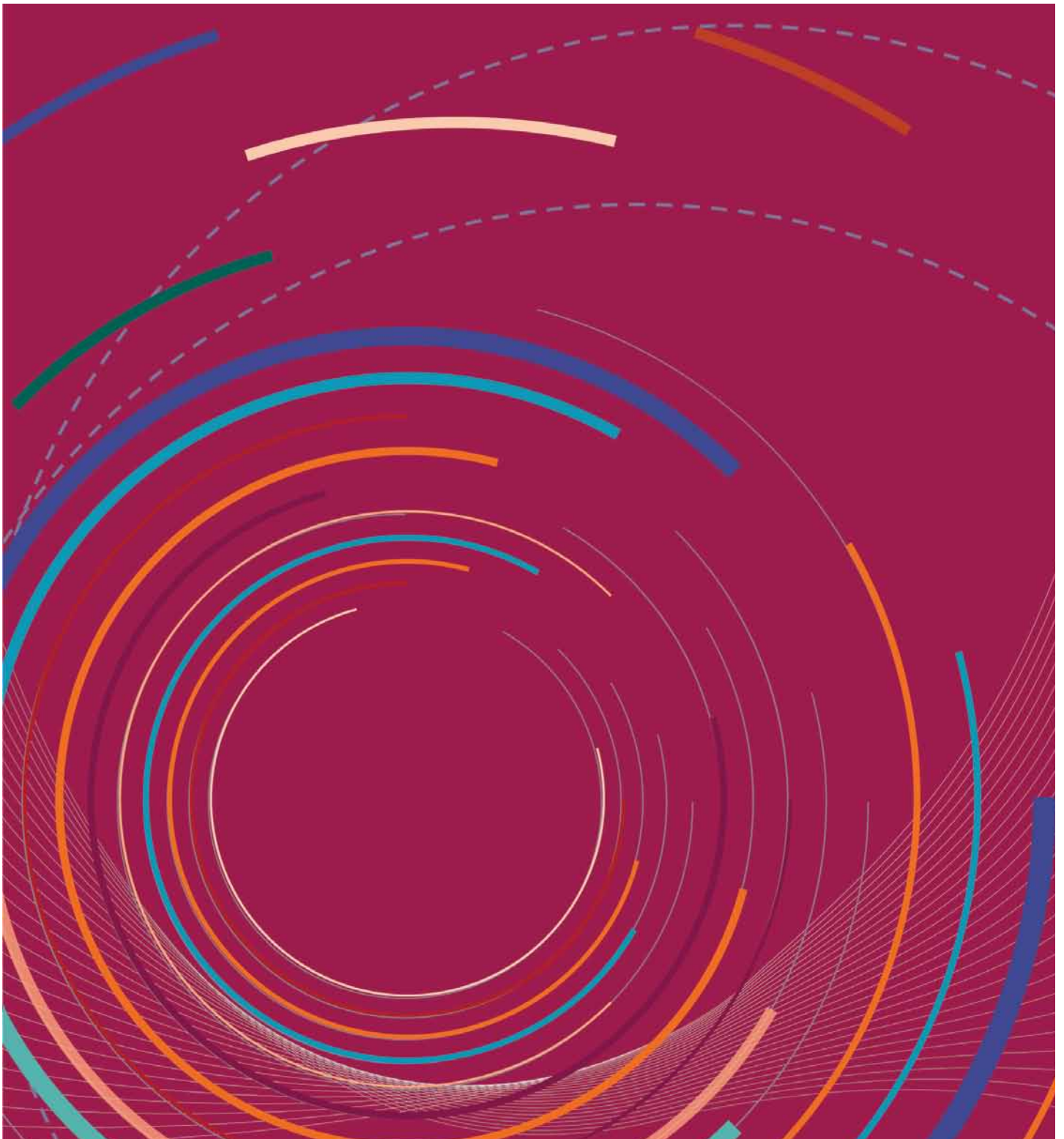


IP Law Update

Spring 2014



Welcome to the Spring 2014 edition of the Withers & Rogers IP Law Update. This e-publication provides a link to a number of articles that have been published on our website. These articles cover some of the more important cases that have been decided in the UK and Europe in the past year. We hope they will provide a useful insight.

