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Page White and Farrer is a leading European Intellectual Property firm, based in London.

New .eu domain names now open to all Europeans

The new global top-level domain name, .eu, is now available. Its Registry, EURid, will not check applications to see whether the applicant owns any prior rights in the chosen domain name, but the applicant must comply with nationality requirements, such as being a resident of the European Union, or an undertaking having its registered office, central administration or principal place of business within the European Union.

Applicants, including Trade Mark owners, who are not resident in the EU may therefore need to file .eu domain names in the name of their European licensees or subsidiaries. ■



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What is a legal service?

Under the present International Classification of Goods and Services (Nice Classification), “legal services” are placed in Class 42, together with scientific and technological services. In the ninth edition of the Nice Classification, which will take effect from 1 January 2007 for all contracting countries, “legal services” will be transferred to Class 45, together with personal and social services. ■



EPC 2000 – New European Patent Convention coming in 2007

Introduction

The European Patent Convention EPC has been revised, coming into force on **13 December 2007** at the latest. The revised EPC is referred to as “EPC 2000”.

The more significant changes are summarised overleaf. ►

► Substantive changes

Amendment after grant

Under the current EPC, it has not been possible for a Patentee to amend a granted EP patent in a single procedure before the EPO, unless during opposition proceedings. It has been necessary to apply to amend in each designated state.

Under EPC 2000, the Patentee can request revocation or limit the claims, provided no opposition is pending. This gives the Patentee the option of limiting the scope of a granted patent in a central procedure.

There would be an examination only to confirm that the claims are being limited in scope and are formally allowable. There would be no examination of the patentability of the amended claims.

Second medical use claims

Currently, it is possible to patent a first medical use (e.g. "substance X for medical use Y"). However, it is not possible correspondingly to patent a second medical use. This problem has been circumvented in the past by using a "Swiss form" of claim: "Use of substance X for the manufacture of a medicament for therapeutic application Y", where Y is the new and inventive second medical use.



Under EPC 2000, protection of a second (and subsequent) medical use of a substance or composition already known as a medicine will be possible. This would apply to any applications pending when EPC 2000 comes into effect.

Designation of states

Under the new law, all states are deemed to be designated at the time of filing of an EP application. The designation fees would still be payable as currently, with one designation fee payable for each state up to a maximum of seven designation fees.

How to interpret the scope of a claim

Article 69 EPC has been amended to state that the extent of protection of an EP patent is determined by the claims (Article 69 EPC previously referred to the "terms" of the claims). This change is unlikely to have any significant effect. However, the Protocol on the Interpretation of Article 69 EPC has been amended. The current Protocol indicates that Article 69 is to be interpreted as defining a position that combines a fair protection for the patent proprietor with a reasonable degree of legal certainty for third parties. This position is between the two extremes of literal claim scope and the claims merely being a guideline.

Under the EPC, no formal body of precedent case law has been established concerning claim construction because Board of Appeal decisions are not legally binding on other Boards of Appeal. National courts hear infringement and validity actions, but there is still no clear harmonisation on claim construction. This was demonstrated in the "Epilady" case where UK and German courts respectively found non-infringement and infringement of the same European patent for the same allegedly infringing device. German courts apply a test of equivalence, whereas UK courts do not. This case plainly did not provide "a reasonable degree of legal certainty for third parties".

Presumably with an aim to achieve greater harmonisation under the EPC, the Protocol has been amended to add a new Article 2 which defines that "...due account shall be taken of any element which is equivalent to any element specified in the claims."

It is difficult to predict precisely how this equivalence test will be applied by the EPO. However, it is interesting that the original proposal, which was not adopted, was more similar to a US-style "doctrine of equivalents". Proposed Article 2, which was not adopted, referred to account being taken of "means" being equivalent "at the time of the alleged infringement", and also defined such equivalence as being "obvious to a person skilled in the art that using such means achieves substantially the same result" as the claimed means. The revised EPC 2000 may not therefore have a particularly strong equivalence test.

Proposed Article 3, referring to file wrapper estoppel, was not adopted. This emphasises that there is no formal file wrapper estoppel under the EPC.

Priority

Priority can be claimed from "any Member of the WTO".

Definition of "patentable"

The EPC has been amended, for conformity with TRIPs, to define that "a patent may be granted... **in all fields of**

technology... This will not change current practice relating to business methods and computer programs.

Again, to bring the EPC in accord with TRIPs, "inventions the **commercial** exploitation of which would be contrary to "ordre public" or morality..." are excluded from protection. This would not change current practice, following on for example from the "Harvard Oncomouse" case.

Finally, "methods for treatment of the human or animal body by surgery or therapy and diagnostic methods practiced on the human or animal body..." are now defined as unpatentable, whereas the current EPC excludes such methods as being incapable of industrial application.

Privilege

There have been concerns, particularly by US patent attorneys, that professional representatives before the EPO do not enjoy the same rights of privilege as US attorneys, and this has led to some unease concerning attorney-client communications being discoverable in litigation, particularly US litigation. To address these concerns, new Rule 101a (1) EPC entrenches evidentiary privilege for communications between EPO professional representatives and their clients which are subject to the representative's professional obligation of confidentiality. The language has been taken from *Bristol-Myers Squibb v. Phone Poulenc Rorer* (Southern Dist. NY, 19 April 1999).

