

2016 JAUIP Summer IP Seminar Practitioner Course

Date : August 29 through August 31, 2016
Place: *Porta* Kagurazaka 5F (Tokyo, Japan)

Organized by the IP Graduate School Union (JAUIP)

Greetings



➤ Dear Friends,

➤ In 2012, the Japan Association of Universities for Intellectual Property Education and Research (JAUIP), a nonprofit educational organization, started the summer English seminar for intellectual property studies in Japan. This seminar was intended for attendees in and out of Japan who had interest in learning intellectual property and its management in English.

➤ In 2015, the JAUIP opened, in addition to the students' course, an intensive program of 3 days for patent practitioners in Asia. We continue to open the practitioner course for the period from Monday August 29 through Wednesday, August 31, 2016. Distinguished lecturers, academic and practicing attorneys, will cover their professional fields of IP practice from procedural aspects to obtain patents to post-grant enforcement and negotiations for licensing.

➤ The practitioner course is featured with many classes of group work. In each group work, members are supposed to collaborate each other to work on the assignment and prepare a written product within a limited time. The session will surely provide you with opportunities to enhance your professional skill while broadening your human network in the IP arena.

➤ We welcome your participation to the seminar.

□ Sincerely yours,

□

□ Jinzo Fujino

□ Program Director

Practitioner Course

- **Period:** Monday, August 29 - Wednesday, August 31, 2016
- **Place:** P51 Class Room at the PORTA KAGURAZAKA 5 F, (Kagurazaka, Tokyo)
- **Registration fees:** 70,000yen
- **Seat Capacity:** 40
- **Language:** English
- **Necessary Devices:**
 - ▣ Each attendee is required to join the program with a PC. Having a PC, desirably with a power point software, is inevitable for the group work. Your PC can be connected to the Wi-Fi network in the seminar place.
- **Remarks:**
 - ▣ Attendees are required to attend the entire course. The certificate of completion will be issued to each attendee after the completion of the program.
 - ▣ Materials to be used in this course shall be downloadable from the JAUIP web site.
- If you have any question, feel free to contact: summer-seminar@jauip.org
- **Program director:**
 - ▣ Mr. Jinzo FUJINO, Chair of JAUIP
 - ▣ Former professor of Tokyo University of Science, School of Intellectual Property Studies

How to Apply

- Those who want to participate are suggested to send the application form with required entries and their own resume (within 1 page). The application form is downloadable from the JAUIP web site. (<http://www.jauip.org/>)
- The application form together with your resume can be sent via e-mail to the JAUIP secretariat at: summer-seminar@jauip.org
- Upon receipt of application, the JAUIP secretariat will send each applicant a sheet of instructions for the payment of the registration fee, seventy thousand (70,000) Japanese yen.
- Payment is due only by bank transfer. Please be aware of that unqualified applicants may not be approved to attend.
- Upon payment of the registration fee, the applicant will receive an acknowledgment of payment and a pass for registration. The attendee is supposed to keep the pass during the seminar period.

Program at-a-glance

(8/29/2016 - 8/31/2016)

