

PATENT NEWSLETTER

NAVIGATE YOUR ROUTE TO AN EFFECTIVE FILING STRATEGY

ARE NATIONAL FILINGS
IN EUROPE A VIABLE
ALTERNATIVE TO THE EPO?

In the early 1980's when the European Patent Office (EPO) was new, there was much discussion of when to use the EPO and when to continue with national filings. The overall conclusion was that the EPO was less expensive when at least 3 or 4 countries were needed. Over the years, national filings generally fell out of favour, even for those applicants for whom it could have been a good option. However, in recent years, this 'dead' question has become topical once more due to the many changes to the European Patent Convention (EPC) that have been made since the end of 2007, when EPC2000 came into force (see October 2007 newsletter: www.dyoung.com/newsletter/patentnewsletter1007.pdf), and due to the London Agreement which came into force in early 2008 (see December 2007 newsletter: www.dyoung.com/newsletters/patentnewsletter1207.pdf).

One side effect of the recent London Agreement is a significant loss of translation work at the EPO grant phase for some European patent firms. This is particularly a problem for German patent law firms. It has not gone unnoticed that since the advent of the London Agreement, there has been an increased promotion in some quarters of German national patent filings instead of EPO filings. The marketing argument put forward is that a German

national filing is a low cost value-for-money alternative to an EPO filing. How true is this? This article seeks to give an answer to that question. More generally, this article explores the costs and value-for-money of filing at the EPO to obtain protection in Germany, France and the United Kingdom (UK) against obtaining the same protection through national filings.

The modelling results presented in this article of course make a set of assumptions. It is assumed that an English-language specification is available at no cost. This will be the case for most applicants: either because the case was drafted in English, or because an English translation has been prepared for a parallel US filing. Consistent with that, it is assumed that French and German translations must be obtained at commercial rates. For simplicity, it is assumed that all the patents grant in year 5, although in reality the French and UK patents will most often be granted earlier. The timing of the grants has no significant effect on the conclusions reached. For both the German and UK patent applications, it is assumed that combined search and examination is requested on filing. The EPO, German and UK cases are modelled with an assumption that one office action is needed at a cost of €1,500. The French

case assumes the cost of considering and responding to the search is €1,000. Although we do not present other results in this article, we have modelled all the variable costs within normal ranges, such as attorney fees, and translation rates, and also changed the assumptions regarding numbers of office actions, and nothing significant changes in the overall conclusions.

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	CONTACT AND SUBSCRIPTIONS

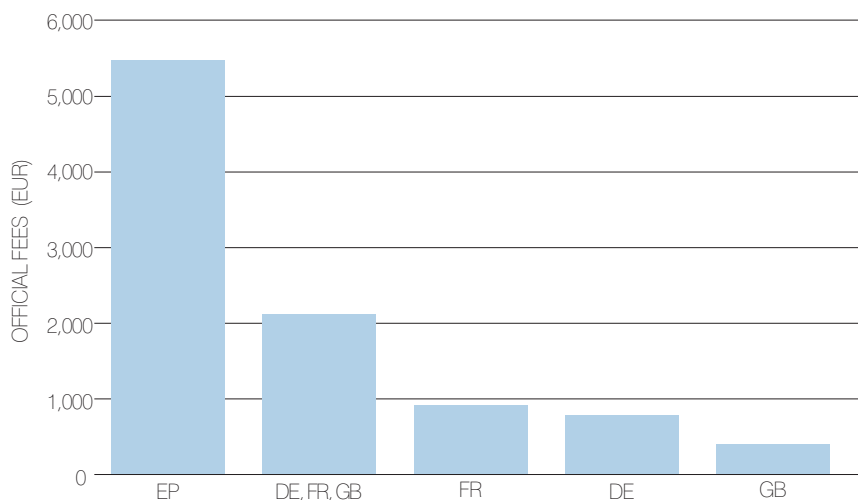


Figure 1, right, is a bar chart of official fees to grant including renewal fees for an example case with 15 claims and 20 pages of description. As expected, we see the EPO official fees are very high - almost three times the combined official fees of German, French and UK national filings. If the numbers of claims exceed 15, then the EPO becomes relatively more expensive, since it has high excess claims fees of €200 per claim from the 15th claim. Germany and France also have excess claims fees, but at much lower levels of €30 and €40 per claim respectively. The UK currently has no claims fees, and overall the UK official fees are extremely low.

