

Partner

Takamitsu Shigetomi

Osaka Bar Association, Japan Federation of Bar Associations (1999)
Japan Patent Attorneys Association (JPAA)
New York (2005)
American Intellectual Property Law Association (AIPLA), International Association for the Protection of Intellectual Property (AIPPI)
Location
Osaka Office and Tokyo Office and Nagoya Office

Practice Areas

Intellectual Property Law

Intellectual Property Transactions / Unfair Competition / License and Franchise / Intellectual Property Dispute Resolution

Dispute Resolution

Intellectual Property Dispute Resolution / International Dispute Resolution / Product Liability / Corporate Litigations, Disputes and D&O Liabilities

International Practice

International Commercial Contracts / International Dispute Resolution / North America / Europe / Chinese Practice / Asia/Emerging Countries Desk / Mexico, Central America, South America, and the Caribbean / Africa / Middle East

Energy and Infrastructure

Electricity / Gas

Industries

Environmental Law / Entertainment / Information Technology, Internet and Telecommunications / Sports

Corporate and M&A

General Corporate Practice / Corporate Litigations, Disputes and D&O Liabilities / Corporate Governance/Shareholders Meeting / Venture and Startup Support

Risk Management & Compliance

Corporate Investigation / Product Liability

Life Science, Pharmaceutical and Healthcare

Research and Development / Business-Academia Collaboration / Labelling and Advertising regulation / Dispute Resolution / Health and Nursing Care / Cosmetics & Health/Beauty Care Products

Personal Data, AI, IT and Digital

Data Breach & Incident Response / AI, Machine Learning

Professional Summary

Takamitsu Shigetomi is a partner who is in charge of Intellectual Property Practice Department in the Oh-Ebashi LPC & Partners. Mr. Shigetomi specializes in intellectual property licensing and litigation of all types and has prepared, tried and argued intellectual

property cases in various technical fields including pharmaceuticals, biotechnology, chemistry, mechanical engineering, electric engineering and computer software. Mr. Shigetomi has been lead counsel in major patent infringement litigation in Tokyo and Osaka district courts and IP high court.
Mr. Shigetomi is a frequent author and lecturer on intellectual property practice topics, and teaches courses as an adjunct professor of (i) Graduate School of Science, Technology and Innovation at Kobe University and (ii) Graduate School of Intellectual Property at Osaka Institute of Technology.
Mr. Shigetomi has received many professional accolades such as Chambers Asia-Pacific, Who ' s Who Legal Patents, Who ' s Who Legal Japan - IP Litigation and Best Lawyers.

Major Cases Handled

- Patent infringement case between an originator drug manufacturer and a generic drug manufacturer
- Patent infringement cases between antibody drug manufacturers concurrently litigated in several countries
- Action to rescind a trial decision concerning the registration of an extension of the term of a medical patent
- Negotiation with a foreign company to conclude a patent license agreement for inventions related to a regenerative medicine
- Large-scale patent infringement case concerning electric equipment
- Dispute between semiconductor precision devices manufacturers concerning trade secrets
- Trademark infringement case concerning a brand-name product

Education & Professional Experience

2003
University of Washington School of Law (LL.M.)

1997
Osaka University (LL.B.)

Activities

2019-present
Member of the AIPPI Standing Committee on Standards and Patents

Publications

2023.02.28	National Comparison Tables - Japan part
2022.12.16	JAPAN: An Introduction to Intellectual Property: Bengoshi
2022.07.15	The Intellectual Property and Antitrust Review 7th edition Japan Part
2021.07	The Intellectual Property and Antitrust Review 6th edition Japan Part
2021.04	International Advertising Law：Second Edition［JAPAN］
2020.07	The Intellectual Property and Antitrust Review 5th edition Japan Part
2019.11	Legal Practice Concerning Joint Research and Development Agreements
2017.03	International Design Protection in Japan
2016.11	Filing a Lawsuit before the Japanese Court with regard to the Disputes Over Ownership of the Right to Obtain Patents and Patent Rights in Foreign Countries
2016.05	Legal Counseling on Unfair Competition Prevention Act I and II (Updated Seirin Shoin Legal Counseling Series No. 8)
2016.04	Special Article: Actions in Response to the Revision on the Employee's Invention System
2016.02	The Front Line of Intellectual Property Law — Revision on the Employee's Invention System
2015.03	Practitioner's View on Recent Development of IP Disputes
2014.09	On " The Essentials of Solving Problems " concerning the Provisions on Multifunctional Contributory Infringement (The Central Research Institute of Intellectual Property of the Japan Patent Attorneys Association, Research Report No. 37 " Studies on Contributory Infringement ")
2014.09	Interpretation of Functional Claims: Doctrine of Literal Infringement and Doctrine of Equivalents

