D YOUNG & CO

PATENT NEWSLETTER

October 2009

OUT OF REACH

EPO REJECTS "REACH-THROUGH" CLAIMS

In an important recent decision (T1063/06), an EPO Board of Appeal rejected a Bayer patent application directed to use of compounds defined by their biological activity. The decision is the first time a Board has explicitly rejected "reach-through" claims and affirms existing EPO practice in this area.

"Reach-through" claims are directed to future inventions which are based on the invention disclosed in a patent application. They are often present in patent applications directed to biological targets, such as receptors, and biological assays for screening whether a particular compound is active against that target. Such applications are usually filed in the early stages of a pharmaceutical research programme, when the target has been identified but compounds active against it have not. Typically, "reach-through" claims are directed to compounds active against the target as identified by a specified assay, or the use of such compounds to treat a disease to which the target is related. The active compounds themselves are not identified *per se* but are defined in relation to the specified assay/target.

The filing of "reach-through" claims in the biotechnology area has been the subject of controversy for some time. In 2001, the EPO, USPTO and JPO conducted a trilateral comparative study on their practices as regards these types of claim. All three Offices concluded that, regardless of whether the specific function (eg the relationship to a specific disease) of a receptor protein is disclosed, claims to active compounds in general identified by a screening assay, and claims to uses of such active compounds in general to treat the specified disease, did not meet the Offices' requirements regarding enablement and/or support: they concluded it would be an undue burden on the skilled person to randomly screen undefined compounds for the claimed activity. Claims to the

CONTINUED ON PAGE 2

D YOUNG & CO VOTED TOP TIER IP FIRM 2009

We are delighted to report that we have again been recommended by the Legal 500 as a top tier UK patent and trade mark practice. We would like to thank our clients and associates for their support and contributions to this year's Legal 500 review.

CONTINUED ON PAGE 2

CONTENTS

OUT OF REACH
EPO REJECTS "REACH-THROUGH" CLAIMS
CONTINUED FROM COVER PAGE

active compounds were only acceptable if the compounds were defined by their structure.

The main claim of the Bayer case related to the use of compounds capable of stimulating soluble guanylate cyclase independently of the heme group in the enzyme for the treatment of cardiovascular disorders such as angina pectoris, ischaemias and cardiac insufficiency. Although the application also disclosed and claimed structurally defined classes of compounds, the patentability of those specific classes of compounds was not at issue in this case.

The Examining Division refused the application on the grounds of lack of sufficient disclosure (Article 83 EPC), on the basis the skilled person, without any direction from the patent application, would have to select and test compounds for the claimed activity. Such testing was considered an unreasonable effort for the skilled person in carrying out the subject-matter of the claim across its entire width.

In their appeal, Bayer argued that the broad scope claimed was justified by the patent application's contribution to the art. Bayer further referred to Decision T68/85, which permits a claim to be defined by the result to be achieved in certain circumstances (where there is no other way to claim the invention without unduly restricting its scope and the description contains instructions which are sufficiently clear to reduce the invention to practice without undue burden), and argued that restriction of the claim to structurally defined compounds would be an unreasonable limitation on their invention. The Board rejected the appeal, pointing out that a patent applicant is only granted protection for his actual contribution to the art. In this application, the claim covered compounds which were not yet structurally determined at the priority date, but could only be found in the future using the specified assay procedure. The Board further ruled that, even though the application provided sufficient information to enable the assay procedure to be carried out, this alone was not sufficient to carry out the entire subject-matter of the claim: as the claim covered all chemical compounds having the desired activity, the skilled person would have to test any conceivable chemical compound for the specified activity.

This Decision indicates for the first time the Board of Appeal's endorsement of existing EPO practice as set out in the 2001 trilateral study. It will consequently become much more difficult in the future to obtain allowance by the EPO of chemical compound claims defined in terms of a biological activity or uses of such compounds, even when specific uses are claimed.

GARRETH DUNCAN

OUT AND ABOUT

MANAGEMENT FORUM SEMINAR : "FREEDOM TO OPERATE - A PRACTICAL GUIDE"
Anthony Albutt (speaker), 23 October 2009, Rembrandt Hotel, London.

SEOUL INTELLECTUAL PROPERTY INTERNATIONAL CONFERENCE
Jonathan Jackson (attending), 13-15 November 2009, Westin Chosun, Seoul, Korea.

ASIAN PATENT ATTORNEYS ASSOCIATION (APAA) MEETING
Jonathan Jackson (attending), 18-22 November 2009, Hong Kong.

