

page white and farrer european IP

newsletter 2 Autumn 2004 www.pagewhite.com

Page White & Farrer is a leading firm of Patent and Trade Mark Attorneys. Page White & Farrer was founded in London in 1876 and now has offices in the United Kingdom and Finland. Our main office is in Doughty Street in the Bloomsbury area of central London, and our Helsinki office is in Runeberginkatu, near the Finnish Patent Office.

31 October 2004 – applying for a Supplementary Protection Certificate (SPC) in certain new EU countries

The recent expansion of the EU (see PWF Spring 2004 newsletter) provides an opportunity to apply for an SPC in some new EU member states outside the normal deadline. In Latvia, for example, it is possible to file an application for an SPC for

a locally approved product that is protected by a basic patent in force in Latvia within six months of the date of accession i.e. by 31 October 2004. Subject to certain conditions, SPC applications may also be filed in Hungary, Lithuania, Poland, Slovakia and Slovenia by this date. ■



For further details, please contact Jeff Daniels at jeff.daniels@pagewhite.com

Community Trade Marks (CTMs) or Madrid International Registrations?



From 1 October 2004, applicants for Madrid International Registrations (Madrid Registrations) can choose the CTM as a designated state. However, they will need EU representation in order to deal with any issues which arise. These could include specification, deceptiveness or ►

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► non-distinctiveness objections, as well as Observations or Oppositions, which frequently arise. Since EU representation will be needed in such cases, it may be easier to file a CTM application directly and not via the Madrid system.

Moreover, there are further reasons why this may be advisable:

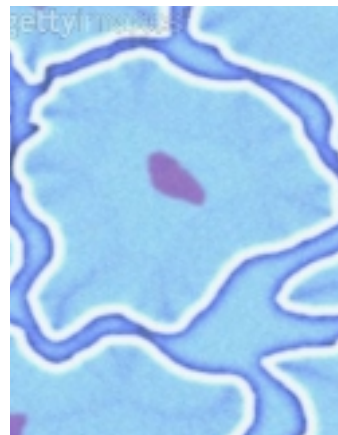
1. Madrid Registrations can only cover goods covered by “home” applications or registrations. This is restrictive for applicants from countries which encourage a narrow description of goods, such as the US. By contrast, a CTM which is not filed under the Madrid system can cover a wider range of goods, without such a restriction.
2. A designation under the Madrid system has ties with its home registration, until 5 years after registration. If the home registration is limited the Madrid Registration is similarly limited, unless transformed into national registrations, so a Madrid-designated CTM could be lost or limited, due to events outside the EU.
3. As a Madrid Registration is tied to the home rights, it is often best to wait until the home rights are registered. However, most applicants do not want to delay filings until the home rights are registered. By then, it may be too late to claim priority (which can be important) and, even without such a wait, applicants will face many months’ delay in registering their rights in any event.

The fact that Madrid Registrations are tied to home rights means that many applicants are expected to continue filing EU applications directly with the CTM Registry, without using the Madrid system. Although this may be slightly more costly for those applications which encounter no problems, in many cases it will prove quicker and easier, and give extra advantages. ■

EU Countries

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

Protecting Medical Inventions in the United Kingdom and Europe



In March 2004, the UK Patent Office published new guidelines for handling medical inventions. The guidelines present an interesting opportunity to compare UK Patent Office practice with European Patent Office (EPO) practice.

Although UK Patent Office practice is largely in line with EPO practice there are some important differences between them. Applicants can use these differences

to maximise protection for their inventions. This could involve developing a considered filing strategy, whereby a UK application may be filed in parallel with a European application.

Here, we focus on some differences which may shape a filing strategy:

