

# SOEI VOICE

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SOEI News

# Japan Entered a New Pro-patent Era with a Hop, Step and Jump

by Yoshiki Hasegawa , President



by Yoshiki Hasegawa

There are two different policies nations can take with respect to inventions. One is a pro-patent policy, which emphasizes the protection of

inventions, and the other is an anti-patent policy, which emphasizes an antimonopoly policy and pays little attention to protection of inventions.

### RESULTS ACHIEVED THROUGH THE JAPANESE PRO-PATENT POLICY

The Government of Japan has had a pro-patent policy since 1995 when it enacted the Basic Law on Science and Technology. The policy brought the following results:

First, it successfully established a national common understanding that respects intellectual property. Today, the general public as well as technical experts engaged in research and development consider intellectual property important

and think that it is quite natural to protect it by law.

Second, legislation and legal systems to protect intellectual property have been improved. The Japanese Patent Law has been amended a number of times since the late-eighties. Most of the amendments expanded the scope of protection, making it easier for patent owners to exercise their patent rights and strengthening penalties imposed on violators.

### HOP, STEP...

The British athlete Sir Jonathan Edwards has held the world record (18 m 29 cm) for the triple jump since 1995. The triple-jump involves a series of three jumps: a Hop, a Step and a Jump. If we compare the triple jump to the Japanese pro-patent policy

- The Hop was the establishment of national common understanding that respects intellectual properties,
- The Step was the strengthening of legislation and legal systems to protect intellectual property.

These first two jumps have already been made.

In order to complete the Japanese pro-patent policy, we still need to do the Jump. The last jump toward a Japanese pro-patent policy would be for the Japan Patent Office (JPO) and the Intellectual Property High Court to render a decision respecting the protection of inventions.



### AND JUMP!

On January 28th, 2009, the Intellectual Property High Court rendered a sensational ruling that overruled the JPO decision to reject an invention (2008 Gyo Ke No. 10096, Title of the invention: Connecting Member for a Circuit). This day will long be remembered by all intellectual property practitioners as the day when Japan finally "Jumped" into the pro-patent era. The ruling threw out one of the key points in the Examination Guidelines that the JPO has been using in the evaluation of inventive step for over 10 years.

Without going into detail, the important effects of the ruling are 1) It became easier for applicants to get a

patent and 2) It became harder to invalidate a registered patent.

Since then, the concept of what constitutes an inventive step has greatly changed in the eyes of the Intellectual Property High Court and the JPO, and the patent office has been rendering more decisions advantageous to patent owners. Japan has made the triple jump into a pro-patent era.

Soei argued on behalf of the applicant in a case that resulted in the ruling on January 28, 2009. We will keep working flat out in order to win rulings that place a high value on protection of intellectual property.

### Patent

# How to Draft a Computer Program Claim in Japan

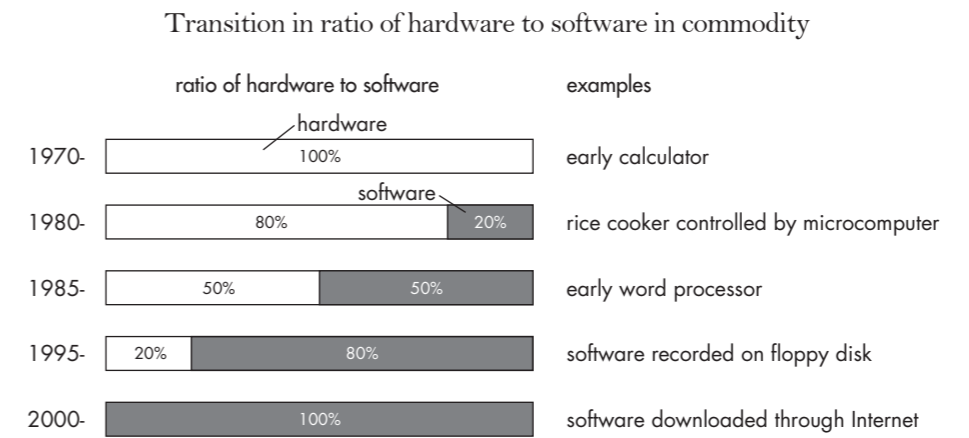
by Makoto Tamura



by Makoto Tamura

The following graph shows the approximate change in the ratios of hardware and software incorporated in commodities in the past decades. As

shown in the graph, ratio of software in commodities has increased and, in modern society, computer programs are traded through the Internet.



