AIPPI Japan

Activity Report 2012/2013

(1 April 2012 to 31 March 2013)

(A) Membership services

1. Case Study Group

This year, there were 951 participants in total in eleven sessions for studies on judicial precedents:

109th April 2012
Technical scope of product-by-process claim
Yusuke Inui (Attorney at law, Patent attorney)

110th May 2012
Revised Examination Guidelines on "Extension of duration of patent rights"
Reeko Imamura (21st Board of Appeals, JPO)

111th July 2012
US Supreme Court decision on the Prometheus case
Toshiko Takenaka (Professor, UW School of Law)

112th July 2012
A case where the court revoked a trial decision of invalidating a patent on "fluoroether compositions and methods for inhibiting their degradation in the presence of a Lewis acid" for failure to meet the enablement requirements
Akihiro Otsuka (Patent attorney, Nihon Medi-Physics Co Ltd.)

113th September 2012
A case where a degree of contribution of the patent invention was taken into account when calculating an amount of damage under Article 102(1) of the Patent Act
Kei Iida (Attorney at law, Patent attorney)

114th October 2012
"L'EAU D'ISSEY" case on 3-dimentional marks
Hiroya Aoki (Instructor, Intellectual Property Center, Osaka University)

115th November 2012
Practices at Appeals Department after law amendments in 2011
Kazuhiko Yoshimura (Chief Appeals Examiner, Appeals Dpt., JPO)

116th December 2012

A case where the court revoked a trial decision on an invention (use invention) of "superoxide anion decomposing agent" based on its substantial identicalness to a cited invention and its lack of novelty

Akira Chino (Judge, 3rd Div. IP High Court)

117th January 2013

Publicity rights – Supreme Court decision on the Pink Lady case

Masami Ashidate (Associate Professor, School of Law, Tohoku University)

118th February 2013

Who is eligible to seek injunction under Article 2(1)(iii) of the Unfair Competition Prevention Act

Shunji Matsuda (Attorney at law)

119th March 2013

Scope of examination in a suit for revocation of trial decision, and a role played by "common technical knowledge" in assessment of inventive step

Kenji Yamaguchi (Attorney at law, Patent attorney)

2. International seminars

This year, there were 801 participants in total in fourteen IP seminars:

April 2012 Circumstances surrounding IPRs in Japan and the US: Protection, enforcement, and acquisition

David Tennant, Shamita Etienne-Cummings, Jack Lever,

Yuji Ogiwara, Hiroshi Naito, David Case, Nobuo Mori

April 2012 Report on activities of AIPPI and future prospects

Yoon Bae KIM, John Bochnovic, Laurent Thibon, Kazuhiko Yoshida

May 2012 Patent litigation in Europe, esp. in Germany

Ulrich Blumenröder, Bernd Allekotte
June 2012  
Patent litigation in the world, and latest developments in the US and China

Stephen Jones, Shih Yann Loo, Robert Parker, Kenichi Nakayama

July 2012  
Updates on Chinese patents

Yong Xiang, Nie Ningle

September 2012 
Updates on patent law amendments and litigation in the US

Calvin P. Griffith, Ognian V. Shentov, David M. Maiorana

September 2012  
Important developments in European IP laws from 2011 to 2012

Colin Sawdy

October 2012  
Unified Patent Court

Klaus Grabinski, Ryoichi Mimura

October 2012  
US Patent Law Final Provisions effective 16 Sept 2012: What are they and how to deal with them

Ken Ichirou Yoshida

October 2012  
IP systems in Gulf (GCC) countries

Rob Deans, Takamasa Makita

November 2012  
Brazilian Patent and Trademark Seminar

Bruno Holfinger, Filipe Cabral, Joaquim Goulart,
3. Publications

(1) Journals (periodicals)

- Monthly "A.I.P.P.I." in Japanese (12 issues / yr)
- Bimonthly "A.I.P.P.I." in English (6 issues / yr)

(2) Foreign IP laws, etc.

Overseas Laws Relating to Industrial Property: updated 44 laws and rules

Manual for Handling of Foreign Applications: updated 20 countries and two treaties

PCT Applicant's Guide: issued supplements

(3) Japanese IP laws, etc.

