# D YOUNG & CO PATENT NEWSLETTER no.30

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## Editorial

It has been an interesting month for scientific and intellectual endeavour. US Independence Day celebrations collided with the major scientific announcement that scientists at the European Organization for Nuclear Research, reporting from the Large Hadron Collider, have claimed the discovery of a new particle consistent with the Higgs boson. It is an historic milestone and one of the biggest scientific discoveries of the century, but it is only the beginning. Scientists will need to assess whether the particle they see behaves like the version of the Higgs particle predicted by the Standard Model, the current best theory to explain how the Universe works. However, it might also be something more exotic. Could the Higgs boson be a bridge to understanding the 96% of the Universe that remains obscure?

This discovery is the frontier, on the edge of new exploration. It is scientific and intellectual endeavour which makes working as a patent attorney a most enjoyable and rewarding profession. Long may it continue…

**Editor:**
**Aylsa Wiliams**

*Article 01*

# Stem Cell-Related Inventions
# EPO Follows Brüstle CJEU Decision

The new Guidelines for Examination in the European Patent Office came out on 20 June 2012. On the subject of patenting stem cell-related inventions, the guidelines largely follow the ruling of the Court of Justice of the European Union (CJEU) in the Brüstle v Greenpeace (Case C-34/10), which was discussed in the December 2011 edition of this newsletter[1].

The original procedure for the isolation of human embryonic stem cells (hESC) involves the destruction of a blastocyst, a very early pre-implantation stage embryo consisting of approximately 150 cells. However, alternative technologies are now available.

Established human embryonic stem cell lines have been developed, which are a suitable starting point for many hESC-related inventions. The deposit of such hESC lines by the Israel Institute of Technology (Technicon) at the US National Institutes of Health (NIH) in May 2003 has been considered to mark the start of the period where such cell lines were 'available' (see below).

In August 2006, the US-based company Advanced Cell Technology (ACT) published findings relating to a method for extracting embryonic stem cells without destroying the actual embryo, deriving a stem cell line using a process similar to preimplantation genetic diagnosis, in which a single blastomere is extracted from a blastocyst.

Then in about 2007, induced pluripotent stem (iPS) cell technology was developed in which adult cells are reprogrammed to an embryonic-like state.

Rule 28(c) of the European Patent Convention (EPC) states that European patents shall not be granted in respect of biotechnological inventions which concern "*uses of human embryos for industrial or commercial purposes*".

Prior to the Brüstle decision, an unofficial interim practice had arisen at the EPO whereby patent applications filed after May 2003 were generally considered to escape the Rule 28(c) exemption on the grounds that, as deposited human embryonic stem cells lines were available, it was not necessary to destroy a human embryo as part of the practice of the claimed invention.

However, the Brüstle decision indicated that the use of hESC lines as a starting point is not sufficient to escape the exemption as the cell lines themselves have involved destruction of a human embryo in their preparation. The fact that this may have happened a long time before the implementation of the invention was considered to be irrelevant.

The EPO Guidelines now read as follows (Part G, Chapter II Paragraph 5.3 (iii)):

*"A claim directed to a product, which at the filing date of the application could be **exclusively** obtained by a method which necessarily involved the destruction of human embryos from which the said product is derived, is excluded from patentability under Rule 28(c), even if said method is not part of the claim (see G 2/06). The point in time at which such destruction takes place is irrelevant.*

*When examining subject matter relating to human embryonic stem cells under Art 53(a) and Rule 28(c), the following has to be taken into account:*

*(a) The **entire teaching** of the application, not only the claim category and wording, and*

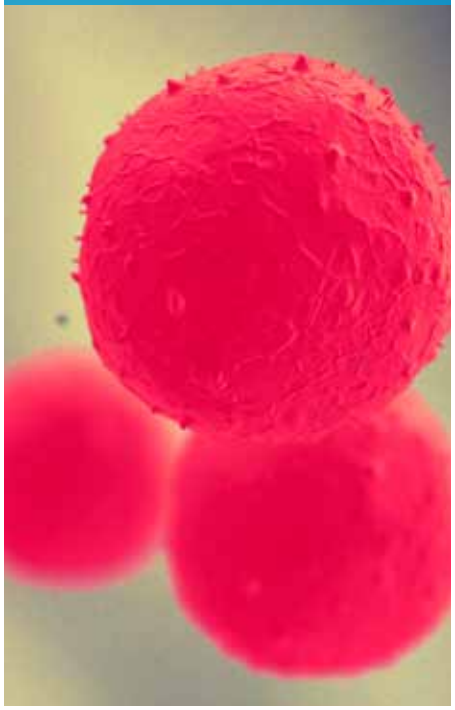
*(b) The **relevant disclosure in the description** in order to establish whether products such as stem cell cultures are obtained exclusively by the use, involving the destruction, of a human embryo or not. For this purpose, the disclosure of the description has to be considered in view of the state of the art at the date of filing."*

This wording suggests that the EPO is planning to revise its previous practice. Patentees will no longer be able to rely on the May 2003 date for availablilty of hESC lines. Instead it seems likely that a new date will be settled upon at which it is considered that alternative technologies were available to produce hESCs which did not involve the destruction of a human embryo.

