HIROYA KAWAGUCHI,

The Essentials of Japanese Patent Law

Kluwer Law International 2007, xix and 294 p., 122 €.

Few fields of Japanese law are more important to foreign practitioners than intellectual property, and patents in particular. More than 30.000 foreign patent applications are filed in Japan every year, and the enforcement of patent rights is an integral part of business strategy in a country where innovation substantially contributes to economic success.

While Japanese law on intellectual property is well-covered by an almost innumerable number of commentaries, textbooks, student guides, Q & A manuals and monthly reviews in Japanese, there is a certain dearth of reliable information in foreign languages for this field,[1] perhaps not much different from most other fields of Japanese law.

Publishers of books on Japanese law in English are faced with the question whether the foreign reader would be better served by a book written by a foreigner with knowledge of Japanese law, or a Japanese expert in this field. While foreigners are more aware of the peculiarities of Japanese law when compared to other jurisdictions, Japanese experts would know more about practical aspects, in the patent field particularly the practice of the Patent Office, and decisions of the courts.

On the face of it, Mr. Kawaguchi would therefore appear to be a good candidate to write, as the preface promises, "as systematic and concise analysis" of Japanese patent law. Yet the result is an example of how a book on Japanese law should *not* be written.

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1 While the reader of German is admirably served by HINKELMANN's „Gewerblicher Rechtsschutz in Japan", 2nd ed. 2008, and readers of Korean can draw on good translations of many Japanese textbooks in this field, works in English are more limited. The reader's attention is drawn to:

- K. PORT, Trademark and Unfair Competition Law and Policy in Japan, Kluwer 2008;
- RÖHL (ed.) History of Japanese Law since 1968 (containing the history of Japanese IP law on p. 402 - 542 (Heath/Ganea)), Brill 2005;
- GANEA / HEATH / SAITO, Japanese Copyright Law, Kluwer 2005;
- C. HEATH, The System of Japanese Unfair Competition Prevention Law, Kluwer 2001.
- K. PORT, Japanese Trademark Jurisprudence, Kluwer 1998;

The translation of a good many Japanese decisions on intellectual property can be found in the International Review of Intellectual Property and Competition (IIC), and in the Japanese AIPPI Journal (English Edition). IP related news can also be found in the English-language Japanese journal Patents & Licensing, and in some newsletters, e.g. the one published by Yuasa & Hara. A translation of the intellectual property laws and the Patent Office Guidelines has thankfully been undertaken by AIPPI (industrial property) and the Cultural Research and Information Center (CRIR) (copyright).

Style. A reader unfamiliar with Japan will already find the citation of decisions (just as an aside, literature is not cited at all) rather puzzling, eg "Tokyo H. Ct. Heisei 9-7-17, Titekisaisyu 29-3-365" (fn. 26 on p. 73). While a Japanese reader is used to indications of dates in Japanese style, a foreign reader may find it an interesting exercise of mathematical calculation to figure out that the footnote refers to a decision of the Tokyo High Court of 17 July 1997 published in a collection of IP decisions (Chiteki zaisan hanrei shu, in short: Chizaishu) vol. 29/3 on page 365. Those familiar with Japanese will slightly shudder about the Kunrei transcriptions used by the author ("Titeki saisyu" instead of the Hepburn transcription "Chiteki zaishu", "Syowa" instead of "Showa") that smack of Japanese imperialism and will not get a Tokyo visitor very far when asking for the subway station "Sinbasi" instead of, as it is actually pronounced, "Shinbashi". Finally, the English is sometimes innovative ("contrariwise", p. 5) and sometimes outright incomprehensible ("Claim for reinvesting of a right to a patent in the legitimate proprietor", p. 51; The proviso 'does not take effect' "is interpreted to mean unenforcability (sic!) only against the Patent Office because we find no substantial unlawful elements in omission of the declaration except the need for a procedural purpose on the part of the Patent Office.", p. 56; "the concept of 'infringement of right' has been subsumed in 'negligence'…", p. 11).

