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PATENT

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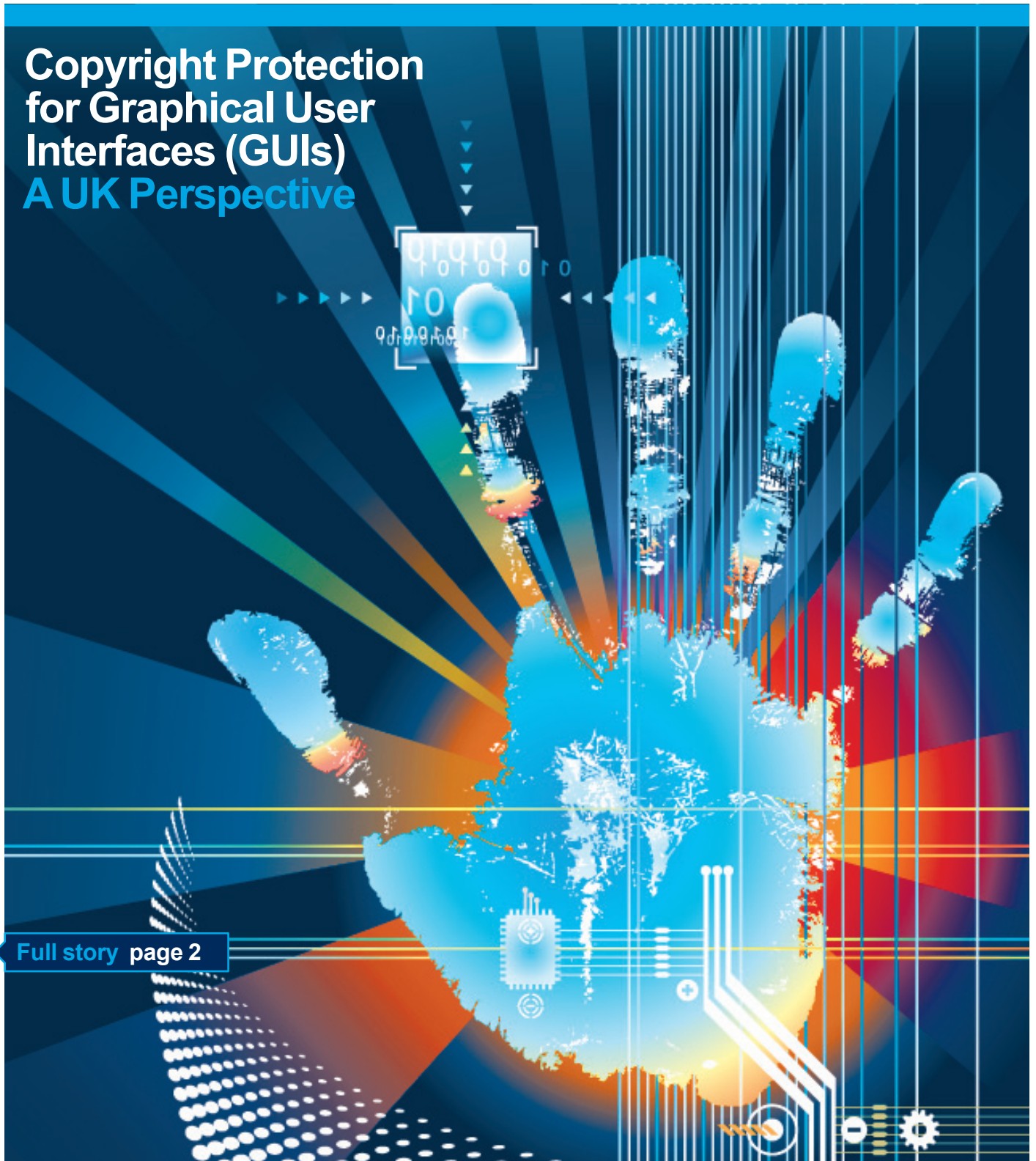
June 2011

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Copyright Protection for Graphical User Interfaces (GUIs) A UK Perspective

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Events

**13-17 June 2011****Patent Summer School, London**

Simon Davies and Kit Wong are leading this Management Forum patent litigation workshop.

