

Patent Harmonization from the Perspective of a Japanese IP Judge

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Introduction

I would like to present a Japanese judge's perspective on Patent Harmonization. The Judicial Conference of the United States Court of Appeals for the Federal Circuit was held on April 8th this year, its 20th anniversary. The Chief Justice of the United States said, "With the growth in global commerce and technology, the areas within the jurisdiction and expertise of the Federal Circuit have become more and more topical for international exchanges. It is important for judges and legal communities of different nations to exchange views, share information and learn to better understand on another and our legal systems. The judges in this circuit have a lot to offer." I hope the Chief Justice of the Japanese Supreme Court has the same understanding with the Intellectual Property Division of Tokyo High Court.

On the contrary, twelve years ago, the Intellectual Property Division of the Tokyo District Court, I was working for, was strongly criticized by American patent attorneys. They said, "Japanese Intellectual Law is stupid and Japanese judges are..." Oh, Professor Tamai says," Japanese law is stupid even now. Because I was young twelve years ago, I got very angry and wanted to study in America how Japanese law was stupid and American law was good. I sent a letter to Chief Judge Nies. I asked her to permit me to study at Federal Circuit. Fortunately, she kindly permitted my study and recommended me to study at Judge Rader's chamber. I studied at his chamber for three months. I have been exchanging information with him until now. Then, Professor Thomas was a law clerk of Chief Judge Nies, but he did not do for me...anything. (Laughter) Since he started to study in Japan, we have been good friends and I know he is a very kind person. I can imagine he was too busy when I was studying at Federal Circuit.

I could learn a lot from Chief Judge Nies, Judge Rader and the other Federal Circuit judges. At the end of my study at Federal Circuit, I asked her to come to my court and teach the importance of international judicial cooperation to Japanese judges

in charge of intellectual property cases. She promised me to do so. Actually, she visited my court the next year; so Japanese judges could have discussions with her. As you see now, Japanese judges are not good at speaking English, and it was very difficult to find a good interpreter who knows both American and Japanese intellectual property law, as well as both languages. Finally, a young patent attorney voluntarily accepted my request to interpret at our conferences. Thank you for your good interpretation, Professor Takenaka. I will never forget your contribution. Chief Judge Nies told me at the end of her visit to my court, that a friend of hers also would like to visit to my court and requested that I arrange the visit. Of course, I accepted the request, and I was very much surprised and pleased to know that a friend of hers was Justice Ginsburg. I am proud that her visit to my court was no less successful than Chief Judge Nies'.

1. Who will benefit from patent harmonization?

a) Developed countries or Developing countries?

1) Reduce expenses

Technology is borderless and our economy is international today. Business people want to reduce expenses of both patent applications and patent infringement litigation. Now people have to apply lots of patent applications to lots of patent offices around the world and file lots of patent infringement litigation in the courts around the world. Moreover, prosecution and litigation procedures are varied and people have to cope with various IP systems.

2) Technology transfer

Big companies have become multinational and want to produce products in the country where labor is cheaper. Business people want to prevent identical products from being dealt in the country where the big company wants to export its products. Those companies want those countries to create and keep the legal protection of intellectual property in those countries.

b) Patent harmonization should be beneficial to all of the people in the world.

1) Economic development

Intellectual property systems benefit the big businesses that file pioneer inventions, produce and export products all over the world. But, does the intellectual property system exist for the profit of big businesses only?

Developing countries participate in the international IP harmonization because IP system is necessary for economic development. The technology transfer is necessary for economic development and IP system is necessary for technology transfer. Moreover, if the big businesses produce more products in developing countries, more employment is created and the quality of life of the people will be improved.

Some developing countries say international IP harmonization prevents medical practice, compel people to buy expensive imported products and it is harmful overall. But, they have to realize that it is impossible for any country to survive without international transactions in this world. The countries that want to become a member of WTO have to have intellectual property systems by TRIPS.

Indeed, we have to admit that demerits of developing countries may happen. Developed countries have to do their best for the economic development and social welfare of developing countries. Without those efforts, international IP systems cannot be maintained.

