REZENSIONEN / REVIEWS

BERND HANSEN / DIRK SCHÜSSLER-LANGEHEINE (eds.), Patent Practice in Japan and Europe – *Liber Amicorum* for Guntram Rahn

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The *liber amicorum* is a tribute to an outstanding academic and legal practitioner. Among other accomplishments, Guntram Rahn is the author of the famous book *Rechtsdenken und Rechtsauffassung in Japan* (1990), a work of extraordinary academic profoundness and an invaluable source of information for those who strive for a thorough understanding of Japanese legal tradition as well as reception and adaptation of foreign law. The editors, two patent practitioners and colleagues of Guntram Rahn, have gathered 63 contributors from Europe, Japan, South Korea, Taiwan, and the US, an impressive number that demonstrates the popularity Rahn enjoys within the international patent community. Moreover, the list of authors reads like a "Who's Who" of the patent scene – it comprises not only legal practitioners but also academics, high-ranking officials from national patent offices and the EPO, as well as Japanese and European judges.

The book contains eight chapters on patent prosecution, several aspects of litigation, and various areas of substantive law, such as patent protection for pharmaceuticals, employee's invention law, and utility models. Geographically, it covers Europe (with a focus on Germany), Japan and, to a smaller extent, the US. Many articles, however, deal with specific topics in a comparative manner, so that even an article on Japan may contain valuable information about the situation in the US or Europe.

The emphasis on "patent practice" in the title implies that the book is mainly intended for specialized litigators and patent attorneys. In fact, however, the coverage of the book is much broader. It comprises numerous articles that suit the needs of an academic readership with an interest in innovation history, legal thinking, institutional environment, and public policy issues. One of these articles is Harald Baum's and Moritz Bälz' introductory contribution to Chapter I on "General Questions." This explores the cultural, institutional, and historical aspects of Japanese litigation practice in great detail, and includes a historical overview of Japan's litigation history from the Edo Period until present-day Japan. Eiji Katayama's interdisciplinary observations on recent Supreme Court cases are also very instructive, showing that especially in patent-related decisions, the Supreme Court is increasingly assuming the role of policy maker, whereas decisions in other legal areas continue to be rather non-political. Alexander Grigoriev outlines the

Eurasian Patent System, a relatively young regional patent administration. Two further articles contributed by Masatake Shiga and Ryo Tokunaga present an overview of the economic role of the Patent System during Japan's post-war recovery until today, including current attempts to set the course for further developments of the patent system to serve the interests of the Japanese industry and public. Shozo Uemura's and Hiroshi Kato's contribution on the Japanese IP policy and patent history concentrates on the post-war period through present-day Japan. Hanns Ullrich concludes the first chapter with an article on a much-debated issue, namely the future European and EU Patents Court and its interdependence with the European Court of Justice.

Chapter II on "Patent Prosecution and Patentability Requirements" deals with several aspects of patent application, examination, grant, and invalidation. Three contributions – two written by patent attorneys Yuriko Hamada and Ryo Iwatani and one by Toshiaki Iimura, presiding judge at Japan's Intellectual Property High Court – deal with the comparably strict Japanese requirements with regard to full disclosure and support of the patent claims by the description and embodiments. Iwatani's article points to the specific danger that the priority of a prior foreign application may be denied in countries of subsequent application with stricter standards regarding full disclosure. Two further articles deal with patent prosecution in the EPO: Willem A. Hoyng discusses the present treatment of undisclosed and disclosed disclaimers in patent applications as a means of demarcating the claimed subject matter from the prior art. David Lethem advises proprietors and opponents on how to succeed in EPO opposition proceedings, *inter alia*, with regard to the style of written pleadings and demeanor in the course of oral hearings. Shoichi Okuyama identifies a new trend toward right owner-friendliness in recent IP High Court case law with respect to complaints against Japanese Patent Office decisions; for instance, the court enhanced the prerequisites for establishing non-patentability due to insufficient inventiveness. Harold C. Wegner concludes the chapter with a strong plea for an enhanced openness toward patent eligibility of subject matter pertaining to newly emerging areas of technology, also by rethinking the traditional patentability prerequisites.

