

mewburn ellis llp's review of recent developments in ip law

The Enlarged Board of Appeal of the EPO has been busy in recent months, deciding cases on the admissibility of disclaimers and the ability to claim priority under the EPC from a WTO country. However, they will have little time to relax as they have now been asked to consider the law relating to the exclusion from patentability of diagnostic methods.

Regular readers will recall the origins of the "disclaimers case" which was first reported in issue 4. A single Board of Appeal decision appeared to have overturned an established line of case law allowing, in certain situations, disclaimers not having explicit basis in the application as filed. The Enlarged Board's decision puts much of the previous practice back in place, but with a worrying caveat. Any disclaimer which is *or becomes* relevant to inventive step is not allowed. Thus a disclaimer which is validly added during Examination may later become unallowable. If this change in status occurs post-grant the patentee is in an inescapable trap, since to remove the disclaimer would inevitably broaden the scope of the patent.

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1st May 2004 saw the expansion of the European Union to include a further ten countries. Community trade marks and designs thus have even greater reach, but enlargement may yet prove to be the final straw for the Community patent, which appears irrevocably stalled on the issue of translations and now requires the unanimous approval of the 25 member states. In the pharmaceutical and agrochemical industries expansion also opens up the possibility of Supplementary Protection Certificates being obtained in the new member states, and a more detailed analysis is on page 8.

The procedure for oppositions to UK trade mark applications has recently been the subject of a significant overhaul. Most significantly, a "cooling-off period" has been introduced and an opponent must now prove use of old marks on which an opposition is based, thus avoiding the need for applicants to separately challenge the validity of those marks. These changes bring UK opposition procedure broadly into line with CTM oppositions, although there are still significant procedural differences.

The CTM Regulation itself has also undergone the first significant changes since its introduction in 1996. Amongst other changes, the requirements for ownership have been considerably simplified, the official searches will become optional and division of applications and registrations will be possible. More details are given on pages 4 and 5.

Finally, following successful trials, we are pleased to be able to offer our clients an "extranet" service which allows secure access over the internet to information about your applications held on our Records system. Turn to page 11 for more details and information on how to access this service. ❖

disclaimers at the epo

Regular readers of this *Mewsletter* will be aware that disclaimers have been a hot topic at the EPO for some time (see issues 4, 6 and 7).

background

Article 123(2) of the European Patent Convention (EPC) prohibits addition of subject matter to a patent or patent application after it has been filed. Nevertheless, a line of case law from the EPO's Boards of Appeal has traditionally allowed disclaimers (negative limitations) having no basis in the application as filed to be introduced into patent claims under certain circumstances. This provided a convenient way for applicants to avoid certain types of prior art. In particular, disclaimers have been used to avoid earlier European patent applications which were unpublished at the priority date of the application in question (deemed to be prior art for assessing novelty only under Article 54(3) EPC) and so-called "accidental anticipations" which destroy the novelty of a claim, but would not be relevant for considering inventive step.

A classic example of an accidental anticipation is where an application discloses a novel class of chemicals which has been found to be useful for a particular purpose. This would normally support a claim to that class of compounds. An earlier publication which discloses one specific compound within the class, without making any mention of the useful property, would destroy novelty of the class. However if the single previously-known compound can be disclaimed, then the earlier document is no longer relevant for either novelty or inventive step.

In 2002, a single Board of Appeal decided that disclaimers having no basis in the application as filed could not be allowed under any circumstances (decision T323/97). Their reasoning extrapolated from the Enlarged Board of Appeal's decision G2/98, which was actually concerned with priority rights. A different Board subsequently described this interpretation of G2/98 as "adventurous".

Feeling that T323/97 conflicted with the established case law, two more Boards of Appeal asked the Enlarged Board of Appeal to decide once and for all whether disclaimers with no basis in the application as filed could ever be admissible and, if so, in what circumstances. All examination and opposition cases whose outcome depended on the decision of the Enlarged Board were suspended.

decision of the enlarged board

After oral proceedings in December, the Enlarged Board published their written decision in April as G1/03 and G2/03.

