# D YOUNG & CO PATENT NEWSLETTER no.34

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## Editorial

*"Necessity is the mother of innovation"* (anon). A more suitable quotation could not be found for this edition. Articles range from UK Government initiatives to stimulate innovation growth in the UK in an attempt to beat the recession and to change UK law to ensure pharmaceutical research and clinical trials are not forced out of the UK, to changes in US law to reduce the impact of patent trolls. All of these law changes have been brought about by necessity, as are many innovations. The good news is that the EPO reports a further steady increase in European patent filings, showing that a steady recovery is apparent. Other schemes to stimulate innovation growth for UK companies (including SMEs) include tax reduction schemes, the 'Technology Strategy Board' the 'Smart Scheme', the 'Small Business Research Initiative'(SBRI) programme, collaborative R&D schemes, 'Innovation Vouchers' and the 'Growth Accelerator initiative'. Find out more at http://dycip.com/ukinnovation.

**Editor:**
**Aylsa Williams**

## Events

**08 April 2013 - IP Commercialisation**
**Charité Entrepreneurship Summit**
Charles Harding will discuss IP commercialisation in the field of medicine, life sciences, venture capital, entrepreneurship, and tech transfer.

**17 April 2013 - 9am, 12pm & 5pm - Webinar**
**European Biotech Patent Case Law**
The latest update from European Patent Attorneys Simon O'Brien and Robert Dempster.

**22 April 2013 - BIO International Convention**
**BIO Chicago, US**
Simon O'Brien will discuss 'IP Issues Impacting Biomarker Diagnostics and Personalised Medicine Innovators and Businesses'. Catherine Mallallieu and Robert Dempster are also attending the convention.
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*Article 01*

# Boxing Clever
# Are you Ready to Take Advantage of the UK Patent Box?

The financial year starting in April 2013 sees the introduction of potential corporation tax relief under the so-called Patent Box scheme. Use of the Patent Box can reduce corporation tax payable from 23% to 10% on profits made by any company in the UK that can be attributed to qualifying patents. This relief will be introduced on a sliding scale starting at 60% of this amount in 2013 and increasing by 10% each year, until in 2017 corporation tax on these profits will be 10%.

### How might the Patent Box apply to you?

If you hold eligible patents or patent applications or exclusively license patents then you may be able to reduce your corporation tax bill by using the Patent Box. Eligible patents include among others, those granted by the European Patent Office (EPO) and UK Patent Office (UK IPO). The profits on any product that has some part of it covered by a patent owned by you or exclusively licensed by you would be eligible for the scheme. It is not an automatic relief but is something that you can elect into.

Although a larger product having a small component covered by a patent would see the profits from the whole product falling within the Patent Box, the inclusion of a patented component in a larger product that does not seem to add anything to that product may be seen as tax avoidance. Therefore if you have a product, only a small component of which is covered by a patent, documentation regarding the usefulness of this component should be retained.

### What should you do now?

It may be appropriate to adjust your IP strategy to ensure that new products are covered by patents and that you record relevant information on any profits attributable to qualifying patents.

If you have patents that are due to expire or that you plan to sell, you need to elect into the Patent Box scheme while they are still valid and owned by you if you are to claim any relief from the profits of these patents.

Although relief is only available on granted patents, profits attributable to patent applications can be counted under the scheme

**UK Patent Box Scheme Starts 01 April 2013**

retrospectively once the patent is granted. In order to do this you do need to include the calculations of profits for the patent application in the tax returns for the relevant years.

The profits that are attributable to qualifying patents are fairly complex to calculate but it is important to note that your corporation tax will not reduce from 23% to 10%. Only a certain proportion of your profits will be considered to be due to qualifying IP and other amounts deemed to be due to marketing assets and routine profits will be deducted from this proportion. This is clearly something to consider before electing into the scheme.

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**Julia Mills**

### Useful links

D Young & Co Patent Box FAQ
**http://dycip.com/patentboxfaq**

Patent Box articles and updates
**http://dycip.com/ipknowledge**

UK HM Revenue & Customs (HMRC) Patent Box tools and advisory notes
**http://dycip.com/hmrcpatentbox**

# The SHIELD Act
## Protecting Against Patent Trolls in the US

The term 'patent troll' is widely used to refer to a commercial entity that collects patents mainly for the purpose of aggressively pursuing alleged infringers. Alleged infringers are encouraged to settle with the patent troll, rather than entering expensive litigation proceedings.