15-16 June 2011**Chemspec Europe 2011, Geneva**

Connor McConchie and Garreth Duncan are exhibiting at Europe's only dedicated fine and speciality chemicals show.

27-30 June 2011**BIO International Convention, Washington**

Simon O'Brien is speaking at and Robert Dempster is attending this global biotech event.

For more events see page 7 of this newsletter or visit www.dyoung.com/events

Editorial



After another successful INTA annual meeting and US BIO International Convention imminent, the year is steadily marching on. Also in June we have attorneys speaking at US BIO, exhibiting at Chemspec Europe in Geneva and attending the China Intellectual Property Symposium in Shanghai.

In July we are holding a seminar giving practical patent advice for universities and SMEs in the chemistry and life sciences sector (see page 7 for more information). Registration is open and with spaces limited it is important to register as soon as possible. We are also commencing a series of biotechnology webinars to keep clients up-to-date with EPO biotech case law - registration is now open.

Professor Ian Hargreaves has completed his independent review of intellectual property and growth, commissioned by the UK Government. The published report is available at: www.ipo.gov.uk/ipreview.htm and provides a number of recommendations; for more information visit www.dyoung.com/article-hargreavesreview

Editor:

Aylsa Williams

Article 01

Copyright Protection for Graphical User Interfaces (GUIs)

A UK Perspective

Put simply, a GUI is the part of a software application that enables users to interact with the computer by means of graphical images rather than text. It is important to note that there are two fundamental aspects to GUIs:

1. Their functionality, ie, the way GUIs convert the user's commands into 'language' that the computer understands and, conversely, communicate outputs from the machine to the user; and
2. Their 'look and feel', ie, their appearance on screen and configuration.

The Court of Justice of the European Union (CJEU) has recently considered two key questions in relation to GUIs' copyright protectability in *Bezpečnostní softwarová asociace – Svaz softwarové ochrany v Ministerstvo kultury* (Case C-393/09):

1. Whether GUIs are an 'expression in any form of a computer program' within the meaning of article 1(2) of Directive 91/250 on the legal protection of computer programs and, therefore, attract copyright protection; and
2. Whether the television broadcasting of GUIs constitutes a communication of the work to the public within the meaning of article 3(1) of Directive 2001/29 on the harmonisation of certain aspects of copyright and related rights in the information society.

In relation to the first question, the CJEU concluded GUIs do not constitute a form of expression of a computer program and cannot be protected by copyright in computer programs by virtue of Directive 91/250. To reach this conclusion, the Court

first referred to article 10(1) of the Agreement on Trade-Related Aspects of Intellectual Property Rights (Annex 1C of the Agreement establishing the World Trade Organisation), which provides that computer programs, whether expressed in source code or in object code, are to be protected as literary works. It then observed that, consequently, source code and object code of a computer program are forms of expression of the same and are entitled to be protected under Directive 91/250.

Therefore, the object of the protection is the expression in any form of a computer program which permits reproduction in different computer languages, such as the source code and the object code. Conversely, GUIs do not enable the reproduction of a computer program, but simply enable communication between the user and the computer.

Although the CJEU had not been asked expressly by the referring national court, it went on to consider whether GUIs can be protected by the ordinary law of copyright under Directive 2001/29. The Court found that a GUI can be protected by copyright if it meets the relevant originality criterion, ie, if it is the author's own intellectual creation (*Infopaq International*, Case C-5/08), and it is for the national court to ascertain whether this is the case. However, the Court held that such originality requirement will not be met by all the components of a GUI, in particular those components whose expression is dictated solely by their technical function.

As far as the second question is concerned, the CJEU held that 'communication to the public' pursuant to Directive 2001/29 has to be interpreted broadly. However, such interpretation will not cover the broadcasting of a GUI because viewers

will receive a communication in a passive manner and will not have access to the essential characteristic of an interface, ie, its interaction with the user.

