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Welcome to the latest edition of our *Mewsletter* in which we highlight some of the recent news and developments in European and UK intellectual property.

Our lead article in this issue focuses on changes to the UK Patents Act which are currently before Parliament. Although few of these changes are "headline grabbers" in their own right, the total effect is to relax some of the more onerous rules on formal matters, resulting in general simplification and greater accessibility.

Continuing on the theme of simplification, it does not seem particularly long since this publication was discussing the last major change to the PCT with the general extension of Chapter I from 20 to 30 months. Now what is arguably the completion of that process sees the abolition of designations and designation fees, and the introduction of a "search opinion". Compared to the system in place five years ago, the PCT is now considerably streamlined and generally less complex.

On the European front, the decision of the European Parliament approving a radically amended Directive on the Patenting of Software has already received worldwide attention. At the moment it seems that this particular project may rapidly disappear into obscurity, leaving discrepancies between the EPO and national Courts and Patent Offices as to the validity and allowable scope of patents in this area and consequently an undesirable degree of uncertainty for applicants and the public alike.

However, one issue that looks set to be around for many years to come is the inherent conflict between competition law and IP, and this is revisited with the proposed revision of the EU's Technology Transfer Block Exemption Regulation. We review the significant changes and their likely impact.

The long-running dispute between "Mr & Mrs Douglas" and *Hello!* magazine over their wedding photographs rumbles on with the conclusion of the damages hearing in November and the costs judgement in January. Readers of the British press at least may have been confused by conflicting reports as to which side actually won, so hopefully we can clear this up. However, this case could be with us for some time yet, as *Hello!* at least intends to appeal.

Shortly before going to press, the President of the EPO referred to the Enlarged Board of Appeal various questions on the allowability of claims relating to methods of diagnosis. This follows decision T964/99 in which a Technical Board of Appeal stated that claims to methods which were "of value for diagnosis" should be excluded, apparently overturning established case law in this area. All examination and opposition proceedings where the decision depends entirely on the Enlarged Board's decision will be suspended. We will report further on this in the next issue.

On an administrative note, we intend to make greater use of e-mail in the distribution of future issues of this newsletter. A soft-copy version of the present issue is available from our website or on request by e-mailing mewsletter@mewburn.com. If you wish to receive future copies in electronic form, please also use this e-mail address to contact us. Feedback from previous issues indicates that there have been technical problems with this address, but we believe that these have now been rectified. E-mail addresses submitted to this address will not be used for other purposes.

Finally, we wish to announce that we will be a Limited Liability Partnership (LLP) from 1st April 2004. A separate note on this will be sent to all our clients.

LONDON
York House
23 Kingsway
London UK
WC2B 6HP
tel +44 (0)20 7240 4405
fax +44 (0)20 7240 9339

BRISTOL
No. 1 Redcliff Street
Bristol
BS1 6NP
tel 0117 926 6411
fax 0117 926 5692

CAMBRIDGE
Newnham House
Cambridge Business Park
Cambridge
CB4 0WZ
tel 01223 420383
fax 01223 423792

MANCHESTER
Bridgewater House
Whitworth Street
Manchester
M1 6LT
tel 0161 247 7722
fax 0161 247 7766

Changes to the UK Patents Act

In 2003 a consultation document was issued by the UK Patent Office relating to proposed changes to the UK Patents Act 1977. Following some amendment due to comments received, a Regulatory Reform Order has now been put before Parliament in order to implement these changes.

The proposed changes are directed towards removing a number of the burdens on applicants in the Patents Act by removing some of the “red tape” that is presently found in the patent application system. The changes also bring the Patents Act 1977 into line with the WIPO Patent Law Treaty, signed in 2000.

The proposed changes can be split into six main areas of interest:

- date of filing an application
- procedural aspects of the application
- time limits
- priority claims
- national security considerations
- patent transactions

Date of filing

Presently, to receive a filing date from the Patent Office, an application must at least: contain a request for a patent; identify the applicant(s); contain a description of the invention; and be covered by a filing fee (presently set at nil).

Under the proposed changes, the identity of the applicant(s) may be substituted by means allowing the Patent Office to contact the applicant, with the identity of the applicant being supplied at a later date.

