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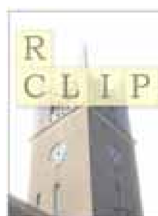
http://www.21coe-win-cls.org/e_index.html



Newsletter

21COE-WIN-CLS RCLIP

RCLIP Asian Seminar No.3（2005/3/2）

"Recent Movement of Korean IP Precedents"

Choi Sung-Joon, Senior Judge, Patent Court of Korea

The RCLIP Special Seminar on March 2, 2006 invited Senior Judge Choi Sung-Joon, Patent Court of Korea to deliver a lecture entitled as "Recent Movement of Korean IP Precedents – Comparison with Japanese Precedents". Since this seminar was held to commemorate the data addition of Korean precedents to RCLIP's database, the lecture widely covered recent important precedents in Korea. Judge Setsu Shimizu, Tokyo District Court also attended to give us an explanation about Japanese precedents related to Korean precedents that Judge Choi introduced in his lecture.

First, as patent law related decisions, Judge Choi introduced (1) Korean Supreme Court's decision on "requirements of doctrine of equivalence"(the Supreme Court's decision 97 Fu 2200 on July 28, 2000), indicating that the requirements stated in the decision were almost the same as those in Japanese Supreme Court's decision of the ball spline bearing case in Japan (The Third Petty Bench of the Supreme Court decision of March 9, 1999, Minsyu 53 3 303), however, the primary requirement such as "the solutions to the problems of both inventions must be equivalent" in Korea was slightly different from that in Japan. Next, he explained (2) the flow of the decision on patent infringements of "omission invention" (an incomplete invention which has less or equivalent effect than the effect of the patented invention by omitting less important component parts in the patented invention). With this respect, he introduced the recent Korean Supreme Court's decisions (the Supreme Court's decision 98 Fu 2351 on November 14, 2000 and others) indicated that the invention was not within the technical scope of the patented invention in principle when a part of required component elements was missing (the principle of component element completion). Furthermore, (3) in relation to "the hearing scope of a suit against Patent Office's trial decision for invalidation", he said there had been many discussions in Korea since the opening of the Patent Court. Then he introduced "the theory of no limitation", currently adopted by the Patent Court, which did not limit the hearing scope in a suit against Patent Office's trial decision for invalidation and the Patent Court did not allow the claim of new ground of rejection in an appeal against decision of rejection (the Supreme Court's decision 2000 Fu 1290 on June 25, 2002 and others). Also, even when the judgment to approve correction is decided while the suit against Patent Office's trail decision for invalidation is pending, the Patent Court will not cancel the trial decision by that judgment immediately, but it will make judgments if the ground for invalidation exists or not about the scope of the corrected patent claim. He pointed out this handling was quite different from Japanese approach.

In addition to precedents related to patent law,

Judge Choi also referred to precedents related to trademark law, domain name, and copyright law such as the case of P2P file-swapping. For example, about “the scope of trademark that may offend public order and morals”, there have been the cases where someone is applying other’s trademark which is famous in a foreign country but unknown in Korea. For those cases, it should be examined whether or not they offend public order. He introduced that the Patent Court consistently decided such cases did not offend public order. Following Judge Choi’s lecture, Judge Shimizu of Tokyo District Court explained some Japanese precedents in relation to the Korean precedents introduced by Judge Choi. First, about the Supreme Court decision for the case of ball spline bearing, which indicated “requirements of doctrine of equivalence”, he agreed with Judge Choi that the second to fifth requirements of the five requirements in the decision were the same as Korea. He also mentioned that the first requirement, which seemed slightly different, would essentially say the same thing although the expression was different. Furthermore, he introduced the Supreme Court decision for the case of the method for manufacturing large-diameter rectangular steel tube (The Third Petty Bench of the Supreme Court decision of March 9, 1999, Minsyu 53 5 303) and pointed out that, just as Judge Choi indicated in his lecture, there was a great difference between Japan and Korea in the case handling when the judgment to approve correction was decided while the suit against Patent Office’s trail decision for invalidation was pending.