D YOUNG & CO VOTED TOP TIER IP FIRM 2009
CONTINUED FROM COVER PAGE

The Legal 500 provides an annual assessment of UK law firms and advisors in order to provide independent advice to clients seeking the best firm for their work.

In arriving at their recommendation of D Young & Co the Legal 500 considered a number of criteria, including: most prestigious clients; in-depth capability; strength of technical ability available for the most complex work; capacity for substantial transactions/ cases; market share; track record on top deals/cases; capacity to handle all client requirements; commitment to IT and the use of IT to improve client services and perception in the market.

"Understanding the firms is only one aspect of the research process." says David Kelly, editor of The Legal 500, "Ultimately, it is the clients' opinions that matter; the 45,000 or so references taken up this year are a vital component of our evaluation of the various legal markets covered in this guide." (source Editorial, The Legal 500 2009 Edition).

D Young & Co's Legal 500 entry can be viewed via the Legal 500 website: www.legal500.com/firms/91824-d-young-co/offices/91824-southampton

EPO ADMITS ONLY ONE
DOUBLE PATENTING AT THE EUROPEAN PATENT OFFICE

In a recently published case T0307/03, a Technical Board of Appeal of the European Patent Office (EPO) issued a decision refusing a divisional application for attempted double patenting. In reaching their decision, the Board radically interpreted a well established Article of the European Patent Convention and appear to have contradicted previously issued decisions.

The phrase "double patenting" refers to the concept that two patents having the same effective filing date should not be granted to the same applicant for the same invention. Some of the Contracting States to the EPC do not permit double patenting. For example, the Comptroller of the UK Intellectual Property Office will revoke a UK patent if a European (UK) application for the same invention having the same priority date and filed by the same applicant proceeds to grant. However, the European Patent Convention contains no explicit prohibition of double patenting.

Two questions therefore arise in the European context: firstly does the EPC actually prohibit double patenting and secondly and perhaps of more practical interest, if so, what is meant by "the same invention".

The Guidelines for Examination of European Patents (C-IV 7.4 and C-VI 9.1.6) state (without any evident legal basis) that Examiners should not allow double patenting and that divisional applications must be directed to subject matter "clearly distinguishable" from the parent application. That said, until recently the EPO appeared happy to permit a parent and divisional application in which the subject matter of the broad claims of one encompassed the subject matter of the narrow claims of the other.

In particular in T0587/98 the Technical Boards of Appeal reversed a decision of the Examining Division to refuse a divisional application on the ground of double patenting. In this case the Examining Division had argued that as the claim of the divisional, directed to feature A (a substrate), implicitly included feature A with feature B (the substrate plus a dielectric layer) as explicitly claimed in the parent, the subject matter of both applications overlapped and therefore both applications were directed to the same invention.

The Appeal Board disagreed and stated that:

"There is no express or implicit provision in the EPC which prohibits the presence in a divisional application of an independent claim… which is related to an independent claim in the parent application in such a way that the 'parent' claim includes all the features of the 'divisional' claim combined with an additional feature."

In other words, it was concluded that the EPC does not prohibit a divisional application with claims that are broader, due to the absence of a feature, than the claims of the parent application. Moreover, the Board quite correctly pointed out that situations of this kind exist frequently when there is art for the purposes of novelty only (Art 54(3) EPC), so there was no apparent reason why it should be seen as giving rise to "double patenting". Thus, the Board applied a narrow interpretation to what is deemed double patenting.

The recently published decision of a Technical Board of Appeal of the EPO in T0307/03 is worthy of note as it appears flatly to contradict T0587/98.

T0307/03 concerned a divisional application which was originally rejected as lacking novelty. The parent application was granted but then revoked in opposition. That revocation has been appealed and is pending under T0334/07. In T0307/03, the Main Request and First Auxiliary Request were considered to cover identical subject matter to the parent patent and were refused for double patenting. The subject matter of claim 1 of the Second Auxiliary Request differed from claim 3 of the parent patent only insofar as it was directed to a catalyst which comprised "a water-soluble alcohol" rather than "a water soluble aliphatic alcohol". The Board asserted that this claim being sought would be "re-patenting the subject matter of claim 3 of the parent application as granted, and seeking protection for additional subject-matter, namely where the water-soluble alcohol is not aliphatic". The Board further stated that "it cannot regard the extent of double patenting here as something that can be ignored as *de minimis*, given that the subject matter which would be double patented would be the preferred way of carrying out the invention". The Second Auxiliary Request was refused with the Board concluding that double patenting "can be raised where subject matter of the granted claim is encompassed by the subject matter of the claim later put forward."

