Articles

Summary of the "Judicial Symposium on Intellectual Property/TOKYO 2018"

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Part 1 Introduction

The "Judicial Symposium on Intellectual Property/TOKYO 2018" ("JSIP2018") was held for two days from October 31, 2018. This symposium was co-organized by the Supreme Court, the Intellectual Property High Court, the Ministry of Justice, the Japan Patent Office, the Japan Federation of Bar Associations, and the IP Lawyers Network Japan following the "Judicial Symposium on Intellectual Property/ TOKYO 2017" ("JSIP2017") held in October 2017.[1,2]

This report is a brief summary of the overview and results of JSIP2018.

Part 2 Overview of JSIP2018

1. Background of the symposium

In the field of intellectual property, it is common to see similar disputes occurring in many countries at the same time because business activities are becoming more globalized and the technology protected by IP rights is used throughout the world. As a result, in this sense, it is extremely important to pay attention to the trends of IP disputes in other countries and to ensure that the interpretation and application of laws by Japanese courts meet the world's standards.

Since its establishment in April 2005, the IP High Court has been receiving an increase in number of visitors from abroad. In total, more than 3,000 legal experts visited the IP High Court from other countries. Also, there has been an increasing number of opportunities for Japanese judges to go abroad and make presentations at international conferences on IP-related issues or attend such conferences as panelists.

Amid this trend, JSIP2017 held in October 2017 was the first symposium for which the IP High Court joined as one of the organizers. The IP High Court offered a program in the symposium in which four countries, namely, Japan, China, South Korea, and Singapore, conducted mock trials and a panel discussion on the topic of evidence collection procedures. Such program was provided for the

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purpose of promoting mutual understanding of the legal systems and judicial practices in East Asia in terms of IP-related disputes, raising a sense of partnership and solidarity among the four countries in order to improve the dispute settlement capability in the region as a whole, and providing the legal experts and business persons who attended the program with accurate information concerning the legal systems and judicial practices in those countries in order to help them conduct IP-related activities in the region.

The "Judicial Symposium on Intellectual Property/TOKYO 2018" was held as an event following JSIP2017 by inviting Asian countries. JSIP2018 was held by inviting Germany, France, the U.K., and the U.S., in order to achieve the aforementioned goals in cooperation with Western countries.

2. Overview

JSIP2018 was held for two days in Tokyo (October 31 and November 1, 2018 at Bar Association Building (Auditorium "Creo")). 527 people participated on the first day, on which the IP High Court provided the aforementioned program, whereas 357 people participated on the second day, on which the JPO provided a program. In total, about 900 people participated in the symposium.

JSIP2018 has the subtitle "Global Collaboration for IP Dispute Resolution." Many legal experts were invited such as judges and attorneys from Germany, France, the U.K., and the U.S. and also examiners from the USPTO and the EPO. In particular, it should be noted that world-renowned judges in the field of intellectual property rights participated in the symposium such as Presiding Judge Peter Meier-Beck from the German Federal Supreme Court (Bundesgerichtshof), Judge Richard Hacon from the Intellectual Property Enterprise Court, and Judge Richard Linn from the United States Court of Appeals for the Federal Circuit.

Part 3 Overview of the results

1. First day (October 31)

(1) Overview of the program

On the first day, the IP High Court offered a program.

JSIP2018 started with the greetings from the Supreme Court Justice, Tsuneyuki Yamamoto, followed by mock trials and a panel discussion conducted by the participants from five countries, namely, Japan, Germany, France, the U.K., and the U.S.

The theme of the mock trials was "Patent validity in patent infringement lawsuit." In each mock trial, firstly, a judge or attorney from the five countries explained the legal system of their respective home countries. Then, a mock trial was conducted by the judge and IP lawyers in their country. In all of the mock trials, the same hypothetical case was handled.[3] After the mock trials conducted by judges and lawyers from the five countries, a panel discussion was held by a total of 10 panelists consisting of judges and lawyers from the five countries.[4]

The details of the mock trials and panel discussion conducted by the representatives of the five countries are described in a separate report (Akira Katase and Ken Furusho, "Report on the Judicial Symposium on Intellectual Property/TOKYO 2018 (Fisrt Day): Comparison on 'Patent Validity in Patent Infringement Lawsuit' based on Mock Trials conducted by Five Countries," page X of this magazine). In short, the mock trials and panel discussion has revealed that each country has a different legal system to handle a dispute over the issues of patent invalidity in a patent infringement lawsuit. Although the mock trials reached almost the same conclusion, the systems of the five countries differ greatly in terms of the decision-making process and approach.

