

D YOUNG & CO

PATENT NEWSLETTER *no.100*

April 2024
In this issue:

Important notification Change of D Young & Co London office address	04
UPC Court of Appeal reverses first instance decision In-depth review and analysis	04
UPC Court of Appeal A positive step in transparency of proceedings	06
UPC favours SMEs for language change Claimants ordered to sue in the language of the granted patent	08
Patents in the media UKIPO report review	11

Also: EPO registration of transfers of rights and licenses, EPO excluded subject matter, how to invalidate your own design, events and webinars



Celebrating 100 newsletters Patent decisions 2007-2024

Full story Page 02



Important notification Page 04
D Young & Co London team moves to new offices



It is with great pleasure that we present the 100th edition of our patent newsletter. Reviewing the technological and legal developments that we have reported on over the course of those editions amply demonstrates the rapid pace of change of each. We are privileged to work at the interface of both, navigating the complex and fascinating world of patents.

Several of our articles in this edition deal with the first decisions emerging from the nascent Unified Patent Court, and we continue to monitor the development of its early case law with interest.

D Young & Co goes from strength to strength and, as we move into our new London office, I am delighted to report that our patent partner Anthony Albutt has been named UK Practitioner of the Year in the Managing IP EMEA Awards 2024. That the firm has also won the UK Trademark Prosecution Firm of the Year award highlights the multi-disciplinary excellence we present.

Nicholas Malden, Editor

Events



BIO International Convention
San Diego, US, 03-06 June 2024
 Partners Tamara Milton, Jennifer O'Farrell and Antony Latham will be attending this convention.

Lexology UPC masterclass
Webinar, 05 June 2024
 Save the date! More information available on our website events page in May.

Patent protection for software-related inventions in Europe and the USA
Webinar/London, UK, 05 June 2024
 Partner Alan Boyd will be co-leading this online and in-person course. Enrolment is now open.

European Biotech Patent Case Law
Webinar, 9am, noon & 5pm, 25 June 2024
 Partner Simon O'Brien and Associate Nathaniel Wand present our latest webinar update of new and important EPO biotechnology patent case law.

www.dyoung.com/events

Subscriptions



Email subscriptions / mailing preferences:
subscriptions@dyoung.com

Read online and view previous issues:
www.dyoung.com/newsletters

Our privacy policy is published at:
www.dyoung.com/privacy

Follow us



LinkedIn: dycip.com/linkedin
 Twitter: @dyoungip

Our 100th newsletter

Celebrating 100 newsletters Patent decisions 2007-2024

To celebrate our 100th patent newsletter we've compiled a condensed overview of the eighteen years' worth of case law and commentary since our first October 2007 publication. Over this time the emergence of new technologies has posed challenges for rights holders, attorneys, scholars and the judiciary alike, and has led to transformation of the patent legal landscape around the globe. We invite you to visit our IP knowledge bank where all our articles, guides, webinars and newsletters can be found: www.dyoung.com/ipknowledgebank.

2007-2008
 Our first patent newsletter heralded the entry into force of the European Patent Convention 2000 (EPC 2000) at the close of 2007. We welcomed the new year with news that the EU had joined the Hague Agreement, meaning any European individual or company could file an international registered design. In May 2008 the London Agreement entered into force, offering a reduction in the cost of translations at grant for some of the most commonly designated EPO states, and in September 2008 the patent prosecution highway (PPH) pilot programme between the EPO and the USPTO commenced, allowing fast-track patent examination procedures.

2009
 Another fast-track system hit the news in May when the UKIPO introduced the Green Channel, an accelerated process for UK applications relating to greentech. Hot topics over the year included computer-implemented inventions as well as antibody, stem cell and DNA patents, divisional applications and the liberalisation of ECJ law on multiple SPCs.

2010
 This was the year we evolved our brand identity to the logo and newsletter format you see today. Elsewhere we saw more debate in the courts on DNA sequence and computer programme patenting, SPC application time limits and the end of the Swiss claim format for second medicinal use claims. By the close of the year we were reporting a reboot of the Patents County Court (PCC)

with hopes that the "re-born" court would bring affordable UK litigation to SMEs.

2011
 In January we introduced our dispute resolution & litigation group and became the first firm of patent and trade mark attorneys to establish a legal disciplinary practice in the UK. We also launched our now popular European biotech patent case law webinars (and we hope you will be able to join us in June for the latest of these). This year the CJEU ruled on stem cell patenting, causing considerable uncertainty for European stem cell companies at the time.

2012
 After years of speculation about the elusive unitary patent, discussions gained impetus following an EU Competitiveness Council meeting in Paris in which the compromise solution of a Central Division in Paris with specialist clusters for chemistry, life sciences and mechanical engineering was proposed. Our closing words "watch this space" were to be repeated for another 11 years until the launch of the UP and UPC in June 2023!