Also, a full description of the invention will no longer be required to receive a filing date. Instead, either “something which appears to be a description of the invention” or a reference to a previous application can be supplied, with a full description and a copy of the earlier application being filed before a later date. This will allow applicants, for example, to obtain a filing date based on a description in a foreign language, as long as it appears to be a description and a translation is filed before a later date, or based simply on a reference to an earlier application.

The “later date” referred to above is expected to be the date under the present law for completing the application formalities (the later of twelve months from the priority date or one month from filing).

Procedural aspects of the application

Under the new law, a new “application fee” will be payable before the expiry of the time limit for completing the application formalities (see above). This fee will take the place of the present filing fee (currently set at nil). The application fee is intended to cover work performed by the Patent Office in processing the application. The amount of the fee has not yet been set, but it is proposed that the present combined preliminary examination and search fee will be split between the application fee and a separate search fee.

Time limits

Under the new law, the applicant will have the right to extend once *any* time limit set by the Comptroller, as long as the application for the extension is made within the initial time limit. It is proposed to set the length of this extension at two months with a fee payable for obtaining the extension. This covers time limits, such as responses to Examination Reports, to which extensions are currently only available at the discretion of the Comptroller. It will still be possible to request further extensions of such time limits at the discretion of the Comptroller.

Priority claims

The requirements for claiming priority are to be altered slightly in the proposed changes to allow priority to be claimed after twelve months from the priority date in certain very restricted circumstances. These are limited to cases where reasonable care has been taken to file the priority claim within the twelve month time limit and where the failure to do so was unintentional.

National security considerations

Under the present legislation, a UK resident who wishes to file a patent application abroad must either file first in the UK and then wait for six weeks, or must seek the permission of the Comptroller to file first

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For a full text of the Regulatory Reform Order, look on the UK Patent Office website at:
<http://www.patent.gov.uk/patent/notices/misc/deregulation.htm>.

Changes to the UK Patents Act (continued)

abroad. This provision is to prevent the disclosure of inventions which may be prejudicial to national security.

Following the proposed changes, the burden of deciding whether an invention is prejudicial to national security will lie with the applicant. Although this may seem like a heavy burden, the Patent Office has drawn up detailed lists of the type of invention which would be considered to prejudice national security, and applicants may apply to the Comptroller for guidance if required.

Overall, this provision is expected to ease the burden on the majority of applicants, whose inventions do not fall within the Patent Office lists, as they will no longer be required to seek the permission of the Comptroller to file first in a foreign country. However, the scope of the lists is still undecided, and could impose significant restrictions in this area (a first draft included the broad term "toxic chemicals").

Patent transactions

Changes to the law relating to patent transactions are also included which will mean that only the signature of the assignor, mortgagor or person assenting to the transaction will be required for a patent transaction. This brings patent law into line with many other types

of intellectual property law for which this is already the case.

When will the proposed changes come into effect?

These proposed changes are due to be enacted by the end of December 2004, with the parts relating to extensions of time applying to requests for extension received after this date.

How will these changes affect you?

The most relevant changes for our clients are thought to be as follows:

- The relaxation of the requirements to obtain a filing date may make it faster, easier and/or cheaper to obtain a filing date in certain circumstances.
- The right to an extension of time limits set by the Comptroller provides certainty for clients wishing to extend certain deadlines at the Patent Office.
- The relaxation of requirements for transactions relating to patents may simplify assignments in some cases.

Douglas v Hello!

It is nearly four years since Michael Douglas and Catherine Zeta-Jones got married. However, the repercussions of the story surrounding the publication of pictures from that wedding in *Hello!* magazine rumble on.

The case started with an attempt by the Douglases (along with their exclusive licensee *OK!*) to obtain an injunction to prevent publication of unauthorised pictures of the wedding in *Hello!*, which was refused by the Court of Appeal on the basis that damages would be a sufficient remedy.

The damages action duly went ahead, and was successful on the principal argument that the images of the wedding were confidential, and that *Hello!*'s publication of illicit photographs had misused this confidential information.

The size of the damages was left to a further hearing, and was decided in November 2003 with awards of £14,500 to the Douglases themselves for distress and wasted expenditure, and of £1,033,156 to *OK!* for their

lost sales of issues containing exclusive authorised pictures. Shortly before going to press, the issue of costs was also decided, with the Douglases and *OK!* being awarded over 75% of their costs, a sum rumoured to be around £2-3 million. Combined with the damages and their own costs, the total cost to *Hello!* is likely to be around £4-5 million.

