ACTIVITIES

I. Activities of the International Law Association of Japan

THE TWENTY-THIRD ACADEMIC CONFERENCE (2016)

Date: April 23, 2016
Venue: Sanjo Kaikan, University of Tokyo
Morning Session:
Chair: Professor Shin'ichi Ago, Ritsumeikan University
Speaker: Professor Takane Sugihara, Emeritus Professor, Kyoto University
Afternoon Session: Intellectual Property Rights and Public/Private International Law
Chair: Professor Koresuke Yamauchi, Chuo University
Speaker: Professor Toshiyuki Kono, Kyushu University
Speaker: Professor Takanobu Kiriyama, Osaka City University
Speaker: Professor Masabumi Suzuki, Nagoya University
Speaker: Mr.Yoshio Kumakura, Attorney at Law, Former President of AIPPI Japan

Modern International Law: Its Cultural Foundation and Historical Evolution
Takene Sugihara, Emeritus Professor, Kyoto University

Since the 19th century, Western international lawyers have maintained the view that modern international law was largely a product of European Christian civilization. They highlight that their common cultural heritages – such as principles of Christian morality, systems of Roman and Canon law, and traditional doctrine of the law of nature – have laid the crucial foundation for building the modern law of nations. Even though all of these foundations are, in essence, universal and transnational in character, the international law that started to develop in early modern times long-remained a law solely between Christian nations.

Since the second half of the 19th century, the Western powers had been obliged mostly by commercial needs to receive several non-Christian states into the community of states that are subject to international law. Consequently, such states as Turkey, Persia, Siam, China, and Japan were received as members, though not initially full members, of the international law community. This development marked a significant step forward in the process of realizing the universal character of international law. However, the international law of this era was accompanied by a well-known regime, a system of the so-called "capitulation" or "extra-territorial jurisdiction." These treaty regimes made between the Western powers and the Asian states imposed a limitation of sovereignty upon the latter, which they were constrained to accept. It should be noted that the acceptance of the said regimes by the Asian states was an indispensable condition for obtaining their status as subjects of modern international law.

A Report from the Committee on Intellectual Property and Private International Law
Toshiyuki Kono, Professor, Kyushu University

The Committee was established in 2010, with the objective of drafting guidelines to address issues related to cross-border enforcement of Intellectual Property. This aim was based on such preceding projects such as:

- The American Law Institute, Intellectual Property: Principles Governing Jurisdiction, Choice of Law and Judgment in Transnational Disputes (AIL Publishers, 2008);
- European Max-Planck Group for Conflict of Laws in Intellectual Property (CLIP), Conflict of Laws in Intellectual Property: The CLIP Principles and Commentary (Oxford University Press, 2013); and
- Basedow/ Kono/ Metzger, Intellectual Property in the Global Arena – Jurisdiction, Applicable Law, and the Recognition of Judgment of Europe, Japan and the US (Mohr Siebeck, 2010).

Since 2011, the Committee has been convened at least once annually (in Lisbon, Sofia, Amsterdam, Washington DC, Geneva, and Munich). Its officers have met seven times, while Skype conferences have been held every two to three months since 2010. The Committee has been working closely with such international organizations as the World Intellectual Property Organization (WIPO) and the Hague Conference on Private International Law. The Committee plans to submit Draft Guidelines on non-controversial issues to the ILA Congress in Johannesburg in 2016: they will contain provisions on international personal jurisdiction, applicable law, and recognition of foreign judgments, although a few provisions in the Draft Guidelines are still subject to ongoing discussions. The Committee feels that more time will be needed to complete the discussions and to address some new issues.

The Intellectual Property Rights and the Traditional Knowledge of Indigenous Peoples
Takanobu Kiriyama, Professor, Osaka City University

Since 1990s, there has been much debate around the intellectual property rights (IPR) of indigenous peoples at the tables of various international forums. The purposes of IPR include both promoting the development of the economy and industry and protecting culture and heritage. Therefore, many international forums, such as WIPO, the World Trade Organization (WTO), COP of Convention on Biological Diversity (CBD) and United Nations Educational, Scientific and Cultural Organization (UNESCO), are faced with the problems of IPR connected to

indigenous affairs.

Genetic resources (GR), traditional cultural expressions (TCE) and traditional knowledge (TK) are the controversial areas. In particular, TK problems have multilateral aspects including cultural and spiritual values. However, it is often posited that these problems can be resolved through a conventional approach, such as copyright, trademark, and patent laws. Conversely, others reason that because these indigenous rights have collective, historical, and holistic character, the existing approach cannot protect them adequately.

The adoption of the history-making United Nations Declaration on the Rights of Indigenous Peoples (UNDRIP) stimulated IPR debate from the perspectives of international human rights law and other relevant areas.

In fact, since the beginning of this century, WIPO has managed the property rights of TK and other indigenous cultural heritage. Currently, the WIPO IGC (Intergovernmental Committee on IP and GR, TK and TCE) is proceeding with negotiations based on the draft text on TK submitted by the WIPO's Secretariat.

Examples of the controversies include whether the nature of the text is binding or non-binding, who are the beneficiaries of protection, and the necessity of the establishment of a *sui generis* legal system. The participation of the indigenous peoples in the law making process also poses a serious issue.

