

Intellectual Property Practice

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Mori Hamada & Matsumoto (the "firm") provides a broad range of legal services in the field of intellectual property, such as patents, trademarks, copyrights and trade secrets, including the handling of infringement cases, arbitrations and other dispute resolutions, invalidity trials and trademark prosecutions and providing advice on valuation and strategic use of intellectual property.

The firm handles large-scale and complicated infringement cases and arbitrations related to intellectual property, both in and outside Japan, and it has abundant experience and an outstanding record of achievement in licensing, joint research and development, technology transfers, and other complicated transactions related to intellectual property. The firm also works on many cutting-edge topics, such as the utilization of AI and the protection of content in the metaverse.



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IP Litigation - Japan

The firm has handled infringement cases involving patents, trademarks, designs and copyrights, cases seeking provisional disposition for injunction orders against acts of infringement or unfair competition, as well as invalidity trials and appeals involving patent invalidations, thereby accumulating an excellent record of achievement and experience in these matters. The firm also has abundant experience in litigation seeking compensation for employee inventions, in addition to dispute resolutions involving licensing and technology transactions. The firm's experience in IP practice has seen it handle matters in various fields, including electronic devices, optical devices, semiconductors, telecommunication, information technology, medicine, bioscience, life science, healthcare, and consumable commodities. In addition, the firm's flexible dispute resolution team structure has enabled it to accumulate experience in handling not only large-scale cases but also small cases. The firm aims to provide strategic dispute resolution services with a view to maximizing the benefits achieved for our clients.

IP Litigation - Worldwide

With the globalization of corporate business activities, intellectual property disputes are often transnational in nature. In order to handle international IP disputes, attorneys at the firm have accumulated specialized knowledge and expertise obtained from studying and training abroad. In addition, the firm works closely with other leading international law firms to provide strategic advice, with a view to achieving the best possible result for our clients. In recent years, the firm has provided clients with efficient solutions in a variety of IP disputes arising in China and elsewhere in Asia through its offices located in China, Singapore, Myanmar, and Bangkok. The firm has also developed a track record of successfully handling arbitration cases before the International Court of Arbitration of the ICC and other international courts.

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IP Transactions

The firm's IP practice group represents clients in a wide range of cross-border IP transactions, including license agreements, joint research and development agreements, technology transfer agreements, and content and software development, and assists clients in formulating schemes and strategies and by drafting and reviewing transactional documentation. In addition, the firm has abundant experience handling M&A and investment transactions where intellectual property constitutes the material asset of the target company, as well as structured finance transactions where intellectual property is used as collateral. The firm's IP practice covers a wide range of fields, handling matters in the technology sector, the entertainment industry (including movies, music and games), and for sports-related businesses. The firm also provides advice on emerging areas such as AI (Artificial Intelligence), IoT (Internet of Things) and Big Data, and so-called "WEB3" fields including NFTs and the metaverse.

IP Management

Recent court cases in Japan have made it increasingly important for both large and small companies to pay careful attention to the management of intellectual property generated in the course of day-to-day operations. In particular, development of appropriate management systems for preventing the leaking or divulgence of trade secrets to outsiders has become essential in recent years. The firm provides advice both to startup ventures and large corporations, as well as universities and other educational institutions, in connection with internal policies and procedures to control, protect, acquire, and utilize intellectual property according to the specialty, business, and operations of those entities.

The firm also advises on control systems for customer information and other personal information, which have become increasingly important given recent legislation focusing on protection of the privacy of personal information maintained by companies.

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Trademark Prosecutions

The firm's trademark team, which consists of both attorneys-at-law and trademark attorneys, provides a broad range of services in the field of trademark prosecutions, including prior trademark searches, advice on trademark portfolio strategies, and filing of trademark applications, and also handles cancellation trials both in and outside Japan. The firm has established Mori Hamada & Matsumoto Intellectual Property Co., Ltd. in China, where issues related to trademark rights are a particular concern, in order to provide one-stop services regarding trademark rights and copyrights in China through seamless coordination between the firm's Beijing Office and the firm's trademark team in Tokyo (please see page 11).

Cutting Edge and Specialized Legal Services

The firm's IP practice group regularly holds internal workshops to study and analyze the latest relevant judicial precedents and share knowledge and know-how obtained through the experience of each attorney in order to improve the quality of services provided by the practice group as a whole. The firm often sponsors IP-related seminars and lectures for the benefit of clients and encourages its attorneys to publish articles on topics of current legal interest in the intellectual property field.

