Edited by
TOSHIKO TAKENAKA

Intellectual Property in Common Law and Civil Law

Intellectual Property in Common Law and Civil Law

Edited by

Toshiko Takenaka

University of Washington School of Law, USA

常州大学图书馆
藏书章

Edward Elgar
Cheltenham, UK • Northampton, MA, USA

© The Editor and Contributors Severally 2013

All rights reserved. No part of this publication may be reproduced, stored in a retrieval system or transmitted in any form or by any means, electronic, mechanical or photocopying, recording, or otherwise without the prior permission of the publisher.

Published by
Edward Elgar Publishing Limited
The Lypiatts
15 Lansdown Road
Cheltenham
Glos GL50 2JA
UK

Edward Elgar Publishing, Inc.
William Pratt House
9 Dewey Court
Northampton
Massachusetts 01060
USA

Reprinted 2013

A catalogue record for this book
is available from the British Library

Library of Congress Control Number: 2012943538

This book is available electronically in the ElgarOnline.com
Law Subject Collection, E-ISBN 978 0 85793 437 6

ISBN 978 0 85793 436 9

Typeset by Servis Filmsetting Ltd, Stockport, Cheshire
Printed and bound in Great Britain by T.J. International Ltd, Padstow

Intellectual Property in Common Law and Civil Law

Contributors

Martin J. Adelman, Professor of Law, George Washington University Law School, USA

Theo Bodewig, Professor of Law, Humboldt University, Berlin, Germany

Gail E. Evans, Reader in Intellectual Property Law, Queen Mary University of London, UK

Mario Franzosi, Partner, Avvocati Associati Franzosi Dal Negro Pensato Setti, Italy

Shubha Ghosh, Professor of Law, University of Wisconsin Law School, USA

Sang Jo Jong, Professor of Law, Seoul National University School of Law and Director of the SNU Center for Law & Technology, South Korea

Jan Krauß, Partner, Boehmert & Boehmert, Munich, Germany; Lecturer, University of Washington School of Law, USA

Mary LaFrance, Professor of Law, William S. Boyd School of Law, University of Nevada, Las Vegas, USA

Amy L. Landers, Professor of Law, University of the Pacific McGeorge School of Law, USA

Salil Mehra, Professor of Law, Temple University, Beasley School of Law, USA

Signe H. Naeve, Lecturer, University of Washington School of Law, USA

Frédéric Pollaud-Dulian, Professor of Law, Panthéon-Sorbonne University, France

Christoph Rademacher, Assistant Professor, Waseda Institute for Advanced Study, Japan

Yves Reboul, Professor of Law, University of Strasbourg, France

Brad Sherman, Professor of Law, Law School, Griffith University, Australia

此为试读,需要完整PDF请访问: www.ertongbook.com

Joseph Straus, Professor of Law, Universities of Munich and Ljubljana, NIPMO-UNISA Chair for Intellectual Property, University of South Africa (UNISA), Pretoria and Emeritus Director, Max Planck Institute for Intellectual Property and Competition Law, Munich, Germany

Mira T. Sundara Rajan, Honorary Member, Magdalen College, Oxford University, UK

Toshiko Takenaka, Professor of Law, University of Washington School of Law, USA

Marketa Trimble, Associate Professor of Law, William S. Boyd School of Law, University of Nevada, Las Vegas, USA

Preface

This book is the result of collaborations between European and Asian scholars who participated in a ten-year project co-sponsored by the Research Center for the Legal System of Intellectual Property (RCLIP) (http://www.21coe-win-cls.org/rclip/e_index.html) at Waseda Law School in Tokyo, Japan and the Center for Advanced Study and Research on Intellectual Property (CASRIP) (http://www.law.washington.edu/Casrip/) at the University of Washington, School of Law (UWLS) in Seattle, Washington, U.S.A. I had the pleasure of working with Professor Ryu Takabayashi, Director of RCLIP, and his colleagues when I taught comparative IP classes at Waseda Law School as a visiting professor from 2004 to 2011. RCLIP received funding from the Japanese government to develop a database on IP cases from major jurisdictions in Asia and Europe (http://www.globalcoe-waseda-law-commerce.org/rclip/db/search_form.php). By making the database publicly accessible free of charge and by sponsoring a number of conferences, RCLIP promoted a comparative law study of IP among not only Japanese scholars but also IP professionals and scholars in other Asian countries and Europe.