The past year has seen plenty of action in IP in Europe. We cover a selection of trade mark cases, which show that household names such as Nestlé, Cadbury, Interflora and Marks & Spencer have been involved in the action.

Several of the patent decisions we have reported on relate to the pharmaceutical industry which, along with the telecommunications industry, continues to dominate the scene. It was, however, in the mechanical field that the UK Supreme Court issued an important decision in the case of *Schütz v Werit*. This revisited the 'right to repair' issue, potentially with the result of undermining patents held by original equipment manufacturers, and opening up competition in the aftermarket.

Life has also been busy for the EPO. The difficult issue of patents which are simultaneously subject to EPO opposition proceedings and national court proceedings reared its head, in the form of a case at the UK Court of Appeal between IPCom and HTC. In common with the Court of Appeal, we also see delays as one of the EPO's main problems, and are encouraged by their proposed 'Early Certainty from Search' initiative which is currently under consultation.

Related to, and in some ways a solution to, the inherent conflict between the EPO and national courts is, of course, the much talked about Unitary Patent. Much progress has been made

recently, and although the relevant legislation has yet to be ratified, it is now time for applicants to begin planning for the new system. We feel it is very important for our clients to be able to make the best decisions through what will be the biggest change in patent law in Europe since the introduction of the EPC over 35 years ago, and have a section of our website dedicated to this subject. See **Unitary Patent** for basic summaries as well as the latest news.

Looking ahead, the renewed focus on energy security in the light of recent political events is likely to boost patent filings in this area. With Specialist Practice Groups in the **Oil & Gas** and **Clean Technology** sectors, we are well placed to help our clients move quickly to take advantage of the opportunities. In the marketplace as a whole, the tentative but apparently stable economic recovery is likely to mean an uptick in R&D spend, and an increased emphasis on obtaining and enforcing strategically useful IP rights.

We hope that you find the articles useful. As always, please feel free to get in touch with your usual contact if you have questions about any of the issues raised here, or more generally. We very much look forward to working with you over the coming months and beyond.



Elizabeth Swan
Editor & Associate



Nicholas Jones
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Trade Marks

01

UKIPO blocks Nestlé's bid to protect the shape of its KitKat chocolate bar

Despite the dramatic progress made on the Unitary Patent in the past year, the courts around Europe continue to come to different conclusions on substantially the same facts. This happened in the battle between Nestlé and Cadbury, where the UKIPO blocked Nestlé's bid to obtain trade mark protection in the UK for the four-fingered shape of its KitKat chocolate bar, just a few months after the Board of Appeal of the CTM office had upheld the trade mark.

[For more information click here](#)

**02**

In Bloom: Interflora v M&S

In May 2013, the UK High Court issued its decision in the long-running case of Interflora v Marks and Spencer. This case focused on the use of registered trade marks in keyword advertising and the extent to which such use can constitute trade mark infringement. Online retailing has transformed the way companies do business. The use of registered trade marks online by competing organisations is an area where care is needed.

[For more information click here](#)

**03**

Evidence unscrambled: SCRABBLE unsuccessful in trade mark dispute at UK high court

Acquiescence can be a dangerous pastime. For Mattel, it appears to have been a factor in a UK High Court decision which ruled that its SCRABBLE trade marks were, in the main, not infringed by an online game by Zynga.

[For more information click here](#)

**04**

Undiluted: CJEU critical of General Court's decision in Wolf trade mark battle

In 2012, a decision by the EU General Court concerning a trade mark involving a wolf seemed to upset the settled case law on proving detriment to reputation. The recent appeal decision from the CJEU goes some way to restoring the status quo.

[For more information click here](#)



EPO

05

**EPO - No post-grant correction of pre-grant errors**

Moving from trade marks to EPO case law, the Enlarged Board of Appeal was called in to decide a point of law that arose as the sole issue in an opposition. The issue was whether a patent that has been granted containing an error in its wording can be corrected by the EPO using a similar procedure for correcting errors before grant. The answer, in short, is that it can't.