# The Unitary Patent Is An End In Sight?

*Knowledge Bank*
*Scan the QR code below using your internet enabled smart phone to access our knowledge bank*

**New EPO Guidelines for Examination for stem cell-related inventions**



We will have to wait and see whether the date relates to the availability of ACT's method, iPS cells, or some other stem-cell related technological advance.

It is also not clear, considering (a) and (b) above, the extent to which the use of the new technology would need to be exemplified in the application as filed. It may be that one will need to show that the invention has been put into practice using stem cells made by a method which does not involve the destruction of a human embryo. On the other hand, it may be possible to argue that such cells were available at the time of the invention and could have been used instead of hESC or hESC lines in order to practice the invention.

**Author:**
**Louise Holliday**

**Useful links**
1. CJEU Decision C-34/10 - A Kiss of Death for the European Stem Cell Industry?

**http://dycip.com/dyoungdecstem**

In 1975 the Community Patent Convention (CPC) was signed by the then member states of the European Union (EU) – its aim was to have a single patent covering the whole of the EU. It was never ratified and so never became a reality.

Ever since then, there have been attempts to bring in a 'Community Patent' but these have floundered, generally on issues relating to language, cost and the judicial system. For the last two years, there has been a new impetus to create a 'Unitary Patent' for all EU member states (except Spain and Italy who have refused to participate so far and indeed have challenged the basis of it before the European Court).

The last couple of months have seen even more activity but increased confusion as to whether it will come into force and what effect it might have. At the end of June the 'Competitiveness Council' of the EU agreed a compromise solution of having the principal court (the 'Central Division') in Paris but with specialist clusters in London (for, essentially, chemistry and life sciences litigation) and Munich (for, essentially, mechanical engineering). In addition to this court, there will also be regional courts involving more than one member state and local courts for one country. The council also suggested the deletion of one of the more controversial proposals (that of allowing the European Court to decide on infringement appeals) and also proposed preventing EU domiciled defendants from seeking to transfer cases from a regional court to the Central Division.

Just a week later, the European Parliament effectively rejected these decisions, but did not make a final decision and instead referred the matter back to the EU's Legal Affairs Committee. How long it may remain there is uncertain.

The Unitary Patent has aroused very strong feelings and not just from patent lawyers but also from an increasing number of patentees – they feel the legislation is being railroaded through in a non-transparent way and without an understanding of the consequences. There are real concerns that the main users of the patent system will simply not use it and will revert to national patents – this defeats one of the principal objectives. Out of the long list of complaints, the following are some of the more important ones:

- There is still no idea of its cost to users or whether it would be cheaper than the 'norm' of only validating a European patent in 3 or 4 countries.
- The process has been done largely without proper public scrutiny, with key documents being kept secret by the EU Commission.
- The overly patentee-friendly (to UK eyes) German principle of bifurcation of infringement and validity will remain, leading (in practice) to different procedures around the EU.
- The likely cost of the whole system (including the training of judges) remains a secret. If filing fees are cheap, might litigation costs be high to recoup the costs?
- SMEs do not really want or need a patent covering 25 countries, yet that might be what they get as well as the risk of being sued in a foreign country.
- The current procedural rules governing litigation are not agreed and are still being discussed by a panel of experts and even issues of substantive law (eg, as to accessory liability) have not been dealt with.
- The proposal to allow the European Court to hear appeals on the scope of protection and infringement will lead to long delays and will undermine the notion of having to have specialist judges decide patent issues.

These (and other) issues, whilst not insurmountable, are important to the users of the patent system and it may (or perhaps should) be more time before any agreement is reached. If the major issues are not dealt with and the proposal is pushed through, there remains the real risk that, like the CPC, it will never be agreed and/or that users will simply not use it. Watch this space.

**Author:**
**Ian Starr**

# Avoiding The Pitfalls Of Patenting In An Emerging Technology
## Graphene Related Inventions

A study by the UK Intellectual Property Office (UK IPO)[1] has commented on recent trends in patent application filings relating to graphene. In particular, it notes that there has been a "*rapid take-off of patenting related to graphene since 2000*" and that a large proportion of the recent graphene-related patent applications have been filed by a relatively small proportion of applicants.

However, it seems that cheaper processes for producing graphene substrates are likely to be of great commercial interest and so it is reasonable to expect further research and thus patent applications to be focussed on this area.

Although the rewards for obtaining an early dominating right in an emerging technology sector can be high, the examination of patent applications related to emerging technology can expose risks with the patent. A review of examination reports of European patent applications having the word 'graphene' in the title shows such potential complications.

