



NEWSLETTER

Research Center for the Legal System of Intellectual Property

RCLIP Workshop (2010/5/28)

(1) Issues and Economic Impact Concerning Droit de Suite

Dr. Akiko Ogawa, Research Associate, Waseda Institute for Corporation Law and Society

(2) Development and Reality of Chinese Legal System of Intellectual Property

Dr. Yu Fenglei, Global COE Researcher, Waseda Institute for Corporation Law and Society

At the RCLIP Workshop on May 28, 2010, Dr. Akiko Ogawa who is a research associate and Dr. Yu Fenglei who is a researcher of our Institute presented about their doctor's theses to commemorate completion of their degrees.



First, Dr. Yu made a presentation on “Development and Reality of Chinese Legal System of Intellectual Property”. As a real picture in China, he introduced that conflicts over the giant market got intensified due to lack of effective system of enforcement although China had shifted the way of economic development from “Production in China” to “Creation in China” and had implemented law revisions at a rapid pace concerning intellectual property right such as patent, copyright and so forth. Then, as a solution in the future, he assumed a theoretical structure that the “balance” is maintained by continuously circulating private right and public right, based on the way of thinking to integrate strained relations between public interest and

private interest while focusing on right placement and profit allocation of intellectual property. He examined the fundamental theory in which “harmony” is essential instead of contradiction from the viewpoint of social law.

Next, Dr. Ogawa presented on “Issues and Economic Impact Concerning Droit de Suite”. The purpose of her thesis is to analyze what Droit de Suite is like from historical, legal, economic and social aspects and ultimately



examine the possibility of establishing Droit de Suite in Japan. Especially at the workshop, she outlined what Droit de Suite was like, how the adoption of Droit de Suite would change the protection of artwork and what impact it had upon the authors. Then, she examined whether Droit de Suite was required for the copyright protection of art and also what positive impact the adoption had and on the other hand, whether negative impact, which the opponents mainly led by economists were afraid of, would occur.

Then, Professor Hikota Koguchi of Waseda University and Emeritus Professor Hiroshi Saito of Niigata University commented respectively and the workshop successfully ended.



(RA Asuka Gomi)



❖RCLIP Workshop Series No.31 (2010/6/4)

“The Future of Design (*Isho*) System”

【Lecturer】Kazuko Matsuo, Attorney at Law and Patent Attorney, Nakamura& Partners



The RCLIP Workshop Series No.31 invited Ms. Kazuko Matsuo as a lecturer to speak with the theme of “The Future of Design (*Isho*) System”

The design system recently remains stagnant with decreasing number of applications. This lecture presented various concrete proposals on possible system reforms based on the current condition with no concrete revitalizing plan in Japan as well as conditions of foreign systems in which the speed of change is very rapid. Throughout the lecture, she emphasized “perfectionism” in the current application examination and the necessity of a departure from “dependency” on the authority of the Patent Office. With such a focus, various topics were covered including ① correcting the subject matter which is protected, ② simplifying and streamlining the procedure of establishing *Isho*(design) right, and ③making a modification by non substantive examination principle in contrast with substantive examination principle, and ④modifying the protection of creation.

①As to the correction of the subject matter which is protected, she focused the interpretation of the concept of “articles” in Article 2, paragraph 1 of the law. Concerning the relations between “design” and “articles”, various theories exist but no standardized theory is recognized. Some say two are inseparable and others say they are separable. Considering such a condition, it is not necessary to adhere to the traditional concept of

“articles” in designing the subject matter which is protected. In addition, the protection is extended to intangibles in EU and the U.S. and the concept of articles in Japan also is gradually expanded by approving “parts of articles” as “articles”. Having said that, the concept of “articles” should be viewed appropriately by taking *raison d'etre* of design or the purpose or *raison d'etre* of articles into account. It should be understood as “aesthetic molding of technology related to function and use which is traded”. As to the concept of “design”, it is not necessary to have a physical unity with articles. It is only necessary to become subjects traded in the market, related to articles.