CASRIP co-sponsored many such conferences with RCLIP in both Tokyo and Seattle and contributed articles and book chapters for publication based on these conferences. It also translated more than 1500 cases from France, Germany, Italy and Spain and collected approximately 400 cases from India and the U.K. by working with scholars from these countries. These cases have been incorporated into the RCLIP IP case law database. Through discussions with scholars from various countries, I identified many aspects of IP systems that are deeply influenced by common law and civil law traditions. Thus, this book discusses these aspects and examines whether such aspects should remain diverged despite increasing efforts in world harmonization, or whether they should find a common ground for further harmonization.

Many of the contributors in this book are RCLIP database contributors who collected cases from the country of their expertise and/or are speakers for the conferences co-sponsored by CASRIP and RCLIP. Throughout the years, while working on the development of the database, I have formed friendships with the contributors and learned from them about

their IP systems. The database project and the CASRIP-RCLIP collaboration will celebrate its tenth anniversary in April 2013. As a memento of the celebration, I asked my friends and colleagues to write an essay on the issues I identified as being influenced by common law and civil law traditions. I am very pleased and proud to share our experiences and research results with the readers of this book.

Before concluding this preface, I would like to thank my colleague, Professor Ryu Takabayashi, for giving me the opportunity to participate in the database project. With his leadership and guidance, the database started as a collection of cases from Asian countries and then expanded to collect cases from Europe. Now, CASRIP is planning to collect cases from Russia, Brazil and South Africa and looks forward to working with scholars in these jurisdictions for the next decade. Moreover, I would like to thank all the contributors and my research assistants, UWLS JD students who edited book chapters, particularly, Mr. Hiroshi Okazawa, Mr. Koji Tauchi and Mr. Yoshinari Oyama, UW IP Law & Policy LL.M. graduates and CASRIP visiting scholars, who oversaw the entire editing process. Finally, I would like to thank my husband, Hisato, for his forbearance and continuous support for my work.

Toshiko Takenaka

Contents

PART I

Introduction

此为试读,需要完整PDF请访问: www.ertongbook.com

1. Towards a history of patent law

Brad Sherman

I. INTRODUCTION

Patent history is a subject that is still largely waiting to be written. Potentially, a history of 'patents' encompasses a number of different factors including patent administration, the professionals that work within the patent system, and the concepts, rules, and procedures that make up and inform patent law. There are also a number of different approaches that could be taken when writing a patent history ranging from comparative examinations and sector specific studies through to more political or theoretically informed histories.

To date, the bulk of the scholarship that has looked at the history of patents has focused on the patent system as an economic tool and on the role that the patent system plays in stimulating (or hindering) research and development. Until recently, most historical accounts have tended to see patents as instruments that are broadly adaptable to economic forces, and whose internal tensions and inconsistencies can be deciphered as effects of conflicts and shifts in economic interests. While this instrumentalist vision has produced some engaging historical accounts of the political and economic effect of patents there has, at least until recently, been much less attention given to the *legal* aspects of patents. It is as if lawyers were embarrassed by their own discipline: that they were more concerned to speak the language of economists, social scientists and policy makers than they were their own. The lack of attention given to the legal history of patents is particularly notable if we contrast existing historical scholarship on patent law with equivalent work in respect to copyright law, which has blossomed over the last 20 or so years into a serious and well developed area of study. The lack of attention that has been given to the legal history of patents is particularly ironic given that many of the rules of patent law are, despite their forward looking aspirations, applied retrospectively: patent law is, in this sense, inherently historical.