Coverage in the British press at the time of the first decision managed to imply that it was a victory for *Hello!* (who had successfully defended a number of subsidiary and alternative claims). Even more surprisingly, this attitude continued after the damages decision. Although the award to the Douglases for "non-commercial" damages was small in the general scheme of things, the award to *OK!* actually exceeds what they paid for their exclusive rights in the first place. The judge viewed the amount as not being penal, but "such as may make *Hello!* alive to the un wisdom of its acts".

The case is, however, still far from dead, with *Hello!* at least likely to appeal.

The damages were viewed as not being penal but "such as may make Hello! alive to the un wisdom of its acts".

New EU Technology Transfer Block Exemption Regulation

European competition law (specifically Article 81(1) of the Treaty of Rome) prohibits agreements which have as their object or effect the prevention, restriction or distortion of competition within the common market. Those who have been involved in licensing IP will know that this means that certain terms which parties may wish to include in technology licences are in fact prohibited by European competition law.

However, the European Commission has issued several regulations which provide exemption from Article 81(1) for certain types of agreement provided the effect of the agreement is to promote rather than restrict competition. On 1st October 2003 a new draft technology transfer block exemption regulation was published and it is expected that the final version will come into force on 1st May 2004.

The proposed new block exemption system is somewhat less rigid than the previous version and (unless the current draft is substantially amended before coming into force) exemption will in future depend to a greater extent on the market shares of the parties. The most significant changes are as follows:

1. The "white list" of obligations which were expressly permitted in licences will no longer exist, although a "black list" of prohibited restraints on the parties will remain.
2. The new block exemption has broader scope. It will cover design licences and some software licences as well as patent and know-how licences, provided such licences are primarily for manufacturing purposes. It will not cover multiparty licences. Licences relating solely to trade marks do not fall within the new block exemption.
3. As currently drafted, the new block exemption will only apply if the parties' market shares fall below specified thresholds. For *non-competitors*, neither party's share of the relevant technology or product market may exceed 30%; for parties who are *competitors*, the parties' *combined* share must not exceed 20% of any relevant product or technology market.

Defining markets and assessing market shares can raise complex issues of economic analysis. In addition, since the parties' market shares will change over time, a licence which fell within the block exemption when it was drafted may cease to benefit from the block exemption during its lifetime.

Unless this aspect of the new draft block exemption regulation is amended before it is finalised, there will be very many cases in which the parties cannot rely on the block exemption. In such cases, the parties will have to either apply for an individual exemption (a costly and time-consuming process) or ensure that their licensing arrangements include no terms which are restrictive of competition and thus infringe Article 81(1).

Those involved with licensing should therefore note:

1. It is important to check *now* that the provisions of any new draft licence agreements are either non-restrictive of competition and thus fall outside the scope of Article 81(1) of the Treaty of Rome, or comply with the requirements of the new draft block exemption.
2. It will also be important that existing licences are reviewed once the final version of the block exemption regulation is published to ensure that they do not contain any provisions which infringe Article 81(1) and are not exempted under the terms of this new block exemption.

We will report further on the new block exemption once the final version has been published. In the meantime, please do not hesitate to contact us if you have any queries or concerns about your existing licences, or are planning to enter into any new licensing agreements.

New EPC Contracting State

Poland (PL) has acceded to the EPC, becoming the 28th contracting state. The EPC will enter into force for Poland as from 1st March 2004.

European applications filed on or after that date will be able to designate Poland. PCT applications filed on or after that date will automatically designate Poland as part of a European Patent.

Please note that PCT applications filed before 1st March 2004 will *not* be able to designate Poland when entering the regional phase before the EPO, and separate protection in Poland should be sought.

Exemption will in future depend to a greater extent on the market shares of the parties. However, defining markets and assessing market shares can require complex economic analysis.

Proposed European Software Directive in Difficulty

In September 2003, the European Parliament debated a proposed directive on the patentability of computer-implemented inventions. Many controversial amendments were introduced, principally as a result of highly effective lobbying by the open source community. The result is widely regarded as unworkable by the European patent profession and by some parts of the software industry. Possibly the proposed directive will now be dropped altogether.