A defining characteristic of such patent trolls is that the accumulation of patents is done, not for the purposes of expanding or making use of the technology *per se*, but rather to use the patent itself as a means to make money. This technique has been widely criticised as being detrimental to innovation, since the patent trolls themselves typically do not exploit the technology, and other companies are steered away from the technology in order to avoid the high settlement costs. A further concern about such techniques is that the patents favoured by patent trolls are extremely broad and potentially invalid. However, few companies are prepared to pay the large sums of money necessary to enter infringement/validity proceedings. Instead, as the patent troll will be appeased by paying a much smaller sum of money as a settlement, many alleged infringers prefer to pay this smaller sum rather than go to court.

> According to a Boston University study, the direct cost of patent trolls asserting patents in 2011 was $29 billion.

This figure includes the cost of settlements and companies going to court. However, the figure excludes indirect costs such as diversion of resources, delays in new products and loss of market share, which in themselves can be quite significant.

Although patent trolling is not exclusive to the US, its effect is somewhat mitigated in the UK. This is because UK court cases may involve the losing party paying a proportion of the winning party's legal costs. Therefore, if the patent troll tries to assert an overly broad and invalid patent against a third party, they may have to pay a proportion of the winning party's legal costs. This is not currently the case in the US. However, the SHIELD Act aims to adjust the legal process when patent trolls are involved so that they may have to pay a proportion of the winning side's costs.

The SHIELD (Saving High-Tech Innovators from Egregious Legal Disputes) Act is a bill that has been introduced to US congress by Peter DeFazio and Jason Chaffetz. Broadly speaking, it requires that the plaintiff is required to pay the full costs of the defendant if either the plaintiff's patent is found to be invalid, or if the defendant is found not to have infringed the plaintiff's patent. Plaintiffs may also be required to provide a bond, showing that they can cover the defendant's legal costs, before being allowed to proceed with infringement proceedings.

Certain categories of plaintiff are exempt from the SHIELD Act. Specifically:

- the original inventor(s) or assignees of the patent application on filing;
- entities showing substantial investment in exploiting the patent by sale or use of a product covered by the patent; and
- university or technology transfer organisations whose main purpose is to facilitate the commercialisation of technology developed at higher education institutions.

By making it potentially expensive for patent trolls to pursue alleged infringers using a weak patent or having a weak infringement case, the SHIELD Act aims to remove the disincentive for alleged infringers to contest infringement accusations. At the same time, the SHIELD Act also allows legitimate infringement suits – either from people who exploit patents in an 'accepted' way or from anyone who has a genuinely legitimate patent.

The Electronic Frontier Foundation (EFF) is encouraging all Americans to tell their representatives to enact the SHIELD Act and has set up an automated system for people to contact their elected representative and pass on their message of support for the Act.

**Authors:**
**Alan Boyd & Jonathan Jackson**

**Useful links**

The Electronic Frontier Foundation (EFF) represents *"the public interest in every critical battle affecting digital rights"*. Their website can be found at

**http://dycip.com/effwebsite**

Boston University School of Law Research on Innovation 'The Direct Costs from NPE Disputes' written by James E Bessen and Michael J Meuer, Law and Economics Research Paper No. 12-34, 28 June 2012

**http://dycip.com/bostonuni-npepaper**

The SHIELD Act in full (pdf) can be viewed on the Electronic Frontier Foundation's (EFF) website

**http://dycip.com/shieldact**

# Clinical Trials Exempt From Patent Infringement

## Patents Act Supports UK Life Sciences Innovation

On 26 February 2013, the UK Government announced a proposal to change UK patent law to exempt clinical trials of innovative drugs, for both regulatory approval and health technology assessments, from patent infringement. This is welcome news for the pharmaceutical industry as it finally clarifies the scope of this exemption, and the new, more liberal provisions could lead to more clinical trials of experimental drugs being carried out in the UK.