Experience

Featured below are just some of the many intellectual property matters that the firm's attorneys have handled.

2022

- Represented an overseas telecommunication vendor, intervening in patent infringement lawsuits at the Tokyo District Court, and successfully obtained court decisions completely denying the claims of the plaintiffs
- Represented a Japanese company in a lawsuit filed with the Tokyo District Court in which a former employee made a claim for damages regarding infringement of trade secrets, and successfully obtained a court decision completely denying the claim of the plaintiff
- Represented a major Japanese pharmaceutical company in a patent infringement lawsuit filed with the Tokyo District Court regarding assistive devices for physical disabilities, and successfully obtained a court decision completely denying the claim of the plaintiff
- Represented a Japanese company in a patent infringement lawsuit filed with the Tokyo District Court regarding an image production system for video cameras, and successfully reached a settlement agreement with the plaintiff under the direction of the presiding judge, by which the plaintiff withdrew all of its claims
- Successfully took measures on behalf of Japanese companies against imitations and pirated copies (of communications technology, machinery, vehicles, pharmaceuticals, beauty appliances, game software, and animation, etc.) in China and other Asian countries by arranging for the execution of administrative raids and lawsuits in relation to trademark and copyright infringements
- Filed, on behalf of Japanese companies, for trademark invalidation relating to a trademark that had been applied for (using a misappropriated application) and registered in China without authorization and successfully obtained a trial decision and judgment invalidating the trademark (in industries including those for machinery tools, machinery, automobile parts, pharmaceutical manufacture, and services)

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- Advised a number of Japanese companies on the licensing of rights for Japanese content to Chinese and other Asian companies
- Provided advice and other services to Japanese companies with respect to portfolio diagnosis for, and strategies for the application of, trademarks and designs both in and outside Japan and undertook procedures for the filing of an application and intermediate treatments on behalf of those Japanese companies
- Assisted Japanese manufacturers in entering into a technology license agreement with a Chinese state-owned company

2021

- Represented an overseas telecommunication vendor, intervening in a patent infringement lawsuit at the Tokyo District Court, and achieved complete victory
- Represented a Japanese company in a trademark trial decision revocation action in the Intellectual Property High Court, resulting in a favorable settlement
- Involved in the invitation to host an international sporting event in Japan in 2022
- Involved in hosting IChO (International Chemistry Olympiad) 2021 JAPAN as an online event
- Involved in the development of NFT conversion schemes and licensing agreements for a wide variety of digital content, and advised the establishment of numerous NFT marketplace trading services including art auctions.

2020

- Represented an overseas semiconductor manufacturer in a patent infringement lawsuit at the Tokyo District Court and achieved complete victory (waiver of the entire claim)
- Represented an overseas smartphone manufacturer in proceedings filed against Tokyo Customs by a non-practicing entity regarding the suspension of customs clearance for a patent right and obtained a ruling of non-acceptance (dismissal of claim)
- Conducted, on behalf of a Japanese company, negotiations to purchase a domain name with an individual located in Europe and succeeded in achieving the purchase based on reasonable conditions

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2019

- Filed, on behalf of a Japanese system development vendor, a patent infringement lawsuit against a foreign competitor at the Tokyo District Court and achieved a winning settlement obligating the other party to purchase products
- Assisted a Japanese material manufacturer in negotiating and drafting an agreement concerning licensing of a patent and know-how to a European company
- Filed, on behalf of a Japanese company, a request with WIPO's domain resolution center for the transfer of a domain and succeeded in enabling the transfer
- Advised on the establishment of a joint venture operating a film distribution business, etc. between a Japanese company and a U.S. company
- Assisted in requesting an invalidation trial concerning a trademark that had been applied for using a misappropriated application in Vietnam
- Assisted Japanese companies in arranging for the execution of administrative raids and requesting an invalidation trial concerning patent infringement in China (daily necessities, beauty appliances, game software, etc.)