The patentability of computer programs has long been a hotly debated topic in Europe. There is a statutory exclusion on the patentability of computer programs in the European Patent Convention (EPC) and the laws of contracting states. However, case law from the EPO Boards of Appeal has come to recognise that there can be patentable inventions that are implemented using computer programs. Given that the EPO is prepared to grant patents for computer programs in certain circumstances, the existence of the statutory exclusion creates considerable legal uncertainty.

At present, the practice of the EPO is to refuse patents for “computer-implemented inventions” unless the invention provides a new “technical effect”. The technical effect must be non-obvious and must be more than the typical interaction between a piece of software and a computer.

An attempt was made to remove the computer program exclusion from the EPC during a revision conference in November 2000. However the attempt was abandoned due to a serious lack of agreement between the contracting states.

Instead, the European Commission proposed a Software Directive, intended to give the current practice of the EPO explicit statutory basis by harmonising national law in this area. Although not perfect, the Commission’s proposal was put forward to the European Parliament for debate and amendment in September 2003.

In the run-up to the debate in the EU Parliament, there was some extremely well organised lobbying, particularly by the software open source community, against the proposed directive. The result was that the directive was amended, in effect, to render it unworkable.

A review of all the significant amendments to the draft directive is beyond the scope of this article. In general, the amendments are intended to further limit or rule out patentability for computer programs, even in the

narrow circumstances in which the EPO currently allows patents to be granted for computer programs.

Two amendments in particular are worth mentioning. The term “industry” is defined for the purposes of European patent law as “the automated production of material goods”. Although the draft directive is intended only to apply to computer-implemented inventions, it is clear that providing such a definition in European patent legislation may have far-reaching consequences because the EPC specifies that an invention must be industrially applicable in order to be patentable. Furthermore, it is stated that “production, handling, processing, distribution and publication of information can never constitute patent infringement”, which would appear to significantly limit the value of patents in fields such as printing.

The next stage in the legislative process is a review by the national governments of the EU member states to see if they can reach agreement on suitable wording for the directive, in the light of the amendments proposed by the EU Parliament. A meeting is due in May 2004. The European patent profession is pushing either for most of Parliament’s amendments to be removed or for the directive to be dropped altogether. We will update you when there is further news.

Disclaimers

The EPO’s Enlarged Board of Appeal (EBA) held oral proceedings in December to discuss the questions of whether disclaimers not having a basis in application as filed are allowable without “addition of subject matter”, and under what circumstances. As is usual in such cases, the EBA did not reach a decision at those proceedings, but hopefully the issue will be resolved in the next few months. In the meantime, all examination and opposition proceedings where the outcome depends entirely on the outcome of proceedings before the EBA are suspended.

This legal process dates back to T323/97 (see issues 4 and 6 of this *Mewsletter*) in which an *obiter* comment from a Board of Appeal blandly stated that a disclaimer not having basis in the application as filed adds subject matter, thus apparently overturning an established line of case law which allowed disclaimers in certain situations. We will keep you updated on any developments in this area.

Many controversial amendments were introduced, principally as a result of lobbying by the open source community. The result is widely regarded as unworkable.

More Changes To The PCT

Significant procedural changes have come into place which affect Patent Cooperation Treaty (PCT) applications filed on or after 1st January 2004.

Enhanced International Search and Preliminary Examination (EISPE)

The PCT search and examination procedure has been significantly revised. Under the “old” system, applications were subject to search (under Chapter I) and optionally subject to examination (under Chapter II, if a Demand was filed). Under the “new” system, all applications filed on or after 1st January 2004 are subject to search *and* examination. This may occur without interaction between the applicant and the Examiner (under Chapter I) or with interaction between the applicant and the Examiner (under Chapter II).

For PCT applications filed on or after 1st January 2004, an Examiner's opinion will be established as part of the international search procedure under Chapter I. An International Preliminary Report on Patentability (IPRP) will be prepared for every application, addressing the questions of whether the claimed invention appears to be novel, involves an inventive step and is industrially applicable.

The procedure will now operate as follows. The International Searching Authority (ISA) will prepare both the International Search Report (ISR) and a preliminary and non-binding Written Opinion (WO/ISA). Optionally, the applicant may file an “informal reply” to the ISO.

If a Chapter II Demand for International Preliminary Examination is not filed, the WO/ISA forms the IPRP, which is sent to the applicant and the designated offices along with any “informal reply” that may have been filed.