While EPO official fees are much higher than the combined national official fees, the question is whether the savings on official fees are more than offset by the multiplication of attorney costs when separate national filings are pursued.

Figure 2, below, is a graph plotting the cumulative cost of an EPO case which is validated in Germany, France and the UK, alongside the cost of the 3 equivalent national filings. The graph in Figure 2 shows the

FIG 1: A BAR CHART OF OFFICIAL FEES TO GRANT INCLUDING RENEWAL FEES



cumulative costs for the first 8 years. The costs of the three individual national filings are also plotted. The same example case is used as in Figure 1, i.e. 20 pages and 15 claims. The total EPO costs to grant are lower. Although not plotted, we varied the cost parameters widely, and the EPO filing is nearly always cheaper. The only exception is when there is a very short specification (e.g. 10-20 pages) and a very high number of claims (40+), but this is not a likely scenario. Figure 2 also shows the phasing of the expenditure, and the EPO filing is also better in this regard, since if national filings are made the translation costs (for Germany and France) are incurred at filing. The EPO costs remain much lower than the national filings until EPO grant when the high EPO grant phase costs reduce (but not close) the gap.

Another question is whether an applicant wishing to gain European protection only in France and Germany is better off using the EPO or national applications in France and Germany. Our modelling shows they will cost about the same for most applicants. The French and German national route costs the same as the EPO route when there are about 30 pages of text. For very short texts, the national route is slightly cheaper, and for very long texts of 50+ pages the EPO is much cheaper.

There are also significant factors that are not taken into account by the modelling, all of which point in favour of the EPO and against a strategy which involves German or French national filings:

- If abandonment and refusal rates were factored in, then the EPO route would become more favourable, since the high grant phase costs will never be incurred for such cases, whereas the high cost of translation will be incurred for all French and German national cases on filing.
- The German patent office often cites documents only available in German, and these must either be translated or considered solely by the German attorney.
- The German national patent system has a post-grant opposition procedure similar to the EPO, and

