO has adopted this stance since March 2021, based on the position that "The meanings of the goods or services designated in an application can be interpreted by taking into consideration information such as the name of the class set forth in the appended table of the Order for Enforcement of the Trademark Act, which has been provided in accordance with the International Classification, the contents and characteristics of the goods or services that are categorized under that class, and the explanation on the goods or services indicated in the explanatory notes of the list of classes constituting the International Classification. Therefore, if an indication of designated goods or services does not include a description of the materials or use, etc., but the materials or use, etc. can be specified by taking the classification into consideration, it is reasonable to consider such indication to be a clear indication of goods or services, and there would be no problem in adopting such an interpretation."

As an example, for applications filed on or after January 1, 2020, the conventional Class 30 "sweets, confectionery and snacks" are divided, depending on its main ingredients, into Class 29 "fruit-based, vegetable-based, bean-based or nut-based snacks" and Class 30 "sweets, desserts and snacks other than fruit-based, vegetable-based, bean-based or nut-based" (note that it is currently divided into Class 29 "snacks based on foodstuffs of animal origin, as well as vegetables and other horticultural comestible products which are prepared or preserved for consumption" and Class 30

"sweets, confectionery and snacks [other than snacks based on foodstuffs of animal origin, as well as vegetables and other horticultural comestible products which are prepared or preserved for consumption].") However, under the JPO practice described above, if an application is filed now with the indication of Class 30 "sweets, confectionery and snacks," it will likely be registered as is under the said indication of goods without receiving any refusal, on the grounds that considering the class makes it clear that they are "other than snacks based on foodstuffs of animal origin, as well as vegetables and other horticultural comestible products which are prepared or preserved for consumption." A review of past registrations over the last five years or so reveals numerous cases where the indication "snacks" or "sweets, confectionery and snacks" alone has been registered under Class 29 or Class 30. This suggests that the JPO operates based on the judgment that the scope of goods and services can be specified by taking the class into consideration, and has actually accumulated a substantial track record of examinations based on this stance.

However, from the perspective of those engaged in daily trademark practice, the inability to identify the scope of protection solely by the wording of the indication of goods and services poses a problematic issue. For example, suppose you are considering requesting a trial for revocation for non-use of registered trademarks against a registered trademark designating Class 30 "sweets, confectionery and snacks." If a usage investigation of the trademark in question reveals that the trademark is used only for "potato-based snacks" (currently classified under Class 29), the determination of whether it can be revoked depends on when the trademark in question was filed. This is because, even with the exact same indication of designated goods, Class 30 "sweets, confectionery and snacks," the scope of the goods varies depending on when the application was filed.

Although this is just one example, my concern is that, if the scope of goods and services cannot be determined without taking the classification into consideration in this manner, the task of specifying the scope of a trademark right will be extremely complex and cumbersome in practice, thus potentially obscuring the very scope of the trademark right. This is because the classes are by no means permanently fixed from the past into eternity, and it is not uncommon for certain goods and services to be moved from one class to another. Even the JPO acknowledges this reality. A footnote of the relevant section of the Examination Manual states that "It should be noted that the contents and scope of goods and services belonging to each class may be changed frequently as the 'Alphabetical List of the International Classification of Goods and Services' based on the Nice

Agreement is revised annually."

Considering that a trademark right is a highly powerful exclusive right with a significant impact on others' economic activities, the scope of such a right should be as clear as possible. In this regard, the ideal approach for designated goods and services would be to interpret them based on the wording of their indications as a fundamental principle, and to refer to the classification only if ambiguity still remains. It should be noted that establishing a trademark right that must be interpreted by also taking its classification into consideration from the very beginning could potentially complicate subsequent interpretations of the right.

It appears that the JPO's examination operations regarding goods and services have a strong tendency to judge that the requirements of Articles 6(1) and (2) of the Trademark Act (i.e., the clarity of the indication of goods and services as well as the correctness of classification) are satisfied once the similar group codes can be identified. However, from the perspective of securing a well-defined right, greater focus should be placed on ensuring that no ambiguity arises solely from the wording of the indication of goods and services.

4. Issues Related to the Distinction Between the Concepts of Goods and Services

The restaurant business was among the hardest hit economically by the COVID-19 pandemic a few years ago. Facing severe restrictions on in-person dining, many restaurants that had not previously offered take-out services attempted to maintain their business operations by providing food and beverages available for take-out as an alternative to their in-store services.

Traditionally, the Japan Trademark Act interprets goods as defined as "objects that can be the subject of commercial transactions, especially personal property," that possess "marketability," and interprets services as "the act of providing labor or benefits to others which can in itself be the object of commercial trade." Applying this interpretation to food and beverages, the act of providing them in a store has been interpreted as "services," while take-out items have been interpreted as "goods" on the grounds that they possess marketability. In accordance with this interpretation, food provided basically as a dine-in option needs to be protected as a service under "providing food and beverages" (similar group code: 42B01) in Class 43. On the other hand, food provided as a take-out option needs to be protected as goods under "boxed lunches" (similar group code: 32F06), "hamburgers, sandwiches, pizzas" (similar group code: 30A01) and the like in Class 30. Furthermore, if beverages are served alongside the food, it may be required to protect them

under "carbonated drinks [refreshing beverages], fruit juices" (similar group code: 29C01) in Class 32, "coffee" (similar group code: 29B01), "tea" (similar group code: 29A01) and the like in Class 30. According to the "Examination Guidelines for Similar Goods and Services," however, no similarity is presumed between these goods and services, and they are basically treated as non-similar goods and services.