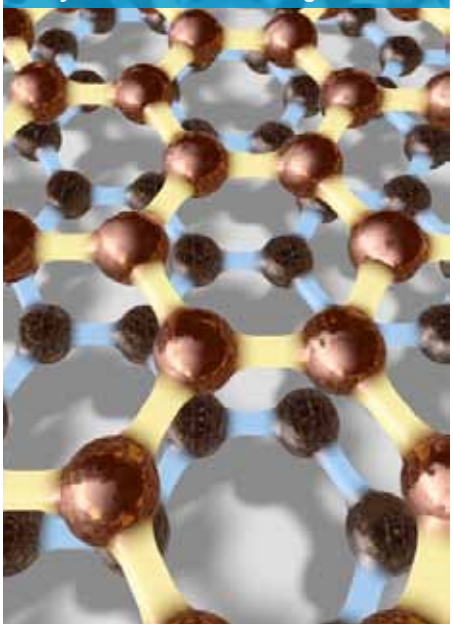
### Sufficiency

A number of objections have been raised by the EPO alleging a lack of sufficiency, ie, that the patent application, in combination with the common general knowledge, does not provide sufficient information for the claimed invention to be reproduced. In this regard, a number of examiners have noted the significant difficulties with producing graphene substrates, such as graphene ribbons, and pointed to commentaries in the art to support these difficulties.

During the emergence of a new field of technology, the common general knowledge may not be particularly well settled and may be open to debate. This is particularly the case for industries where research is being conducted at a furious pace and there are few standardised and well characterised production methods.

Therefore, applicants should ensure that their patent applications contain a robust and comprehensive explanation of how the invention is to be reproduced, and should not seek to rely solely on methods disclosed in a small number of previous publications which may be shown later to produce inconsistent results.

**Graphene is the thinnest material known and yet also one of the strongest**



### Clarity

The EPO also appears to be particularly sensitive to the claim language used when examining subject matter from an emerging technology. In particular, it can be seen that a number of objections have been raised against misuse of the term 'graphene' in the sense that it has in some cases apparently not ruled out the presence of graphite or fullerene allotropes. This is perhaps because of an inconsistency between the description and the claims, or perhaps just because of a poor definition. Also, some Examiners have raised concern over the inconsistent use of the terms 'graphane' and 'graphene', and the unclear use of the term 'functionalised' in the context of 'functionalised graphene'.

Taking the use of the term 'functionalised' as an example, care should be taken to ensure that any method used to determine the type and extent of 'functionalisation' is clearly disclosed and not contradicted in the description, or by the common general knowledge. This is especially the case where the term is used to establish patentability. Where a term is essential to establish patentability, the EPO requires that it should be clearly defined and its parameters reliably determinable. If there are multiple methods for determining the 'functionalisation' which may provide different results, it is important to ensure that at least one way is described in the application in detail and that the invention is linked to this specific method.

Care should also be taken when discussing certain properties of graphene, such as conductivity. For example, in view of graphene's potential to display ballistic conductivity, but not necessarily superconductivity, it is important to ensure that the properties of the material are defined correctly.

### Product-by-process

As mentioned above, cheaper fabrication processes for graphene are likely to represent a significant commercial goal for many. As a result, it may be that product-by-process claims form part of an overall strategy to protect such products. However, it should be remembered that for a product-by-process claim to be validly used before the EPO, the product should be patentable (eg, novel and inventive) in its own right and there should not be another way of defining the invention. In this regard, it could be argued that there is not a commonly acknowledged 'clear' way of defining new graphene substrates and so it may be allowable to define the product with reference to its production method.

### Summary

Establishing a dominating patent portfolio in an emerging technology requires a measured and balanced approach. In the case of graphene related inventions, issues relating to its methods of production, characterisation and physical properties have all been raised by the EPO. Although it seems that some of these issues could be resolved during examination, for others this may not be the case and the application may be refused. Also, as the commercial importance of graphene grows, it is these types of issues which could be exploited by opponents in order to seek revocation of the patent.

**Author:**
**Connor McConchie**

### Useful links

1. http://dycip.com/ipo-graphene

# Amendment Heals Wound
## Smith & Nephew plc v Convatec Technologies Inc

A recent UK High Court decision regarding an application by Smith & Nephew Plc (the claimant) to revoke European Patent (UK) 1,343,510 owned by Convatec Technologies Inc (the defendant) contained some interesting comments regarding the issue of added subject matter.

The patent relates to a method of preparing a wound dressing that comprises the known antimicrobial agent silver but which is stable in the presence of light. The defendant proposed an amendment that included adding to claim 1 the feature of:

> *"A material which includes gel-forming fibres containing one or more hydrophilic, amphoteric or anionic polymers".*

Claim 1 went on to specify that the polymer was selected from a list of chemical types or mixtures thereof.

The patent only contained a few mentions of the phrase 'gel-forming fibres', these included statements that:

> *"Materials which are particularly adapted for the inventive method include gel-forming fibres such as Aquacel™…or those described in WO 00/01425…wound dressings containing similar gel-forming fibres behind or overlying a non-continuous or perforated skin-contact layer such as Versiva™."*

Aquacel™ is a commercially available material that contains sodium carboxymethyl cellulose.