From a UK perspective, the most surprising aspect of the decision is the Court's finding at para. [46], whereby a GUI "can, **as a work** (*emphasis added*), be protected by copyright if it is its author's own intellectual creation". This statement is problematic for the following reasons:

1. Copyright law is not harmonised at EU level in respect of its protectable subject matter (other than for databases and computer programs). It is for national legislators to determine which creations are 'works' and then it is for the courts to ascertain if such works meet the originality test (also not harmonised at EU level other than for databases, computer programs and photographs);
2. Nonetheless, the Court rendered its decision on the assumption that a GUI is part of the relevant subject matter 'as a work' itself, thereby extending the definition of work to include GUIs; and
3. The Court seems to be saying that it is not the GUI's 'look and feel' that the Court considers protectable by ordinary copyright law, but its 'essential element' (or function) itself, ie, the interaction between the user and the computer program.

This is at odds with UK copyright law's taxonomic approach to defining its subject matter. Section 1(1) of the Copyright, Designs and Patents Act 1988 features an exhaustive list of species or types of protectable works: original literary, dramatic, musical and artistic works; sound recordings; films; broadcasts, and

Graphical user interfaces (GUIs) enable users to interact with the computer by means of graphical images rather than text.



typographical arrangements of published editions. When determining whether a creation is a copyright work, the first issue a court needs to determine is whether the creation in question comes under one of the statutory descriptions of work (Jacob LJ refers to them as separate 'boxes' in *Sawkins v Hyperion Records Ltd* [2005] EWCA Civ 565).

Therefore, a UK court would need to consider whether a GUI (either as a whole or its components) might be regarded as any of the works described in section 1(1). It is likely that the GUI's on screen appearance would fall in the artistic work 'box', but the GUI's functionality *per se* may

not find an appropriate box and, therefore, fall at the first hurdle.

However, as a result of decision C-393/09, some interesting questions arise. For example, are UK courts now bound to recognise GUIs (in particular their functionality) as a new bona fide species of protectable works, providing that they satisfy the originality criterion? Does the CJEU's decision have the effect of harmonising EU copyright law through the back door? We will wait for further developments in this interesting field.

Author:
Cam Gatta



Make Your Selection EPO Shifts Criteria for Selection Inventions

➤ Useful links
Full text of decisions:
T230/07:
<http://bit.ly/t23007>
T198/84:
<http://bit.ly/t019884>
T279/89:
<http://bit.ly/t27989>

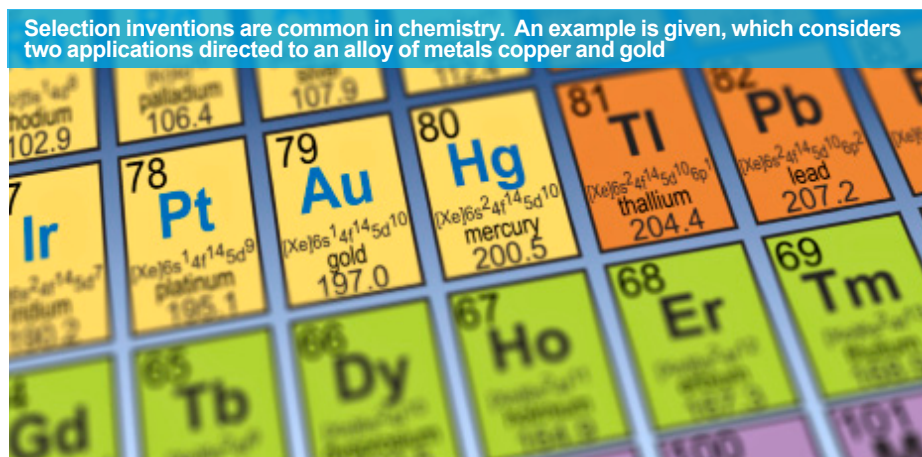
A recent EPO Board of Appeal decision has challenged the long-established case law on selection inventions and could potentially change EPO practice in the chemical field, making it easier for applicants to obtain future selection patents.

A selection invention falls within the broadest scope of an earlier-published patent application, but is not specifically disclosed or exemplified in that earlier application. Selection inventions are particularly common in chemistry, where early research may identify a broad class of chemical compounds or a broadly-claimed chemical formulation and later research identifies a particularly useful, but more narrowly defined, class or formulation falling within the earlier broad scope.