After a break, a panel discussion took place, joined by Professor Ryu Takabayashi of Waseda University, RCLIP’s director. The discussion mainly focused on “invalidation judgment in a suit against infringement” and “examination scope in a suit against Patent Office’s trial decision for invalidation”. Although he did not introduce any precedents related to the first topic in his lecture, in the response to Professor Takabayashi’s question, Judge Choi stated that there had been many discussions over this issue and there was the decision of the Supreme Court of Korea that approved “invalidation judgment in a suit against infringement” like the Kilby case in Japan (The Third Petty Bench of the Supreme Court decision of April 11, 1999, Minsyu 54 4 1368). However, Judge Choi clarified that it was less precedential because the decision only mentioned this point as an obiter dictum. Next, Judge Choi also responded to Professor Takabayashi’s questions about the case handling when the judgment to approve correction was decided while the suit against Patent Office’s trail decision for invalidation was pending, in relation to the second point. He explained that, same as Japan, Korea also reversed and remanded the original decision if the judgment to correct the decision was decided while the case was still at the Supreme Court. When the case is pending at the Patent Court, Korea continues proceedings of the scope of the corrected claim unlike Japan because it is possible to continue the trial for further consideration. He also explained that adopting “the theory of no limitation” in a suit against Patent Office’s trial decision for invalidation intended to allow people to have the right to a court immediately.

(RA Asuka Gomi)

RCLIP Workshop Series No.13（2006/4/17）

"Interface of Design Law and Copyright Law – Copyright Protection Guideline for Applied Art"

Masahiro Motoyama, Associate Professor of Law, Kokushikan University

RCLIP Workshop Series No.13 on April 17, 2006 invited Associate Professor Masahiro Motoyama, Kokushikan University to report on "Interface of Design Law and Copyright Law – Copyright Protection Guideline for Applied Art".

According to the report, the guideline of "a high degree of creativity", which courts adopt for protecting works of applied arts by copyright law, is rooted in "the stage theory" in the legal interpretation of German copyright law. That "stage theory" is a legal theory to understand that works and designs are "creations of the same nature but have differences to some degree". On the premise of the legal interpretation of our design law finding "the theory of confusion" appropriate, there is no logical consistency in adopting "the stage theory" to the legal interpretation of our copyright law. The report concluded that it was appropriate to apply a general protection guideline for copyright for protecting works of applied arts.

First, Associate Professor Motoyama outlined the precedents where the protection of works of applied arts by copyright law came into question. He pointed out the past precedents adopted and maintained the guideline of "a high degree of aesthetic creativity" as the guideline for protecting works of applied arts by copyright law based on the grounds that (1) design law and copyright law exist in parallel and (2) works of applied arts are protected by design law. Many theories have held critical and negative opinions against that guideline. He stated that those criticism were only from the interpretative methodological perspective and few of them criticized it based on the view that "why such a unique guideline is accepted", which was an essential problem. The guideline of "a high degree of aesthetic creativity" means that the work of applied art must be accompanied with a high degree of creativity enough to exceed the degree of creativity required as a general requirement of copyrighted work so that copyright law protects the work of applied art that is a subject of design law protection.

Therefore, as a premise of criticism of the guideline of "a high degree of aesthetic creativity", the report examined its root and clarified the root was "the stage theory (Stufenthorie)" in the legal interpretation of German copyright law by raising several grounds. "The stage theory" is the way of thinking that a rigid distinction between a subject of design law protection and a subject of copyright law protection is made in stages depending on the degree of aesthetic creativity or molding as an indicator. This theory has been formed through accumulating precedents and is now also supported by the Supreme Court (Federal Court of Justice of Germany, the *Bundesgerichtshof*). This stage theory is premised on that the subject of both rights is equivalent, that is, the subject of design law protection is interpreted based on the theory of creation.

Next, he examined whether or not the subject of design law protection was interpreted based on the theory of creation in Japanese design law interpretation and then, denied it by referring to many precedents. In Japan, the scope of protection by design law is distinguished by the "similarity in concept". Over the understanding of the "similarity in concept", the theory of creation conflicts with the theory of confusion. The precedents have rejected the theory of creation and stood on the theory of confusion

basically. Especially in the recent precedents, there have been cases where the registered design lost its protection as a result of the decision for registration invalidation based on the theory of confusion. So, he pointed out that the theory of confusion tended to slow down. In relation to the theory of interpreting design law that applies the theory of confusion instead of the theory of creation, there is no theoretical consistency in adopting "the stage theory" = the guideline of "a high degree of aesthetic creativity" for interpreting copyright law. Therefore, he concluded that, it was appropriate to adopt the general guideline of copyright protection for works of applied arts just as other copyrighted works.