Because of the background shown above, the revision of the Japanese Patent Law in 2002 stipulated that an inventive computer program or the like is a product

invention. Thus, one of the unique features of the Japanese patent practice allows that applicants to draft a claim directed to a computer program itself.

## 1. HOW TO DRAFT A COMPUTER PROGRAM CLAIM

According to the examination guideline published by the Japanese Patent Office, applicants can draft claims for computer program inventions as shown in the examples below:

[Example 1]

A program which causes a computer to execute:

procedure A;  
procedure B;  
procedure C;...

[Example 2]

A program which causes a computer to operate as:

means A;  
means B;  
means C;...

[Example 3]

A program which cause a computer to perform:

task A;  
task B;  
task C;...

## 2. WHAT IS "OR THE LIKE"

The 2002 revision of the Japanese Patent Law stipulated that an inventive computer program "or the like" is a product invention. But what is "or the like"?

This phrase refers to information that is similar to a computer program and can be processed on a computer. For example,

If the applicant fails to draft the claims appropriately, the examiners will issue an office action in which they assert that the claims are not a statutory invention or that the claims are not clear.

For example, if the claim is drafted as "A program comprising: means A; means B; and means C," the examiners will issue an office action in which they assert that the claim is not clear because the computer program itself cannot provide those means.

Moreover, although other jurisdictions allow claims to be drafted as a "program product," "carrier wave," "program signal" or "information transmittable media," the examiners will issue an office action in which they assert that the claim is not clear. But redrafting these claims as "program claims" will overcome the office action.

such information could be a peculiar data structure which defines a computer processing and enables a computer to process the data in a significantly efficient manner. Under the Japanese patent law, a claim can be directed to such information as well.

## 3. SUPPORT FOR A COMPUTER PROGRAM CLAIM IN THE SPECIFICATION

If the specification describes a computer related invention as a method or apparatus clearly, the specification will mostly likely also be sufficient to support a computer program claim. In the typical case, the specification will be sufficient if the computer program is explained in detail with figures for the hardware

architecture of the computer which runs the computer program, block diagrams which show functions or means that are realized by the computer program, flow charts which show the procedures of the computer program, and explanatory schematics which facilitate understanding of the functions, means or procedures.

## 4. BENEFITS OF DRAFTING COMPUTER PROGRAM CLAIMS

Although a computer program is actually intangible, Japanese patent law regards it as a kind of "a product." As a result, the owner of a registered patent with a computer program claim can enforce the patent against an infringer whose business activity includes, for example, producing the computer program, using the computer program, assigning the computer program, leasing the computer program, importing the computer program, offering the computer program for assignment, or displaying the computer program for the purpose of assignment.

What is remarkable here is that the

definition of "assign" includes services through the Internet. Accordingly, the proprietor can enforce the patent not just against a person who sells a recording media with the computer program stored on it, but also against a person who provides a service through the Internet. The proprietor can enforce the patent against a person who makes it possible to download the computer program through the Internet or against a person who runs an Application Service Provider which makes it possible to use the functions of the computer program through the Internet without providing the computer program itself.

## 5. REMARKS

In comparison to patents which contain other types of computer related claims such as apparatus claims or method claims, infringement of a computer program claim is more likely to be direct infringement and more easily enforced against a wide range of

infringement activity. By having a computer program claim, the patentee can put herself/himself in an advantageous position in a lawsuit. Hence, applicants would be wise to include a computer program claim in addition to an apparatus claim and a method claim.