The question of whether research into a patented drug infringes the patent has been a controversial one in the UK for many years. Section 60(5) of the UK Patents Act generally exempts experimental use of a patented invention from infringement.

### 1985 Monsanto v Stauffer

However, the 1985 UK Court of Appeal decision in Monsanto v Stauffer limited the scope of this experimental use defence. The scope was restricted to acts carried out to find out something unknown about the patented product (for example, a new use), and did not cover acts carried out to demonstrate to a third party (such as a regulatory authority) that the product works. Although this case related to field trials of a plant protection product, the general wording of the ruling meant it also applied to trials of pharmaceutical products. As this decision has never been overruled by a higher UK Court, this strict interpretation of the exemption has put the UK out of step with other EU countries, notably Germany, which exempted some clinical trials from patent infringement.

### 2004 EU Directive

A 2004 EU Directive attempted to harmonise EU law on this matter. The Directive required Member States to exempt from infringement, trials of a patented, marketed pharmaceutical for the purposes of obtaining regulatory approval of a generic version, to be marketed after the patent expired. This Directive is commonly referred to as the 'EU Bolar Directive', after the corresponding provision in US law which exempts acts required to gain regulatory approval of a pharmaceutical by the US Food and Drug Administration (FDA) from

The UK Government is keen to support UK pharmaceutical research and development

patent infringement. However, EU Directives are binding only as to the result to be achieved, and Member States have some degree of freedom as to the way they are implemented. In this case, while some other EU countries implemented the EU Bolar Directive broadly, to exempt all clinical trials of both innovative and generic pharmaceuticals from patent infringement, the UK implemented it narrowly and applied it only to trials of generic drugs.

The combined effects of the above provisions have meant it has long been uncertain whether clinical trials of patented, innovative medicines in the UK constitute patent infringement. A particular issue arises when the

pharmaceutical regulatory authorities or health technology assessors require an innovative drug to be tested against a comparator drug already on the market – if the comparator is patented, the patent could be infringed under the current legislation. This has prompted concerns that companies seeking to avoid the legal uncertainty on infringement are being forced to carry out clinical trials elsewhere. There was some concern that the UK implementation of the EU Bolar Directive was driving pharmaceutical research out of the UK.

### 2012 UK Government Public Consultation

In response to these concerns, the UK Government launched a public consultation in October 2012 – the results of that consultation have just been published. The Government has accepted the need to change UK patent law to exempt from patent infringement activities involved in preparing or running clinical trials involving innovative drugs for the purpose of gaining regulatory approval in any country. It has also accepted that the proposed exemption should also apply to activities involved in health technology assessments, such as those carried out by the UK National Institute for Health and Clinical Excellence (NICE), which is the authority which decides whether the UK National Health Service (NHS) pays for an approved drug. The Government therefore plans to amend the UK Patents Act to explicitly exempt these activities from infringement.

Speaking about these changes, Lord Younger, UK Minister for Intellectual Property said:

> *"The government is keen to create a supportive environment for pharmaceutical research and development in the UK. Helping the industry get their products to market as quickly as possible will benefit patients, the industry and the economy."*

A summary of how the proposed law changes will affect trials is set out below. It is noted that the proposed changes will not apply to plant protection products, so Monsanto v Stauffer will still prohibit all UK field trials of such products for regulatory review.

| Trials | Old Law | New Law |
|---|---|---|
| Clinical trials of generic drugs | Allowed | Allowed |
| Clinical trials of innovative drugs for regulatory approval | Possibly allowed | Allowed |
| Clinical trials of innovative drugs for health technology assessment | Possibly not allowed | Allowed |

The new exemptions will be carried out by a regulatory reform order, so may come into force within the next few months. However, the exact terms of the exemption have not yet been clarified. In particular, the consultation results do not make it clear how broad the scope of the term 'activities' will be: it remains to be seen whether the exemption would only apply if one company both made and tested the patented drug, or whether a third party could supply the testing company with the drug and itself avoid infringement (a 2012 decision by the Düsseldorf District Court ruled that the third party would infringe in this case).

The Chartered Institute of Patent Attorneys (CIPA) and The BioIndustry Association (BIA) have reportedly both welcomed this initiative.