FIG 2: A GRAPH PLOTTING CUMULATIVE COSTS FOR THE FIRST 8 YEARS

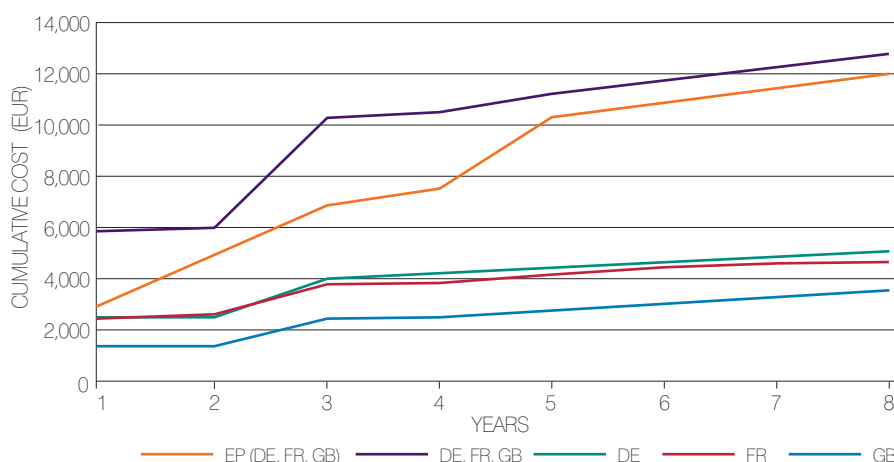
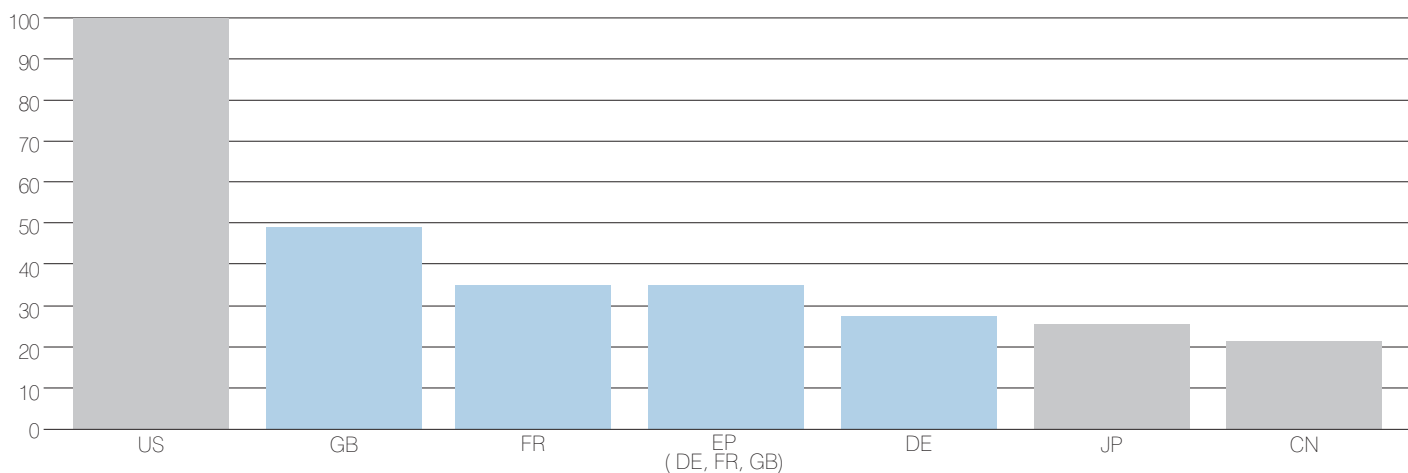


FIG 3: A BAR CHART OF VALUE-FOR-MONEY



- oppositions are quite common, since many German companies have routine watches in place to identify all grants by competitors and/or in certain classifications.
- French national filing is not possible after PCT, since France cannot be directly designated in a PCT application. The so-called “national route” is closed. A French national patent application must therefore be filed at 12 months from priority through the Paris Convention.

Thus far we have only considered absolute costs. It is also important to think about the overall economic significance of the territory. How big is the market? To measure value-for-money, we use the territory’s gross domestic product (GDP), since this is a universal proxy for market size. In the context of this article, we have not considered different market sizes for individual technologies, but have assumed homogenous market conditions. The value-for-money of a patent is therefore the territory’s GDP divided by the cost of obtaining a patent there. In the August 2009 edition of our newsletter: www.dyoung.com/newsletters/dyoungpatentnewsletter0809.pdf we presented such results as an aid to devising a global filing strategy. Our earlier article showed - unsurprisingly - that a US patent is the best value-for-money, since it combines a huge market size with a relatively inexpensive patent system. On a value-for-money index with US set at 100, the next best value patents identified in our earlier article were EP (index = 28¹), Japan (25) and China (23). In the present article, we use the

same measure to determine the value-for-money index of national patents in Germany, France and the UK, and then to compare that with an EPO filing covering these three countries.

Figure 3, above, is a bar chart of value-for-money for the various filings considered in this article overlaid with the other best value-for-money countries taken from our earlier article, these other countries being shown in grey. What we see is that a UK national patent is the best value-for-money of all the European options with a rating of 49, followed by a French national patent, the EPO (DE, FR, GB), and finally a German national filing.

