Securing IP Talent Which Contributes to Corporate Management — Can we fill the gap in IP talent? —

The Second Subcommittee
The First Intellectual Property Management Committee

Today, Japan is in danger. Our industrial competitiveness is declining. Poor in natural resources, we have no way of survival but to rely on intellectual property, and we must urgently review and reform our intellectual property strategies. There is a pressing need to change the conventional type of intellectual property department, which is in charge of carrying out the procedures to file patent applications and obtain patent rights and dealing with patent disputes and licensing contracts, into a new type of intellectual property department that will play a role in corporate management. This revolution can be achieved only by people, and therefore it is an urgent task to develop and acquire IP talent, a new type of human resource specializing in intellectual property. In the main text, we advocated the use of "IP strategists" and "IP experts" as personnel who can fill the gap between the desired situation and the actual situation regarding IP talent. "IP strategists" are persons who can propose IP strategies to the top management from a management perspective, and "IP experts" are persons who can support IP strategists with their advanced technical skills and experience in handling intellectual property. We studied the roles and capabilities required for "IP strategists" and "IP experts" respectively, and presented measures and models to develop and acquire such IP talent. Since human resource development is a national undertaking, it is absolutely necessary to establish infrastructure to develop and acquire highly-capable IP talent. From this viewpoint, we also discussed necessary measures to be taken for IP talent development by the government, companies, and universities respectively, and recommended that an industry-academia-government IP talent cycle should be created in order to ensure effective use of IP talent.

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Effective Factors for Interpreting U.S. Patent Claims — Initial review of attack by U.S. patentee —

The First International Affairs Committee

Japanese companies frequently receive patent infringement notices from US patentees. For the party receiving the notice, the finding of possible grounds for interpreting the scope of patent claims more narrowly than that argued by the patentee (narrow interpretation of claims) is an important way to acquire the upper hand in subsequent negotiations.

From this point of view, we studied the possibility of arguing for the narrow interpretation of claims, assuming the initial stage when the party receiving the notice responds to it. In the main text, we reviewed the basic rules regarding how intrinsic evidence (the patent claims, specification, and prosecution history) and extrinsic evidence affect narrow interpretation of claims, and analyzed recent

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CAFC decisions in this respect. Furthermore, based on the analysis results, we discussed practical points worth noting when companies independently consider whether narrow interpretation is possible.

The analysis we conducted in the main text from the viewpoint of the party receiving the notice is also useful as information that provides "points worth noting in order to obtain strong patents."

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Study of Recent Patent Infringement Decisions in China

The Third International Affairs Committee

China, where the number of civil actions on intellectual property infringement has been increasing along with economic development and advancement of science and technology, is currently endeavoring to strengthen intellectual property protection by acceding to the World Trade Organization (WTO) and putting the necessary legal framework in practice by way of the second revision to the Patent Law which preceded the accession.

Under the Chinese justice system, the Supreme People's Court issues "judicial interpretations," which binds on the decisions of lower courts. As a "judicial interpretation" on patent infringement, "Several Provisions by the Supreme People's Court on Issues Relating to Application of Law to Adjudication of Cases of Patent Disputes" (No. 21; 2001) came into force in July 2001, and has significantly influenced court decisions rendered thereafter.

Also in China, databases on court decisions have been created following the development of the justice system, and several people's courts publicize their decisions on their websites.

In the main text, with the objective to understand the decisions Chinese courts made in patent infringement cases, we examined the decisions rendered by the Beijing Court and the Shanghai Court on infringement of patent rights and utility model rights in January 2003 and thereafter, which have been posted on the Internet. In particular, we selected six court decisions relating to factors that may be important for the comparison with Japanese court decisions, such as claim interpretation (including the doctrine of equivalents), indirect infringement, and working in good faith, and presented points worth noting for infringement cases in China.

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Study of Cases Involving Abuse of Trademark Rights

Trademark Committee

Since the Supreme Court rendered its judgment on the Kilby patent (judgment of the Third Petty Bench of the Supreme Court of April 11, 2000), trademark infringement cases have also been judged

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