

PATENT PRACTICE IN JAPAN AND EUROPE

*Liber Amicorum
for Guntram Rahn*

EDITED BY BERND HANSEN
AND DIRK SCHÖSSLER-LANGEHEINE



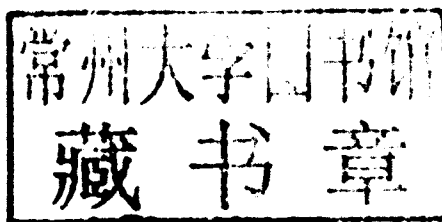
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Edited by:

**Bernd Hansen
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For Guntram Rahn
with Best Wishes

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Preface

At the end of 2010, Dr. Guntram Rahn concluded a brilliant career as an attorney-at-law, arbitrator, lecturer, litigator and as an expert in Japanese civil law with a particular focus on intellectual property protection in Japan.

Guntram has met, accompanied and sometimes confronted many “travel companions” on his long journey through the maze of corporate strategies, legal thinking, laws, directives, regulations and established case law, and a good many of these wanted to honor Guntram’s professional achievements by contributing to this *liber amicorum*. This publication is therefore a reflection of the high esteem in which he is held by the legal circles in Germany, Japan and beyond, and most especially by the authors of this book.

We the editors of this work as partners at Hoffmann · Eitle are not, however, just “travel companions”, but have over the years come to regard Guntram Rahn as a very dear friend. We are therefore quite aware that celebrating his achievements in public might embarrass him as he has a very humble nature, and it is not his style to pat himself on the back or allow others to do so on his behalf. Hence, this book has been created in all secrecy. Every communication regarding this project was handled using the code word “Musashi” and the authors and contributors readily agreed not to use Guntram’s name in their correspondence. And, everyone also agreed that they would not breathe a word about this project to him when working or meeting with him.

The code name “Musashi” has not been selected arbitrarily. The great samurai Miyamoto Musashi (1584-1645) was famous for his innovative and accomplished two-handed sword dueling style, an unsurpassed skill he developed undoubtedly as a consequence of deep reflection, steady resolve and diligence in his craft. When Miyamoto Musashi held a long sword in his right hand and a short sword in his left, no one in his lifetime could get even close to his masterly skills, and this assured that he was never defeated.

Some years ago Guntram Rahn's wife Mary, a graduate of the Tokyo University of the Arts, painted a picture of this respected warrior and presented this to her husband. The painting of Miyamoto Musashi, which is also depicted in this book, enjoyed a prominent place on one of the walls in Guntram's office.

Guntram reported in one of his lectures that John Henry Wigmore, the reputable US jurist who acted as foreign advisor to the Japanese government in the Meiji era, liked to refer to Miyamoto Musashi in his informal after-dinner speeches. Wigmore likened the traditional spiritual and moral heritage of Japan to the short sword style, and Western learning to the long sword style. It is said to have been Wigmore's idea that Japan, in order to become really great, must master Miyamoto's two-sword style. Guntram has extended Wigmore's allegory to characterize the challenge to lawyers, taking the long sword as a symbol for legal knowledge and expertise, and the short sword as a symbol for such soft skills as empathy and the ability to anticipate what the adversary or the court might think and do. According to Guntram, one needs to master the two-sword style as Musashi once did to become an excellent lawyer. There is no doubt that he is right, nor is there any doubt that he has done just that.

The fundamental qualities underlying skilful swordsmanship are still valuable in today's world. Indeed, these qualities appear to be just as valuable as they were in the 17th century: uncompromising discipline, deep reflection and circumspection, deliberate and meticulous preparation as well as an honorable fighting spirit. Guntram has continually displayed all of these qualities in his legal battles, be it when representing Japanese corporations in Europe or during his representation and tenacious defense of foreign corporations in Japan.

Guntram's formidable qualities have also been reflected in the representation and complex coordination of clients' needs in cross-border litigation all over Europe to enforce their patents or to clear the way for their products. Whether these lawsuits represented retro-reflective sheetings, consensus interferons, polymer nucleation agents or four-blade razors, Guntram used his legal background, dedication and willpower to fully understand such sophisticated technologies.

The central theme throughout his life, however, has always been his connection to Japan. Born to German parents, Guntram attended school in Japan, where he and his parents were living at that time. He then studied law and Japanology at the University of Hamburg in Germany, but after graduation and qualifying as an attorney-at-law, he returned to the country of his adolescence with a scholarship from the Japanese government, where he dedicated three more years to studying Japanese civil law at the University of Tokyo. His fourteen years of education in Japan left him with an excellent command of the Japanese language and he can speak, read and write the language fluently. His subsequent doctoral thesis "Legal Thought and the Concept of Law in Japan" was awarded the Prize of the Faculty of Law of the LMU Munich, and to this day this thesis is still a must for all who can read German and are truly interested in studying Japanese law.

