

IP Law Update

Autumn 2015

Welcome to the Autumn 2015 edition of the Withers & Rogers IP Law Update. This e-newsletter provides a round-up of our articles covering some of the more important intellectual property cases that have been decided in the UK and Europe in the past year.

As we've come to expect, it's been a busy year in the courts, with the UK Supreme Court hearing both patent and trade mark cases, as well as at the EPO, with several rulings from the Enlarged Board of Appeal. A high level of M&A activity, particularly in the pharma sector, has been a feature of the past year and is likely to continue for at least the next few months. The UPC also rumbles on, with the past year having seen a number of important developments.

With IP filtering more and more into the public consciousness, and IP stories regularly hitting the headlines, we have a great opportunity as IP professionals to inform and educate. We hope that you find this publication informative and interesting. Please get in touch if you would like to speak to us about any of the issues covered.



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UK Patent Cases



Wind turbine speed control patent win for Siemens AG

By Richard Worthington

Wobben Properties GmbH v Siemens PLC & Others

This High Court case relating to High Wind Ride Through (HWRT) technology highlights the importance of considering the impact of general advancements in the state of the art between the date of prior art and that of a later filed patent against which it is used. The important question is, what would the skilled person have obviously done in light of those advancements?

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Itchy combinations and the power of common general knowledge

By Helen Henderson

Teva UK Limited and Another v Leo Pharma A/S and Another

The decision by Mr Justice Birss in the Patents Court provides an interesting commentary on the assessment of obviousness and common general knowledge for combination inventions. As this case shows, inventors in the field may benefit from devoting more time to comparative studies.

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Scope of protection: around and around the numbers

By Emily Collins and Elizabeth Swan

Smith & Nephew Plc v ConvaTec Technologies Inc

The Court of Appeal issued an interesting and somewhat controversial decision concerning how the boundaries of a range in a claim should be interpreted. The court asked: would the skilled person assume that the patentee had intended for the boundary of the claimed range to be rounded to a certain degree of accuracy, and, if so, which rounding convention would they have used?

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UK Patent Cases

Court of Appeal overturns cross jurisdiction award of DNIs to Actavis

By Kirsty Simpson

Actavis UK Ltd & Others v Eli Lilly & Company

The saga continued in this long running patent dispute between Actavis and Eli Lilly with respect to Eli Lilly's patent relating to the use of the anti-cancer drug pemetrexed disodium (marketed as Alimta®). In a change to decades of case law, the possibility that prosecution history might become important in UK patent litigation, analogous to "file wrapper estoppel" in the US, was considered in this case.

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Innovative relief for second medical use patent holders

By Justin Wilson

Warner-Lambert Company, LLC v Actavis Group Pte EHF & Others

The decision in this case heralds the first time that a UK court has granted an order that directly affects the prescribing practice of doctors. In ongoing UK High Court litigation between Warner-Lambert and Actavis, Mr Justice Arnold granted an order mandating the National Health Service to issue guidance to doctors and pharmacists that the drug pregablin must only be prescribed for the treatment of neuropathic pain (a patented indication) under the brand name Lyrica® and not using the generic name pregablin.

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First mover advantage valued highly by the Court of Appeal

By Elizabeth Swan

AstraZeneca AB & Another v KRKA dd Novo Mesto & Another

In this case about stomach ulcer treatments and interim injunctions, the Court of Appeal upheld the finding of the Patents Court that the claimant, Astra Zeneca (AZ), should pay £27 million in damages to the defendants Krka and Consilient. This is one of the largest ever awards made in a case of this kind.

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Are the public interested in patent infringement? Not according to the Supreme Court

By Andrew Evitt

Les Laboratoires Servier & Another v Apotex Inc & Others

The highest court in the UK this year considered the thorny issue of damages in multi-national infringement proceedings. The Supreme Court ruled that patent infringement does not engage the public interest. It appears that the "illegality defence", which relies on harmful effects on public well-being, cannot be used to avoid paying injunctive damages relating to potential patent infringement.

