RCLIP Special Seminar (2/15/05)
"A Japan-US-Germany Comparative Legal Consideration -References for the Technical Scope of a Patented Invention- (focusing on the case of CAFC Phillips in the U.S.)"

On February 15, 2005, the RCLIP invited to speak at the RCLIP's Special Seminar Judge Randall Rader, the U.S. Court of Appeals for the Federal Circuit(CAFC), Professor Martin J. Adelman, Director of Intellectual Property Law Program, the George Washington University Law School, and Professor Toshiko Takenaka, University of Washington School of Law and Visiting Professor of Law, Waseda University.

To begin, Professor Takenaka explained the method that is used to determine the technical scope of a patented invention, with particular reference to previous US court's decisions relating to reference materials in claim interpretation. Given were the decisions made in the cases: *Markman v. Westview Instruments, Inc., Vitronics Corp. v. Conceptronic, Inc., Pitney Bowes, Inc. v. Hewlett-Packard Co.*, and in *CCS Fitness, Inc. v. Brunswick Corp*. Professor Takenaka further gave an explanation on the technical scope of the patented invention in claim interpretation and after-arising technology, referring to the decision in *Chiron Corp. v. Genetech*.

In continuation, Judge Rader gave a more detailed explanation on the issues raised by Professor Takenaka. Further, referring to the case of *Phillips v. AWH Corp*. at the en banc court, Fed. Cir, he described its background and issues in detail as well as discussed the possible patent policies unique to the bio technology field by mentioning the Chiron case where the issue was whether the technical scope of a pioneer patent could include after-arising advanced technology or not. Although it is difficult to predict the future development of the doctrine of judicial precedents, he concluded that, at any rate, it is impossible to make clear rules that can provide simple answers for claim interpretation.

Professor Adelman made a statement about the current circumstances in the U.K. where similar issues are taking place. As an example, he mentioned the case of *Catnic Components Ltd. v Hill & Smith Ltd.*, and the case of *Kirin-Amgen Inc. v. Hoechst Marion Roussel Ltd.*, (House of Loads), in order to explain the issue of after-arising technology in detail. In particular, comparing the House of Loads' decision in the case of Kirin-Amgen with the Federal Circuit's decision in the Chiron case, he described the relation between an invalid plea concerning enablement requirement and claim interpretation, with his analysis of comparative law.

Afterward, Professor Ryu Takabayashi, the director of the RCLIP, who was a moderator of the event, succeeded the discussion and explained briefly about the similar issues occurring in Japan today, focusing on the doctrine of equivalence.

The panel discussion after the reports, to start off, was mainly concerned with the previously raised issues regarding biotechnology related patents. Then, it discussed the differences in the doctrine of equivalence between each country. Particularly, Professor Takenaka introduced the prevailing theory among both academics and practitioners in the current U.S., to limit applying the doctrine of equivalents mainly to equivalents replaced by after-arising technologies. This theory was expressed in the concurring opinion filed by Judge Rader in the decision in *Johnson & Johnston Associates Inc., v. R.E. Service Co., Inc*. She then concluded to say that it was necessary to pay full, careful attention when making patent claims.

In a QA session with the audience after the panel discussion, practitioners, mainly Japanese judges, raised many questions and opinions. Of the interpretation regarding the requirement of essential elements in the decision in the case of ball spline in Japan, Professor Adelman contrasted it with the material requirement that was required when the House of Loads applied the doctrine of equivalents in the U.K. There was a view raised by one of the participants on whether it was possible to understand the case in a different way from Professor Adelman. Highly specialized discussion continued one after another. The seminar proved to be so successful that it appeared to satisfy all the participants who wanted forefront information in the field.

(RA Yuka Aoyagi)

RCLIP Workshop Series No.7 (1/31/05) "Moral Rights of Performers"

Shu Masuyama, Director of Legal Research Division, Center for Performers' Rights Administration, Japan Council of Performers' Organizations

In this lecture, Mr. Masuyama introduced domestic and international discussions on the issues such as the background of the lawmaking as well as the contents and limitations of the moral right of performers. Then, he raised issues to be examined and problems in the current Japanese Law, having a discussion actively with participants.