Chapters III through V cover three aspects of patent litigation, namely litigation systems, procedural aspects, and substantive law. In his introductory article to Chapter III ("litigation systems"), Christian Gassauer-Fleissner observes an increasing convergence of Austrian and German patent case law and highlights, *inter alia*, a tendency among courts in both countries to refer to each other's decisions. Peter Meier-Beck outlines the comparably strict German separation between invalidation procedures and infringement procedures. It should be noted that in this particular regard, important Asian countries, where patent laws are traditionally shaped according to the German model, tend to deviate from German principles: Japan, China, and South Korea have enhanced the possibilities to challenge the validity of the plaintiff's patent during infringement proceedings. Michael Ritscher completes the observations on German-speaking countries with an article on the coming Swiss Patent Court. Jay Young-June Yang, Dae-Woong Noh, and

Martin Kagerbauer conclude the whole chapter with valuable insights into the Korean litigation system, including observations on the fading separation between infringement and invalidation proceedings.

Three articles in Chapter IV on procedural aspects of patent litigation deal with the various national approaches toward a balance between the alleged infringer's interest in the protection of his know-how and the plaintiff's interest in gathering evidence. Takanori Abe's and Li-Jung Hwang's contribution outlines the adaptation of US-style protective orders in Japan and Taiwan. Trevor Cook treats the same topic from a UK perspective, and Dirk Schüssler-Langeheine contributes an article on the situation under German law. Two articles deal with nullity proceedings: Thorsten Bausch provides detailed insights into the new German nullity procedures and suggests modifications to further accelerate the procedure. Klaus Füchsle and Kathrin Füchsle deal with a specific aspect of nullity procedures, namely the circumstances under which the Federal Court of Justice in appeal cases and the Boards of Appeal of the EPO accept amendments to the claims of the disputed patent. Two further contributions deal with pre-litigation measures: Frank van Bouwelen presents Netherland's new seizure proceedings regime and its compliance with the EU Enforcement Directive, and Gérard Portal provides detailed insights into the French system of preliminary measures, a legal instrument so strong that it did not have to be amended to ensure its compliance with the corresponding provisions of the Enforcement Directive. Kazufumi Dohi identifies an increasing responsiveness of the Japanese legislature toward the introduction of an instrument similar to the German *Patentvindikation*, mainly due to enhanced joint research activities and the increasing necessity to protect inventors against usurpation of their inventions. Meanwhile, the legislature has introduced such instrument in the course of the Patent Act amendment of 8 June 2011. Wolfgang von Meibom and Christian Harmsen outline the German practice with regard to a legal instrument that enjoys high popularity in East Asia, namely declaratory actions of non-infringement. With regard to Germany, however, they identify comparable strict legal requirements as one reason for a persistent reluctance to resort to this instrument. Hiroshi Morita compares Japanese, US, and European courts with regard to their eagerness to assume jurisdiction in cases in which disputed subject matter is a foreign patent. He arrives at the conclusion that Japanese courts are most likely to affirm jurisdiction.

The third litigation-related chapter on "substantive law" contains a number of articles on patent claim interpretation: Gérard Dossmann outlines the practice of patent scope determination in France. Niels Hölder points to a not yet sufficiently answered question with regard to the application of the equivalence doctrine, namely at which point in time (e.g., priority, grant, infringement?) the fictional skilled artisan must have been able to accomplish the invention by equivalent means. Thomas W. Reimann raises the question of how far the prior art cited in the application documents shall be taken into account when determining patent claims. Three articles are dedicated to a much-debated topic: the exhaustion of industrial property in Japan. Ryôichi Mimura presents a detailed over-

view of Japanese case law on patent exhaustion, including the landmark "BBS" decision, which dealt with parallel imports, and more recent case law on the permissibility of recycling and reselling disposable products. Whereas Mineko Mohri's article also deals with the exhaustion of patents in disposables from a comparative perspective, Christopher Heath's contribution is related to another area of industrial property, namely trademarks and recent case law on trademark exhaustion. His actual remarks on exhaustion are preceded by a tribute to of Guntram Rahn as the former head of the Japan and East Asia department at the Max Planck Institute in Munich, with reminiscences of the institute's "Golden Age" when linguistic and regional expertise were still held in high regard. Makoto Hattori's article highlights the difficulty of determining infringers in cases in which various parties contributed to a patent infringement in different ways. He supports the introduction of a new type of infringement in addition to well-established infringement forms (such as contributory infringement), the so-called "control-type direct infringement." Atsushi Kawada explores the commonalities and differences between Japanese and German regulations on the compensation for uses of the invention during the publication period. Yukio Nagasawa compares Japanese and US practices with regard to reliance on technical experts in patent-related court litigation. Two more articles focus on patent enforcement in Germany and Europe: Simon Klopschinski deals with the much-debated question whether and to what extent border measures against transiting goods that incorporate the IP of European right holders can be regarded as legitimate. Thomas Kühnen explains the circumstances under which German law regards a product as being "directly" obtained by a patented process.