**The patent relates to a method of preparing a wound dressing that comprises the antimicrobial agent silver**

The claimant argued that the amendment involved an intermediate generalisation and that there was no general disclosure of 'gel-forming fibres'. In particular, the issue arose of whether a skilled person would read the application as a whole as disclosing gel-forming fibres generally and sodium carboxymethyl cellulose as an example (as argued by the defendant) or as disclosing only sodium carboxymethyl cellulose gel-forming fibres (as argued by the claimant).

The claimant's argument was strengthened by the fact that the only gel-forming fibre disclosed in the application was sodium carboxymethyl cellulose or products that contain this fibre. In particular, the claimant argued that when gel-forming fibres are introduced in the application the language would be understood as a disclosure that the gel-forming fibres being discussed are those like Aquacel™. The claimant pointed out that alternatives mentioned such as the disclosures in WO 00/01425 and the product Versiva™ also disclose or contain sodium carboxymethyl cellulose.

The defendant argued that the words "*such as*" Aquacel™ show that the disclosure is not limited to this product but includes other gel-forming fibres made from other polymers such as those mentioned in claim 1. It was pointed out that a skilled person would know from his common general knowledge that gel-forming fibres could be made from the other polymers in the list.

The judge commented that the claimant's argument was a strong one on the basis of the words of the patent specification alone. However, the judge considered the argument regarding the common general knowledge to be the decisive one. The judge considered that a skilled person would read the disclosures in the knowledge that sodium carboxymethyl cellulose is by no means the only type of gel-forming fibre known and that other polymers can be made as gel-forming fibres as well. Hence, a skilled person would see that sodium carboxymethyl cellulose was being used as an example only. The amendment was therefore held allowable. The amended patent was also held to be valid.

This decision highlights that the issue of what is considered common general knowledge can be a key factor in the interpretation of the disclosure of the patent specification and in determining whether an amendment adds subject matter.

**Author:**
**Michael Simcox**

# Orange Book Case Revisited
## Developing FRAND Terms For Standards Related Patents

> *Further information*
> *An extended edition of this article is available online at www.dyoung.com/article-orange0712*

Those practicing in the field of electronics and software will be well aware of the importance that standards play in the establishment of modern electronics and computing devices, particularly where interoperability is required. Standards setting bodies have therefore established an intellectual property rights (IPR) policy which requires that parties contributing to the development of a standard declare any patents and patent applications which are considered by the declarer to be essential to the standard. By declaring patents as essential, parties agree to license those patents to other parties on fair, reasonable and non-discriminatory terms, which are known by the abbreviation FRAND. However what FRAND means in practice is an open question.

The Orange Book case concerned CD-Rs and CD-RWs. The format and operation of CD-Rs and CD-RWs is set out in a standard known as the Orange Book. In 2009 Philips sued SK Kassetten, a distributor of CD-Rs and CD-RWs, for patent infringement, in a German regional court. The patent was determined by both the regional court and the Court of Appeal to be infringed, because it was essential to the operation of the standard. As a remedy for the infringement, the regional court granted Philips injunctive relief, which was upheld by the Appeal Court. The defendant appealed the decision to the Bundesgerichtshof (BGH) arguing that the Appeal Court should not have upheld the grant of injunctive relief, because this was not consistent with the requirements of FRAND.

In a landmark judgment the BGH confirmed that the holder of a standards essential patent may be entitled to injunctive relief. The defendant is only entitled to a defence against an injunction if the patent proprietor does not license the patent after the defendant has made an unconditional offer to license on FRAND terms and is bound by the license agreement for infringing acts committed before the license was concluded. Injunctive relief will be denied if the patent proprietor discriminates against a company by demanding licensing terms, which inequitably obstructs the company from entering a market which FRAND terms are intended to allow. The defendant bears the burden of proving that the offered license is fair and reasonable, and the patent proprietor can refuse the license if the demands being made by the defendant go further than what would be considered to be fair and reasonable under competition law. Notably the BGH indicated that offering to take a license only under the condition that the court finds that the patent is infringed does not make the offer unconditional and therefore injunctive relief is still available.

In a further development of the decision, in November 2011, the District Court of Mannheim in Apple v Motorola determined that Motorola were entitled to injunctive relief for patent infringement even though Apple had offered to take a license on FRAND terms. Consistent with the Orange Book judgment by the BGH, the court differentiated between the licensing conditions for infringing acts which occurred before an offer to license had been made to those acts after the offer had been made. An offer to take a license under FRAND terms for past infringing acts did not represent an unconditional offer so that the claimant is still entitled to injunctive relief in spite of the offer. Furthermore, challenging the validity of a patent whilst offering to take a FRAND license was considered to be inconsistent behaviour and therefore also did not comply with the requirements for an unconditional offer to license. As such the injunctive relief could be granted.