If a Chapter II Demand is filed (within the later of three months from issuance of the WO/ISA or 22 months from priority), the IPRP is prepared in the same way as the current International Preliminary Examination Report (IPER). The IPRP is based upon the WO/ISA and any amendments and/or arguments under Article 34 PCT filed at the same time as the Demand addressing objections raised in the WO/ISA. Again, the IPRP is sent to the applicant and the elected offices.

Fee changes

The EPO has increased the International Search Fee for applications filed with European national offices or at the EPO directly by almost 65% (from 945 Euros to 1550 Euros). This increase apparently reflects the additional work required to prepare the WO/ISA.

Rationalised Designation System

For PCT applications filed on or after 1st January 2004, it is no longer necessary (or possible) to choose which member states or which types of protection (e.g., patents, utility models, etc.) you wish. Instead, the PCT application provides automatic coverage for all member states and all types of protection available under the PCT at the time of filing the International application. However, if desired, it is possible to exclude Germany, South Korea, and/or the Russian Federation; it is also possible to withdraw any of the designations, at the time of filing, or later. The previous “basic fee” and “designation fees” have been replaced by a new flat “international filing fee”, which is approximately equal to previous fees payable when making five or more designations.

“Reservation Countries”

Singapore withdrew its reservation to the amended Article 22(1) PCT with effect from 1 January 2004. The deadline for bringing PCT applications into the national phase in Singapore is now 30 months, whether or not a Chapter II Demand has been filed.

Note that, if you wish to extend the deadline for entering the national phase from 20 months to 30 months from priority in the remaining “reservation countries” (Brazil, Norway, Serbia & Montenegro; the other reservation countries are available via regional patents for which the deadline is automatically extended to 30 months), it is still necessary to file a Chapter II Demand by 19 months from priority.

New PCT States

As of 1st January August 2003, there are 123 contracting states to the PCT. The most recent additions are: Egypt (EG), Botswana (BW) (also a member of ARIPO (AP)), and Namibia (NA). Notably, Argentina, Chile, Pakistan, Taiwan, Thailand, and Malaysia are still not contracting states.

An IPRP will be prepared for every application, addressing the questions of whether the claimed invention appears to be novel, involves an inventive step and is industrially applicable.

A Sound Judgement?

In the recent case of *Shield Mark v KIST*, the claimant was the proprietor of several Benelux trade mark registrations for sound marks. Examples of the marks were: musical notation from Beethoven's *Für Elise*; an alphabetic sequence of musical notes; and the word "Kukelekuuuuu" - a Dutch onomatopoeia suggesting in English a "cock crow".

The claimant brought proceedings for trade mark infringement and unfair competition against a Mr Kist, claiming that he had used both *Für Elise* and a "cock crow" in an advertising campaign for his business. The court dismissed the action insofar as the claim for trade mark infringement was concerned, on the ground that it was the intention of the Benelux Government to refuse the registration of sounds as trade marks.

The claimant appealed and the Appeal Court sought guidance from the European Court of Justice on the issue of whether the EU Trade Marks Directive (which is designed to approximate the laws of member states relating to trade marks) allows sounds to be registered as trade marks.

The first question the Court considered was whether Article 2 of the Directive precludes sound marks from registration. Article 2 defines the types of signs of which a trade mark may consist. These signs must be capable of distinguishing the goods and services concerned, and must be capable of graphic representation. Whilst sound marks are not expressly included in the list of acceptable signs in Article 2, the Court decided that this list of signs was not exhaustive and that signs which are not in themselves capable of being represented visually (e.g. sounds) are not *expressly* excluded from registration as long as they are: a) capable of being represented graphically; and b) capable of distinguishing the goods concerned.

The Court then went on to consider the conditions which would allow a sound sign to be represented graphically. The Court decided that these requirements were *not* satisfied when the sound sign was represented graphically either:

- by means of a mere written description of the sound in question; or
- by a simple onomatopoeia; or
- by a mere sequence of musical notes without further detail.

The Court decided that the requirements for graphical representations *are* satisfied if the sign is represented

graphically by a musical staff divided into bars showing in particular the musical notes and other relevant musical notation, including their duration.