Development in digitalization has facilitated modification of performances. So perspective is internationally recognized that moral rights of performers should be admitted. Responding to the WIPO Performances and Phonograms Treaty (WPPT, adopted in 1996), Japanese Copyright Law was also revised in 2002 to grant moral rights of performers.

First, Mr. Masuyama followed the legislative circumstances around this lawmaking chronologically occurred in Japan and abroad to reach the actual legislation in Japan on the moral rights of performers, then introduced the International Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organizations in 1961(the Rome Convention) and related issues at WPPT in 1996. Then, he explained about related definitions in the Copyright Law of Japan.

Then, after a brief explanation about the provisions in WPPT, he examined the right of

determining the indication of the performer's name (Article 90bis) and the right of preserving the integrity (Article 90ter), referring to some cases, then pointed out several issues. In short, the right of determining the indication of the performer's name was the right to determine whether his/her name or stage name should be indicated or not. The right was limited to the cases that had no risk to damage performer's interest claiming he/she was the performer in the performance, and that were not against fair practice. In this respect, when the performer's name was indicated in the performance that other person did, it would become a problem whether it infringed the right of determining the indication of the performer's name or not. The right of preserving the integrity was the right to preserve the integrity of his performances against any distortion, mutilation or other modification of them that would be prejudicial to his/her honor or reputation. The right was not permitted to the modifications considered to be unavoidable and to be not against fair practice. It is questionable whether such kind of modifications can exist or not, which are considered to be unavoidable or not against for fair use while damaging performer's honor or reputation.

Furthermore, in comparison with the legislation related to moral rights of copyright holders, Mr. Masuyama pointed that the current law for moral rights of performers did not include some necessary provisions including the right of making the work public, moral rights of performers in joint-performance, regulations for an act of exploitation of a performance prejudicial to the honor or reputation of the performer, and penal regulations to distribution of copies of a work where a real name of other person or well-know false name was indicated as the performer's name, explicitly stating that the necessity to consider these issues. He also examined the relation to the copyright holder's right as well as a retroactive adjustment for the protection.

After the report, many questions arose from practitioners and academics, followed by theoretical and practical opinion exchange. Some of leading discussions were as follows. ①to the question about the indication of the performer's name when the performer was a group, Mr. Masuyama explained that moral rights of performers are the rights to an individual. So the group did not fall under the performer defined in the provision. ② to the question about the possibility for compensations for damages based on moral rights, occurred to the explanation that moral rights of performers differ from economic rights, Mr. Masuyama pointed out non-monetary nature of moral rights and implied the difficulty to recover to the status quo when infringed, referring to actual cases. ③to the opinion saying that it is necessary to have respective regulations for an act of exploitation of a performance prejudicial to the honor or reputation of the performer, Mr. Masuyama raised an actual example that a famous scene in a movie was copied for a karaoke clip and admitted the necessity of legislative solution for this kind of case to be expected. (RA Yuan Yi)

RCLIP Workshop Series No.8 (4/25/05)
"The Article 30 of Copyright Law and Three-step Test"

Tetsuo Maeda, Attorney at Law of Somei/Maeda Law Firm, Lecturer of Graduate School of Law, Waseda University

The RCLIP Workshop Series No.8 invited Mr. Tetsuo Maeda, Attorney at Law, to give a report titled "The Article 30 of Copyright Law and

Three-step Test".

The three-step test is a set of rules stated in the Berne Convention as well as other treaties. It says that limitations or exceptions to exclusive rights are confined to certain special cases (the first requirement) that do not conflict with the normal exploitation of a work (the second requirement) and do not unreasonably prejudice the legitimate interests of the right holder (the third requirement).

After giving an explanation on Article 30 of Japan's Copyright Law that included limitations of copyright, Attorney Maeda pointed out that the cases where private use was permitted by Article 30 were inconsistent with those limited to the three-step test. For example, A and B who were not members of the same family (not in the same household) bought a CD album together, and A made a copy of the CD on a CD-R, then gave the CD to B. A could then listen to the album on the CD-R and B could listen to the original CD as they pleased. Under Article 30, A's act of making copies is considered to be within the scope of a reproduction for private use. However, in the three-step test, the second requirement is generally interpreted to mean that the reproduction "does not conflict with the exercised copyright holder's right". Based on this interpretation of the wording, A's reproduction cannot be permitted because it is invasive of the music CD market and conflicts directly with the copyright holder's business.

