

IP Law Update

Winter 2011/12





Welcome to the Winter 2011/12 edition of Withers & Rogers IP Law Update. This e-publication provides links to a variety of articles published on our website which we hope will provide our clients and contacts with a flavour of developments in intellectual property law in the UK and Europe.

2011 was an interesting year in IP. We have probably seen more progress on the creation of the unitary EU patent in the last year or so than in the previous two or three decades. At the time of writing, discussions are still ongoing as to how such patents will be litigated. Maybe, just maybe, this time it will happen?! Mention must also be made of the significant changes to US patent law which will soon be coming into force. This edition contains a brief overview of some of the key aspects of these changes.

In addition, we report on a number of decisions of the UK courts and the European Patent Office, including the UK Supreme Court's deliberations on industrial applicability of inventions. Also considered are two rulings of the Court of Justice of the European Union, one concerning supplementary protection certificates, the other relating to the emotive area of the patenting of stem cell-based inventions.

In the Spring 2011 edition of IP Law Update, I commented that the economic recovery had been looking increasingly assured. More recent economic data, and the ongoing trouble in the Eurozone, have since shown of course that the foundations of the recovery may not have been as solid as was thought.

The economic headwinds facing many countries will, of course, recede but it is difficult in many instances to predict when, and by what series of mechanisms. As many great investors will attest, periods of maximum depression in market sentiment often herald the greatest opportunities for making eventual gains. It is also apparent that many major corporations currently have significant cash reserves on their balance sheets. In this vein, we believe that careful investment in IP now may yield significant returns downstream, whatever form the economic recovery takes.

Enjoy reading the articles. Best wishes for 2012 and beyond!



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01



Supplementary Protection Certificates: Much ado about...something

Since the last edition of IP Law Update, there has been a lot of action in the niche, but commercially very important, area of supplementary protection certificates (SPCs). A number of cases have appeared before the UK courts, primarily involving SPC applications for medicinal products containing multiple active ingredients ([see here](#)). These cases have culminated in a referral to the Court of Justice of the European Union (CJEU), from which a somewhat worrying Advocate- General's opinion emanated ([see here](#)). Recently, the CJEU has provided its decision, altering the opinion of the Advocate-General in certain respects and providing some comfort, but also some concerns, for pharmaceutical innovators ([see here](#)).

02



Play-Doh or Play Don't: The power of reputation

Here we report on a decision of the UK High Court considering trade mark infringement and passing off claims in respect of the well-known trade mark Play-Doh. The court considered, amongst other things, that the reputation built up by the trade mark Proprietor was sufficient to prevent a third party from using the strap-line "the edible play dough" in relation to its competing product.

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03



EPO oppositions - The importance of filing amendments early

The Boards of Appeal of the European Patent Office have been keen to stress that parties to an appeal should aim to present their entire case at the earliest opportunity in those proceedings. In recent decisions, this principle has been applied even more strictly, such that a patent Proprietor was denied permission to file amended claims during appeal proceedings, where those claims could, and should, have been filed during the first instance proceedings before the Opposition Division.

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04



A novel approach to arguing for inventive step

In this UK Court of Appeal decision, the Proprietor of a patent argued that the proximity of the publication of a key prior art document to the filing date of the patent application was too short to have allowed the skilled person to arrive at the invention in an obvious manner. In addition, it was contended that the inventive step of the claimed product was justified by the decision of the researcher to spend the time and money in developing the product. Both arguments failed, illustrating the fundamental approach taken by the courts to assessing inventive step, and the subordinate nature of commercial considerations.

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05



Surgical methods given the EPO treatment

The decision G1/07 of the Enlarged Board of Appeal of the European Patent Office set out the requirements for a claimed method to fall foul of the exclusion from patentability of methods of surgical treatment. In this Technical Board of Appeal decision, an illustration is provided as to how one of the Enlarged Board's criteria - an invasive step, entailing a substantial health risk - may be assessed.

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06



Patent infringement - Repair or renew revisited

We have previously reported on the case of *Schütz v Werit*, which considered the question of infringement of a patent where the defendant contended that it was merely repairing the patented products, rather than infringing the patent by making the products. Here we report on the UK Court of Appeal's decision, which reversed the decision of the High Court. Unfortunately, the appeal decision may still leave some doubt as to the correct approach for assessing this area of the law.

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07



The Enlarged Board of Appeal on disclaimers (again)

In late summer 2011, the Enlarged Board of Appeal of the European Patent Office issued its decision on the allowability (or otherwise) of disclaimers which relate to subject matter which was originally positively disclosed in a European patent application. In principle, the Enlarged Board has confirmed that this practice can be allowed and does not automatically fall foul of the "added subject matter" prohibition. However, the Enlarged Board's decision emphasises that the assessment must be made on a case-by-case basis, thereby leaving room for doubt in many scenarios.

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08



Patentability of software in the UK - The "mental act" exclusion

This High Court decision, involving oil and gas services giant Halliburton, illustrates the narrow scope which should be applied to the exclusion from patentability of "mental acts". The patent applications in question concerned the computer-aided design of drill bits for mining operations, and it was considered that the mental act exclusion should apply only to techniques which really would be considered capable of being carried out by the human mind.

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09



Patenting of stem cells in Europe - The end of the road?

The controversial area of patenting inventions relating to human stem cells was potentially dealt a further blow by the Court of Justice of the European Union in late 2011. It had been accepted law, at least in the European Patent Office, that inventions which, at the time of filing of the relevant patent applications, necessitated the destruction of human embryos, were not patentable. The decision of the Court of Justice effectively extends the scope of this exclusion by, among other things, applying a broad interpretation to the term "human embryos". The decision has been widely criticised in bioscience circles. On the positive side, however, it at least provides greater certainty for researchers and investors as to what may, and may not, be protected.

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10



Industrial applicability of inventions - Hurdle laid low by the Supreme Court

Of the three key requirements for patentability - novelty, inventive step and industrial applicability - the latter has generally been regarded as the easiest to fulfil and, as a result, not too many patent cases come before the courts in which this issue is decisive. In *Human Genome Sciences v Eli Lilly*, the patent related to a gene sequence encoding a novel protein, the biological properties of which had been postulated in the patent application based on the similarity of the protein sequence to other, known proteins. The UK High Court and Court of Appeal had found that the patent was invalid for lack of industrial applicability, since the functions of the novel protein were viewed as purely speculative. In the first patent case to reach the Supreme Court since its creation (from the House of Lords), these lower decisions were reversed, an outcome welcomed by innovators in the bioscience area.

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11



US Patent Reform...as you may have heard!

Although IP Law Update is generally focused on UK and European matters, it was felt that the recent major changes in US patent law were well-deserving of a mention. Much has already been said and written on this subject by various commentators. However, here we provide a brief summary of some of the more significant changes which will be enacted in the relatively near future.

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