

A HISTORIC EVENT



A historic IP event occurred on October 25 to 27, 2011 at the Hotel Okura in Tokyo, Japan, when the United States Court of Appeals for the Federal Circuit and the Japan Intellectual Property High Court sat together en banc at the Joint Judicial Conference on Japan and United States Intellectual Property Rights.

The United States Court of Appeals for the Federal Circuit has exclusive jurisdiction in the United States over intellectual property cases which make up approximately 31% of the court's caseload. The Japan Intellectual Property High Court has exclusive appellate jurisdiction over intellectual property cases in Japan.

On behalf of the Judges of the Japan Intellectual Property Court and the United States Court of Appeals for the Federal Circuit Chief Judge Randall R. Rader extended a warm welcome to all and noted the importance and significance of the joint meeting of the two courts.



The historic en banc panel consisted of Chief Judge Randall R. Rader, and Circuit Judges Arthur J. Gajarsa, Richard Linn, Timothy B. Dyk, Sharon Prost, and Kimberly Moore from the Federal Circuit, and Chief Judge Tetsuhiro Nakano and Presiding Judges Toshiaki Iimura, Shuhei Shiotsuki, Takaomi Takizawa, Tamotsu Shoji, and Yasuhito Inoue from the Japanese Intellectual Property High Court.

This first-ever meeting of the two courts sitting en banc at the Joint Judicial Conference was witnessed by more than 800 judges, government lawyers, corporate counsels, practitioners, and academicians from the United States, Japan, Germany, China, and numerous other nations throughout the world.



The en banc meeting of judges from the two courts was one of a number of sessions held over three days led by American and Japanese moderators and speakers who discussed intellectual property issues of mutual interests with panelists and those in the audience.

The Conference is noteworthy because it is the first time that national courts from two nations have sat in an en banc session, and answered questions from a moderator and the audience on a wide range of intellectual property issues.

The joint session also is significant because it is the first time the judges from the Japan Intellectual High Property Court have met in a conference setting with members of the local Japanese bar associations or with Japanese lawyers who practice before the Court.

The goal of the Joint Judicial Conference on Japan and United States Intellectual Property Rights was to discuss common problems in deciding intellectual property issues and to explore ways of resolving differences in interpreting similar provisions of intellectual property law.



INNOVATION AND COMMERCE

On the first day of the three-day conference, judges, academics, lawyers, and general counsel from over 125 of the largest corporations in Japan met to discuss issues dealing with the session's theme of "Innovation and Commerce — Global Legal Considerations." The focus of the panels on the first day of the conference addressed recent developments in patent law, best practices in advocacy and court management, and best practices in protecting corporate patents and managing Intellectual Property.



Specific subjects covered during the first day session included:

- Innovation, the Law, Commerce, and Best Practices: The Corporate Perspective
- Recent Developments in the United States
- Best Practices in Administration: The Courts and the Agencies
- The Role of the Bar and Best Practices
- Best Practices in Advocacy
- Best Practices in Managing an Intellectual Property Portfolio

The focus of the sessions on best practices was to identify the most effective “mechanisms and techniques in place in both Japan and the United States for the resolution of intellectual property disputes,” said Nick Cannella of Fitzpatrick, Cella, Harper & Scinto in New York, New York.

Cannella noted that “[t]o ensure that each system serves the admirable goals of stimulating innovation and promoting commerce, certain primary considerations” need to be addressed. “No matter the jurisdictional system,” he added, “the ultimate goals of correctness and predictability of outcome, timeliness, and efficiency must always be paramount.”

The unifying idea throughout the panel discussions was the importance of innovation and invention, the rapidly increasing growth in the global economy, and the role of innovation in creating jobs.

The uniform challenge confronted by economically advanced nations is how laws governing intellectual property can be used to encourage innovation and development as opposed to discouraging creativity and hindering growth.

The presentations and discussions, and questions from the audience, dealt with how the courts, corporate counsel, practitioners, academics, and the bar associations are responding to the exponential growth in creativity and innovation, the burgeoning growth of the

international economy, and the need for uniformity in the decision of intellectual property issues among nations.