As a value judgment, Attorney Maeda defined that it was inappropriate to permit the action stated above (the act allowing two persons not in the same household to use the copied work simultaneously in different places). Then, he explained possibilities and issues in interpretation that would limit to the application of Article 30.

In the interpretation described by Attorney Maeda, the three-step test can be introduced to the application of Article 30 through Article 5. Namely, the Article 5 states that "if an international treaty provides otherwise in respect to the rights of the authors.... the provisions thereof shall prevail". Thus the three-step test provided in the international treaty should prevail as long as the application of Article 30 and that of the three-step test are different. However, since it is still inappropriate to deny Article 30 because it might breach the treaty, he suggests an interpretation that limits itself to the application of Article 30 in order to be consistent with the three-step test, using, for example, a limited interpretation of constitutionality. On the other hand, he also introduced an objection to this view, saying that the rule of Article 5 means that an international treaty prevails only when national laws have no rules in respect to the matter. Further, he cited Tokyo District Court's Decision on the STAR digit case (Tokyo District Court's Decision of May 16, 2000, Hanrei Times 1057, p.221) that rejected the limited interpretation of Article 30 to be in conformity with a treaty. Then, it was considered that Article 5 intended for "an international treaty [to] prevail if regulations of national laws and those of the international treaty conflict", from the phrase "if an international treaty provides for otherwise with respect to the rights of authors" in the Article 5. Thus, in his opinion, it seemed difficult to understand the phrase to say, "an international treaty prevails if national laws do not provide with respect to the matter"

Then, as an issue surrounding the stated interpretation, he referred particularly in relation to the royalty system for private reproduction in Japan, which requires that any person who makes sound or visual recording on a digital recording media for private use pay a reasonable amount of compensation to the copyright owners (Article 30(2)). Namely, the system was introduced through concerns that the Article 30 might be inconsistent with the three-step test as it had been because the application of the provision was too broad in its interpretation. As far as the system was introduced, an objection can be made that the Article 30 has already met the requirements of the three-step test. In this respect, Attorney Maeda stated that the system be introduced to

avoid a possible violation of the third requirement of the three-step test (the reproduction do not unreasonably prejudice the legitimate interests of the right holder), concluding that even after the system is introduced, copyright holders can still eliminate illegal acts that directly conflict with everyday business of the copyright holders (that is, whatever violates the second requirement: the cases do not conflict with a normal exploitation of the work).

After introducing these interpretations stated above, Attorney Maeda explained that the reason why the illegality of the stated reproduction was an issue in the first place, was because uncertainty existed in the relation between the second requirement of the three-step test and the provisions of Article 30. Based on this understanding, he said, whether or not a certain reproduction met the second requirement of the three-step test depended on whether it could be said in general or not that users had to buy the work in the market in order to make that kind of reproduction. In this judgment, he referred to factors that need to be considered such as ①the type of work, ②the purpose and nature of the reproduction (for example, whether the reproduction is meant to meet the same purpose as the purpose of buying a music CD product), ③the number of reproductions（wholly or partially reproduced）, and ④the quality of the reproduction（equivalent to the quality of the original music CD）.

In addition, he pointed out the necessity to examine a possible legislation to add a such addendum to the Article 30 as those appeared in Article 35(1) or 36(1) providing regulations to limit the limitation of copyright, “provided that such reproduction unreasonably prejudice the interests of the copyright owner”.

Lastly, Attorney Maeda said that the current rules in the Article 30 permitted reproductions that were impermissible in the light of the three-step test, however, on the other hand, they regulated reproductions that were permissible in the light of the three-step test, for example, a reproduction of a part of a work for an internal meeting at a company. So he stated it was open to question in terms of social propriety, pointing out the necessity of interpretation of this legality as well as the necessity of legislative interpretation.

Followed by the report above, an active QA session took place among participants.