Lastly, if the general protection by copyright law is adopted for works of applied arts, the conflict of the right of adaptation or the right of integrity might occur in some cases like a case making improved products, resulting in impediment to industrial development. In response to that possible criticism, the report referred to the case of "the classified telephone directory", decided by Tokyo District Court on November 30, 2000, then, concluded that it would not be a matter of grave concern if the scope of copyright protection and the degree of creation were correlatively interpreted. In short, the aesthetic expression, which has functions, must be at a lower level in terms of the degree of creation because of its functional limitation. The effect of copyright law will remain only in the extent to remove a dead copy after all.

In addition, there might be an objection that design law's raison d'etre will decrease if the works of applied arts are protected by copyright law. On this point, the report concluded that design law's raison d'etre would never be lowered because the design law was composed of absolute right, given the fact that the copyright law was composed of relative right.

An active QA session took place with the participants after the report stated above.

In addition, in response to the question from a participant, Associate Professor Motoyama pointed out that EU Design Law and new German Design Law that went into effect in Europe came to have the framework of competition law, and as its theoretical consequence, the traditional stage theory had tended to decline in German.

(RA Asuka Gomi)

RCLIP & CASRIP Joint Seminar: U.S. Patent Lawsuit Seminar (2006/4/24)

RCLIP & CASRIP Joint Seminar was held On April 24, 2006, inviting Kent A. Jordan, Judge of Delaware State Federal District Court at Waseda University, Ibuka Masaru International Conference Hall.

Delaware State Federal District Court is one of the courts that handle many patent infringement cases in the U.S. It handles about 150 IP related cases per year. In the keynote speech, Judge Jordan explained how important the context was in understanding words by using English texts and Japanese texts as references, then, emphasized that "claim interpretation" was the matter of language and it was not simply legal interpretation.

Patents are made by putting dialogues to an inventor, a society, and regulatory authorities in writing. The interpretation of patents should be done while considering the context. The claim interpretation is the process to discover what that claim means, for whom that claim has what meaning, and to which person that claim has the meaning. It is not enough to simply choose the

definition in the dictionary. It is necessary to read what the inventor meant in the context of the claim.

Following the keynote speech by Judge Kent Jordan, Barry Bretschneider, Morrison & Foerster LLP gave comments on Judge Jordan's speech.

After a break, a panel discussion took place with the participation of Mr. Ryuichi Shitara (Judge of Tokyo District Court), Mr, Eiji Katayama (Attorney at Law), Mr. Barry Bretschneider (Morrison & Foerster LLP), Professor Ryu Takabayashi (Professor of Law, Waseda University), moderated by Toshiko Takenaka, Professor of Law School, University of Washington, Visiting Professor of Law, Waseda University.

Compared to patent litigation in Japan, the distinct feature of patent litigation in the U.S. is the jury system in fact-finding proceedings. However, it is said many people in the U.S. want to abandon jury judgment. But, from the position of the agent of the party, Mr. Bretschneider stated the jury system is quite reliable.

Next, using a hypothetical case based on the case of Bausch & Lomb contact lens decided by the Federal Circuit in 1986, the panelists had a discussion about the overbroad claim despite its disclosure of the specification or the claim that can be interpreted to include the prior art. The discussion considered the relation between grounds for invalidation and claim interpretation in Japan and U.S. from the perspective of comparative law. Then, the panelists described how the claims were argued in the court on the assumption that Japanese and American lawyers serve as a proxy for the plaintiff or a proxy for the defendant in the hypothetical case. It was a quite interesting discussion because the audience could know how Japanese and American judges respond to such claims. After the seminar, the card-exchange party was held, sponsored by Nakamura and Partners.