In contrast the Dutch courts in the parallel case to the Orange Book took a different approach. The District Court of the Hague disagreed with the decision of the BGH and concluded that the rights of a patent proprietor are not affected by the presence of an agreement to license a patent under FRAND terms. A defendant who proceeds to use the patented technology without the permission of the patent proprietor therefore is under a risk of an injunction being granted against infringing activities.

But what if the patent proprietor is a non-practising entity? If the patent proprietor itself is not satisfying a market for a product then could the patent proprietor still obtain an injunction preventing commercial activities of the defendant within a market which the patent proprietor itself is not satisfying? This is particularly important because many non-practising entities have declared patents to be essential against standards. Certainly the general principles applied by the UK courts are that injunctive relief is an equitable remedy and considers whether the patent proprietor can be compensated by monetary damages alone and would suggest that the granting of injunctive relief depends on the circumstances of the patent proprietor. And yet in all the decisions from the German and the Dutch courts the activities of the patent proprietor do not seem to have been considered. Perhaps we will have to wait for the unitary patents court to operate before we get a unified approach to the conditions for granting injunctions and the implication for FRAND terms.

**Format and operation of CD-Rs and CD-RWs is set out in the Orange Book standard**

**Author:**
**Jonathan DeVile**

*Article 06*

# The Tomato Case
## G2/12 All In A Stew

**Can the Enlarged Board of Appeal continue with G2/12 now Unilever's Appeal is withdrawn?**

The Technical Board of Appeal in the tomato case (T-1242/06) issued an interlocutory decision on 31 May 2012 referring yet further questions to the Enlarged Board of Appeal. This time the questions relate to the patentability of product (plant) claims following the opponent's (Unilever's) request that further questions should be referred to the Enlarged Board.

The new Enlarged Board of Appeal case is pending as G2/12 and the three questions regarding the patentability of plants referred to the Enlarged Board of Appeal are set out here (see right). However, Unilever has now withdrawn its appeal.

The question on everyone's lips is: can the Enlarged Board of Appeal continue with G2/12 now that Unilever has withdrawn its appeal? There is no precedent for this situation and no case law on this specific point.

However, can the Enlarged Board of Appeal really proceed with a case, if the appellant (who raised the objection that led to the referral) has withdrawn from the appeal?

It would appear that G2/12 may have to be terminated without an opinion of the Enlarged Board of Appeal.

**T-1232/06 Questions**

1. Can the exclusion of essentially biological processes for the production of plants in Article 53(b) EPC have a negative effect on the allowability of a product claim directed to plants or plant material such as a fruit?

2. In particular, is a claim directed to plants or plant material other than a plant variety allowable even if the only method available at the filing date for generating the claimed subject-matter is an essentially biological process for the production of plants disclosed in the patent application?

3. Is it of relevance in the context of questions 1 and 2 that the protection conferred by the product claim encompasses the generation of the claimed product by means of an essentially biological process for the production of plants excluded as such under Article 53 (b) EPC?

**Author:**
**Aylsa Williams**

*Article 07*

# 2012 European Inventor Award
## Rewarding Innovation

Launched by the European Patent Office and organised with the European Commission, this prestigious award rewards inventors (granted at least one valid European patent for their invention) for their contribution to technological and economic progress.

**Industry**
Jan Tøpholm, Søren Westermann and Svend Vitting Andersen of Widex (Denmark) were recognised for the development of a computer-aided method of manufacturing individually-fitted hearing-aid devices used worldwide in the majority of hearing aid devices.

**SMEs**
Dr Manfred Stefener, of SFC Energy AG (Germany), Oliver Freitag and Dr Jens Müller's were honoured for their invention relating to environmentally friendly fuel cells for portable use, known as the direct methanol fuel cell (DMFC).

**Research**
Dr Gilles Gosselin, Professor Jean-Louis Imbach (French National Center for Scientific Research) and Dr Marti L Bryant were recognised for the development of an effective and successfully commercialised drug for the treatment of hepatitis B.

**Non-European countries**
Australian inventors Dr John O'Sullivan, Graham Daniels, Dr Terence Percival, Diethelm Ostry and John Dean from the Commonwealth Scientific and Industrial Research Organisation (CSIRO), Australia's national science agency, made wireless local area networking (W-LAN) faster and more robust so that it could replace cabled networks and become the foundation of today's popular Wi-Fi networks.

**Lifetime achievement**
Professor Josef Bille (University of Heidelberg, Germany) is a pioneer in the field of laser eye surgery, and has filed almost 100 patent applications relating to ophthalmology. His invention of wavefront technology for laser eye surgery allows aberrations in the iris to be accurately mapped in great detail.

**Author:**
**Cathrine McGowan**

# Permissible Amendments And Sufficiency
## A Review Of Recent European Patent Office Decisions

Several decisions recently added to the EPO database of Board of Appeal decisions[1] have been selected for review. They collectively provide some insight into the way the Boards are considering the question of permissible amendments and sufficiency.

