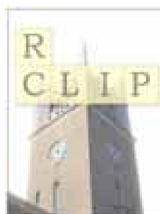
ISSN 1880-3245
August 2005, No.6
http://www.21coe-win-cls.org/e_index.html

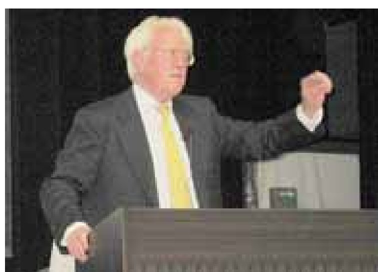


Newsletter

21COE-WIN-CLS RCLIP

RCLIP Special Seminar (5/9/05)

"Issues resulting from Global R&D Activities: Foreign Licensing Issues and Inventorship or Ownership Disputes"



On May 9, 2005, the RCLIP held the Special Seminar, inviting Prof. Keisuke Shimizu (Keio University, Faculty of Business and Commerce, Director of Intellectual Property Center, Keio University), Mr. Paul Meiklejohn(Patent Attorney at Law in the U.S., Dorsey & Whitney, Lecturer of University of Washington School of Law), Dr. Heinz Goddar(Patent Attorney at Law in Germany, Boehmert & Boehmert) and Prof. Toshiko Takenaka (University of Washington School of Law, Waseda Law School).

To begin, Mr. Akira Fujiwara, Manager of Intellectual Property, Intellectual Property Division of Tokyo Medical and Dental University that was a co-sponsor of the event, gave an opening remark, introducing "IP Expert Development Program" uniquely adopted by their life science department.

The seminar itself started with Prof. Keisuke Shimzu's report on various issues occurring when rights belong to universities, and solutions for those issues. Specifying the inventor through an interview has been working effectively, resulting in increasing number of cases where a student is determined as an inventor. Under the policy of the government, each university can set up its rule freely on inventorship. As a result, most of the national universities adopted the rule for employee's invention when they became independent administrative institutions. The process to make inventions belong to universities is as follows: The universities select the inventions from all the reported inventions born in the university laboratories. For the selected inventions, they cover the patent application cost and share the royalty distribution. For the non-selected, they returned the right to the inventors. Prof. Shimizu also explained the issues concerning the university inventorship such as the IPR management, comprehensive cooperation, and a consortium. Those issues have arisen in the relations between TLO and universities.

Next, Mr. Paul Meiklejohn presented about compensation to inventors, priority order of inventorship, and requirements for joint inventor. Because the United States takes the first-to-invent rule, the person who conceived the idea first becomes the inventor. The priority order is very important and the requirements depend on whether the technology is predictable or not.

The reduction to practice of the conception needs only ordinary skill when it is a predictable technology. However, when it is unpredictable, the outcome is uncertain until the reduction to practice. On the other hand, it cannot be proved that the unpredictable technology really works well until the actual reduction to practice. There is no conception here. In this case, a true inventor is the person who reduces the invention to practice, not the person who invented the conception. Mr. Meikeljohn introduced various cases including the case of *Burroughs Welcome* and the case of *Smith v. Bousquet*.

ISSN 1880-3245
August 2005, No.6
http://www.21coe-win-cls.org/e_index.html

He explained when we apply the doctrine of simultaneous conception and reduction to practice in determining inventorship, the inventor is not the person who conceived the idea, but the person who actually reduced it to practice. Introducing the case of *Fina Oil v. Ewen* in California that used this doctrine to determine the joint inventor, he mentioned that the doctrine should not be applied because it was only a "hope" to be successful that the person who had the conception could hold for the unpredictable technology. He raised the issues occurring when the inventorship was uncertain such as naming a wrong inventor, invalidating the patent by the fact the inventor was not correct, and causing dilution of the patent. To avoid the errors, he concluded that it was necessary to provide researchers with knowledge of the inventorship, to record the inventor clearly, and to clarify the inventorship by recording the inventor's contribution and collaboration.

Dr. Heinz Goddar presented about the circumstances and framework concerning the patent in Germany. First, he introduced two laws regarding compensation for inventions and inventorship. One was the German Constitution that included the right concerning research and education. The other was the German Employee's Inventions Act. According to his presentation, the employee's inventions included both those originating from employees' regular work and those based on the experience gained through their employment. For example, even if a doorman who had worked for a chemical factory, noticing an oil leak when watching trucks coming and going, came to conceive the idea of a safety valve 15 years later, the invention would be considered as an employee's invention.