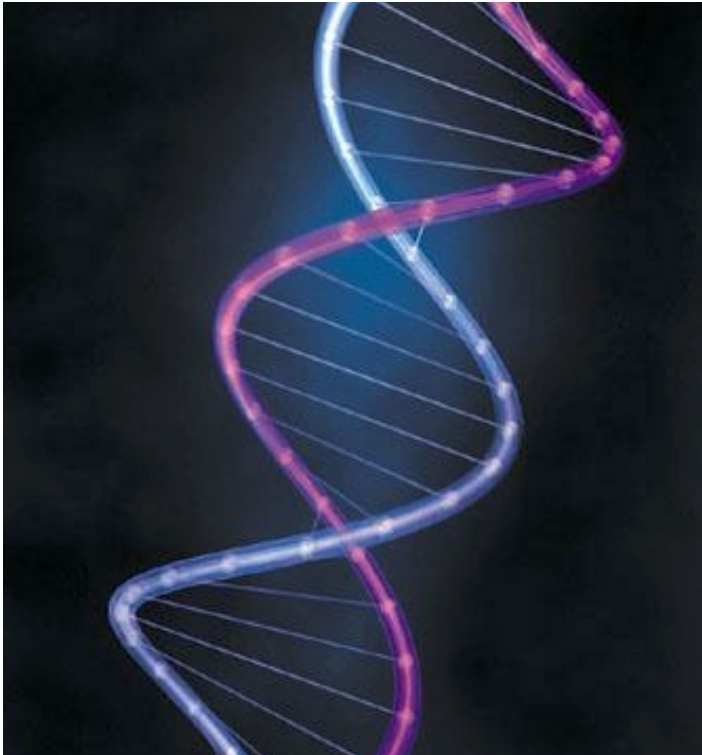
Multi-step method of treatment of the human or animal body by surgery or therapy or of diagnosis performed on the human or animal body

Under UK practice, if the invention taken as a whole can not be considered to be such a method, then the method is not excluded. For example, a method of producing a transgenic animal which involves a number of steps, one of which is a surgical method of embryo transplantation, is not excluded. The EPO has taken the contrary view, that any multi-step method which involves such a surgical, therapeutic or diagnostic step is excluded from patentability (EPO technical appeal board decisions T820/92 and T35/99).

Novelty of Swiss-type medical use claims

Under UK practice, to show prior use of a compound in a specified therapeutic application, actual disclosure of the specified therapeutic use must be found. A research paper that merely discloses experiments which show an activity suggesting the specified use, or discloses *in vitro* testing for such a use, would not anticipate a Swiss-type claim for the specified medical use.

A slightly different approach is taken by the EPO. In EPO technical appeal board decision T241/95, it is stated that “a pharmacological effect or any other effect such as a behavioural effect observed either *in vitro* or in animal models is accepted as sufficient evidence of a therapeutic application if for the skilled person this observed effect directly and unambiguously reflects such a therapeutic application”.



Patenting of embryonic stem cells

Although not covered by the new UK medical guidelines, a further difference between UK and EPO practice that is worthy of consideration relates to patenting embryonic stem cells.

The European Patent Convention (EPC) specifically excludes from patentability biotechnological inventions that concern the use of human embryos for industrial or commercial purposes. In the recent 'Edinburgh' patent case (EP 0,695,351), an EPO opposition division indicated that the rules were to be interpreted to prevent the patenting of cells that can be retrieved from human embryos. As such, if this decision is to be followed, human embryonic stem cells, and methods for using these cells, are not patentable at the EPO. This decision is currently under Appeal.

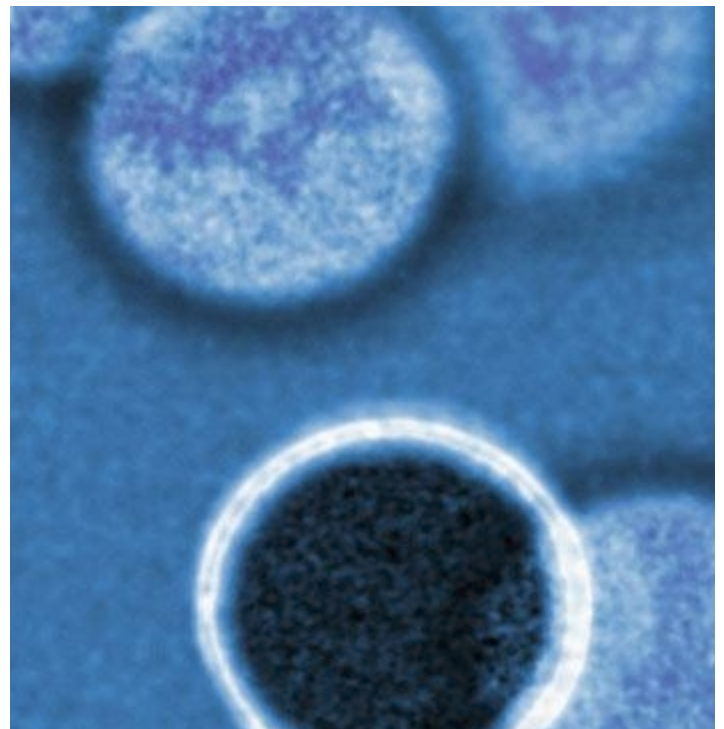
The UK Patent Office appears to be taking a different view. A practice notice issued in April 2003 indicated that a distinction would be drawn between totipotent and pluripotent stem cells. The former, having the potential to develop into an entire human body, would be excluded from patentability. However, inventions concerning pluripotent cells (including human embryonic pluripotent stem cells) would not be excluded.