Chapter VI is dedicated to pharmaceutical patents. Giuseppe Bianchetti's introductory article highlights the difficulties of fulfilling the "sufficient disclosure" requirement with special regard to pharmaceutical inventions. Three articles deal with patent term extension in different legislations: Marc Dernauer outlines new Japanese case law that facilitates the application for a second patent term extension for the same or another patent for a pharmaceutical invention. Frank-Erich Hufnagel and Matthias Kindler highlight different aspects of European Supplementary Protection Certificates (SPC), the former the similarity of an SPC with a patent in terms of comprehensive protection against all uses as pharmaceuticals, the latter the emergence of new obstacles to obtaining an SPC imposed by recent ECJ and national court decisions. Andreas von Falck's and Miriam Gundt's article identifies a trend toward a European harmonization with regard to second medical use claims, *inter alia*, due to the Enlarged Board of Appeal's G 02/08 decision. Two further articles discuss the greater socio-economic environment of the pharmaceutical industry. Bernd Hansen's "provocative thoughts on the patenting of new pharmaceuticals" make a strong plea for rethinking the application of the inventive step requirement to pharmaceutical inventions in the same manner as it is applied to inventions in other fields of technology. Regarding even small technical developments in this particular area as "obvious" would in most cases turn out to be inappropriate, as even such small developments could hardly be conceived without inventive endeavor by

a person skilled in the art. Paul N. King outlines the negative effects President Obama's health care reform ("ObamaCare") had in his opinion on the pharmaceutical industry in terms of increased government involvement in marketing approval, price control, and a higher risk of firms and managers to be prosecuted for new forms of misconduct. Hajime Tsukuni concludes the chapter with a comparison of Japanese, Chinese, Taiwanese, and Korean law and practice, *inter alia*, with regard to surgical and therapeutic treatment, novelty and non-obviousness requirements, medical use inventions, patenting of genetic inventions, patent term extension, and trademark protection.

Chapter VII deals with employee inventions, an area in which recent Japanese case law on employee remuneration gave rise to heated debates and new legislation. Peter Klusmann questions the *raison d'être* of the German Employees' Inventions Act, not least due to remaining bureaucratic obstacles even after the 2009 amendment. Shoji Matsui gives an overview of the recent developments in Japan and bemoans that employee remuneration has become a matter of court decisions rather than of consent between employer and employee. Anja Petersen-Padberg presents Japanese and German remuneration schemes in great detail and advises German companies that employ inventors in Japan and *vice versa* with regard to the foreign application of domestic rules and company guidelines.

The last Chapter VIII deals with utility model protection in Russia, Japan, and Germany. Vladimir Biriulin's article highlights remaining institutional and legal insufficiencies after the incorporation of all legal rules on IP in Part IV of the Russian Civil Code. With regard to Japan, Masashi Kurose observes a declining importance of utility models in general, whereas SMEs, however, would still attach considerable importance to this kind of intellectual property protection, as well as bigger enterprises faced with an increasing need to protect their incremental innovation against imported counterfeits from neighboring Asian countries. Henrik Vocke's concluding article deals with the continuingly high importance attached to utility models in Germany, not only as cheaply and quickly available substitutes for patents, but also as a strategic tool in addition to patent protection.

The book ends with closing words by Motoaki Suzuki, who expresses his respect and gratitude to Guntram Rahn for building bridges between Japan and Germany.

Due to the high number of contributions and the broad coverage, the book is a treasure trove for practitioners and academics in search of answers to current patent-related questions. Especially the contributions on Japan form an invaluable resource, as non-Japanese speakers still find it difficult to access Japanese patent information. If one were to extract all the Japan-related articles, assemble them in a smaller volume titled *Handbook on Present Patent Practice in Japan*, and add an index, the new book would have a good chance of becoming a comprehensive standard treatise on current Japanese patent law. A *liber amicorum*, of course, cannot offer an index, a list of cited cases, and the like. Finding an answer to a specific question, therefore, remains a bit of a challenge, but due to the abundance of topics treated in great depth, the chances that an answer will finally

be found are very high. The book is definitely a worthy capstone to an exceptional professional career and a must for patent practitioners and academics with an interest in patent systems in Asia and throughout the world, even for those few who have not yet heard of Guntram Rahn.

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