Japanese Laws Relating to Industrial Property: Issued supplements to reflect revisions to the Trademark Act Implementing Regulations and the Attached Table (J/E bilingual corpus) under the Ministerial Ordinance No.86 of November 30, 2012

4. Submissions to public consultations

We submitted our opinions in the following ten occasions:
1. Comments on Draft Amendment to Chinese Patent Law
   Solicited by State Intellectual Property Office, China

2. Comments on Revisions to CFRs and Examination Guidelines in relation to AIA
   Solicited by USPTO

3. Comments on Proposed Complete Amendment to Draft Korean Design Protection Act
   Solicited by Design Examination Policy Div., KIPO

4. Comments on the draft National IPR Strategy
   Solicited by Office of the Controller General of Patents, Design and Trademarks

5. Comments on Draft Ordinance on Employee Invention
   Solicited by State Intellectual Property Office, China

6. Comments on "Proposed Revisions to Trademark System" reported by the Trademark System Subcommittee, the Industrial Structure Council
   Solicited by Legislative Affairs Office, JPO
5. Software Patent Study Group

Part of its study results was published in our journal "A.I.P.P.I.":

(1) Assessment of a patent infringing act and an amount of damage in China
Infringement of a patent on air-conditioner control methods (issue November 2012)

(2) En banc decision on the Akamai case (Akamai and McKesson cases):
Whether a party may be liable for infringement under, where two or more entities join together to perform the steps of a process claim (issue January 2013)

6. AIPPI Nakamatsu Memorial Scholarship

In the 17th year, there were 15 applicants from nine universities. We selected and awarded a scholarship to the following two students:

(1) Ms. Pham Hǎi An

Nagoya University, School of Law
Subject: "Legal Issues concerning Protection of Famous and Well-known Marks"

(2) Mr. Gu Xin (China)

Hokkaido University, Graduate School of Law
Subject: "Usurped Applications for Foreign Trademarks in China - Change in basis for decision from "use in China" to "degree of fame in China"

(B) International activities

1. AIPPI Congress / ExCo

(1) World Congress in Seoul (20 to 24 October 2012)

By publicly recruiting members, we set up four Working Committees to work on their respective questions and submitted Group reports in July. The Congress meetings in October were attended by 157 people from Japan, who made a contribution to the drafting of Resolutions.

Q229: The use of prosecution history in post-grant patent proceedings

(Supervised by Yuzuru OKABE, Chaired by Katsuomi ISOGAI
Members: Kazuo UBUKATA, Hiroshi UEYAMA, Kei KONISHI, Sumiko KOBAYASHI, Tsuyoshi SUEYOSHI, Hiroshi SORIMACHI, Hideki TAKAISHI, Hiromi TANAKA, Satoru DENO, Kiyoko NAKAOKA, Nobutaka YOKOTA)
Q230: Infringement of trademarks by goods in transit

(Supervised by Shoichi OKUYAMA, Chaired by Noboru TANIGUCHI
Members: Satoru ARAI, Naho EBATA, Tomoyuki KANAI, Haruo GOTO, Mariko NAKAYAMA)

Q231: The interplay between design and copyright protection for industrial products

(Supervised by Eiji KATAYAMA, Chaired by Hiromichi AOKI,
Members: Toshihiko AIKAWA, Yusuke INUI, Sayuri IMAKO, Riichi USHIKI, Nobuyuki UCHIYAMA, Hiroyuki OHNO, Nobuyuki KASHIWA, Takeshi KATADA, Yuriko SAGARA, Dai SEKI, Kozo TAKEUCHI, Minako MIZUNO, Manabu MIYAJIMA)

Q232: The relevance of traditional knowledge to intellectual property law

(Supervised by Yoshio KUMAKURA, Chaired by Hirohito KATSUNUMA
Members: Hiroshi AKIMOTO, Makoto ASANO, Shimako KATO, Takeshi SEKINE, Yukihiro HOTTA)

(2) Forum & ExCo in Helsinki (5 to 11 September 2013)

We set up four Working Committees to work on their respective questions:

Q233: Grace period for patents

(Supervised by Hirohito KATSUNUMA, Chaired by Katsuomi ISOGAI
Members: Makoto ASANO, Takahiro KOSHIBU, Kei KONISHI, Sumiko KOBAYASHI, Tomoko SAIKI, Takeshi SEKINE, Hiroshi SORIMACHI, Tomoya DEGUCHI, Satoru DENO, Yorikatsu HOHOKABE)

Q234: Relevant public for determining the degree of recognition of famous marks, well-known marks and marks with reputation

(Supervised by Shoichi OKUYAMA, Chaired by Masako NISHIMURA
Members: Yusuke INUI, Akitaka UKAJI, Naho EBATA, Kazutaka OTSUWA, Chihiro ONISHI, Hiroyuki OHNO, Noboru TANIGUCHI, Reiko HASE, Akira WATANABE)