2) Promotion of individual creativity

IP becomes public domain after a certain period of exclusive protection. Even during the exclusive protection period, they are licensed and develop the level of the technology in those countries. After the development of technology, new IP will be created in the country if IP is protected there. IP protection also promotes individual creativity as the incentive even in developing countries.

2. How to harmonize

a) What level of harmonization?

1) Examination, invalidation and enforcement

IP harmonization has three levels; those are examination, invalidation and enforcement. Now examination level of harmonization is discussed mainly. But even if the level of harmonization will be succeeded, it is not satisfying if invalidation and enforcement are not harmonized at all. Of course, we have to do our best for the examination level of harmonization now, because it is the first step of total harmonization.

2) Patent office and judiciary

The Patent Office is in charge of examination and the judiciary is in charge of enforcement. Both the patent office and the court are in charge of invalidation procedure. When the harmonization is shifted from examination to invalidation and enforcement, the authority in charge of harmonization will be shifted from the patent office to the judiciary. Judges have to realize that we are responsible for patent harmonization.

b) Cooperation or unity?

1) National or international organizations

There are two ways of IP harmonization. The one way is that each country keeps its independent national power and cooperates with each other. The other is that each country gives the national power that is necessary to create international organization and unifies the system.

Which is better? It depends on the political situation. If most countries agree to unify the system, complete unity is desirable. But if many countries want harmonization that is not so tight, cooperation is realistic.

The foundation of a new international organization may attach too much importance to a certain county. The similar situations may happen in any creation of international organization. I think it is not necessary that unified IP organization is located in one country only. Of course, one main office is necessary, but the patent offices in each county will be the branch of the unified IP organization. So the foundation of a new international organization does not give too much importance to a certain country inevitably.

3. The Japanese legal system

a) Constitutional provision with respect to treaty

1) Superior to national law

Japanese constitution provides that International Treaty and Convention is superior to national law. When a Substantive patent law treaty is ratified, it will be superior to Japanese patent law.

b) Judicial attitudes toward patent harmonization

1) Doctrine of equivalent

2) Invalidity defense

Japanese Supreme Court changed precedents in respect to international patent harmonization. The court applied doctrine of equivalent and invalidity defense, as is internationally reported.

4. A judge's perspective

a) Protection of human rights and the rule of law

1) National and international

I would like to present how I, as a judge, should face to international IP harmonization.

During the effort to harmonization, each government does its best to protect the national interest. Each company pushes the government to protect the profit of the company. Of course, they are the responsibilities of the government and the company.

On the contrary, a judges' responsibility is to protect human rights and the rule of law. We should protect the human rights, not only of the people of our own country, but also of foreign countries. We should protect rules of not only national law but also international and foreign law.

Companies and governments compete with each other, but judges have common responsibility to protect human right and rule of law around the world. Judge's responsibility always urges us to cooperate with each other by nature. I think judges should strongly back up the

international intellectual property harmonization and help all of the people to benefit from international IP harmonization.

Chief Judge Nies made a speech at AIPLA annual meeting in 1992. She said, “The poverty of our neighbors is not due to historical imperialism or the deliberate oppression of a ruling elite or natural poverty of resources. The villain is the law of their own countries and the political nature of the judiciary. This is inimitable to the principle of free markets and totally destructive of individual creativity.”

b) Protection of IP rights

1) Based on the protection of property rights in the judiciary

Judges’ responsibility to protect human right includes the protection of property rights that is necessary basis for the protection of IP rights.

2) Independent of politics

The judiciary that is independent of political power can protect fundamental human right including property right. The political power includes all of the power of our own country, foreign countries and international organizations.

c) International judicial cooperation

1) IP judges as members of an international collegial group

Chief Judge Nies said, “The judges of this court and judges of foreign courts, which deal in intellectual property matters already think of themselves as members of an international collegial group.”

Judges are members of a collegial group who have common responsibilities to protect human right and rule of law. Judges around the world should cooperate to do our responsibility. In particular, IP judges have to remember that we are members of international collegial group of international IP harmonization.

