

# IP Law Update

Spring 2011





Welcome to the Withers & Rogers IP Law Update, Spring 2011 edition. As usual, this e-publication contains links to a number of articles published on our website in recent months. We hope that the articles will provide our clients and contacts with an overview of what has been happening in UK and European IP.

We report on a number of decisions of the UK Courts and the European Patent Office (EPO). In particular, further ruminations of the EPO on double patenting and disclaimers are discussed, and we report on the referral to the Court of Justice of the European Union of certain questions on Supplementary Protection Certificates for medicinal products. This edition also contains further news on the “smell-alike” trade mark infringement case of L’Oreal and Bellure, and provides a brief update on the UK Patents County Court, a forum which could make IP litigation in the UK much more attractive.

Since the last edition of IP Law update, the economic recovery has been looking more and more assured. Although recent data may suggest that we are not “out of the woods” yet, patent filing volumes at least suggest that IP protection is still viewed by many businesses as a high priority. Be that as it may, recent developments in the Middle East are a reminder that political and social changes can take everyone by surprise. In unpredictable times, we feel that it is more important than ever to ensure that IP rights are well protected.

I hope you will find this edition of IP Law update useful. Your comments are, in any event, always welcome.



*Nicholas Jones*

**Nicholas Jones**  
**Editor & Partner, Withers & Rogers LLP**

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## Double patenting becoming clearer in the EPO?

Over the last few years, certain worrying decisions have emanated from the European Patent Office concerning whether, and to what extent, “double patenting” may be used to refuse European patent applications. We report on Decision T 1423/07 which, refreshingly, considered that, at least in the circumstances of that case, double patenting does not exist as a ground of refusal under the European Patent Convention.

[For more information click here](#)



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## Medical uses in the EPO: The importance of a new effect

There is now a considerable amount of case law concerning the patenting of second or subsequent medical uses of substances in the EPO. Here we compare two recent decisions in an attempt to illustrate a nuance of the approach which the EPO takes to assessing the novelty of such inventions.

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## SPCs for multi-ingredient medicines to be considered by European Court

The last few years has seen a rash of decisions from national courts concerning Supplementary Protection Certificates (SPCs) for medicinal products. SPCs are capable of providing highly valuable patent term extension and hence the interpretation of the European Regulation which provides for SPCs is a matter of great importance. We reported in the last IP Law Update on a series of SPC applications from Medeva for medicinal products containing multiple active ingredients. Those SPC applications were refused by the UK High Court. Medeva appealed to the Court of Appeal, and here we report on the reference which has now been made to the Court of Justice of the European Union for guidance on the correct approach to such products.

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## EPO Enlarged Board to consider disclaimers again

A number of years ago, the Enlarged Board of Appeal (EBA) of the European Patent Office handed down a decision (G1/03 and G2/03) which attempted to codify the allowability of disclaimers in patent claims under circumstances in which there is no basis in the patent application as filed. The EBA is now to revisit disclaimers. In this instance, however, it has been asked to decide whether a disclaimer may be inserted into a claim, where the basis for the disclaimer is a positive description of the subject matter of the disclaimer in the patent application as filed.

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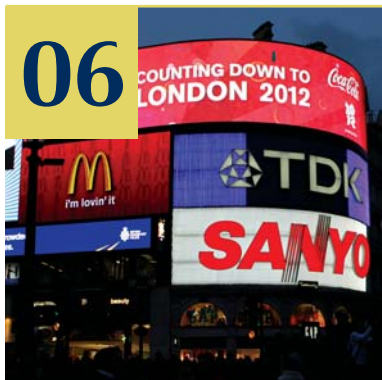
## Can a priority document “kill” its children?

A Technical Board of Appeal of the European Patent Office has issued a decision which once again illustrates the very strict approach to assessing entitlement to priority under the European Patent Convention. In the case in question, an error in the lower limit of a numerical range in a claim of the European patent application meant that the claim was not entitled to its priority date. Furthermore, since the priority application was a European patent application which had been maintained through to publication, the loss of the priority claim had a disastrous outcome for the Applicant.

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## ECJ ruling in “smell-alike” case is victory for brand owners

The UK Court of Appeal has now provided its judgment in the case of L’Oreal v. Bellure, applying the decision of the Court of Justice of the European Union (formerly the ECJ). L’Oreal had sued Bellure for trade mark infringement in respect of the marketing of Bellure’s perfumes by means of lists comparing the perfumes to L’Oreal’s well known perfumes having similar smells. The decision found that one of the essential functions of a trade mark was for the purposes of advertising and that, since this function had been harmed by Bellure’s activities, an infringement had occurred.

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## The Patents County Court: A coming of age?

Significant changes came into force on 1 October 2010 concerning the procedures of the UK Patents County Court (PCC). The changes are intended to present the PCC as a real, and hopefully quicker and less costly, alternative to High Court proceedings for intellectual property disputes. Since this brief article was prepared, Colin Birss, QC has been appointed as the PCC Judge, and we are pleased to note that a number of decisions have already been given which suggest that the objectives of the PCC are being realised.

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## No “Reformatio in Peius”: Will the EPO abide by this principle whatever the cost?

The case law of the Boards of Appeal of the European Patent Office has established a strict doctrine of no reformatio in peius - meaning that, in appeal proceedings following a decision of an Opposition Division, if only one party has filed an appeal, the non-appelling party cannot improve its position with respect to the Opposition Decision. The Technical Board of Appeal Decision T 0659/07 illustrates how rigorously the European Patent Office will adhere to this principle, even where the results may be somewhat absurd.

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## Divisional applications - a rare moment of leniency from the European Patent Office

Unexpectedly, the Enlarged Board of Appeal of the European Patent Office has decided that, where a patent application is refused by an Examining Division, the application remains “pending” until the expiry of the time limit for filing an appeal, even if an appeal is not filed. In this instance, this enabled a divisional application to be validly filed after the parent application had been refused at oral proceedings, even though the Applicant did not subsequently file an appeal. Although this decision may not make a great deal of difference now that the EPO has introduced deadlines for filing divisional applications, it is welcomed nonetheless for its pro-Applicant stance.

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## Best Buy case provides a warning on trade mark threats

A recipient of correspondence threatening trade mark infringement proceedings can bring proceedings in the UK for damages, where appropriate, and a declaration that the threats were unjustified. This case helps to illustrate the approach which the UK courts will take when considering defences to an allegation of unjustified threats.

[For more information click here](#)



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## The UK inventive step test - have you picked the right team?

Case law has established that the “person skilled in the art” for the purposes of assessing the inventive step of an invention may be a team, rather than an individual. Here we report on a UK Court of Appeal decision which considers the composition of the “team skilled in the art”. An important outcome of this decision applies where an invention is based on the application of a known technology to a new field. The “team” in such instances could be considered not to include key individuals, with the result that an inventive step is more likely to be present.

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## Contributory infringement revisited

Indirect (or contributory) infringement of a patent may occur when a person supplies an essential element of a patented invention, the essential element enabling the invention to be put into effect. For infringement to be found, however, it must be known or obvious to the supplying person that the supplied materials are both suitable and intended to put the invention into effect in the UK. In the case of *Grimme v. Scott*, the UK Court of Appeal looked at the meaning of the “intention” aspect of this provision. It was decided that the analysis should focus on the supplier, rather than the person supplied.

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