

# page white and farrer european IP

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

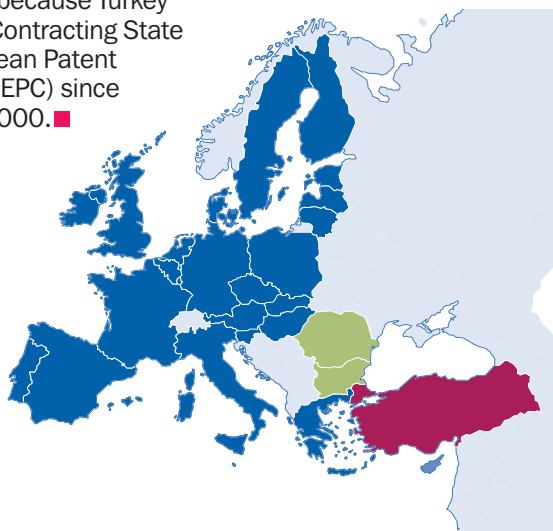
## Protecting IP in Turkey

Turkey, situated at Europe's south-east, is now closer to becoming a member of the European Union (EU). In a very recent development, the governments of all 25 member countries of the EU agreed in principle to the accession of Turkey to the European Union. Formal negotiations regarding the conditions for accession are due to begin in the near future.

If and when Turkey does join the EU, potentially in 2015, it will be possible to obtain trade mark protection in Turkey through a Community Trade Mark application and existing Community Trade Marks will expand to include

Turkey, as from its accession date, without the payment of fees. For inventions, it is already possible to obtain patent protection in Turkey through a European patent application, because Turkey has been a Contracting State to the European Patent Convention (EPC) since November 2000. ■

**Key**  
■ EU as at 2005  
■ Romania and Bulgaria, which are expected to join in 2007  
■ Turkey



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## European Software Patent Directive

The European Parliament has voted against the Software Patent Directive proposed by the European Commission. Accordingly the guidelines and case law which are presently provided by the European Patent Office will continue to provide the relevant framework for patenting business methods and software.

Thus, a business method or computer implemented invention may be patentable if it can be shown to be new, not obvious and provide a technical contribution. ■

## Changes to Community Trade Mark Procedures

Numerous improvements have been made to the Community Trade Mark procedures. The official fee for recording CTM transfers has been abolished and it is now possible to divide CTM rights for a fee. When registering single colour marks, it is no longer necessary to specify a recognised colour code and the recordal of licences is possible without filing a copy of the licence, if the licensor signs the recordal application.

In CTM oppositions, there are stricter rules on filing translations and seeking proof of use, whilst costs awards have been increased. Moreover, the "cooling off" negotiation period is now limited to 24 months, which benefits those awaiting progress in an opposition. ▶

► There are already other benefits for those filing CTM applications separately, rather than as part of a Madrid application. The potentially lengthy delays during WIPO checks and the high up-front fees for designating the EU are avoided.

There are risks when relying on “home” country rights that may have narrow lists of goods, or be limited before registration, or within 5 years thereafter. As a result, many applicants continue to file separate CTM applications, when seeking EU-wide rights, rather than using the Madrid Protocol.

Practice amendments are made often by the EU Registry and the case law is increasing quickly, so local advice should always be sought early on, to ensure awareness of the latest developments. ■



## When is a surgical method not a surgical method? - The patenting of cosmetic treatments at the European Patent Office

It is well established practice at the EPO that non-surgical methods of cosmetically treating the human body are not necessarily excluded from patentability by the provisions of the European Patent Convention. Two very recent decisions of a Technical Board of Appeal at the European Patent Office suggest that the same may now apply to surgical methods of cosmetically treating the human body.

Article 52(1) of the European Patent Convention states that “European patents shall be granted for any inventions which are susceptible of industrial application, which are new and which involve an inventive step” and Article 52(4) of the European Patent Convention states that “methods for treatment of the human or animal body by surgery or therapy and diagnostic methods practised on the human or animal body shall not be regarded as inventions which are susceptible of industrial application within the meaning of paragraph (1)”. These exclusions are supported by TRIPS Article 27.