2014.05	International Advertising Law [Japan]
2014.04	Unfair Competition
2014.02	How to avoid legal risk of assertion of derivation and breach of joint application provision in the course of business activities
2013.08	Relationship between Trademark and Well-known Mark – Focusing on the Doctrine of Abuse of Trademark Right against Well-known Mark
2012.06	Commentaries on Unfair Competition Prevention Act (3rd Edition)
2012.05	Patent Term Extension System-Practice under Revised Examination Guideline in 2011
2012.03	International Design Protection in Japan (Global Handbook, Globe Law and Business, May 2012) - “ Theory and Practice – Damage arising out of Intellectual Property Right Infringement
2011.12	Effect of Revision of Derivation Proceeding against Patent Invalidation Trial Proceeding in Japan
2011.10	Doctrine of Equivalents – Analysis of IP High Court Decision [Portable Communicator Case]
2010.12.01	Trademark License Dispute Regarding Mark for a Foreign Brand - Practical considerations when entering into a sub-licensing agreement-
2009.11.01	Analysis of University-Industry Collaboration from legal and contractual perspective
2009.10	Supreme Court Decisions in Intellectual Property Laws – Celebrating 77th anniversary of Mr. Shoen Ono ’ s birth
2009.05.15	Double-track phenomenon in JP patent disputes – JP Patent Law Art. 104-3 and Supreme Court Decision on April 24th 2008.
2009.05.14	Consultation on Trademark Law
2009	Report on Research regarding arrangement of patent in joint R&D phase (Drafting Chapter II Provisions of co-owned patent)
2008.04.25	Latest Intellectual Property Case Law - Celebrating 60th anniversary of Mr. Yoichiro Komatsu ’ s birth
2008.03	Analysis of Revision of Japanese Patent Law for Indirect Infringement (Article 101(2) and (5))
2008.03.01	Relationship Between Assignment of Component/Licensing of Component Patent and Enforcement of Final Product Patent -Analysis of scope of exhaustion and implied license-
2008.01.01	Exhaustion of Patent/Damage for Patent Infringement (“ Film Unit with Lens ” Case) -Review in Relation to Judgments in IP High Court in 2006 and Supreme Court in 2007-
2007.11.01	Inevitable Disclosure Doctrine in the United States Trade Secret Law
2007.06.25	Theory and Practice on Intellectual Property related Agreement
2006.12.07	Legal Consultation on International Intellectual Property Dispute Resolution
2006.09.15	Review on Unfair Competition Prevention Act 2(1)14-Analysis on New Trend for Recent Judgments of Tokyo High Court and Tokyo District Court
2004.06.30	Reasonable remuneration for assignment of right to obtain a patent - Shuji Nakamura v. Nichia Kagaku Kogyo K.K. - “ Blue LED ”
2004.04.01	Patent Litigation and Estoppel-Analysis on Prosecution History Estoppel in the U.S. and Applicability into Japan
2004.03.15	Patent Litigation and Estoppel-Analysis on Prosecution History Estoppel in the U.S. and Applicability into Japan
2004	Two Judgments on Japanese Patent Law Article 35 Amazed Industry All Over the World
2003.04	The Federal Circuit Reaffirmed that the Copyright Act did not Preempt or Narrow the Scope of Shrink-wrap License Agreement that Prohibited Reverse Engineering
2003.01	Is Legal Protection of Trade Secrets in Japan Enough?
2002.03	Imitation of Configuration of Product under the Unfair Competition Prevention Act
2002.01.10	Trade Secret

Seminars/Lectures

2026.05.21	Kansai Intellectual Property Seminar (May 21) SEP Names and the Front Lines of International SEP Disputes - Learning about plaintiff-defendant litigation and licensing strategies in the US and Europe through hypothetical cases
2022.10.04	【Onilne Seminar】Life Science Practice Seminar No.8: Legal Practices for Settlement of Pharmaceutical Patent Disputes
2019.08.27	【Tokyo】Seminar on the Amendments to the Unfair Competition Prevention Act to be enacted on July 1, 2019
2019.07.09	【Nagoya】Seminar on the Amendments to the Unfair Competition Prevention Act to be enacted on July 1, 2019
2018.05.30	【Osaka】Understanding in 90 Minutes! - Overview of the Changes Made to the Employee's Invention Reward System by the 2015 Amendment to the Patent Act and Remaining Issues
2018.05.24	【Tokyo】Understanding in 90 Minutes! - Overview of the Changes Made to the Employee's Invention Reward System by the 2015 Amendment to the Patent Act and Remaining Issues
2017.02	Strategic Practices for Cross-Border Licensing -- Challenges of Licensing in China and Solutions Thereto
2017.02	Points to Know about the Intellectual Property System that Supports Development of Gaming Industry The Chubu Bureau of Economy
2016.11	Proof of Damages in Global Intellectual Property Litigation and Important Practical Issues Thereon - Options concerning Intellectual Property Damages and the Role of Economists
2016.06	Strategic IP Management (Practical Measures for Obtaining Registered Intellectual Property Rights and Keeping Intellectual Property as Trade Secrets with Prior User Rights)
2015.11.11	U.S. Patent Seminar Practical Points to Note in Securing the Confidentiality Privileges in the Phases of Patent Application and Litigation: The Attorney-Client and Work Product Privileges in the U.S. -A Practical Application for Japanese Companies
2015.10	Technology and Law: Risk Avoidance and Creation of Opportunities
2015.07.08	[Intellectual Property Seminar] Implementation in Companies of the Employee Invention System (in View of the Current Law and Its Amendment)
2008.04	Adjunct Lecturer of Kwansei Gakuin University Law School, teaching Intellectual Property Law (Patent/Copyright Law) and Intellectual Property Law Seimnar (Patent/Copyright Case Law)
2006.04.19	Visiting Associate Professor of Faculty of Intellectual Property at Osaka Institute of Technology, teaching Anglo-American Law / U.S. Patent Litigation Practice
2006.04.19	Visiting Associate Professor of Graduate School of Intellectual Property at Osaka Institute of Technology, teaching Comparative Patent Law in U.S., EU & Japan / U.S. Trade Secret Law
2006.04.01	Adjunct Lecturer of Graduate School at Kyusyu University, teaching Intellectual Property Law

Languages

Japanese and English