②As to the issue of simplifying and streamlining the procedure of establishing the right, first, mentioning the so-called “one design, one application” principle in Article 7, she introduced the adoption of “one application for multiple designs” in EU and suggested that Japan should consider adopting the similar system. At least, allowing one application to have “variations within the same concept” would improve the convenience of system. Next, as to the too strict and detailed requirement of drawing description, examples in EU and the recent law amendment in the South Korea were introduced. She concluded that we should simplify our regulation to the extent of recognizing design created and socially accepted and release the procedure of establishing the right from complicated drawings. Furthermore, as to the design system for less-used composite, she stated that, in order to improve the use rate, it was necessary to increase the freedom of combination of composite by eliminating the combination chart of composite as well as to ensure the effectiveness of the right by preparing the rules for indirect infringement.

③As to the issue of making a modification by non substantive examination principle in contrast with substantive examination principle, she raised the question whether it was necessary to conduct perfect examination for preventing a small number of infringements. There is no perfect



examination. Also, the parties must conduct researches on publicly-known designs anyway in infringement cases and the number of infringement is not so many. So we should adopt partial non-examination system as “institutional design with options” from the viewpoint that design registration is necessary but not indispensable for people in the design industry because there are some designs created with short life-cycle or for high-fashion products. Concretely speaking, she proposed eliminating a substantive examination for part of registration conditions such as (i)the condition of being industrially applicable in Article 3-1, (ii) the condition of “being not easily created” in Article 3-2, and (iii)the condition of non-registrable designs in Article 5. Especially, as to (ii), it is more appropriate to take specific concrete decisions in courts rather than general abstract decisions by the Patent Office. We should eliminate the examination for such a condition and instead, set a ruling to require “a description of original creativity of design” which briefly describes the creative activity of the design including the concept of the design creation or the design development and we should assume “the filed design is an original creation of the applicant” based on the description. Next, as the second modification, she proposed that we should realize a protection with no examination for new designs for which various legal problems remains in terms of the range of efficacy of the right such as the designs of articles with short life-cycle or drawing designs, modeling after the similar system in Korean law. As to the third modification, she proposed establishing the design right of non examination registration (formal examination only), which models after the EU regulation, along with the design right granted through the normal substantive of examination. In addition, as to the measure of protecting designers sufficiently, she proposed establishing a system of generating “the right of creating design” as one package by entrustment

including (i) the right of seeking injunction and compensation for damages to the third party who use the design without consent, (ii) the right to show designer’s name, and (iii) the right of having design registration.

④Last, Attorney Matsuo spoke again about the aforementioned “description of original creativity of design”. She emphasized the significance of improving the protection of design creation by using the description for judgmental decisions on infringement in litigations and making allowance for all activities of design creation in judging “efficacy of design right”.

An active QA session took place after the lecture and the workshop successfully ended.

(RA Asuka Gomi)

International Symposium: Medical Care and Intellectual Property

“Legal Issues Surrounding Medical Practice / Pharmaceutical Innovation: Update in US and Europe” (2010/6/26)

Part I “Legal Issues Surrounding Clinical Trial”

【 Moderator 】 Toshiko Takenaka, Director, CASRIP, Professor of Law, University of Washington School of Law

【 Speakers 】

Prof. Masatoshi Hagiwara School of Biomedical Science, Tokyo Medical and Dental University

Prof. Beth Rivin, Director, Global Health & Justice Project University of Washington School of Law

Prof. Patricia Kuszler, Director, Health Law Program, Professor of Law University of Washington School of Law

Part II “Comparative Study of Patentability of Medical Methods: Impact on Life Science Ventures from Bilski Supreme Court Decision and Ariad Federal Circuit en banc Decision”

【 Moderator 】 Prof. Ryu Takabayashi, Director, RCLIP, Waseda University

【 Speakers 】

Dr. Andrew Serafini, Fenwick & West LLP, Seattle, U.S.A.



Dr. Jan Krauss, Boehmert & Boehmert, Munich, Germany

Mr. Ryo Kubota, Chairman, President & CEO, Acucela Inc.