Patent

# Patent Applications in Japan - Some Statistics

by Yosuke Totsu

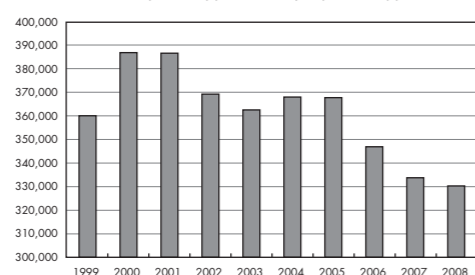


by Yosuke Totsu

## 1. RECENT TRENDS IN THE NUMBER OF PATENT APPLICATIONS BEING FILED

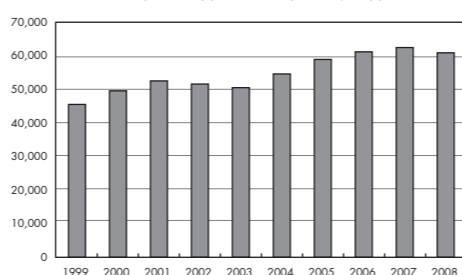
According to statistics from the Japanese Patent Office (JPO) for the last ten years, the number of patent applications

the number of patent applications by Japanese applicants



filed by Japanese applicants is decreasing while the number of patent applications filed by foreign applicants is increasing.

the number of patent applications by Foreign applicants



## 2. DETAILS OF PATENT APPLICATIONS BY FOREIGN APPLICANTS IN 2008

According to JPO statistics, foreign applicants filed 60,892 patent applications in 2008. The number of patent applications by foreign applicants entering Japan via the PCT route in 2008 was 41,964 while the number of patent applications filed by foreign applicants using the Foreign Language Application System in 2008 was 4,712. The PCT is much more popular than the Foreign

Language Application System. According to JPO statistics, the rank ordering of patent applications in 2008 by country of origin is as follows. Please note that the table only lists countries that filed over 50 applications. The number of patent applications by the applicants in the United States is impressive.

Countries	Number of Patent Applications	Countries	Number of Patent Applications	Countries	Number of Patent Applications
1 United States	25,112	12 Canada	726	23 Norway	152
2 Germany	8,023	13 Finland	575	24 Others	109
3 Korea	5,599	14 Australia	572	25 Liechtenstein	106
4 France	3,458	15 Israel	520	26 Hong Kong	90
5 Netherlands	3,391	16 Belgium	519	27 Barbados	80
6 Switzerland	2,437	17 Denmark	502	28 Luxembourg	79
7 Great Britain	2,079	18 Ireland	301	29 New Zealand	76
8 Taiwan	1,581	19 Singapore	298	30 Brazil	61
9 Sweden	1,576	20 Austria	296	31 South Africa	61
10 Italy	820	21 Spain	257	32 Russia	57
11 China	772	22 India	214		

Source : JPO's website

[http://www.jpo.go.jp/cgi/link.cgi?url=/shiryu/toukei/nenpou\\_toukei\\_list.htm](http://www.jpo.go.jp/cgi/link.cgi?url=/shiryu/toukei/nenpou_toukei_list.htm)

Design

# Drawings for Japan Design Applications - Points to Consider

by Yu Noma



by Yu Noma

## 1. INTRODUCTION

With increasing globalization of trade, the manufacture and distribution of counterfeit goods has also increased.

Therefore, as the need to have design rights at home increased, so to did the importance of obtaining design rights in many other countries around the world, including Japan, by claiming priority under the Paris Convention based on a design application filed abroad.

However, each country has a different design system, which may cause various problems. Because the biggest problem is related to the drawings, we would like to briefly describe the points to consider when preparing the drawings when the applicant is planning to file a Japan design application claiming priority under the Paris Convention.

