★★★ ＜第21回知的財産翻訳検定試験【第10回英文和訳】＞ ★★★

≪１級課題 -知財法務実務-≫

【解答にあたっての注意】

１．問題の指示により和訳してください。

２．解答語数に特に制限はありません。適切な個所で改行してください。

３．課題文に段落番号がある場合、これを訳文に記載してください。

４．課題は２題あります。それぞれの課題の指示に従い、２題すべて解答してください。

問１　下記に示す英文の下線部を日本語に翻訳してください。

注記１　この英文は、アメリカ合衆国ワシントンＤＣ連邦地方裁判所の判決文から抜粋したものです。

注記２　この英文中に引用されている他の判決、及び文献名（例えば*Encyclopaedia Britannica, Inc. v. Dickstein Shapiro LLP,* 905 F. Supp. 2d 150, 153-54 (D.D.C. 2012)）は、訳出する必要はありませんが、括弧内に記載されている当該引用判決等の引用部分は翻訳してください。

注記３　「Id at 100.」等のラテン語法律用語は訳出する必要はありません。

注記４　"case within a case"あるいは"trial within a trial"とは、ここでは代理人の不法行為を争う訴訟の中でさらに審理される特許訴訟を意味しますが、訳出する必要はありません。アルファベットでこのまま記載してください。

以下問題文

I.　BACKGROUND

Procedural History

In 2006, plaintiff Encyclopaedia Britannica, Inc. ("EB") sued several companies for alleged infringement of United States Patent Nos. 7,051,018 (the "'018 patent") and 7,082,437 (the "'437 patent") Compl. ¶7. Both patents were held invalid in Texas District Court because of a previously unnoticed defect in an earlier patent application filed in 1993. *Id.* ¶¶10-11 & Ex. B. EB then sued Dickstein Shapiro, the law firm that had prosecuted the 1993 application on EB's behalf before the Patent and Trademark Office ("PTO"), for malpractice. EB contends that but for the defect in the 1993 application, the '018 and '437 patents would have been valid and that it would have won its infringement case. This Court has previously held that under the "case-within-a-case" principle that governs malpractice claims, EB must prove the merits of its underlying patent claims in order to show that the alleged malpractice actually caused it some injury. *Encyclopaedia Britannica, Inc. v. Dickstein Shapiro LLP,* 905 F. Supp. 2d 150, 153-54 (D.D.C. 2012). Accordingly, the parties have briefed issues relating to claim construction and questions of validity under 35 U.S.C. § 112.

While those issues have remained pending, there have been developments in patent law that Dickstein Shapiro alleges are "fatal" to EB's malpractice claim, regardless of how the disputed claim terms are construed. In *Alice Corporation Party Ltd. v. CLS Bank International,* 134 S. Ct. 2347 (2014), the Supreme Court held that claims directed to abstract ideas are not eligible for patent protection under § 101, and that "mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention." *Id.* at 2358. Dickstein Shapiro argues that applying the principles set forth in *Alice,* "the asserted claims of the '437 and '018 patents are invalid as a matter of law because they merely recite computerized implementation of abstract ideas." Def.'s Mem. in Supp. of Mot. for J. on the Pleadings Based Upon Lack of Patent- Eligible Subject Matter ("Def.'s Mot.") at 2. If true, EB cannot prove the

case-within-a-case, and Dickstein Shapiro is entitled to judgment on the pleadings. *See, e.g., Content Extraction & Transmission LLC v. Wells Fargo Bank, N A.,* 776 F.3d 1343, 1349 (Fed. Cir. Dec. 23, 2014) (affirming district court's ruling on § 101 issues based solely on the pleadings, without claimconstruction, discovery, or expert reports).

B. The Patents at Issue

Dickstein Shapiro has provided a helpful overview of the patents at issue. Because EB did not dispute this factual summary or provide an alternative, and because the Court finds it succinct and accurate, it is largely reproduced as follows.

The '018 and '437 patents both derive from the same original patent application and share a common specification. As described in the body of the specification, the invention is a computerized encyclopedia containing both textual articles and graphical images (e.g., photographs and charts). A user can search the encyclopedia by selecting one of several "entry paths" from a main menu screen. For example, the "Topic Tree" entry path allows a user to browse through a list of topics and subtopics and then retrieve articles of interest. '437 Patent at 7:13-19. The "Idea Search" entry path allows a user to enter terms to search for in the database, and then generates a list of article titles relevant to the search request from which user can select an article for retrieval. Id. at 6:61-65. And the "Picture Explore" entry path allows a user to search for pictures in the encyclopedia database, either by randomly browsing through a collection of pictures or browsing or searching through a list of picture captions and selecting a picture for retrieval. Id. at 7:4-12. As described in the specification, the invention also includes a "World Atlas" entry path. *Id.* at 7:24 32. When this option is selected, the computer will display a map of the Western Hemisphere. *Id.* at 19:19-20. The user can then zoom in on particular regions or pan the map in a particular direction. *Id.* at

19:20-26. Places on the map are marked with place names (if the "Labels" feature is turned on) and with symbols (e.g., a circle for a city or a star for a state capital) as on a conventional map. *Id.* at 19:27-30, 20:54-58. The user can select a place name (e.g., by clicking with a mouse) and retrieve a list of articles related to that place. *Id.* at 19:30 35. In addition, the user can search for a place, either by browsing through a list of place names or entering the place name in a search box to generate a list of place names. Upon selecting a place name, a map showing that place will be displayed. *Id.* at 19:60-20:14.