2013
 The start of the financial year ushered in a new opt-in tax saving scheme, the UK Patent Box, a tax opportunity that any IP-active company should still keep in mind. The smartphone patent wars rumbled on with news of the latest skirmishes in Samsung v Apple, and 3D printing was capturing our collective imaginations.

2014
 Trending issues a decade ago were "big data", graphical user interfaces (GUIs), and wearable tech, plus of course the ongoing smart phone wars. We discussed implementation of the Nagoya Protocol in the EU, enabling the fair and equitable sharing of benefits arising from the utilisation of genetic resources, contributing to the conservation and sustainable use of biodiversity. In October the UK IP Act 2014 came into force, designed to modernise IP law and to support UK businesses in the protection of their IP rights in the UK and abroad. The global patent prosecution highway (GPPH) pilot

> Related articles

Every edition of this newsletter can be found at www.dyoung.com/newsletters



programme expanded to include Singapore, bringing the total number of participating IP offices to 19 (in 2024 we have reached 27 members, including the DPMA and UKIPO).

2015

The so-called Broccoli and Tomato decisions (G 2/12 and G1/13) were stand-out cases for 2015, and good news for applicants seeking protection for non-GM plants in Europe. This decision was overturned five years later in G 3/19, at which point the law updated to state that “plants and animals exclusively obtained by essentially biological processes are not patentable”.

2016

In a decision that disappointed many design right holders, Magmatic (Trunki) lost its appeal to the UK Supreme Court in its case against PMS, sellers of the competing Kiddee Case. This remains a cautionary tale regarding the importance of filing design registrations that do not limit scope of protection unnecessarily, especially for shape designs. Significantly for D Young & Co, this was the year we opened our first German office to support our growing client base across Europe and the rest of the world. In 2024 we are delighted to celebrate the continued growth and success of our Munich team.

2017

2017 was a momentous year for claim interpretation in the UK, with a ground-breaking decision from the UK Supreme Court (Actavis v Eli Lilly). The decision brought a doctrine of equivalents into UK patent law, as well as a limited doctrine of file wrapper estoppel, changing the way in which the scope of protection conferred by a UK patent is assessed. Also, the High Court of England & Wales handed down a judgment in Unwired Planet v Huawei, determining the terms of a licence relating to standard essential patents (SEPs) for mobile communication technologies on fair reasonable and non-discriminatory (FRAND) terms.

2018

The UK announced its intention to join (after much delay) the Hague system, becoming

the 68th member of the system and giving applicants increased flexibility over the strategy to pursue when filing international design applications. In a decision that was welcomed by campaigners against GM foods, but regarded with dismay by many scientists in the field, the Court of Justice of the European Union (CJEU) decided that gene-edited organisms, using technology such as CRISPR, should be classified as genetically-modified organisms (GMOs), and thus subject to substantial associated regulations. At the end of the year the EPO published revised guidelines for examination relating to AI, machine learning and mathematical methods, aiming to reduce uncertainty for applicants as to what technological innovations are patentable.

2019

A new buzzword in the tech industry was “blockchain”, a potentially disruptive technology. By the close of the year, for the first time in the history of the EPO, the Enlarged Board of Appeal had been asked for a decision relating to the patentability of computer-implemented inventions (CIIs) in G 1/19.

2020

Sadly, the Collins English Dictionary word of the year was “lockdown”. Writing our newsletters during the Covid-19 pandemic we worked with and witnessed creative groups and individuals from around the globe protecting us from the virus and innovating in diverse areas ranging from frontline medicine, epidemiology, and immunology, to engineering, digital communications and many more. The pandemic dramatically accelerated moves towards digitalised working practices, most prominently at the time for patent attorneys at the EPO, with the adoption of oral proceedings by videoconference. In September the UK Supreme Court confirmed that UK courts are able to set global FRAND terms, a decision that addressed the inherent conflict between, on the one hand, a globalised market place and standards setting context for many technologies, and on the other, the national scope of individual patent rights.

2021

The EPO Enlarged Board of Appeal announced its decision in respect of G 1/19 relating to the patentability of computer simulations, restricting the patentability of purely simulation based innovations in Europe. Following the UK’s exit from the European Union in the previous year, we published our “Patents and SPCs post-Brexit” report, shining a spotlight on the impact of Brexit on the pharma industry, focusing on the challenges ahead, as well as areas of opportunity for the UK.

2022

With news in January that Austria had deposited the instrument of ratification for the Protocol to the Agreement of a Unified Patent Court, launch preparations for the new court began in earnest and we were busy answering your all-important opt-out questions. In the UK the government issued its response to a consultation conducted into artificial intelligence and IP, exploring three areas of patent and copyright law particularly relevant to the commercial exploitation of AI: copyright in computer-generated works, patents, and text and data mining.