[For more information click here](#)

06

**Sequence listings - when are they optional at the EPO?**

Of interest to biotech readers, a Legal Board of Appeal of the EPO considered the conditions under which a sequence listing must be provided. A Notice from the EPO, which had apparently been issued without proper basis, was overturned to provide clearer rules for applicants.

[For more information click here](#)

07

**The EPO on second medical use claims, witness testimony and oral disclosures**

The EPO, in its capacity as adjudicator of oppositions to European patents, is generally less comfortable than national courts with witness testimony and oral disclosures. In one Board of Appeal decision, T2003/08, both were involved. The standard of proof required for oral disclosures to be relevant prior art was yet again tested and found lacking in this case.

[For more information click here](#)

Patents

08

Stay - the 'default' position?

In today's fast moving commercial environment, with innovators bringing products to market as quickly as possible, but the EPO still taking several years to grant patents that cover them, EPO opposition proceedings often run simultaneously with proceedings in one or more national courts for infringement and/or validity. The UK courts have been grappling with the question of whether or not to stay proceedings pending an EPO opposition. The latest guidelines have been set out in the IPCOM decision from the Court of Appeal.

[For more information click here](#)

**09**

'Right to repair' ruling could undermine certain patents

The UK Supreme Court made a significant ruling on the issue of the 'right to repair' defence to infringement in the *Schütz v Werit* decision. The decision mainly affects original equipment manufacturers that hold patents and operate in sectors that have an established aftermarket. The decision has been seen to undermine the ability of the original equipment manufacturer to use patents to control the aftermarket, by making it easier for a third party to remanufacture or retrofit a product.

[For more information click here](#)

**10**

Inventive step in the UK - The question is, was it obvious?

The Court of Appeal Decision in the case of *Novartis v Generics* gives an interesting insight into the UK courts' approach to inventive step. Following a recent line of case law, the Court of Appeal has again pared the assessment of inventive step back to the very basic question of whether or not the invention was obvious, period, rather than obvious to try. Placing emphasis on an 'obvious to try' question is an approach often favoured by parties arguing against the presence of an inventive step. It is now clear that an 'obvious to try' argument should be made with care.

[For more information click here](#)

**11**

A storm in a coffee cup

A UK High Court decision that will be popular with coffee drinkers ruled in favour of Dualit, a supplier of coffee capsules, for use with Nestec's "Nespresso" machine. Nestec aimed to prevent Dualit from supplying the capsules on the basis that this amounted to contributory infringement. The trial judge did not agree. Interesting questions arose concerning entitlement to priority, and the ease with which priority can be lost.

[For more information click here](#)



Patents

12

Interim injunctions - The court may take into consideration previous judgements against you

As usual, the pharmaceutical industry has been busy in the courts in the past year. In an interesting case between Bristol-Meyers Squibb (BMS) and Teva, BMS were able to obtain an injunction against Teva to prevent infringement that had not yet occurred. This case will, no doubt, inform the conduct and strategy of generic manufacturers going forward.

[For more information click here](#)

**13**

CJEU attempts to offer clarity in three SPC decisions

Staying with the pharmaceutical industry, 2013 was a bumper year for SPC decisions from the CJEU. In the recent past, CJEU decisions concerning SPCs seem to have caused at least as much confusion as they have addressed. In December 2013, three decisions were handed down on the same day, leaving lots to digest for companies who hold or want to challenge SPCs.

[For more information click here](#)



Designs

14

"I'm out" - Court of Appeal rules no infringement of Trunki design

Turning finally to designs, Magmatic's Registered Community Design covering the 'Trunki' ride-on children's suitcases, which are a common site at UK airports and which were made famous by an appearance on BBC's Dragon's Den, was recently held by the UK Court of Appeal not to be infringed by a competitor's product. It seems that, in this case, a simple line drawing might have served Magmatic better than the computer generated images used in the design registration.

[For more information click here](#)