## 2. DRAWINGS IN JAPAN DESIGN APPLICATIONS

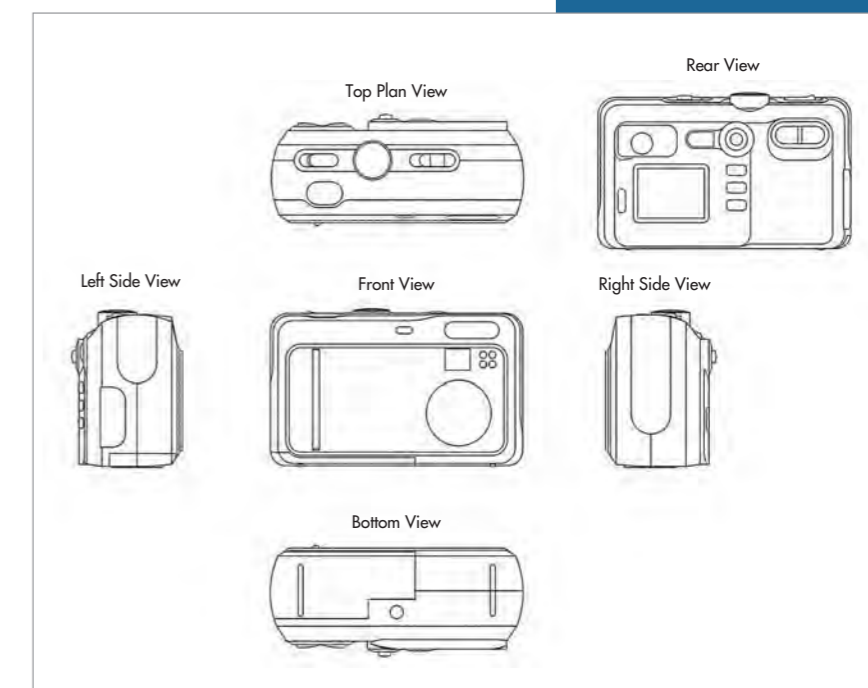
At least six orthographic views (front view, rear view, top plan view, bottom view, right side view and left side view) are necessary in the Japanese design practice.

The scale and shape of each view must be strictly consistent with the other views. If the scale and shape in any view is inconsistent with any other, the application will be refused.

Therefore, if the applicant is planning to file Japan design application, it is also desirable to include the six views described above and shown in the examples below in the application to which priority will be claimed.

If the priority application does not include all six views, the missing views must be added when the application is filed in Japan. In this case, if the supplemented views can be naturally derived from the other views, the examiner will accept the priority claim under the Paris

Convention. Thus, if the application includes a perspective view and one or more of the six views is missing, the priority claim can be maintained because the missing views can be easily deduced from the perspective view.