Conclusion

Since the inception of the European patent system and the EPC, obtaining patent protection in an EPC contracting state via the EPO has been a very attractive option. Prosecution takes place before a central office in a single language, so that generally costs are less than those for prosecuting a handful of national applications. Further, the claim wording is uniform for all of the states where the European patent is ratified.

However, there are disadvantages in prosecuting applications before the EPO. The prosecution can be slow. Also, a granted European patent can be attacked centrally at the EPO by filing an opposition; the European patent stands or falls across all designated states. By contrast, prosecution before the UK Patent Office is usually quicker. Many applicants consider that these disadvantages provide sufficient reason alone to consider filing a UK national application in parallel with a European application, for an important invention. This may now be even more attractive for certain medical inventions, when greater protective scope might be obtained via the UK Patent Office route.

These considerations also apply more widely: for inventions in other biotechnological fields and computer software inventions, where UK Patent Office practice and EPO practice are similarly at variance. Specific advice should always be obtained from a UK patent attorney when adopting a filing strategy in Europe in order that applicants can take advantage of the differing approaches and the consequent differing protective scope potentially on offer before the European and UK Patent Offices. ■



Director's profile Peter Jenkins



Peter has more than 20 years' experience of obtaining and enforcing intellectual property rights on behalf of the firm's clients, as well as invalidating rights of their competitors. His experience includes the enforcement of patent rights in the US and continental Europe as well as in the

United Kingdom. Some of the cases that Peter has been closely involved with include: *Instance v OnSerts* (Northern District of Illinois, 1994; CAFC 1996) where our client's US patent was held valid and infringed directly, indirectly and wilfully; and multijurisdictional patent litigation in the UK, France, Germany, Italy and the Netherlands for one of the firm's clients against various infringers.

Peter is one of a small number of UK patent attorneys to have been awarded a Patent Litigator Certificate, enabling him to directly represent his clients in court proceedings in the UK. Peter is also well equipped to advise in relation to registered design protection in the UK and the European Union; recently, Peter has been one of the first to defend – successfully – an invalidation action against a Registered European Community Design of one of the firm's clients.

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Peter has an unsurpassed level of experience in relation to oral proceedings at the European Patent Office in Munich, where he has represented the firm's clients in opposition and appeal proceedings on well over a hundred occasions. His exceptional familiarity with the workings and personalities of the Opposition Divisions and Appeal Boards is used to good effect to obtain the best result for the firm's clients.

Having taken a broad-based science degree at the University of Cambridge, Peter's patent practice spans a wide spectrum of technical areas, ranging from chemical inventions, through mechanical and electromechanical inventions, to electrical and business method inventions. Peter has particular expertise in automotive technology, printing, medical devices and materials science and metallurgy. Peter has been the named professional representative before the EPO responsible for more than 1700 European patent applications and oppositions.

Behind all Peter's work lies a keen awareness of the commercial aims behind the acquisition and enforcement of intellectual property rights, which is derived from his experience with the practical exploitation of intellectual property to secure a strong market position.

Outside of the office, Peter's time is shared with his wife and three children. He enjoys gardening and is a member of the Royal Horticultural Society. He is also an active racquet sportsman. ■

London



Foundling Museum

The London offices of Page White & Farrer are in Bloomsbury, in Doughty Street which runs south from the Coram's Fields estate. In the early eighteenth century, London's first public art gallery was opened at the Foundling Hospital in Coram's Fields.

Founded by Captain Thomas Coram, and granted a royal charter in 1739, many of the most famous Londoners of the time became involved in the hospital, including Handel, Hogarth, Gainsborough and Reynolds. All gave works to the hospital, creating a fashionable collection which was designed to attract visitors, and thereby solicit donations from them.

The artworks of the hospital are once more on public display, in the Foundling Museum, which opened in June 2004.

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Helsinki



Sibelius Monument

Jean Sibelius (1865-1957) is Finland's most important composer. Between 1899 and 1924 he wrote seven symphonies, and during his long life he also wrote very many songs, choral works, pieces for the violin and piano and symphonic poems, as well as the well-known string quartet *Voces Intimae*.

Sibelius's greatest work is *Finlandia*, a symphonic poem which was completed in 1899. *Finlandia* became a symbol of Finland's desire for independence as a nation, which was achieved in 1917.

Our photograph shows the Sibelius monument by Eila Hiltunen (1922-2003), in the Sibelius Park in Helsinki.

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