This symposium was held on June 26, 2010, co-organized by IP Division, Tokyo Medical and Dental University, CASRIP of University of Washington School of Law, Waseda University Institute for Interdisciplinary Intellectual Property Study Forum (IIIPS Forum), and the RCLIP. It aimed at seeking the ideal IP system contributable to the development of medical services and drug discovery based on various problems in this field.

With a large audience, the symposium started with the greeting from Professor Ikuo Morita, Vice President of Tokyo Medical and Dental University.

1. Part I “Legal Issues Surrounding Clinical Trial”

First, Professor Hagiwara delivered a lecture with the title of “Mekong Medical Aid”.

Many people in Vietnam are always at high risk of contracting infection. He introduced an effort of providing used dialysis machines of Japan to Hanoi Medical University for free as well as the international collaborative research with Vietnam for developing bird flu medicine. He stated that it was important to bring cooperation in technology development or researches instead of just building hospitals and so forth.

In addition, he mentioned the spread of Japanese encephalitis in Cambodia and introduced a project of providing JE vaccine to Cambodia.

Next, Professor Rivin delivered a lecture with the title of “Clinical Trials in Resource Poor Settings: Leading Issues of Justice”.

A lot of research expenses have been spent on drug discovery of minor diseases in the advanced countries while little has been spent for major diseases in the developing countries. The cases were introduced where participants died or had aftereffects because of the reduction of dosage in

clinical trial. He also explained about the circumstances of international discussions on the ideal state of justice and ethics in medical care and drug discovery.

Then, Professor Kuszler gave a lecture with the title of “Genes, Cells and Human Tissues: Ownership vs. Entrepreneurship”.

Professor Kuszler explained about what kind of rights are owned by the related parties: donors of human tissues, cells, and genes, researchers using those materials, and universities paying for such a research. Some cases were introduced such as the case seeking a suspension of using tissues, cells and genes and the case seeking a profit allocation based on the research result using those materials.

She also pointed out the possible future issues on subjects and objects of the right arising along with the birth of new systems in medical care such as accumulation of personal genetic information and introduced the discussions to respond those issues.

Last, a panel discussion took place.

The panelists discussed the relations between justice, equity and charity and pointed out the necessity of profit return to trial subjects. Also it was pointed out that handling genes became complicated in relation to personal information protection due to non-anonymity of genes. The importance of redistributing information, access, and medical care instead of redistributing wealth was also mentioned.

2. Part II “Comparative Study of Patentability of Medical Methods: Impact on Life Science Ventures from Bilski Supreme Court Decision and Ariad Federal Circuit en banc Decision”

First, Dr. Serafini gave a lecture with the title of “Ariad Pharmaceuticals, Inc. v. Eli Lilly & Company (en banc)”.

As to the issue whether the description requirement is different from the enablement requirement and what that would be if it is so, Dr. Serafini introduced the discussions by citing Ariad case and overviewed the CAFC en banc

Decision and its effect on practices.

In addition, the outline of Bilski case was introduced to explain patentable invention.

Next, Dr. Krauss made a speech on “Recent European Case Law on Patent Eligibility and Written Description with a focus on Life Sciences”.

The lecture pointed out that, in EU, they always concerned a discrepancy between EPC and patent laws of each countries. There is no such thing in EU as the US’s description requirement. Instead, they have support requirement. The enablement requirement becomes the grounds for invalidation but the support requirement does not. Therefore, whether a defect in description would be against the support requirement or the enablement requirement become an issue in many cases.

It also pointed out that the reasons why this issue was often seen in the biotechnology field were a rapid technological development, use of functional terms in claims, and so forth.

Next, Mr. Kubota gave a lecture on “The Development of Medicine for Blinding Eye Diseases and Venture Alliances”.

He stated that one reason why venture companies became successful in the US would be that the US had established specialization and collaboration among researchers, managers, and legal professionals and researchers could conduct researches to have good patents by having patent attorney’s support.

On the other hand, he stated that an appropriate patent strategy would be needed in an appropriate patent system because it was necessary to make choices of various compounds for drug discovery.

Then, Professor Takabayashi explained about the description requirement and patentable inventions in Japan.