Trademark

# Similar Group Codes - A Poorly Understood Aspect of the Japanese Trademark Practice

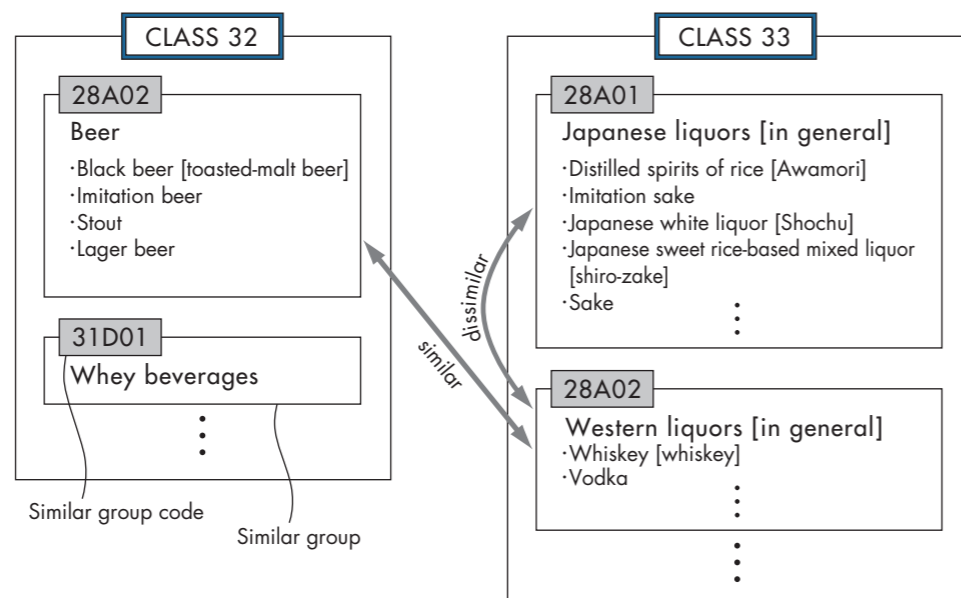
by Tomoya Kurokawa



by Tomoya Kurokawa

As in many other jurisdictions, trademark examiner examines relative ground of rejection before allowing the trademark to be registered. If there is a similar trademark that was filed prior to the pending trademark, the pending trademark is rejected. The similarity of the pending trademark to the prior trademark is determined based on two elements: similarity in mark itself and similarity in designated goods/services. That is, if both marks are similar in appearance and both designate similar goods/services, the pending trademark is rejected based on the prior trademark. On the other hand, if marks are not similar in appearance or the respective marks designate goods/services that are not similar, the pending trademark is not rejected based on the prior trademark.

In the Japanese practice, in order to determine whether the goods/services designated by the marks are similar or not, the trademark examiner relies on the “Examination Guidelines on Similar Goods/Services.” The Guidelines contain lists of goods/services categorized by taking into consideration the commonality of such factors as raw materials, production methods, distribution channels, intended purpose, typical consumers, part/finished product relationships and the like. The Japanese practice refers to these categories of goods/services that have several of these factors in common as “similar groups” and calls the index affixed to each of the categories the “similar group code.” The trademark examiner determines the goods/services designated in the mark under examination are similar



to those designated in the prior mark by comparing the similar group codes affixed to the goods/services designated for the respective marks.

For example, the similar group code for *Sake (Japanese liquor)* in class 33 is 28A01 while the similar group code for Whisky in class 33 is 28A02. Hence, the examiner will determine that *Sake (Japanese liquor)* and Whisky are dissimilar goods. (Please refer to the Figure on P7, part of the Guideline provided by the JPO.) Goods in different classes sometimes belong to same category (and, therefore, have the same similar group code). For example, the similar group code for Lager beer in class 32 is 28A02, which is the same as for Whisky in class 33. Thus the examiner will determine that Whisky in class 33 and Lager beer in class 32 are similar goods. (Again, please refer to the Figure on P7.)

Sometimes the categorization may seem to be a little bit unreasonable. For example, the similar group code for both

“Industrial Chemicals” in Class 1 and “Binding Agents for Ice Cream [edible ices]” in Class 30 is 01A01, and both “Napkins for Incontinents” in Class 5 and “Gloves [clothing]” in Class 25 have the similar group code of 17A04.

However, these examples notwithstanding, it is quite difficult to overturn a decision by the examiner, based on the Guidelines, that the goods/services in the present application are similar to those in the cited mark. Possible options to overcome such a decision are deleting conflict goods/services, filing a cancellation action against the prior mark, or negotiating with the owner of the prior mark for assignment.

There is a Similar Group Code table listing goods and services together with their similar group codes in both Japanese and English at the website below: [http://www.jpo.go.jp/cgi/link.cgi?url=/shiryu/kijun/kijun2/ruiji\\_kijun9\\_eng.htm](http://www.jpo.go.jp/cgi/link.cgi?url=/shiryu/kijun/kijun2/ruiji_kijun9_eng.htm)

Law

# License Agreements in Japan: What Happens When One Party Goes Bankrupt?

by Kazuhiro Ajisaka



by Kazuhiro Ajisaka

## 1. INTRODUCTION

A license agreement, which grants a license to carry out activities with regard to a particular intellectual property or to use such a property, becomes a bilateral agreement if the licensee agrees to pay royalties to the licensor. Various types of license agreements are in wide use for commercial purposes: package license

agreements which define the scope of the license depending on the licensed products or techniques, cross-license agreements where the parties grant each other reciprocal licenses, and package cross-license agreements which combine the essence of these two agreement types. In corporate reorganizations or other

arrangements that result from bankruptcy procedures, the handling of license agreements can be an important issue. This article will address the handling of a