However, can this truly be considered a reasonable distinction from the perspective of business owners who actually operate restaurants? For example, if a business owner who has traditionally managed a restaurant decides to offer not only dine-in but also take-out services, the very same dishes served inside the restaurant are often packed into take-out containers. In such cases, the take-out service is not entirely separated from the restaurant service, but should rather be regarded as an extension of it.

Incidentally, under the Nice Classification, which sets international standards for the classification of goods and services, the service indication "take-away restaurant services" is listed under Class 43 in its "Alphabetical List of Goods and Services." The JPO has published, as a translation of this indication, "レストランにおける持ち帰り可能な飲食物の提供" (literally, "providing food and beverages available for take-out at a restaurant") in the "International Classification Table of Goods and Services" compiled by the Trademark Division of the JPO. However, this translated phrase in Japanese is deemed unacceptable as an indication of designated services in Japan^[1]. This is presumably because, in accordance with the aforementioned distinction between goods and services in Japan, the "food and beverages available for take-out" themselves in the translated phrase are regarded as marketable goods, and therefore, even if they are "provided" "at a restaurant," it is not considered to qualify as a service.

However, one could argue that this indication in the Nice Classification accurately reflects the actual nature of business. In other words, "take-away" (= take-out) and "restaurant" (= dine-in) are by no means mutually exclusive or entirely different in nature. Rather, the current reality is that while a restaurant maintains its primary form of operation, take-out services provided by such a restaurant have become widely prevalent.

For example, suppose that a restaurant owner has a registered trademark for their traditional dine-in services, designating the service of "providing food and beverages" under Class 43. If, due to social or economic changes, the restaurant begins offering take-out services as well, does it truly reflect social reality to immediately say that this act constitutes trademark use for goods

in Class 30 or similar classes, that is, this act amounts to trademark use completely outside the scope of the registered trademark right? In fact, would it not be more natural to perceive the newly introduced take-out services as an integral part of the conventional restaurant service?

I fully understand that we must respect the interpretations, concepts and definitions of goods and services within the trademark system that have been traditionally discussed and established in Japan. However, if these established standards do not fit today's social conditions, it may be necessary to initiate a certain level of discussion to bridge the gap.

5. Conclusion

This paper was conceived from my perception that, compared to the Arguments on Trademarks, the Arguments on Goods and Services has been less actively discussed. However, what has been examined in this paper represents merely a small fraction of the Arguments on Goods and Services -just the tip of the iceberg- and I believe there are many more issues waiting to be explored.

In recent consultations with clients, there has been a surge of inquiries regarding innovative, unprecedented services, many of which cannot be directly categorized under the indications of goods and services in the "Examination Guidelines for Similar Goods and Services." To appropriately protect such services, it is crucial to thoroughly understand the nature of the business and adopt a strategic vision that treats them as complex, multi-class services. In some cases, it would be necessary to proactively incorporate the essential features of the services into the indication of goods and services to ensure adequate coverage. As discussed above, regarding the scope of trademark rights, goods and services should, as a fundamental principle, be interpreted in accordance with the literal wording of their indications. Therefore, rather than forcing them to be covered by comprehensive or superordinate concepts, if that proves difficult, it will also be important to proactively describe the actual features of the goods and services as they are. While examining the similar group codes is indispensable in Japanese practice, what matters most is ensuring that businesses are securely protected through the appropriate indication of goods and services.

In closing, I hope that this paper will help contribute to the deepening of discussions about the Arguments on Goods and Services in Japanese trademark practice. In that sense, the arguments presented above should be viewed merely as my tentative observation based solely on my own view.

There will certainly be disagreements, but the emergence of such differing opinions is precisely what is needed to generate active discussions in this field.

[1] A review of registered cases in Japan reveals that the indication "providing food and beverages at a restaurant available for take-out" has been deemed acceptable by the JPO as a Class 43 service. Under the JPO practice, while this indication is acceptable, the indication "providing food and beverages available for take-out at a restaurant" is rejected; thus, it appears that the decision on acceptability is based on the difference in word order. Regarding the indication "take-away restaurant services" in the Nice Classification, given the English word order, it would be more natural to translate it as "providing food and beverages at a restaurant available for take-out" in Japanese. Furthermore, since there is no practical difference in meaning between the indication "providing food and beverages available for take-out at a restaurant" and "providing food and beverages at a restaurant available for take-out," it seems unreasonable to draw a distinction between the two in terms of acceptability.