The Enlarged Board specifically disapproved T323/97 and its reliance on G2/98. Instead, they adopted the reasoning from earlier Enlarged Board decision G1/93, which had held that amendments having no basis in the application as filed did not fall foul of Article 123(2) if they make no technical contribution to the claimed subject matter. As a result, disclaimers may be allowed under certain circumstances.

article 54(3) prior art

Firstly, disclaimers can be used to establish novelty over documents which are prior art under Article 54(3). The Board decided that the purpose of Article 54(3) was to prevent the same subject matter being patented independently in separate applications. An applicant should therefore be entitled to exclude material present in a prior unpublished application in order that they can properly protect novel material present in their own application. Otherwise, the earlier application has a greater effect on later applications than was intended by the legislator.

accidental anticipation

A disclaimer may also be used to establish novelty over an accidental anticipation. Although this term was used in earlier case law (see above), its exact scope was somewhat confused. The Enlarged Board has now defined an accidental anticipation as a document which is published before the priority date of the application, but which is "so unrelated and remote that the person skilled in the art would never have taken it into consideration when working on the invention". Even this definition leaves scope for interpretation and could be construed rather narrowly.

From the opposite perspective, the Board explicitly states that disclaimers are not allowed to overcome prior art which is, or becomes, relevant for considering inventive step.

exclusions from patentability

Subject matter which is excluded from patentability for non-technical reasons may also be disclaimed. This covers situations like the famous "Edinburgh patent", where the term "non-human" was introduced so that a claim to a method of animal cloning did not also cover

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disclaimers may be allowed under certain circumstances

disclaimers at the epo (continued)

human cloning in contravention of the European Biotechnology Directive. The Board accepts that applicants may need to take account of changes in the law between filing and grant, and that applicants cannot be expected to take account of all exclusions from patentability in all jurisdictions when drafting patent applications.

sufficiency

Disclaimers may *not* be used to exclude non-functional embodiments, as had been allowed in a couple of isolated cases some years ago. The Board considered that such an amendment would make a technical teaching which was not disclosed in the application as filed, so cannot be allowed.

form of disclaimer

A disclaimer must be drafted so that it does not remove more than is necessary to restore novelty, or remove excluded subject matter. It must also comply with the clarity and conciseness requirements of the EPC. However a disclaimer need not use wording directly from the prior art document where the terminology of the prior art and the application differ, because this would cause a lack of clarity.

consequences

On its face, the decision appears largely to restore the position before the controversial T323/97. However, problems remain.

The definition of an accidental anticipation is so narrow that it may only rarely be applicable. Whether an anticipation is accidental or not is also a subjective question, and the answer to that question may depend on what other prior art is available. A new document may cause inventive step to be reassessed and prior art which was once far enough removed from the invention to be considered an accidental anticipation may suddenly become “relevant to inventive step”. According to the Enlarged Board, the disclaimer may then violate Article 123(2).

Situations like this are unusual in examination proceedings, but more common in opposition, after the patent has been granted. There,

Article 123(3) also becomes relevant, which states that the scope of a claim cannot be broadened after grant.

Thus a disclaimer may become inadmissible after grant of a patent. The patent then contains a disclaimer which impermissibly adds subject matter, but which the patentee cannot delete because to do so would broaden the scope of the claim. This is an inescapable trap which leads, inevitably, to revocation of the patent.

A similar problem may arise if a claim is found after grant not to be entitled to priority. Documents which were once prior art under Article 54(3) may then become full prior art and relevant to inventive step. Again, a disclaimer may suddenly become unallowable, with fatal consequences for the patent.

summary

Although the decision of the Enlarged Board expressly allows disclaimers, the criteria for determining their admissibility are subjective and open to reassessment throughout the lifetime of a patent. Consequently, a disclaimer may be found inadmissible after grant for reasons which could not be foreseen at the time it was drafted. This could cause a patent to be revoked with no means of redress for the patentee.

Despite the positive face of the decision, then, it appears that in future disclaimers should only be used with extreme caution. ❖

pct update

Norway (NO) removed its reservation under Article 22(1) PCT with effect from 1st February 2004. For all PCT applications which had not entered the national phase in Norway by that date, and for which 20 months from priority had not expired on that date, it is now possible to enter the national phase in Norway up to 31 months from the priority date.

Brazil (BR) removed its reservation under Article 22(1) PCT with effect from 30th April 2004. For all PCT applications which had not entered the national phase in Brazil by that date, and for which 20 months from priority had not expired on that date, it is now possible to enter the national phase in Brazil up to 30 months from the priority date.

Apart from countries in which protection is obtainable by regional (EP/AP) applications, only Serbia & Montenegro (YU) still has a reservation in force in respect of the 20 month deadline for national processing.

a disclaimer may be found inadmissible after grant for reasons which could not be foreseen at the time it was drafted

changes to the community trade mark (ctm) regulation

The Community Trade Mark Office (OHIM) has recently made the first significant changes to the CTM Regulation since it was introduced in 1996. There are a number of amendments, although some will not take effect until the Implementing Regulation has also been amended.