Specifically, the following are listed as being privileged: any communication or document relating to: the assessment of patentability; the preparation or prosecution of an EP application; and an opinion relating to validity, scope or infringement of an EP patent.

Procedural changes

Filing requirements

A European patent may be filed in any language (for example, Japanese or Chinese). A translation must be filed within 3 months.

An EP application must include a description or reference to a previously filed application. There is no longer a requirement for claims to obtain an EP filing date.

Review of Board of Appeal Decisions

Currently, there is no mechanism for review of an EPO Board of Appeal Decision, even if there were fundamental flaws in the legal process.

EPC 2000 provides for the filing of a petition for a review of a Board of Appeal Decision by the Enlarged Board of Appeal. The circumstances justifying a review would be rare, such as a fundamental procedural defect or a criminal act in the appeal.

Further processing/restoration

If an EPO time limit is missed so that an application is deemed to be withdrawn, in some circumstances it is possible to request "further processing", pay a small fee and complete the omitted act.

The scope of further processing has been significantly broadened, and now applies to the "failure to observe a time limit vis-à-vis the European Patent Office". Further processing is ruled out for some time limits including (among others): claiming priority and filing a notice of appeal.

Restoration under Article 122 EPC (where it is necessary to prove that all due care was taken to observe a time limit) has been limited so as to exclude periods for which further processing is available.

Information Disclosure Statements

Under the EPC 2000, the EPO may invite the applicant to provide information on prior art taken into consideration in national or regional proceedings.

If you require any further information, please do not hesitate to contact Peter Jenkins (peter.jenkins@pagewhite.com) or your usual adviser. ■



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The Enlarged Board of Appeal generally considers points of law referred to it by a Board of Appeal or by the President of the European Patent Office.

The European Patent Convention (EPC) excludes from patentability diagnostic methods practised on the human or animal body. This exclusion has been interpreted by some Technical Boards of Appeal in a narrow sense whereas others have applied the exclusion broadly to deny patentability to methods relating to diagnosis. The Enlarged Board of Appeal has now considered this point of law in detail and issued an opinion in December 2005 holding that the exclusion from patentability in respect of diagnostic methods must be interpreted in a narrow manner (G01/04).

In essence, it was held that for a claim to fall under the prohibition excluding protection for diagnostic methods it would have to include each of the following features:

- i) the diagnosis for curative purposes, in the restricted sense, representing the deductive medical or veterinary decision phases as a purely intellectual exercise;
- ii) the preceding steps which are constitutive for making that diagnosis; and
- iii) the specific interactions with a human or animal body which occur when carrying out those preceding steps which are of a technical nature.

Each of the method steps of a technical nature which belong to the “preceding steps” of ii) must be practised on the human or animal body for the method to be regarded as a method of diagnosis. However a specific type or intensity of interaction with the human or animal body was not required in order to be “practised on the human or animal body”. Any step was seen to fulfil this criterion if it implied an interaction with the human or animal body, requiring the presence of the latter. The Enlarged Board also held that the participation of a medical or veterinary practitioner in a method is not necessary for the method to be considered to be a diagnostic method.

The opinion of the Enlarged Board was based on the reasoning that diagnosis for curative purposes is a multi-step process which includes an examination phase involving a collection of data, the comparison of these data with standard values, the finding of any significant deviation during the comparison (i.e. a symptom), and the attribution of the deviation to a particular clinical picture in the deductive medical or veterinary decision phase. Intermediate findings of diagnostic relevance must not be confused with diagnosis for curative purposes in the restricted sense. A method for obtaining such findings does not

constitute a sufficient basis for denying patentability according to the Enlarged Board.

On the basis of the reasoning of the Enlarged Board, claimed methods not including all of features i) to iii) would appear not to be excluded from patentability as a diagnostic method. If some or all of the method steps of a technical nature are carried out without implying any interaction with a human or animal body, these steps may not be considered to be “practised on the human or animal body”. The inclusion of one or more such steps in a claim (for instance steps carried out in vitro or by using a computer program) may therefore render a method outside the exclusion. However, the Enlarged Board noted that the exclusion cannot be avoided merely by omitting one or more of steps i) to iii) from a claim if the claim then fails to contain all of the essential features of the invention.

In conclusion, the Enlarged Board appears to have ruled that the diagnostic methods exclusion under the European Patent Convention must be interpreted narrowly.

Applicants with new applications for filing at the European Patent Office and those with existing applications in this field should review their claims because objections previously raised by Examiners may no longer apply. Moreover, some methods which might previously have been excluded from patentability may now be protectable in Europe.

It is also important to remember that the exclusion of the European Patent Convention of the patentability of methods of diagnosis does not extend to apparatus. Accordingly, it is possible to obtain patent protection for novel and inventive apparatus for diagnosing the human or animal body.

If you have any questions or queries on this, please contact Jeff Daniels (jeff.daniels@pagewhite.com) or your usual adviser. ■

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