Thus, the Board in T0307/03 has made it clear that it considers claims in divisional applications of overlapping scope to those in the parent application to constitute double patenting.

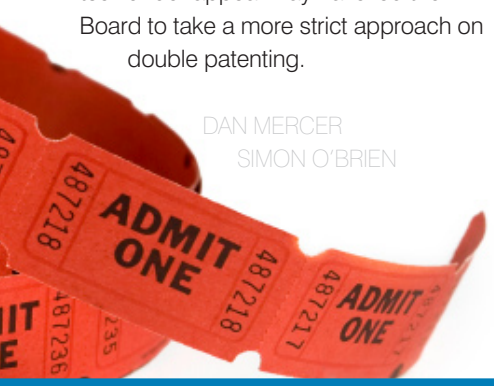
In justifying its decision, the Board cites Article 60 EPC which states "…the right to a European patent shall belong to the inventor or his successor in title". From this, the Board deduced that the inventor (or his successor in title) has a right to the grant of one and only one patent from the EPO for a particular invention as defined in a particular claim. Once a patent has been granted to the inventor (or his successor in title) this right to a patent

has been exhausted. Not surprisingly, this leap of interpretation has caused considerable consternation.

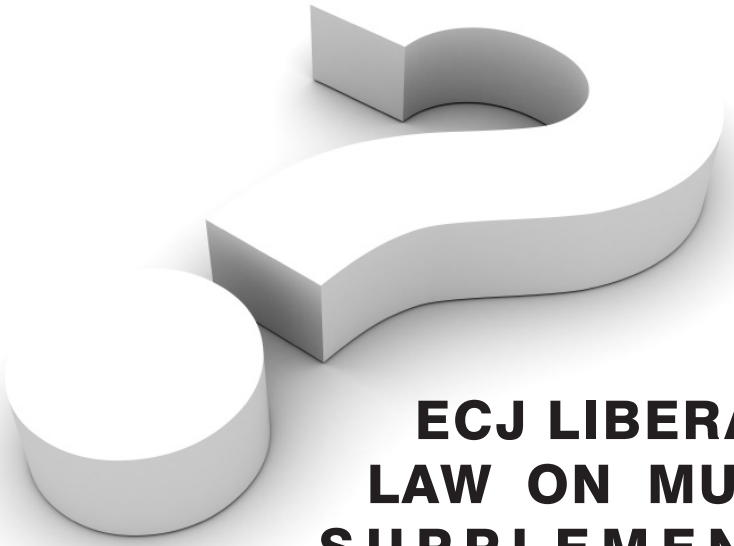
The Board stated that to avoid the objection of double patenting the claimed subject matter would have to be confined to subject matter not already granted on the parent application. Given the EPO's strict approach to added matter, this will prove difficult in the majority of cases. Perhaps a sensible approach would be for the EPO to allow the use of disclaimers wherein the overlapping subject matter is disclaimed from the divisional application. However, the Enlarged Board of Appeal Decisions G1/03 and G2/03 which define the situations when disclaimers can be used make no reference to their use to obviate double patenting.

CONCLUSION

It remains to be seen if the findings of T0307/03 will be followed in later decisions. However, in this particular case, it must be borne in mind that the subject matter that constituted double patenting (i.e., the subject matter claimed in the divisional application that overlapped with the subject matter claimed in the parent patent) was the preferred way of carrying out the invention. This was likely to have been a persuasive factor in the Board's decision. One may tentatively conclude from this that a divisional application with claims overlapping in scope with those of the parent patent may be less likely to face a double patenting objection if the additional non-overlapping subject matter sought in the claims constitutes a preferred way of carrying out the invention. Moreover, the fact that the parent patent had been revoked in opposition and was currently itself under appeal may have led the Board to take a more strict approach on double patenting.



DAN MERCER
SIMON O'BRIEN



ECJ LIBERALISES LAW ON MULTIPLE SUPPLEMENTARY PROTECTION CERTIFICATES

5 QUESTIONS REFERRED TO THE EUROPEAN COURT OF JUSTICE

The European Court of Justice has just issued its decision on the AHP Manufacturing v BIE case, on which the Dutch IP Office (BIE) referred a number of questions regarding the granting of multiple Supplementary Protection Certificates (SPCs) for the same product. The five questions referred are summarised below:

1. Does the EC Regulation regarding SPCs for medicinal products preclude the grant of an SPC to the holder of a basic patent for a product for which, at the time of the submission of the SPC application, one or more SPCs have already been granted to one or more holders of one or more other basic patents?