The invention belongs to the employee, who has a duty to notify the employer of the invention. Within two months after the notification, the employer can object to it because of incompleteness. In the case of several joint inventors, the employer can file an objection when the information about the contribution rate between the joint inventors is missing. Within four months of receiving the notification, the employer can make the invention belong to it by declaring an unrestricted claim of the invention. If the employer acquires the right of invention, it has a duty to file a patent application.

Making the invention a trade secret depends on the employer's discretion. But the employer must notify the judgment to the employee and recognize the patentability. The employer must provide remuneration to the employee when it decides to hold the invention as a trade secret as much as when it files the invention as a patent. If the invention is determined as non-patentable, the employee cannot receive remuneration. However, when it is the trade secret, the employer can ask the Arbitration Committee for Employee's Inventions to examine the invention in a secret manner to judge its patentability. If it is patent-able, reasonable remuneration is calculated.

A guideline provides the methods for calculating remuneration. In Germany, an employee can object to the remuneration up to six months after termination of employment. So the method uses the license analogy basically. It also uses the assumption of the contribution ratio and the reduction rate to the sales. For the patent application abroad, the employer must report to the employee because the employee can file the application unless the employer does so.

University professors did not have to report their inventions to the universities until February 5, 2003. The new law was enacted, prohibiting professors from transferring their inventions to a third party without notifying their universities. When the specific provisions for professors became invalid, all universities had a duty to open TLOs. Dr. Goddar added that the Berlin Contract was used as a guideline in many cases.

Afterward, Professor Takenaka moderated the panel discussion and a QA session with the audience followed. A reception was held, sponsored by Dorsey & Whitney that Mr. Paul Meiklejohn worked for. (RA Akiko Ogawa)

ISSN 1880-3245
August 2005, No.6
http://www.21coe-win-cls.org/e_index.html

R
CLIP

RCLIP Workshop Series No.9 (6/27/05)

"Copyright Rule at Universities – Strategies at Keio University"

Naoki Koizumi, Professor of Law, Keio University

The RCLIP Workshop Series No.9 invited Prof. Naoki Koizumi for a lecturer. Prof. Koizumi pointed out universities' role to be fulfilled despite of certain risks occurring when copyrights belong to universities because of insufficiency of the current Copyright Law. Chapter One of Intellectual Property Strategic Program 2005 by Japanese government prescribes, "Promoting the Creation of Intellectual Property at Universities and Public Research Institutes". For the copyright, ①clarifying rules making software, database or digital contents belong to institutions, ② clarifying whether or not copyrights are open to society free of charge, and ③preparing the rules for submitting research results. Traditional model on universities and copyright has been based on personal writings such as a thesis or a lecture note. However, the scope of work made for hire (Article 15) is limited and the meaning of "made for hire" comes to an issue. Prof. Koizumi explained that making a lecture note was not a professor's task because a university was a community of independent researchers, which is different from a corporation.

Next, he introduced how they looked at copyrights and universities in the United States. In the US, the custom of individualism was firmly established and they were very cautious about approving the work for hire. In the decision for the case of *Weinstein v. University of Illinois*, 811 F.2d 1091,7th Cir.1987, the court concluded that a thesis written by an Assistant Professor of Pharmacy Administration based on a clinical program funded by the university is not a work for hire under academic tradition even though a dean asked him to write it for promotion.

According to "Universities and Intellectual Property (2003)" by Monotti&Ricketson, the rules of universities vary, but have a tendency of individualism as a common clause. For example, the invention does not belong to the university even when the inventor used the university's resource to complete it. However, if the inventor makes a profit with the invention, the inventor must return the fund used for the invention (except for the case of computer program).

Recently many people rather than one person involve with works at universities in many cases due to changes of circumstances. Universities are required to fulfill their new social responsibility of returning the outcome funded by public research funds to the society. If all the work become belong to individuals, it might make rights relations complicated.

Based on the stated points, Prof. Koizumi described what the copyright rule at universities should be. Lectures are instructor's work. E-learning contents using lectures are secondary work of the lectures. It is necessary to have consent of use (belonging to individual). The problem remains who owns the outcome made using digital contents other than e-learning contents or machinery purchased by national or university funding (including machinery after the project was over). A moderate rule is needed for the inventions that are owned partially by universities and partially by individuals (joint ownership). The issues of the rule of joint ownership are 1) determining the scope, for example, limiting to digital contents, including theses, or defining the reason why the right of database or software is protected more than that of writings, 2) determining the distribution. For example, transfer of license needs "consent of

all"(Article 64&65). In that case, the rights should divide into exclusive and non-exclusive to let right owners transfer non-exclusive rights without consent of other owners. The profit must be distributed by proportion of ownership. (In a QA session, it was pointed out that the Copyright Law did not include a kind of work existing between work for hire and individual work, and admitted joint ownership only for joint work. Unless it set a special clause for not exercising moral rights, it would be a mistake to use the word "joint ownership" as a technical term.) It seems many issues left to discuss since the copyright rule at universities has not been established yet.

