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Review of 'Intellectual Property in Common Law and Civil Law' ed. T. Takenaka, 2013, Edward Elgar, ISBN 978-0-8593436-9

This work claims to be the culmination of a 10-year collaborative research project jointly sponsored by research institutes at Waseda Law School, Tokyo, Japan and the University of Washington, School of Law, Seattle, USA. It addresses an issue which will be of interest to most scholars, practitioners and postgraduate students working in the field of intellectual property law: in an era of international and regional standardisation of intellectual property norms, do the common law and civil law traditions remain influential in informing differences in national copyright laws? The thesis of this work is that they do: as the book's synopsis states, the "two traditions...still exert powerful and divergent influences" on intellectual property law. The stated aim of the work is to answer the normative question of "whether such aspects should remain diverged" or whether "common ground" between traditions can be found (see Preface, p. ix). As the editor goes on to explain, the essays explore these questions in relation to topics identified as "deeply influenced by common law and civil law traditions" (*ibid.*).

The book comprises 18 essays, organised in 7 parts written by contributors from a number of countries: 18 academics from jurisdictions including the USA, Germany, UK, South Korea, France, Japan and Australia, as well as a practitioner of intellectual property from Italy. It opens in Part I with an introductory chapter: an essay by Brad Sherman on the history of patent law in the nineteenth century. Parts II, III, and IV cover substantive legal issues in seven essays, organised into the categories of patents, copyright and trade marks/unfair competition respectively. The patents chapters comprise contributions by Joseph Straus about *ordre public* and morality in patent eligibility, Toshiko Takenaka and Martin J. Adelman about first-to-file and first-to-invent issues, Amy L. Landers on inventive step and Jan Krauss on equitable doctrines in international patent law. On copyright, Mira T. Sundara Rajan looks at moral rights, Salil Mehra considers recent changes in Japanese copyright law and Frederic Pollaud-Dulian and Sang Jo Jong look at defences to infringement. The trade mark law chapters consist of a chapter about passing off and unfair competition by Mary LaFrance, trade dress by Signe H. Naeve, and finally a comparative analysis of the protection of geographical indications in the EU and US by Gail E. Evans.

Three further Parts follow these substantive law chapters. Part V covers issues of

enforcement and infringement: extraterritorial enforcement is the subject of the chapter by Marketa Trimble and injunctive relief in patent cases of the piece by Christoph Rademacher. In Part VI, “legal aspects common to all branches of IP” are considered, comprising chapters on exhaustion by Theo Bodewig, non-compete covenants by Shubha Ghosh, and employee inventions by Toshiko Takenaka and Yves Reboul (the last mentioned perhaps which would have been better presented alongside the other patents essays in Part II). The work closes with Part VII, which consists of a single essay by Mario Franzosi presenting what he claims to be “the oldest documents” relating to “the first patent law” enacted in Sybaris, Italy at some point before 506 BC, and closing with some rather dubious and unsubstantiated remarks about the need for “a truly European cross-border jurisdiction” (at p. 419 and p. 430). It is regretted that no explanation is given as to what exactly this means, as well as how this would be possible, given the work’s premise of entrenched differences in national traditions.

As will be evident from this overview, the work encompasses essays on a multiplicity of issues. There is diversity too in the jurisdictions covered, not only spanning the USA and European countries, but also aspects of the laws of Japan, South Korea and India. While the breadth of jurisdictions covered is to be applauded, the book suffers a central weakness: it is unclear to the reader how these essays support or develop its central thesis as stated in the Preface. For example, Brad Sherman’s introductory chapter presents a thought-provoking reflection on mid nineteenth century patent law in Britain, a topic little considered by existing literature. However, it is hard to understand the editorial decision to present this excellent essay as the work’s introductory chapter. First, the relevance of the piece to the book’s central question lies with one small aspect only, that historicises the emergence of what Sherman terms “‘common law’ ‘civil law’ caricatures”, which tend to ignore the important points of connection and the sharing of concepts and ideas that occurred between common law and civil law countries” (at p. 14). Yet, uncovering a shared history between common law and civil law traditions surely raises more questions than it answers for the work’s central claim that entrenched differences exist between “two traditions”. Secondly, it is hard to understand why patent law history has been singled out by the editor for the introductory chapter, given that cross-filtration of concepts and ideas is also claimed by Sherman elsewhere (in his work with co-author Lionel Bently, *The Making of Modern Intellectual Property Law* (Cambridge 1999) at, for example, p. 111) to characterise the history of other branches of intellectual property law such as copyright law.

Similar comments can be made about later chapters. For example, in two illuminating pieces, Takenaka and Adelman present the details of the recent America Invents Act 2011 in which the USA adopted a first-inventor-to-file approach to patent priority, in the context of differences between first-to-file and first-to-invent patent systems. While the essay is certainly timely, there is a lack of clarity as to how these various systems map onto the “two traditions” of the common law and civil law. In fact, this might be said to be a subject that contradicts the work’s central thesis, as these differences defy a simplistic “two tradition” analysis. Similarly, another piece in the collection by Signe H. Naeve presents a comparison of protection for trade dress in the USA and EU. Again, while the analysis is interesting, to address the work’s central question would require the author to look behind the EU regime to differences, if any, in how the courts of common law and civil law jurisdictions apply the various EU instruments. Overall, therefore, while this collection covers a diversity of topics, the absence of an editor’s introduction and conclusion explaining how the essays come together results in a muddled whole.

Unfortunately, the work’s weaknesses do not stop there. First, a glaring omission is any attempt to discuss perhaps the most topical issue regarding European copyright law today: the implications of the European Court of Justice’s ruling in Case C-5/08, *Infopaq v Danske Dagblades* [2009] E.C.R. I-6569, and subsequent cases, for the development of a European notion of “originality”. *Infopaq* raises the question of whether common law and civil law traditions continue to shape how national courts interpret this case law, but the issue is sadly ignored. Secondly, the book does not engage with other scholarship on the relevance of “traditions” both today, and in the past, for example Catherine W. Ng, Lionel Bently and G. D’Agostino, *The Common Law of Intellectual Property* (Oxford and Oregon 2010), that presents a very different picture of growing divergences amongst jurisdictions of the common law tradition (at, for example, p. 4). The lack of an editorial chapter placing the work under review in the context of scholarship such as *The Common Law of Intellectual Property* makes the central claims of *Intellectual Property in Common Law and Civil Law* unconvincing.

Overall, therefore, while the collection includes some timely and interesting essays, as the product of 10 years of research on the relevance of common law and civil law traditions today, the work as a whole is disappointing on a number of levels. Perhaps of greater interest is the database of English summaries of over 2,000 intellectual property cases from 12 European and Asian jurisdictions (France, Germany, UK, Spain, Italy, China, Thailand,

Indonesia, South Korea, Taiwan, Vietnam and India) compiled as part of the same project. The database is no longer at the url stated in the work's Preface and can now be found at [http://rclip.sakura.ne.jp/db/search\\_form.php](http://rclip.sakura.ne.jp/db/search_form.php). While this is a useful resource, the basis for case selection is not stated. Consequently, like the book, while the database's coverage is impressive, its weakness is a lack of clear editorial statement.