Guntram Rahn's professional life has encompassed two main phases of approximately the same length. From 1975 to 1992 he headed the Japan and Far East Department at the highly reputed Max Planck Institute for Foreign and International Patent, Copyright and Competition Law in Munich. And then, of course, he spent

fifteen years as a partner at Hoffmann · Eitle, where he successfully developed the Legal Department up until his retirement at the end of 2010. In addition to this impressive CV, he was also a lecturer at the WHU Koblenz School of Graduate Management (1998-2002) and organized numerous seminars and conferences throughout Europe and Japan at which he presented notable lectures that contributed to the understanding of the laws and practices as well as the relations between both of his home countries.

It is therefore with great satisfaction that we thank the many authors from all over the world who have agreed to submit their scientific contributions to this book and to honor Guntram Rahn in this way. Each of the authors has shared Guntram's mission in his or her own unique way: To enrich their countries by stimulating a more in-depth dialogue between not only the legal practitioners of each country but also the people to bring about a closer understanding and respect for what each country can offer by way of its heritage, expertise, innate values and traditions.

This mission will not be abandoned with the conclusion of Guntram Rahn's career as an attorney-at-law. Guntram has said that it is a good thing to change one's professional focus once in a while, and that after fifteen years as an attorney-at-law the time has come to turn to new challenges. We look forward with anticipation, but also with great impatience, to witnessing the materialization of his book projects. We understand that Guntram now intends to contribute even more to enhancing the understanding of Japan and its culture in Germany, and this will be of great benefit to us all.

It seems that Miyamoto Musashi also changed his professional focus after a fifteen-year period. It is reported that he started sword fighting at the age of 14 and by the age of 29 had already won more than 60 fights. At this point, he turned to perfecting his skills and mastering *bushi-dô*, the Way of the Warrior. This included at the time a dedication to the fine arts, Buddhist teachings and other activities that were considered essential to achieve perfection. He also wrote "The Book of the Five Rings" (*Gorin no sho*) that is still quoted today. Thanks to this work, we have a good knowledge of the techniques and skills that made Musashi so exceptional in his day, and we hope that also Guntram Rahn will use his extensive knowledge and wisdom to further benefit the generations to come.

We do not want to conclude this foreword without expressing our deep appreciation to Mary Rahn, Guntram's artistic wife and life companion, who has selflessly offered her enormous support continually throughout their marriage. Her love and encouragement have allowed Guntram to pursue his long, active and very successful career. We also wish to thank her for passing her "artistic genes" to their daughter Ayumi Rahn who has become a painter and is presently living in Berlin. Ayumi was quite honored to be asked to contribute the portrait of her father that you will find in this book. It should be noted that Guntram's son Marein Rahn is following in his father's footsteps and is presently studying at the University of Tokyo.

Bernd Hansen, Dirk Schüssler-Langeheine
May 2011

Editors' Note

The core aim of this book is to provide a compilation of the current issues regarding the laws and practices in intellectual property in Europe and Japan. Thus, the articles handle subjects such as the procedural implications of litigation, international jurisdiction, doctrines of exhaustion, utility-model systems and practice, employed inventor's compensation, as well as the special aspects of pharmaceutical patenting such as obtaining supplementary protection certificates. Many of the articles also include a comparative analysis of the laws and practices in both geographical regions or deal with the same legal issues but in different jurisdictions, such as the USA and Korea.

To achieve our goal and to present a variety of views, we selected authors from many different countries. In order for all of these contributions to be understood world-wide, the book therefore had to be in the English language. Thus, most of the authors had to express themselves in a language that is foreign to them. We are most grateful to those contributors who graciously accepted this additional complication.

Some aspects of Japanese law and practice seem to be particularly difficult for foreign legal practitioners to understand, as are, for instance, the requirements of disclosure and support of patent claims or the question of replacement, substitution and exhaustion of claimed subject matter once a patentee has profited from its exclusivity rights inside or outside Japan. In an effort to provide a comprehensive elucidation of such matters, we invited several authors – judges and practitioners from private practice – to deal with these topics from their specific point of view.

Since American spelling was to be used and since legal terminology and designations of courts, etc. needed to be consistent, editing became a challenge. In addition, due to time constraints, some of our authors had to provide their contributions in German or Japanese. We wish to therefore extend our gratitude here to Ms. Anna Delia Henley-Bührke of Hoffmann · Eitle, Munich, for her invaluable and most competent help with the English and the English translations.

At times, however, we ran up against some limitations, especially when translating contributions from Japanese into English. Dr. Rahn once noted in another context: “The translation is more precise than the Japanese original”. As amazing as this may sound, this is due to the ambiguities inherent in the Japanese language and the fact that a translator has to choose, for example, whether a noun should be singular or plural or whether a general or specific reference should be adopted. Consequently, the language we have used may at times be more precise than the original. If we have added an unintended clarification, we would like to apologize here for having produced a “more precise” version.

Mostly due to the consistency and formatting requirements, nearly all of the contributions that we received had to be retyped in part or their entirety. This has been undertaken by Ms. Ilonka Gösi, and we are deeply indebted to her. Without her efforts, competence and circumspection we would have been thoroughly lost.

And finally, we would like to add our own disclaimer: The contributors to this book all come from different walks of professional life, e.g. judges of reputed courts, university lecturers or legal specialists in corporate and private practice. It is only natural that their views are colored by their specific background. Thus, the opinions expressed in the various contributions, except our own, reflect the views of the contributors from whom we ourselves can and have learned so much.

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