A summary of the major changes is given below. Some of them are quite radical, and they may make the CTM system more appealing to applicants.

entitlement to hold

Perhaps the most significant change, which takes immediate effect, is the amendment made to the legislation which outlines who is entitled to own a CTM. Previously, some relatively complex rules governed ownership of a CTM. These have all been abolished and the system simplified. Now, “any natural or legal person, including authorities established under public law, may be the proprietor of a CTM”. For example, companies based in the Cayman Islands will now be able to apply for, and own, a CTM.

official search

The article governing the official search, which is currently drawn up by OHIM and some of the national offices of the Member States of the EU, has been completely redrafted. However, the changes will only take effect from 10th March 2008.

Applicants will now have to indicate when filing an application that they would like the national Trade Mark Registries of the various Member States who have not opted out of the search to conduct a search on the National Registers of these countries. This request will be subject to the payment of a fee (yet to be determined). As there are now ten new member states in the EU, OHIM's costs in providing this service have presumably increased, while official fees have remained unchanged.

Some of the Member States, including Germany and France, have already opted out of providing searches to OHIM, and it remains to be seen whether this is simply the first step in completely phasing out the searches. As doubts have been raised as to the effectiveness and value of the searches, it is expected that many applicants will decide not to pay this fee, and the official search may thus be effectively abandoned through lack of interest.

When a search is requested, OHIM will continue to transmit search reports to the applicant if and when the application is published, as well as informing proprietors of CTM

applications/registrations that their marks have been cited in the search report. However, it will still be the proprietors' responsibility to protect their rights by filing oppositions where appropriate.

division of applications/registrations

This change will not take effect until the Implementing Regulation has been amended. However, once this is done it will be possible to divide both applications and registrations upon payment of a fee. Divisional applications and registrations will retain the original filing date of the parent application/registration.

dividing an application

The applicant will be able to divide the application by declaring that goods/services covered in the original application are to be separated into one or more divisional applications. As one would expect, there can be no overlap in the goods/services in the subsequent applications, so it will not be possible to include the same goods/services in more than one of the applications.

Division of a CTM application may be useful for example:

- where an objection has been raised against the application which is only relevant to part of the goods/services; or
- where an opposition has only been directed against part of the goods/services.

This would allow applicants to divide the part of an application which is not subject to an objection/opposition, thereby allowing this part of the application to move to the next stage in the registration procedure.

Please note that it will not be possible to divide applications in every situation.

In particular, where an opposition has been entered against the original application it will not be possible to divide an application in respect of any of the goods/services which

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now, “any natural or legal person” may be the proprietor of a CTM

changes to the community trade mark (ctm) regulation (continued)

have been opposed until the opposition proceedings have been resolved.

The amendments to the regulation also suggest that there will be other periods when it will not be possible to divide an application, although there is as yet no indication as to what these periods might be.

dividing a registration

Once a CTM is registered, the proprietor can divide the registration into one or more divisional registrations.

However, it will not be possible to divide the registration in respect of any goods/services

which are the subject of a cancellation action or a counter-claim in such an action.

continuation of proceedings

This change will also not be introduced until the Implementing Regulation has been amended. Once introduced, some of the procedures on time limits will be changed. If certain time limits are not adhered to, the party who has missed the deadline will be able to continue the proceedings by completing the omitted act and paying a fee, provided this is all done within two months of the unobserved time limit. However, a number of important deadlines will not be covered by this amendment, including priority deadlines, the opposition deadlines and the renewal deadlines. ❖

uk trade mark rule changes

On 5th May 2004, the UK Trade Marks Registry introduced the Trade Mark (Amendment) Rules 2004.

changes to opposition proceedings

Although many of the changes are relatively superficial and have been made to help the registry administer the opposition system more effectively, there are some changes which are more profound. The new rules effectively mean that unused marks which have been on the register for over five years will not be able to be used to successfully oppose new trade mark applications. Similarly, proprietors of registered marks more than five years old which have broad lists of goods and services will only be able to successfully oppose in respect of those goods on which they can show use of the mark. The major changes are outlined below.

transitional provisions

The new rules apply to all proceedings filed on or after 5th May 2004. For those filed before this date, the proceedings will be dealt with under the old rules until the counter-statement is filed. In the case of proceedings where the counter-statement has been filed prior to 5th May 2004, the proceedings will continue under the old rules until any new step is taken.

earlier registrations

Where an opposition is based on an earlier registration which is more than five years old, it will now be necessary to complete a "statement of use". This should set out the details of goods/services in relation to which the earlier registered trade mark has been used (or provide proper reasons for non-use) in the last five years.