The good value of a UK patent follows from the low cost of obtaining a UK patent coupled with the large market size of the UK, which is essentially the same as France and 75% of Germany. The relatively poor showing of Germany follows from the fact that its market size is not much bigger than either France or the UK, but it has a much more expensive national patent system with the lifetime cost of a German patent being 2-3 times that of a UK patent. The relatively high lifetime costs of the German system relate not only to higher filing and prosecution costs, but also to renewal fees. German renewal fees become very expensive in the latter part of the patent term compared with UK and French renewal fees. For example, the 15th year renewal fee for Germany is €1,060, compared to €278 and €430 for the UK and France respectively. The total renewal fees payable over the full term of a patent are €3,676, €5,680 and €13,170 for the

UK, France and Germany respectively.

In summary, an applicant wishing to gain maximum value for money in Europe without using the EPO would be advised to consider filing a UK national patent only, or the combination of UK and French national patents. Based on this value-for-money strategy, a German national filing looks expensive compared to the other options, i.e. UK, French or EPO filings. In fact, the lifetime cost of a German patent, i.e. over 20 years, is approximately the same as the combined lifetime cost of UK and French national patents, whereas the combined market size of UK and France is 50% greater than that of Germany.

These results challenge the view that filing in Japan, China or even Germany is essential, whereas filing in the UK or France is peripheral. Such a view is traditionally based, at least in part, on obtaining patent protection in manufacturing countries. However, as manufacturing patterns are changing rapidly, a more secure and long-term basis for patent planning is consumer countries, whereby GDP becomes much more relevant. On this basis, a UK patent is much better value in terms of market coverage than any other patent apart from a US patent, and filing UK and French national patents in combination gives greater European market coverage at approximately the same cost as filing in Germany.

For further information please consult your usual D Young & Co advisor.

MILES HAINES
BENJAMIN HUSBAND

¹ Assumed validation in Germany, France, UK and Italy

SHORTENED TIME LIMIT FOR FILING DIVISIONAL APPLICATIONS

Under amended Rule 36(1) EPC divisional applications must be filed before the expiry of 24 months from:

- a) The Examining Division's first communication in respect of the earliest application; or
- b) Any communication in which the Examining Division has raised a unity objection to the earlier application, provided it was raising this specific objection for the first time.

TRANSITIONAL PROVISIONS FOR FILING DIVISIONAL APPLICATIONS

Where a first communication or a new specific lack of unity objection was issued before 1 October 2008, either on a specific case or any preceding parent, then the deadline for filing any new divisionals is 1 October 2010.

In addition to these new time limits, the previous requirement that the parent application must be pending at the time of filing a divisional application still stands. So any divisional application must be filed before the parent application is granted, refused or withdrawn, even if this is earlier than the above mentioned date.

PLURALITY OF INDEPENDENT CLAIMS IN SAME CATEGORY

The EPO objects to applications which contain more than one independent claim in the same claim category (product, process, apparatus or use) except under specific circumstances, e.g. interrelated products. Currently, this type of objection is raised and dealt with during examination.

Under new Rule 62a for Search Reports issued on or after 1 April 2010:

- This type of objection will be raised by the Search Division. The applicant will be given two months to specify which claims are to form the basis of the search. If no response is filed, the EPO will search the first independent claim in each category by default.
- The Examining Division will invite the applicant to restrict the claims to searched subject matter unless it finds that the objection was not justified.

NEW YEAR'S RESOLUTIONS EPO ANNOUNCES MULTIPLE RULE CHANGES FOR APRIL 2010

We have recently seen a flurry of EPO announcements. As 2009 draws to an end, it is a good time to summarise the changes that will be in force from 1 April 2010.

INCOMPLETE SEARCH

Currently, if it is impossible to carry out a meaningful search on some or all of the claims, the Search Division issues a reasoned declaration to this effect or issues a partial Search Report. The applicant would be given an opportunity to amend during examination and a new search may be required.

Under new Rule 63 EPC for Search Reports issued on or after 1 April 2010:

- The EPO will invite the applicant to file a statement indicating the subject matter to be searched within a period of two months.
- If no response or an insufficient response is filed, the EPO will issue a reasoned declaration explaining no meaningful search could be performed or, as far as practicable, will draw up a partial Search Report.
- If a partial search report has been drawn up the Examining Division will invite the applicant to restrict the claims to searched subject matter, unless it finds that the objection was not justified.