2023

The Enlarged Board of Appeal issued its much awaited decision G 2/21 (concerning post-filing data in support of a technical effect for inventive step), and hot topics included techbio, AI inventors and inventions, data mining, greentech and spacetech. However, the clear headline news, arguably since our inaugural newsletter, was the launch in June 2023 of the Unified Patent Court (UPC) and unitary patent (UP). Our newsletters and website are now frequently updated with UP & UPC statistics, commentary and insight on the new system (www.dyoung.com/upandupc).

2024 +

Technology advances every day and IP law must continually evolve to catch up. We will continue to keep you abreast of the latest developments in law, science and technology and publish our patent and trade mark newsletters each month. To subscribe, please email your details to subscriptions@dyoung.com or visit www.dyoung.com/subscriptions.

Important notification

Change of D Young & Co London and registered office address

D Young & Co, 3 Noble Street, London



From Tuesday 19 March 2024 our London team should be contacted at the following address:

D Young & Co LLP
3 Noble Street
London
EC2V 7BQ

Tel: +44 (0)20 7269 8550
Fax: +44 (0)20 7269 8555

D Young & Co Chair David Meldrum comments: "This exciting move reflects our commitment to growth and innovation. We look forward to welcoming clients to our new London home, in the heart of the City, where we will continue to thrive and create value together."

Our Munich and Southampton offices remain unchanged. If you usually correspond with our Munich or Southampton offices (and Southampton accounts) please continue to do so:

- D Young & Co LLP, Rosental 4, 80331, Munich.
- D Young & Co LLP, Briton House, Briton Street, Southampton, SO14 3EB.

UPC Court of Appeal reverses first instance decision

In-depth review and analysis

On 26 February 2024 the Unified Patent Court (UPC) Court of Appeal overturned the order of the Munich Local Division, finding the subject patent more likely than not to be invalid, and rejected the applicants' request for a preliminary injunction, whilst dismissing requests from both parties for a stay in proceedings.

Related article

For our initial update on this case see our article "UPC: Court of Appeal overturns first instance ruling for a preliminary injunction" 28 February 2024: dycip.com/upc-coa-nanostring-feb2024

Background

The patent at issue, EP 4 108 782, relates to optical multiplexing methods for detecting target molecules in a sample, and was granted on 07 June 2023. On the first day of the UPC, 01 June 2023, the applicants, including 10x Genomics, applied to the Munich Local Division as Court of First Instance for an order for a preliminary injunction against the defendants, NanoString Technologies group of companies.

In September 2023, within two weeks of the hearing, the Munich Local Division found "with a sufficient degree of certainty", that the patent was most likely valid and infringed, and an order for a preliminary injunction was issued. The order, which stretched over one hundred pages, demonstrated the Munich Local Division's desire and ability to consider complex technical and legal issues swiftly.

NanoString Technologies appealed this order to the UPC Court of Appeal pleading, among other things, that the Munich Local Division had erred in its narrow interpretation of claim 1 of the patent, and in its finding that the patent was most likely valid.

The order

Starting with claim construction, in line with Article 69 of the European Patent Convention (EPC), the UPC Court of

Appeal acknowledged that the description and drawings of the patent must be used as explanatory aids for the interpretation of the patent claim. In doing so it disagreed with the Court of First Instance's interpretation of the patent claim, in particular with regard to whether the detection reagents must remain bound to the respective analytes throughout the entire detection procedure. Unlike the first instance order, the UPC Court of Appeal decided that there is nothing to preclude the decoder samples, once they have been bound to the respective analytes, from being removed again at a later stage.

Although the UPC Court of Appeal agreed with the Court of First Instance that claim 1 of the patent would more likely than not be found to be novel, it found fewer novel features when compared to the disclosure of document D6, a research paper disclosing a method for detecting a plurality of amplified single molecules (ASMs) by encoding and decoding the single molecules. In particular, the UPC Court of Appeal considered the only novel feature to be that claim 1 of the patent allows the detection of a plurality of analytes "in a cell or issue sample", whereas D6 relates to the detection of ASMs ordered in vitro in an array format.