Lastly, Prof. Koizumi introduced the rule development for copyright work distribution at universities. First, he mentioned the DRM that was implemented already in centralized management of music copyright. He presented the possibility to implement DRM management of copyright work of universities by establishing a digital management center. In Hollywood, people talk about the digital cinema that can trace its use by using GPS whenever it takes place. But it is desirable to invent a more practical and inexpensive tool for universities. In addition, he mentioned the Open Source as one of soft distribution rules, which enables universities to return the public-funded research outcome to the society and to send their intelligence out to the world. However he stated that the implementation should be carefully determined in advance because some do not like the Open Source such as GPL.

The QA session followed the stated report actively with the participants.

(RA Lea Chang)

RCLIP Special Seminar (7/4/05)

"Strategies for International Litigation and IP Dispute Resolution System in Japan"

On July 4, 2005, the RCLIP held an open lecture at Waseda law School on IP Dispute Resolution Law as the RCLIP Special Seminar. 167 participants attended the seminar including respected academics, legal professionals, business practitioners specialized in IP in addition to Waseda Law School students. Abe, Ikubo & Katayama Law Office and Nakamura & Partners Patent and Law Office sponsored the reception after the seminar.

As market globalization is developed, there is more risk that IP dispute might occur not only in Japan but also in the US and European countries concurrently. Responding the trend, Waseda Law School offers both Japanese and Western IP Dispute Resolution Law courses to provide students with political views as well as practical skills.

This Special Seminar consisted of two parts: counseling and panel discussion. As a combined class of two courses at Waseda Law School, the first part of the seminar described the fictitious legal case of a client counseling skill for international IP dispute and examined several practical strategies for the lawsuit such as forum shopping or letter of warning, depending on legal cost, compensation for damages, and procedure of collecting evidences. Based on the counseling in the first part, the second part held a panel discussion to discuss strengths and weaknesses as well as future problems of Japan's IP Dispute Resolution System, compared with the conditions

of foreign countries.

In the first part, three practicing lawyers: Mr. Eiji Katayama, Mr. Eiji Tomioka, and Mr. Makoto Hattori who had legal experiences in the US or Germany counseled an IP manager acted by Prof. Toshiko Takenaka.

At first, Prof. Takenaka, the client, stated about the facts of a hypothetical international patent infringement case.

The keys for resolution of this case included the client's economic conditions in addition to the legal issues of the dispute. The client wanted to solve the dispute as soon as possible to down the court cost and attorney's fee.

To set up the legal strategy for a lawsuit in the US, Attorney Katayama who acted as a US Patent Attorney explained some characteristics of lawsuits in the US, focusing on discovery procedure, damages remedy, expeditious court proceedings, jury system, and legal cost. In explaining discovery procedure, he introduced a document referring to the possible infringement written by a Project Manager who had received a warning of infringement. The Project Manager handed the document unintentionally to chief of patent division. Attorney Katayama stated that the lawyer for the other party would be convinced of a victory when this kind of documents appeared through discovery procedure. The document could give great advantage to the party in reconciliation. Also Attorney Katayama explained the standard cost of a patent-infringement lawsuit in the US exceeded a hundred billion. The longer the lawsuit takes, the higher the cost will be. Because of that reason, they are making efforts to streamline the legal procedure in the US.

Next, Attorney Tomioka who acted as a Japanese Patent Attorney explained about the issues for a lawsuit in Japan, focusing on legal cost, compensation for damages, preservation of evidence, efforts to streamline the legal procedure, border meager and presumptive provision on method patent, According to Attorney Tomioka, it is important to prepare bill of complaint carefully and start a lawsuit at a sitting, after confirming of no probability of infringement and no ground for invalidation in the patent. If so, the lawsuit could be settled with the cost of 10 to 15 million Yen in some cases. But in this case, translation cost will also occur. The procedure of preservation of evidence has more limit than the discovery procedure. Especially, it is difficult to present fully the necessity of the evidence. More than 50% of lawsuits in Japan take one year to be settled. Most of the lawsuits in Japan are settled within two years.