We will provide an update on this subject as soon as further details of the new legislation are announced.

**Author:**
**Garreth Duncan**

### Useful links

UK Government announcement

**http://dycip.com/ukgovpatentact**

*Article 04*

# Unitary Patent First Session Held by Select Committee

The Unified Patent Court Agreement was formally signed by the 24 participating Member States on 19 February 2013. This was a formal stage in the process towards the creation and implementation of the Unified Patent system. There are still a number of important details that need to be finalised (such as the costs of both the system itself and of the Court) and the process of ratification is likely to take some considerable time. The European Patent Office appears keen to maintain the pace of change, announcing that its Select Committee of the Administrative Council of the European Patent Organisation dealing with the unitary patent held its first session on 20 March 2013.

The EPO has been entrusted with granting and administering unitary patents. The Select Committee started the discussion of its rules of procedure and the planning of its further work over the coming months. EPO President Benoît Battistelli commented that the commencement of the Committee's work

> *"shows the strong commitment of the participant member states to keep up the momentum and bring the unitary patent project to a successful conclusion".*

We will keep you updated of further developments in subsequent newsletters and on our website.

**Author:**
**Catherine Mallalieu**

### Related article

'The Unitary Patent - A Connected Europe?' Ian Starr, February 2013

**http://dycip.com/upfeb13**

# Samsung v Apple
## More Skirmishes in the Patent War

*Related articles*
*'Samsung v Apple RCD Dispute - Not as Cool But (Still) Not Infringing', Scott Gardiner, October 2012: http://dycip.com/samsungapple1012*

*'Samsung v Apple - Not As Cool, But Not Infringing', Jonathan Jackson, July 2012: http://dycip.com/samsungvapplejul12*

A few new blows have exchanged this month in the on-going worldwide battle between Samsung and Apple discussed in previous newsletters.

At the end of February, Samsung lost a case in the Tokyo District Court of Japan in which Samsung had attempted to show that Apple's iPhone infringed JP 4,642,898 relating to 3G technology. In this case, Judge Ichiro Otaka ruled that Samsung had abused its position and had not acted in good faith.

Firstly, the court noted that Samsung had made the patent in question essential by submitting it for the 3G (Universal Mobile Telecommunications System - UMTS) standard. The body (European Telecommunications Standards Institute - ETSI) which oversees the UMTS Standard requires that companies reveal any IPR that they have that may be essential to the adoption of a standard. This must be done in a timely manner. In the current case, Samsung had three patents that related to the UMTS standard. However, Samsung had only disclosed those patents to ETSI at one, two, and four years after ETSI had agreed to adopt Samsung's technology as part of the standard. Judge Otaka ruled that, consequently, Samsung could not have been said to have acted in the required "*timely manner*".

Secondly, in accordance with the rules set down by ETSI, Samsung must agree to license its technology in a 'fair, reasonable and non-discriminatory' (FRAND) manner in relation to these essential patents. However, the court ruled that Samsung was breaking this pledge by requesting a preliminary injunction against Apple in relation to the same technology.

Thirdly, the court ruled that Samsung's attempt to license the technology to Apple was not carried out in good faith. Samsung had offered to license its patents to Apple for a "*royalty of 2.4% for each end product*". However, Samsung had not explained why this offer met the FRAND criteria, nor was it clear that Samsung's offer was a *bona fide* attempt at negotiation.

**Samsung and Apple continue to battle**

In view of the conduct of Samsung, the court ruled that the patent was unenforceable. This prevented Samsung from seeking damages or other relief.

Whilst the decision by the Japanese Court was a blow for Samsung, better news for them came from the US. In the US, District Court Judge Lucy Koh decreased the damages awarded to Apple from $1.05 billion. Although the jury had found that several different intellectual property rights had been infringed (including both design and utility patents) relating to 28 products, it was not clear what level of award had been made by the jury for the infringement of each right. In reviewing the award, Judge Koh ruled that although it was possible to determine that the jury had miscalculated the award given for 14 of the infringing products, there was insufficient information available to correct the award. Accordingly, Judge Koh overturned the award and ordered a retrial to recalculate the damages in relation to those 14 products. The award given to Apple was therefore cut to $599 million, which relates to the remaining products. It is expected that a new trial will result in a new final award value between $599 million and $1.05 billion.