For an example of a selection invention, consider two patent applications directed to an alloy (mixture) of the metals copper and gold:

- a.** Earlier-filed patent application A discloses and claims in its broadest scope an alloy consisting of 1-20% copper and 80-99% gold. This application discloses two specific examples: one having 2% copper and 98% gold; the other having 4% copper and 96% gold.
- b.** Later research results in patent application B, disclosing and claiming an alloy consisting of 15-18% copper and 82-85% gold.

When the earlier application defines an invention in terms of a numerical range and



the later application claims a sub-range falling within this broader range, EPO Boards of Appeal have established three criteria for deciding whether the later invention is novel over the earlier one. These criteria are set out in Decisions T198/84 and T279/89, and specify that the selected sub-range must be:

- 1.** Narrow;
- 2.** Sufficiently far removed from the examples of the broader range;
- 3.** Not an arbitrary choice from the earlier range, but must be another invention ('purposive selection'). In order to do so, the selected sub-range must generally confer a technical effect or advantage over the earlier range.

In the example above, the claims of patent application B are both narrow and distant from the examples of patent application A, and would therefore fulfil criteria 1 and 2.

Criterion 3 has often been criticised by some European patent attorneys, as it introduces

into the assessment of novelty a criterion which is usually only relevant for assessing inventive step. In decision T230/07, the Board agreed: they considered that the requirement for a technical effect within the sub-range should solely be considered for the purposes of inventive step, and should not be taken into account when assessing novelty.

This decision may not affect the assessment of some selection inventions, as a technical effect over the earlier disclosure will still be required to demonstrate an inventive step. However, it could be of critical importance when the earlier application is a prior-filed European application which is not published until after the filing date of the European application being examined. Under Article 54(3) EPC, such applications form prior art for novelty only and cannot be considered for inventive step. If the decision in this case is followed by EPO examiners, it may not be necessary for the later application to show any technical effect or advantage over the earlier application.

As the new decision seemingly conflicts with the established case law, the President of the EPO has the power to refer the matter to the Enlarged Board of Appeal in order to clarify the law. We will keep you updated on developments in this field: for more information, please contact your usual D Young & Co adviser.

Author:
Garreth Duncan



Chewing Gum and Coffee: What is the Difference?

The Importance of Prior Art and Design Freedom for Registered Community Designs

Registered Community Designs (RCDs) are a relatively cheap, very quick and effective way of protecting a wide range of designs. In the last couple of years, the number of RCDs has increased significantly as more companies appreciate the legal and commercial benefits of having a registration. Unlike trade marks or patents, there is effectively no examination process.

A consequence of this is that there are an increasing number of invalidity attacks, usually taken by competitors. Given that RCDs essentially protect visual elements, the scope for detailed legal argument is limited as OHIM (and any appeal bodies) will use their own eyes to determine the issues.

However, there are areas where it is important to make sure the case is presented properly, particularly when it comes to producing evidence as to the previous 'design corpus' (ie, prior art) and as to the degree of 'design freedom'. Procuring the dates of prior art is not always an easy task as much of it will be non-registered rights, such as photographs from retail shops, magazines, internet evidence, etc.

In *Cadbury v Wrigley* (ICD 000006799), the Invalidity Division refused to consider a number of prior art designs as either the photographs were not dated, or they were inadequately dated. In the event, these deficiencies may not have had an effect on the final decision, (as the invalidity application was rejected), but it is a salutary lesson that OHIM take a strict approach when it comes to evidence. If necessary, independent evidence of dates may be needed. This decision also highlights the view OHIM is currently taking, that even quite small differences may be sufficient to persuade them that an RCD is valid. There are two main grounds on which invalidity are usually sought:

1. lack of 'novelty'; and
2. lack of 'individual character'.

The former is hard to succeed on, unless it can be proved that the **actual** or an identical product, subject of the RCD, was publicly available at least 12 months before the application date of the RCD.

