

**KLAUS HINKELMANN, *Gewerblicher Rechtsschutz in Japan***

**Carl Heymanns Verlag, Cologne 2004, 564 p., Euro 168; ISBN 3-452-26622-1**

The last comprehensive book on Japanese industrial property written in German dates back to 1926 and was authored by a Japanese practicing attorney as his Ph.D. thesis at the University of Hamburg.<sup>1</sup> A number of works have been published in English,<sup>2</sup> yet many of them are out of date. And a good number of articles about new developments are available, but they certainly cannot replace a systematic work.<sup>3</sup> Writing the latter is difficult not only because of the language barrier but also because of the wealth of material that has to be taken into account. It fell upon *Klaus Hinkelmann*, currently a patent attorney in Munich and previously a member of a three-year German BASF delegation to Japan, to tackle this difficult and laborious task. The result speaks for itself.

*Hinkelmann's* book of 553 pages plus an index covers a lot of ground in five chapters: patents, utility models, designs, trademarks, and unfair competition prevention. The book is written primarily for the practitioner and mostly omits historical developments or doctrinal discussions. It is focused on details of the application procedure and the use and enforcement of industrial property rights.

The longest and certainly most important chapter on patents takes up more than half of the book (p. 1-323). The author starts off with the requirements of patentability, describes the granting procedure in great detail, and concludes with some remarks on claim interpretation and enforcement. The author often and most helpfully compares Japanese concepts with those of Europe (*e.g.*, inventions for certain types of industry, 6-13; novelty and grace period, 34-36; application requirements, 88-91; examination request, 118; claim amendments during the examination procedure, 138-147). The text provides impressive reading not least through the thorough analysis of the examination guidelines and the relevant court cases. The latter also allows a detailed description of the law and practice on employees' inventions (162-172) and the interpretation of claims (232-266). Generally speaking, *Hinkelmann* as a patent attorney excels in describing issues related to the application procedure.

Relatively limited space is given to utility models (327-340) and designs (341-378). Both are of limited economic interest to foreign applicants. One special feature of design law is the substantive examination (353-356).

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1 H. IIZUKA, *Deutsches Industrierecht* (Hamburg 1926).

2 On patents: TANABE / WEGNER, *Japanese Patent Law* (Washington 1977); on trademarks: K. PORT, *Japanese Trademark Jurisprudence* (London 1998); on unfair competition prevention: C. HEATH, *The System of Unfair Competition Prevention in Japan* (London 2001).

3 *E.g.*, AIPPI Journal of the Japanese Group, English edition; Patents & Licensing; Yuasa & Hara Intellectual Property News; Japanese Intellectual Property Journal; Japan Patents & Trademarks (Suzuye Report).

Trademarks are dealt with in great detail (381-518), and justifiably so. One important feature of the application procedure is the substantive examination of prior conflicting rights, which the author already mentions in the introduction. The trademark chapter is also written in a concise and readable style, again with an emphasis on practical issues (e.g., the protection of three-dimensional marks with secondary meaning (406-408) or the determination of similarity between signs (414-434, 471-476). The remarks on the protection of well-known marks that have been registered in Japan by unrelated third parties may be a bit too concise: Here, Japanese jurisprudence increasingly holds these marks to be unregistrable because they contravene the *ordre public*, even in the absence of consumer confusion. The abuse of trademark rights is dealt with more broadly (483-490, 493-500). The relationship between trademarks and domain names is explained in great clarity (479-480, 537).

The book concludes with a short chapter on unfair competition prevention law (520-553), particularly the protection of non-registered signs.

An index and a comprehensive table of contents at the beginning of each chapter complete the work and help the reader find the relevant subject matter.

Here and there, one encounters slight inconsistencies or omissions, yet this is nothing out of the ordinary for a book of such length. All in all, *Hinkelmann* has presented a comprehensive, detailed, well-researched, and readable work that can be highly recommended.

*Christopher Heath*