

2023

JPAA IP Practitioners Seminar



February 27 – 28, 2023
Bangkok, Thailand

Organized by
Japan Patent Attorneys Association (JPAA)

In cooperation with
The Japan Patent Office (JPO)
The Intellectual Property Association of Thailand (IPAT)

Welcome Message



SUGIMURA Junko (Ms.)
President
Japan Patent Attorneys
Association (JPAA)



KONISHI Kay (Ms.)
Director General
International Activities Center, JPAA

It is our great pleasure and honor to welcome you to the forthcoming 2023 JPAA (Japan Patent Attorneys Association) IP Practitioners Seminar on behalf of the JPAA, which will be held again in Bangkok, Thailand, the land of smiles.

The JPAA IP Practitioners Seminar was first introduced to Singapore in 2005, has been conducted every two years in several South-East Asian countries including Viet Nam, Malaysia, the Philippines, Thailand, Indonesia, and Cambodia, and has since trained over 1,000 IP professionals. After a four-year absence due to the COVID-19 pandemic since the last 2019 Seminar in Phnom Penh, Cambodia, the JPAA has decided to resume the Seminar. Revisiting Thailand after a decade since 2013, the 2023 Seminar will be our 9th.

Asian countries are, without a doubt, now at the heart of global IP activities. The latest WIPO statistics show that IP Offices in Asian countries received 67.6% of 3.4 million patent applications filed worldwide in 2021, and 69.7% of 13.9 million trademark applications filed worldwide in 2021, which means two-thirds or more of global IP filings now emerge in Asian countries. Consequently, enhancing practical skills on IP for IP professionals in Asian countries, in particular in South-East Asian countries, is of paramount importance. Extensively skilled IP professionals are therefore a driving force for a quality and sustainable global IP system.

The two-day Seminar aims to enhance must-have practical skills for IP professionals instead of mere theoretical knowledge on IP, and will start from half-day plenary sessions, followed by one-and-a-half-day group work sessions. All attendees will be divided into either a Patent dedicated class or a Trademark/Design dedicated class, which is a choice for individual attendees as both the Patent and the Trademark/Design group work sessions run concurrently.

The Patent group work sessions include lectures followed by group discussions, tutored by JPAA members, on drafting patent claims and responding to Office Actions, while the Trademark group work sessions include lectures followed by group discussions, also tutored by JPAA members, on distinctiveness, similarity judgement, and responding to Office Actions.

As well as benefiting from highly practical training programs, the small cohorts each consisting of just several attendees will build strong bonds over shared common goals towards becoming highly skilled IP professionals, and the Seminar will ultimately lead to strong business relationships as well as friendships. We therefore cordially invite you to join the 2023 JPAA IP Practitioners Seminar in Bangkok, Thailand. We look forward to seeing you in Bangkok.



Suebsiri Taweepon
President of Intellectual Property
Association of Thailand

On behalf of the Intellectual Property Association of Thailand (“IPAT”), I am delighted to extend a warm welcome to the Japan Patent Attorneys Association (“JPAA”) and to all attendees joining the Asia Seminar 2023 in Bangkok, Thailand. The JPAA has always been a friend of the IPAT and has provided great support to IP practitioners across Asia. We look forward to welcoming the JPAA to Thailand in February 2023, and we would be happy to provide any possible support for the JPAA’s events during this time.

The IPAT was established in November 1972 and is considered Thailand’s oldest and strongest association of private IP practitioners. As the COVID-19 pandemic recedes, most major international IP events will return to being held in-person, allowing us to meet and develop more meaningful connections with one another. This upcoming seminar will be a great opportunity for IP practitioners from across Asia to network and build relationships, both as professionals and as friends.

Thailand is a warm country, and February marks the end of the cool season. It will be a perfect time for you to explore the country after the seminar, whether that be our historic temples in Bangkok, the great mountain ranges to the north or the beautiful beaches and islands in the south.

We look forward to seeing you all soon.

Program

During the two-day seminar, intellectual property practitioners will gain a practical overview of the Japanese intellectual property (IP) system and environment. Each session will provide participants with specific tools and information which they can use to streamline prosecution, increase the value of their IP portfolio, and reduce overall costs. The Monday morning sessions are designed to cover the Japanese IP system and environment in general. From Monday afternoon, participants may choose one of the two groups, 1) Patent Group or 2) Trademark & Design Group. The session of Patent Group will be held in the same room, and the session of Trademark & Design Group will be held in parallel in a different room. A portion of these two group sessions will allow participants to share their real-world experiences in IP practice and obtain feedback on the same from their fellow attendees.