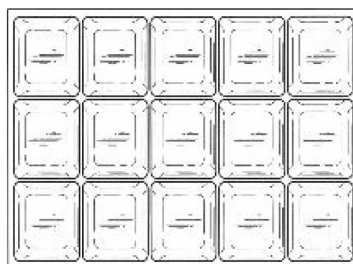
Most cases are decided on 'lack of individual character', where the test is whether the RCD produces the 'same overall impression' on the 'informed user' as the prior art.

An informed user is someone with a real knowledge of and interest in the market for the sort of products the RCD is protecting, although (in practice) it is very rare to put in evidence about this and the Invalidity Division will use its own perceptions.

A key issue in assessing individual character is the degree of freedom of the designer for the design in issue. Thus, teapots have to have handles and spouts and shoes need soles, so these elements of a design should be discounted.

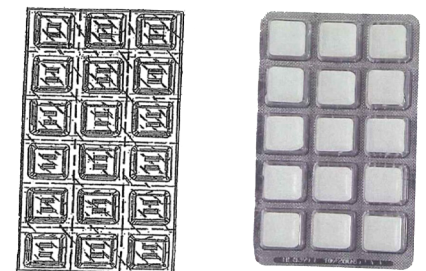
This issue of design freedom has also been extended to cases where the designs have to fulfil certain criteria (eg, the shape of packaging is determined by the products they are to contain, or the receptacle in which they are to be placed), with the result that the prior art necessarily has a limited range of similar designs capable of fulfilling such criteria. In such circumstances even quite small differences may be sufficient to give the RCD individual character.

In *Cadbury v Wrigley*, the RCD (shown below)



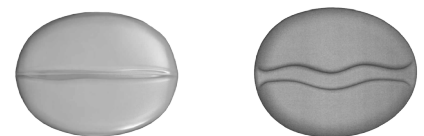
was found valid over the prior art (see above right) as the design was considered to be more compact and streamlined with tighter spacing between the walls of the blister pack than the prior art. Despite the great similarities, these

were largely discounted on the basis that the design freedom was limited by the chewing gum or pills these packs had to contain.



Somewhat in contrast, in *Sara Lee v Essey* (ICD 7148) the RCD was held invalid. In this case the designs were for 'coffee dosers' (which go into coffee machines and so their shape is constrained by the particular machine in question, although there are a variety of different machines which will have different constraints). It seems that coffee dosers do, as a consequence, come in a variety of shapes and sizes depending on the machine they fit into.

In this case, the RCD (below left) was held invalid as the prior art (below right), despite its visual differences, was held to be sufficiently similar to create the same overall impression.



This seems slightly surprising and in contrast to the *Wrigley* decision, given that the similarities (ie, size and shape) were presumably largely dictated by the machine they were used with (which, by analogy, was the reason why the *Wrigley* RCD was held valid).

What these cases show is that it is often a fine line between success and failure and that, even though the eventual decision will be largely based on a visual comparison, it is important to set the scene by explaining the degree of freedom of the designer taking into account the use and purpose of the products in the market to which the design relates.

Author:
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Dealing with Patentable Subject Matter Exclusions

Patentability of Methods Based on Mathematical Methods

Even though exclusions to patentability can still be a controversial subject, the European Patent Office (EPO) has in recent years shown consistency in this domain. It has recently confirmed in one of its decisions, T 1326/06, how patentable subject matter exclusions should be dealt with, based on **technical character** and **technical contribution** considerations.

The current approach at the EPO, when dealing with excluded subject matter as defined in Article 52(2) of the European Patent Convention (EPC), is to assess the technical character and technical contribution of an invention in a two step approach:

Step 1: To avoid non-patentable subject matter exclusions, an invention has to have technical character. For example, a scientific theory (eg, the electromagnetic induction theory) is considered to lack technical character while a specific application of a scientific theory (eg, an electromagnet) may have **technical character** and be patentable.

Step 2: When assessing inventive step, only technical features can contribute to an inventive step. For example, if the features giving an invention its technical character are already known from the state of the art, the invention does not provide a **technical contribution** over the state of the art.