For non-surgical methods of cosmetically treating the human body, it is well established practice at the EPO that these are not necessarily excluded from patentability by Article 52 of the European Patent Convention, and such methods have been found to be patentable by the European Patent Office even where they might in some circumstances also have a therapeutic effect. In 1986 Decision T0144/83, a Technical Board of Appeal found that a method of improving the bodily appearance of a non-opiate-addicted mammal by the administration of naltrexone was patentable even though the administration of naltrexone could also be used for the therapeutic purpose of curing obesity. Also, in 1997 Decision T0469/94, a Technical Board of Appeal found that the use of a choline compound “for increasing the acetylcholine level in the brain and the tissue and thereby reducing the perception of fatigue in a person about to participate in major exercise or in a person having completed major exercise” was patentable even though choline could be used for the therapeutic treatment of patients suffering from a muscular disease, muscular injury or epilepsy.



On the other hand, in relation to the surgical methods of cosmetically treating the human body, the wording of Article 52(4) EPC had generally been interpreted in a way such that all surgical methods are excluded from patentability regardless of whether or not they are for therapeutic purposes, and indeed even the June 2005 version of the Guidelines for Examination at the European Patent Office indicates in relation to Article 52(4) that “surgery defines the nature of the treatment rather than its purpose. Thus, for example, a method of treatment by surgery for cosmetic purposes or for embryo transfer is excluded, as well as surgical treatment for therapeutic purposes”.

However, in two very recent decisions, a Technical Board of Appeal has taken a narrower interpretation of Article 52(4) EPC. In Decision T0383/03 published in March 2005, a Technical Board of Appeal took the view that “treatments by surgery which are clearly neither suitable nor potentially suitable for maintaining or restoring the health, the physical integrity, or the physical well-being of human beings or animals do not fall within the exclusion from patentability of Article 52(4)”. It found that a cosmetic method for hair removal by ►

applying optical radiation for a short period to the skin through an element positioned over the skin was not excluded from patentability by Article 52(4) EPC. It went on to add that such a method “falls into that category of methods which includes tattooing and piercing, for example, whose only possible object is to beautify the human or animal body” and that they “are fundamentally different from those methods which, although they can be used to beautify the human or animal body, may also be used to restore the physical integrity of the body, such as a method of breast enlargement by surgery (following a cancer operation, for example) or a correction of the shape of the nose (after a car accident, for example)”.

In later Decision T1172/03 taken in May 2005, the same Technical Board of Appeal repeated the same narrow interpretation of Article 52(4) EPC, but in this case it found that “a cosmetic method of tightening a skin surface overlying a collagen tissue site” by delivering electromagnetic energy

through the skin surface and the epidermis to the collagen-containing tissue site was nevertheless excluded from patentability by Article 52(4) EPC because “the method can be used for several therapeutic purposes including the application on the face or neck for reconstructive purposes”, in relation to which it referred specifically to the thermal induction of scar collagen deposition, as a reaction to inflammation induced by a thermal injury, as having a therapeutic reconstructive effect.

It remains to be seen whether a higher Board of Appeal at the European Patent Office will be asked to resolve this question of the interpretation of Article 52(4) EPC, but in the meantime consideration should be given to pursuing patent protection for new and inventive surgical methods for non-therapeutic purposes in Europe at the European Patent Office. In any case, new and inventive devices for use in surgery, or apparatus for carrying out a surgical method, are well established as being patentable in Europe. ■

## In the news



### Dosage Levels in European Second Medical Use Claims

The European Patent Office has recognised that the dosage level of a medicine can constitute novelty and inventive step in a second medical use claim.

In Decision T0230/01, a European Patent Office Technical Board of Appeal considered a patent for treating human allergic rhinitis, which claimed a particular dosage level of a

known medicament DCL. That dosage level was significantly lower than the recommended level in the state of the art for treating allergic conditions, and the dosage claim was found to be inventive. The text was:

Claim 1. Use of DCL, or a pharmaceutically acceptable salt thereof, for the manufacture of a medicament for use in treating allergic rhinitis in a human, said medicament to be administered in an amount sufficient to provide daily dose of 0.2mg to 1mg of DCL or a pharmaceutically acceptable salt thereof to a human.