5. A Japanese judge’s perspective

a) Continuous cooperation with judges around the world (in particular, American, Korean and Chinese judges)

As a Japanese judge, I would like to emphasize several issues. Japanese people have been borrowing from other countries for a long time during Japanese history. Japanese law is a mixture of Anglo-American law, German law and French law. Japanese courts have given Japanese judges the opportunity to study in those countries. Japanese judges are exchanging information with the judges we met during the study in those countries.

In IP fields, the Japanese patent office has already agreed with the American, Korean and Chinese patent offices to increase cooperation of examination. I regret that Taiwan could not do so due to a political reason. With the Japanese patent examination procedure becoming more strongly connected to the procedure of those countries, Japanese judges will have to cooperate with the IP judges of those countries even more.

Judge Soo-wan Lee, who is a research judge in charge of intellectual property appeals at Korean Supreme Court, graduated from this Law School. I met him several years ago when he was a judge of the Korean Patent Court handling intellectual property appeals; and I was a research judge in charge of intellectual property appeals at the Japanese Supreme Court. Since then, we have been exchanging information about Japanese and Korean law. During our exchange of information, he was appointed as a research judge at the Korean Supreme Court and I was appointed as a judge at Intellectual Property Division of Tokyo High Court. I do not think this is a coincidence.

b) Judicial support to developing countries in Asia

1) Judicial support plan has started, beginning with Vietnam

Japan is a member of the Asian community and its economy is strongly connected with Asian countries. It is important for Japan to keep up good relationships with other Asian countries.

The Japanese judiciary decided to start a judicial support plan for Asian developing countries. At first, a Japanese judge stayed in Vietnam for two years to support the judicial system there. Japanese judges are proud that the people working for the judiciary in Vietnam are satisfied with a Japanese judge's contribution to their judiciary.

Now, the Japanese court is planning to send the next Judge to another Asian country soon.

6. Proposal

a) Respect to the precedents of foreign courts

1) Study of foreign law and precedents

I would like to propose several plans mainly to Japanese judges. It is important for judges to study foreign law and precedents, because a judge has a responsibility to protect human rights and the rule of law around the world.

In particular, conflicts of IP precedents should be avoided from the viewpoint of IP harmonization. Judges should study foreign law and precedents.

b) International (Asian, ASEAN and APEC) judges conference on IP law for the dissolution of conflicting international precedents

In reality, conflicts of precedents may happen, as it happens even within a country. An international judges' conference on IP law is helpful in dissolving conflict, as shown by European judges.

c) Exchange program for the education of foreign judges

Staying in a foreign court for a certain period of time is very helpful for the study of foreign law, as I did. Actually, very many Asian judges, especially Korean judges, are visiting Japanese courts to study Japanese law.

d) Assisting developing countries by serving as advisors to their judges and courts

I know that so many Asian judges need our judicial support. Unfortunately most of them cannot stay in Japanese courts for a long enough period of time. The Japanese judiciary should continue to support the Asian judiciaries.

e) Daily conferences between IP judges using the Internet as the forum

Now we have the Internet and it is useful for our communication. I am

wondering how to create an Internet forum of judges to have daily conferences to exchange information. It is less expensive and less time consuming. Of course, I would like to actually meet with judges, but it is impossible to meet everyday. When the International IP court is founded, it will enable me to practice with judges of all over the world and interact with them everyday.

Conclusion

Ten years ago, Chief Judge Nies said, “This rich interchange of ideas between judges from all over the world appears to be more than just fortuitous. It is as though forces are at work preparing judges in the field of intellectual property to assume a wider outlook and broader responsibilities for the future. No doubt ten years is too short a time for a revolution of such dimension to occur. I have no doubt, however, that the winds of change are in the air and cannot be turned.” I quite often think to myself that Chief Judge Nies is the best judge I have ever met, “I am practicing with your colleagues all over the world as you taught me.” Now ten years have passed, but I still believe that the winds of change are in the air and cannot be turned.

Personal History (Yukio Nagasawa)

- 1982 Graduated Tokyo University, Law faculty
- 1984 Appointed as a judge
- 1989 Judge, IP division, Tokyo District Court
- 1991-1992 Studied IP law in U.S.A and European countries
- 1994 Research Judge, IP section, Supreme Court of Japan
- 2000 Judge, IP division, Tokyo High Court