

BOOK REVIEW

FUNDAMENTALS OF PATENT LAW: INTERPRETATION AND SCOPE OF PROTECTION

By Matthew Fisher,

Oxford: Hart Publishing, 2007, 448 pp, £65.00, ISBN 1841136921/9781841136929

Let me “warn” the reader that the title of the book is misleading: the book deals with more than what is stated in the title. From the first chapter, I understood that the author was to explore issues relating to the scope of patenting in the UK. However, the chapter on the British tradition and claim theory read more like a chapter on legal history than on the narrow scope envisaged by the author. This was followed by an excellent introduction to the history of the patent system – again leaving me to wonder what exactly the author was trying to achieve by entitling this book *Fundamentals of Patent Law*. The author then takes us from history to economics, making us wonder once again whether this was a book that examines patent law from a multi-disciplinary perspective.

Having said this, I should state that these chapters on the economics of the patent system are generally well written. However, the problem is that it is difficult to understand the connection between the economic theories of patent and claim interpretation on the one hand, and the scope of patents on the other. Although the author attempts to discuss the relevance of the theories for claim construction and interpretation, it was not clear how a patent system should deal with the scope and interpretation of claims on the basis of these theories – including what the author referred to as recent alternatives. The author thus concluded, “the best justification that we currently have for the patent system is the fact we currently have a patent system.” (p 108) The problem is that an economic analysis is not well suited to explaining different aspects of the patent system. The theories did suggest a rationale for the patent system or the role of monopoly rights and other incentives for innovation. Yet the relationship between innovative activity, based on these theories, and the way different aspects of the patent system works was not very clear. This should be obvious given that different countries’ patent law and practice have evolved in different ways – irrespective of the uniform models or theories put forth by economists. So at the end of Part I, I was left wondering where the author was going – the promise of the title was nowhere in sight, and the journey thus far was more a detour.

However, Part II sees the author move toward the promised lands after the detour of Part I. The first chapter in Part II gives an excellent analysis of the USA’s patent law – in its determination of scope and its doctrine of equivalents. The doctrine of equivalents is a difficult subject to understand in patent law, and in the USA it has a

chequered history. Commentators have often pronounced its demise or irrelevance, through which it has survived. The doctrine of equivalents and the reverse doctrine of equivalents was analysed by the author and was readable – a good introduction to a complex subject.

Taking Germany as the next case study was logical as Germany is known for its expansive interpretation of patent claims. The author traced the developments over the years by identifying the different periods and covered recent decisions as well. The historical approach, combined with the analysis of the decisions in important cases, makes this chapter a treat for those who want to get a better understanding of claim interpretation in German patent law and practice. The author concluded by writing, “We have also seen that the provision of broad protection based on the uncertain concept of general incentive idea did not stifle Germany’s technological growth to any appreciable or quantifiable, extent during the Second and Third Periods.” (p 257) This is a controversial claim as many factors affected technological growth, and the role that broad protection played was debatable.

The next chapter was on the Japanese patent system. The historical context of the Japanese patent system is explained well by the author, as is the figure on page 277, which explains the scope of single and multi-claim patents. The author also deals with the importance and the implications of the Ball Spline decision for claim-interpretation in Japan. After discussing the subsequent decisions, the author examines the importance of the incorporation of the doctrine of equivalents into Japanese law, and points out: “[y]et the requirements and limitations placed on operation of the doctrine of equivalents under Ball Spline (as interpreted) once more favour the incremental over the pioneer.”(p 287) The observations made by the author in the concluding section of the chapter are relevant – particularly in the debates on harmonisation of patent systems. Thus, the chapter provides a fascinating analysis of the Japanese patent system by analysing developments in law and interpretation from an historical perspective.

After discussing patent law and claim interpretation in three different countries that adopt differing approaches, the next two chapters are devoted to claim interpretation in British patent law and the European Patent Convention. In this chapter, the author does not discuss (for a change) the history of patent law in Britain, but focuses instead on the *Catnic* legacy and subsequent developments. The reader is provided with an excellent analysis of the decision in *Catnic* and the application of the test formulated therein. The post-*Catnic* decisions are covered well by the author, who provides a thorough analysis of the various decisions and their implications for claim interpretation. The author discusses the *Kirin-Amgen* decision extensively and the issues that arose from the interpretation of Article 69 of the EPC. He rightly points out that although the decision in *Kirin-Amgen* had enhanced the clarity in interpreting claims, this was not sufficient for the purposes of harmonisation.

In the final chapter the author concludes that implementation of the amended text of the EPC provides a unique opportunity to bring construction of claims to a predictable standard that could be understood.

Reading the book was a rewarding experience. At times I felt that I was reading a book on the history and economics of patents – although Part II was focused on the core theme of the book. In one sense, the two parts could be construed as two different volumes integrated into one book. Perhaps the author had dealt with a broad range of materials in his dissertation and has tried to do the same in this volume. This is the flaw of the book. Yet the reader is rewarded inasmuch as there is a comprehensive explanation of the history and economics of the patent system, and the issues in interpretation and scope of protection. So, the flaw conceals a benefit in that the book would make a worthwhile addition to law school libraries.

However, the author could have given us a more focused book with a more representative title and introduction. The author should also have dealt with in greater depth, issues raised by TRIPS, initiatives to harmonise patent law (e.g. SPLT), and provided an overview on how patent systems in other countries (e.g. France) deal with interpreting claims and constructing the scope of protection. Given the depth of knowledge (on history and the evolution of patent systems in different countries) demonstrated in the book, it would fair to expect this from the author. Similarly, a thorough analysis of the EPC and issues of harmonisation in Europe would have enhanced the relevance of the book. The second part of the book does justice to the title and the extensive analysis of legal issues. The discussions on major cases proved to be a welcome contribution given how unusual it is for a single book to cover the patent systems of four countries.

This book would be of much interest and utility to readers who want to get a good understanding of claim interpretation, the scope of protection and, notably, the doctrine of equivalents and its application in patent law. For academics teaching patent law, and for students of intellectual property law, this book would be a useful reference that deals with these basic issues clearly and with coherent analysis.

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