2. Does the EC Regulation regarding SPCs for plant protection products give rise to a different answer to Question 1?

3. When answering the previous questions, is it relevant whether the last SPC application submitted, like the previous application or applications, is submitted within the 6-month period from marketing authorisation or from grant of the basic patent (whichever is later)?

4. When answering the previous questions, is it relevant whether the period of protection afforded by the grant of the later SPC expires at the same time as, or at a later time than, that of one or more SPCs already granted for the product?

5. When answering the previous questions, is it relevant that the EC SPC Regulation does not specify the period within which the national Patent Office must process the application for and ultimately grant an SPC, as a result of which a difference in the speed at which the national Patent Offices process SPC applications may lead to differences between them as to the possibility of an SPC being granted?

In the judgement, the ECJ answered "no" to all five questions. This decision therefore extends the provisions of the Biogen case (which allowed the grant of multiple SPCs to different basic patent holders whose SPC applications were co-pending) to those where the first SPC application has already been granted. Obtaining multiple SPCs for the same product in Europe may therefore become easier in the future.

GARRETH DUNCAN

EPO FORMS CLOSER TIES WITH IEEE AND OTHER STANDARDS BODIES

In July, the EPO announced that it had signed a memorandum of understanding (MoU) with the IEEE Standards Association to share knowledge, documentation and understanding on the development of technology and standards. Although this is a seemingly innocuous development, it is worth reflecting on why an organization whose sole function is to grant patents should form closer ties with a standards setting body.

Patent practitioners working in the field of telecommunications and consumer electronics will be aware of the importance of patents for inventions which are incorporated into technical standards. An important development in modern electronics and telecommunications is that, in order to achieve interoperability, compatibility and economies of scale, manufacturers of equipment collaborate to form an agreed standard at least in the interfaces between items of equipment forming a system. For example, in the field of public broadcast television the analogue television standards PAL and NTSC were developed, followed by the digital standards MPEG and DVB. In the field of mobile telecommunications, one can see that, given that there is one radio frequency spectrum, which is allocated by national authorities, there is a requirement for a common radio access interface as well as a back bone network. If the mobile radio system is to be deployed across national boundaries, then there is an added political dimension to the requirement for a common technical standard. This was indeed the situation which led to the establishment of the GSM standard as administered by the European Telecommunications Standards Institute.

To develop a common standard requires that companies, which are normally competing, collaborate to pool technical research and to agree the operation of a system. However, competition is preserved through the patents system. Thus companies which contribute to the development of a new standard file patent applications before any technical disclosures are made, with the aim of obtaining patents for inventions relating to that technical disclosure. If the technical disclosure then becomes incorporated into the standard then any party implementing a system which operates in accordance with that standard will infringe the patent. Such patents are known as "essential" patents for a given standard. Essential patents are therefore extremely valuable, but since standards are developed so that all manufacturers must use the invention; essential patents can give rise to allegations of anti-competitive practices if the monopoly provided by the patent is abused.

Perhaps a clue to the reason for this development at the EPO is the paragraph which states that "Closer involvement with standards organisations is supporting EPO's efforts to make sure that the patent system contributes to the promotion of innovation and a healthy, competitive environment for business".

One reason for the EPO becoming a member of a standards setting body is to ensure that anything which is disclosed to a working group in either written or oral form becomes part of the state of the art and can therefore be cited against any subsequently filed patent applications. Typically, any paper submitted to a working group is not usually accessible by any party other than a member of that working group. So let's say someone floats an idea, in a paper submission, which is not adopted and so does not form part of the standard when established and then published. That paper may not necessarily be accessable or more importantly searchable. It may not necessarily ever be used as a prior art citation unless it is published in some other way. Furthermore, if the EPO is a member of the working group then it may be possible in some circumstances to more easily prove the date of submission of a document to the working group and therefore when that document was published in the legal sense. So allowing the EPO to become a member of a standards body may establish more accurately the true state of the art and therefore prevent a party establishing a monopoly right in something which was already known or an obvious extension of what was already known by parties inside or outside the working group. On the other hand, this makes it even more essential that a patent application is filed before a submission is made to a standards body in either oral or written form.

