

2015 JAUIP Summer IP Seminar Practitioner Course

Date : August 31 through September 2, 2015
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 students in and out of Japan who had interest in learning intellectual property and its management in English. This year, the JAUIP opens the 4th summer seminar for the period from August 24 through August 28, 2015 in Tokyo.
 - In addition to the student course program, the JAUIP organizes an intensive program of 3 days for patent practitioners in Asia. This program called “Practitioner Course” starts on Monday August 31 through Wednesday, September 2, 2015. Distinguished lecturers, academic and practicing attorneys, will cover their professional fields of practice relating to procedures to obtain patents and to post-grant enforcement and negotiation for settlement.
 - The practitioner course is featured with group work opportunities for active learning. In the session of group work, members of each group are supposed to collaborate each other to prepare a written product within a limited time. Group work will surely provide you with precious 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 (Professor, Tokyo University of Science)
- Hiroshi Kato (Professor, Nihon University)

Practitioner Course

- **Period:** Monday, August 31- Wednesday, September 2, 2015
- **Place:** P502 Class Room at the PORTA KAGURAZAKA 5 F, (Kagurazaka, Tokyo)
- **Registration fees:** 70,000yen
- **Seat Capacity:** 40
- **Language:** English
- **Necessary Devices:**
 - ▣ Attendees are supposed to bring their own PCs with a PPT software. They are inevitable for group work and presentation. Your PCs and tablets can be connected to the Wi-Fi network.
- **Remarks:**
 - ▣ Attendees are required to attend the entire course because the members of each group work will remain the same through the seminar. The certificate of completion will be issued to each attendee after the completion of the program.
 - ▣ Materials to be used in this course will be downloadable from the JAUIP web site.
- If you have any question, feel free to contact: summer-seminar@jauip.org
- **Program directors:**
 - ▣ Prof. Jinzo FUJINO (Tokyo University of Science, Graduate School of Intellectual Property Studies, MIP)
 - ▣ Prof. Hiroshi KATO (Nihon University, Graduate School of Intellectual Law, IP Property)

Application & Registration

- Those who want to participate to the seminar 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. They can be sent by e-mail to the JAUIP secretariat at:
 - summer-seminar@jauip.org
- Upon receipt of application, the JAUIP secretariat will send to each applicant a notice of registration. Please be aware, however, that registration might be refused when and if application is from an unqualified applicant.
- The registration fee (70,000 Japanese yen) is payable at the seminar place during the time for registration on Day 1. If a bank transfer is preferred for payment, please contact the JAUIP secretariat.

Program at-a-glance

(8/31/2015 - 9/2/2015)

	Monday, August 31	Tuesday, September 1	Wednesday, September 2
Morning	Registration & Orientation (9:30 - 10:00)	Registration (9:30 - 10:00)	Registration (9:30 - 10:00)
	Lecture: IP Harmonization – International framework (10:00 – 12:00) Prof. Hiroshi Kato	Lecture: Fundamentals of Patent Prosecution in Japan/US (10:00 - 12:00) (Japanese Perspective) Mr. Ichikawa (US Perspective) Mr. Kevin Kunzendorf	Lecture: Fundamentals of Dispute Resolutions In Japan/US (10:00 - 12:00) (Japanese Perspective) Mr. Shinichi Murata (U.S. Perspective) Mr. Naoki Yoshida
Lunch Break	12:00 - 13:30	12:00 - 13:30	12:00 - 13:30
Afternoon	Lecture: Patentability and Patentable Subject Matter (13:30 - 15:30) (Japanese Perspective) Mr. Nobutaka Yokota (US perspective) Mr. Maxwell Fox	Lecture: Issues caused by translations in Japan/US (13:30 - 15:30) (Japanese and Perspective) Dr. Shoichi Okuyama (U.S. Perspective) Mr. James Hughes	Role Play: Mock Patent License Negotiations (13:30 - 15:30) (Played by) Prof. Makoto Ogino Mr. Katsumi Harashima Mr. Torahiko Maki Mr. Yutaka Hara
	Group Work: Analyzing damages calculation in the case of Apple v. Samsung (16:00 - 18:00) Prof. Jinzo Fujino	Group Work: Drafting patent Claims (16:00 - 18:00) Dr. Shoichi Okuyama Ms. Kaoru Kuroda Ms. Megumi Konishi	Group Work: Drafting Settlement Clauses (16:00 - 18:00) Mr. Stuart Beraha Ms. Louise Stoupe
	Welcome Reception 18:30 - 20:00	—	Closing