Attorney Makoto Hattori who played the role of German Patent Attorney explained about the issues for a lawsuit in Germany from the viewpoints of people, goods and capital as well as jurisdiction, evidence and legal cost. In Germany, 13 of 125 district courts only have jurisdiction of patent infringement lawsuits. Dusseldorf and Munich courts deal with those lawsuits mainly. Because both courts have handled many patent cases historically, judges become accustomed to technical judgment in those cases, which assures their stability in judgments. As regards collecting evidence, the Supreme Court gave a rule that it should be approved with a relatively easier basis than before by applying the provisions related to inspection in substantive law. However, even after this decision was announced, it seems the procedure of collecting evidence have not been practiced on the basis stated by the Supreme Court. As regards compensation for damages, Germany has presumptive provision like Japan. But in most of the cases, the court allows appropriate license fee as damages. Germany

ISSN 1880-3245
August 2005, No.6
http://www.21coe-win-cls.org/e_index.html

does not have the rule of three-time compensation that the US has. A part of the attorney's fee is allowed to be claimed to the other party. In many cases, the first trial takes about one year to be settled in Dusseldorf and Munich courts. The average legal cost is about 10 to 20 million Yen. Further discussion continued on other several issues including stopping import of goods produced by the patented method, international jurisdiction and other topics related to the concrete factors of the case.

In the second part, Judge Makiko Takabe (Presiding Judge, Tokyo District Court, Civil Division 47) and Prof. Ryu Takabayashi joined to discuss the current system for IP lawsuits.

First, relating to streamlining legal procedure, Judge Takabe presented about the issues including defense of abuse of right and expert commissioner system. She also mentioned that international jurisdiction or private international law might come to an issue in many cases because of international aspects of IP lawsuits.

After her presentation, Prof. Takabayashi raised an issue on discovery procedure and protection of trade secret in the US. Each panelist explained about respective issues such as protective order in the US, the state of order on the production of evidence in Germany, protective order expanded in April 2005 or in-camera procedure.

Furthermore, Prof. Takabayashi referred to the legal cost and attorney's fee, asking each panelist to explain for the condition in each country. （1） In Germany, there are a legal fixed fee and a time0charge fee as the attorney's fee. The one who won the lawsuit can request for payment of the legal fixed fee to the one who lost the lawsuit. （2） In Japan, the defeated party must pay the legal cost basically, however it does not include the attorney's fee. The attorney's fee is compensated as damage to considerable causal relationship in some cases. （3） In the US, everyone must pay the attorney fees on his own. Exceptionally, as Article 285 of the Patent Law prescribes, the court may award reasonable attorney fees to the prevailing party.

Prof. Takabayashi also mentioned the issues of international jurisdiction and applicable law. Each panelist explained conditions in each country and discussed over the issue.

（COE Research Associate Tetsuya Imamura）

RCLIP Special Seminar (8/25/2005)

"Protection of Traditional Knowledge
and Cultural Expressions of Folklore"

The Protection of Traditional Knowledge and Cultural Expressions of Folklore is the latest topic among IPR related discussions. This seminar invited Prof. Kamal Puri, the University of Queensland in Australia. An RCLIP Research Assistant Yuka Aoyagi, Waseda University, Graduate School of Law, Doctoral Course, also gave a report.

This topic, mainly genetic resource, has been introduced in several symposia in Japan until now. In this seminar, Prof. Kamal Puri presented about overall summary of the currently recognized issues as well as the significance of Folklore culture with the theme of "Protection of Traditional Knowledge and Cultural Expressions of Folklore and Law". Afterward, with the theme of "Overview of the Model Law for the Protection of Traditional Knowledge and Expressions of Culture", Ms. Aoyagi had a report on the overview of the model law by the Secretariat of the Pacific Community that Prof. Puri drafted.

Although the number of participants was small due to a typhoon, many specialists who had

interest especially in the issue came to the seminar. From the floor, some provided information about international conditions on the issue outside of the report by Prof. Puri. To respond the question asking whether or not the stated model law can apply the misappropriation and commercial use of traditional knowledges for medical supplies, Prof. Puri explained about the involvement of international organizations (WIPO and UNESCO) in drafting the model law. The seminar was very successful in providing valuable information that was mostly not released in writings, and having many opinions based on the information.

(RA Yuka Aoyagi)

International Private Law Group

First, I would like to have a brief report on the research trip that Prof. Shoichi Kidana, our group leader, and RA Yuichi Sasaki of our group made to Guadalajara and Mexico City of Mexico from February 24 to March 25, 2005, in order to conduct a research on technology transfer, investment and FTA in Mexico.