As a result, in contrast to the first instance order, the UPC Court of Appeal decided that claim 1 of the patent would "more likely than not" be considered obvious. Emphasis was placed on the presence of the two technically qualified judges when stating that not only was there a need for multiple analysis techniques at the priority date of the patent, but that the skilled person would consider transferring the encoding and decoding techniques disclosure in D6 to the detection of ASMs in cell or tissue samples. Further, the UPC Court of Appeal considered the skilled person to have sufficient expertise to be able to deal with the problems that could be encountered when combining the disclosures of different documents, noting that such problems regularly arise in connection with in situ detection. Equally, the judges considered there to be an incentive in D6 to modify the method towards that claimed in the patent, referring to a footnote

➤ **Case details at a glance**

Decision level: Court of Appeal, Luxembourg

Case: UPC_CoA_335/2023

Date: 26 February 2024

Judgment: Order

Parties: NanoString Technologies Inc [et al] v 10x Genomics Inc [et al]

Action: Appeal against provisional measures

Decision: dycip.com/upc-order-595990

Useful links

Order 6653/2024, UPC Court of Appeal,

26 February 2024:

dycip.com/order6653-upc-coa

Related articles

"UPC: Court of Appeal overturns first instance ruling for a preliminary injunction":

dycip.com/upc-coa-nanostring-feb2024

"Preliminary injunctions before the Unified Patent Court: what do we know so far?":

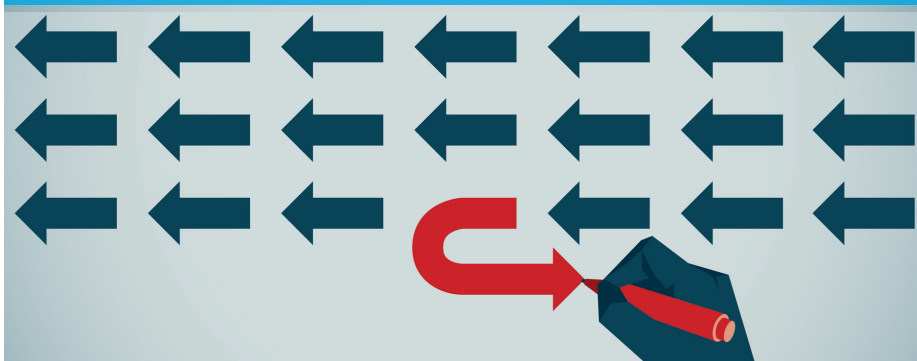
dycip.com/preliminary-injunctions-upc-dec-2023

Breaking news Irish referendum on UPC participation postponed

The Irish Government has announced that the referendum to vote on Ireland's participation in the Unified Patent Court (UPC) has been delayed. The government has not provided any indication as to when the delayed referendum will occur:

dycip.com/upc-irish-referendum-delay

The UPC Court of Appeal overturned the order of the Munich Local Division



in D6 referring to in situ genotyping of individual DNA molecules. The UPC Court of Appeal therefore concluded that the skilled person would arrive at the subject matter of claim 1 of the patent, either from the disclosure of D6 alone or in combination with D30, a different document related to in situ detection of non-polyadenylated ribonucleic acid (RNA) molecules.

As a result of finding that it is more likely than not that the patent will prove to be invalid, the first instance order was revoked, and the request from 10x Genomics for an injunction was rejected.

Stay of proceedings

In a related order, the UPC Court of Appeal ruled that the proceedings were not required to be stayed as a result of NanoString Technologies opening insolvency proceedings under Chapter 11 of the Bankruptcy Code in the USA.

The judges noted that the Rules of Procedure of the UPC are to be interpreted to ensure a fair balance between the legitimate interests of all the parties, and that the proceedings are to be conducted in the most efficient and cost effective manner. The judges particularly emphasised the need for a timely order on proceedings related to preliminary injections.

Since NanoString Technologies was only declared insolvent after the oral hearing in this case had concluded, the judges decided all procedural steps had been taken by the parties and all costs already incurred, so

any decision or order on the case after the declaration of insolvency would have had the same effect as if the decision or order were issued before the declaration of insolvency.

Further, the judges referred to comparable provisions in the codes of procedure in France, Germany, Italy and the Netherlands for not staying proceedings if a party is declared insolvent after the oral hearing, or if the case is ready for an order. Accordingly, the UPC Court of Appeal ordered the requests for a stay of proceedings to be dismissed.

Discussion

In overturning the Munich Local Division's conclusion on the validity of the patent the UPC Court of Appeal does not identify any legal error made in the first instance order, nor does it make any comment on the methodology used in assessing whether a preliminary injunction should be granted. Instead, the UPC Court of Appeal reassessed the construction of the claim and the resulting impact on the novel features over the prior art. Although the disclosure of D6 is discussed at length, a formal "problem and solution" approach as used at the EPO is not expressly used in the order. Instead, the UPC Court of Appeal identifies the problem the invention seeks to address, then analyses whether the skilled person would be motivated to modify the disclosures in the prior art to arrive at the claimed subject matter. It is still not clear how the UPC will assess inventive step and whether the 'problem and solution'

approach will be formally adopted; we will continue to watch how inventiveness is assessed as more decisions come out.

In finding the patent more likely than not invalid, the UPC Court of Appeal did not consider the issue of infringement, and in particular whether carrying out part of process on a server operating outside the territory of the UPC constituted infringement, which was one of the defences of NanoString Technologies during proceedings at the Court of First Instance.