The specification states that other variations on the invention are possible. "More particularly, it is contemplated that this invention can be used with any information that can be stored in a database. While the present invention has largely been described with reference to an encyclopedia, other databases of published graphical or textual information could be included." *Id.* at 22:23-28.

omitted

III. ANALYSIS

"To prevail in its legal malpractice action under D.C. law, Britannica ultimately has to show, among other things, that Dickstein's actions caused it injury, i.e., that, had it not been for Dickstein's purported malpractice, Britannica would have prevailed in its ...infringement suit." *Encyclopaedia Britannica,* 905 F. Supp. 2d at 153 54. "This is the so-called 'case within a case' or 'trial within a trial' showing required for malpractice suits under D.C. law." *Id.* at 154. Therefore, if the patents at issue are invalid for reasons unrelated to the alleged defect in the 1993 application-i.e., if the patents are invalid because they are not directed to eligible subject matter under § 101 then EB cannot meet its burden of demonstrating that Dickstein Shapiro's alleged malpractice caused an injury to EB.

A. Proper law to apply

The parties agree that the Supreme Court's decision in *Alice* altered the way courts treat claims involving § 101, although they may disagree as to what extent. *See, e.g.,* Pl.'s Mot. at 9; Def.'s Opp'n at 2. However, as an initial matter the Court must decide whether *Alice* (decided in 2014) and other post-2009 legal developments are relevant to this case.

EB argues that "[t]he standard of care by which Dickstein's conduct must be judged and the standard for patentability to be applied to the '018 and '437 patents is that which existed at the time that summary judgment was rendered in the Texas District Court; namely 2009." Def.'s Opp'n at 2. This statement is half correct. EB asserts that to determine malpractice liability, "attorney's conduct is to be viewed in the context of events prevailing at the time of the alleged malpractice, not in light of subsequent developments." *Id.* (citing *Biomet, Inc. v. Finnegan Henderson, LLP,* 967 A.2d 662, 668 (D.C. 2009)). This, as Dickstein Shapiro concedes, is obviously true, for an attorney cannot be expected to make litigation decisions based on unknown future legal theories. *See* Def.'s Reply at 4 (citing *Biomet Inc*. v. *Finnegan Henderson* LLP, 967 A.2d 662, 668 (D.C. 2009) (noting that "an attorney is not expected, much less required, to accurately predict developments in the law"). But the attorneys' conduct is not currently before this Court: At this stage of a case within a case inquiry, the Court instead considers simply the whether the patents were otherwise valid.

omitted

問２　下記に示す英文は、商標ライセンス契約の抜粋です。下記注記事項を遵守して、下線部分を日本語に翻訳してください。

注記１　下線部分の翻訳に際しては、最初に“Licensor”及び“Licensee”の語を翻訳する際に、これらの用語がいずれの当事者を指し示すのか、その正式名称を注釈として括弧書きで記載してください。注釈は、“Licensor”及び“Licensee”のそれぞれの語を訳出した直後に、（注：【該当当事者の正式名称】のこと）と記載する形式にしてください。

注記２　下線部分の翻訳に際しては、下線部分ではない箇所も含めた契約全体の文脈において、整合性及び統一性が取れるよう注意してください。

注記３　下線部分の翻訳に際しては、日本語翻訳文だけを読んでも内容を正確に且つ容易に理解できるよう、日本語として自然な和訳を心がけてください。

以下問題文

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XXX Corporation

1-1-1, YYY, ZZZ-ku,

Tokyo Japan

Atten: General Manager, XXX Business Unit

November 1, 2015

Dear Sir:

This letter confirms and evidences the agreement (the “Agreement”) entered by and between you (“Licensee”) and us (“Licensor”) as of January 1, 2016 (the “Effective Date”) with respect to the terms and

conditions governing Licensor's granting of certain trademark license to Licensee and Licensee's use of such licensed trademark, as set forth below:

1. **Definition**: In this Agreement, the following capitalized terms shall be understood and construed in accordance with the definitions set forth to them below, unless otherwise provided herein:

(a) "Distribution Network" refers to the network of the physical retail shops (i.e., any online or virtual retail shops are expressly excluded for this purpose) owned and operated by Licensee within the Territory;

(b) "Marked Product(s)" refers to the Product(s) attached, directly or indirectly, with the Trademark(s) in accordance with the terms and conditions hereof;

(c) "Product(s)" refers to the cosmetic product(s) that is: (i) manufactured and distributed by Licensee for the sales of the same within the Territory under the Cosmetics Manufacture and Distribution License No. 12345 issued by the applicable Japanese government authority; and (ii) expressly approved in writing by Licensor for the purpose hereof prior to the date of this Agreement;

(d) "Term" refers to a term during which the License (as defined below) remains effective, which is specifically provided in paragraph 3.