Commenting on the first day's program, Patrick Coyne, a partner at Finnegan, Henderson, Farabow, Garrett & Dunner in Washington, D.C., noted that it "offered something for everyone, from U.S. practitioners to our Japanese colleagues." Coyne stated that "speakers . . . from some of the largest multinational corporations, shared their greatest . . . challenges in managing intellectual property in a global environment." In addition, "judges . . . candidly addressed some of the most vexing current issues" they have to deal with in trying intellectual property cases, namely "eDiscovery; forum shopping; and damages."

Etsuo Doi, of Foley and Lardner in Tokyo, added that the panel speakers were "senior legal professionals from a broad spectrum of leading companies of different industries." Doi noted that they discussed "differences in innovation needs, intellectual property management, and the implications of government approaches on innovation." The litigation speakers, he observed, discussed "costs management issues and alternative billing approaches [like] fixed fee or contingent fees for patent litigation. Such issues," Doi noted, "have seldom been discussed publicly in Japan." These "discussions", he said, "turned out to be of significant value to the audience."



Meredith Addy, a partner at Steptoe & Johnson in Chicago, Illinois, noted that Chief Judge Rader and Judge Linn, two Federal Circuit judges, provided valuable insights on the impact the Patent Pilot Program, Model e-Discovery Order, and America Invents Act are having on Intellectual Property practice in the United States.

SUBSTANTIVE ISSUES

The highlight of the second day of the three-day conference was the en banc session consisting of six judges from the United States Court of Appeals for the Federal Circuit and six judges from the Japan Intellectual Property High Court. The two-hour session consisted of a series questions asked of the twelve-judge en banc panel by two moderators: Teresa Summers of Morrison & Forester, LLP, and Eiji Katayama of Abe, Ikubo, & Katayama.



The questions posed to the judges of the two courts (Summers asking questions of the Federal Circuit and Katayama asking questions of the Intellectual Property High Court) highlighted similarities and differences on how the courts address common issues, problems, and matters.



Summers posed questions in English to the Federal Circuit Judges and Katayama posed questions in Japanese to the Intellectual Property High Court. Real-time translation through the use of ear phones by judges and attendees ensured uniform communication and comprehension.

“This first joint conference between the courts,” noted Coyne, “was stunning.” He observed that the “opening 2-hour panel of six Federal Circuit judges and five Tokyo High Court judges exhibited a level of candor likely unheard among the Japanese judiciary and rarely seen outside the Federal Circuit in the US, with each of the judges answering questions on a wide range of topics.”



The afternoon breakout sessions of the second day addressed specific intellectual property subjects. The topics discussed by United States and Japanese judges and practitioners during the afternoon breakout sessions included the following:

- International Exhaustion
- Joint Infringement and Indirect Infringement
- Damages and Injunctions
- Obviousness
- The Doctrine of Equivalents
- Protection of Trade Secrets



Oral questions from the audience to the panelists also were answered.

VIEWS FROM THE JAPAN AND AMERICAN PATENT OFFICES



The highlight of the morning of the third day of the Joint Conference was views from the leaders of the American and Japan Patent Offices. David J. Kappos, Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office, spoke on the challenges facing the American Patent Office by provisions included in the recently enacted American Invents Act and the need to act on the over 25,000 case backlog in United States patent applications.

Yoshiyukei Iwai, Commissioner of the Japan Patent Office spoke on the important role of intellectual property law in encouraging innovation and creativity and its critical role in growing the economy of their respective nations.



Both leaders commented on trends toward harmonization of intellectual property law between their respective nations, and the need for continued cooperation on issues of mutual interest.

At the conclusion of their remarks Kappos and Iwai answered questions from lawyers in the audience.

MOCK ORAL ARGUMENTS BEFORE JAPANESE AND AMERICAN JUDGES

On the afternoon of the third day of the Conference a Japan Mock Appellate Oral Argument was presented to the Japan Intellectual Property High Court by four appellate counsel. The argument was followed by a United States Mock Oral Argument presented to the United States Court of Appeals for the Federal Circuit on the same issues argued before the Japan Intellectual Property High Court.

The issue before the courts was whether rebuilding a sealed single-use camera is nothing more than simply repairing the camera or is it really the reconstruction of a patented product. The issues of damages and burden of proof also were argued.



Counsel presenting arguments to the Japan Intellectual Property High Court were Yoshio Kumakura of Nakura and Partners, Harumi Kojo of Bingham McCutchen Murase, Sakai Minura Aizawa Foreign Law Joint Enterprise, Ryoichi Minura of Nagashima Ohno & Tsunematsu, and Seiji Ohno of Ohno & Partners.