Whilst the Court's judgement is to be welcomed as providing clarification on some of the issues affecting the registration of sound marks, it would however seem to impose greater difficulties on those seeking to register non-musical "sound signs", e.g. a lion's roar or the sound of laughter etc., given the potential difficulties of representing these sounds graphically in accordance with the Court's judgement. Whilst it is clear from the Court's judgement that these non-musical sounds are not expressly excluded from registration, nevertheless considerable care should be taken in the drafting of the appropriate written descriptions when applying to register these kinds of sound marks.

The exclusion of sound signs represented by means of a mere written description also seems to apply a different criterion from that used in another class of "non-visible marks": smell marks. In the latter area, CTM registrations have been obtained for marks with descriptions such as "the smell of fresh cut grass"; "the smell of roses".

Madrid Protocol Expands

Two highly significant steps in the expansion of the Madrid Protocol for international registration of trade marks have occurred in recent months.

On 2nd November 2003 the USA ratified and acceded to the Protocol, thus allowing proprietors or applicants in existing Protocol countries the opportunity to extend their international application or registration to the US, as well as opening up the Protocol system to US applicants/proprietors.

On 27th October 2003 the European Union decided to ratify the Protocol and to deposit its instrument of accession with WIPO. Formal accession is expected some time in 2004, at which point CTM applications/registrations will be available under the Protocol.

These events will make two of the most significant worldwide trade mark jurisdictions available under the Protocol and can only serve to increase the attractiveness of the Protocol to its users.

Sound marks are not sufficiently graphically represented by: mere written description; simple onomatopoeia; or a mere sequence of musical notes without further detail.

In-House News



Nicholas Sutcliffe (above) joined the partnership on 1st October 2003. Nick has worked at Mewburn Ellis since 1997 and specialises in patents in the fields of biotechnology, immunology, genetics and

biochemistry. He has two young children and is a keen rugby player. Asked to describe his life in three words his immediate response was "Patents, Children, Rugby", which was later translated to "Need more sleep."

Since the last Mewsletter, Richard Clegg, Graham Forrest, Daniel Holt and Wilhelmus Wytenburg have all qualified as European Patent Attorneys. Daniel and Wilhelmus have also qualified as UK Patent Attorneys.

March 2004 sees the retirement of Stuart Macintyre, our administration manager, after 17 years with the firm. Using his army experience to good effect, he has notably organised and supervised the movements of each of our offices to at least one new set of premises and has also been integral in organising our annual course on the European Patent. We welcome Dianna Baker as his successor and look forward to her building on Stuart's legacy.

Mewburn Ellis Publications

Mewburn Ellis produces a number of information sheets on common aspects of Intellectual Property Law. All these sheets are available on request or can be viewed and downloaded from our website.

European Patent Convention (EPC) Contracting States

Austria	Liechtenstein
Belgium	Luxembourg
Bulgaria	Monaco
Cyprus	Netherlands
Czech Republic	Poland*
Denmark	Portugal
Estonia	Romania
Finland	Slovak Republic
France	Slovenia
Germany	Spain
Greece	Sweden
Hungary	Switzerland
Ireland	Turkey
Italy	United Kingdom

* From 1st March 2004

EPC Extension Countries

Albania	Lithuania
Latvia	Macedonia

EU Member States (Community Trade Mark and Community Designs)

Austria	Italy
Belgium	Luxembourg
Denmark	Netherlands
Finland	Portugal
France	Spain
Germany	Sweden
Greece	United Kingdom
Ireland	

EU Enlargement Countries

Cyprus	Lithuania
Czech Republic	Malta
Estonia	Poland
Hungary	Slovakia
Latvia	Slovenia

On 1st May 2004 the above countries will join the EU. Existing Community applications and registrations will automatically be extended to cover these countries.

EPO Holiday Dates 2003

9th & 12th April
30th April
5th May
20th May
31st May
10th June
1st November
24th December
31st December

OHIM Holiday Dates 2003

9th & 12th April
22nd April
20th May
31st May
24th June
12th October
1st November
6th December
24th to 31st December

Website addresses

UK Patent Office:	www.patent.gov.uk
EPO:	www.european-patent-office.org
World Intellectual Property Organisation (WIPO):	www.wipo.org
OHIM:	www.oami.eu.int
Mewburn Ellis:	www.mewburn.com

The information in this newsletter is simplified and must not be taken as a definitive statement of the law or practice. If you would like any more information, please ask your usual Mewburn Ellis contact, or e-mail us at: mewsletter@mewburn.com.