As to the description requirement, he stated that it was used to be the enforcement requirement only however, we were just starting to recognize the support requirement separately from the description requirement, triggered by the recent IP High Court’s decisions. As to the patentable

inventions, he stated that we had handled the issue by interpretation of the rule on the definition of inventions including business method although there were opinions of eliminating the ruling on invention

Last, a panel discussion took place.

Some opinions were introduced as to the patentable invention. One said that it was too broad in the US in comparison to Europe and Japan and the CAFC’s decision on Bilski would be meant to have a certain restriction. From the viewpoint of benefiting the society, granting patent to machines should be the source of protection and the medical method itself should not be the subject of patent. As to the description requirement, the protection scope should be broad in drug development to get a return on investment and we should consider the conditions of technological filed for an appropriate protection scope. The symposium successfully ended with such active discussions.

(RC Motoki Kato)

❖The US IP and Antitrust Law Seminar

(2010/7/5)



【Hosts】 The Japanese Institute of International Business Law Inc., and Ropes & Gray LL.P.

【Moderator】 Hiroyuki Hagiwara, Partner, Ropes & Gray LL.P., Tokyo Office

【Speakers】 Attorneys of Ropes & Gray LL.P. who have expertise of antitrust law and IP litigations including Mr. Mark Popofsky, former Senior Council of Antitrust Division, the US Department of Justice.

【Guest Commentators】 Prof. Toshiko Takenaka,



University of Washington School of Law, Visiting Professor of Waseda University and Prof. Masahiro Murakami, the Graduate School of International Corporate Strategy, Hitotsubashi University

On July 5, 2010, the seminar on the recent movements of judicial decisions concerning the US IP and antitrust was held at the Tokyo Trust City Conference in Marunouchi. The topics discussed at the seminar were very broad. First, the fundamental concepts and rules in the US law on IP and antitrust were introduced. Then, the latest judicial decisions were examined concerning the issues of which legality is questioned under the Antitrust Act: ① tying arrangement, ② package licensing, ③ minimum resale price maintenance, ④ combination discount, ⑤ market-share discounts, and ⑥ product design change for shutting out competitors' product. In addition, presentations were made by the attorneys of Ropes & Gray LL.P. on the other issues including the execution of IPR or the form of settlement which possibly cause the problem under the Antitrust Act, the settlement in the Google case which often become a popular topic also in Japanese legal community, and the issues under the US law concerning patent pool and technology standard. Mr. Hiroyuki Hagiwara who served as a moderator was one of the first alumni of Summer Institute by CASRIP which is a partner of RCLIP. After the Summer Institute, he graduated from New York University School of Law. Currently, he is a representative of Tokyo Office of Ropes & Gray LL.P. He is familiar with the contractual practice in the US and Japan. Having the advice of Professor Murakami who is an expert of the competitive law in Japan, Mr. Hagiwara chose the most interesting topics to Japanese companies for this seminar. Thanks to his effort, the seminar hall was filled with more than 100 participants including not only IP related parties but also those who handle contract at legal affair division.

After the presentation by the US attorneys, Professor Murakami made a comment from the comparative legal perspective. First, in Japan, it is very rare to file a counterclaim in infringement lawsuits. Also, because discovery does not exist, it is difficult to verify anticompetitive effect in the market. Therefore, lawsuits on antitrust violation among private parties have been rarely seen. He pointed out the number of judicial decisions were small because of this reason. Specifically, among the topics this time, the issues like reverse payment or product design change have not been discussed yet in Japan. The issue of technology standard also remains unsolved. Furthermore, concerning the Google case, he showed his opinion that we would need a central management organization of digital text just like JASRAC for musical works.

As an IP expert, I was interested in the point that licensing was introduced as the suspicious act under the antitrust law in general. Based on that understanding, he examined each contract form which became an issue under case law. He especially took time to examine the case of Illinois Tool Works which was the recent Supreme Court's decision on the relations between IP and the Antitrust Act. The decision repealed the rule of presuming plaintiff's market power by simply acquiring a patent. The rule of reason assesses a competitive effect in the market in each case for all contract forms related to license except a royalty liability after patent expiration. If the act of licensing is suspicious under the Antitrust Act as unfair expansion of the power, presuming that a patentee has a market power, it is questionable to give discriminatory treat to licensing after the Illinois Tool Works.