(RC Asuka Gomi)

International Symposium: “Biotechnology and Biotherapy” sponsored by Hokkaido University (2/22-23/05)

On February 22nd and 23rd, an international symposium was held, sponsored by the 21st Century COE Program at Hokkaido University featuring ”the Laws and Policies of Intellectual Property: Building a New Global Network”. The RCLIP co-sponsored the event and Research Assistant Yuka Aoyanagi presented a report.（”Involvement of Indigenous Peoples and Local Communities to Law Making Relating to Traditional Knowledge”）The symposium invited many researchers from Taiwan as well as many panelists from Japan including Prof. Toshifumi Hienuki and Prof. Teruki Tsunemoto of Hokkaido University and Associate Prof. Ryuta Hirashima of Tsukuba University, and Ms. Maiko Tagami of the Japan Patent Office. Following the reports where the panelists brought up a broad range of discussion points, a panel discussion was held with active opinion exchanges among the attendees the afternoon of the last day of the event. The RCLIP expects to contribute in developing discussions of Intellectual Property Rights within academic circles in Japan, and will continue its collaborative relationship with Hokkaido University. Please refer to the event in detail by visiting the Hokkaido University COE Website.

http://www.juris.hokudai.ac.jp/coe/seminarinfo/feb05/timetable.html

(RA Yuka Aoyagi)

≫RCLIP Special Seminar (5/9/05)

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

As global R&D activities are developed, Japanese enterprises or universities often confront increasing disputes relating to inventorship or licensing of inventions because of the difference among countries on employee's invention law or on contents of the rights for joint invention. Especially, in the high-tech field such as health science or IT where many researchers involve with development, it is difficult to specify joint inventors, causing a dispute.

On this issue, the RCLIP held a special seminar, co-sponsoring with Office of Intellectual Property at Waseda University and Intellectual Property Division at Tokyo Medical and Dental University on May9, 2005. The theme was "Issues resulting from R&D Activities: Foreign Licensing Issues and Inventorship or Ownership Disputes".

About 170 people including the concerned parties participated in the event. After substantial lectures, a panel discussion took place. The abstract of this seminar is following. After the session, a reception was held, sponsored by Dorsey & Whitney Seattle Office of Mr. Paul Meiklejohn, in order to provide the audience with an opportunity to meet the speakers in person and exchange business cards.

※ Our next newsletter in August 2005 will feature this special seminar in more detail.

【Speakers】

Opening:

Mr. Akira Fujiwara (Manager of Intellectual Property, Intellectual Property Division, Tokyo Medical and Dental University)

Lecturer:

Prof. Keisuke Shimizu (Keio University, Faculty of Business and Commerce, Director of Intellectual Property Center, Keio University)

Dr. Heinz Goddar(Patent Attorney at Law in Germany, Boehmert & Boehmert)

Mr. Paul Meiklejohn(Patent Attorney at Law in the U.S., Dorsey & Whitney, Lecturer of University of Washington School of Law)

Moderator:

Prof. Toshiko Takenaka (University of Washington School of Law, Waseda Law School)

≫The RCLIP Column

A monthly column on various IP related issues is updated at our website.

This month's column:

55 Years since "The Kiss at City Hall"

by RA Akiko Ogawa

In 1950, Robert Doisneau, a photographer, took a series of pictures of young lovers in Paris for Life magazine. "The Kiss at City Hall" was one of the pictures. Some who saw the picture claimed to be the couple of the photo, but Doisneau did not reveal who the models were.... until the time when a lawsuit was filed against him…..(http://www.21coe-win-cls.org/rclip/activity/e_index11.html)

IP Japanese precedents database at the Institute of Intellectual Property's website and Asian Seminar

The Institute of Intellectual Property (IIP) in Japan has released an IP Japanese precedents database in Japanese (not available in English) on their website.

http://220.99.110.43/cases/search.html

The RCLIP's site now has a link to this database, allowing users to use both databases easily. As may be found in the explanation on the site, the Supreme Court, the RCLIP, and University of Washington have collaborated to create the database, led by the IIP's initiative. The RCLIP's Asian precedents database and the IIP's Japanese IP precedents database will contribute to facilitating discussions among researchers and practitioners of the Asian IP system, for further development of the overall IP system.

Based on the research of these databases, the RCLIP will organize Asian seminars in October 2005 (Thai IP Seminar) and in January 2006 (Chinese IP Seminar) at Waseda University. Participation in these seminars is free. The RCLIP will invite recognized authorities from each country, expecting many participants for each seminar.