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European Patent Cases



Products of essentially biological processes deemed patentable

By Andrew Evitt

*Enlarged Board of Appeal G2/12 and G2/13
("Tomato II" and "Broccoli II" cases)*

The European Patent Convention sets out that "essentially biological processes" for producing plants or animals are excluded from patentability. In welcome news for the biotech industry, the Enlarged Board of Appeal ruled that the patentability exclusion for essentially biological processes does not extend to the products of those processes.

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Medical devices left out in the cold

By Elizabeth Swan

Board of Appeal T773/10


This recent decision from the EPO has confirmed that medical devices cannot be protected using second medical use claims. The applicant argued that the provisions that allow "substances or compositions" to be patentable in this format should be interpreted broadly to cover medical devices. The Board of Appeal did not agree.

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European Patent Cases



Ruling out the prior art

By Jack Whitfield

Board of Appeal T 1488/10

This decision examines whether or not a feature in a figure of a prior art document can be measured to assert that a claim is not novel, if the figure appears to be to scale. The case is interesting in that although the cited prior art document included a schematic drawing, unusually the schematic drawing specified the dimensions of certain parts, but not the part that was critical to the case.

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Second medical use claims: time to drop the Swiss?

By Kirsty Simpson

Board of Appeal T1570/09

Here, the Board of Appeal of the European Patent Office had to decide on a claim set that included both a Swiss-type claim and a purpose-limited product claim under Article 54(5) EPC 2000. Read more if you are interested in which prevailed, and for practical tips.

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Can a FRAND SEP stop ZTE?

The CJEU rules on the rules

By David Nicholls and Russell Barton

Huawei Technologies Co. Ltd v ZTE Corp. and ZTE Deutschland GmbH (ZTE)

In this article we examine the criteria set out by the CJEU to determine when the owner of a FRAND encumbered patent may seek an injunction when the owner is in a dominant market position. The judgment acts as an important reminder of the necessary conduct of both SEP proprietors and users to ensure that their respective obligations are maintained.

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Trade Marks



UK Court of Appeal orders re-trial in Interflora v M&S keyword advertising battle

By Mark Caddle

Interflora Inc and Another v Marks and Spencer Plc

The latest decision in the long-running dispute between Interflora and Marks and Spencer (M&S) concerns M&S' use of the INTERFLORA trade mark in internet keyword advertising. The UK Court of Appeal has ordered that the case undergo re-trial in the High Court, overturning Mr Justice Arnold's earlier decision in favour of Interflora by allowing M&S' appeal. Find out the reasoning behind this decision in this article.

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VOLVO and LOVOL – not similar

By Martha Murray

Volvo Trademark Holding AB v OHIM

The car manufacturer Volvo has failed in its most recent attempt to prevent the registration of two figurative trade marks containing the sign LOVOL. Hebei Aulion Heavy Industries, a Chinese company, had applied to register LOVOL marks to cover machines and vehicles more specifically for agricultural use. Volvo opposed the marks.

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A departure from established UK case law on passing off? Not NOW, says UK Supreme Court

By Charles King

Starbucks (HK) Limited and Another v British Sky Broadcasting Group PLC and Others

This case is indicative of the growing tension between the territorial nature of IP rights and the ubiquitous use of a borderless internet as a means of marketing and delivering goods and services. The question that arose was, where an undertaking has no paying customers in the UK for goods sold under a mark and therefore no goodwill, can a claim for passing off succeed on the basis of the mark's reputation alone?

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Streamlined global design rights protection becomes a reality as the US and Japan sign up to the Hague System

By Richard Worthington

In a significant development in design law, the US and Japan became official members of the Hague System on 13 May 2015. This will serve to increase the popularity of the system, which reported a 10% annual rise in the number of Hague design filings earlier this year.

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Important lessons on unregistered design right from the fashion industry

By Jennifer Unsworth

G-Star Raw CV v Rhodi Ltd & Others

One of few fashion designs cases that has reached the High Court in recent times has provided useful guidance on the assessment of unregistered design right infringement in the UK. Find out how G-Star, a leading European denim fashion brand and owner of the ARC Pant, was successful in proving that the Voi brand infringed its design rights and that four Rhodi companies were liable for the infringement.

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