Also, in the Illinois Tool Works case, the Supreme Court clarified that the rule of presuming patentee's market power was adopted from the precedent of patent misuse. Therefore, the US scholars of IP law are still questioning whether the patent misuse exists and what range it would be if it exists. I asked the speakers about



this point at the panel discussion. In Popofsky's view, there seems no change in terms of the fact that the acts like tying related to licensing should be suspicious acts. However, he stated that a suspected infringer must verify the market power for misuse in the future. It would be necessary to conduct further theoretical analysis on this issue by scholars of IP and competitive laws in the US.

At the reception which was held after the seminar, the participants could have an opportunity to personally discuss with the speakers. When I left at the scheduled closing time, the venue was still full of people.

(Toshiko Takenaka, Director, CASRIP, Professor of Law, University of Washington School of Law, Visiting Professor of Waseda University)

※Although we announced the RCLIP would publish the lecture in Japanese and English at the seminar, we are sorry that we did not record the lecture by mistake and would like to cancel publishing. Please take our sincere apology.

❖RCLIP International IP Strategic Seminar

The Latest Trend of US Patent Lawsuits:

An Impact of the Supreme Court's Decision on Bilski and En Banc Hearing on Inequitable Conduct (2010/7/9)

【Overall host】 Prof. Ryu Takabayashi, Director, RCLIP, Waseda University

【Moderator】Prof. Toshiko Takenaka, University of Washington School of Law, Visiting Professor of Waseda University

【Speaker】 Douglas F. Stewart, US Patent Attorney, Dorsey & Whitney LLP, Seattle

The seminar was held at Waseda Ono Memorial Hall on July 9, 2010, having two topics of ① "Recent Development in the Patentability of Software and Business method" and ② "Recent Developments in the Inequitable Conduct Defense Both in Courts and in Congress" Due to the absence of a scheduled speaker of the second topic, Attorney Paul Meicleljohn, for health reasons, Attorney Douglas F. Stewart presented on both topics.



The first topic, "Recent Development in the Patentability of Software and Business method", focused on the impact on the future practice of patent law by the Supreme Court decision on Bilski case ruled on June 28 just before the seminar (*Bilski v. Kappos*, 561 U.S.__(2010)). Mr. Stewart overviewed the development of case law related to Section 101 of the US Patent Act to the recent Supreme Court decision and explained about the original decision - the CAFC decision on Bilski in 2008. In the Bilski case, the issue was patent-eligibility of a claim describing a method of hedgerisking in the field of commodities trading without having a tie to a particular machine. The CAFC voluntarily held an en banc hearing (*In re Bilski* 545 F.3d 943(Fed. Cir. 2008)) and ruled that the machine-or-transformation test should be applied to evaluate patentability of the process under Section 101. What the test requires is (1) process tied to a particular machine or apparatus, or (2) process transforms a particular article into a different state or thing. The CAFC en banc decision rejected a concrete and tangible test adopted in the en banc decision on *Alappat* (1994) and decided that software or business methods could not be categorically excluded. Then, it rejected the patent-eligibility of the claim in question by adopting the machine-or-transformation test as the sole test. Although it affirmed the CAFC decision, the Supreme Court decision on June 28, 2010 rejected the CAFC's test as the sole standard, relying on *Diamond v. Chakrabarty* to acknowledge wide scope of patent protection available. Then, it concluded that Bilski's claim

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was rejected because his claims were drawn to an abstract idea. The Supreme Court came back to the traditional standard which only excludes the laws of nature, natural phenomena, and abstract ideas (*Gottschalk v. Benson*, 1972). So it increased chances that patent-eligibility might be confirmed for the subject of software and business method which were excluded by the CAFC's machine-or-transformation test.