In brief, an invention has to have technical character and to provide a technical contribution to be patentable.

The decision T 1326/06 concerns an appeal from a decision of the Examining Division based in particular on the grounds that the claims related to a mathematical method as such (excluded under Article 52(2) EPC) and therefore lacked technical character.

Claim 1 under appeal was directed to a method to be used when encrypting or signing data using the RSA (Rivest, Shamir and Adleman) algorithm. RSA is an asymmetric encryption/decryption algorithm using a pair of numbers

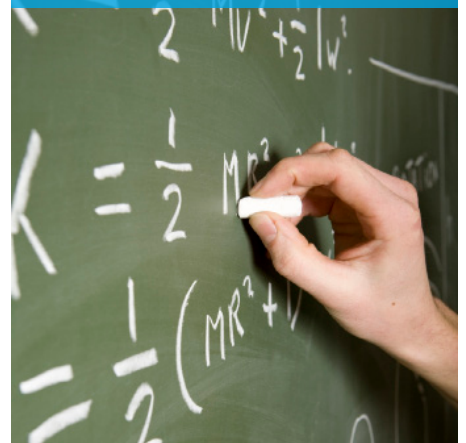
called 'keys' to encrypt and decrypt data. One of the keys is a public key and the other one is a private key, kept secret.

In the appeal decision in question, the method steps of claim 1 under appeal were directed to steps for the generation of the pair of RSA keys. Those steps included complex calculations on large integers and the claimed invention provided a simplification of those calculations by introducing intermediate steps on smaller numbers. The claim's preamble referred to the use of the method in an RSA encrypting or signing method, while all of the method steps were mathematical steps. As a result, claim 1 was essentially based on a mathematical method.

The Board of Appeal took a different approach from the Examining Division and has provided in decision T 1326/06 interesting comments on the patentability of methods essentially based on mathematical methods. The Board of Appeal started with broad considerations regarding RSA encryption/decryption methods. It identified in particular that, even though RSA "appears, to a great extent, to be a pure mathematical method", asymmetric cryptography ensures a secure transmission of electronic data. The Board concluded that RSA, "by providing a secure transmission of electronic data, provides a technical effect" and that "achieving that effect has to be considered as being a technical problem". In other words, even though an RSA method is essentially based on a mathematical method, it is not automatically excluded from patentability, because such a method solves a technical problem and therefore has a technical effect and technical character.

A particularly interesting aspect of this analysis from the Board of Appeal regards the interpretation of 'it' in the question 'is it technical?' asked when determining whether a claim has technical character. In effect, the Board of Appeal clarified that 'it' should refer to the problem solved by the claims, ie, to the effect of the claimed invention (secure data transmission), not to the specific features defined in the claim (mathematical steps). Expressed differently, what is important is the **technical effect** achieved by the claim, not the means to achieve this technical effect.

T 1326/06 concerns the patentability of methods based on mathematical methods



Turning to claim 1 under appeal and applying this 'technical effect' assessment, the Board of Appeal found that the claim had technical character and was therefore not excluded from patentability. As a result, the Board of Appeal remitted the application to the Examining Division to be searched and examined such that the technical contribution could be assessed.

To summarise the key aspects of this decision:

1. The technical character and technical contribution approach when dealing with excluded subject matter is still very much the EPO preferred approach;
2. When assessing the technical character of a claimed invention, it should be assessed whether the invention has a technical effect, regardless of the specific features of the claims for achieving that effect;
3. Methods essentially based on mathematical methods can be patentable, provided they have technical character and provide a technical contribution.

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Seminars and Webinars

Patent Advice and Updates

Summer 2011

Useful links

- m.dyoung.com
- www.dyoung.com/events-sme2011
- www.dyoung.com/events-webinar0711

We are committed to providing regular and reliable intellectual property news and updates to our clients and colleagues in a convenient format. We have extended the reach of our online knowledge bank to enable users to search and view IP information when out and about, in a 'phone-friendly' format and are therefore pleased to announce the launch of our smart phone optimised website at:



m.dyoung.com

Visitors to www.dyoung.com using smart phones should automatically be redirected to our smart phone friendly site, which can

be found directly at m.dyoung.com or reached via the QR code (left).

