

International Conference

“Patent Judges (Chambers and Courts) as IP Institution—Internal and External Views from Asia and Beyond”

Organizers

Singapore Management University

IP School Renmin University of China

Guangzhou IP Court

Management Committee of Sino-Singapore Guangzhou Knowledge City

Date

June 27 (Saturday) and 28 (Sunday), 2020

Venue

Guangzhou (PRC)

Background

Asian economies have made huge progress in the development of intellectual property (IP) laws and the enforcement of IP rights since the TRIPS Agreement in 1994. One of the indicators is the institutional arrangement of specialized IP judges (chambers and courts): Thailand (The Central Intellectual Property and International Trade Court, 1996), the Philippines (Special Commercial Courts, 2003), Malaysia (2007), Taiwan (IP Court 2008), Singapore (Singapore International Commercial Court, 2015), India (divisions in the High Courts 2016), Japan (IP High Court in 2005). In China, three IP Courts of intermediary level was set up in Beijing, Shanghai, and Guangzhou in 2014. The Supreme People’s Court set up IP Court in 2019 to directly handle all appeal cases against decisions by intermediary courts about patent, antitrust and unfair competition cases.

To sum up, in Asia, some jurisdictions have patent judges (chambers and courts) both as first and second instance courts (e.g. Japan, Korea, Taiwan, mainland China), some have them only at second instance (e.g. Singapore and India), and some have associate judges who are lay persons with expertise in IP (e.g. Thailand).

There are specialised IP or patent courts outside Asia, more notable are the German Federal Patent Court, the Patents Court in the UK, the Boards of Appeal of the European Patent Office (EPO), the Swiss Patent Court and the US Court of Appeal for the Federal Circuit (CAFC). The UK Patents Court is a specialised first instance court, the CAFC a specialised second instance court, the Swiss Patent Court mostly works with part-time judges, the German Federal Patent Court a specialised first instance court that deals with patent validity only, while the EPO Boards of Appeal deal with validity only, yet in last instance.

Thus far no systemic study has been made on Asian patent judges, what are their strength and weakness? how do they benchmark against their European, UK and US counterparts? How do judges see themselves from within and how do scholars assess them from outside? Can there be best practice for Asian patent judge regimes? How can we better construct patent judge regime as an IP institution in Asia?

Applied Research Centre for Intellectual Assets and the Law in Asia (ARCIALA), School of Law Singapore Management University, IP School Renmin University of China, Guangzhou IP Court, and Management Committee of Sino-Singapore Guangzhou Knowledge City, based on their recognition of the importance of the above-mentioned issues, strive to facilitate mutual understanding and exchange among Asian IP regimes, have teamed up to co-host the first International Conference on “Patent Judges Chambers and Courts) as IP Institution—Internal and External Views from Asia and Beyond”.

Invited speakers

Prof. Liu Chuntian (Renmin University of China)

Prof. Su-Hua Lee (National Taiwan University) (confirmed)

Prof. Yinliang Liu (Peking University) (confirmed)

Prof. Kung-Chung Liu (SMU/Renmin University of China) (confirmed)

Prof. Guo He (Renmin University of China) (confirmed)

Prof. Luo Li (Renmin University of China) (confirmed)

Prof. Yoshiyuki Tamura (Tokyo University) (confirmed)

Prof. Ichiro Nakayama (Hokkaido University) (confirmed)

Mr. Prashant Reddy (Senior Resident Fellow, Vidhi Centre for Legal Policy/External research fellow, ARCIALA) (confirmed)

Dr. Jakkrit Kuanpoth (Thailand Development Research Institute; Tilleke and Gibbins International).

Prof. Alex Fider (University of the Philippines) (confirmed)

Prof. Dr Lim Heng Gee (Faculty of Law, Universiti Teknologi MARA, Malaysia) (confirmed)

Prof. Byungil Kim (Hanyang University, Korea) (confirmed)

Prof. David Llewelyn, Singapore Management University (confirmed)

Prof. Mark Findlay, Singapore Management University (confirmed)

Hon'ble Ms. Justice Prathiba M. Singh, High Court of Delhi, India (invitation accepted, pending approval)

Hon'ble Dr. Judge Sutatip Yuthayotin (Office of the President of the Supreme Court of Thailand) (confirmed)

Hon'ble Judge Christof Schmidt (EPO Appeal Board) (confirmed)

Hon'ble Judge Kyuhong Lee (Presiding Judge, Patent Court of Korea (confirmed)

Hon'ble Division Chief Judge Chih-Hong (Henry) Tsai (previously Taiwan IP Court, currently Taiwan Shilin District Court) (confirmed)

Hon'ble Ms. Judge Ju-Chi Tsai (Taiwan IP Court) (confirmed)

Hon'ble Ms. Chief Judge Makiko Takabe (President Tokyo IP High Court) (pending approval from Japanese Supreme Court)

Hon'ble Dr. Matthias Zigann (Presiding Judge of 7th Civil Chamber, District Court Munich I (confirmed)

Format and issues of discussion:

Five roundtables will be held:

First Roundtable

Are specialised patent judges justifiable, when and how?

- Could specialised judges be seen as a preferential treatment of some legal fields over others?

How different is the view between judges and scholars?

