



(RE) THINKING INTELLECTUAL PROPERTY

FUNDAMENTAL QUESTIONS AND NEW PERSPECTIVES

Comparative Study of employee invention systems in major countries (U.S., U.K., Germany, France and Japan) and Proposal of the Best Practice

Toshiko Takenaka

Professor at the Washington School of Law, Seattle (U.S.A.)

Wednesday, April 03, 2013

5.30 pm

CEIPI– Amphithéâtre 23

11, rue du Maréchal Juin BP 68

67046 Strasbourg

The conference will be held in English and followed by a debate with the audience, moderated by Yves Reboul, Director of the French section of the CEIPI. Free admission subject to availability.

Event validated by the continuing training programme for lawyers

Activity declaration number: 4267 04090 67



Abstract :

At this presentation, the speaker will examine employee invention systems in major countries. To represent common law countries, the speaker will examine the U.S. and U.K.; to represent civil law countries, she will turn to Germany, France, and Japan. Although European patent scholars and professionals have found that the different approaches taken in common law and civil law traditions prevent EU member states from finding common ground, the speaker aims to propose a model for harmonization. A paradigm of a system in the civil law jurisdiction is the German Employee Invention Act in which the public policy of labor law extensively limits the freedom of contract. In contrast, the freedom of contract governs ownership of employee inventions under U.S. and U.K. Patent Law. On its face, the U.S.-U.K. and German systems are so different that it seems impossible to reconcile their basic principles. However, France and Japan have employee invention systems that are hybrids incorporating various features from both the U.S.-U.K. and German systems and thus suggest models for harmonization.

Accordingly, the speaker will review these systems and propose a system based on the French system, which represents the best balance between the interests of employers and inventors by giving inventors incentive to invent while guaranteeing their employers enough rewards for commercialization. She will also take account of today's R&D environment, where inventors interflow beyond the traditional notion of legal entity, and propose an employee invention system, which will promote an information-sharing culture and a collaboration of researchers from academic and private sectors while facilitating IP professionals' patent portfolio management.

This presentation is based on research conducted at the CEIPI, University of Strasbourg, which led to an article co-authored with Prof. Yves Reboul. The article will be published in *IP Systems in Common Law and Civil Law* (Edward Elgar Pub. Co. 2013).

Bio :

Professor Takenaka is a Washington Research Foundation Simpson Professor of Law at the University of Washington School of Law (UW Law School), Seattle, U.S.A. She joined the UW Law School faculty in 1993 and teaches a variety of courses in legal protection of technologies. She is the Director of the Center for Advanced Study and Research on Intellectual Property (CASRIP) and Director for Japanese Legal Studies at the Asian Law Center at UW Law School. She was a visiting professor at Waseda Law School, Tokyo Japan (2004-2011) and currently holds a visiting professorship at Tokyo Medical Dental University and Osaka Institute of Technology.

Before joining UW Law School, Professor Takenaka worked as a patent prosecution specialist at a leading electronics company and worked as a patent attorney at an IP law firm in Tokyo. She has been extensively published in the field of comparative patent law and is a frequent speaker for academic and professional seminars focusing on patent law. She is on the board of editors of the JOURNAL OF INTELLECTUAL PROPERTY LAW AND PRACTICE.