Monday, February 27

All Participants (Fuji Ballroom2)

08:00–09:00 Registration

09:00–09:20

**Welcome & opening remarks/ Activities of JPAA
SUGIMURA, Junko**

President, Japan Patent Attorneys Association (JPAA)

09:20–09:35

Welcome message and CIPITC's current activities

Toon Mek-yong

**Chief Justice, Central Intellectual Property and
International Trade Court (CIPITC)**

09:35–09:50

Welcome message and DIP's current activities

Vuttikrai Leewiraphan

**Director General, Department of Intellectual Property
of Thailand (DIP)**

09:50–10:05

Welcome message and IPAT's current activities

Suebsiri Taweepon

**President of Intellectual Property Association of
Thailand (IPAT)**

10:05–10:30 Coffee Break

10:30–11:30 Session M-1

Activities for Intellectual Property in Southeast Asia

WATANABE, Junya

**Director, IP Department, JETRO Bangkok Attaché of
JAPAN PATENT OFFICE (JPO)**

11:30–11:50 Session M-2

IP Trend in Asia and Role of IP Professionals

KONISHI, Kay

Director General, JPAA International Activities Center

12:00–13:30 Lunch (The Oasis Restaurant)

Patent Group (Sakura)

13:30–14:10 Session P-1

**General overview of patent procedures [Mechanical &
Electrical engineering]**

SAWAI, Yoko

In this session, general tips on how to draft claims for a patent application and how to respond to an Office Action (OA) will be showcased.

14:10–14:30 Session P-2**General overview of patent procedures [Chemistry]****NAGANO, Atsushi**

This session will provide brief explanation for claim drafting and a response to an Office Action (OA), focusing on the chemical field. The participants will learn types of claims and how to respond to an OA, etc., unique to the chemical field.

14:30–15:00 Session P-3**Reviewing a question regarding claim drafting****[Mechanical & Electrical engineering]****TANAKA, Hideyuki**

In this session, how to make claims will be explained using a specific example of a mechanical invention. Specifically, overviews of the example invention, prior art and tips for making a set of claims will be explained, which will help participants to prepare a set of claims on the next day.

15:00–15:30 Coffee break**15:30–15:50 Session P-4****Reviewing a question regarding claim drafting****[Chemistry]****OHTANI, Kimio**

In this session, the materials and information necessary for the next day's group discussion will be explained. This session will help you in understanding the gist of an invention and the contents of prior arts. From the viewpoint of claim drafting, how to interpret the contents of an example that is specific to the chemical field will also be explained.

15:50–16:10 Session P-5**Reviewing a question regarding handling Office****Actions [Mechanical & Electrical engineering]****ZHANG, Huawei**

In this session, a mock patent application case at the Office Action stage will be introduced to help participants in their preparation for the breakout discussion on the following day. A summary of the present invention, the contents of office action as well as references, and wishes of clients will be explained briefly. In the last part, some key points to focus on in the discussion will be presented.

16:10–16:40 Session P-6**Reviewing a question regarding handling Office****Actions [Chemistry]****ISHIKAWA, Yusuke**

In this session, participants will receive explanations on a summary of an Office Action with an invention and citations. Each group will be required to prepare a draft claim amendment and the gist of arguments for the next day.

**18:00-20:00 Welcome reception for all participants
(The Oasis & The Pool Terrace)*****Trademark & Design Group*** (Tsubaki)**13:30 – 15:00 Session T-1****Explanation of distinctiveness in Japanese trademark examination, Workshop****NAGAMINE, Haruka**

Distinctiveness of a mark is one of the requirements for registrability of a trademark in Japan. In this session, registrability criteria pertaining to inherent distinctiveness under the Japanese Trademark Law will be discussed.

15:00–15:30 Coffee break**15:30–16:15 Session T-2****Protection of three dimensional configuration in Japan****NAKAYAMA, Kenichi**

This session will explore possible vehicles to protect three dimensional configurations under Japanese statutory laws.

16:15–17:00 Session T-3**Enforcement against trademark infringement in Japan****MAKIYAMA, Yoshimichi**

This session will cover enforcement against trademark infringement in Japan.

Specifically, after an overview of the current status of damage caused by counterfeit products and trends in countermeasures, we will review administrative, criminal, and civil remedies for enforcement against trademark infringement.

**18:00-20:00 Welcome reception for all participants
(The Oasis & The Pool Terrace)**

Tuesday, February 28

Patent Group (Sakura)

How to Draft Claims 9:00-12:20

In this session, participants will have group discussions on how to draft claims. Some points for obtaining a strong patent with suitable broadness of invention will be discussed and explained.