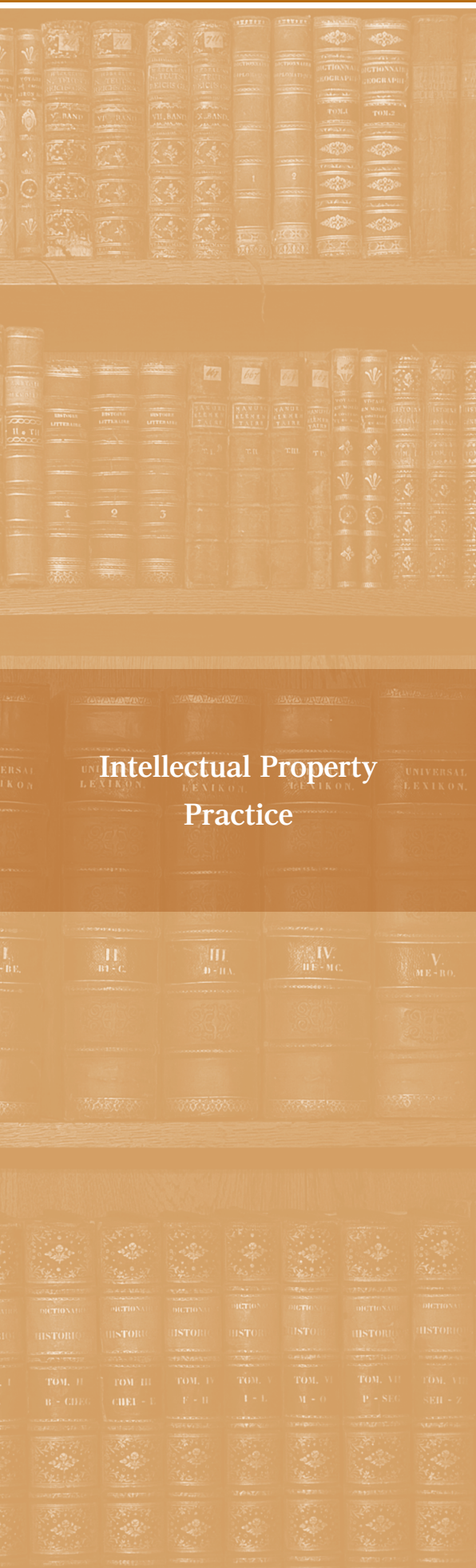
2018

- Represented a French life sciences company in a lawsuit against a global pharmaceutical company (at the Intellectual Property High Court) seeking rescission of a trial decision for a bioengineering patent and achieved victory in the case by obtaining a decision invalidating the patent
- Represented a Japanese subsidiary of a major U.S. pharmaceutical company in a lawsuit against a global pharmaceutical company (at the Intellectual Property High Court) seeking rescission of a trial decision for a patent related to molecularly targeted therapy and achieved victory in the case by obtaining a decision invalidating the patent and rescinding the trial decision
- Represented a Japanese subsidiary of a major U.S. pharmaceutical company as an appellee (defendant) in an appeal (at the Intellectual Property High Court) of a patent right infringement lawsuit regarding an anticancer drug and achieved victory in the case by obtaining a decision dismissing the appeal and the claim; in addition, in a related case seeking rescission of the Japan Patent Office's trial decision for the continued

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maintenance of a patent (at the Intellectual Property High Court), the firm represented the appellant and achieved victory in the case by obtaining a decision invalidating the patent and rescinding the trial decision

- Represented a Japanese IT company in patent infringement lawsuits brought before multiple courts in China by a Chinese company and achieved a winning settlement dismissing the claims without imposing any responsibility on our client
- Represented a Japanese game software manufacturer in a copyright infringement lawsuit brought before the Beijing High Court against a Chinese game software manufacturer and achieved victory in the case by obtaining a decision dismissing the appeal, obtaining an injunction, and securing damages
- Represented a Japanese automobile parts manufacturer in a case seeking the following brought by a major non-practicing entity (NPE) and achieved complete victory by obtaining a decision dismissing the claims and invalidating all patents: an injunction on the import of products, brought before the U.S. International Trade Commission; and an injunction on the import of products, as well as damages, brought before the U.S. District Court for the Eastern District of Michigan
- Represented a Japanese machinery manufacturer in a case requesting an invalidation trial concerning a trademark that had been applied for using a misappropriated application in China and achieved victory in the case by obtaining clarification of the trademark's protected status as a "well-known trademark" and invalidating the trademark that had been applied for using a misappropriated application in China
- Represented a patentee in a lawsuit (at the Intellectual Property High Court) seeking rescission of a trial decision that was filed against a trial decision to continue maintenance of a common use patent for an anesthetic belonging to U.S. and European pharmaceutical companies and achieved victory in the case by obtaining a decision maintaining the patent
- Represented a major Japanese SNS company (defendant) in an infringement lawsuit based on a patent for a service providing mobile handset characters and achieved victory in the case by obtaining a decision dismissing the appeal
- Assisted a major Japanese pharmaceutical company in negotiating a pharmaceutical license agreement with a major U.S. pharmaceutical company