To begin with, they did the research at universities and institutions in Guadalajara. In the morning of February 25, they visited Prof. Dr. A. Cruz, Prof. Carlos Enrique, Prof. Guevara Ramos and others of the Graduate School of Law, Panamericana University, Guadalajara to ask about the conditions of Mexican economy and legal system since NAFTA. Panamericana University is a private university but just right for the research on legal conditions of Central and South American countries because it owns several universities and research institutions in South American countries. After that, they visited Guadalajara University to meet Mr. Arroyo, the President of Administrative Economic Science Center, Guadalajara University and also Dr. M. Falck and others at Dept. of the Study of the Pacific, Social and Human Science Center to ask about the Foreign Investment Law, the Intellectual Property Law, and FTA. Also, they exchanged opinions with Prof. Tejo of Guadalajara University about FTA, especially talking about NAFTA and the economic partnership agreement between Japan and Mexico. At the Graduate School of Law, they met Dr. Murillo and Dr. Cervantes to ask about Mexican economy and legal system since NAFTA.

Then, moving to Mexico City, they visited Mr. Cortina, an attorney of Takimoto, Cortina,Farell y Asociados, S.C. on February 28 to discuss the changes of Mexican economy and Japanese companies' movement since NAFTA. On March 1, they met Mr. Yamazaki, an accountant of Deloitte Touche Tohmatsu, Mexico City and others there to talk about the current condition of foreign investment to Mexico as well as Japanese companies' movement. After that, they met Mr. C.Garcia-Fernandez, the head of the Federal Commission for Regulatory Improvement, Economic Ministry to talk about Mexican Foreign Investment Policy and the expansion of FTA. Then, they had a discussion about the intellectual property law with Professor M. Pinchetti, Iberoamericana University. In addition, they asked about the changes of Mexican economy and Japanese companies' movement since NAFTA to Mr. A. Matsunaga, General Manager of Machinery Dept., Mitsubishi de Mexico. On March2, at the Mexican Institute of Industrial Property in Mexico City, which was organized as a foundation by the flow of history, but in fact, corresponds to the Patent Office of Mexico, they had a chance to talk with Mr. Lic. A. Hernandez, Sub Director General of Support Service about the intellectual property legislation and its execution in Mexico. Besides, they collected literature about the Foreign Investment Law, the Intellectual Property Law, and FTA as well as research materials of law in general including the Constitution or the Civil and Commercial Law at universities and other places in Guadalajara and Mexico City. The findings by this research trip will be published all together in

ISSN 1880-3245
August 2005, No.6
http://www.21coe-win-cls.org/e_index.html

the future.

Next, in the quarterly bulletin, "Corporation Law and Society", No. 4, published in May 2005, our group announced the result of the Japan-Korea IP Law, International Private Law Joint Seminar held in September 2004 in Korea, which was introduced in vol.3 of RCLIP Newsletter published in November 2004, and the result of the international symposium, which was introduced in vol4. of RCLIP Newsletter published in February 2005, and the joint research meeting held in November 2004 at Waseda University. The article has the title of "Special Feature: Japan-Korea Comparison – International Private Law Research (2)". With the preface written by Prof. Shoichi Kidana, our group leader, this featured article (2) consists of several theses by the speakers of the symposia. It includes the Max-Planck Institute Proposal introduced by Prof. Annette Kur of the Max-Planck Institute for Intellectual Property, Competition and Tax, a critical observation to the Max-Planck Institute Proposal by Prof. Kwang Hyun Suk of Hanyang University, critical observations by Prof. Tae-Ak Rho of Judicial Training Institute of Korea and Research Associate Takaya Ito, Waseda University to the Principles on Jurisdiction and Choice of Law in Transborder Disputes, Preliminary Draft No.2 that was submitted by the Council to the on January 20, 2004 at the 2004 American Law Institute ("ALI") Advisory Committee, and an observation by Dr. Kyung-Han Sohn, Vice President of Korea Private International Law Association, to the draft Proposal for a European Parliament and Council Regulation on the Law Applicable to Non-contractual Obligations ("RomeⅡ"). It also includes a report by Prof. Dae-Hee Lee of Inha University on the relation between the WIPO Copyright Treaty and the WIPO Performances and Phonograms Treaty and Korean copyright legislation, and a report by Prof. Syunichiro Nakano of Kobe University about the IP disputes and ADR.