## 2. BANKRUPTCY OF THE LICENSOR

Generally speaking, if the license is registered with the Patent Office, the licensor's trustee or custodian is not entitled to terminate the license agreement, which should instead remain in force. That is to say, the licensee may continue its contractual performance by paying to the licensor such royalties as specified in the license agreement. If a patent right or other rights covered by the agreement are assigned to a third party during the course of bankruptcy procedures, the relationship between the licensor and the licensee with respect to their rights and obligations under the license will change into a relationship between the third party and the licensee with the same effect.

On the other hand, if the license is not registered with the Patent Office, the licensor's trustee or custodian is entitled to terminate the license agreement, or to request the payment of royalties instead of terminating the license agreement. The licensee may ask the trustee or custodian provide a definite reply by a deadline as to

## 3. BANKRUPTCY OF THE LICENSEE

If the licensee goes bankrupt, the licensee's trustee or custodian may terminate or continue the license agreement. However, as long as the licensee continues to pay royalties as specified by the agreement, the licensor may not terminate the agreement in question. This principle should

license agreement that concerns industrial property rights such as patent rights in Japan in the event of the bankruptcy of one of the parties to the agreement.

whether the agreement should be terminated or its obligations should be performed by giving notice well in advance of such deadline. If the trustee or custodian fails to give a definite reply before the deadline, the agreement is deemed to be terminated.

If the licensee incurs any losses as a result of such trustee or custodian terminating the agreement, the licensee will be entitled, as a bankruptcy creditor, to exercise its rights to claim compensation for its losses as a bankruptcy debtor and demand that royalties that it has paid be refunded.

If the trustee or custodian transfers the patent right to a third party, the licensee may not assert its license against the third party, and unless the third party grants a license to the licensee, the licensee may not continue to exercise its license. If the trustee fails to terminate the license agreement in advance and this failure prevents the licensee from exercising its license, the licensee will be entitled to claim damages from the trustee or custodian.

apply in the same manner to a provision that stipulates that the agreement is to be terminated in the event of a petition by the licensee for the commencement of bankruptcy procedures, and such a provision would be considered to be null and void.

## Come to Japan

# Miyajima: an Island Where People and Gods Live Together

by Asako Ando

Miyajima, an island about 30 minutes from the Hiroshima city by train and ferry, is famous for its fantastic scenery: Itsukushima shrine, the Otorii (Grand gate) floating above the sea, and Mt. Misen. Miyajima itself has been worshipped as a god since ancient times; this belief has been passed down generation to generation along with the unique culture, history and natural scenery that are still present today.

Itsukushima shrine, registered as a World Cultural Heritage in 1996, was built in a Japanese style called "Shinden



Itsukushima shrine at high tide

In Miyajima, you can see the ebb and flow of the tide before your eyes every 6 hours. Why can the Otorii appear to be floating in the sea? The water at high tide fills the inlet that surrounds the Itsukushima Shrine and Otorii every 12 hours. At the low tide, on the other hand, you can actually walk to the foot of the Otorii.



Conger eels (picture: cited from website)



Otori at high tide

Zukuri." This shrine was first built in 593, and the pavilions were re-constructed in their present form in Heian Period in 1168. The Otorii, the grand gate, is 16 meters high and painted vermilion and is the symbol of the Itsukushima shrine. The vermilion Otorii floating over the blue sea creates such a fantastic scene that many visitors from around the world stop to take a picture.



Otori at low tide

Miyajima also has delicious food such as fresh oysters and Momiji-manjyu (a bun in the shape of a Japanese maple leaf with sweet red-bean paste inside). Recently, conger eels ("anago," Conger myriaster) caught in the Seto Island have become popular and each shop has its own secret seasoning.