Is the information flow just one way? How can a standards setting body benefit from knowing of what patents have been applied for by others? This appears to be more difficult. Knowing of a patent application is one thing, determining its validity and its scope of protection is what is ultimately crucial and that can, in the end, only be determined by a national court. The MoU refers to "whether the Office [EPO] can participate in beta testing of [the IEEE's] document management system", but this appears to be simply a way of accessing the disclosures to the standards setting body.

Perhaps another reason for this development might be that the European Commission or the EU has informally discussed the standardisation issue with the EPO.

It appears that other MoUs will be signed with the International Telecommunication Union (ITU) and European Telecommunications Standards Institute (ETSI).

JONATHAN DEVILE

D YOUNG & CO PATENT GROUP

PARTNERS	ASSOCIATES	ASSISTANTS
Nigel Robinson	Paul Price	Catherine Coombes
Ian Harris	Cathrine McGowan	Dan Mercer
Charles Harding	Michael Simcox	Susan Fridd
James Turner	Susan Keston	Carola Lempke
Catherine Mallalieu	Darren Lewis	Zoë Birtle
David Horner	Lawrence King	Nicola Elliott
Neil Nachshen	Simon O'Brien	Tessa Seymour
Miles Haines	Garreth Duncan	Benjamin Husband
Jonathan DeVile	Gareth Scaddan	Robbie Berryman
David Alcock	Stephanie Wroe	
Aylsa Williams	Doug Ealey	
Simon Davies	Stephen Blance	
Zöe Clyde-Watson	Stuart Lumsden	
Kirk Gallagher	Nicholas Malden	
Louise Holliday	Anthony Carlick	
David Meldrum	Connor McConchie	
Jo Bradley		
Julia Mills		
Kit Wong		
Jonathan Jackson		
Robert Dempster		
Tim Russell		
Anthony Albutt		

CONTRIBUTORS THIS ISSUE

EDITOR: JO BRADLEY
Partner
Profile: www.dyoung.com/people/staff/jobradley.htm

JONATHAN DEVILE
Partner
Profile: www.dyoung.com/people/staff/jonathandevile.htm

SIMON O'BRIEN
Associate
Profile: www.dyoung.com/people/staff/simonobrien.htm

GARRETH DUNCAN
Associate
Profile: www.dyoung.com/people/staff/garrethduncan.htm

DAN MERCER
Assistant
Profile: www.dyoung.com/people/staff/danmercer.htm

EXAM SUCCESS

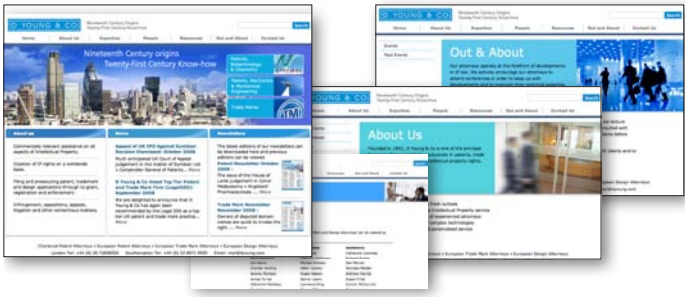
THREE NEW ASSOCIATES APPOINTED AUGUST 2009

Following their recent exam success we are pleased to announce that Nicholas Malden, Anthony Carlick and Connor McConchie are fully qualified Chartered and European Patent Attorneys and have therefore been appointed associates of the firm. Tessa Seymour and Susan Fridd have also been successful and are now qualified European Patent Attorneys.

We wish all of our trainee attorneys best of luck in their ongoing studies.

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.



Visit our website **www.dyoung.com** for further information about D Young & Co, our attorneys and our services. This newsletter, our trade mark newsletter and a library of previous editions can be found online at www.dyoung.com/resources/newsletters.htm.

PATENT NEWSLETTER SUBSCRIPTIONS
To subscribe to the D Young & Co patent newsletter please contact Rachel Daniels, Business Development Manager, at our Southampton office address (see details, left), or by email at rjd@dyoung.co.uk

www.dyoung.com

mail@dyoung.co.uk

D Young & Co London
120 Holborn, London, EC1N 2DY
T: +44 (0)20 7269 8550
F: +44 (0)20 7269 8555

D Young & Co Southampton
Briton House, Briton Street, Southampton, SO14 3EB
T: +44 (0)23 8071 9500
F: +44 (0)23 8071 9800