MANDATORY RESPONSE TO THE EXTENDED EUROPEAN SEARCH REPORT

At the moment it is optional to file a response to the Extended European Search Report (EESR). If no response is filed, the Examining Division reissues the opinion included with the EESR in the first Examination Report.

Under new Rule 70a EPC for EESRs issued on or after 1 April 2010 a response must either be filed:

1. Within the period for requesting examination (6 months from publication of the Search Report), if examination has not already been requested; or
2. Within the period for indicating whether or not the application is to be proceeded with (2 months from receipt of relevant communication), if examination has already been requested or a supplementary Search Report has been drawn up on a Euro-PCT.

BASIS FOR AMENDMENTS TO THE EUROPEAN PATENT APPLICATION

The EPO has always asked for the basis of any amendments made to a European patent application. For applications on which a Search or supplementary European Search Report is issued on or after 1 April 2010, under amended Rule 137 EPC, the provision of such information will be mandatory. If the information provided is not sufficient, the Examining Division will issue a time limit of one month to supplement the information.

EXAMINATION WHERE EPO WAS INTERNATIONAL SEARCHING AUTHORITY (ISA) OR INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY (IPEA)

Currently, after entering the EP regional phase a Rule 161 EPC communication is issued setting a 1 month time limit

to (optionally) amend the application; and the first Examination Report for an EP-PCT will include the objections raised during the International phase (in the written opinion of the ISA or the IPEA).

For all European applications where a Rule 161 EPC communication has not issued before 1 April 2010 under amended Rule 161 EPC, where the EPO was the ISA or IPEA, there will be a requirement to respond substantively to the written opinion of the ISA or IPEA within a period of one month from a communication issued by the EPO.

RESTRICTION OF CHANCES TO AMEND THE APPLICATION

Currently the applicant can amend the application after the European Search Report, and also after receipt of the first Examination Report.

For applications for which the European Search Report is drawn up on or after 1 April 2010 under amended Rule 137, the EPO has removed the second opportunity for the applicant to make amendments as of right in response to the first Examination Report. The only chance to make voluntary amendments will be in response to the communications under new Rules 70a and 161 EPC, detailed above, which issue before formal examination commences! After that amendments are at the discretion of the Examining Division.

MORE TIME FOR PAYMENT OF FURTHER SEARCH FEES

Currently if a lack of unity objection is raised, the EPO will invite the applicant to pay an additional search fee within a period of no less than two weeks and no more than six weeks.

For applications for which the European Search Report is drawn up on or after 1 April 2010, under amended Rule 64 any further search fees must be paid within a two month period.

DRAFT UPDATED EPO GUIDELINES

On 30 November 2009, the EPO published a notice and a draft version (in English only) of the future Guidelines for Examination applicable as of 1 April 2010 at: www.epo.org/patents/law/legal-texts/guidelines-2010.html

CATHERINE MALLALIEU

FURTHER RECENT EPO CHANGES

PRIOR ART DETAIL REQUESTS

Since the introduction of EPC 2000, the EPO has been entitled under Rule 141 EPC to invite Applicants to provide details of prior art taken into consideration in national or regional patent proceedings and concerning an invention to which the European application relates. The following changes will come into force on 1 January 2011:

CHANGES TO RULE 141 EPC TIME-LIMITS

Under amended Rule 141 EPC, the EPO will invite Applicants to provide prior art details within a period of 2 months. Failure to comply in due time will lead to the European patent application being deemed withdrawn, but further processing can be requested.

PRIORITY APPLICATION SEARCH RESULTS

If a European or Euro-PCT patent application claims priority from an earlier application, under new Rule 70b EPC and amended Rule 141 EPC:

- Applicants must file the results of searches carried out on the earlier application by the patent office with which the earlier application was filed.
- The results should be filed at the same time as filing a European patent application or on entering the European regional phase or as soon as possible once the search results are available to the Applicant.
- If search results are not filed in time, the EPO will invite the Applicant to provide the search results or a statement explaining why the results are not available to the Applicant within a period of 2 months.
- Failure to comply with the request in due time will lead to the European patent application being deemed withdrawn. However, further processing can be requested.

