

Chronicle about

UNIVERSITY OF WASHINGTON CASRIP 2012 TRANSNATIONAL IP PROGRAM

Hosted by University of Roma Tre Law School
Rome, 19th – 23th March 2012

by

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The week of 19th March five representatives of the present edition of Magister Lucentinus were invited to attend the **Transnational IP Seminar** organized by the University of Washington Center for Advanced Study & Research on Intellectual Property (CASRIP) and University of Roma Tre held in Rome. There were invited as well several representatives from University of Roma Tre, University of Washington, University of Rome La Sapienza, Queen Mary Institute, CEIPI of Strasbourg, University of L'Aquila and Max Planck Institute. It was an excellent International Seminar that counted with the participation of the best lecturers and professors and superb representatives from all the universities and schools, including **Magister Lucentinus**. It has to be remarked the great organization of the Congress carried out by University of Washington and University of Rome Tre in collaboration with **UAIPIT**, University of Alicante.

The aim of the venue was to develop some team activities such as the negotiation of a license, the representation of a mock trial open to the public and for which was very usual to attend to different lectures given by outstanding teachers and lawyers from all over the world.

The seminar began on Monday 19th with some welcome and orientation words by CASRIP's Director **Prof. Toshiko Takenaka**. Right after, the first lecture started with **Prof. Dan Laster**, Affiliate Professor of law of University of Washington and **Prof. Francesca Maschio**, PhD, Roma Tre Law School, about "United States and European Union License Essentials". The lectures were very interesting as both focused on the difference between both systems. Prof. Maschio also covered other topics as university inventions and the importance of the recognition of moral rights of the inventor in EU law.

Some other international issues were discussed as for example: "What will happen if an employee from Italy went to work for the same company in the United States?" "What law will be applied and what happens with the invention?"

The next lecture was taught again by **Prof. Daniel Laster** and dealt with "U.S. Copyright Protection for Computer Software" most important issues. He introduced the topic by explaining some Copyright basics and then moved to software legal issues. He remarked that "Copyright law has changed so much since its beginnings in the 60s so that we can distinguish Four Generation issues". Prof. Laster reminded the importance of the International Treaties regulating this issues like TRIPS or WIPO and some important cases like *Apple v. Microsoft* or *Sega v. Accolade* in relation to Fair Use and Reverse Engineering. He also gave much importance to the new models born in

1980's (like shrink wrap), in the 1990s (like web wrap and) the most recent Open Source movement.

The last lecture of the day was about "Software Protection in the EU" and the European Directive 2009/24 where it was clarified the difference existing between US law and the European regulation. It was also debated whether copyright protection is it better that patent protection for computer programs. It was said that in the US copyright protection is much cheaper and quicker than patent protection (35 v. 10000 USD).

On Tuesday the students from all Universities were supposed to negotiate the terms and conditions of a license so, on Monday afternoon, they started its preparation in groups. The case that had to be solved was the following:

"A group of University of Rome Tre students developed a video self-learning Italian language software (ItaliSoft) using an open source software licensed under GPL version 2. They had filed U.S. and European patent applications.

Rome Tre students uploaded ItaliSoft to University of Rome Tre webpage so that incoming students can freely use the software to prepare for arriving in Italy and preparing for student life. ElettroVerde, a multi-national electronics company, has approached Rome Tre students about forming a joint venture to distribute the language software on a variety of hardware devices sold by ElettroVerde".

Tuesday's first lecture, given by **Prof. Toshiko Takenaka**, Director of CASRIP, University of Washington, was focused on "Direct and Indirect Patent Infringement". Direct infringement was clearly explained by making reference to US binding cases like *BMC Res., Inc. v. Paymentech L. P.* (Fed. Cir. 2007) or *Akamai Tech v. Limelight* (Fed. Cir. 2011). On the other hand, she made also reference to Indirect Infringement of a patent. She remarked that "when is sure there is no direct infringement, it may be is easier to prove there is indirect infringement". There were explained the two types of indirect infringement: active inducement (Specific knowledge and intent necessary) and contributory infringement (Specific knowledge).

"US and EU Copyright Fair Use" was the second lecture of the morning given by **Prof. Signe Naeve**, UW Law School and **Andrea Stazi Ph.D.**, Università Europea di Roma. The lecture started with an analysis of Section 107 of the US Copyright Act to delimitate the concept of fair use. After, Prof. Naeve exposed some interesting cases in order to decide whether some works were transformative or not. To this extent, she specially mentioned *Campell v. Acuff-Rose* case where a parody of the lyrics of the song "Pretty woman" was made. In this case US Supreme Court established the different factors that must be examined for determining if one work is transformative: purpose and character, nature, amount and substantiality, market effect...

In the afternoon took place the negotiation of the license. For two hours the participants of the seminar tried to achieve a solution consistent with the interests of both parties. In one specific group for example it was not hard to reach an equitable solution except for the economic terms of the license.

At the end of the time given to negotiate, they put everything in common with **Prof. Daniel Laster**. A representative of each negotiation team made a presentation with the goals achieved and the issues that were tougher to agree. It was an interesting exercise because there were three different solutions and agreements for the same problem.

Wednesday's morning presentation started again with **Prof. Signe Naeve** and **Prof. Stefano Sandri**, Roma Tre Law School, about "Trademark and Trade Dress Protection". The lecture started with the definition of trademark, explanation about why do we need to protect them and how to do it. They after continued with another related concept: trade dress, which may be understood as "the total image of product that identifies source of goods". It was also made clear that "since trade dress is a type of trademark, trademark criteria apply".

