ISSN 1880-3245
February 2007, No.12
http://www.21coe-win-cls.org/e_index.html

International IP Symposium（2006/12/15）

"The Goal of Intellectual Property Protection – Pros and Cons of Strong Intellectual Property Protection"

Keynote Speech

The International IP Symposium began its program with the keynote speech by Professor Rochelle Dreyfuss of New York University School of Law. On the issue of 'pros and cons of strong intellectual property protection', Professor Dreyfuss suggested that it was necessary to strike a "delicate balance" between the proprietary interests of producers and the access interest of users. Then she presented various issues to harm the balance and the necessity to recover it.

The first issue was the legal design confronting globalization. She explained that not only the problem such as the strength of intellectual rights, but also two strategy questions were raised: how will the world evolve a coordinated approach to IP strength, and when is a global answer supplied. It is difficult to harmonize national systems globally when each legal regime takes different position about the ownership of intellectual property. Furthermore, the issue is whether coordination (harmonization) is a good idea as a matter of social policy.

Various ways to coordinate worldwide protection have been proposed. According to her report, one strategy is to ask a local court to extend its law extraterritorially, to cover remote infringements. There is also a variation on this idea: to sue a defendant in one country and to ask that he be held vicariously (secondarily) liable for infringements occurring elsewhere. However, she said these approaches raised questions about the balance between rights holders and users. Since plaintiffs will always choose the most convenient jurisdiction for themselves, there is a risk of exporting very strong law to worldwide.

A second coordination strategy is consolidation, asking one state to adjudicate claims that arise under both domestic and foreign law. She stated that, as an institutional matter, this procedure was very attractive because it allowed jurisdictions to maintain their own views on the appropriate strength of protection for activities that would occur within their own borders.

And even if there were agreement on rationales, there would be considerable difficulty setting the international level of intellectual property protection correctly, for there are other developments afoot that affect that issue: changes in reproductive and distribution technology; changes in the way that business is conducted; changes in the marketplace; and changes in science. She said we must examine how these developments affect that delicate balance, i.e. development of digitization and inventiveness.

In the final analysis, she concluded that it was unlikely the question of IP strength will ever be answered definitively. Nothing can be answered with a simple response that either high protection or low protection is the right solution. Following the keynote speech, the copyright panel discussion and the patent panel discussion took place.

（RA　Akiko Ogawa）

ISSN 1880-3245
February 2007, No.12
http://www.21coe-win-cls.org/e_index.html

Panel 1: Copyright

For the panel 1, Professor Jane C. Ginsburg of Columbia Law School, Professor Michael Lehman of Max Planck, and Professor Tatsuki Shibuya of Waseda University were invited. Professor Hiroshi Saito, Sensyu University moderated the discussion.

First, Professor Saito presented a report titled "Balance of Interests – from 2 Perspectives". He mentioned that the copyright system was fated to confront new technology at all times. In addition, he pointed out that a delicate balance was always needed between author and copyright owner, the interest of licenser and the interest of licensee under the condition in which the scope of copyrighted work use was dynamically changing with technology development. He suggested a strategy to adjust benefits of author and copyright owner when the two parties are different by legislation or contract, and a strategy to adjust benefits of licenser and licensee when unknown exploitation of the media takes place with technology development.

Next, Professor Jane Ginsburg presented a report titled "The Pros and Cons of Strengthening Intellectual Property Protection". In her report, she especially mentioned to "Strengthening Copyright through Anti Circumvention Laws" as a theme, referring to the DMCA 1998 Section 1201. The DMCA Section 1201 defines three new violations. She suggested that these violations were distinct from copyright infringement and thus the section expanded the scope of copyright. Based on that analysis, she suggested it should be necessary to assess appropriately whether section 1201 has over-expanded the reach of copyright or, has enabled copyright to adapt to the challenges and opportunities that digital media presents.

Professor Michael Lehmann mentioned some issues on software protection in his report titled "Protecting Software? The Benefit of Exclusive Rights in Intellectual Property". He took a perspective that monopolistic property rights for the protection of intellectual and industrial property are made available only to the extent that an economic society requires these goods which are produced as a result of the existence of this system of incentive and reward. With this perspective, he concluded that, if property rights is extended or newly created, the burden of proof must be satisfied in the context of the necessity of creating particular property rights to the development of an economy.