The UK Registry realise that there is a great number of oppositions filed on the last day of the opposition period, so it should be possible to file a statement of use after the rest of the opposition has been submitted.

Once the opposition has been filed, the applicant will be sent notification along with a copy of the opposition papers. The date of issuing this notification will be known as the "notification date". The applicant will have three months from the notification date to file a counter-statement, unless the opposition goes into the "cooling-off period".

cooling-off period

This is an idea which is new to the UK opposition procedure, although a similar system exists for Community Trade Mark (CTM) oppositions. Unlike the CTM system, however, the UK system will only go into the cooling-off period at the *joint* request of the parties. This request must be made within three months of the notification date.

The cooling-off period will be a single term of nine months and will be inextensible. However, if negotiations break down, either side will be able to terminate the period. The opponent

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where an opposition is based on an earlier registration which is more than five years old, it will now be necessary to complete a "statement of use"

uk trade mark rule changes (continued)

can do this by filing the appropriate form (the new TM9t), while the applicant can simply file a counter-statement. If the cooling-off period expires (or is terminated by the opponent) without settlement, the applicant will have a month to file their counter statement (but would always have three months from the notification date).

preliminary indication

The Registrar contends that most oppositions are based on identical/similar marks in relation to identical/similar goods/services, and believes that much of the evidence filed by the applicants and opponents is irrelevant when it comes to deciding the matter. In an effort to shorten proceedings, the Registry will now issue a “preliminary indication” of the decision that is likely to be reached on the basis of the similarity between the marks and the goods/services.

It is hoped that both parties will accept this decision around 30% of the time, but this remains to be seen. Where the preliminary indication is accepted by both parties, the proceedings will end and the preliminary indication will become final. In most cases neither party will have to do anything more.

However, where either (or perhaps both) of the parties do not accept the decision, one of the parties can give the Registry notice that they intend to file evidence and continue the proceedings.

filing evidence

The opponent should be given the first opportunity to file evidence to support their claims. Where the mark upon which the opposition is based is more than five years old, the opponent will have to file evidence substantiating the statement of use filed at the beginning of the opposition proceedings. As things stand, it is believed that there may be cost implications if the opponent cannot substantiate the claims made in the statement of use. If the opponent is unable to file any evidence substantiating the statement of use for any mark, that mark cannot be relied upon and, in cases where this was the only basis of opposition, the opposition will consequently fail.

Once the opponent has made their submissions, the applicant will be able to respond, as is currently the case.

hearings and appeals

Once all the evidence is in, the principal hearing officer will decide whether a hearing is necessary to decide the matter. It is thought to be unlikely that this will be the case in most cases. Of course, both parties will still retain the right to be heard even if the hearing officer felt this was unnecessary.

The right of appeal to the Appointed Person remains, although the Appointed Person can now give a decision on the basis of both parties' written submissions alone, unless either party insists on being heard.

official fees

When these changes were initially proposed, the indications were that the official fees governing the opposition procedure would be increased. However, no changes have yet been introduced, pending the outcome of the Patent Office fee structure review. An increase, albeit slight, is expected by many in view of the initial enthusiasm from the Registry to increase fees.

changes to invalidity and revocation proceedings

These changes are broadly similar to the new opposition proceedings.

invalidity

Where the action is based on an earlier registration more than five years old, it will be necessary to provide a statement of use relating to the five year period prior to the filing of the invalidity action. If the statement of use is denied or not admitted, the applicant for invalidity will have to provide evidence substantiating the statement of use, otherwise this ground of invalidity will be discounted.

revocation on the grounds of non-use

The applicant for revocation will now need to specify the alleged period of non-use, and consequently the evidence to be filed in reply should be directed at this specific period of alleged non-use.

legislative changes

There are also changes to the trade marks legislation itself, bringing the UK into line with the ECJ decisions in *Davidoff & Cie v Gofkind* (9th January 2003) and *Adidas-Salomon AG v Fitnessworld* (23rd October 2003). In these cases it was decided that a Member State that provides protection for marks with reputation in relation to dissimilar goods and services (as the UK does) has to give the same protection to similar goods and services. The legislation has thus been changed to reflect this. ❖

the Registry will now issue a “preliminary indication” of the decision that is likely to be reached on similarity between the marks and the goods/services

the issue of “function” in relation to the patentability of sequence-based inventions