9:00-10:30 Session P-7

Group discussion [Claim drafting]

KOSHIKAWA, Takao

In this session, participants will draft claims for an invention in their group based on the explanation of the gist of the invention and the prior arts.

10:30-10:50 Coffee break

10:50-12:20 Session P-8

Presentation [Claim drafting]

KOSHIKAWA, Takao

The leader appointed in each group will present the draft claims in front of all participants. The tutor of the group will comment on the presented draft response.

12:20-13:50 Lunch (The Oasis Restaurant)

How to respond to Office Actions 13:50-17:10

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

13:50-15:20 Session P-9

Group discussion [Handling Office Actions]

ZHANG, Huawei

Participants will have a breakout discussion on handling an Office Action of a mock patent application. After studying the materials, the participants will prepare a draft response for the office action in a group.

15:20-15:40 Coffee break

15:40-17:10 Session P-10

Presentation [Handling Office Actions]

ZHANG, Huawei

The leader appointed in each group will present the draft response in front of all participants. The tutor of the group will comment on the presented draft response.

Trademark & Design Group (Tsubaki)

9:00-9:45 Session T-4

Similarity judgement in Japan

FURUHATA, Eri

This session aims to provide outlines of similarity determination of trademarks and goods/services according to the examination guidelines provided by the JPO.

9:45-10:30 Session T-5

Workshop

FURUHATA, Eri

We will review recent appeal cases in an exercise style. Your active participation is highly appreciated.

10:30-10:50 Coffee break

10:50-12:20 Session T-6

How to deal with Office Actions, including mini-workshop

WADA, Mitsuko

The session looks at an outline of the Japanese trademark examination procedure, the major reasons for refusal, and how to respond to Office Actions. In the session, the speaker will ask simple yes-or-no questions to compare the Japanese practice and participant countries' practices and to share useful information. Active participation is highly appreciated.

12:20-13:50 Lunch (The Oasis Restaurant)

13:50-14:35 Session T-7

Bad faith application in Japan

SATO, Shunji

This session reviews several IP High Court / JPO Trial and Appeal Board decisions on bad faith applications / registrations and compares those decisions to find out what factors were important to reach each decision.

14:35-15:20 Session T-8

Workshop

SATO, Shunji

In this workshop, participants will discuss the applicability of bad faith theory to actual cases. Your active participation is highly appreciated.

15:20-15:40 Coffee break

15:40-17:10 Session T-9

Basic knowledge about Madrid Protocol

ASHIHARA, Emi

This session provides an outline of the Madrid System and tools to help choose whether it provides the best option. Participants will be encouraged to exchange their own opinions on points to consider when filing through the Madrid System in different jurisdictions.

General Information

Location

Hotel Nikko Bangkok
27 Soi Sukhumvit 55 (Thonglor), Sukhumvit Road, Klongtan Nua,
Wattana, Bangkok 10110 Thailand
Tel. +66 (2) 080 2111
Fax. +66 (2) 080 2112
URL: <https://www.nikkobangkok.com/>

Dates

February 27 and 28, 2023

Language

English only

Registration and Seminar Fees

Applications and payment of the registration fee of **USD 200/person** will be accepted online only on a first-come-first-served basis and will be open on January 23, 2023, and closed on February 10, 2023. If the number of applications reaches the limit, the registration will be closed before February 10. Links to the online registration form and additional information can be found on the JPAA website: <https://www.jpaa.or.jp/en/activity/2023-jpaa-ip-practitioners-seminar/>

The registration fee includes the fees for all seminar materials, coffee breaks, lunches and the welcome reception. All other expenses, such as accommodation fees, are the responsibility of the attendees.

Accommodations

Attendees are responsible for their own accommodations at Hotel Nikko Bangkok or other hotels. The attendees can book their own accommodations at Hotel Nikko Bangkok from the following URL. <https://www.nikkobangkok.com/>

Hotel Nikko Bangkok

27 Soi Sukhumvit 55 (Thonglor), Sukhumvit Road, Klongtan Nua,
Wattana, Bangkok 10110 Thailand
Tel. +66 (2) 080 2111

Information on the Reception Party

Date and time: Monday, February 27, 2023, from 6:00 p.m. to 8:00 p.m.
Venue: Hotel Nikko Bangkok, 6F, Oasis & Poolside Terrace
Style: Buffet
The reception party may be canceled if the state of COVID-19 infections worsens. Please note that the registration fee will not be refunded even in the case of cancellation of the reception party.

