

page white and farrer european IP

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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.

EPO Appeal Decision on Oncomouse case published

The European Patent Office (EPO) has ruled that patent claims to non-human transgenic animals may be allowable if they do not specifically relate to a single animal variety. This was confirmed by the EPO's judgment in the long-running

Oncomouse case, which related to transgenic animals engineered to develop cancer for medical research purposes. The patent had been opposed by a large number of organisations including animal rights activists on ethical grounds.

However, transgenic animals are only patentable if any likely suffering of the animals is compensated for by a "substantial medical benefit to man or animal", and the invention is not otherwise considered to be contrary to morality. ■

"The focus of this case is a very small animal, namely a mouse – to use a poet's description, a 'Wee, sleekit, cowrin, tim'rous beastie'" – The European Patent Office quotes Robert Burns in its judgment of the Oncomouse case.



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News Flash – SPCs

Recently, the European Court of Justice (ECJ) ruled that the date of grant of a marketing authorisation in Switzerland (which is not a member of the European Union) can be used in calculating the duration of a Supplementary Protection Certificate (SPC), thereby potentially limiting the period of exclusivity for drugs whose first European authorisation was obtained in Switzerland. ■



Amendments to UK Patents Act and Patents Rules effective from 1 Jan 2005

These important new provisions are wide ranging and have changed UK patent practice in several areas, for example:

- A UK patent application can now be filed on the basis of a non-English description

- There are now specific provisions relating to late declarations of priority
- There is now a remedy for unintentionally missing the 12 month priority deadline. ■

Registering Surnames as Trade Marks becomes Easier

The European Court of Justice in *Nichols plc –v– Registrar of Trade Marks (C404/02)* has provided guidance on registering surnames as Trade Marks, which means they are more likely to be allowed in the future.

The UK Registry formerly refused applications for surnames, if they were common in telephone directories. Accordingly, the Registry rejected 'NICHOLS' for foodstuffs and the ECJ was asked to consider this policy.

The ECJ confirmed that distinctiveness must be assessed by reference to the specific circumstances of the case, the public's perception and having regard to the goods. Surnames must be treated like other categories of sign and not assessed simply by checking telephone directories.

The UK Registry has now changed its policy and we are finding that many surnames that would formerly have been rejected are now being allowed as Trade Marks.

Those seeking to register surnames, such as White for paint, that also have other descriptive meanings, may still face descriptiveness problems however! ■

If you would like any specific advice, please contact james.cornish@pagewhite.com.



Patenting Software & Business Methods in Europe

There is a widely held belief that it is not possible to patent software or business methods in Europe. This is not the case. It is possible to patent software and business method inventions in Europe if the invention has technical character.

Introduction

The case law regarding the patentability of business methods and software is still evolving and the position regarding such inventions may be quite different in several years' time without there necessarily having been a change in the European Patent Convention. The body of case law for such inventions from national courts is small and it is not clear whether or not the national courts will interpret the wording of the European Patent Convention in the same way as the European Patent Office.

There will always be inventions relating to software and business methods which will never be patentable, whilst others will be quite clearly patentable. However, between these two extremes will be a grey area, the boundaries of which are likely to be subject to much debate and change. In this article, ways of assessing patentability of software and business method inventions will be considered.

Computer Programs

As far as computer programs are concerned, a claim to a computer program is patentable if it has 'technical character'.

Business Methods

Effectively the same reasoning applies to business methods. Methods only involving economic concepts and practices of doing business, i.e. pure business methods are not patentable.

A computer system suitably programmed for use in a particular field – even if that field is the field of business and economy – can be patentable if there is technical character.

Technical Character

Thus when assessing if an invention is likely to be patentable in Europe, it needs to be determined whether the invention possesses technical character. Currently there is no commonly accepted definition of technical character. However, there are a number of ways to determine if an invention has technical character, for example, if:

- A technical effect is achieved by the invention; or
- Technical considerations are required to carry out the invention.

In assessing technical character, consideration needs to be given as to what advantages a system or apparatus running the software offers. For example:

- Does the software require less memory space, or have effects on other aspects of the system operation which result in less memory use?
- Does the software allow the system to operate more quickly?
- Does the software improve the reliability of the system?
- Does the software improve the usefulness or user friendliness of the system?
- Does the software cause the system to have an improved or new function?
- Does the software cause the system to provide a new result?

The software can provide technical character by having these effects on the computer system itself or on an apparatus controlled by the computer system, even if the apparatus or the computer system is itself known.

Technical character may arise, for an invention, in:

- The problem to be solved
- The implementation of the solution
- The function of that implementation
- The effects of that implementation.

Novelty and Inventive Step

Even if a business method or computer software invention has the necessary technical character to be patentable, the invention must of course be novel and inventive.

Case Studies

We discuss below two examples where the invention has been found to be patentable.

Coupon Distribution

Forum: Paris Court, Revocation Action
 Publication No: European Patent No. 0173835
 Date of Decision: 21st June 2002
 Decision: Patent Valid

The invention relates to a system for distributing coupons. In the prior art, coupons were distributed to a customer at a point of sale. The coupons were distributed to customers who had already purchased the product or a similar product to which the coupon related. In the invention, the coupon was not for the product just bought, but for another product triggered by the product just bought.