“function” and the biotechnology directive

The concept of “function” in respect of the patentability of sequence-based inventions first appeared in EU Directive EC/44/98, the “Biotechnology Directive”. This makes clear that a mere DNA sequence without indication of a function does not contain any technical information and is therefore not a patentable invention. It was generally thought that the Directive was worded in this way to exclude subject matter such as expressed sequence tags (ESTs) from being patentable. The directive also links the consideration of function to the industrial application requirement and says that it is necessary, in cases where a nucleic acid sequence is used to produce a protein, to specify which protein is produced and what function this protein performs. However, inventive step must also derive from the function of a sequence given that, unlike at the USPTO, structural non-obviousness is not sufficient to satisfy the inventive step requirement at the EPO.

A problem arises as “function” is a very loose term which does not appear in this context in the EPC itself. At present, there is no case law from the EPO Boards of Appeal that could be usefully applied when considering the concept of “function”. The only official text that discusses “function” is the *Guidelines for Examination in the EPO*, and this has little to say on the subject of sequence-based inventions. Given that “function” has implications for both industrial application and inventive step, interpreting what is meant by “function”, and indeed what level of “function” may be required for patentability of sequence-based inventions, is a key issue.

“function” and epo decisions and test cases

The “ICOS decision” from the Opposition Division of the EPO is the only indication at present of the EPO’s position on the “function” required for industrial application to be satisfied. The patent in question related to a novel receptor, the function of which was

proposed based on sequence homology to other members of the receptor family. The decision revoked the patent on the grounds of lack of industrial application (amongst other things) because the function disclosed was too speculative. This general theme is seen in other EPO decisions and test cases of the Trilateral Project B3b. Thus, applications have been refused for lack of industrial application and/or inventive step where the function of a sequence is based solely on structural and sequence homology, without any “wet” biology being carried out. The reasoning behind this is that it is well known that even though a protein may be defined by homology as belonging to a super-family, different members of such families can have very different functions, even when the homology is high. Thus, homology alone cannot be used to reliably predict the function of the sequence. It therefore follows that where “wet” biology has demonstrated actual function, that function is not speculative and should be sufficient to meet the requirements for industrial application and inventive step.

“function” and the current position of the epo?

However, recent objections and decisions of Examining Divisions received since the ICOS decision are not consistent with this approach. Instead, there appears to be an emerging trend for the EPO to require a further technical effect of function over that which has already been demonstrated, in effect raising the level of “function” that needs to be disclosed in an application. The reasoning given for this is as follows. Where a protein is part of a family, its function is obvious because it can be predicted from the known function of the other members of the family. Demonstrating the actual function of the protein by “wet” biology merely serves to confirm the predicted function and is therefore not inventive, hence the requirement to show a further, inventive, “function”. This is contradictory to the existing position discussed above.

According to the (personal) views of an EPO biotechnology examiner, expressed in a recent paper, the interpretation of the concept of “function” in all its aspects is a central issue for examination of applications for sequence-based inventions. It remains to be seen what view the EPO will form on the meaning of “function” in the context of patentability of sequence-based inventions. What is clear at present is that the more data included in an application in support of the function of a sequence, the better. ❖

the interpretation of “function” is a central issue for examination of sequence-based inventions

supplementary protection certificates: eu enlargement

From 1st May this year the two EU Regulations (Council Regulation (EEC) No. 1768/92 and Council Regulation (EEC) No. 1610/96) creating supplementary protection certificates (SPCs) for medicinal products and plant protection products apply in the new member states of the European Union: Cyprus, Czech Republic, Estonia, Hungary, Latvia, Lithuania, Malta, Poland, Slovakia and Slovenia.

Supplementary protection certificates have been available in the other EU countries (Austria, Belgium, Denmark, Finland, France, Germany, Greece, Irish Republic, Italy, Luxembourg, Netherlands, Portugal, Spain, Sweden, and the United Kingdom) as well as in Norway, Iceland and Switzerland for some years. They have the effect of compensating a patent proprietor for an effective shortening of their monopoly period resulting from the need to gain regulatory approval before their product can be placed on the market.

In each country where an SPC is required, an SPC application must be filed in the national patent office and must be based on a patent in that country, and on the first marketing authorisation in that country in respect of an active ingredient to which the patent relates. If the SPC application is successful, an SPC is granted. It has a duration of not more than five years, and has the effect of extending the patent only in so far as it relates to the active ingredient which is the subject of the marketing authorisation.

