

IP Law Update

Winter 2012/13



Welcome to the Winter 2012/13 edition of Withers & Rogers IP Law Update. In this e-publication, you will find links to a number of articles published on our website. These are intended to give our clients and contacts a taste of what has been happening in patent and trade mark litigation in the UK and Europe over the past year.

The period did not fail to produce a number of key, and sometimes surprising, decisions. Indeed, the reports cover several eagerly anticipated decisions of the Court of Justice of the European Union relating to trade marks and supplementary protection certificates for medicinal products. Beyond Europe, we also report on a significant decision of the US Supreme Court concerning the exclusion from patentability of natural laws. Also included are decisions of lower tribunals covering, among other topics, patentability of pharmaceutical formulations, product marking and late payment of fees at the European Patent Office.

We have also included a piece on a recent decision of the EPO which could materially affect the deadline for filing divisional applications on certain cases. We have already identified cases under our care which may be affected, and are in touch with clients to provide further advice where necessary.

Although it is not covered in the following reports, mention must be made of the further progress towards the European Union Unitary Patent. The key hurdles of the language regime and the operation and location of the Unified Patent Court appear now to have been largely overcome. For better or

worse, it now seems more likely than not that this key change in the way in which European patents are obtained and litigated will come into effect, probably in 2014.

As ever, the broader political and economic scene has had an impact on the world of IP. It is impressive that despite the Eurozone crisis and the “fiscal cliff” threat in the US, the Unitary Patent legislation and the bringing into effect of major changes in US patent law have not been derailed. Doubt remains in the minds of some commentators, however, whether the EU Unitary Patent legislation may actually have been given the time and care it really needed.

One interesting change to have arisen from the recent economic troubles, and the UK Government’s wish to promote growth, is the introduction of the Patent Box regime. This could allow innovative companies to significantly reduce their corporation tax burden and may, in some instances, change the rationale for seeking patent protection altogether. Further information on Patent Box can be found [here](#).

As always, I hope you find the Update useful. We wish you all the best for 2013!



Nicholas Jones
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01



More confusion over divisional applications at the EPO

Following a recent Legal Board of Appeal Decision, the EPO has issued a Notice that may affect any deadline you or your clients may have for filing European divisional applications (although this time in a good way!).

[For more information click here](#)



02



CJEU gets Bullish when considering trade mark use by packaging company

Following a series of hearings originating in the Benelux courts, the Court of Justice of the European Union (CJEU) was asked to consider whether the filling of pre-labelled cans bearing branding allegedly similar to the well-known RED BULL trade mark amounted to trade mark infringement. The CJEU determined that merely offering the service of filling packaging without having a commercial interest in the branding applied to the packaging did not amount to use of the relevant signs in the course of trade. Consequently, a finding of no infringement was reached.

[For more information click here](#)



03



Multiple SPCs for same basic patent

During 2011, several decisions (including on referral to the CJEU) were handed down concerning supplementary protection certificates (SPCs) for medicinal products. As reported in our Winter 2011/12 IP Law Update, a CJEU decision had led to additional questions for companies and advisors having an interest in this important area of patent law. During 2012, European national courts have had a chance to interpret the CJEU decision and, in most cases, provide a degree of comfort for SPC applicants and holders. In this decision, the UK Patents Court found that multiple SPCs may be granted for different products covered by the same basic patent.

[For more information click here](#)



04



Surgical methods - the EPO draws a line

Following the EPO Enlarged Board of Appeal decision G1/07, a number of decisions of the EPO have been issued concerning the exclusion from patentability of methods for treatment of the human or animal body by surgery. Although G1/07 provided a series of criteria which had to be met in order for a method to fall foul of the exclusion, the application of these criteria to individual cases has not always proved straightforward. In this Technical Board of Appeal decision, claims directed to a method of measuring the rate of blood flow and involving haemodialysis were concluded to fall within the exclusion. The patent proprietor in this case was in the fortunate position, however, of being able to settle for claims to a patentable apparatus for carrying out the process.

[For more information click here](#)



05



The CJEU on the scope of SPCs covering combination products

Following a referral from the UK Patents Court, the CJEU was asked to consider whether an SPC for a single active ingredient covered a third party product containing that active ingredient in combination with another active ingredient. It was decided that the scope of such an SPC should be interpreted in a similar manner to that of a corresponding patent claim, such that the combination product was indeed covered by the SPC.