It is becoming increasingly important to respect the right to self-determination of indigenous peoples through their prior informed consent to resolve these issues amicably.

International Harmonization of Systems for Intellectual Property Protection and Its Limitations

Masabumi Suzuki, Professor, Nagoya University

Current systems for the protection of intellectual property (IP) are based on the principles of territoriality and the independence of rights. However, for purposes such as the avoidance of cross-border free-riding on another person's creations, the protection of foreign nationals, and making IP-related procedures more efficient, efforts have been directed toward international harmonization and the convergence of the IP protection systems since as early as the 19th century. The goal of such efforts seems to be the establishment of a strict and uniform set of rules and standards for IP protection, as exemplified by the Trade-Related Aspects of Intellectual Property Rights (TRIPS) Agreement. However, multilateral negotiations for new international frameworks have practically stalled in recent years. The reasons for this impasse include enduring North-South conflicts, developing countries' growing awareness of their own interests and, consequently, more assertive demands, and the increasing possibility of encountering issues relating to the fundamental principles of local legal systems or public policy matters. In these circumstances, countries concerned about IP protection are increasingly relying on plurilateral or bilateral trade (and/or investment) treaties.

The problems associated with these recent trends comprise, first, that the "one-size-fits-all" approach is no longer appropriate for accommodating the various situations and conditions of different countries and industries. Second, negotiating IP in the context of broad economic issues tends to ignore the need for fine-tuning the systems. Therefore, it is advisable to return to the more traditional approach in which states focusing simply on IP in international rule-making, with careful balancing of the interests of IP holders and the users of such subject matters.

Case Study of International IP Disputes

Yoshio Kumakura, Attorney at Law, Former President of AIPPI Japan

The legal procedures to obtain IP rights have been the subject of an international drive toward uniformity for many years through the Paris Convention, the Patent Cooperation Treaty; to a certain extent, uniformity of the substantive laws concerning various IP rights has also been pursued through TRIPS, several multinational copyright conventions, etc. For example, under the European Patent Convention, the patent examination is conducted by a single office (European Patent Office, EPO), but the scope, construction, and validity of patents are decided by individual member countries as bundles of national rights, and the litigation for enforcement of those rights are subject to the laws of each jurisdiction. Therefore, the IP holders and practitioners continue to face various difficulties in multinational litigations, because of the differences in substantive laws and procedural laws between countries.

(1) The first case study reported on the differences in several countries in Europe and Japan on the issue of whether the same word mark maintains distinctiveness as a trademark. This trademark was adopted for a new material invented in the 1930s. The product was manufactured in Europe by a company owned by the inventor and, in Japan, by a company established under a license to the inventor's friend, a famous scientist. Because the product was a new material, the trademark seemed to have been intended to be used by consumers as a generic name or a common name, regardless of the trademark registrations. The ownership of both companies were transferred several times and their businesses were globalized respectively, with competition between them beginning in many countries. Thus, the European company sued the local subsidiaries of the Japanese company in three jurisdictions. In two of the three jurisdictions, the first instance courts denied the distinctiveness and declared there was no infringement. However, one court found distinctiveness and held that there had been infringement. This case demonstrates that even one of the most basic concepts of "distinctiveness" cannot be decided uniformly, as this issue has a fact-finding aspect in addition to

the application of laws.

The procedural laws are also different. In one jurisdiction, the court may issue a preliminary injunction order to prohibit the defendant's use of a trademark and sale of a product bearing the trademark through an ex-parte procedure, without hearing the defendant's opinion. In other jurisdictions, requests for a provisional injunction may be conducted through an inter-partes procedure, giving the opportunity for the defendant to submit their defense.

The admissibility, conditions, and effects of cross border injunctions in European countries were also discussed.

(2) As the second case study, the prevention of the international flow of counterfeit products was analyzed using the Dyson cases in Japan. The source of the counterfeits was China. Initially, counterfeiters imitated the trademark and designs and descriptions on product packages. These activities were stopped as trademark infringement, copyright infringement, and violation of Japan's Unfair Competition Prevention Act. The second round of litigation concerned design and patent infringements. Dyson sued for a provisional injunction order against one importer in the Japanese court. The court issued the injunctive order after hearing the defendant's argument. This court order was later used in warnings (cease and desist letters) to many importers and internet shops, in addition to being submitted to the Japanese customs authority to ensure prohibition of the import of the design-infringing products.

The negotiations with internet providers, such as Amazon, Rakuten, etc., were initially difficult but they later became more cooperative after the e-Bay cases in Europe and the similar Chupa Chups case in Japan, which held that internet providers have certain responsibilities towards the holders of IPR.

The functions of the customs authority, the institution responsible for preventing the importing of counterfeits at borders, also vary between countries. In Japan, the customs authority officers are authorized and trained to identify and prohibit infringing goods after the acceptance of a right holder's detailed application. However, in European countries, right holders are required to file patent infringement litigation before the courts of each country within a rather short period after the customs authority suspends the import clearance. It is reported that this European border approach is very expensive and time consuming. The International Trade Committee (ITC) procedure, a quasi judicial procedure by administrative judges in the USA was also compared.

Some discussions were held concerning what changes will occur after the European Unified Patent Court and Unitary Patent are launched, but this is now uncertain because the United Kingdom has decided to leave the EU.