



**Patent Resources Group**  
**Procuring & Enforcing Patents in Asia**  
**Course Syllabus**

**I. INTRODUCTION**

- A. Patents in Asia**
  - 1. R&D Spending in Asia**
  - 2. Technology Transfer**
  - 3. Asian Patent Wars**
- B. Communicating With Asian Clients**
  - 1. Language**
  - 2. Culture**
- C. Controlling Costs in International Discovery**
  - 1. The Case Management Order**
  - 2. Document Collection**
  - 3. Discovery Management**
  - 4. Depositions**
- D. Handling Attorney/Client Privilege and Work Product in International Cases**
  - 1. Definition of “Attorney-Client Privilege”**
    - a. What Is Legal Advice?**
    - b. Who Is a “Professional Legal Advisor?”**
    - c. Applying the Privilege to Foreign Patent Prosecution**
  - 2. Work Product**
    - a. Work Product Immunity Is Available if There Is a “Substantial Probability” of Litigation When the Document Was Created. *Weil Ceramics & Glass, Inc. v. Work*, 110 F.R.D. 500 (S.D.N.Y. 1976)**
  - 3. Are Patent Prosecution Documents “Work Product?”**
  - 4. Best Practices Regarding Privilege Review**
- E. The International Deposition**
  - 1. Preparing Witnesses**
  - 2. Depositions in Japan**
  - 3. Compelling Witnesses to Be Deposed in the United States. *Tailift*, 2004 WL 722244 at \*2 (2004)**
  - 4. Best Practices for International Depositions**



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- F. Protective Orders in International Cases**
  - 1. Protective Orders in Patent Cases Generally Include Limitations on the Use of Confidential Technical Information**
    - a. Protective Orders Can Be Modified at Court's Discretion**
    - b. *Infineon Technologies AG v. Green Power Technologies LTD*, 247 F.R.D. 1, 2 (D.D.C. 2005)**
  - 2. Modification to Allow Use in Co-pending Litigation on Related Patents in Foreign Jurisdictions**
    - a. *Infineon Technologies AG v. Green Power Technologies LTD*, 247 F.R.D. 1 (D.D.C. 2005)**
    - b. *In re Jenoptik AG*, 109 F.3d 721 (Fed. Cir. 1997)**
- G. Extraterritorial Reach of the US Patent Laws**
  - 1. 35 U.S.C. § 271(a)**
    - a. *Deepsouth Packing Co. v. The Laitram Corporation*, 406 U.S. 518 (1972)**
    - b. *NTP, Inc. v. Research in Motion*, 418 F.3d 1282 (Fed. Cir. 2005)**
    - c. *Decca Ltd. v. United States*, 544 F.2d 1070 (Ct. Cl. 1976)**
  - 2. 35 U.S.C. § 271(b) and (c)**
    - a. When Can Actions by Overseas Entities Be Held to Induce or Contribute to Infringement in the United States?**
  - 3. 35 U.S.C. § 271(f)**
    - a. *Rotec, Inc. v. Mitsubishi Corp.*, 215 F.3d 1246 (Fed. Cir. 2000)**
    - b. *Microsoft Corp. v. AT&T Corp.*, 550 U.S. 437 (2007)**
  - 4. 35 U.S.C. § 271(g)**
    - a. Importing the Product of Patented Process Can Be an Infringement**
    - b. Presumption of 35 U.S.C. § 295**



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- c. ***Bayer A.G. v. Housey Pharmaceuticals, Inc.*, 340 F.3d 1367 (Fed. Cir. 2003)**
- d. ***NTP, Inc. v. Research in Motion*, 418 F.3d 1282 (Fed. Cir. 2005)(Not Applied to Transmission of Information)**
- 5. **Injunctive Relief Against Foreign Companies**
  - a. ***International Rectifier v. Samsung Electronics Co., Ltd.*, 361 F.3d 1355 (Fed. Cir. 2004)**
  - b. ***Spindelfabrik Suessen-Schurr v. Schubert & Salzer Maschinenfabrik Aktiengesellschaft*, 903 F.2d 1568 (Fed. Cir. 1990)**
- 6. **Best Practices Regarding Extra-territoriality Review**
  - a. **Key Issues: Knowledge of the Patent, Activities in the United States, Knowledge of Whether Products Are Shipped to the United States**