Professor Shibuya presented a report related to the presentations by Professor Ginsberg and Professor Lehmann. In the context of Professor Ginsberg's theme, he mentioned use restriction technology and access restriction technology as anti-circumvention technology related to anti-circumvention law. Then, he made clear about Japan's corresponding legal system by referring to the difference of response between Copyright Act and Unfair Competition Law. Especially, as to the punishment to the person who provides devices, which is one of responses under the Copyright Act, unauthorized use of copyrighted work is not necessarily required to occur as a result. He pointed out that it was one of very new ideas under Japan's Copyright Act. As to the access restriction technology, he explained that not Copyright Act but Unfair Competition Law handled it in Japan. In addition, in the context of Professor Lehmann's theme, he described that it was not proper to protect software by protection of neither patent nor copyright and instead, it was enough to control software under Unfair Competition Law because software was the result of "sweat of the brow"

ISSN 1880-3245
February 2007, No.12
http://www.21coe-win-cls.org/e_index.html

and investment. Then, he suggested what the legal system should be in that case.

Following the presentations mentioned above, the discussion took place actively among the panelists. Mr. Eiji Tomioka, an attorney of Nakamura and Partners that sponsored the symposium, gave a comment in closing.

（RC　Tetsuya Imamura）

Panel 2: Patent

Following the Panel 1, the Panel 2 took place, moderated by Professor Toshiko Takenaka of University of Washington (visiting professor of Waseda University). The panelists were Judge Meier-Beck of German Supreme Court, Associate Professor Sean O'Connor of University of Washington, Judge Ryoichi Mimura of Intellectual Property High Court of Japan, and Professor Yoshiyuki Tamura of Hokkaido University.

First, two researchers from Japan and the U.S. made a presentation respectively on the fundamental ideas of patent system. In the presentation titled “Using Research in the History and Philosophy of Science to Redefine Patentable Subject Matter under the Progress Clause of the U.S. Constitution”, Associate Professor O’Connor pointed out that the scope of patentable subject matter had to be re-examined to face various critiques arguing that research is being hindered by excessive patenting of scientific and technological innovation. To interpret the Progress Clause (U.S. Constitution, art. I, sec. 8, cl.8), which is the origin of intellectual property protection, he adopted a new interpretation by using the history and philosophy of science studies. With his interpretation, he argued that the patent system was not established in order to protect the work of scientists and natural philosophers. Then, he introduced his argument that scientific advances can be kept out of the patent system.

In addition, Professor Tamura made a presentation titled “Law and Policies on Patent System”. The significance of the patent system relies on promotion of innovation and early publication of innovation, avoidance of overlapping investment by prompt patent prosecution, and an incentive to commercialize an invention by prompt patent prosecution. He pointed out all of these factors are linked to efficiency. For example, the issues such as patentable subject matter, sufficiency of patentability, or the scope of protection should be determined in the context of efficiency, however it is difficult to obtain the best solution in this context. Therefore, the patent system was established to set up a patent right artificially in order to make use of a market and to interpret the issue of efficiency as the rights-duty relationship between the parties in each lawsuit. Furthermore, he referred to the way to prescribe court norms based on such perspective and introduced that, along with several economic theories such as Prospect Theory and Competitive Innovation Theory, Burk & Lemley recently argued that the court should adopt these economic theories subject-matter specifically. Then, he explained that it was difficult to adopt this kind of theory directly as court norms and thus, it was necessary to need a policy-making process to turn it into courts norm in order to utilize such a theory, for example, the process by legislative bodies, the patent office, or courts.

ISSN 1880-3245
February 2007, No.12
http://www.21coe-win-cls.org/e_index.html

Next, judges from Japan and Germany made a presentation respectively from the perspective of the balance between patent protection and limitation to third parties by patent protection.

In the theme of "Balancing fair protection of inventions with a reasonable degree of certainty to third parties", Judge Meier-Beck mentioned that patent law had to balance conflicting interests between the patentee who wanted broad protection of the invention and the competitors of the patentee whose freedom to use was limited by the protection. He said that unclear criteria of the extent of protection factually resulted in an unfair broad protection of inventions, and as a result, disrupted the balance of conflicting interests. He stated that it was necessary to use objective and manageable criteria of claim interpretation in order to maintain reasonable balancing and presented some criteria of claim interpretations. In addition, he pointed out that so-called "irrelevant elements of a claim" theory should not be adopted and furthermore, statements in the prosecution history should not have any influence on claim interpretation.