(COE Research Associate Lea Chang)

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

280 most important precedents accumulated by FY 2004 were translated into English, checked for terminological accuracy as well as English accuracy, and placed at the database (50 patent cases, 60 trademark cases, and 60 copyright cases of Beijing region, 50 cases of Shanghai region, and 60 cases of Guangdong region). Chinese DB project was completed as it was planned. Translating 40 cases of 50 most important precedents for FY 2005 has already been started (10 patent cases and 10 copyright cases of Beijing region, 10 cases of Shanghai region, and 10 cases of Guangdong region). Those will be placed at the database this summer.

(RC Yuan Yi)

≫IP Database Project: Thailand

Currently 254 Thai precedents have already been placed at the database. More 50 cases will be added within this fiscal year. To analyze the Thai precedents accumulated so far, a COE Research Associate had made a one-week visit to the IP&IT Court in Bangkok. The precedents related to trademark of those collected precedents were examined this time. The research result has been publicized at the COE's periodical journal.

(RC Tetsuya Imamura)

≫IP Database Project: Indonesia

Finally Indonesian DB was completed and uploaded to the website. 80 cases were selected among the Supreme Court's precedents. It is said even local attorneys cannot acquire those decisions. So publishing 80 precedents over the Internet is significantly meaningful. It is quite touching and impressive to see the database completed at last after a long effort since the beginning of the project. It is strongly hoped that it will be widely utilized. (RC Yuka Aoyagi)

IP Database Project: Taiwan

Taiwan DB project has been advancing its two-year plan. As this fiscal year starts, 300 cases for the first year and the second year have already been completed and uploaded at the website. A part of them uses pictures. Interesting precedents were collected. Next, the project will move to the process to update the database.

(RC Yuka Aoyagi)

IP Database Project: Vietnam

The project is at the stage of confirming the basic information of Vietnam. In the near future, an RCLIP member will visit Vietnam for further progress to collect concrete precedents and seek to upload the precedents within this fiscal year.

(RA Asuka Gomi)

Events and Seminars

For inquiries, please visit our website.

The 4th Research Presentation of Intellectual Property Association of Japan, Joint Session, "International Seminar on Judicial Treatment of Industrial Property Disputes in East Asia"

【Date】June 18, 2006, 10:00-12:00

【Place】Waseda Univ., Bldg 52, Room #301

【Lecturers/Panelists】

Prof. Shieh Ming-Yan (Taiwan National University)

Attorney Hubert Hsu (Hubert Hsu & Associates)

Justice Georgia Shu-yen Chou (Presiding at the Civil Court of Taiwan Panchiao District Court)

【Coordinator/Panelist】

Tatsuki Shibuya, Professor of Law, Waseda University (Coordinator), Toshiko Takenaka, Professor of Law School, University of Washington, Visiting Professor of Law, Waseda University, Ryu Takabayashi, Professor of Law, Waseda University (Moderator)

RCLIP Workshop Series No.15

【Date】June 30, 2006, 18:30-20:30

【Place】Waseda Univ., International Conf. Hall, 3rd floor, Conf. Room #2

【Lecturer】Toshiko Takenaka, Professor of Law School, University of Washington, Visiting Professor of Law, Waseda University

【Theme】Comparative Legal Analysis on the Issues under Patent Law and Competition Law about Replacement of Consumables

RCLIP Workshop Series No.16

【Date】July 19, 2006, 18:30-20:30

【Place】Waseda Univ., International Conf. Hall, 3rd floor, Conf. Room #2

【Lecturer】Ryuta Hirayama, Associate Professor of Law School, Tsukuba University

RCLIP Special Seminar

【Theme】Copyright and Freedom of Expression

(1) Comparative Advertising: The Conflicting Claims of Copyright, Unfair Competition and Freedom of Expression.

(2) "Fair dealing" and like exceptions in UK

(3) Limitations on copyright in Japan

【Date】July 26, 2006, 18:00～21:00

【Place】Waseda University (Bldg 8, 3rd floor)

【Lecturers】

Mr Jonathan Griffiths, BA (Oxon) MA (York), Solicitor

Senior Lecturer, Department of Law at Queen Mary, University of London

Mr Tetsuya Imamura, Candidate for the SJD (Waseda Univ.)

Lecturer, School of Information and Communication, Meiji University

【Coordinator】

Ryu Takabayashi, Professor of Law, Waseda University

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