Then, Mr. Stewart pointed out the impact of the Supreme Court's decision. The decision, which was described as too simple despite its importance, did not include how to position other CAFC's tests and did not provide enough guidance to determining the patent-eligibility of the subject of software or business method. Referring to such an issue, he explained the probable impact in the future on prosecution and litigations. Concerning the prosecution, the PTO's interim guidelines (issued June 30, 2010 after the Supreme Court's decision) stated that they continued to call for application of machine-or-transformation test as evaluation tool. Generally, it is not clarified on how examiner can determine if software and business method claims are abstract ideas and applicants need to refer to the traditional Supreme Court's decisions for subject matters with abstractive nature. However, if the claimed method meets the test, the method is highly likely to be patent eligible. In infringement lawsuits after the CAFC decision, the number of cases where alleged infringers

challenge validity under Section 101 has been increasing since *Bilski*. He predicted that evaluation would become difficult after the Supreme Court decision and in the near future, the CAFC would make a ruling on Section 101. On the other hand, he also predicted that those patent owners who were worried about potential negative impact of *Bilski* decision could move forward and the number of cases filed alleging infringement of software and business method patents would increase.

Last, Mr. Stewart analyzed the recent trend of the CAFC and the Supreme Court. Recently, it seems that, with extensive patent experience, the CAFC is crafting bright line rules to give objective guidance to district courts and practitioners. In contrast, the Supreme Court is less interested in bright line rules and rather focused on broad legal principles. It pays attention to the statutory intent and constitutionality of lower court actions and is repeatedly rejecting the test which the CAFC made. Recent Supreme Court decisions have rejected CAFC standards which diverged from existing Supreme Court precedent such as *eBay* case or *KSR* case. Seeing such a trend, the CAFC rejected its own precedent to adopt a standard from the Supreme Court in the *Bilski* case. However, he pointed out that the Supreme Court rejected the CAFC's test because it was too limiting and concluded that the test increased uncertainty in patent practice.

The second topic, "Recent Developments in the Inequitable Conduct Defense Both in Courts and in Congress", introduced the issues which have probable major impact on the prosecution, focusing on the *Therasence* case (*Therasence, Inc. v. Becton, Dickinson & Co.*) which is currently at the CAFC en banc and is expected to have a decision to clarify the standard on the that issue.

First, Mr. Stewart covered the brief overview of inequitable conduct defense. Under the US Patent Act, if applicants conceal intentionally or disclose by mistake any important information

related to patentability in the prosecution of patent application (or reissue application), inequitable conduct against USPTO is found due to the breach of duty of candor and good faith under the equity and it makes their patents unenforceable in infringement lawsuits for their all claims. Inequitable conduct in infringement lawsuits is determined by ① materiality of information, ② the intent to deceive the USPTO and then, ③ sufficient combined materiality and intent to constitute inequitable conduct (balancing by the court, balancing test). ① The materiality is determined on whether an envisaged "reasonable examiner" consider the information as important in deciding whether to allow the application to issue as a patent or whether there is no inconsistency in claims to the PTO. ② The intent to deceive the USPTO is rarely shown by direct evidences. It is the factor that is often be drawn in the absence of a credible explanation of the conduct. The intent is often shown by the totality of the circumstances surrounding applicant's acts including the highly material nature of the information not disclosed or lack of credible explanation for nondisclosure. It questions inequitable of not only the related parties but also patent attorneys. The judgment is reversed in appeal courts only if clearly erroneous mistake or abuse of discretion has been conducted. The chance of reversal is lower than 10 % in the case of erroneous mistake and is lower than 2% in the case of abuse of discretion. Therefore, if inequitable conduct is found, patent attorneys must expect the harshest result.