The order does, however, confirm that the burden of proof is on 10x Genomics to satisfy the court to "a sufficient degree of certainty" that 10x Genomics is entitled to apply for provisional measures, and that the patent is valid and infringed. In particular, the judges set out that the court must consider it "at least more likely than not" that the patent is infringed, and such "a sufficient degree of certainty" is lacking if, on the balance of probabilities, the patent is more likely than not to be invalid. Despite this, the discussion of inventiveness in the order spans multiple pages, with a detailed discussion as to why the skilled person would not only be motivated to provide all of the features of claim 1 of the patent, but would also have sufficient expertise to do so.

The patent is currently under opposition at the EPO, and NanoString Technologies was quick to file the UPC Court of Appeal's order as a document in opposition proceedings.

We will observe with interest how the Opposition Division uses the UPC Court of Appeal's order during opposition proceedings.

Although the order from the UPC Court of Appeal lifts the preliminary injunction in the seventeen UPC contracting member states, a separate injunction in Germany remains in place, and NanoString Technologies has announced it is evaluating its next steps in Germany.

Author:

Andrew Cockerell



UPC Court of Appeal

A positive step in transparency of proceedings

The UPC (Unified Patent Court) Court of Appeal has issued its decision in *Ocado v Autostore* (10 April 2024) regarding the appropriate standard to be applied when considering requests by third parties for access to written pleadings and evidence pursuant to Rule 262.1(b) of the UPC Rules of Procedure. In brief, the Court of Appeal dismissed the appeal and thereby upheld the decision of the Nordic-Baltic Regional Division to allow access to the statement of claim. This is a welcome ruling as it appears to set a generally permissive regime for access to pleadings and evidence at the UPC.

Background

As previously reported (see “Transparency of UPC proceedings: Court of Appeal to rule on “reasoned requests” for file access”: dycip.com/upc-proceedings-file-access), the appropriate standard to be applied when considering requests by third parties for access to written pleadings and evidence pursuant to Rule 262.1(b) of the UPC Rules of Procedure has been an early point of contention in the UPC. The Munich Central Division applied a highly restrictive approach in *Astellas v Osaka* (UPC_CFI_75/2023) and *Sanofi v Amgen* (UPC_CFI_1/2023) rejecting requests for file access based on “education and training” and “out of interest” in the patent at issue and its legal validity. This was contradicted by the Nordic-Baltic Regional Division applying a more liberal approach in *Ocado v Autostore* (UPC_CFI_11/2023) and granting access to an (anonymous) member of the public based on “interest” in how the statement of claim was framed.

Ocado appealed the decision of the Nordic-Baltic Regional Division on this point.

The arguments of the parties

In its appeal against the first instance decision, Ocado accepted that access to pleadings and evidence might be justified in order to enable members of the public to understand a final order or decision of the UPC. However, Ocado argued that in a case where no decision was issued, for example where the parties reached a

This decision provides clarity on how requests for access should be assessed at the UPC



settlement prior to the court hearing (as was the case in *Ocado v Autostore*), there was no justification for members of the public to be granted access to documents. Ocado also acknowledged that access to pleadings and evidence could be justified where the proceedings concerned the validity of a patent that the requesting party was specifically concerned with, but that no such interest had been established for the anonymous member of the public making the request in the case in question.

The member of the public argued in response that access to a case file should always be given, regardless of the stage or nature of the proceedings. It was further argued that the term “reasoned request” in Rule 262.1(b) of the UPC Rules of Procedure merely requires the requesting party to set out which documents are requested to be given access to, so long as the request is not abusive as required by Article 45 UPCA. The member of the public also argued that access may only be denied according to the UPC Agreement if a party to proceedings has a legitimate reason to keep certain information confidential.

The decision of the court

The court dismissed Ocado’s appeal and

further expanded upon the reasoning of the Nordic-Baltic Regional Division at first instance for granting access to the requested statement of claim.

The court interpreted Articles 10(1), 45, and 52 of the UPC Agreement as providing the general principle that the UPC register and proceedings held before the UPC **should be open to the public, “unless the balance of interests is such that they are to be kept confidential”**.

The “interests” to be balanced were the interests of a member of the public of getting access to the written pleadings and evidence, against the protection of integrity of proceedings. The latter included (1) the interests of the parties to proceedings or other affected persons (for example, protection of confidential information and personal data), and (2) general interest of justice and public order. Public order was noted to be affected where, for example, the reasoned request made is abusive or public security would be at stake if the request were granted.

In view of the arguments put forward by Ocado and the member of the public, the court discussed these “interests” with reference to the stage of proceedings.