Course Profile - Day 1

➤ **“Harmonization of the Patent System” (10:00-12:00)**

➤ **by Prof. Hiroshi Kato**

- In this lecture, recent policies for an international harmonization of the patent system in the World Intellectual Property Organization (WIPO) are explained, and recent trends of the revision of Patent Laws in major countries are considered. Also, as an international harmonization in the practical side, the patent prosecution highway (PPH) and the recent cooperation among major IP offices such as Japan Patent Office (JPO), United States Patent Trademark Office (USPTO), European Patent Office (EPO), State Intellectual Property Office of China (SIPO) and Korean Intellectual Property Office (KIPO) are explained, and practical issues among major countries are discussed.

➤ **Group Works:**

“Analyzing the Damages Calculation in the case of Apple v. Samsung” (16:00-18:00)

➤ **by Prof. Jinzo Fujino**

- During the seminar, the seminar attendees will be divided into small groups for group work. The same members of each group are supposed to work together during the entire seminar. On Day 1, the group work analyzes how damages are calculated in the case of infringement of standard-essential patent (SEP). Before group work, the case of Apple v. Samsung decided by the Intellectual Property High Court (IPHC) in Japan will be reviewed. Based on the case review, the members of each group will discuss what are reasonable damages for SEP and why.

Course Profile - Day 1

➤ “Patentability Requirements in Japan/US” (13:30-15:00)

➤ 1) Japanese perspective

➤ by Mr. Nobutaka Yokota

- The Japanese Patent Law requires that five substantive patentability requirements be satisfied before an application is granted a patent. These requirements are considered to be almost consistent among the major five (JP, US, EP, CN, and KR) patent offices, but inconsistent provisions and practices still remain. This lecture will review patentability requirements in Japan with explanations of the provisions and practices specific to Japan. In connection with the following lecture relating to the “US perspective”, the eligible subject matter in Japan will also be explained.

➤ “Patentability Requirements in Japan/US” (13:30-15:00)

➤ 2) US Perspective

➤ by Mr. Maxwell Fox

- This lecture will introduce the requirements for patentability in the United States, namely that the invention include patent eligible subject matter, that it be novel, non-obvious and useful. In particular, the lecture will focus on some of the recent developments in United States case law, such as the Supreme Court’s decisions in Alice Corporation v. CLS Bank, Mayo v. Prometheus, AMP v. Myriad and KSR v. Teleflex, that affect the way the patentability requirements are interpreted in the courts. If time permits, the lecture will also compare and contrast the various legal procedures in which patentability comes into play, including prosecution, litigation and the newly available invalidity challenges at the Patent Trial and Appeal Board.

Course Profile - Day 2

- **Fundamentals of Patent Prosecution in Japan/US (10:00-12:00)**

- **by Mr. Ichikawa and 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.

- **Issues caused by translations in Japan/US (13:30-15:30)**

- **by Dr. Shoichi Okuyama and Mr. James Hughes**

- Translation of patent specifications and claims is extremely tricky simply because the grammar and vocabulary, particularly, in patent claims, are very different from ordinary English, Japanese or any other language. We will go through the peculiarities of patent or claim language from English and Japanese perspectives, so as to clarify the importance of specialization in patent translation.