Regulation provides for a 6 month extension to the life of a Supplementary Protection Certificate (SPC) for paediatric medicines, in view of the requirement for pharmaceutical companies to conduct clinical trials on children.

### UK Patents – Computer Software and Business Methods

Historically, the European Patent Office and UK Patent Office have used different practical tests to assess the patentability of applications involving computer software or business methods.

The UK Patent Office has now issued a notice indicating that with immediate effect the UK Patent Office will adopt a very similar approach to that taken by the European Patent Office.

The UK Patent Office has taken the view that this will not change the boundary of what is patentable. For borderline cases, however, this change in practice may well be important. ■

### European Parliament approves Regulation on medicinal products for paediatric use

In September 2005 the European Parliament adopted the Regulation on medicinal products for paediatric use. The



## Director's profile Jeff Daniels



Jeff Daniels is a European Patent Attorney and UK Chartered Patent Agent who has practised in the intellectual property profession for nearly 20 years. Jeff joined Page White and Farrer in 1989 and has been a Director for over 10 years. He is now head of the expanding biotechnology group.

With a degree in biochemistry and several years' research experience in molecular biology and enzymology, Jeff's practice concentrates on the biosciences. His professional experience ranges from chemistry to biotechnology and includes pharmaceutical chemistry, protein chemistry, molecular biology, immunology and plant genetics.

Jeff's considerable experience of all aspects of patents in the biotechnology field gives him an in-depth knowledge and understanding of practice and case law both in the UK and at the European Patent Office. This extends to the specialised area of protecting medical use inventions as well as advice in relation to supplementary protection certificates for medicinal and plant protection products in Europe. Jeff also advises on the impact of the European Biotechnology Directive, including its effect on the protection available for inventions in emerging new fields such as nuclear transfer technology.

Jeff assists in portfolio management and business model development, having worked with numerous start-ups, spinouts, and small companies, as well as large and established companies, to grow their businesses and maximise the commercial usefulness of their patent portfolios. This has often involved developing an IP strategy tailored to a client's specific needs, including a system for IP harvesting, and competitor surveillance in patent landscape monitoring. This leads to third party patent portfolio evaluation and opinion work, particularly advising on infringement and validity issues.

In addition to patent drafting and prosecution, Jeff also has wide experience in written and oral representation before the European Patent Office (EPO), including in many multiparty biotech oppositions and in Board of Appeal proceedings.

Jeff is a regular attendee at IP related biotech conferences, such as the annual International Bioconference and events organised by the London Biotechnology Network to keep abreast of trends and developments in the biotechnology field.

Outside the office, Jeff's time is spent with his wife and two children. He enjoys wine tasting (and drinking), cricket and music. ■

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## London



British Museum

The offices of Page White and Farrer are in Bloomsbury, near the British Museum. The British Museum was established by Sir Hans Sloane (1660-1753), physician, naturalist and collector. In his Will, he bequeathed his collection of 71,000 objects to King

George II for the nation.

Parliament passed an Act in 1753 establishing the British Museum, and a public lottery was held to raise the necessary funds.

The Museum opened to the public on 15 January 1759, on the site of the present building; admission to the building was and remains free and open to all. The Museum itself was rebuilt in the neoclassical style in the nineteenth century when King George IV donated his own library, and the round Reading

Room was added soon afterwards. Many noted authors visited the Reading Room to write, including Karl Marx, Oscar Wilde, Rudyard Kipling, George Bernard Shaw and Virginia Woolf.

The collections of the Museum have outgrown the original site. In the 1880s the natural history collections were moved to a new building, now the Natural History Museum, in South Kensington. In 1973 the library collections became part of a new organization, the British Library, which moved to its new home at St Pancras in 1998. Most recently the Queen Elizabeth II Great Court opened in 2000, designed by Sir Norman Foster and created in part of the space vacated by the British Library.

Our picture shows the front entrance of the Museum, designed in 1823 by Sir Robert Smirke (1780-1867).

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