Case details at a glance

Decision level: Court of Appeal, Luxembourg

Order reference: ORD_19369/2024

Date: 10 April 2024

Parties: Ocado Innovation Limited

Type of action: Generic Order

Language of Proceedings: English

Decision: dycip.com/upc-19369-2024



Save the date!

Lexology masterclass

The impact of the UPC
one year from launch:

Webinar, 05 June 2024

- The court acknowledged that the general interest of the public for documents to be made available usually arises only after a decision is issued, since it is only then that a decision exists that requires scrutiny.
- The court considered that the “protection of integrity of proceedings” was usually only an issue whilst proceedings were still ongoing, where it is important to ensure that the parties can bring forward arguments and evidence without undue influence or interference from external third parties.

The UPC Court of Appeal thus concluded that “these interests”, that is, the general interest of the public and the protection of integrity of proceedings are “usually properly balanced and duly weighed against each other”, if access to written pleadings and evidence is given to a member of the public after the proceedings have come to an end by a decision of the court.

The court also, however, acknowledged that as in the case at issue, proceedings may come to an end before a decision is issued. However, Ocado’s argument that access to documents should be denied in such a case was explicitly rejected. The court held that **once the integrity of proceedings no longer plays a role**, the balance of interests will usually be **in favour of granting access** given the general principle that the UPC register and its proceedings are open to the public. The court even acknowledged that in such a situation, the case file may “serve another legitimate interest” of the member of the public, “such as scientific and/or educational interests”.

Finally, the court considered the situation where the third party requesting access has a more specific interest in the ongoing proceedings. An example of “a more specific interest” was “a direct interest in the subject-matter of the proceedings, such as the validity of a patent that he is also concerned with as a competitor or licensee, or where a party in that case is accused of infringing a patent with a product which

is the same or similar to a product (to be) brought on the market by such member of the public”. In such a scenario, the court acknowledged that a direct legitimate interest in gaining access to pleadings and evidence may arise during the proceedings themselves and not only on their termination.

The court held that the “balance of interests” would again generally be **in favour** of granting access. The “direct interest” in the proceedings would seemingly outweigh the general interest of integrity of proceedings.

The court did, however, note that such access could be subject to certain conditions to appropriately protect integrity of proceedings. An example was the obligation for that member of the public to keep the provided documents confidential until proceedings had come to an end.

With the above principles in mind, the UPC Court of Appeal dismissed the appeal and thereby upheld the decision of the Nordic-Baltic Regional Division to grant access to the statement of claim to the anonymous third party. The court noted that:

- the interest of the third party was one of a general nature;
- Ocado had not argued that the request was abusive, and there was no indication that it was; and
- at the time of the request, the proceedings in question had come to an end by a settlement.

It was also noted that Ocado had not made any request for certain information in the statement of claim to be excluded from public access for the purposes of confidentiality or personal data protection. The court concluded that the balance of interest was in favour of granting access.

The court also explained that a “reasoned request” pursuant to Rule 262.1(b) of the UPC Rules of Procedure must not only indicate the documents for which access is sought, but must also specify the purpose

of the request and explain why access to the specified documents is necessary for that purpose. The court held that such an explanation is required for the judge-rapporteur deciding on the request to consider the balance of interests required by Article 45 of the UPC Agreement.

The court further noted that Rule 262 of the UPC Rules of Procedure allows for parties to proceedings to request that certain information in the requested documents be kept confidential (for example, details of the settlement agreement reached) and that Rule 262.3 of the UPC Rules of Procedure provides a separate procedure for the requesting party to apply for access to such confidential information.

Comment

The UPC Court of Appeal’s decision provides welcome clarity as to how requests for access to pleadings and evidence should be assessed at the UPC. It is particularly reassuring that the appeal was dismissed and in view of a genuine interest from a third party, without a counter-balance from protecting the integrity of the proceedings, the request for access was allowed.

It seems likely that following this decision, the first instance courts of the UPC will draw a clear distinction between requests for access to documents made whilst proceedings are still ongoing and those made after the proceedings have come to an end.

Specifically, it appears that requests made after proceedings have terminated will in general be granted, unless the parties to proceedings request that certain information stay confidential. In contrast, it appears that requests to access pleadings and evidence made whilst proceedings are ongoing will be more closely assessed and may require a direct interest in the patent at issue.

We will continue to monitor developments in this area and provide updates as they arise.

Authors:

Rachel Bateman & Khalil Davis



UPC favours SMEs for language change

Claimants ordered to sue in the language of the granted patent

Since publishing this article, the UPC Court of Appeal in *Curio Biosciences v 10x Genomics* has ordered a change of language of proceedings to English, the language in which the patent granted. This request was rejected at first instance. Circumstances including the smaller size of Curio Biosciences versus 10x Genomics factored into the Court of Appeal's decision.