	Monday, August 29	Tuesday, August 30	Wednesday, August 31
Morning	Registration & Orientation (9:30 - 10:00)	Registration (9:30 - 10:00)	Registration (9:30 - 10:00)
	Lecture (1) : Landscape of IP Framework Worldwide – Present & Future (10:00 – 12:00) Ms. Tomoko Miyamoto	Lecture (2): Patent Prosecution in Japan, the US and EU (10:00 - 12:00) Mr. Nobutaka Ichikawa Mr. Kevin Kunzendorf	Lecture (3): Enforcing Intellectual Property Rights under the TRIPs Regime: Legal and Strategic Perspectives (10:00 - 12:00) Prof. Spiritas Cho
Lunch Break	12:00 - 13:30	12:00 - 13:30	12:00 - 13:30
Afternoon	Group Work (1): Patent Information Retrieval (13:30 - 15:30) Mr. Atsushi Nozaki	Group Work (3): Drafting Patent Claims (Part 1) (13:30 - 15:30) Dr. Shoichi Okuyama Ms. Kaoru Kuroda Mr. Tasuku Tanaka	Group Work (5): Fundamentals of Dispute Resolution in Japan and the United States (13:30 - 15:30) Mr. Shinichi Murata Mr. Naoki Yoshida
	Group Work (2): Cross Boarder Licensing (16:00 - 18:00) Mr. Toshifumi Futamata Mr. Nobuaki Kimura	Group Work (4): Drafting patent Claims (Part 2) (16:00 - 18:00) Dr. Shoichi Okuyama Ms. Kaoru Kuroda Mr. Tasuku Tanaka	Mock Patent Negotiation: License Negotiations for SEPs (13:30 - 15:30) Prof. Makoto Ogino Mr. Katsumi Harashima Dr. Yutaka Hara Mr. Toru Kobayashi
	Welcome Reception (18:30 - 20:00)	—	Closing

Course Outline - Lectures

➤ Day 1

➤ “Landscape of Intellectual Property Framework Worldwide - Present & Future” (10:00-12:00)

➤ by Ms. Tomoko Miyamoto

- The globalization of R&D, manufacturing and commercialization has inevitably brought attention to the international aspects of patent systems. This lecture will provide an overview of the recent international discussions and developments in the field of patents, including selected activities at the World Intellectual Property Organization (WIPO). Multilateral normative work operates in the complex web of national, bilateral, plurilateral, regional and international frameworks, both within IP and beyond. The lecture will address the political, legal and practical dimensions of the multilateral normative work, which provide a framework for a wide range of future international patent cooperation agenda.

- Day 2

- “Fundamentals of Patent Prosecution in Japan, the US and EU” (10:00-12:00)

- by Mr. Nobutaka Ichikawa

- Mr. Kevin Kunzendorf

- This lecture will examine the two routes - Patent Cooperation Treaty (PCT) and Paris Convention - available to applicants for filing patent applications in foreign jurisdictions, and their requirements. The lecture will then look at patent prosecution as a negotiation process between the applicant and the patent examiner, and examine how this negotiation process affects the interaction between the applicant and the examiner and creates and influences many judgment calls that must be made by the applicant during prosecution. The lecture will conclude by examining some typical issues raised by patent examiners during prosecution of patent applications.

Course Outline - Lecture

➤ Day 3

➤ **“Enforcing Intellectual Property Rights under the TRIPs Regime: Legal and Strategic Perspectives”**

➤ **(10:00-12:00)**

➤ **By Prof. Spiritas Cho**

➤ This lecture will provide an overview of the disputes arising under the WTO TRIPs regime that have been brought before the WTO Dispute Settlement Body (DSB). In addition, the practitioners will be able to gain some strategic insights as to how they could utilize the WTO TRIPs Agreement to further their client's business objectives. The first part of the lecture will provide a brief summary of the WTO TRIPs-related disputes brought under the DSU mechanism including a more detailed analysis of the most significant intellectual property-related disputes that have been subject of substantive adjudication by the DSB.

➤ This doctrinal review will precede a more practical and strategic discussion of how companies may be able to use the TRIPs Agreement in order to level the playing field in terms of commercial competition or to ensure that their rights are properly protected in the various markets in which they conduct business.

Course Outline

-Group Work-

➤ "Group Work (1):

"Patent Information Retrieval"

(13:30-15:30)

➤ by Atsushi NOZAKI

- In this class, fundamentals of patent information retrieval will be explained by the lecturer first. Then, attendees will be divided into several small groups to engage in group work assignments. Using its own PC, each member of the group will be required to make necessary searches through the EPO's data base "Espacenet" on the internet. Each attendee is required to take with its own PC. PC is inevitable in this class.