Furthermore, we are also delighted to announce the first in a series of summer patent seminars, intended to provide practical

patent related advice and updates in an easily digestible manner.

Information about our involvement in IP related events can be found on our website:

www.dyoung.com/events

Get a Little Extra (Patent) Protection This Summer

12 July 2011: patent seminar giving practical advice to universities and SMEs



Join us at our centrally located London office for an informal seminar and drinks reception hosted by our Biotechnology, Chemistry & Pharmaceuticals Group.

What's it about?

The seminar will comprise a series of presentations with Q&A sessions offering practical advice on a range of topics relevant to universities and SMEs, including:

- Patent filing strategies
- Recent EPO case law
- Freedom to operate
- Patent due diligence
- Patent litigation and alternative dispute resolution

Who should attend?

Business development, technology transfer and R&D professionals working in the chemistry and life sciences sector, particularly those based at universities, related spin-out companies, and SMEs.

Further information

Please email Rachel Daniels, D Young & Co Business Development Manager: rjd@dyoung.co.uk

Registrations

To register your interest and secure your place at this seminar, please email registrations@dyoung.co.uk.

Date: Tuesday 12 July 2011

Time: 1pm to 6pm (drinks at 6pm).

Location: D Young & Co LLP, 120 Holborn, London, EC1N 2DY.

Cost: £65 (+ VAT) per delegate, to be invoiced on registration.

www.dyoung.com/events-sme2011

Biotech Case Law Webinar

19 July 2011: first in a series of webinars focusing on essential IP updates



Don't miss this opportunity to catch up on significant recent European Patent Office (EPO) case law in this 30 minute round up.

Simon O'Brien and Robert Dempster of the D Young & Co Biotechnology, Chemistry & Pharmaceuticals Group, will provide this essential update, which will include presentations and live Q&A.

To register your interest please email registrations@dyoung.co.uk.

Date: 19 July 2011

Times: 12 noon UK time (13:00 CET) & 5pm UK time (09:00 PST, 12 noon EDT).

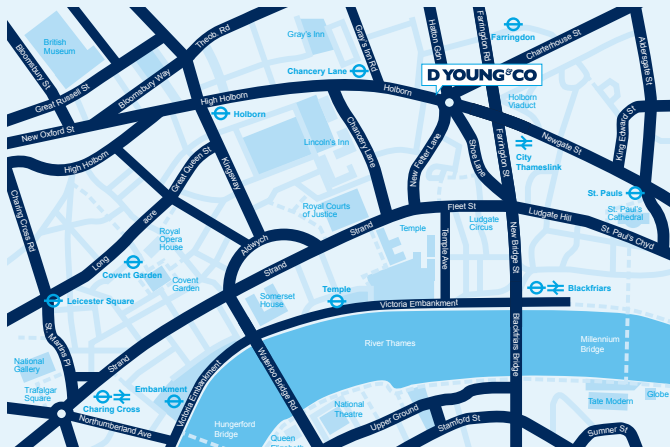
www.dyoung.com/events-webinar0711

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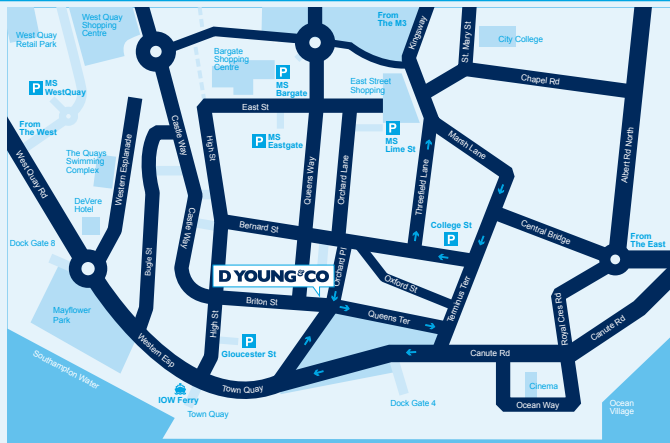
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