The second lecture of the morning consisted of an introduction to "US Patent Litigation Procedure" with **Prof. Paul Meiklejohn**, Dorsey and Whitney, LLP. Firstly, he referred to the Courts existing in the United States: State and Federal Courts. After some details about how these systems work, he explained some patent cases in particular. As he mentioned, in the US there are two kinds of patent cases: Affirmative (where the patentee is the plaintiff) and Declaratory Judgment (where the patentee is defendant). Subsequently, he highlighted the importance of claim construction in relation to its interpretation in the procedure and in the end, he distinguished between what it is decided by the jury (which are fact questions underlying legal issues) and by the judge (equitable issues like inequitable conduct, laches, estoppel, patent misuse...).

The third lecture, given by himself again, was an introduction of the hypothetical US Mock Trial that would take place on Friday. He summarized the three issues that needed to be discussed in order to defend or accuse the specific party in this procedure: "Is there direct infringement under the doctrine of joint infringement? Did Dragon actively induce infringement? Was Dragon "wilfully blind" about the existence of Husky's patent prior to receiving the cease and desist letters?"

The first presentation made on Thursday focused on "Substantive Patent Law: Claim Interpretation and DOE" with **Prof. Toshiko Takenaka** and **Dr. Tilman Mueller-Stoy**, Bardehle Pagenberg. Prof. Takenaka began explaining how the infringement of a patent must be analysed. This is done by a two step analysis that was exposed in *Autogiro v. U.S.* (Ct. Cl. 1967) case that consists of interpreting the claim language and applying the claim to the accused device to see whether every element of the claim can read on literally or equivalently. In this regard, she also mentioned the six cannons of claim interpretation and the Doctrine of Equivalents (DOE). This led into a debate between Prof. Takenaka and Dr. Mueller-Stoy as DOE is seldom applied in the US in comparison to German procedures.

Dr. Christof Karl, Bardehle Pagenberg, was the lecturer of the subsequent presentation: "Patent Litigation Procedure in Europe", very useful for both Italian and German mock trials. He explained the system of the European Patent defining it as a "bundle of national patents" and mentioned the project of creating a European patent court. Its consequence would be that "only very few European Patents are litigated in more than one country, only around 20% of the cases". After, he referred to the legal bases used in Europe like Brussels Regulation among others. Finally, he explained how to determine jurisdiction, gather the evidence, court proceedings and the existing remedies in the European regulation.

The last speaker of the morning was **Hon. Judge Sharon Prost**, U.S. Court of Appeals for the Federal Circuit, who gave a lecture about the "Roles of Federal Circuit in Patent Litigation".

Transnational IP Seminar finished on Friday 23th March with the mock trials open to the public. The case we had to solve was the following:

“Husky is a leading optical product manufacturer which sells lenses to spectacle shops in Husky Chain. Husky invented a spectacle lens supply method from he obtained U.S., German and Italian patents. All three patents include only one claim with exactly the same terms.

Husky found out its competitor located in Portland, Oregon, U.S.A., Dragon Glass MFG, supplies lenses directly to U.S. consumers using a method similar to its patented method for replacing their lenses. Although the method is the same, the procedure in which its done its different, as some of the steps are carried out by Dragon and the rest by the consumers.

Husky sent cease and desist letters with a copy of U.S., German and Italian patents to Dragon and its subsidiaries which did not stop their operations. Husky sued Dragon and its subsidiaries in U.S., Italy and Germany respectively.”

In their respective groups, the students solved the case according US, German and Italian law which showed three different solutions depending on the law applied.

The venue started with the US Mock Trial, which was presided by **Hon. Sharon Prost**, US Court of Appeals for the Federal Circuit. The instructors for the parties were **Prof. Paul Meiklejohn** and **Ms. Marian Flattery**, Flinnegan LLP. The first mock trial was represented as it would have been in a real US trial excepting for the jury, as in patent procedures in the US is the jury who takes the final decision. The mock trial began with an opening statement from each of the parties, direct examination and cross-examination of the witness and the closing statements with the final conclusions.

The German Mock Trial was presided by **Judge Dr. Klaus Grabinski**, Federal Supreme Court of Germany. **Dr. Tilman Mueller-Stoy** and **Dr. Christof Karl** were the instructors. The trial began with some complimenting words from the Judge for the statements the parties' had previously sent to him. The German trial was structured differently from the US one. Moreover, the judge had specified which arguments and issues wanted to be explained from both parties, starting with procedural matters and finishing with the substantive ones. For proving the evidence, Husky showed their website and presented a witness that was examined and cross-examined

The last trial was the Italian Mock Trial presided by **Judge Dr. Gabriella Muscolo**, Rome IP Court Instructors **Prof. Pieremilio Sammarco**, Studio Legale Sammarco e Associati and **Prof. Francesca Maschio**. This mock trial was also different among the others as Judge Muscolo applied the US procedural rules (Opening statement, direct examination and cross-examination and closing statements) but she applied the Italian intellectual property law to solve the case.

When the three mock trials finished the Judges gave a review on each procedure, praising the students for the brilliant results of the cases and mentioning the extra difficulty that involves speaking in a foreign language for the international students. This edition of Transnational IP Seminar ended with the certificates handing out and the kind thanking words of Prof. Takenaka in the closing ceremony.

To sum up, it has to be said that there were covered really important topics of United States and European Patent law that helped all the assistants to understand how both systems work. It was an excellent job of comparative law illustrated with a large number of case studies and examples framed in an international environment, which allowed a rich exchange of ideas and opinions between teachers and students.