Furthermore, on September 3 and 4 of 2005, our group will co-sponsor an international symposium with Korea Private International Law Association in Kyongju of Korea, having the theme as "International Intellectual Property Right and the View from International Private Law". The overview of the symposium is described as the following. The result of the international symposium will be published in our quarterly bulletin, "Corporation Law and Society". This symposium aims to have reports and discussions with participations of joint researchers of International Private Law and Intellectual Property Law in Japan and Korea about several issues on International Intellectual Property Law and International Private Law that our International Private Law Group has been working on. The symposium expects to discuss the following issues.

On the first day of the seminar, Mr. Kong-Woong Choe, President of Korea Private International Law Association will take the chair of the theme of "Various Issues of International Intellectual Property Right "and Dr. Kyung-Han Sohn, Vice President of Korea Private International Law Association, will have a report on "Tourist Attractions and Intellectual Property Right". Then, about the Uniform Domain-Name Dispute-Resolution Policy ("UDRP") adopted at the ICANN for a resolution to trademark-based domain name disputes, Judge Rim Chi Yong, Seoul Central District Court, will talk about "the UDRP and International Jurisdiction Agreement – Focusing on the case of hpwe.com in Korea", referring to the cases in Korea. Mr. Takaya Ito, a researcher of Graduate School of Law, Waseda University and a researcher of Kyoto Comparative Law Center will have a report about the trademark infringement over the Internet. Prof. Gyooho Lee, Kwangwoon University and Ms. Mari Nakayama, RA of the Waseda Institute for Corporate Law and Society, studying in a doctoral course of Graduate School of Law, Waseda University, will talk about "International Discussion Points on Copyright Infringement

over the Internet".

In the morning of the second day, having the theme as "Recent Trend Relating International Private Law", Prof. Kim Moon Hwan, President of Kookmin University will take the chair to have reports and discussions over the recent movements in International Private Legislation. First, Prof. Huan Renting, Tezukayama University will have a report of "Issues of the International Private Law on International Sightseeing Tour. Next, Prof. Masato Dogaichi will explain about the Exclusive Choice of Court Agreement which was adopted on June 30 2005 at the Hague Conference on International Private Law. It has been examined since 1992. In 1999, the "the Hague Draft Convention on Jurisdiction and Foreign Judgments in Civil and Commercial Matters" was submitted and in 2001, it was revised by the Diplomatic Session. After the discussion over the revised draft, the scope of the agreement changed to a much limited, then the draft was fully examined to its completion. Following the report by Prof. Dogaichi, Prof. Tae-Ak Rho, Judicial Training Institute of Korea will have a discussion. Furthermore, Japan is working on the Modernization of the International Private Law. The International Private Law Section of the Legislative Council has been discussing it since 2003. It announced an interim summary report on the Modernization of the International Private Law on March 22, 2005, then after adding some modification based on the discussions, it completed the summary report on the Modernization of the International Private Law on July 12, 2005 at the 28th meeting of the group. The report will be submitted to the Minister of Justice after being discussed at the general meeting of the Legislative Council on September 6, 2005. In relation to this issue, Prof. Masato Dogaichi, Waseda University will have a report on "Recent Movement of Revision of International Private Law in Japan". Then, Prof. Jun Hyok Jang, Kyung Hee University, will have a comment to this report.

In the afternoon of the second day, Prof. Lee Kou Tei, Seoul National University, takes the chair having the theme as "Issues on International Family Law". Prof. Satoshi Watanabe of Ritsumeikan University will have a report on "Issues of International Private Law on Child Abduction", and Prof. Kim Won-Tae, Ph.D.(Chungbuk National University)will have a report on "Legal Issues on International Divorce". In addition, about the "Legal Issues of International Succession between Korea and Japan", Prof. Shoichi Kidana, Waseda University talks from Japanese view and Prof. Kim Sang-Yong (Pusan National University) talks from Korean view, followed by exchanging opinions.

(RA Mari Nakayama)

The RCLIP's
Asian IP Precedents Database Project

※ The database is available in English, free of use. Please visit our database at:
http://www.21coe-win-cls.org/rclip/db/

IP Database Project: China

From July 8 to 18, the RCLIP paid a courtesy call to the collaborators on the Chinese DB project. We examined the issues recognized last year to find possible solutions with Associate Prof. Li Zhenghua of Zhongshan Univ., Judge Zhang Xiaodu, the Third Civil Tribumal in Higher People's Court of Shanghai, Prof. Zhang Ping of Peking Univ., Prof. Wang Bing of Tsinghua Univ., and Prof. Guo He of Renmin Univ. In addition, we asked them for cooperation for the next fiscal year and exchanged opinions about the renewal of the project contract.