In her ruling, Judge Koh blamed Apple for the need for a re-trial for damages. Judge Koh commented that

> *"[I]t was Apple's strategic decision to submit an expert report using an aggressive notice date for all of the patents."*

Judge Koh went on and said

> *"The need for a new trial could have been avoided had Apple chosen a more circumspect strategy or provided more evidence to allow the jury or the Court to determine the appropriate award for a shorter notice period."*

It is interesting that the conduct of the parties in both the Japanese and US actions had such a fundamental impact on the outcome of the Decisions. In Japan, the conduct of Samsung in respect of the use of Standards essential patents meant that the Japanese Court found the patents to be unenforceable and in the US, the conduct of Apple meant that their damages have been cut. This message highlights the importance of negotiation and conduct deemed reasonable by a Court in disputes.

Meanwhile, the battle between Samsung and Apple rumbles on.

**Authors:**
**Alan Boyd & Jonathan Jackson**

# Making or Repairing? New Decision and Guidance from the Supreme Court

> Useful link
> *Full judgment of the Supreme Court Schütz v Werit: http://dycip.com/uksc-2011-0266*
>
> *Decision of the Supreme Court (then 'House of Lords') United Wire Limited v Screen Repair Services (Scotland) Limited: http://dycip.com/unitedwire*

The UK Supreme Court (previously 'House of Lords') has very recently given its judgment on the Schütz v Werit case relating essentially to the question of repair.

Patent EP0 734 967 relates to an Intermediate Bulk Container (IBC). IBCs are designed to carry large amounts of liquids and conventionally comprise a bottle in a metal cage where the cage and bottle are placed on a pallet. The inventiveness of the patent lies in the weld joints of the cage, although the claims are directed to a complete IBC with a pallet, a cage and a bottle. 'Schütz' is the exclusive licensee of the patent in the UK while 'Werit' sells IBC bottles to a reconditioner 'Delta'. Delta replaces Schütz bottles of discarded Schütz IBCs with Werit bottles and the reconditioned IBCs are then marketed. Schütz objected to this activity alleging that Delta and Werit were both infringing the patent.

In first instance, the High Court ruled that this activity did not amount to an infringement. A key deciding factor in this decision was that "*the inventive concept of each of these claims is wholly embodied in the Schütz cage. Thus when the bottle is removed, the part retained embodies the whole of the inventive concept*".

On appeal, this decision was overturned mainly on the ground that the bottle was an integral part of the claimed product. The Court of Appeal found that, by adding a Werit bottle to a Schütz cage, a product according to the claim was being 'made' and the patent was thus infringed.

The Supreme Court therefore had to address the question of whether this activity of repairing the IBC by replacing the bottle amounted to 'making' the claimed IBC within the meaning of S.60(1)(a) of the Patents Act. A previous Supreme Court (then 'House of Lords') decision on this point, namely United Wire Limited v Screen Repair Services (Scotland) Limited (2000), clarified that there was no repair right as such and that the courts only had to answer the question of whether the defendant was 'making' the claimed product. Interestingly, United Wire reads that *"as a matter of ordinary language, the notions of making and repair may well overlap. But for the purposes of the statute, they are mutually exclusive"* and *"[The owner's right to repair] is a residual right, forming part of the right to do whatever does not amount to making the product"*. However, United Wire did not provide any guidance on how to decide whether an action amounted to 'making' the product or not. Schütz v Werit now provides such guidance.

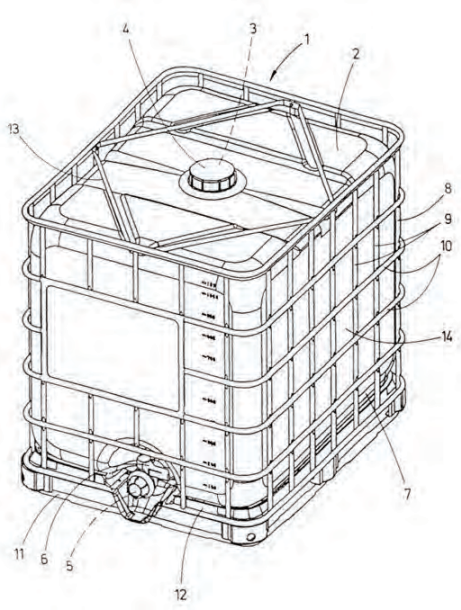
Throughout the decision, the Supreme Court insisted that this 'making' question is a *"matter of fact and degree"*. As a result, the courts would have to balance different considerations, for example *"one should bear in mind, at least as part of the background, the need to protect the patentee's monopoly while not stifling reasonable competition"*.