This new requirement applies where the European patent application or (in the case of a Euro-PCT application) the international patent application is filed on or after 1 January 2011.

SUPPLEMENTARY INTERNATIONAL SEARCH REPORTS

Since 1 January 2009 PCT Applicants have been able to request the performance of supplemental searches

during the international phase, in addition to the search prepared by the Applicant's "usual" International Searching Authority (ISA). The December 2008 PCT Newsletter indicates that it is expected that this service will not be used routinely, but rather for select cases of particular commercial importance where for example the Applicant is concerned that the "usual" international search report does not list prior art that they expected to be relevant. A prior art document may not be identified for example because the ISA is not skilled in the document's language. An Applicant may therefore wish to have a supplementary international search (SIS) performed by an ISA that is more familiar with the language that relevant prior art is most likely to be published in.

The Federal Service for Intellectual Property, Patents and Trademarks (Russian Federation), the Swedish Patent and Registration Office and the Nordic Patent Institute have been offering to perform PCT supplementary international searches since 1 January 2009. At least three more Authorities are expected to begin offering the service later in 2009 and in 2010.

The EPO will amend provisions to include reference to SIS Reports issued by the EPO and to provide a fee structure for issuing these reports. If the EPO carries out a SIS, a search fee will not need to be paid on entering the European regional phase as the EPO will not draw up an additional search report. The amended provisions come into force on 1 April 2010 and 1 July 2010, which suggests the EPO may offer this service soon.

UPDATED EPO OFFICIAL FEES

The Administrative Council of the EPO has also issued decisions regarding updated Official Fees (most of which appear to have increased by about 5%) and changes to reductions in the cost of a supplementary European search report carried out on a PCT application. The new official fees apply to all payments made on or after 1 April 2010. However, the new international search and international transmittal fees apply to international applications filed on or after 1 April 2010.

TESSA SEYMOUR



GENTLEMEN START YOUR ENGINES

PATENT PROSECUTION HIGHWAY TRIAL SEES 12 MONTH EXTENSION

The EPO and USPTO recently announced that the trial period for the Patent Prosecution Highway (PPH) programme has been extended by twelve months. The trial period will now end on 30 September 2010.

The PPH enables an applicant whose claims have been declared allowable by the USPTO to have a corresponding European application advanced out of turn for examination. Similarly, examination of a US application can be accelerated if a corresponding European application contains allowable claims.

For a European application to be eligible for participation in the PPH, the following four conditions must be met:

1. The European application must be a Paris Convention application validly claiming priority from one or more US applications.
2. The US application(s) must have at least one claim determined by the USPTO to be allowable.
3. All the claims in the European application must sufficiently correspond (or be amended to sufficiently correspond) to the allowable claims in the US application(s). Claims will be considered to sufficiently correspond where, accounting for differences due to claim format requirements, the claims are of the same or similar scope.
4. Examination of the European application must not have started.

Therefore, the PPH can be used to accelerate examination of a European application in the situation illustrated, right.

An applicant requesting PPH for a European application must submit paper copies of a request form, the allowable US claims, any Office Actions issued for the US application(s), the documents cited in the US Office Actions (except European patents or applications), and a table indicating the correspondence between the allowable US claims and the European claims.

If the request for PPH participation is accepted, then the European application will be processed in an accelerated manner under the EPO's PACE scheme. However, the EPO Examiner is under no obligation to reach the same conclusion as the USPTO.

The PPH scheme is not currently available for PCT(EP) regional phase applications, although PCT(US) national phase applications are eligible for PPH at the USPTO. However, a trilateral PCT PPH pilot scheme has recently been announced by the EPO, USPTO and JPO which will result in PCT(EP) regional phase applications becoming eligible for PPH. The trilateral PCT PPH is scheduled to begin on 29 January 2010.