**II. IMPACT OF CHINA ON IP LAW IN THE 21<sup>ST</sup> CENTURY**

- A. **Background**
  - 1. **General**
  - 2. **Current Republic of China**
- B. **OVERVIEW OF CHINESE PATENT SYSTEM**
  - 1. **History**
  - 2. **Patent Laws; 1984**
    - a. **First Amendment**
    - b. **Second Amendment**
    - c. **Third Amendment**
  - 3. **Categories of Patents**
  - 4. **State Intellectual Property Office (SIPO)**
  - 5. **Patent Procurement Steps**
    - a. **Choose Patent Category (Invention, Utility, Design)**
    - b. **Be Aware of Subject Matter Scope**
    - c. **Claiming Convention**
    - d. **Novelty**
    - e. **Utility Requirement**



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- f. **No Continuations**
        - g. **Examination Procedure**
      - 6. **High Profile Cases**
      - 7. **Trends**
- III. **THE INCREASING POWER OF IP LAW IN 21<sup>ST</sup> CENTURY JAPAN**
  - A. **IP Law Will Play a Central Role in 21<sup>st</sup> Century Asian Trade and Diplomacy**
  - B. **Japan Recognizes That It Needs Strong International IP Laws in Order to Maintain Its Standard of Living**
  - C. **Japanese Managers in the New Generation Are Willing to Use the Courts as a Business Tool**
  - D. **Japan Has an Intellectual Property Master Plan and Is Progressing Slowly According to Plan**
  - E. **Now Is the Time to Develop Basic Knowledge and Context in Order to Adopt Successful Long-Term Strategies**
  - F. **Overview of the Class**
    - 1. **Basic Facts About Japan**
      - a. **Geography**
      - b. **Population**
      - c. **Culture**
    - 2. **Brief Legal and Economic History**
      - a. **Legal History**
      - b. **Economic Model**
  - G. **Overview of the Japanese Patent System**
    - 1. **History of the Patent Law**
      - a. **Patent Law in the Showa Period**
      - b. **The Early *Heisei* Amendments (1994)**
      - c. **The 21<sup>st</sup> Century Koizumi IP Revolution**
    - 2. **The Institutions That Govern Japanese IP Law Today**
      - a. **The Japanese Patent Office**
      - b. **Intellectual Property Strategy Headquarters**
      - c. **Intellectual Property High Court**
      - d. **Supreme Court of Japan**



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- e. **Japanese Fair Trade Commission**
- f. **Customs Court**
- H. **Patent Prosecution in Japan**
  - 1. **Priority**
    - a. **First to File**
    - b. **Six-Month Grace Period**
      - i. **Experiment, Publication, Presentation at Exhibition**
      - ii. **Disclosed Without Patentee's Knowledge**
  - 2. **Patentability**
    - a. **Industrially Applicable**
    - b. **Novel**
    - c. **Inventive**
    - d. **Does Not Harm Public Order, Morality or Public Health**
  - 3. **Application**
    - a. **Request**
    - b. **Specification**
    - c. **Claims**
    - d. **Drawings**
    - e. **Abstract**
  - 4. **Foreign Translations**
    - a. **JPO Accepts Applications in English**
    - b. **Japanese Translation Must Be Received Within 14 Months of Filing or Priority Date**
  - 5. **Publication**
    - a. **18 months After Filing Date**
    - b. **Applicant May Request Earlier Publication**
  - 6. **Examination**
    - a. **Request for Examination and Fee Required for Examination on the Merits**
    - b. **Request for Examination Within Three Years of Filing**
    - c. **Examiner Examines**





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- h. Forms of Evidence
  - i. Ruling
  - j. Appeal
  - J. High Profile Cases and Issues
    - 1. Compensation for Inventors
      - a. The Law, the Policy, and the Consequences
      - b. *Blue LED Case*
    - 2. Patent Exhaustion
      - a. The Law, the Policy, and the Consequences
      - b. The *BBS Case*
      - c. *Recycle Assist v. Cannon*
    - 3. Obviousness
      - a. The Law, the Policy, and the Consequences
      - b. The *Internet Gaming Patent Case*
    - 4. Protective Orders and Discovery
      - a. The Law, the Policy, and the Consequences
      - b. The *Samsung Case*
  - K. Antitrust Law
    - 1. Guidelines for Use of Intellectual Property
    - 2. Guidelines on Standardization
    - 3. *Microsoft Case*
  - L. Parting Words
    - 1. The Need for US Companies to Follow Legal Reform in Japan
    - 2. How to Follow Such Reform
- IV. INTELLECTUAL PROPERTY LAW IN KOREA**
- A. History and Overview of IP in Korea
  - B. Hot Cases
    - 1. *Microsoft v. Lee*
  - C. Basic Overview of Korea
    - 1. Historical/Geographical/Economic Perspective
  - D. History of Korean IP / KIPO
    - 1. KIPO
      - a. Founding and Evolution