[For more information click here](#)



06



Prometheus - the US position on patentability of "natural laws" clarified

Breaking from UK and European matters, we report here on a decision of the US Supreme Court concerning the patentability of a method for optimising a therapeutic treatment using a known drug. The patent proprietor, Prometheus Laboratories Inc, had determined that the blood levels of a metabolite of the drug could be defined in such a way as to determine whether the dose of drug needed to be increased or decreased. Like the Prometheus of Greek legend, the patent proprietor was unable to protect a natural law, with the Supreme Court finding that the claimed method amounted to nothing more than simply applying the natural law in a conventional or obvious way. As a result of this decision, the Supreme Court also asked the Court of Appeals for the Federal Circuit to reconsider its decision in the Myriad case, concerning patentability of DNA sequences. Pleasingly for the biotechnology industry, it was concluded that such inventions were still patentable in principle.

[For more information click here](#)



07



Patentability of pharmaceutical formulations - a difference of opinion

This UK Patents Court decision looks at the patentability of a sustained release formulation of the drug quetiapine. Despite the patent proprietor's contention that sustained release formulations of such drugs were difficult to obtain, the court found that the claimed invention was obvious. In a conflicting decision, the court in the Netherlands found the claimed invention to be inventive, illustrating that patent litigation across Europe is still by no means harmonised.

[For more information click here](#)



08



Trade mark dilution bites back

In this decision of the EU General Court on appeal from OHIM (the European Community Trade Mark Office), consideration was given to the impact of trade mark dilution on trade mark infringement and the registrability of later trade marks (in this case, where both the earlier and later marks contained depictions of wolves' heads). It was indicated that, in order for trade mark proprietors to protect their marks from potential dilution by later marks, only the future risk of detriment needed to be demonstrated.

[For more information click here](#)



09



IP Translator - Clarification of trade mark class headings

The Chartered Institute of Patent Attorneys applied to register the trade mark “IP Translator” using a broad trade mark class heading. The application was intended as a test case to determine whether all services officially listed under the relevant class heading would be deemed to be covered, even though such services were not specifically listed in the application. The CJEU confirmed that goods and services needed to be identified with enough precision to allow determination of the extent of the coverage on that basis alone. As such, applicants must specify in each case whether or not the use of a class heading is intended to cover all the goods or services contained in the relevant list, or only a certain selection thereof.

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The future looks bright for new uses of known drugs

In this decision of the CJEU, it was concluded that an SPC could be granted for a new use of a known drug, even where that drug has been the subject of a previous SPC. Our report on the opinion of the Advocate-General can be found [here](#), whilst a summary of the decision of the CJEU can be found using the link below.

[For more information click here](#)



11



Brand owners have the right to control first marketing of goods in the EEA

The concepts of European exhaustion of rights and parallel importation have led to a number of significant decisions over the last decade or so. In *Oracle America v M-Tech Data*, the UK Supreme Court further enhanced the ability of trade mark owners to prevent third parties from bringing goods into the European Economic Area for the first time, unless consent of the trade mark owner is given.

[For more information click here](#)



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Limitations on the use of post-dated experimental evidence

Post-dated experimental evidence (that is, evidence presented after the filing date of a patent application) is frequently used during patent prosecution to demonstrate the presence of an inventive step. The UK Patents Court was asked to consider, in the case of *Generics v Yeda*, whether post-dated evidence which conflicted with the evidence shown in the patent could be used to demonstrate that the patent disclosure did not actually make it plausible that the technical problem behind the invention had been successfully solved. The court decided that such evidence could not be used in this way and that, once a technical result has been decided to be plausible based on the disclosure of the patent itself, later contradictory data should not alter this conclusion.

[For more information click here](#)



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Product marking in the spotlight

It is rare that the issue of product marking is considered in patent litigation. In the case of *Schenck Rotec v Universal Balancing*, the infringing party was successfully able to limit the damages awarded against it by relying on the defence that, since the patent proprietor had not marked its products or website with the relevant patent number, there was no reason to believe that a patent existed which covered the product.

[For more information click here](#)



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Extension states - a cautionary tale

Under the European Patent Convention (EPC) it is possible to obtain territorial coverage for a number of countries which, whilst not being contracting states to the EPC, have nevertheless signed "extension agreements" with the EPO. Whilst the number of such "extension states" has decreased in recent years as these countries have become full contracting states to the EPC, a couple of countries still require the extension route to be adopted if a European patent is to become effective in their territories. A recent decision of a Legal Board of Appeal of the EPO considered whether it was possible to pay the extension fees for effecting designation of extension states after the deadline for entering an international application into the European regional phase. Under the circumstances of the case it was decided that this was not possible, and the decision illustrates how a key remedy available under the EPC is limited by the scope of the extension agreements.

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