In this particular case, the Supreme Court found that the High Court may have oversimplified the situation while the Court of Appeal did not recognise that the decision was a matter of fact and degree.

The Supreme Court used the example of replacing a damaged lid of the IBC bottle as an illustration: even though the lid is (at least implicitly) part of the claim, it would be difficult to consider that merely replacing a damaged lid would amount to a claim infringement.

The Supreme Court found that it was relevant to assess whether the bottle was a subsidiary part of the patented article when determining whether its replacement, when required, involves 'making' a new article or not. Factors taken into accounts included:

- the lower life expectancy of the bottle compared to the cage;
- the fact that the bottle was easily replaceable; and
- the bottle neither including *"any aspect of the inventive concept of the Patent"* nor *"having a function which is closely connected with that concept"*.




It thus found that, in this case, the bottle was relatively subsidiary to the patented article. It therefore concluded that, on balance and taking into account the facts of this case, Delta was not 'making' the patented product.

This *"matter of fact and degree"* guidance is good news for spare part manufacturers or resellers as the Court of Appeal decision on this case might have caused them some concern. Some might have for example been worried that repairing any part of a product would be considered as an infringement, even in cases where the part is not related to the inventive concept of the patent. On the other hand, the Supreme Court has not given spare part manufacturers or resellers a licence to freely repair or replace any spare part, and in particular repairs relating to the inventive concept of a patent are less likely to be found allowable. Even though this "*matter of fact and degree*" is unlikely to be a straightforward point to address (and opposing parties will surely fight this point at length in court), we can now hope that, from a legal definition perspective, the issue of 'repair' has now been put to rest in view of the more balanced approach of the Supreme Court in Schütz v Werit.

**Author:**
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## And finally…

### Growth in European Patent Filings
### EPO 2012 Annual Report

According to the EPO's latest Annual Report, 2012 was another successful year, with an increase in European patent filings of 5.2% and an increase in European patents granted of 5.8% compared to 2011. This growth shows that Europe remains an important market and an important strategic region when protecting innovation.

The President of the EPO stated that *"this new peak in European patent filings for the third year in a row shows that companies from Europe and around the world are continuing to seek protection for their inventions, and that Europe remains an attractive market for new technologies. This growth is part of a consistent, long-term trend, and is clear evidence of the confidence of industry in the value of European patents"*.

Interestingly, the growth has largely been fuelled by filings from Asia and in particular from China, Korea and Japan. These three countries had individual growth rates of 11.1%, 9.3% and 9.1% respectively.

Additionally for the first time, the Applicant with the largest number of filings was an Asian company. The South Korean company Samsung filed 2,289 European patent applications in 2012, out of a total of 257,744. Another first was a Chinese company, ZTE, breaking into the top ten applicants, climbing from 43rd to 10th place.

Among the top ten applicants there were also four European companies: Siemens, BASF, Robert Bosch and Ericsson.

Within the individual technology sectors, European companies led the way in eight out of ten of the most active technical fields. In the transport sector, 60% of all applications came from European states. In measurement technology, engines, pumps, turbines (particularly in clean energy technologies) and organic fine chemistry, European applicants held 50% or more of all applications. The field with the most applications was, as in 2011, medical technology, and this sector was dominated by US applicants (42%), followed closely by Europe with 38%.

Other key statistics include the majority of filings (63.5%) originating from non-European countries and the continuation of the geographical trend seen in recent years with the US providing the most filings (24.6%), followed by Japan (20.1 %) and Germany (13.3%).

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**Useful link**

2012 EPO Annual Report in full

**http://dycip.com/eporeport2012**

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