➤ Group Work (2)

- Cross boarder licensing negotiation
- Roll play training of IP negotiations
(13:30-15:00)

➤ by Mr. Toshifumi Futamata Mr. Nobuaki Kimura

- IP negotiation is a crucial tool to sustain competition and further shape future of each corporation. Based on the globally advanced negotiation theory, participants will experience unforgettable experience of IP negotiations through real case material.

Course Outline

-Group Work-

DAY 2

➤ “Drafting Patent Claims (Part 1)”

(13:30-15:30)

➤ “Drafting Patent Claims (Part 2)”

(16:00-18:00)

➤ by Dr. Shoichi Okuyama, Ms. Kei Konishi and Ms. Kaoru Kuroda

- The scope of patent protection is determined by the patent claims. The drafting of patent claims is an art that requires at least three to five years to acquire.
- This is similar to draftsmanship for painters. Whatever one does as a painter, even for constructivist or abstract painters, the basics are firmly planted in conventional draftsmanship.

- Whether one aspires to be a patent litigator or administrator, a licensing specialist, or a prosecution specialist, skills relating to claim drafting are essential.
- An additional hurdle is that unusual grammar, conventions, and terminology are used in patents, particularly in patent claims.
- We will investigate the very strange and surprising world of patent language and the drafting of patent claims by working in groups and doing practical exercises.
- Group work activities including presentation of the work product.

Course Outline

-Group Work-

➤ DAY3

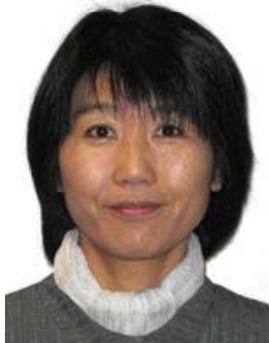
- **“Fundamentals of Patent Dispute Resolution in Japan and the United States” (10:00-12:00)**
- **by Mr. Shinichi Murata, and Mr. Naoki Yoshida**
- Japan and the United States have relatively well-developed patent dispute resolution systems in the world. Patent litigation in Japan, however, has several unique characteristics, some of which are considerably different from those of U.S. patent litigation. This lecture will address significant patent litigation procedures in Japan and the United States, showing some distinctive features of litigation proceedings in each country and presenting comparative views. Also, participants will be required to develop litigation strategies for Japan and United States through a group workshop during the lecture.

➤ DAY 3

- **“Mock Patent Licensing Negotiation” License Negotiations for SEPs (16:00-18:00)**
- **by Prof. Makoto Ogino, Mr. Katsumi Harashima, Dr. Yutaka Hara, and Mr. Toru Kobayashi**
- Experienced negotiators sit for mock patent license negotiations. Potential Licensee attempts to challenge a standard-essential patent arguing that a proposed royalty is too high in view of the FRAND declaration. The patent owner counter-argues that the matter would go to the court if the negotiations fails. Contemporary issues around FRAND declaration will be highlighted through the negotiations. The mock will also demonstrate negotiation tactics and strategy to be commonly taken by the parties. The mock negotiations will provide the audience with an awareness of the FRAND issues as well as an atmosphere of actual licensing negotiations.

Lecturers

- Day 1 -



Ms. Tomoko Miyamoto

Head of the Patent Law Section, Patent Law Division, World Intellectual Property Organization (WIPO). She joined WIPO in 1997, and has worked on various issues with respect to patent policy, law and practices, including development of the international patent system, promotion of WIPO treaties and capacity building trainings. Prior to joining WIPO, she worked for the Japan Patent Office. She holds a Master degree in electronic engineering and an LL.M (IP law and management).



Mr. Atsushi Nozaki

Graduated from School of Science and Technology, Keio University and K.I.T. Toranomon Graduate School of Innovation Management. After working at NGB Corp., Tokyo, Japan, he joined Landon IP GK as Senior Director for establishing Japan office where he is active as a research & consulting and a media specialist for delivering e-newsletters and running website. He wrote two books on both patent searches and patent analytics, and published many articles.