In the year of unusual weather, the temperature in China has already reached to 40 degrees Celsius in July. Despite the tight schedule under the burning sun, all the people we met readily assisted our visit to discuss the project, giving us useful advice for achieving the Chinese DB project with a limited budget. Mr. So, a lawyer

ISSN 1880-3245
August 2005, No.6
http://www.21coe-win-cls.org/e_index.html

who helps the project in Shanghai, also gave us some advice.

After that, Prof. Li of Zhongshan Univ. sent us the latest revision (the third version) and the RCLIP has it translated into English smoothly with the help of a translation company.

(RA Yu Fenglei)

IP Database Project: Thailand

Currently 209 Thai precedents have already been placed at the database. More 50 cases will be added within this fiscal year. In addition, the RCLIP will hold the Asian Seminar at Waseda University on October 12, inviting the following four Thai judges of the Intellectual Property and International Trade Court ("IP&IT Court") who are involved with the DB project.

(COE Research Associate Tetsuya Imamura)

IP Database Project: Indonesia

The DB project of Indonesian precedents proceeds steadily under the collaboration with Indonesia's Supreme Court. According to the notice in the middle of August, they finished selecting precedents for the DB and making a list of the precedents. Now they are summarizing the selected precedents. The RCLIP will visit Jakarta again in October to see the progress and discuss the future plan with them.

(RA Yuka Aoyagi)

IP Database Project: Taiwan

The DB Project in Taiwan will start with the help of the project team that Prof. Ming-Yan Shieh, National Taiwan University joins. The project team has two members in addition to Prof. Ming-Yan. One is a lawyer and the other is a judge. Both are IP specialists in Taiwan.

The RCLIP visited Taipei In July to confirm the collaborative relationship and the future project plan. Under the present plan, the RCLIP DB will have several precedents by the end of this fiscal year and more than 100 precedents by the beginning of the next fiscal year.

(RA Yuka Aoyagi)

IP Database Project: Vietnam

In July of 2005, with assistance from the US International Development Agency (USAID), Vietnam published the judgments 2003-2004 by the Judicial Council of the Supreme People's Court for the first time. It also announced that it plans to publish judgments of other courts （http://thanhniennews.com/politics/?catid=1&newsid=7982）. Apparently, it seems Vietnam is moving on to make their precedents open to the public.

As of the DB project, the RCLIP asked for the help to Vietnam's Supreme People's Court (the "SPC") through a certain party who aids building up Vietnam's legal system in Japan. The SPC responded to us via e-mail to show their interest in collaborating with us on the DB project basically. As the next step, the RCLIP will show the future project plan as well as the process to establish the DB that the RCLIP has experienced in order to promote the project, taking into account Vietnam's special circumstances. The RCLIP plans to visit Vietnam for the concrete negotiation when receiving Vietnam's general consent to the project plan.

(RA Akiko Ogawa)

IP Database Project: Korea

The RLIP is conducting a preliminary research for the DB project of Korea to start the project very soon. In August 2005, we visited Korea to meet several researchers and practitioners specialized in IP including Choi Sung-Joon, Senior Judge, Patent Court of Korea, Kang Ki-jung (Senior Judge, Research Judge, Supreme Court of Korea), Yeo Mee-Sook (Judge, Deputy Director General for Investigation Research, Supreme Court of Korea), Lee Soo-Wan (Attorney(Korea&NewYork), Patent Attorney), and Park Junu (J.S.D. , Professor, College of Law,

Myoungji University). They gave us very useful information as well as insightful advice. Korea has already started translating its major precedents into English with the leadership of the Investigation Research, Supreme Court of Korea. It will place the first part of the translated precedents open to the public at the website by the end of this year. However, the database is slightly different from the RCLIP database because these precedents include not only the IP precedents but also the precedents selected from all legal area. Further research in Korea is expected to seek how to adjust the difference between two projects.

(RA Lea Chang)

Asian IP Precedents Database was on the Publication by Patent Office Society, Japan

The periodical publication by the Patent Office Society reported the RCLIP's Asian IP Database at the issue of No.237.
http://www.tokugikon.jp/gikonshi/237kiko1.pdf
(Japanese only)

JPO Project of Intellectual Property Research by University

Waseda University's "Research on the dispute settlement of the courts related to Industrial Property in East Asia" was selected as "FY2005 JPO Project of Intellectual Property Research by the University".