Next, he explained the case of Therasence, which was pending at the CAFC en banc over inequitable conduct. In the case, the district court found that statements concerning prior art by patentee's foreign agent to the European Patent Office (EPO) contradicted statements submitted to the USPTO and ruled that there was intent to deceive the PTO based on circumstantial evidence that no explanation was provided for the contradiction. The CAFC also affirmed the

decision of the district court. In April 2010, the CAFC decided to start the en banc hearing of the case based on the patentee's petition and an amicus brief. The amicus brief that Professor Takenaka supported pointed out the necessity of clarifying laws by the CAFC to clarify and restate the law in view of a lack of uniformity in the Court's decisions. The en banc rehearing will focus on six questions of law: ① Should the materiality-intent-balancing framework for inequitable conduct be modified or replaced? ② If so, how? In particular, should the standard be tied directly to fraud or unclean hands? If so, what is the appropriate standard for fraud or unclean hands? ③ What is the proper standard for materiality? What role should the USPTO's rules play in defining materiality? Should a finding of materiality require that but for the alleged misconduct, one or more claims would not have issued? ④ Under what circumstances is it proper to infer intent from materiality? ⑤ Should the balancing inquiry (balancing materiality and intent) by district courts be abandoned? ⑥ Whether the standards for materiality and intent in other federal agency contexts or at common law shed light on the appropriate standards to be applied in the patent context. Oral arguments at the en banc are scheduled on November 9, 2010. Mr. Stewart stated that the CAFC was taking negative attitude toward continuing inequitable conduct defense and the decision has the potential to dramatically



alter the landscape for alleged infringers. He pointed out that, specifically, if standard was elevated to “common law fraud,” significant defense would be lost for alleged infringers in many cases.

Last, he explained the US Patent Reform Act of 2010. In the Congress, the revision on inequitable conduct defense has been discussed over five years. The Congress intends to adopt “supplement examination” while maintaining inequitable conduct defense (It has not been passed yet by the Senate). This allows for request by patent owner to have the PTO consider, reconsider, or correct information believed to be relevant. If this procedure is conducted before the lawsuit starts, the court cannot rule that the patent is unenforceable on the basis of the information submitted for supplement examination. The reform is rapidly progressing at the CAFC rather than at the Congress. Mr. Stewart predicted that the en banc decision would redefine inequitable conduct.

In a QA session, vigorous discussions were made on various issues including the future patent examination concerning the judgmental standard for an abstractive idea after the Supreme Court’s decision on *Bilski* as well as the expected impacts on application practices by the CAFC en banc decision.



(Research Associate Noriyuki Shiga)

The IP Precedents Database Project

※ The database is available in English at:

<http://www.globalcoe-waseda-law-commerce.org/rclip/db/>

<Professor Ryu Takabayashi Awarded 2010 TEPIA Intellectual Property Academic Encouragement Award>

Professor Ryu Takabayashi, Vice Director of Waseda GCOE, Director of the RCLIP (Research Center for the Legal System of Intellectual Property, Waseda GCOE) was awarded Grand Prize of the 2010 TEPIA Intellectual Property Academic Encouragement Award by TEPIA, the Machine Industry Memorial Foundation for the IP precedents database project.

This project aims at providing a useful measure for researchers and practitioners to have discussions over the common materials contributable to the development of Intellectual Property Law which was established based on international treaties and has a certain degree of universality among different countries. To this purpose, the project will select important judicial precedents of Asian IPR cases, which have not been shared due to language barriers, add summary and notes to the precedents, translate them into English, and develop an open database accessible to anyone in the world on the Internet. The project started in 2003 with the cooperation of practitioners, academics, and judges in each country (as of 2010, China, India, Indonesia, South Korea, Taiwan, Thailand, Vietnam, Germany, France, and Italy). In 2005, Institute of Intellectual Property established the similar English database of Japanese precedents with the help of the RCLIP of Waseda Global COE, the Supreme Court of Japan, CASRIP (Director: Professor Toshiko Takenaka) of University of Washington School of Law (the US). In addition, we have held international symposia with the theme of IP enforcement, using legal systems or precedents in each country which we came to



know through this project. We believe that such activities are highly valued for this prize.

http://www.tepia.jp/chizai/chizai/summary_syorei.html (Japanese only)

❖IP Database Project: China

We gained the support of Tianjin University. With this support, the project of Chinese IP cases this year is to be well prepared.

(Global COE Research Associate Yu Fenglei)

❖IP Database Project: Indonesia

As of July 2010, we plan to start working with Attorney Fiona Butar-Butar on the development of new precedents of 2010.