The general rule in the new EU states, as elsewhere in the EU, is that an application for an SPC must be filed within six months from the grant of the first marketing authorisation for the active ingredient in the state of interest, or within six months from grant of the patent to be relied on in the application, if that is later. In addition, however, there are transitional provisions in the new states, which will enable patentees to obtain SPCs based on marketing authorisations granted prior to these states' accession to the EU. The transitional provisions vary from state to state.

In most of the new countries, the deadline for filing SPC applications based on marketing authorisations obtained before accession is six months from accession, i.e. *1st November 2004*. This applies in: *Latvia; Lithuania* (where the patent on which the SPC application is based must have been applied for after 1st February 1994); *Hungary* (provided the first marketing authorisation in Hungary was obtained after 1st January 2000); *Malta; Poland* (provided the first marketing authorisation in Poland was obtained after 1st January 2000); and *Slovenia*.

In the other countries: *Cyprus; Czech Republic; Estonia; and Slovakia*, SPC applications must be filed within six months of

the grant of first marketing authorisations in those states, even if those authorisations were issued before accession. Consequently, the deadlines for filing SPC applications in those countries may be much earlier than 1st November 2004 and may be *imminent*.

From 1st May 2004, marketing authorisations which have already been issued centrally for the EU by the European Agency for the Evaluation of Medicines (EMA) apply also in the new EU states. Therefore, the holders of previously granted EU-wide authorisations now find themselves in possession of authorisations valid in the new states which can, we presume, be used as the basis for SPC applications in those states.

If you would like more information on the possibility of obtaining SPCs in any of the above countries, please talk to your usual Mewburn Ellis LLP contact or to our SPC specialist, Kathryn Nicholls (kathryn.nicholls@mewburn.com).



new ep extension state

From 1st April 2004, European Patents and Patent applications can be extended to Croatia (HR). European Patent applications filed from that date can be extended to Croatia on payment of an extension fee (due at the same time as the standard designation fees). PCT applications designating both EP and HR filed from that date can enter the regional phase before the EPO with a request for extension to Croatia.

since 1st May supplementary protection certificates (SPCs) are available in the new member states of the EU

community patent update

Despite the promising recent signs, this project appears stalled, possibly fatally so. Continuing disagreement, particularly over the required claims translations, their legal significance and their timing, meant that the Regulation had not been adopted by 1st May 2004, when the EU enlarged.

A recent meeting of the EU's Competitiveness Council failed to reach the required unanimous agreement on the latest proposed text and referred the matter to the President. With all possible compromise positions seemingly having been exhausted, this could be the end of the Community Patent, at least in its present incarnation.

claims translations

The latest proposal required the claims of a granted Community Patent (CP) to be translated into *all* official languages of the EU. The number of languages involved increased significantly as a result of the recent enlargement, and there was considerable scepticism as to whether the numbers of sufficiently qualified translators available for some languages would have been able to cope with the number of CPs granted. This was particularly true for languages, such as Maltese, which have a small population base.

Of more concern was the fact that the translation into the language of a state where infringement (or similar action) occurs was to be considered to be the authentic text if the protection conferred was narrower in scope than that conferred in the language of grant. This meant that a granted CP could have had different scopes in different countries depending on the translations, which would have removed some of the "certainty" that the unitary right was intended to provide. This also placed a potentially heavy burden on the proprietor to ensure that the translations obtained were accurate.

With the expansion of the EU, and the corresponding increase in the number of languages, more translations would have been required and the overall cost of obtaining a CP had risen significantly. It was suggested that in

many cases it would actually be cheaper to translate the whole text of the patent into five or six languages (as under the current European Patent (EP) system) than to translate the claims into all languages. With many applicants only validating EPs in six or fewer countries, CPs may not even have had a financial advantage over the existing system.

other issues

litigation procedure

Another area where languages had been causing a problem was in the proposed litigation arrangements. It was proposed that the language of proceedings in any litigation be determined according to a series of conditions based on the defendant's and claimant's domiciles. For an EU-based defendant, the language of proceedings would have been an official language of the member state where the defendant was domiciled.

However, in many cases this would have been a language that none of the judges understood, meaning that documents specifically prepared for proceedings (and probably translated from an original as a result) would have to be further translated into an appropriate language for the judges. Not only would this process have been time consuming and expensive, there was also a risk that the precise meaning of a document could be lost as a result of being subject to multiple translations.