Structure. The book contains two parts: Substantive law in part one and procedural law in part two. The latter part explains the application, examination and appeal procedure, while the first part deals with everything else. While the part on procedure is relatively straightforward and in chronological order of procedure, the part on substantive law is often difficult to follow. Both chapters 2 and 3 deal with the issue of the right to a patent. Chapter 2 refers to employees' inventions while chapter 3, incomprehensibly labelled "civil remedies for infringement", concerns the question what can be done if a third party has misappropriated an invention and then filed for a patent. The matter is not helped by the fact that the issue "rights to a patent" is also addressed in chapter 1 subch. 2. Chapter 4 refers to the effect of a patent, chapter 5 to infringement. Particularly chapter 4 is so confused in structure that one doubts whether the author has really understood the subject matter. Chapter 4 subch. 1 deals with "protected activities" and lists repair/parallel imports/exhaustion, while subch. 3 deals with limitations such as experiments or research. Since also exhaustion and repair are limitations of the right to exclude others, the distinction is not clear at all. Subch. 2 deals with the subject matter of a patent, and starts with claim construction and file wrapper estoppel, while the doctrine of equivalents is dealt with in chapter 5. As the file wrapper estoppel in Japan is an integral part of the equivalents doctrine, one wonders what the logic behind the structure actually is. According to the author, "The negative effect [covered in chapter 5] is broader than the positive effect [covered in chapter 4] since constructive infringement covers activities and subject matter beyond scope of positive effect" (p. 99) – come again?

Contents. Also content-wise, the book is not entirely satisfactory. The second part is mostly a cut-and paste of provisions from the Patent Act and misses the opportunity to tell us more about the examination practice (eg., how often would the Patent Office de facto allow claims to be amended; when can the first office action be expected, p. 190), and about differences between application procedures in Japan, and in other major countries (eg.: the differing approach towards the combination of priorities,[2] p. 184). In some cases, some detail on issues of particular interest to foreigners would have been helpful: when dealing with foreign language filings, p. 204-210, it is unclear to what languages this refers to, and if only to English (as the author seems to assume on p. 205), if this would not give rise to interesting questions of a discrimination issue under TRIPS. On the other hand, do we need a section on the right of minors and persons under guardianship to file for a patent (p. 156)?

The first part of the book often contains information that is either wrong (Patent rights "are absolute in that they are enforceable throughout the world", p. 7), questionable ("a parallel import is in most cases infringing because the patent holder in a foreign country normally imposes specific conditions that the import of the product into Japan is prohibited if so intended", p. 3 – since 1997, no such case of a restriction has come to the courts) or imprecise ("a right to a patent may be protected under Unfair Competition Law for injunction and damages", p. 47. The author refers to trade secret protection, but that does not always help in cases of misappropriation, and one wonders what kind of injunctive relief the right owner could ask for). Often, one would have wished to obtain more information (there has been a rather detailed discussion in Japan on what is considered an unpatentable method of medical treatment, but p. 25 mentions nothing in this respect; it would have been interesting for a foreign reader to know what kind of information the Patent Office needs to register a license, yet no information is provided thereof; the whole chapter on technology transfer (135-139) is rather concise).

One could go on with the shortcomings of this book. What is really a pity is that the book is a missed opportunity to present a complicated field of Japanese law to a foreign audience, and gives rise to the mistaken impression that Japanese academics and practitioners are unable to write a comprehensive and well-structured book on this subject matter. Fortunately enough, Japanese books on patent law by *Yoshifuji, Nakayama, Tamura* and *Shibuya* prove the opposite. If only one of these works would be rewritten in English for the needs of a foreign audience.

Christopher Heath

2 See the article by SHIBATA and INOUE, The partial priority system under the "umbrella theory", 2008 AIPPI Journal of the Japanese Group, International Edition 275.