To the extent that scholars have looked at the history of patent law, they

have been concerned with a number of shared questions and concerns. One of the most pervasive themes that has underpinned historical writing on patent law has been a search for origins. While scholarly accounts about the emergence of patent law have taken a number of forms, typically the legal origins of patents are traced back to one of three sources. In some cases, the patent system is linked back to late mediaeval Venice, where privileges were granted to the inventors or entrepreneurs of useful devices or techniques from the fourteenth century onwards.[1] Because the earliest grants made no real distinction between inventors and entrepreneurs, the tendency is now to shift the point of origin forwards to the fifteenth century, when the newly-acquired prestige of painters and engineers began to rub off on inventors, encouraging their recognition as the creators of technical artifacts.[2] In other instances, (and this is particularly the case in common law countries), patent law is traced back to the 1624 *Statute of Monopolies*. In other instances, patent law is traced back to international treaties, notably the 1883 Paris Convention or in the case of specific aspects of patent law treaties such as the 1977 *Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure*. In addition to these attempts to find the legal or legislative roots of patent law, there have also been attempts to write the history of patent law through the lens of specific organizing principals; whether it be overarching normative principals (often drawn from political philosophy) or more home grown explanations (such as the information function of the patent system).

While there is no denying the heuristic value of these ways of thinking about patent law, particularly when explaining patent law to students or when making policy arguments, in this chapter I wish to revisit the search for origins that dominates the way that we think about the history of patent law. This particular history is based upon two ideas. The first is that it is wrong to see patent law as if it reflects some pre-ordained natural ordering or as if it was governed by a teleology of function. It is also based on the idea that patent law cannot be reduced to simple economic norms, to a specific philosophical positioning, or to a set of higher order principals. In this sense, the chapter is based on the idea that in thinking about the history of patent law, it is important that we should de-naturalize patent law and show that what are often taken as constructs of nature or

---

[1] Frank D. Prager, 'A history of intellectual property from 1545–1787' (1944) 26 Journal of the Patent Office Society 711.

[2] Pamela O. Long, *Invention, Authorship, 'Intellectual Property', and the Origins of Patents: Notes Toward a Conceptual History* (1991) 32 *Technology and Culture* 846.

as timeless inevitable truths are, in fact, the products of a complex and changing alloy of circumstances, practices and habits.

The second idea that underpins this chapter is the belief that when writing a history of patent law as a search for origins it is important to pause and consider: what is meant by 'patent law'? While many histories work on the assumption that patent law is an almost timeless entity that has always existed, albeit in a nascent and emerging form, this chapter is based on the belief that if we suspend our modern preoccupations and let the law speak for itself, a different and somewhat more perplexing picture emerges. If we look at the experience in the United Kingdom, which is the focus of this chapter, an argument can be made that patent law, at least in the sense that we understand it today, did not come into existence until the middle part of the nineteenth century. While there was general acceptance about certain things, such as the possibility of recognizing property rights in intangibles and general agreement about the image of the invention,[3] patent law did not emerge as a separate, discreet and accepted category of law until mid-way through the nineteenth century. Prior to this, there was no law of patents in the sense that we understand and recognize today. Moreover, while it is possible to recognize aspects of patent law in the eighteenth and early nineteenth centuries, these were not given any particular priority. Instead, they were placed alongside and given more or less equal weight to concepts, modes of organization and ways of thinking which, to our modern eyes, are distinctly alien and pre-modern. One of the problems with many of the historical accounts that search for the origins of patent law is that they downplay or ignore these possibilities. By selectively choosing what is read and examined, and by interpreting historical materials in a way that confirms these preoccupations, these histories lose sight of the fact that there were a number of different paths that the law could have followed: the modern patent system that we have inherited was only one of them. Seeing patent law in this way not only opens up new ways of thinking about patent history, it also leads us to question some of the assumptions that underpin the way that we think about patent law. It also enables us to understand some of our contemporary preoccupations and concerns.

---

[3] See Alain Pottage and Brad Sherman, *Figures of Invention* (2011).