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- Assisted a major Japanese apparel company in negotiating and drafting an agreement concerning the transfer of a cross-national brand (trademark)

2017

- Represented a system development vendor in a lawsuit seeking damages on the grounds that the vendor defaulted on obligations related to development of a system, and in a lawsuit seeking damages on the grounds that a user breached its obligation to cooperate with the vendor (at Sapporo High Court) and achieved victory in both cases
- Represented a toy wholesaler (at the Tokyo High Court) in a lawsuit seeking damages on the grounds that a vendor defaulted on obligations related to development of a system (of which the toy distributor was a user) and achieved victory
- Represented a major U.S. pharmaceutical company as a patentee in a request to the Japan Patent Office for an invalidation trial concerning a sedative utility patent and achieved victory in the case by obtaining a decision enforcing the continued maintenance of the patent
- Represented a major Japanese SNS operator as a defendant in a case seeking damages for a software-related patent infringement (at the Tokyo District Court) and achieved victory in the case by obtaining a decision dismissing the claim
- Represented an automobile parts manufacturer in a patent infringement lawsuit filed by a competitor (at the Tokyo District Court) and achieved victory in the case by obtaining a decision dismissing the claim
- Represented a Japanese beverage company in the filing of a litigation appealing a verdict in a trial revoking a trademark due to non-use brought by a competitor and achieved a winning settlement
- Represented a Japanese automobile parts manufacturer in a patent invalidation procedure (through inter partes review, IPR) requested in opposition to a patent infringement lawsuit filed by a non-practicing entity (NPE) before the U.S. District Court for the Eastern District of Michigan and achieved complete victory (invalidating all patents)
- Represented a Japanese game software manufacturer in a copyright infringement lawsuit brought before the Beijing Intellectual Property Court against a Chinese game software manufacturer and achieved victory by obtaining an injunction and securing damages

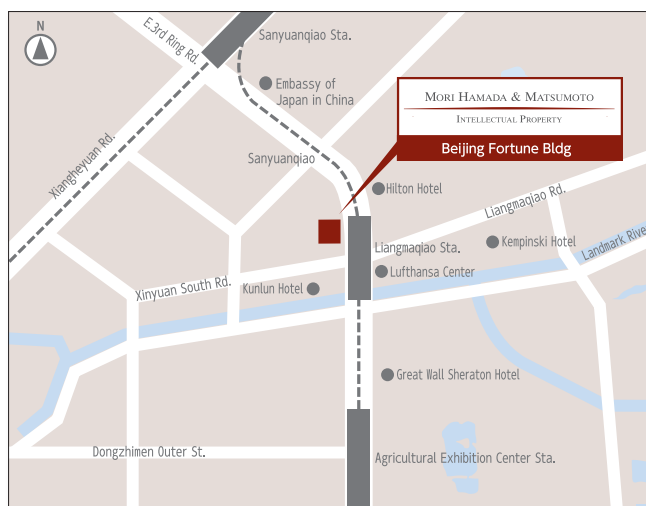
Mori Hamada & Matsumoto Intellectual Property Co., Ltd.

Mori Hamada & Matsumoto established and started operations of Mori Hamada & Matsumoto Intellectual Property Co., Ltd. (Executive Director: Yoshifumi Onodera) in Beijing, the People's Republic of China. The company is an affiliate of our firm which specializes in handling operations such as trademark applications and trials in China.

By establishing the new company, we have put in place a system that enables us to provide our clients with one-stop services in relation to businesses including observation of usurped trademarks, prior trademark investigations, trademark application procedures, trademark-related trials, administrative exposure, and copyright registration in China.

In China, damage caused from fraudulent acquisition of trademarks by third parties (usurped application) and counterfeits and pirated copies that infringe trademark rights and copyrights is still serious, and it is not necessarily easy to engage local attorneys who can deal with these problems in a professional and appropriate manner.

We provide high quality service, as expected of a Japanese law firm, in order to obtain, execute, and protect trademark rights of our clients in China, by coordinating seamlessly with our Beijing Office, staff team in Tokyo in charge of trademark affairs, and the new company.