This is an example of a case where software (programmed in effect to perform a business method) causes known apparatus to operate in a different way. Technical character is provided by a new use or operation of a known apparatus, which use is caused by software operating on the system.

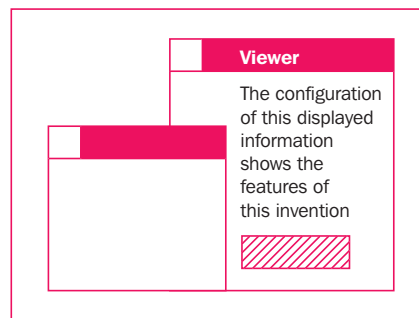


Computer Window Display

Forum: EPO Boards of Appeal, from decision of Examining Division
 Decision No. T 935/97
 Decision: Patent Allowed

The invention relates to a data processing system having a display and an operating system. Display windows are provided. When the information in a first window is obscured by information in a second window, the software causes the information previously obscured by the second window to be viewed in the first window by the user.

The position in this case was simply that the software running on a computer – a standard computer – brought about a technical effect which went beyond that of the normal physical activities of a computer system.



Summary

The table below summarises the position regarding the patentability of business methods. If in the creation of software technical character is present, then any such technical character may form the basis for patentability.

Business method new?	Implemented on apparatus eg computer?	New technical effect/contribution?	Patentable?
Yes	No	No	No
No	Yes	No	No
Yes	Yes	No	No
No	Yes	Yes	Yes
Yes	Yes	Yes	Yes

European Software Directive

The European Union Ministers have endorsed the European Software Directive. The Directive now needs to go to the European Parliament. There is a feeling that the European Parliament, which appears to be uncomfortable with software patents, will make changes or reject this Directive. It seems likely that the European Software Directive will not be approved any time soon.

Conclusion

It is possible to protect software and business method inventions in Europe if they have technical character. ■

If you would like any specific advice, please contact kelda.style@pagewhite.com, virginia.driver@pagewhite.com, or david.williams@pagewhite.com

Director's profile Virginia Driver



Virginia has been a director of Page White & Farrer for about 15 years and her experience as a qualified patent attorney in Europe and the UK spans about 20 years. She is a regular attendee at AIPPI, APPA and FICPI conferences.

Virginia excels in the field of electronic engineering, and her experience extends from drafting and prosecuting European and UK patent applications right through to appeal proceedings at the European Patent Office and patent litigation in the UK courts. This wide-ranging experience includes involvement in the discovery process for parallel litigation in the UK and the US.

Another of Virginia's specialist roles within the firm is providing advice on the protection of business method and computer software inventions; clients value her advice on how to draft claims for maximum success at the UK Patent Office and the European Patent Office. As the UK representative of the Software Commission of the Union of European Patent Attorneys, she is

also actively involved in the ongoing debate about increasing patent protection for computer software inventions in Europe, and is therefore also able to provide informed comments about future possibilities for these kinds of inventions in Europe.

Virginia also has particular experience in the area of competitor surveillance including the monitoring of competitors' products and IP activities in relation to the client's own patent/design portfolio and development activities. In this connection, Virginia represents clients in EPO opposition proceedings against competitors' European patents, such as those located by such surveillance work. Virginia has particular experience of using the client's own commercial activities as prior art for attacking competitors' patents.

Outside of the office, Virginia enjoys playing tennis and going skiing with her husband and three children. ■

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London



The Spectator Building

The London offices of Page White & Farrer are in the Bloomsbury area of central London, at 54 Doughty Street. At 56 Doughty Street are the offices of *The Spectator* magazine.

The name *The Spectator* was first used by the essayists Addison and Steele for their periodical which began in 1711. The present magazine has been published continuously since 1828; having just passed its 175th anniversary, it is the oldest continuously published magazine in the English language.

Virtually every significant British writer, politician, cartoonist and poet of the last 150 years has had his or her work featured in *The Spectator*. For example, the literary careers of Alfred Lord Tennyson, John Buchan, Kingsley Amis and Martin Amis, Graham Greene, Ian Fleming and Virginia Woolf all began in the magazine. Tony Blair wrote for *The Spectator* in 1979, whilst he was still practising as a barrister.

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This newsletter contains general information, and should not be relied upon for any particular case. For specific legal advice, please contact us.

Helsinki



Finlandia concert hall

Alvar Aalto (1898-1976) is Finland's most distinguished architect. His talent led him through the Scandinavian Romantic and Modernist disciplines to form his own style in architecture, and beyond architecture itself into the design of interiors and furniture. Aalto is celebrated not only for his exceptional buildings, many of which reflect the natural world of Finland in their extensive use of wood, but also for his innovations in furniture design.

Aalto's designs include Baker House at MIT, Cambridge, Massachusetts and the Mount Angel Library at St. Benedict, Oregon. It is in Helsinki however that his greatest work may be seen: the Finlandia concert hall.

Our picture shows the Finlandia concert hall which was designed between 1962 and 1971. Named after Sibelius's famous work *Finlandia*, it stands in the centre of Helsinki and contains two auditoria as well as a congress hall. Its interior is as innovative as its exterior, including elegant lighting and wooden reliefs, which both decorate the walls and enhance the acoustics.

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