Similar problems were envisaged with the need for oral presentations to be subject to simultaneous translation into many languages.

fees

Companies and trade associations in all fields continued to express concerns over the fact that the Regulation set out that 50% of the renewal fees for CPs was to be paid to the national patent offices of member states, arguing that this was inconsistent with the desire to produce a system that was competitive and attractive to users. There was also concern that the renewal fee levels were to have been based on the average renewal fees for an EP in seven or eight countries. With many applicants only validating EPs in a small number of countries (see above), this would actually have made renewal fees for a CP more expensive, with no option to reduce the amount of fees in subsequent years by abandoning protection in one or more countries. ❖

with all possible compromise positions seemingly exhausted, this could be the end of the Community Patent

diagnostic methods

The President of the EPO has asked the Enlarged Board of Appeal to consider the following questions relating to the allowability of patents which relate to methods of diagnosis, following a recent conflict in the case law of the Boards of Appeal.

The questions referred are:

1a. Are “diagnostic methods practised on the human body” within the meaning of [Article 52\(4\) EPC](#) (hereinafter: “diagnostic methods”) only those methods containing all the procedural steps to be carried out when making a medical diagnosis, i.e. the examination data thus obtained with the standard values, the finding of any significant deviation (a symptom) during that comparison and, finally, the attribution of the deviation to a particular clinical picture (the deductive medical decision phase), or

1b. Is a claimed method a “diagnostic method” even if it only contains one procedural step that can be used for diagnostic purposes or relate exclusively to the diagnosis? According to which criteria is this to be assessed?

2. If the answer to question 1b is in the affirmative: Does the claimed method have to be usable exclusively for diagnostic purposes or relate exclusively to the diagnosis? According to which criteria is this to be assessed?

3a. Is a claimed method a “diagnostic method” if:

- i) it contains at least one procedural step considered as essential for a “diagnostic method” and requiring the presence of a physician (Alternative 1), or
- ii) it does not require the presence of a physician but presupposes that a physician bears the responsibility (Alternative 2), or
- iii) all procedural steps can also or only be practised by medical or technical support staff, the patient himself or an automated system (Alternative 3)?

3b. If the participation of a physician (by being present or by bearing the responsibility) is decisive, does the physician have to participate in the procedural step practised on the body, or does he only have to participate in any procedural step considered as essential for a diagnostic method?

4. Does the requirement “practised on the human or animal body” mean that the procedural steps take place in direct contact with the body and that only such steps practised on

the body can provide a method with the character of a diagnostic method, or is it sufficient if at least one of the procedural steps is practised directly on the body?

As usual the EPO has suspended first instance proceedings (Examination and Opposition) in which the outcome is entirely dependent on the decision of the Enlarged Board. We will review this in more detail in the next issue. ❖

software patenting directive revived

The EU's Council of Ministers has approved a new version of this directive which largely removes the controversial amendments made by the European Parliament last year (see issue 7). However, the Directive still has to be reconsidered by the Parliament before it can be passed.

priority from wto countries

The EPO's Enlarged Board of Appeal has recently issued a decision confirming that it is *not* possible to claim priority in a European Patent application from an earlier application filed in a country that is a member of the WTO but not of the Paris Convention. Although the next round of proposed amendments to the EPC (“EPC 2000”) will change this, for the time being the EPC remains at odds with the PCT on this issue.

in-house news

Earlier this year Mike Sanderson retired from Mewburn Ellis. Mike had been with the firm since 1969 and ran our Newcastle office from 1971. We wish him well in his retirement.

Since the last *Mewsletter* Stephen Hodsdon and Rebecca Tollervey have qualified as UK Patent Attorneys.

are diagnostic methods only those methods containing all the steps to be carried out when making a medical diagnosis?

mewburn ellis llp extranet

We can now offer our clients the ability to look up details of their cases over the internet. This service is available free of charge to all of our clients although we reserve the right to make a charge if for any reason the amount of work requires this.

Once you have registered to use the scheme you will be given a user name and asked to provide a password.