(e) "Territory" refers to the geographical territory of Japan; and

(f) "Trademark(s)" collectively refers to the Licensor's trademark(s) registered in the Territory and the Licensor's graphics and images as set out in Exhibit A attached hereto and incorporated herein by this reference.

2. **License**:

2.1 **Grant**: Subject to Licensee's observance and performance of its obligations hereof, Licensor hereby grants to Licensee, and Licensee hereby accepts, a limited, personal, non-alienable and non-

exclusive (except for the exclusivity set forth in the following paragraph) license (the "License") to: (a) manufacture the Marked Products in the Territory strictly in compliance with the style restrictions and guidelines provided by Licensor from time to time; (b) distribute the Marked Products in the Territory solely through the Distribution Network and only for the sales of the Marked Products in the Territory; and (c) promote the Marked Products in the Territory using the Trademarks with Licensor's prior approval and in compliance with the marketing restrictions and guidelines provided by Licensor from time to time, during the Term, on the terms and conditions as set forth herein.

2.2 **Exclusivity**: Without prejudice to the generality of the "non-exclusivity" set forth in the preceding paragraph, the License granted to Licensee hereunder shall be an exclusive license such that Licensor will not, without first obtaining Licensee's consent, grant any party a license to use the Trademarks for the distribution of the reasonably same products as the Products in the Territory.

2.3 **Reservation**: Any and all rights in and to the Trademarks not explicitly licensed hereunder shall be reserved to Licensor, and constitute a part of the Licensor's exclusive property. For clarity, such Licensor's reserved rights shall include without limitation the right to grant a license of any trademark owned or controlled by Licensor (including the Trademarks) to any third party for use in respect of any products in a manner not in conflict with the exclusivity of the License hereof, and the right to use any Trademark on its own in any manner and form in any territory including the Territory, whether or not such use is competitive with Licensee's use of the same Trademark. In no event shall the License hereof impose upon Licensor any obligations or restrictions in respect of any Trademarks other than those explicitly set forth herein.

omitted

6. **License Fee**: In consideration of the License granted hereunder, the license fee (the "License Fee")

comprised of (i) the following flat license fee (the "FL Fee") and (ii) the following running license fee (the "RL Fee") shall be payable by Licensee to Licensor pursuant to the payment terms hereof:

(a) The FL Fee shall be in the amount of USD 12,000.00, which shall accrue upon the signature by Licensee on this Agreement; and

(b) The RL Fee shall be the product of USD 0.20 multiplied by the total number of the Marked Products manufactured throughout the Term, which shall accrue upon the manufacture of the Marked Products.

7 **Payment Terms**:

7.1 Licensee shall pay to Licensor the License Fee plus any tax (if applicable) in accordance with the payment terms as set forth in this paragraph:

(a) The FL Fee shall be paid to Licensor in a number of installments equal to the number of calendar months included in the Term (e.g., if the Term includes 12 calendar months, then 12 installments shall apply). The first installment shall be payable no later than the last day of the calendar month during which the Effective Date occurs, and the second and any subsequent installments shall be each payable no later than the last day of the calendar month that immediately follows the calendar month during which the immediately preceding installment was due.

(b) The RL Fee shall be paid to Licensor on a monthly basis for each calendar month of the Term. Each monthly amount of the RL Fee shall be calculated pursuant to paragraph 6(b) using the total number of the Marked Products manufactured during the subject calendar month, and shall be payable on or before the last day of the calendar month that immediately follows such subject calendar month.

7.2 All payments required hereunder shall be made to Licensor in US Dollar, by wire transferring the applicable amount plus any applicable taxes to the bank account designated by Licensor no later

than the due date(s) set forth herein, and shall be made in full without any deductions, counterclaims or other forms of credits or offsets that Licensee may have or claim to have against Licensor. Any and all costs and expenses for making the payments to Licensor (including without limitation remittance fee) shall be borne by Licensee.

omitted

If the foregoing correctly states our understanding, please sign and return one counterpart hereof to the undersigned, whereupon this Agreement will become a binding agreement between us in accordance with its terms.

Very truly yours,

AAA Company Ltd.

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Agreed and Accepted to:

XXX Corporation

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