(2) Patent invalidity dispute

In Japan, we have a so-called double-track system to handle patent invalidity disputes. Under the first track, an alleged infringer can file a request for a patent invalidation trial before the JPO and appeal its decision to the IP High Court. In addition to that, alleged infringer can raise a patent invalidity defense in a patent infringement lawsuit (Article 104-3 of the Patent Act). In the aforementioned five countries excluding Germany, it is possible to raise a patent invalidity defense in an infringement lawsuit. Furthermore, in France, the U.K., and the U.S., a counterclaim can be filed against an infringement lawsuit in order to seek revocation of a patent or to seek a declaratory judgment on patent invalidity. In this way, a patent invalidation procedure is available at an infringement court in those countries. In Germany, the Federal Patent Court is in charge of patent invalidation lawsuits, which is different from the court in charge of hearing a patent infringement case. Moreover, as a Patent Office's procedure to invalidate a patent after the expiration of the period to reexamine, there is the patent revocation procedure in the U.K. and the IPR (Inter Partes Review) system in the U.S. However, there are no such procedures in Germany and France.

In the 21st century, Japan adopted a procedure to file a request for a patent invalidation trial before the JPO and also a procedure to raise a patent invalidity defense in a patent infringement lawsuit. Thanks to these procedures, the proceed-

ings of the infringement lawsuits can be conducted efficiently without suspending it. The mock trial and panel discussion gave us an opportunity to show measures to prevent legal instability under the aforementioned two procedures (so-called double track). One of those measures is the establishment of Article 104-4 of the Patent Act, which imposes restrictions to raise a patent invalidity defense at a re-trial even if a contradicted JPO decision is finalized following the finalization of the judgment of the infringement lawsuit. The other measure is that the same panel of the IP High Court which has the exclusive jurisdiction over the two procedures is to conduct both proceedings and make same determinations on patent validity. We were also able to explain that the allegations and proof submitted through the two procedures are required to be the same in order to ensure fairness between the patentee, which is needed to win the case through both procedures and the defendant of an infringement lawsuit, which can choose either of the two procedures.

(3) Counter defense of correction

In Japan, even if there are grounds to invalidate a patent, it is possible to exercise the patent right by alleging counter defense of correction (re-defense). In Germany, a patentee is permitted to limit the scope of patent claims until the conclusion of oral argument in order to circumvent the grounds for invalidation. In France, a patentee can circumvent the grounds for invalidation by filing a request with the EPO or the National Institute of Industrial Property (INPI) of France for claim limitation. In the U.K., not only the Patent Office but also a court has the authority to permit a correction to a patent specification. On the other hand, in the U.S., an applicant is not permitted to correct the patent claim unless the correction is to correct an obvious error in terms of formality. Since a patentee is not permitted to request a claim correction as a counter defense against a defense of patent invalidity, it is important for a patent applicant to carefully make sufficient sub-claims and obtain a patent.

In this way, the patent system differs from one country to another with regard to a counter defense of correction. In the mock trial conducted by Japanese panelists, the patentee made a counter defense of correction against the defense of patent invalidity and consequently obtained a court determination that some of the defendant's products infringed the patent right. We were able to introduce the exercise of claim correction in an infringement lawsuit.

(4) Introducing expert knowledge

In recent years, many patent lawsuits are filed over the issues related to advanced technology.

Japanese courts acquire expert knowledge by using judicial research officials and technical advisors. The system of explanatory session also greatly contributes to promoting the understanding of advanced technology. In the mock

trial conducted by Japan, we were able to show how an explanatory session is conducted. In contrast, the mock trials conducted by the U.K and the U.S. respectively are unique in that they conducted proceedings by adopting expert witnesses.

2. Second day (November 1)

On the second day, the JPO offered a program in which examiners were invited from the EPO and USPTO to hold a lecture and two panel discussions. For more detail, please refer to a separate report (Shunsuke Shikado and others, "Report on the Judicial Symposium on Intellectual Property/TOKYO 2018 (Second Day): Global Collaboration for IP Dispute Resolution" page X of this magazine).

First, Deputy Commissioner Kunihiko Shimano offered a keynote speech. Then, the JPO, the EPO, and the USPTO provided lectures titled "The Latest Situation of Trials and Appeals of Each Office" and "Introduction of Trial and Appeal System for Patent Invalidation of Each Office." After that, panel discussions were held on the topics "Case Study on Trial and Appeal Procedures for Patent Invalidation" and "Case Study Related to Whether or Not Claims Can Be Corrected/Amended in a Trial for Invalidation /IPR/ Opposition." Through these discussions, it became clear that there are differences among Japan, Europe, and the U.S. in terms of Patent Offices' procedures, etc.

At the end of the Symposium, President of the Japan Federation of Bar Associations, Yutaro Kikuchi, gave closing remarks. JSIP2018 conducted for two days finally came to an end.

Part 4 Achievement and comments

1. Purpose of the international symposium

JSIP2018 is overviewed as above.

It is extremely important to hold an international symposium by inviting legal practitioners from other countries to Japan because it will give an opportunity to share information and exchange opinions in Japan and to learn about IP systems and practices in major countries around the world. Also, an international symposium is very meaningful as a means to show the presence of Japanese courts to the international community.