To respond this presentation, Judge Mimura made a presentation titled "Interpretation of the Scope of Rights and Freedom of Economic Activity". Having the same awareness of the issue as Judge Meier-Beck, Judge Mimura stated that the technical scope of patent inventions should be properly determined and it was necessary to provide general predictability in a court not only for the solution of each case but also for the same type of future disputes. With such a viewpoint, He introduced recent judicial precedents related to the method of claim interpretation, doctrine of equivalence, or doctrine of exhaustion. Also he pointed out the issue on the legislation for indirect infringement (Patent Act, Article 101-2 and 4) and furthermore, the issue that claim correction made in parallel with infringement proceedings hinder general predictability.

Following the presentations stated above, Mr. Heinz Goddar, German patent attorney, Mr. Eiji Katayama, Attorney at law and others made comments on the presentations. Then, the panelists discussed the method of claim interpretation and the doctrine of exhaustion.

(RA Asuka Gomi)

RCLIP Asia Seminar -Korea（2007/1/25）

"Recent Interesting Precedents at the Supreme Court of Korea"

Judge Choe Seong-Jun, Patent Court of Korea

RCLIP Asia Seminar- Korea held on January 25 of 2006 invited Judge Choe Seong-Jun of Patent Court of Korea to present a report on the theme of "Recent Interesting Precedents at the Supreme Court of Korea".

First, he introduced patent precedents related to so-called "parameter inventions", which include a description specifying the object by its features or characteristics. After discussing the relation with means-plus-function claim, and the evaluation whether it falls under patent specification, he analyzed "Supreme Court Decision 2004 Hu 2031 on December 23, 2005" which decided on the scope of the patent claim and patent right of the parameter invention. The decision has a similarity to Japanese precedents. For example, it concluded that the conventional art must be considered as one of the inventions publicly known, worked or described in deciding whether to reject novelty or nonobviousness of the claimed invention as far as there is no specific condition. However, despite the stated decision by the Supreme Court, Korean

Patent Court maintains past position on the grounds that "description of prior art is only a recommended term under the Patent Act and therefore, if the conventional art in the patent specification is approved as publicly known technology without any evidentiary documents, there is a risk of avoiding the description of it afterward."

As trademark related precedents, he introduced the discussion about titles of books and copyright as well as trademark in the relation to the case of a book, "Never Learn English!" which was also published in Japan. As to whether a book's title is considered as a copyrighted work, just like Japan, Korean court basically takes the position that it is not a copyrighted work. However, some of Korean decisions see some possibilities of considering a book's title as a copyrighted work if it has a certain level of length. In addition, as to the criteria for similarity of trademark, he explained about overall observation, substantial part of observation, and separating observation. Then, he introduced "Supreme Court Decision 2004 Hu 929 on July 22, 2004, 'BEAN POLE': 'BEEN KID's'", and "Supreme Court Decision 2001 Hu 2986 on January 10, 2003, 'RobertoRicci': 'NINA RICCI' " which concluded that separating observation is not suitable if the trademark is used and perceived in its entirety in business practice.

Last, as copyright related precedents, he introduced "Supreme Court Decision 2004 Do 2743 on February 24, 2006". By using Mod Chip, the defendant enabled PlayStation 2 games (PS2) of Sony Entertainment to play copied game CDs that had no Access Code. The defendant's act was judged as an act of disabling technological protection measure stipulated in the Article 30-(2) of Computer Program Protection Act. Australian court's decision on the same case was introduced and compared to the Korean court's decision. After the report, Judge Makiko Takabe of Tokyo District Court introduced Japanese precedents such as "IP High Court's decision on November 11, 2005" relating to parameter inventions and support requirements, "the decision of the third petit bench of the Supreme Court on March 11, 1997" and "the decision of the third petit bench of the Supreme Court on July 11, 2000" relating to trademark analogy.

Following the stated report, an active panel discussion took place, joined by Professor Ryu Takabayashi, Director of RCLIP and Professor and Professor Yun Sung-Hee, Hanyang University.

(COE Research Associate Lea Chang)

ISSN 1880-3245
February 2007, No.12
http://www.21coe-win-cls.org/e_index.html

The RCLIP's Asian IP Precedents Database Project

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

IP Database Project: China

With a completion of 50 Trademark data of Beijing, the project of FY2005 was completed as planned. For addition of Chinese precedents this year, the project progresses smoothly with the help of the collaborators at Peking Univ., Tsinghua Univ., Renmin Univ., Zhongshan Univ., and the Higher People's Court of Shanghai. Collecting 30 cases in Guangzhou and Shanghai was already done. It will be completed for other four places by the end of March.

(RA Yu Fenglei)

IP Database Project: Thailand

Currently 254 Thai precedents have already been placed at the database. More 50 cases were already prepared and will be added soon.