(Research Associate Noriyuki Shiga)

❖IP Database Project: Thailand

Currently 435 Thai precedents have already been placed at the database. (RC Tetsuya Imamura)

❖IP Database Project: Vietnam

Last year, we could not build the database of Vietnamese precedents. This year we aim at preparing the precedents, having continuous collaborative relations with the People's High Court of Vietnam.

(RA Asuka Gomi)

❖IP Database Project: Korea

As of July 2010, 139 Korean precedents in total are stored at the database. This year also we are working on to develop additional data.

(RC Lea Chang)

❖IP Database Project: Europe

With the supports of universities in each country, we are currently working on concluding concrete agreements, aiming to collect 85 cases for France, 125 cases for Germany, and 50 cases for Spain.

(RCLIP Office Chiemi Kamijo)

❖IP Database Project: India

Just like last year, we aim to collect 40 precedents with the support of and Delhi University and CASRIP

(RCLIP Office Chiemi Kamijo)



Events and Seminars

<RCLIP International IP Seminar>

Date: October 2, 2010, Sat. 13:00~17:30

Place: Waseda Campus (TBD)

Overall host: Prof. Ryu Takabayashi, Director, RCLIP, Waseda University

<UK>

Moderator: Prof. Tetsuya Imamura, Meiji University

Speakers:

Prof. Uma Suthersanen, Univ. of London, Queen Mary School of Law

Prof. Jonathan Griffiths, Univ. of London, Queen Mary School of Law

<Germany>

Moderator: Prof. Toshiko Takenaka, Director, CASRIP, Univ. of Washington School of Law

Speakers:

Dr. Martin Schaefer, Boehmert & Boehmert, Berlin

Prof. Hanns Ullrich, Max Planck Institute for IP and Tax Law, Munich

Prof. Theo Bodewig, Humboldt University, Berlin

Sponsorship: JASRAC

Collaborator: Tokyo Medical Dental University

<German-Japanese Science and Innovation Forum 2010>

Workshop 1: Global Competition and Intellectual Property Strategy

Date: October 6, 2010, Wed. 14:00~16:30

Place: Roppongi Hills, Academy Hills

Moderator: Prof. Toshiko Takenaka, Director, CASRIP, Univ. of Washington School of Law

Speakers:

Mr. Takeshi Isayama, Former Commissioner of Japan Patent Office and Former Vice Chairman of Nissan Motor Co. Ltd.

Prof. Hanns Ullrich, Max Planck Institutes

Prof. Theo Bodewig, Humboldt University

Panelists:

Prof. Ryu Takabayashi, Waseda University

Mr. Felix-Reinhard Einsel, Sonderhoff & Einsel Law and Patent Office

Dr. Martin Schaefer, Boehmert & Boehmert

<RCLIP International IP Seminar>

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Sponsorship: JASRAC

Collaborator: Tokyo Medical Dental University

Date: October 16, 2010, Sat. 15:00~17:00

Place: Waseda Campus (TBD)

Overall host: Prof. Ryu Takabayashi, Director, RCLIP, Waseda University

Moderator: Prof. Toshiko Takenaka, Director, CASRIP, Univ. of Washington School of Law

Speakers:

Prof. Robert Gomulkiewicz, Director, IP Law & Policy LL.M., Univ. of Washington School of Law

Dr. Maria Cristina Caldarola, Corporate Intellectual Property, Robert Bosch GmbH

Mr. Yukihiro Terazawa, Morrison Foerster LLP, Tokyo Office

From the RCLIP Office

With the end of the rainy season, a heat wave started this summer. In the RCLIP office, we have heated debates as hard as this summer. New members from the US and Taiwan joined us from August to add our activity more international flavor. Please feel free to visit our office.

Editor/issuer

Ryu Takabayashi,

Director of Research Center for the Legal System of Intellectual Property (RCLIP)

Waseda Global COE Program

Web-RCLIP@list.waseda.jp

http://www.globalcoe-waseda-law-commerce.org/rclip/e_index.html