In JSIP2017, the main topic was the collection of evidence. The symposium revealed the differences among the participating countries on the decisions whether to issue an order to submit documents and whether to accept a request for inspection. Those differences would occur since the legal system differs from one country to another. Having been given an opportunity to learn about such differences, we were able to reconsider the current Japanese practices concerning an order to submit a document and inspection.

In JSIP2018, we were able to accomplish great achievements to enhance the dispute settlement capability of courts by means of deepening our mutual understanding and recognition about the legal systems and judicial practices in major Western countries with regard to how to deal with a patent invalidity dispute and a counter defense of correction in an infringement lawsuit. For the attorneys, patent attorneys and business persons dealing with IP who attended the symposium, JSIP2018 must have been a good

opportunity to acquire knowledge on the legal systems of other countries, which will be useful for overseas business expansion in the increasingly globalized environment and also a great opportunity to obtain information about the litigation systems of other countries, which will be useful for resolution of international IP disputes.[5]

Moreover, the greatest achievements of all must be the close human relationships we established with IP judges and the IP lawyers of other countries.

The example case shared in mock trials was a significantly simplified version of an actual case. In JSIP2018, in order to offer a program on the first day, the members[6] of the IP High Court spent almost one year to carry out detailed planning and all the preparations despite their busy work schedules. The symposium members conducted research on the legal systems of the participating countries, created an example case, prepared translations, contacted the persons who were scheduled to be invited from abroad, and planned topics for panel discussions. Thanks to the leadership of these young judges and the cooperation from major members of the IP Lawyers Network Japan and the Japan Federation of Bar Associations, we were able to offer a very beneficial, meaningful program on the first day of the symposium. We would like to take this opportunity to express our heartfelt gratitude.

2. Future prospects

With the advancement of globalization, the JSIP2018 had a total of about 900 participants and ended in a great success. Understanding the significant achievement of this year's symposium, we plan to hold an international symposium in 2019 as well. In the next symposium, we will focus on Asian countries once again. We hope to invite judges not only from China, and South Korea, but also from India and Australia, which are attracting public attention in recent years, and plan to hold mock trials.[7]

The IP High Court will further promote international exchanges in tandem with the advancement of globalization and actively disseminate information. We will contribute to the continuous development of the Japanese IP litigation system by holding a Judicial Symposium on Intellectual Property in cooperation with the Ministry of Justice, the Japan Patent Office, the Japan Federation of Bar Associations, IP Lawyers Network Japan and other organizations.

(Notes)

1 JSIP2018 was supported by Ministry of Foreign Affairs, International Civil and Commercial Law Centre Foundation, Intellectual Property Strategy Headquarters, KEIDANREN (Japan Business Federation), International Association for the Protection of Intellectual Property of Japan, Japan Intellectual Property Association, and Japan Patent Attorneys Association

2 On November 30, 2018, "Judicial Symposium on Intellectual Property Advanced Seminar for ASEAN+3 2018" was also held.

3 In the Japanese mock trial, the author, Ayako Morioka, Judge, IP High Court and Ken Furusho, Judge, IP High Court played the roles of judges, while Shoji Kemmoku, Judicial Research Official, IP High Court played the role of a judicial research official. Yoichiro Komatsu, Attorney, played the role of the attorney representing plaintiff. Makoto Hattori, Attorney, played the role of the attorney representing defendant. Peter Meier-Beck, Presiding Judge of Germany, Denis Monégier du Sorbier, Attorney of France, Richard Hacon, Presiding Judge, of the U.K. and Richard Linn, Judge of the U.S. played the roles of judges and led the judicial proceedings. IP lawyers of the participating countries presented arguments.

[4] At the panel discussion, Yoshiyuki Mori, Presiding Judge, IP High Court served as the leading moderator, while Akira Katase, Judge, IP High Court, and Attorney Hattori served as a moderator.

[5] The results of the questionnaire survey conducted on the attendants revealed that the attendants made the following comments: "It was like attending trials in Japan, the U.S., and Europe at once. I was able to get a quick overview of the differences between the views and stances of other countries," "Since the symposium allowed me to make a comparison between different countries based on the example case, it was easy to understand," "I was interested in approaches taken by other countries in handling the example case," "The symposium was useful because I was able to see mock trials and learn about the process of making a court judgment," "The symposium gave me a precious opportunity to learn about the differences between other countries in terms of the current situation, the measures taken in each country, and the dispute settlement approach.

[6] Judge Masaki Sugiura, Judge Sumiko Sekine, Judge Ayako Morioka, Judge Aya Takahashi, Judge Ken Furusho, Judge Akira Katase, Judge Daisuke Kumagai, Judge Hiromitsu Magira, and Judicial Research Official Shoji Kemmoku

[7] From September 25 to 27 of this year, the symposium is scheduled to be held at Bar Association Building (Auditorium "Creo") in Tokyo.