Counsel presenting arguments to the United States Court of Appeals for the Federal Circuit were Rachel Krevans of Morrison & Forester, Donald R. Dunner of Finnegan, Henderson Farabow, Garrett & Dunner, John M. Whealan, Associate Dean for Intellectual Property Law Studies at George Washington University Law School, and Raymond T. Chen, Deputy General Counsel at the United States Patent and Trademark Office.

These seasoned advocates from the Japanese bar and the American bar presented persuasive arguments on the same issues to judges from their respective courts. The contrast in the interaction between judges and counsel of the respective courts during oral arguments was striking. While the Japanese judges asked counsel a few questions at the conclusion of their prepared arguments, the American panel posed hypotheticals and asked counsel questions and follow-up questions continuously throughout their arguments. In the end the Japanese panel and the American panel reached the same decision on the issues argued.



After arguments were presented, Chief Judge Rader asked the 800 judges and lawyers in the attendance which oral argument format they preferred. The result: a split decision. Chief Judge Rader then invited questions from the audience. The questions asked by members of the audience to the judges and the advocates proved as insightful and interesting as the oral argument presentations.

CONCLUDING THOUGHTS

At the conclusion of the Thursday program, Chief Judge Rader asked the Judges from the Intellectual High Court and from the Federal Circuit for concluding thoughts on the Conference and the topics discussed.



Chief Judge Rader concluded by informing the crowded room of 800 lawyers, judges, and general counsels of the importance of the meeting of the two courts, and of the importance and the need for all to work together to develop an international intellectual property law.

Chief Judge Rader observed that intellectual property law is in the early stages of development in many nations. He noted too that while international commerce now is global in nature and growing exponentially, intellectual property law is balkanized and developing slowly among the many nations in the world.

Chief Judge Rader emphasized the Federal Circuit’s responsibility to take the lead in assisting courts throughout the world in helping to develop a body of uniform and modern intellectual property law. With 30 years of experience in developing intellectual property law in the United States, Chief Judge Rader noted that the Federal Circuit is uniquely positioned to lead, teach, and assist other courts and judges in the development of their intellectual property law. It can do so by means of identifying best practices, communicating recent developments in intellectual property law through the court’s opinions, and by convening international conferences on Intellectual Property such as this one.



At the conclusion a well-attended reception was held in Ascot Hall at the Hotel Okura.



Closing remarks at the reception thanked all who attended and participated in the Joint Conference.

In assessing the value of the three days of meetings, Dr. Anna C. Wolters, Senior European Consultant for Bird & Bird LLP of Dusseldorf, Germany, observed that the “Conference in Tokyo was another important step of the International Series in terms of a search for best practices in Intellectual Property.” The Joint Conference, she stated, “surely will contribute to

a global understanding of the different judicial and cultural systems, to harmonizing laws, and to generating creative thought. The mix of participating judicial, administrative and corporate representatives as well as practitioners added great value to this important international forum on Intellectual Property.”

Ed Haug of Frommer Lawrence & Haug in New York, New York noted that this “historic joint judicial conference in Tokyo brought together leaders of the courts and respective bars of Japan and the Federal Circuit. The open dialogue and interaction among the judiciary and the bars will undoubtedly enhance the quality and effectiveness of our legal systems and economies.”

Donald R. Dunner of Finnegan, Henderson, Farabow, Garrett & Dunner in Washington, D.C. added that the “Conference was a magnificent centerpiece of Chief Judge Rader’s continuing efforts to catalyze interchanges between judicial and administrative leaders in the international intellectual property community. Exposing these leaders to the intellectual property laws and best practices of their foreign counterparts cannot help but improve their respective systems and enhance future cooperation between them.”

The Joint Conference was well-attended to the end. It highlighted the strengths and similarities, and the weaknesses and differences between judicial systems which strive to achieve the dual ends of justice and the peaceful resolution of intellectual property disputes.



In a release entitled “CONFERENCE REPORT: US AND JAPANESE PUSH FOR HARMONIZATION,” distributed by Peter Ollier of Hong Kong, David Makman of the Law Offices of David A. Makman in San Francisco summed up the significance of the three-day meeting as follows: “A feeling of cooperation, sharing and excitement permeated the entire conference and made it a very special event.”