One can say that Miyajima is one of the most cultural important and fabulous islands in Japan which amazes and attracts many visitors with its beautiful scenery. If you have an opportunity to visit Miyajima, you can spend a whole day

discovering this mystical place.

Reference :

Miyajima, an island with a World Cultural Heritage  
(<http://www.miyajima-wch.jp/en/itsukushima1.html>)

## Come to Japan

# Cherry Blossoms

by Naoko Ishigaki

Japan will have ushered in the cherry blossom season by the time this issue of the SOEI-VOICE reaches you.

“If there were no such thing as cherry blossoms in this world, in springtime how untroubled our hearts would be!”

This classical *waka* poem is by Ariwara-no-Narihira, a renowned poet in the Heian Period (794 to 1185). Using the rhetorical technique of enantiosis, it states the opposite (deploring the hustle and bustle caused by cherry blossoms) of what is really meant (deeply cherishing them in fact). It is simply amazing that virtually nothing has changed in the way Japanese people feel about cherry blossoms for the past 1,200 years. We still feel the same way every time the cherry blossom season comes around. Crowds gather, it is noisy day and night, hotel prices go up, and so on. Truly, if there were no such thing as cherry blossoms, our everyday lives would not be disturbed so much. But, then, we would not be able to stand it. After all, cherry blossoms are an essential part of the Japanese spring. They really are.

But why do Japanese people love

cherry blossoms so much in the first place?

- Because cherry blossoms bloom all over the trees, looking impressive.

Cherry blossoms fill the whole landscape with a pale pink color.

- Because cherry blossoms are beautiful to look at even when they are falling off the trees.

Cherry blossoms are picturesque not only in bloom but also falling off their trees.

- Because the blooming of cherry blossoms mark a milestone in the Japanese year

People in Japan often pass milestones in their lives in April, when cherry blossoms are in bloom. Cherry blossoms are likely to stand out in people's minds as they are in bloom during graduations, at the start of the school year and when young adults start their first jobs.

- Because cherry blossoms make people look forward to seeing them bloom before they actually bloom.

Cherry blossoms blooming forecasts are a regular part of Japanese news programs every February. In March, there are advertising campaigns for major viewing spots, saying “The cherry

blossoms season is coming soon!”

Thinking of where to go to view the cherry blossoms and making arrangements are also a part of the joy of the cherry blossom season.

- Because cherry blossoms are short-lived.

Cherry blossoms are in full bloom for only a week or so and fall off after a very short period of time. As they show their extreme beauty during that one week and die quickly and gracefully after that, they are often associated with people's lives. This is why Japanese people feel that cherry blossoms stand out from other flowers and are beautiful in their own special way.

Japanese people adore cherry blossoms not only because they are beautiful to look at but also they remind us of traditional lifestyles and ways of thinking. It seems to me that the fact that they are in full bloom in the milestone month of April, they play a major role in making people think “What is more spring-like than cherry blossoms?” I still remember taking photographs with my mother under a

blooming cherry tree on the way to the ceremony welcoming new students my school and making plans for cherry blossom viewing parties for new employees. In fact, we Japanese readily associate cherry blossoms with encounters and farewells?

Soei Patent & Law Firm also has a cherry blossom viewing party every year. If you become an organizer, there are so many things to do that you have to start preparations about half a year in advance, finding a place and making a plan. Since it is a big event that almost the entire staff attends, it is not easy to complete the preparations. Then again, it is worth all the effort. We feel we are lucky to be in Japan when looking at beautiful cherry blossoms while drinking sake and eating tasty delicacies.

Those living overseas are strongly urged to come to Japan during the cherry blossom season. More than at any other time of the year, this is when you can experience an all-Japanese atmosphere.