Details of the PCT PPH pilot scheme will be available shortly at www.trilateral.net/index.html.

ROBBIE BERRYMAN

US Application

EP Application

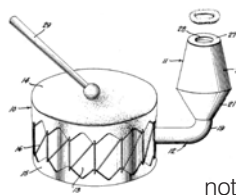
Indication of
at least one
allowable
claim

Request
PPH before
examination
begins

PATENTS FOR THE TWELVE DAYS OF CHRISTMAS?

ON THE FIRST DAY OF CHRISTMAS MY TRUE LOVE GAVE TO ME...

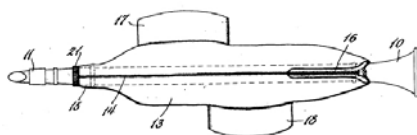
TWELVE DRUMMERS DRUMMING



Want to sing along with the carol singers, but can't remember the words? Fear not, enlist a band with

a set of "Smoke-Ring Signalling Drums" (US Patent 2788607, issued 1957) and the lyrics will be displayed in the form of smoke rings for your delight (assuming you are fluent in the language of 'smoke signal').

ELEVEN PIPERS PIPING



Continuing with the band theme, protect your instrument with this "Muff for Wind Instruments" (US Patent 2160229, issued 1939). Here a clarinet has been encased in a muff "preferably made of pelts or a piece of hide" and chilly hands are inserted into hand-holes to keep warm whilst playing the instrument. Handy!

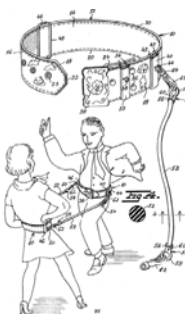
TEN LORDS A-LEAPING

Lords who have indulged in a few too many eggnogs may need leaping assistance. The rather stylish "Apparatus for Facilitating Walking, Running and Jumping" (US Patent 420179, issued 1890) will

"decrease the fatigue inherent to the act of walking, running or jumping...", and "enable the person...to more easily bend the legs...insuring perfect freedom of flexure and motion."



NINE LADIES DANCING



Forget your dancing shoes, what you really need is a "Dance Belt with Detachable Elastic Joining Members" (US Patent 3458188, issued 1969). Because not only does this belt look the part, it also has flashing lights and an

elongated elastic joining device so that wearers of the belts can dance as a team.

EIGHT MAIDS A-MILKING

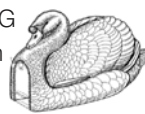


A common dilemma for any conscientious milkmaid: how do I lift two pails of milk and my stool to the next cow, all at the same time? This "Milking-Stool" (US Patent 359921,

issued 1887) can be buckled around the waist, leaving both hands free to carry pails. Lean forward to sit and the stool swings out directly underneath.

SEVEN SWANS A SWIMMING

Stuck for a gift to buy the person who has everything? One might safely assume they won't have one of these beauties. A "Swan Mailbox Cover" (US Patent 377706, issued 1997).



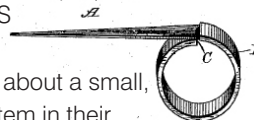
SIX GEESE A-LAYING

Parents wishing to teach their children the value of money might consider the merits of a piggy bank or perhaps open a savings account. We wouldn't recommend this "Toy Bank" (US Patent 68804, issued 1925), described as "a grotesque goose mounted upon a pedestal", for fear of nightmares.

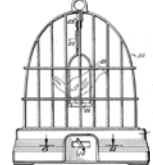


FIVE GOLD RINGS

Many women would get excited about a small, ring-box-shaped item in their Christmas stocking. Imagine the horror when the box is opened to reveal this "Combined Finger-Ring and Tooth-Pick" (US Patent 272985, issued 1883). "I love you, but you have food lodged in your teeth". Who says romance is dead?