(RC Tetsuya Imamura)

IP Database Project: Indonesia

In addition to 80 precedents at the database, additional 20 cases are being prepared. 20 precedents selected from the precedents from November 2005 to December 2006 will be uploaded to the database.

Also, the RCLIP invited three Indonesian collaborators of the IP database project including the Supreme Court's judge and lawyers and held the seminar with the theme of "IP Enforcement in Indonesia" on February 8, 2007(5 p.m. start), following the Vietnam IP Seminar (2 p.m. start).

(RA Akiko Ogawa)

IP Database Project: Taiwan

300 precedents were already at the database. Addition of another 50 precedents was decided. Within the FY 2006, the 2005/2006 precedents will be uploaded.

(RA Akiko Ogawa)

IP Database Project: Vietnam

In this January, Mr. Ngo Cuong of the People's Supreme Court of Vietnam who is the collaborator of our Vietnam project told us that he found several IP dispute related cases of the People's Supreme Court of Vietnam. In February, the three cases were uploaded at the IP database. It is quite epoch-making because there was almost no case of introducing Vietnamese precedents overseas.

Also, in the relation to the precedents upload to the IP database, the RCLIP invited three persons from Vietnam including judges of the People's Supreme Court of Vietnam to hold a seminar titled "IP Enforcement in Vietnam" on February 8. Although it was held during the daytime on a weekday, many participants gathered. It gave a glimpse of high interests to the IP system of Vietnam which is under the spotlight as an investment choice.

(RA Asuka Gomi)

IP Database Project: Korea

In addition to the current 30 precedents, another 30 Korean IP precedents were added on January 25 of this year. Mr. Choi Sung-Joon, Senior Judge, Patent Court of Korea (promoted to the High Court on February 2) selected precedents for the database and added comments to them as he did so last year. In January when the precedents were added to the database, Korea seminar was also held to use the precedents as the subject.

(COE Research Associate Lea Chang)

ISSN 1880-3245
February 2007, No.12
http://www.21coe-win-cls.org/e_index.html

Events and Seminars

For inquiries, please visit our website.

RCLIP co-sponsored - International IP Dispute Resolution Symposium

【Date】March 3, 2007, 10:00-17:00
【Place】Ono Memorial Hall, Waseda University

Development of international transaction has brought about many IP infringement cases over the world on the same products or inventions registered in different countries. Especially, development of the Internet has caused diffusion of infringement worldwide. Conventional ideas in IP law based on territoriality principle have difficulty to handle such a situation. Furthermore, a new business model, so-called patent troll was born. That increases calls for reexamination of IP dispute resolution. This symposium invites Japan and U.S. judges with years of experience in IP dispute resolution in the first panel to examine applicable law or jurisdiction in IP disputes as well as the issue of applicable law in domestic laws, using the case of AT&T v. Microsoft which is now on trial at the U.S. Federal Supreme Court. In the second panel, researchers from Japan, the U.S., Europe, Korea and Taiwan are invited to conduct comparative legal analysis on injunction and claim for compensation as proper resolutions for IP infringements using the U.S. Federal Court's decision last year on the case of eBay v. MercExchange.

Organizer/sponsor: Waseda Law School
Co-sponsor: RCLIP

Panel Discussion 1: Current Issues on International Execution of IPR
Moderator:
Professor Ryu Takabayashi, Waseda University
Panelists:
Judge Randarl Rader, Court of Appeals for the Federal Circuit
Kent A. Jordan, U.S. Court of Appeals for the Third Circuit
Judge Tomokazu Tsukahara, IP High Court
Judge Ryuichi Shitara, Tokyo District Court

Panel Discussion 2: Current Issues on Resolutions for IP Infringements
Moderator: Professor Toshiko Takenaka, UW Law School, Visiting Professor of Waseda University
Panelists:
Professor Polk Wagner,
University of Pennsylvania Law School
Professor Gideon Parchomovsky,
University of Pennsylvania Law School
Professor Heinz Goddar, University of Bremen
Professor Sang-Jo Jong,
Seoul National University
Professor Ming-yung Shieh,
National Taiwan University
(Simultaneous interpretation –Japanese-English)

Announcements

The RCLIP added 50 Chinese precedents (2007/1/18) and 30 Korean precedents (2007/1/25) to the **Asian IP Precedents Database Project (English version)**.

Mr. Soowan Lee, AIP Patent & Law Offices provided Japanese presentation material (138 slides) on Korean patent practices to the RCLIP. It was posted at the RCLIP's website (2007/1/30).

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