### Added matter

T-759/10 provides further guidance of the fact that the previously accepted unwritten understanding that one could, even without specific basis, amend the term 'comprising' in a claim to 'consisting essentially of…', is now a thing of the past. Previous to this decision, T-472/88 and T-975/94 had confirmed the unwritten understanding whereas T-868/04, T-903/09 and T-725/08 provided an indication that the 'understanding' was misplaced.

In T-759/10 this amendment had been made to overcome prior art. The specification had specific basis for the composition 'comprising' or in the alternative 'consisting of' the claimed texturizing agents. Despite the appellant's (patentee's) arguments that 'comprising' encompassed the alternative expressions 'comprising', 'consisting of' and 'consisting essentially of' and therefore by itself already provided a sufficient basis for 'consists essentially of', the Board concluded that each clearly had an alternative technical meaning. Thus, as T-472/88 provided the well-understood meaning of 'consisting essentially of', this specific meaning did not have basis in the specification and its inclusion was therefore impermissible. The appellant additionally argued that the general and specific examples showed that the claimed texturizing agents could be used in an unpurified form which was commensurate with 'consisting essentially of' but this too was not accepted by the Board.

Referral to the Enlarged Board was refused as, despite the existence of conflicting decisions (as set out above), the Board explained that these arose from the intervening decisions of the Enlarged Board of Appeal in G2/98 and G1/03. These decisions clearly establish that the test for priority (same invention), novelty and amendment is identical ie, clear and unambiguous. There was therefore no need for a referral – things had moved on.

The clear message for all applicants is to ensure that the fall-back positions of 'consisting essentially of' and 'consisting of' are clearly included as alternative embodiments in both priority applications and final specifications.

Added matter was also the main consideration in T-0197/08 where the amendment of 'active ingredient' to 'sole active ingredient' was considered permissible even though the specific phrase did not have literal basis in the application as filed. Here the Board took the view that although the specific compound was just one of many described in the specification, monotherapy as well as combination therapy were described. Looking at the examples where single agents were administered in the biological examples and formulation examples each contained a single agent, the Board concluded that it would be clearly understood that monotherapy was contemplated and most probably preferred. This was sufficient basis for the amendment.

This decision is in some way consistent with a decision from the end of 2011 (T-1188/10) where the only basis for the claimed range of preservative was the upper and lower amounts used in the examples. Here the claimed range was 0.006% to 0.015% and the only specific basis in the description was 0.0001% to 1%. The Board looked at the examples and concluded that as the preservation effect appeared to be generally applicable to a range of foods and bacteria, the upper and lower amounts used could be taken from the examples and combined to form a range. Both these decisions demonstrate the willingness of the Board to consider the examples and not just conclude that they are specific to the particular conditions described but can be extended to a generalisation.

### Sufficiency

Moving on to sufficiency, the Boards of Appeal have provided some guidance as to when the argument "the skilled person cannot determine when he infringes" is actually relevant. The patent in T-593/09 had been revoked as being insufficient for that reason – the claimed parameter of "low temperature crystallisation" (LTC) could not be determined and therefore the Opposition Division concluded that as an infringement determination could not be made the patent was insufficient. On appeal, the end result was the same (patent revoked as being insufficient) but for a subtly different reason.

There was much debate as to whether there was sufficient detail in the specification or within the common general knowledge to enable the skilled person to measure this parameter. The deficiency lay in the absence of the heating rate required when conducting differential scanning calorimetry (DSC) as variance in the rate of heating was known to affect the measured LTC. The Board concluded that the inability to measure the parameter and therefore be able to reproduce the technical teaching of the patent rendered it insufficient. The Board continued to state that the 'infringement test' was only applicable when considering Art 84 EPC (clarity, not available as a ground of opposition) and referred to T-1062/98 as basis for this. Several decisions on sufficiency that appeared to rely on this test were dismissed as the test was not the sole reason for reaching such a conclusion. Regarding sufficiency of a vague parameter the Board concluded:

> *"What is decisive for establishing insufficiency within the meaning of Article 83 EPC is whether the parameter, in the specific case, is so ill-defined that the skilled person is not able, on the basis of the disclosure as a whole and using his common general knowledge, to identify (without undue burden) the technical measures (eg, selection of suitable compounds) necessary to solve the problem underlying the patent at issue."*

# PCT(UK) Fast Track
# UK IPO Relaxes Requirements

**Result to be achieved**

There are many applications directed to and patents even granted to claims that appear to be directed to a 'result to be achieved'. An excellent example of this arose in T-1751/07, a decision relevant to the pharmaceutical industry. The claim was directed to a controlled release composition (tablet/capsule) where the drug was present as nanoparticles together with a surface stabiliser in a polymer matrix;

> *"wherein controlled release refers to therapeutically effective release of the drug in a patient for a time period ranging from 2 to 24 hours"*

The Board concluded that that this phrase raised significant areas of ambiguity:

- Was release prior to the second hour permissible?
- Did the therapeutic effect have to exist for the whole period of 2-24 hours?
- Did it matter when the therapeutic level was reached as long as it was maintained for 2-24 hours?
- What if drug release or the drug level remained unchanged after 24 hours?