Mr. Hirofumi Futamata

Research Associate, Policy Alternatives Research Institute, the University of Tokyo. After Panasonic, he was appointed to CEO of Sisvel Japan. Since 2012 he has been a tutor of various IP training programs of the University of Tokyo and JPO. Visiting researcher of Mitsubishi Research Institute. IAM 300 IP Strategists, in 2015.



Mr. Nobuaki Kimura

Patent Attorney, INFORT Patent Firm After working as an engineer in Japanese manufacturing companies, he handled patent licensing in Japanese and foreign companies. Appointed to current position in 2012. He provides service and advice for acquiring IPRs, preparation and representation of license negotiation, formulation of IP strategy, evaluation of IP rights, and royalty audit.

Lecturers

- Day 2 -



Mr. Hidehiko Ichikawa

Patent attorney, Anderson Mori & Tomotsune. His practice focuses on patent prosecution and litigation cases in the electrical, electronic and mechanical fields, including telecommunications and computer software. He previously worked for Vodafone K.K.



Mr. Kevin Kunzendorf

Partner, Sughrue Mion, PLLC (Washington DC). With over 10 years experience preparing and prosecuting patent applications for non-US clients, Kevin has provided patentability and non-infringement opinions and counseling clients on early stage US litigation matters. Kevin has worked as a Senior RF Engineer for Motorola Inc., where he designed and tested radio receivers for products for the Japanese market.

Lecturers

- Day 2 -



Dr. Shoichi Okuyama

Japanese Patent Attorney, Principal of Okuyama & Sasajima, Vice-President of AIPPI Japan, Former President of the Japan Patent Attorneys Association, Expert member of the Intellectual Property Strategy Headquarters organized by the Prime Minister of Japan, Tutor of the EURO-SEAD Patent Drafting Course organized by FICPI



Ms. Kaoru Kuroda

Attorney (Japan and New York), Patent Attorney at Abe, Ikubo & Katayama law Office, Visiting Attorney at Kirkland & Ellis LLP (Mar.-Sep. 2012), Judicial Intern for the former-Chief Judge Rader at the U.S. Court of Appeals for the Federal Circuit (Aug. 2011 - Jan. 2012).



Mr. Tasuku Tanaka

Japanese Patent Attorney, Okuyama & Sasajima. Tasuku is in charge of domestic and foreign patent prosecutions in electrical engineering, telecommunications, and computer software. He previously worked for Hewlett-Packard Japan, Ltd., where he gained experience developing information systems for a major mobile phone provider in Japan.

Lecturers

- Day 3 -



Prof. Spritas Cho

Teaches Intellectual Property and international trade law at Hongik University in Seoul, South Korea. She began her career as an IP litigator in Australia's largest law firm then joined a global media company as an in-house counsel working in many different jurisdictions around the world including Sydney, Tokyo, London, Brussels and Munich. She has significant experience in lobbying the EU Commission and Parliament and has taken part in a WTO dispute settlement process. Professor Cho is admitted to practice in the US, UK and Australia and holds graduate degrees from University of Melbourne and University of Cambridge.



Mr. Shinichi Murata

Partner, Kaneko & Iwamatsu.
Attorney at Law.
Admitted in Japan (Daini Tokyo Bar Association) and New York.



Mr. Naoki Yoshida

Managing Partner, Tokyo Office, Finnegan, Henderson, Farabow, Garrett & Dunner, LLP. Admitted in the District of Columbia, New York, U.S. Court of Appeals for the Federal Circuit, and Tokyo Dai-ichi Bengoshi Kai. Also, admitted to practice before the U.S. Patent and Trademark Office.

Lecturers

- Day 3 -



Makoto Ogino

Professor, Tokyo University of Science, Graduate School of Innovation Studies MIP;
President-to-elect of Japan Licensing Executive Society (LESJ)



Toru Kobayashi

Senior General Manager,
Legal & I.P. Dept., Corporate Planning and Administration Division, Tsukishima Kikai Co., Ltd.