Establishment: September 2020 (Opened on January 2021)

Representative: Executive Director and General Manager

Yoshifumi Onodera

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Beijing 100004, The People's Republic of China

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E-mail: yoshifumi.onodera@mhm-global.com

Business operations: Trademark applications (including trademark investigations), interim procedures, opposition to the grant of trademarks (including monitoring of usurped application), requests for cancellation of a registered trademark not in use, trials against a decision of final rejection, requests for declaration of invalidity, monitoring and investigation of counterfeits, administrative exposure, take-down of electronic commerce sites, suspension at customs, copyright registration, and procedures for cancellation of domain name registration

Awards and Rankings

Featured here are just some of the many awards and industry-related rankings received by the Intellectual Property Practice Group and its individual members.



Mori Hamada & Matsumoto



Mori Hamada & Matsumoto



Mori Hamada & Matsumoto

Chambers Global 2023

The firm is ranked highly in the practice area of "Intellectual Property," and our lawyers named below are evaluated favorably by Chambers Global 2023.

JAPAN

Intellectual Property
Domestic

Yutaka Miyoshi
Atsushi Okada

CHINA

Intellectual Property (International Firms)
Expertise based abroad in Japan

Yoshifumi Onodera



Mori Hamada & Matsumoto

Chambers Asia-Pacific 2023

The firm is ranked highly in the practice area of "Intellectual Property" and "TMT," and our lawyers named below are evaluated favorably by Chambers Asia-Pacific 2023.

JAPAN

Intellectual Property

Yutaka Miyoshi
Atsushi Okada

TMT

Atsushi Okada



The Legal 500 Asia Pacific 2023

The firm is ranked in the Tier 1 for the practice area of "Intellectual property" and "TMT," and our lawyers named below are evaluated favorably by The Legal 500 Asia Pacific 2023.

Leading individuals
Intellectual property

Yutaka Miyoshi
Yoshifumi Onodera
Atsushi Okada

TMT

Hiromi Hayashi
Atsushi Okada

Rising Stars
Intellectual property

Hideaki Kuwahara



The 2024 edition of The Best Lawyers in Japan™

Our lawyers named below are recognized in the practice areas of Intellectual Property Law, Technology Law, Patent Law, Arbitration and Mediation, Litigation, Media and Entertainment Law, Information Technology Law, Sports Law and Fintech Practice.

Best Lawyers

Takuya Iizuka
Hiroki Saito
Tsunemichi Yokoyama
Yutaka Miyoshi
Yoshifumi Onodera
Atsushi Okada
Tetsushi Kamimura
Hiroyuki Tanaka
Masafumi Masuda
Yoshinori Tatsuno
Susumu Sasaki

Ones to Watch

Kento Hirata
Shun Watanabe



asialaw 2023-24

The firm is ranked highly in the practice area of "Intellectual property," "Dispute resolution," "Media and entertainment" and "Technology and telecommunications," and our lawyers named below are evaluated favorably by asialaw 2023-24.

Intellectual property
Distinguished practitioner
Yutaka Miyoshi

Notable practitioner
Atsushi Okada
Hiroyuki Tanaka

The 2023 World Trademark Review 1000

The World's Leading Trademark Professionals

The firm is selected as one of the leading firms in Japan and our lawyers and patent attorney named below are recognized as leading individuals in Japan.

Yutaka Miyoshi Individuals: Enforcement and litigation
Yoshifumi Onodera Individuals: Enforcement and litigation
Atsushi Okada Individuals: Prosecution and strategy
Naofumi Tanaka Individuals: Prosecution and strategy

IAM Patent 1000

The World's Leading Patent Professionals 2023

The firm is ranked highly for its litigation and transactions practice. Also, our lawyers are recognized as leading individuals in Japan.

Yutaka Miyoshi
Yoshifumi Onodera
Atsushi Okada
Tetsushi Kamimura

IAM Global Leaders 2023

Our lawyer named below is recognized as one of IAM Global Leaders.

Atsushi Okada

ALB ASIA IP Rankings 2023

The firm is ranked highly (Tier 1) in the practice areas of "Patents" and "Copyright/Trademarks" in the Japan Domestic category.

Benchmark Litigation Asia-Pacific 2023

The firm is ranked highly in the practice area of "Intellectual property," and our lawyers named below are evaluated favorably by Benchmark Litigation Asia-Pacific 2023.

Yutaka Miyoshi

The Nikkei's "Corporate Legal Tax Affairs and Lawyer Survey 2022"

In the "Corporate Legal Tax Affairs and Lawyer Survey" published by Nikkei Inc., the following lawyers have been chosen as the Best Performing Lawyers of 2022 (as selected by companies and overall (by both companies and lawyers)).

Yutaka Miyoshi

Yoshifumi Onodera

Tetsushi Kamimura

Hiroyuki Tanaka

Masafumi Masuda