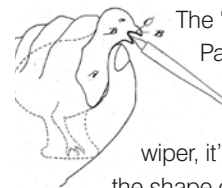


FOUR CALLING BIRDS



Pets are great: loving, loyal, tuneful (if it's a bird) – but what about the mess? Well, the answer is an "Animated Singing Bird Toy" (US Patent 2700247, issued 1955). This whistling, wind-up mechanical bird does everything a real bird would do (except fly... Oh, and repeat 'funny' catchphrases), but with no need to clean its cage or top up its food or water, this could be the perfect pet for pristine houses.

THREE FRENCH HENS



The "Pen Wiper" (US Patent 562371,

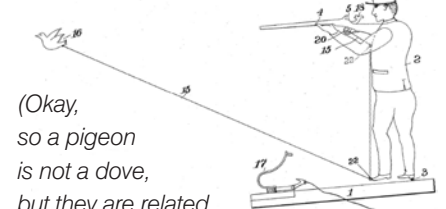
issued 1896) is no ordinary pen

wiper, it's a novelty one in the shape of a chicken. Quite

why the inventor chose to use a

chicken is a mystery, however the wiper is operated by "grasping the chicken with the hand and compressing the neck with the thumb and finger, when the mouth will open and the pen may be wiped on the absorbent material..." Sounds delightful!

TWO TURTLE DOVES



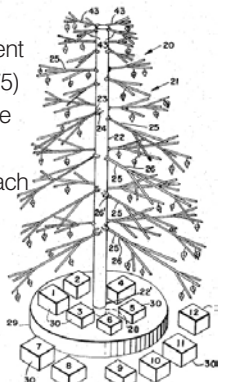
(Okay, so a pigeon is not a dove, but they are related

aren't they?) For the armchair indoor clay pigeon enthusiast comes this "Mechanical Toy" (US Patent 476895, issued 1892), "a figure holding a gun in position for shooting, a cord attached to a suitable firing mechanism and a toy pigeon secured to the free end of the cord, whereby when said object is thrown in the air said mechanism will be operated simultaneously with the dropping of said object substantially set forth". Not only that, but the marksman swivels, just like in real life!

AND A PARTRIDGE IN A PEAR TREE

This "Pear Tree Decoration" (US Patent 3867237, issued 1975) is actually quite a nice idea. During the 12 days of Christmas each package

at the foot of the tree is opened and the contents (miniature swans, pipers, etc, as in the song) are hung on the tree. The invention is "designed principally for the entertainment of young children," although perhaps nowadays children might be more entertained if the boxes contained an MP3 player or the latest Harry Potter book...



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OUT AND ABOUT

2010 INTERNATIONAL CONSUMER ELECTRONICS SHOW 7-10 JANUARY 2010

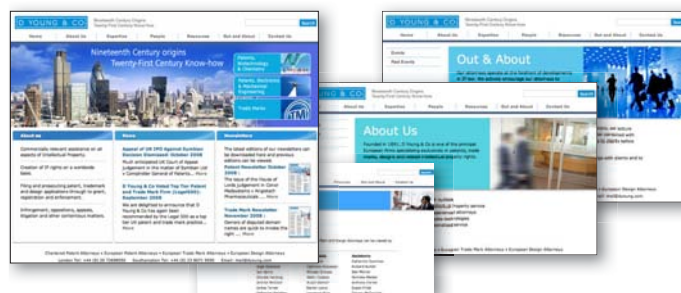
James Turner and Jonathan DeVile will be attending the Consumer Electronics Show in Las Vegas, Nevada, USA.

STEM CELLS 2010 15-16 FEBRUARY 2010

Charles Harding and Louise Holliday will be speaking at the Stem Cells 2010 conference in London. Charles and Louise will be discussing practical steps and strategies on obtaining patent protection for stem cells.

Managing Intellectual Property Global Awards 2009

D Young & Co has been awarded MIP UK Patent Prosecution Firm for 2009 and named MIP Top Tier Trade Mark Firm 2009. We have also been ranked as a top tier Patent and Trade Mark Firm by Legal 500 2009 and feature in the Expert Guides Leading UK IP Practitioners publication.



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