Katsumi Harashima

Director, Taiyo, Nakajima & Kato;
Past President of Japan Licensing Executive Society (LESJ)



Yutaka Hara

Director, Advanced Soft Materials Co., Ltd.;
Member of Japan Licensing Executive Society (LESJ)

Access Information for PORTA KAGURAZAKA

Tokyo University of Science PORTA KAGURAZAKA

(2-6 Kagurazaka, Sinjuku-ku, Tokyo,
JAPAN)

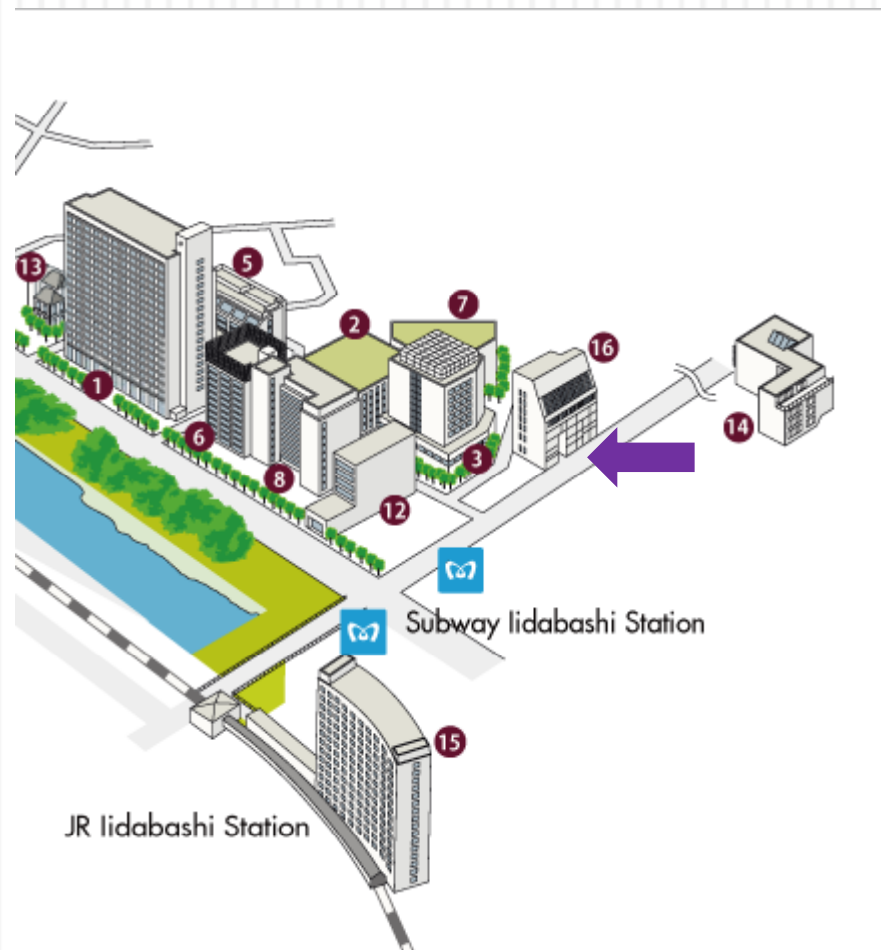
<http://www.sut.ac.jp/en/campus/kagurazaka.html>

- ◆ **JR**
West Exit at Iidabashi Station on Sobu Line,
3 minutes on foot
- ◆ **Subway**
B3 Exit at Iidabashi Station on :
Tokyo Metro Yurakucho Line,
Tozai Line, Namboku Line,
Toei Subway Oh-edo Line ;
2 minutes on foot

Porta Kagurazaka is a gate-shaped building for shops and residence. Going into the gate, you will see elevators on the left to reach the place on the fifth floor.

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PORTA KAGURAZAKA



Inquiries



- **Japan Association of Universities for Intellectual Property Education and Research (JAUIP)**
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- **Contact (General address)**
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