Cancellation and Liability

Attendees are encouraged to purchase travel insurance as the organizers will assume no liability and the registration fee is not refundable.

Immigration and Visa Information

Attendees who wish to enter Thailand should confirm visa information, such as visa exemption to Thailand. Please check the Thailand embassy homepage in your country to acquire more information.

Smoking Policy

Smoking is only permitted in designated smoking areas.

Implementation of COVID-19 Preventive Measures and Request for Cooperation upon Holding This Event

Upon holding this event, we will implement the following measures from the perspective of preventing the spread of COVID-19. We request that those who wish to participate in the event check the information below and apply for participation in the event only if they agree to cooperation with the preventive measures.

(1) General information

- It is recommended that participants voluntarily implement infection preventive measures (e.g., wearing a mask).
- In the indoor site, air conditioning equipment may not sufficiently work due to room ventilation. Participants are requested to voluntarily prepare for measures against heat and cold.
- At the time of reception on the first day and the second day, we will implement checking on the contraction of COVID-19 (see (3) below). Participants who do not meet the prescribed conditions may be refused participation in the seminar.
- In order to implement the checking at the time of reception mentioned above, we request that participants arrive at the event site well in advance. Participants who are not checked will be refused admission.
- If a seminar lecturer is unable to meet the same prescribed conditions as those for the checking mentioned above, the seminar program may be subject to partial change or cancellation even on the day of the seminar. Please note that the registration fee will not be refunded even in the case of partial change or cancellation of the seminar.
- The reception party may be canceled if the state of COVID-19 infections worsens. Please note that the registration fee will not be refunded even in the case of cancellation of the reception party.

(2) Preparation before the start of the seminar

- Tables and the upper parts of the backs of chairs will be disinfected.
- If a conference room without a window that can be opened is used as an event site, efforts will be made to circulate the air between the inside of the room and the outside by keeping the entrance doors open and using circulators.

(3) At the time of reception (both on the first day and the second day)

- Participants and lecturers will be subject to checking of the following.
 - Temperature check: 37.5 degree Celsius or below
 - Observation of noticeable symptoms: Frequent cough or sneeze
- Participants who do not meet the abovementioned conditions in the checking will be refused participation in the seminar and event.
- Lecturers who do not meet the abovementioned conditions in the checking will be refused participation in the seminar.
- Alcohol disinfectants and other disinfectant facilities will be provided. Please disinfect your hands and fingers.

(4) During the seminar

- Ventilation in the site will be operated during the seminar.
- If you are worried about suffering from heatstroke due to wearing a mask, please keep yourself hydrated.
- Seats for each participant are provided with a distance of about 2 m between them. Please do not use a prohibited seat. In order to secure distance between participants, the number of participants will be reduced to about 70% of past seminars.
- Please refrain from talking loudly during the rest period.

(5) After the seminar

- Tables, the upper parts of the backs of chairs, microphones, and other implements and equipment will be disinfected.

Request for Understanding of Posting of Photographs on JPAA's Website and Social Media

We plan to take photographs of this event and post them on JPAA's website and social media. Please note that photographs in which you appear may be posted. We appreciate your understanding.

Organizing Committee

President

SUGIMURA, Junko, Promete International Patent Office

Executive Director

NAGAOKA, Shigeyuki, KONISHI & NAGAOKA IP Firm

Director General, JPAA International Activities Center

KONISHI, Kay, KONISHI & NAGAOKA IP Firm

Deputy Director General, JPAA International Activities Center

IIZUKA, Takeshi, Iizuka International Patent Office

Chair, Organizing Committee

YAMAMOTO, Atsushi, SANKYO PATENT ATTORNEYS OFFICE

Speakers and Tutors

ASHIHARA, Emi, YKI Intellectual Property Attorneys

FURUHATA, Eri, Tass Meister IP Law Firm

ISHIKAWA, Yusuke, Akiyama & Associates

KOSHIKAWA, Takao, KOSHIKAWA&Co.

MAKIYAMA, Yoshimichi, Ripple Partners

NAKAYAMA, Kenichi, SUGIMURA & Partners

NAGANO, Atsushi, Fukami Patent Office, P.C.

NAGAMINE, Haruka, SUGIMURA & Partners

OHTANI, Kimio, SEIWA PATENT & LAW

SATO, Shunji, TMI Associates

SAWAI, Yoko, S&I Japan

TANAKA, Hideyuki, Tanaka International Patent Firm

WADA, Mitsuko, HIKARI Patent Office

ZHANG, Huawei, Eikoh P.C.



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