The RCLIP's Asian IP Precedents Database Project

In March, eight Chinese precedents added to the RCLIP's Asian IP precedents database (available in English) and as the following reports of database project in each country, precedents for the database are being prepared. In addition to Thailand, China, and Indonesia where the projects have already started, a project in Taiwan will start in the fiscal year 2005, and the RCLIP is currently researching for the project in both Vietnam and Korea.

※ 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

Currently, the IP precedents of the Beijing region are being translated into English. For that area, Associate Prof. Zhang Ping of Peking Univ., Prof. Guo He of Renmin Univ. of China and Prof. Wang Bing of Tsinghua Univ. are responsible for the database project. The IP precedents of the Shanghai region and its surrounding area, where Prof. Zhang Naigen of Fudan Univ. and Associate Prof. Li Zhenghua of Zhongshan Univ. are working on the project, as well as the IP precedents of the Guangdong region are now at the stage of revising.

Translated precedents will be available at the RCLIP Asian IP database next fall.

(RC Yuan Yi)

IP Database Project: Thailand

157 Thai precedents are currently available in the database. By the end of May of 2005, 50 precedents will be added.

(RC Tetsuya Imamura)

IP Database Project: Indonesia

RCLIP has decided to establish the database of Indonesian IP precedents in cooperation with the Supreme Court of Indonesia Justice Abdul Kadir Mappong, the Deputy Chief Justice of the Supreme Court, is the leader of the DB project team, formed by the Supreme Court of Indonesia. At the meeting with Justice Mappong at the end of March in Jakarta, the cooperative plan became almost fixed. Up to now, RCLIP had sought several resources for project cooperation in Indonesia, and it turned out that the difficulty in accessing Indonesian precedents had been a key issue for that project. However, RCLIP expects that future collaboration with the Supreme Court will make the project proceed steadily and smoothly hereafter. (RA Yuka Aoyagi)

IP Database Project: Taiwan

The IP precedents database project in Taiwan will begin in the fiscal year 2005. A preliminary research has started since last fall and the RCLIP had had opportunities to have a lot of useful advice and information from researchers and practitioners specialized in IPR in Taiwan. Based on the research, the RCLIP has decided to ask Prof. Ming Yan Shieh of National Taiwan University and his team for cooperation. Prof. Ming Yan Shieh kindly agreed to collaborate with the RCLIP, with the strong belief that the project will contribute on mutual academic development.

The RCLIP will conclude an agreement with National Taiwan University on the database project next spring. (RC Yuan Yi)

IP Database Project: Philippine

The Intellectual Property Office (IPO) of the Philippines announced that it would launch, on December 16th 2004, its New Interactive Website, a Trademark Electronic Filing System ("TM ONLINE"), an Electronic Gazette for trademark publications (e-Gazette Trademarks) and an IP Case Online Search System that uses English. (http://www.ipophil.gov.ph/page_details.asp?sr=220) In view of the fact that the IP precedents of the Philippines have already been introduced in English in the Philippines, RCLIP has decided not to start the Philippines DB project at our COE Institute's DB for the present since the urgency to start it is of a lower priority. (RA Akiko Ogawa)

IP Database Project: Vietnam

The Vietnam DB project is still at the research stage. However, communication with the parties of interest in Vietnam will start soon, following the advice that Social Sciences Professor Tran Van To gave to the RCLIP. (RA Akiko Ogawa)

IP Database Project: Korea

The Korean IP database project is also still at the research stage. However, the RCLIP has begun contact with Prof. JONG Sang Jo of the Center for Law and Technology of Seoul National University, seeking either database establishment in Korea or possible collaboration with the RCLIP. (RA Lea Chang)

Upcoming Event

(1) RCLIP Workshop Series No.9 on 6/27/2005, 18:00-20:00, at Waseda University. Title: Ownership of Copyright at Universities and Distribution Rule (No English translation)
(2) RCLIP Special Seminar on 7/4/2005, 18:00-21:00, at Waseda University. Title: Strategies for International Litigation and IP Dispute Resolution System in Japan (No E.)

For inquiries, please visit our website.

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