A detailed analysis will soon be published on our website: www.dyoung.com/upandupc

Two orders from the UPC Courts of First Instance suggest claimants will not be able to cause trouble for SMEs by suing in a language other than that in which the patent was granted.

Before the Unified Patent Court (UPC), Rule 323 of the UPC Rules of Procedure allows an application to be made for changing the language of proceedings to that in which the patent was granted. In the majority of cases European patents are granted in English.

Two similar orders of the UPC Courts of First Instance have issued in relation to such applications (UPC_CFI_239/2023 and UPC_CFI_373/2023). The initial chosen language of proceedings (Dutch and German) was unfamiliar to both defendants, which are SMEs. Therefore, the defendants applied to change the language of proceedings to English, the language in which the patents were granted.

The judge-rapporteur forwards such applications to the President of the Court of First Instance, who should invite the other party to indicate its position on the application within ten days. Having consulted the division, the President of the Court of First Instance may order the language of proceedings to be changed to the language in which the patent was granted, and this can be conditional on specific translation or interpretation arrangements.

Admissibility

Rule 323 of the UPC Rules of Procedure states that an application for change of the language of proceedings shall be included in the statement of claim or defence, in accordance with Article 49(5) of the Agreement on a UPC (UPCA). Neither of the applications were included in the statement of defence. However, both applicants argued that Article 49(5) UPCA does not include a time frame, and that Rules 321 and 322 of the UPC Rules of Procedure allow both parties, and the judge-rapporteur, to propose such a language change "at any time during

the written procedure". The applicants also argued that the UPCA shall prevail in case of conflict with the UPC Rules of Procedure, and requiring the application to be made in the statement of defence goes against the principles of proportionality, flexibility, fairness and equity, as set out in the Preamble of the UPC Rules of Procedure.

In both cases, the court asserted that Article 49(5) UPCA shall not be interpreted as precluding an application pursuant to Rule 323 of the UPC Rules of Procedure from being filed before the statement of claim/defence. Such an interpretation was considered to slow down proceedings, and go against the general aims of the UPC.

Instead, the courts decided that "in the statement of claim/defence" of Rule 323 of the UPC Rules of Procedure should be understood as the deadline by which the application needs to be made.

Rules 7.1 and 14.4 of the UPC Rules of Procedure specify that written pleadings and other documents should be filed in the language of proceedings, and that the registrar should return any pleading lodged in a different language.

In the second case, however, the application was deemed admissible despite being filed in English, instead of the current language of proceedings. This was because the registry had not returned the application, and no further reason to reject it as inadmissible had been identified.

Merits

On the merits, the applicants argued that they are small companies facing disproportionate and unnecessary financial burden through considerable translation costs, whereas the UPC system aims to make European patent litigation affordable for SMEs.

In contrast, the respondents are much larger companies, either using English as a working language (in the first case) or being well-equipped to conduct the main proceedings in English (in the second case). In fact, English had already been used in both cases for correspondence and/or submissions, and the respondents had considered translation into Dutch/German to be unnecessary.

The applicants also argued that it would be valuable to use the language in which the patent granted for legal discussion in the main proceedings.

In the first case, the respondents argued that there is no disproportionate, unnecessary burden and disadvantage suffered by the applicant, particularly as translation tools are available. In addition, the judges and most of the applicant's representatives speak Dutch, so oral proceedings should be held in Dutch.

The respondents also argued that the claimant has the option to choose the language in which they want to litigate, Dutch being the obvious choice in this case, with Dutch representatives acting before the Dutch local division of the UPC.

In the second case, the respondent argued that the advantages of keeping the current language should be weighed against the inconveniences, with changes of language only being made under very particular circumstances and exceptional situations. Unlike in the first case, they argued that claimants do not get to pick their language of choice, instead, the language of proceedings is limited to that of the local division having jurisdiction, resulting from the circumstances of the case, including where incriminated products are distributed.

The respondent argued that the protection for SMEs should not apply to the applicant, who sells worldwide, and offers information and support in different languages including German. In addition, the respondent argued that German is a foreign language for both parties, and the fact that a translation of the statement of claim was provided does not mean it would be

➤ Related articles

We are frequently publishing UP & UPC updates and resources, especially when decisions break, announcements are made and statistics are made available. Do bookmark our UP & UPC website pages to keep up to date with our latest articles: www.dyoung.com/upandupc.

For our most recent commentary on statistics from the UPC please see our article:

“UPC insights: trends from the January 2024 caseload report”, published 28 February 2024: dycip.com/upc-caseload-jan2024



Save the date!
Lexology masterclass
The impact of the UPC one year from launch:
Webinar, 05 June 2024

Comment

UPC infringement actions can be brought before the local or regional division where the alleged infringement has occurred, or where one of the defendants has its residence or a place of business. Therefore, if an alleged infringement takes place in multiple countries, or there are multiple defendants based in different countries, a claimant is able to forum shop – picking where they wish to litigate.