II. THE EMERGENCE OF MODERN PATENT LAW

Patent law did not emerge as a discrete and recognizable area of law in the UK until midway through the nineteenth century.[4] Prior to this, there was a sense of openness, fluidity, and uncertainty about the content, shape and nature of the law. Indeed, one of the findings of the 1829 *Select Committee on Patents* was the level of uncertainty and confusion that existed in the law at the time. One area where this was particularly notable was in relation to the type of things that could be patented. Given the important role that subject matter plays in demarcating and defining legal categories, the lack of clarity about what could and could not be patented meant that it was very difficult to define the parameters of the nascent 'patent law' (if it could be called this at the time). These problems were compounded by the fact that patent claims were vague and general (making it difficult to ascertain the scope of what was protected). There was also widespread uncertainty about the purpose and requirements of the patent documentation more generally and the role that this played in demarcating and defining the interests that were protected. These problems were compounded by the haphazard registration system that undermined the faith in issued patents, at least until they were validated by the courts (which was itself a haphazard and uncertain process).

Prior to the emergence of patent law in the middle of the nineteenth century, the law was not only fluid, open and disorganized, there were also competing suggestions as to how the law that granted property rights in scientific and technical inventions should be organized. This was because no one mode of organization, no single way of thinking had yet come to dominate as *the* mode of organization. Instead, there were various competing suggestions as to how the law might (or should) be organized. One example was the proposal to establish a 'law of form', which would have focused on the external appearance and shape of objects (and expressly would have included subject matter now in patents, design and copyright).[5] Another approach was to do away with the now familiar patent-copyright-design style approach and to divide productions of the mind into 'two great classification – works (whatever their intention) addressed to the tastes, passion and existing circumstances of the age, and this adapted to all the fluctuations of society'.[6] Another option proposed

---

[4] While this chapter focuses on British patent law, the arguments are directly relevant in many colonies and indirectly relevant in many other countries.

[5] T. Turner, *On Copyright in Design* (1849), 12.

[6] M. Leverson, *Copyright and Patents: or, Property in Thought* (1854).

that the law should be organized so as 'to contract the limits of utility in form till nothing visible were left'.[7] Yet another approach would have seen that patent law was subsumed within a new area of law to be called the 'Law of Arts and Manufacture'. While these different ways of categorizing the law may now seem somewhat foreign and alien, it is important to keep in mind that at the time these different approaches were treated seriously.

The highly contingent and open nature of the law was also reflected in the way that treatises were organized, committees structured, and reports written. The fluid and open nature of the pre-1850 law was also reflected in the language that was used: commentators regularly spoke of copyright in inventions, patents for art, universal patents for authors, and patents for copyright or patterns. The uncertain and open standing of the law was summed up by the fact that although patents had been granted in one form or another by the Crown for over two centuries, it was said in 1835 that 'there existed no law of patents'.[8]

Despite the uncertain and open nature of the law, by the middle part of the nineteenth century, an important transformation had taken place: there was a much clearer idea as to the nature of patent law, what its main elements were, and where its boundaries were to be drawn. While the process was gradual, haphazard and incomplete, by the 1850s (or thereabouts) patent law had emerged as a separate and distinct area of law replete with its own logic and grammar.[9]

A range of different factors facilitated the emergence of patent law in the UK. In the early part of the nineteenth century, a growing concern with the state of British industry led to calls for reform and improvements in the patent system. In response to the growing calls for reform, in 1829 Thomas Lennard called on Parliament to establish a Select Committee to inquire into the state of patent law.[10] While the Select Committee proved inconclusive, nonetheless it played an important role in bringing about the emergence of modern patent law: it exposed the confused and uncertain nature of the law and also drew together many of the divergent criticisms that existed at the time. More significantly, the evidence of witnesses as to their understandings of the law provided the materials for the processes of reformulation that were to take place over the next two decades.

The first attempt to rectify the many grievances that the Select Committee had identified occurred when Richard Godson, who was

---

7 T. Turner, *On Copyright in Design* (1849), 49–50.

8 Mr Tooke, 'Letters Patent' (13 Aug 1835) 30 *Hansard* col 466.

9 Notably, the invention came to function as the common denominator that ensured that linked the rules of patent law.

10 (9 April 1829) 21 *Hansard* col. 598.

此为试读,需要完整PDF请访问: www.ertongbook.com