In short, the definition was so ambiguous that to grant the claim as such would be unreasonable. This is not to say that claims to a 'result to be achieved' are impressible *per se*, but the decision clearly demonstrates the Board's insistence that as the claim could not be clearly understood, it must be refused as lacking clarity.

**Author:**
**Neil Nachshen**

**Useful links**

1. http://dycip.com/EPOappealdatabase



**UK IPO relaxes the PCT(UK) Fast Track requirements**

Following the discussion on ways to accelerate prosecution in the UK in our December 2011 newsletter, the requirements for the PCT(UK) Fast Track have now been relaxed following a new practice notice from the UK Intellectual Property Office (UK IPO)[1].

As regular readers of our newsletter may recall, the PCT(UK) Fast Track previously only applied to cases where the International Preliminary Report on Patentability (IPRP), or the Written Opinion of the International Searching Authority (WO-ISA), contained a positive opinion for all claims of the international application with regard to novelty, inventive step and industrial applicability. Thus, if one claim had received a negative opinion in the IPRP, the PCT(UK) Fast Track was not available to the applicant, even if this claim was deleted on UK national phase entry. This was therefore a very high standard to meet.

The UK IPO has now indicated that, from 8 June 2012, the PCT(UK) Fast Track will be available "*where the claims on file in the UK national phase sufficiently correspond to one or more claims indicated as acceptable in the IPRP or WO-ISA*". Two of the key points in this relaxation of the requirements are:

- "*sufficiently correspond*": a claim will be considered to meet this requirement when it has the same or a similar scope as a claim found acceptable in the IPRP or WO-ISA or if it is narrower in scope. However broader claims, claims in a different category (even if they correspond to claims found acceptable in the IPRP or WO-ISA), or claims not examined during the international phase will not be considered to meet this requirement.
- "*one or more claims indicated as acceptable in the IPRP or WO-ISA*": this wording now removes the requirement that all claims of the international application should have received a positive opinion.

This relaxation of the PCT(UK) Fast Track requirements by the UK IPO is most welcome and, as the UK IPO has set itself the target of issuing a substantive examination report within two months of receipt of the request for accelerated examination on at least 90% of cases, the UK IPO is likely to see an increase in the number of PCT(UK) Fast Track requests in the future.

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**Useful links**

1. http://dycip.com/IPOfasttrack1

# Stop Press: Samsung v Apple
## Not As Cool, But Not Infringing

Coolness goes far beyond just the front screen of a handheld tablet computer

On 9 July 2012 a decision was issued by the UK High Court in the on-going dispute between Samsung and Apple. This decision concerns Apple's Registered Community Design (R000181607-0001 ('the RCD') and a number of Samsung's Galaxy Tab tablet computers. Specifically, this case related to a declaration of non-infringement of the RCD by the Samsung Galaxy Tab tablet computers. There was a counterclaim by Apple that these tablet computers did infringe the RCD. In the UK Courts, both of these issues would be heard at the same time.

### Stay of proceedings?

In addition to these two issues, the judge had to decide whether to stay the proceedings in respect of the declaration of non-infringement and the counterclaim. This was because there are pending invalidity proceedings in respect of the RCD before OHIM. The judge took a rather pragmatic approach in deciding this part of the case. As Samsung had not sought a declaration of invalidity of the RCD before the UK Court, then there is no risk of inconsistent decisions between the UK High Court and the OHIM proceedings. Also, if the UK High Court did decide that Samsung's tablet computers did infringe Apple's RCD, then it would be unfair for Apple to wait for relief pending the outcome at OHIM. The judge held that both the claim and counterclaim would be heard.

### The case

Apple claimed that the similarities between the RCD and the Samsung tablets could be divided into the following seven features:

1. A rectangular, biaxially symmetrical slab with four evenly, slightly rounded corners.
2. A flat transparent surface without any ornamentation covering the entire front face of the device upto the rim.
3. A very thin rim of consistent width, surrounding and flush with the front transparent surface.
4. A rectangular display screen surrounded by a plain border of generally constant width centred beneath the transparent surface.
5. A substantially flat rear surface which curves upwards at the sides and comes to meet the front surface at a crisp outer edge.
6. A thin profile, the impression of which is emphasised by (5) above.
7. Overall, a design of extreme simplicity without features which specify orientation.

In order to decide whether the Samsung Galaxy Tabs infringed the RCD, the judge needed to firstly identify the informed user. Secondly, the design was broken down into features. Thirdly, the overall significance of each feature should be considered. A feature dictated solely by function was to be disregarded. As long as not disregarded, each feature was then considered against the design corpus and considered from the point of view of design freedom.