Staff News



Hiroshi ABE

**Hiroshi ABE (Senior Patent Attorney)**

Mr. Abe received his B.S. (1974) in Precision Engineering from the Gifu University. Positions held in the Japan Patent Office (1975-2002, 2005-2009) include Examiner, Appeal Examiner, Director of Examinations, Chief Appeal Examiner, Senior Director of the Board of Appeal and Deputy Director-General of the Board of Appeal. Also, he worked for Tokyo District Court (2002-2005) as the technical advisor on infringement suits. He has examined applications for patents in many fields, including mechanical devices, medical devices and automotives in the Japan Patent Office. He Joined SOEI in 2009.

**Ayano MIZUTANI**

Ms. Mizutani graduated from Keio University in 2002. After graduation, she worked for a Japanese IT company for several years and joined SOEI in 2006. She qualified as a patent attorney and joined the Japan Patent Attorneys Association (JPAA) in 2010.



Ayano MIZUTANI

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Mr. Hirano received his B.S. (1993) and M.S. (1995) in Molecular Engineering from Kyoto University. Following his graduation, he worked for Nippon Oil Corporation as a researcher on lubricants (1995-1999). He joined SOEI in 1999 and qualified as a patent attorney in 2010. He has been handling prosecutions in the fields of lubricants, fuels, petroleum chemistry, catalysts, adhesives and photoresists.



Hiroyuki HIRANO

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Mr. Komachi graduated from Chiba University, where he studied mechanical engineering. He worked for an automaker and an electronic component maker until he joined Soei in 2004. He has been handling consultation in the fields of mechanical device, automotive, optical devices. He qualified as a patent attorney and joined the Japan Patent Attorneys Association (JPAA) in 2010.



Kiyoteru KOMACHI

**Naoshi FUKUYAMA**

Mr. Fukuyama received his B.S. (2000) and M.S. (2002) in Pharmaceutical Sciences from Nagoya City University and graduate school of Kyoto University, respectively. He worked as an editor at publishing company, then worked as a pharmacist at a dispensing pharmacy and at a hospital until he joined SOEI in 2008. He has been handling prosecutions in the fields of organic and inorganic chemistry, polymer materials, medicinal chemistry, process chemistry, ceramics and mechanical device. He qualified as a patent attorney and joined the Japan Patent Attorneys Association (JPAA) in 2010. He is a member of The Pharmaceutical Society of Japan.



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**Yohei SUZUKI**

Mr. Suzuki received his B.S. in Petroleum Engineering from Tokyo University in 1997. After graduation, he worked for Teikoku Oil Company (now INPEX) for seven years as an oil driller and a researcher. He joined SOEI in 2004. He qualified as a patent attorney in 2010 and joined the JPAA. He has been handling prosecutions in the fields of catalysts, ceramics, chemical engineering, petroleum chemistry and environmental technology.



Yohei SUZUKI

**Yuko ANDO**

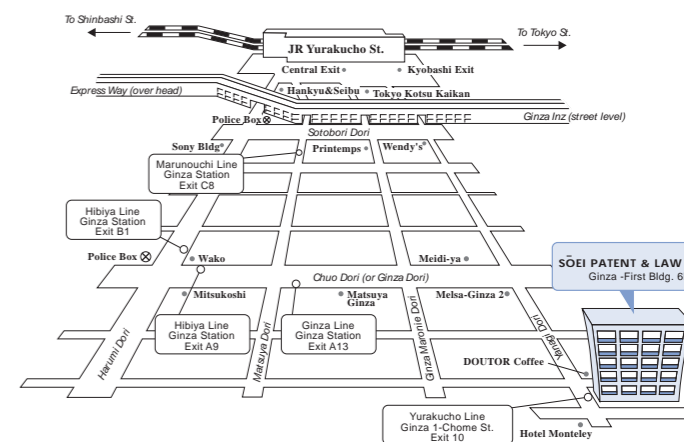
Ms. Ando received her B.S. (2005) and M.S. (2007) in agriculture from Tokyo University. She has been with Soei since graduating from university in 2007. She qualified as a patent attorney and joined the Japan Patent Attorneys Association (JPAA) in 2010. She has been handling prosecutions in the fields of botany, pharmaceuticals, biochemistry, food technology, and molecular biology.



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