Course Profile - Day 2, 3

* DAY2

- **Drafting Patent Claims (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. This is similar to draftsmanship for painters. Whatever one does as a painter, from constructivist to abstract, 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 ordinary grammar, conventions, and terminology are not 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.

* DAY3

- **Fundamentals of Patent Dispute Resolution in Japan /US (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, customs office proceedings and alternative dispute resolution (ADR) will be explained in the lecture.

Course Profile - Day 3

➤ **Mock Patent Licensing Negotiation (13:30-15:30)**

➤ **by Prof. Makoto Ogino,
Mr. Katsumi Harashima,
Mr. Torahiko Maki,
Mr. Yutaka Hara**

➤ Experienced negotiators sit for a mock patent license negotiation. Potential Licensee attempts to challenge to-be-licensed patents while Licensor tries to defend them by giving the Potential Licensee a psychological pressure that the matter will go to the court if negotiations fail. Mock negotiations will provide the audience with an atmosphere of actual licensing negotiations and a sense of negotiation tactics and strategies.

➤ **Drafting Clauses for Settlement Provisions (16:00-18:00)**

➤ **by Mr. Stuart Beraha**

➤ On Day 3, the seminar covers theories of patent dispute resolutions and negotiation techniques for licensing through mock licensing negotiations. In this group work, the group members shall be asked to actually draft a key clause for an agreement to settle a patent infringement dispute, assuming that each group faces a risk of being sued for patent infringement. Each group shall be provided with advance sheets in which necessary factual information is described.

This group work includes discussion with group members, collaboration for drafting a contractual clause and presentation of each draft clause.

Lecturer – Day 1



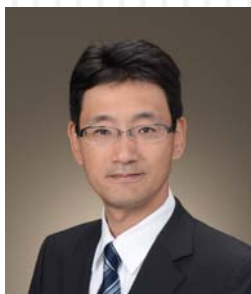
Prof. Hiroshi Kato

Professor, Nihon University, Graduate School of Intellectual Property.
Patent Attorney.
Previous occupation:
Examiner / Appeal Examiner in the JPO.
Assistant professor at Graduate Institute for Policy Studies (GRIPS).



Mr. Maxwell A. Fox

Partner, Ropes & Gray. Representing technology and life sciences companies in IP litigation, licensing, and counseling matters, Mac has litigated cases throughout the US and before the ITC, the CAFC, and the US Sup. Court. He has guest lectured as part of an intellectual property law course at Keio University Law School.



Mr. Nobutaka Yokota

Patent Attorney
Managing Partner of FIELD5 IP Attorneys
Council member of JPAA
Former leader of JPAA-AIPLA project group
Former leader of US practice group of JPAA International Activities Center



Prof. Jinzo Fujino

Professor (adjunct) of Tokyo University of Science, School of Innovation Studies, MIP; Lecturer, The University of Tokyo, School of Information Science and Technology; Member of IP Management Experts Network

Lecturer – 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.

Lecturer – Day 2 (cont'ed)



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. James D. Hughes

Director, International Liaison, S. Soga & Co.; INTA Bulletin, Asia Pacific Law Practice Subcommittee Member; Instructor, ABAC Zoom Patent Translation Course; Former Chairperson, Intellectual Property Committee, ACCJ; Contributor to AIPPI Japan Journal, Patent and Engineering, ACCJ Journal



Ms. Megumi Konishi

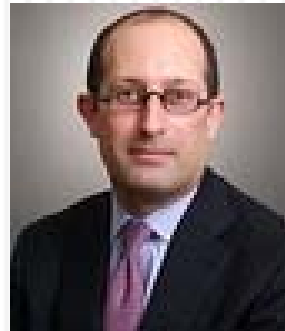
Patent Attorney, Principal/Managing Partner at KONISHI & NAGAOKA IP FIRM, CEO at PERFECT TRANSLATION JAPAN, Inc. Ms Konishi is strong in patent practice in the field of hardware/software, image processing and telecommunications. She has an experience in drafting patent applications and in translating patent specifications and other IP related documents.