The informed user in this case was not disputed by either side and was defined as a user of handheld (tablet) computers.

However, in order to determine the issue of degree of design freedom and the features dictated solely by function, the Court directed that the parties may each call an expert. These experts were cross-examined by the opposing party. This type of evidence is extremely valuable in this type of proceedings to put designs into context.

In his decision, the judge then addressed each of the similarities identified by Apple in turn. The following paragraphs correspond to the numbering of the features identified by Apple.

1. The judge held that the overall significance of a rectangular display was banal and determined solely by function. Although the judge accepted that these devices do not need biaxial symmetry, nor be rectangular, there are a number of designs in the design corpus that have such features. In other words, it was known to designers at the time of filing the RCD to have biaxial symmetry and be rectangular. Therefore the significance of this feature was limited.

2. Although the similarity between the Samsung tablets and the RCD is striking, the design corpus does contain some identical and very close designs. Therefore, the informed user's knowledge of the design corpus reduced the overall significance of the similarity somewhat.

3. The overall significance of this feature is limited due to the design corpus containing some identical and very close designs.

4. The design freedom of this feature is constrained considerably. However, this alone did not account of the close similarity between the Samsung tablets and the RCD. The similarity is however reduced by the presence of a number of designs with similar features in the design corpus.

5. Aside from the design constraint of the back being flat, this feature has considerable design freedom. The sides in the Samsung tablets were similar but are not unusual for products of this type. The informed user would recognise the RCD in this respect as belonging simply to a familiar class of product with somewhat curved sides and a crisp edge. The Samsung tablets are members of the same familiar class.

6. The Samsung tablets look much thinner than the RCD. This is important to the informed user. The Samsung tablets use the same thinness enhancing edge effect as the RCD. However, this in itself is not significant although none of the members of the design corpus use this feature.

7. The front of the RCD was very simple. The Samsung tablets have non-prominent features which specify orientation. The back of the RCD however, is different to the Samsung tablets. The ornamentation on the back face of the tablet strikes the informed user as unusual. That enhances the significance of the difference.

### Overall impression

The judge was keen to stress that objects in this field are handheld, so although the front of the device is important, the informed user would pick up the device and will look at the back. The judge therefore categorized the features as being related to the front (features 1-4), back and sides (features 5 and 6) and overall (feature 7).

The front of the Samsung tablets were judged to be very similar to the RCD. The Tablets use the same screen, with flat plate glass out to a very thin rim and a plain border under the glass. Although the Samsung tablets had subtle buttons on the front, these did not contribute to the overall impression of the tablets.

The details of the side edges between the RCD and the Samsung tablets were not judged to be the same. The RCD had a pronounced flat side face which the informed user would see clearly and feel. It is absent from the Samsung tablets.

The judge commented that the front of the Samsung tablets is strikingly similar to the front of the RCD. However, the judge commented that the front view of the RCD was very similar to that in the design corpus. Indeed, the Judge likened the front view in the RCD and the Samsung tablets to being in the same family as the design corpus. In other words, neither the RCD, nor the Samsung tablet were much different to previous designs. Therefore, the informed user's attention would be drawn to the differences at the back and sides and that such differences would be enhanced considerably.

The judge concluded that the Samsung tablets were thinner than the RCD and had unusual details on the back. This meant that the tablets do not have the same understated and extreme simplicity as the RCD.

Highlighting that our Judiciary are fashion conscious,

> the judge concluded that Samsung Tablets were "*not as cool*" as the Apple RCD

and so the overall impression was different. Therefore the Samsung tablets do not infringe the RCD.

### Conclusion

This case was interesting for a number of points. This case illustrates the importance of properly taking into account the informed user's knowledge and experience of the design corpus. The use of expert witnesses, and the cross-examination of such witnesses, really assists in this process.

Additionally, it was interesting how the judge looked beyond the front side of the Samsung tablet and the RCD. The fact that these objects are designed and built to be handled by users meant that the design of the front is important, but not exclusively important. It is the overall impression of the totality of the design which will be decisive.

This is a point worth noting in view of the increasing importance attributed to the design of handheld devices in the marketplace.

Finally, as Sir Jonathan Ive and the late Steve Jobs would surely appreciate, their tablet design has now been judicially recognised as *"cool"*.

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*Information*

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## And finally…

### D Young & Co Webinar Invitation
### Cloud Computing

**Wednesday 19 September 2012**
**9am, 12pm and 5pm BST (UK time)**

With a large combination of cloud service and deployment models available, this webinar highlights the critical need to select or provide a service that meets both technical needs and regulatory requirements. We will also discuss innovations within the cloud and the issues that surround the patenting of ideas in a multi-party and multi-jurisdictional operating environment. The webinar will be hosted by Cathrine McGowan with speakers Doug Ealey and Susan Keston from our Electronics, Engineering & IT Group.

**Register to secure your free webinar seat at www.dyoung.com/event-websep12**


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