- Would justification depend on the number of (expected) patent cases?
 - Could technical part-time judges offer a solution in countries with few cases?
- Would justification depend on the technical complexities of patent cases?
 - How specialised should judges be:
 - IP in general?
 - Patents only?
 - including trade law?
 - including commercial law?
 - competition law?
 - How is specialized judge (court) viewed (internally) by generalist judges?
- Where should patent judges come from?
 - To appoint experts with an expertise in patent matters (common law countries) or
 - To allow career judges to pursue a specialisation in patent matters?
- Are there needs to set up specialized patent court for SMEs, such as the IP Enterprise Court in the UK?

Second Roundtable

Are specialised patent judges (and representatives) desirable?

Issues to be covered:

- Should patent judges ideally have a technical background?
- Could and should technically trained persons (experts, patent attorneys, patent office officials) be appointed as part time or full time judges?
- Could technology judges and legal judges work together?
 - And which group should have the majority (Federal Patent Court in Germany sits with 3 technically qualified and 2 legally qualified judge. The EPO appeal board sits with 2 technically qualified and 1 legally qualified judge)?
- Should patent judges be assisted by
 - appointed officials from the Patent Offices,
 - ad-hoc appointed experts or
 - technical expertise provided by parties? (Prof. Luo li)
- Should specialised patent judges not rotate to other courts? In order to maintain or not to lose their technical edge?
- Would specialised patent judges become too patentee-friendly?
- Should representation in patent cases be limited to attorneys, or should patent attorneys also have the right to represent?

Third Roundtable

How are and how should court procedures be structured?

- Should cases involving patents follow the same pattern as other civil cases?
- How is the understanding of the legal or factual nature of specific questions.
 - Are the following questions legal questions not to be answered by an expert but by the judge:
 - Definition of the skilled person
 - Point of view of the skilled person

- Claim construction (Yes in Germany, no in NL)
 - Patentability including novelty and inventive step
 - Infringement including doctrine of equivalents
 - Right to sue
 - Right to be sued
 - Legal remedies in case of a patent infringement including calculation of damages
- Are the following questions of a factual nature left to be answered by fact finding, including an expert are:
- specific elements of the knowledge or experience of the skilled person
 - properties of the attacked embodiment
 - specific elements of the question of sufficient disclosure for the skilled person
- Is it useful for the court to be proactive and provide -preliminary opinions and/or guidance on the relevant points?
- What should be the relationship between the written phase(s) and oral hearing(s)?
- Are oral hearings considered useful, and, if so, on which points?
- What is the interaction between technical experts, the court and the parties?
- Where invalidity can be argued, how is the sequence or procedural steps in relation to this defence (argued before infringement?), and
- should the court always give a decision on both validity and infringement?
- Should patent decisions be appealable both on facts and on law? How well are appeal courts equipped to deal with patent issues?
- Are costs (court fees and costs of representation) an issue in patent matters, and should they be?
- What is the practice for interim proceedings in patent matters?
- Do they exist, and if so, how are they conducted in order to safeguard the interests of both parties?

Fourth roundtable

How and where can and should patent (in)validity be tried?

-Three existing models of how the defence of patent invalidity can be invoked by the defendant:

The model of absolute separation between infringement and invalidity:
Germany, Mainland China, and the European Boards of Appeal;

The estoppel model: Japan, Taiwan, Korea;

The counterclaim model: Common law countries.

What are the advantages and disadvantages of each of these models in terms of expertise, costs, duration of proceedings and providing justice to the parties?

Round table resumé, general discussion and suggestions

-Which structures or practices could be recommended for other jurisdictions, and which not?

-Lessons from non-Asian jurisdictions for Asian jurisdictions?

-Asian lessons, if any, for countries contemplating on introducing patent judges (chambers, or courts)?

Each roundtable is to be conducted in the following way:

- 1. Two-three scholars make presentations on issues of their choice from the above-mentioned issue list**
- 2. Two-three judges comment and share experiences and insights.**
- 3. Followed by a discussion of all participants.**

A word-for-word transcript will be made for the comments and discussion, which will be included in the book

When discussing the various patent judge regimes, it is helpful to bear in mind some of the divide between common law and civil law, as summarized in the following:

The divide between common and civil law

- Rule of law: rational state vs limited government
- Legal thinking: systematic vs casuistic
- Judicial function: law and order vs conflict resolution
- Source of law: statutory rules vs case law
- Role of judge: mouth of the law vs what he says is the law
- Argumentation: deduction vs analogy
- Pattern maintenance: law schools vs courts
- Court system: dualistic vs monolithic (Martin Shapiro)
- Judicial review: concentratic vs diffused (Mauro Cappelletti)
- Criminal procedure: crime control vs due process (Herbert Packer)
- Judge recruitment: career vs recognition (Nuno Garoupa)
- Judicial admin.: hierarchical vs coordinate (Mirjan Damaška)
- Judicial community: bees vs scorpions (Alexander Bickel)

Courtesy of Dr. Yeong-chin Su, Chair Professor, National Chengchi University

When preparing their respective reports to be presented during the conference, scholars are requested to do a comprehensive comparative study of relevant regimes within and without Asia mentioned above.

Expected outcome

A monograph composed of contributions (each 10,000 words) from scholars (judges are welcome but not required to make contributions) to be published by a reputable publishing company, also in open access format in 2020.