Q235: Term of copyright protection
(Supervised by Yuzuru OKABE, Chaired by Eiichiro KUBOTA
Members: Kei IIDA, Riichi USHIKI, Nobuyuki KASHIWA, Daisuke KIMOTO, Yoshio KUMAKURA, Kei KONISHI, Tsuyoshi SUEYOSHI)

Q236: Relief in IP proceedings other than injunctions or damages
(Supervised by Koichi TSUJII, Chaired by Manabu MIYAJIMA
Members: Kazuo UBUKATA, Ryoko OSHIKAMO, Yoshifumi ONODERA, Tsuyoshi KAGAYA, Hiroshi KAMIGAMA, Tsutomu SHIMOHAGIHARA, Yasuhiko TAKADA, Ruoling DU, Ryouichi HARADA, Nobushige FURUHASHI, Yukihiro HOTTA)

2. Japan-China-Korea trilateral exchange on intellectual property

The 10th Trilateral Meeting among the Japanese, the Chinese, and the Korean Groups of AIPPI took place at Hotel Grand Terrace Chitose in Hokkaido, the northernmost part of Japan, from 13 (Friday) to 15 (Sunday) July 2012.

At the outset of the main event "Japan-China-Korea Trilateral Meeting on Intellectual Property" on Saturday 14, Mr. Kiyoshi Asamura, Chair of the Organizing Committee, gave an opening address, which was followed by greetings by Mr. Hao Ma, Vice President of the Chine Group, Mr. Seong-Ki Kim, President of the Korean Group, and Mr. Eiji Katayama, President of the Japanese Group. AIPPI seems to pay special attention to this trilateral meeting. This time, we had the pleasure to receive, as guests, AIPPI President Mr. Yoon Bae KIM and his family, Mr. Seong Ki KIM (President of the Korean Group) and his wife, and Mr. John Bochnovic (Vice President of AIPPI). We realized anew that the three countries play a role of global importance not only in economy but also in the fields of intellectual property.

3. Meetings with AIPLA
(1) AIPLA/AIPPI Joint Meeting (in Tokyo)
Held on Wednesday 18 April 2012, at the JPAA’s head office. From the Japanese Group, 25 members attended. Two of the topics were discussed by Japanese speakers:

- IP High Court Decision on construction of product-by-process claims
  by Yusuke Inui

- IP High Court decisions on damages
  by Chihiro Onishi

(2) Mid-Winter Pre-Meeting (in the US)
Held on 29 and 30 January 2013, at Tampa Marriott Waterside Hotel in Florida. From the Japanese Group, six members attended. The following topics were discussed by Japanese speakers:

- Employee Invention Cases (Tokyo District Court’s decision on April 27, 2012 and other cases)
  by Kei Iida

- Exportation of Knock-Down Kits: Indirect or Direct Infringement
  by Yusuke Inui

- Cases between Apple and Samsung (Tokyo District Court’s decision on August 31, 2012 and other cases)
  by Shoichi Okuyama

- Indirect Infringement of Patent for Combination of Drugs (Osaka District Court’s decision on September 27, 2012)
  by Kaoru Kuroda

- Patent Troll Cases (Tokyo District Court’s decision on November 30, 2012 and other cases)
  by Kei Konishi

(C) Research activities in the fields of intellectual property

1. Comparative Studies on Foreign Industrial Property Systems

(1) Research on systems and practices related to visually unperceivable non-traditional marks

(2) Research on representation of designs in other countries

(3) Research on design registration systems and actual status of their use in ASEAN countries

(4) Research on negotiation strategies for FTA/EPA in IP fields: Canada, New Zealand, Colombia, and Turkey
(5) Research on protection of intellectual property and genetic resources

(6) Research on court/trial decisions concerning validity of patent and utility model rights in China, Korea, and Taiwan

2. Data Collection/Updating on Foreign Industrial Property Systems

3. Preparation of Basic Data on Intellectual Property Systems and Practices in Other Countries

4. Research Related to Applications Also Filed with Foreign Offices: Evidence for Opposition etc. in Other Countries

(D) Management of the association

1. Board of Directors meetings (three times)

2. General Assembly meeting (once)

3. Senior Directors’ meetings (11 times)

4. Composition of officers

   46 Directors (including a President, two Vice Presidents, an Executive Director, a Managing Director, and eight Senior Directors), two Auditors, and four Advisors