Aiming to establish useful proposals and conclusions, this research will investigate the dispute settlement of the courts in East Asian countries such as China, Korea, Thailand, Indonesia, Taiwan or Vietnam. Those countries are very important for Japanese industry in terms of investment. The research will be conducted from the viewpoints of both developing appropriate protections over the industrial property and enhancing research and developing researchers and research network in these areas.

Specifically, the research will: 1)examine the tendency or trends of each country by collecting and analyzing precedents in each country, 2) verify the issues by conducting joint research on legal procedures with legal professionals, and 3) hold Asian Seminar Series to share findings and with many concerned parties.

Upcoming Event

For inquiries, please visit our website and send an e-mail in English. We apologize the seminar registration site is available only in English.

Asian Seminar "Discussion Points in Chinese Corporate Legal Affairs – focusing on IPR and Investment Environment"

【Date】September 29, 2005, Thursday,
18:00～20：00
【Place】Waseda University, Bldg 8
【Language】Chinese and Japanese
【Lecturer】
Mr. Chen Youxi（Chief Director of Zhe Jiang Capital Equity Law Firm.China, Chinese Lawyer)
【Interpretation and Commentary】
Mr. Fu Zhicao（Full-time lecturer, Ningbo University, Chinese Lawyer）
Mr. Akihiro Tatara（President of Nextage）

US Patent Lawsuit Seminar

【Date】October 4, 2005, Tuesday 9:00～17:00
（Lunch will be provided）
【Place】Toranomon Pastoral, Tokyo
【Language】English
【Lecturers】
Hon. Liam O'Grady U.S. District Court Magistrate Judge, Eastern District of Virginia
Robert Burns - Finnegan, Henderson (Reston, VA)
David Hill - Finnegan, Henderson (Reston, VA)
Dori Hines - Finnegan, Henderson (Washington, DC)
Michael Jakes - Finnegan, Henderson (Washington, DC)

Michael Morin - Finnegan, Henderson (Washington, DC)
Naoki Yoshida - Finnegan, Henderson (Tokyo, Japan)
【Contact】
Finnegan, Henderson, Farabow, Garrett & Dunner, L.L.P., Tokyo Office
Contact ：Matsumura
（E-mail eriko.matsumura@finnegan.com）

Asian Seminar Series

"FY2005 JPO Project of Intellectual Property Research by the University", Asian Seminar Series No.1, "Research on the dispute settlement of the courts related to Industrial Property in East Asia (Thailand)"
【Date】October 12, 2005, Wed. 18:00-21:00
【Place】Waseda University, Bldg 20 【Okuma Kaikan】, Room 201 and 202

【Theme】Dispute Settlement of Industrial Property in East Asia
【Language】Thai and Japanese Simultaneous Translation
【Lecturers】
Hon. Justice Phattarasak Vannasaeng, Judge of the Appeal Court; Former Chief Judge of the IP & IT Court
Hon. Justice Suvicha Nakvachara, Chief Judge of the IP & IT Court Trade Court
Hon. Justice Ruangsit Tankarnjananurak, Judge of the IP & IT Court
Hon. Justice Sripibool Visit, Judge of the IP & IT Court

※ The Institute of Intellectual Property co-sponsors this project.

※ For the registration,
https://www.21coe-win-cls.org/info/reservation.php?sid=10298 (Japanese only)

RCLIP Workshop Series No.10

【Date】October 28, 2005, Fri. 18:00～20:00
【Place】Waseda University International Conference Hall, Room No.2
【Theme】Overlapped Field in IP Laws
【Lecturer】Prof. Tatsuki Shibuya, Waseda University, School of Law

RCLIP Workshop Series No.11

【Date】November 11, 2005, Sat. 15:00～17:00
【Place】Waseda Univ. Bldg 9, Conf. Room No.1

【Theme】Patent Infringement Relating to Repairs and Parts Replacement
【Lecturer】Prof. Yoshiyuki Tamura, Hokkaido University, School of Law

RCLIP Special Seminar

【Date】December 16, Fri. 2005, 18:00～21:00
【Place】TBD

【Theme】The latest topics of US Patent Law (not decided for the detail)
【Lecturers】
Mr. Stephen G. Kunin, (Former Deputy Commissioner of USPTO; Director of the J.D. and LL.M. Programs in Intellectual Property Law at the George Mason University School of Law; Special Counsel, Oblon, Spivac, McClelland Maier and Nuestadt）

Editor/issuer
Ryu Takabayashi,
Director of Research Center for the Legal System of Intellectual Property (RCLIP)
21coe-win-cls
Web-RCLIP@list.waseda.jp
http://www.21coe-win-cls.org/e_index.html