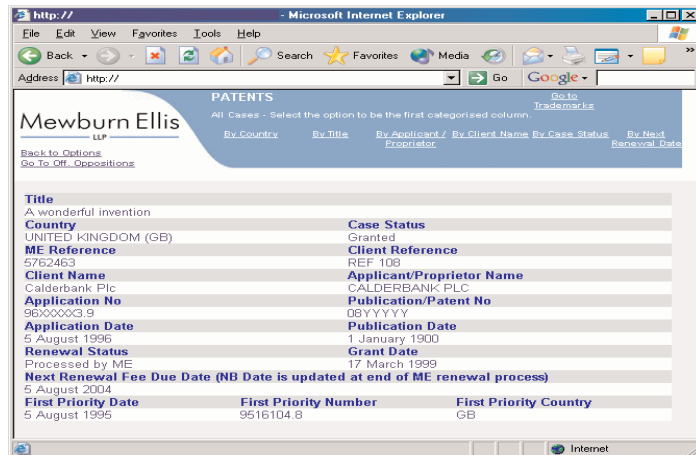
From our website home page you can then log in to our extranet and can choose between various options for searching, sorting, selecting and displaying your cases.

Sample images of the system (right) show demo versions of the trade marks and patent details screens.

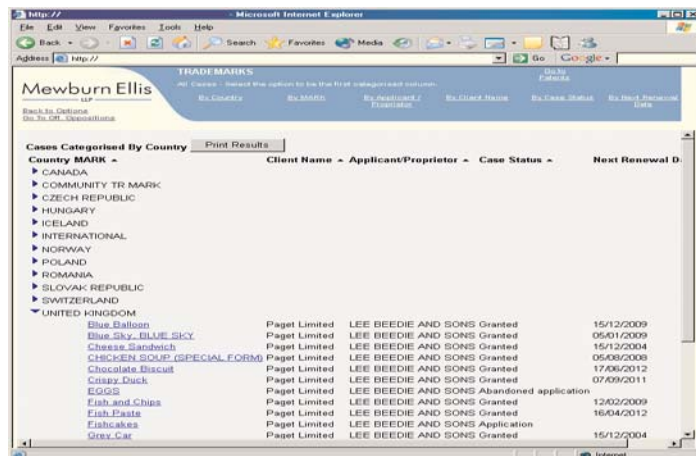
In the future we plan to make Accounts information available through this system as well.

For more information, or to arrange a demonstration, please get in touch with Wayne Kirby (wayne.kirby@mewburn.com) or your usual Mewburn Ellis LLP contact.

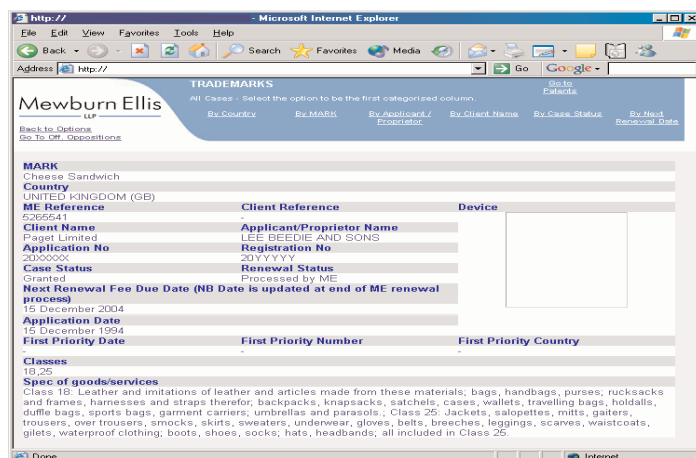
Alternatively you can try this for yourself using our demonstration database. From the home page of our website, click on the tab for "Client log-in" and then, when requested, key user name "metest" (not case-sensitive) and password "metest" (lower case). You should then be able to explore the various options which are available. ❖



A sample of a patent details screen with test data



Our test database showing all TMs sorted by country and giving details of all UK TMs



A sample of a TM details screen with test data - where a device is involved, the image will be shown

we can now offer clients the ability to look up details of their cases over the internet

useful information

european patent convention (epc) contracting states

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

eu member states (community trade mark and community designs)

Austria	Greece	Poland*
Belgium	Hungary*	Portugal
Cyprus*	Ireland	Slovakia*
Czech Republic	Italy	Slovenia*
Denmark	Latvia*	Spain
Estonia*	Lithuania*	Sweden
Finland	Luxembourg	United Kingdom
France	Malta*	
Germany	Netherlands	

* New EU members since 1st May 2004. Existing Community applications and registrations are automatically extended to cover these countries.

epc extension countries

Albania	Lithuania
Croatia*	Macedonia
Latvia	

* Since 1st April 2004

epo holiday dates 2004

10th June
1st November
24th December
31st December

ohim holiday dates 2004

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 LLP:	www.mewburn.com

This information is simplified and must not be taken as a definitive statement of the law or practice. For more information on Mewburn Ellis LLP and other intellectual property matters, please contact us or visit our website at www.mewburn.com.

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