Lecturer – Day 3



Mr. Shinichi Murata

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



Mr. Stuart Beraha

Partner, Morrison & Foerster in Tokyo. Mr. Beraha has extensive experience in licensing and technology partnering and transfer transactions, including patent, technology and content licensing and development relationships. He also regularly handles the intellectual property aspects of merger and acquisition transactions.



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.



Ms. Louise Stoupe

Partner, Morrison & Foerster in Tokyo. Ms. Stoupe's practice is focused on intellectual property and complex commercial disputes. She is an expert in resolving international disputes and regularly appears before U.S. District Courts and the ITC on intellectual property matters.

Lecture – Day 3 (cont'ed)



Prof. Makoto Ogino

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



Mr. Torahiko Maki

Board Member & Managing Executive Officer, Tsukishimakikai Co., Ltd.;
Former vice president of Japan Licensing Executive Society (LESJ)



Mr. Katsumi Harashima

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



Mr. Yutaka Hara

President & CEO, 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)

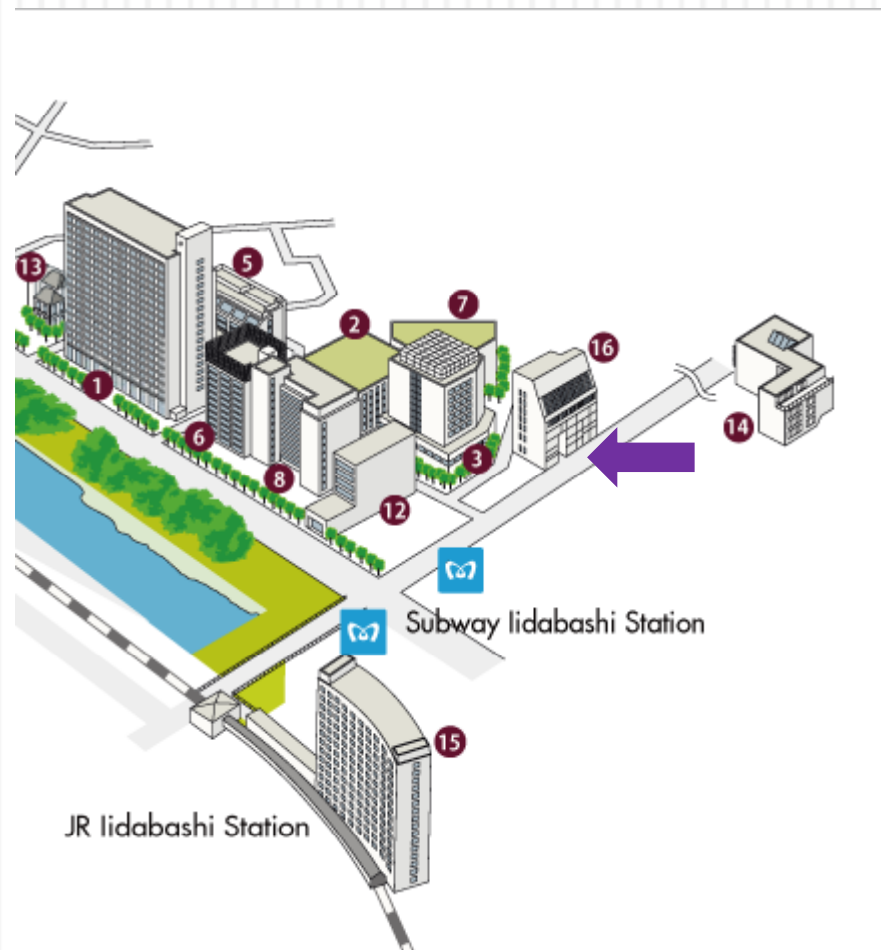
<http://www.sut.ac.jp/en/campus/kagurazaka.html>

- ◆ **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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