Based on these orders, however, claimants should not assume they will be able to cause trouble for SMEs by forum shopping and suing in a language other than that in which the patent was granted. In most cases, this is English, which is an available language of proceedings for all divisions of the UPC, and currently used in 45% of First Instance proceedings.

The remaining proceedings are using German (47%), French (3%), Italian (3%) and Dutch (2%). Given that the large majority of proceedings are using German and English, we at D Young are in an excellent position to represent our clients before the UPC.

Author:

Laura Jennings



Order details at a glance

Decision level: Court of First Instance, The Hague
Case: UPC_CFI_239/2023
Date: 18 October 2023
Parties: Arkyne Technologies SL v Plant-e Knowledge BV & Plant-e BV
Type of action: Application for change of the language of proceedings to the language in which the patent was granted
Decision: dycip.com/upc-cfi-239-2023

Decision level: Court of First Instance, Düsseldorf
Case: UPC_CFI_373/2023
Date: 16 January 2024
Parties: Aarke AB v SodaStream Industries Ltd
Type of action: Application for change of the language of proceedings to the language in which the patent was granted
Decision: dycip.com/upc-cfi-373-2023

In both cases the application to change the language of proceedings to English was granted



advantageous for the respondent to change the language of proceedings to English.

The respondent also argued that the nationality and native language of the judges should be considered, to ensure a high quality decision.

In both cases, the court decided that whether to change or not change the language of proceedings shall be determined with regard to the respective interests at stake, without it having to constitute a disproportionate disadvantage. When considering all the relevant circumstances, it may be sufficient that the language initially chosen is significantly detrimental to the applicant.

In the first case, the court agreed that the use of English would not affect the interests of the respondents, whereas being sued in an unfamiliar language is an important inconvenience for the applicant. Even if they have Dutch representatives and translation tools available, considerable time and costs are involved. Moreover, the respondents

had not given a particular justification for disagreeing to the requested change.

In the second case, the court agreed that an important goal of the UPCA is to take into account the situation faced by SMEs, which have difficulties enforcing their patents and defending themselves. The court considered there would be a significant imbalance in this case, even though German is equally unfamiliar to both parties.

Moreover, the court would not consider the nationality and native language of the judges in relation to the quality of the decision, because English is an official language of the division, and the one most generally used by the judges to communicate and work.

Therefore, in both cases, the application to change the language of proceedings to English was granted. This was not conditional on any specific translation or interpretation arrangements, as the applicants had not requested translation of the existing documents.

UPC Court of Appeal

Members of public require representation to request access to documents

In a recent order the Unified Patent Court (UPC) Court of Appeal has ruled that a member of the public requesting access to documents must be represented by a professional representative.

This is a development which forms part of the ongoing saga around transparency and access to documents at the UPC.

As reported in our article, published 21 December 2023 “Transparency of UPC proceedings: Court of Appeal to rule on “reasoned requests” for file access”, the Nordic-Baltic regional division ordered access to the statement of claim (after redaction of personal data) following a request for access under Rule 262.1(b) of the UPC Rules of Procedure. The request was made by a member of the public and concerned the case of *Ocado v Autostore*.

Ocado appealed the order and the decision was issued on 10 April 2024 (see our article “UPC Court of Appeal: a positive step in transparency of proceedings” on page 06 of this newsletter).

As a side issue to the appeal on access to documents, the UPC Court of Appeal considered the issue of representation under Rule 8.1 of the UPC Rules of Procedure and has ruled that a member of the public requesting access to documents must be represented.

Rule 8.1 of the UPC Rules of Procedure requires that a party to proceedings at the UPC must be represented unless the Rules of Procedure provide otherwise. The central question to be decided upon by the court was thus whether or not a member of the public requesting document access is to be treated as a party within the meaning of Rule 8.1 of the UPC Rules of Procedure.

In this regard, the court noted that Article 47 of the UPC Agreement refers to a party only in the context of actions made before the UPC, which according to Article 32 of the UPC Agreement do not include applications other than actions. However, the court reasoned with reference to opt-outs

and decisions subject to appeal, that the definition of a party in Rule 8.1 of the UPC Rules of Procedure must nonetheless be wider than defined in Article 47 of the UPC Agreement. In other words, the situations in which representation is required is not limited to actions made before the UPC.

In particular, the court noted that opt-out procedures are not defined as actions under Article 32 of the UPC Agreement, and yet applicants are expressly excluded from the requirement for representation by Rule 5.4 of the UPC Rules of Procedure, implying that these applicants should be considered parties with the meaning of Rule 8.1 of the UPC Rules of Procedure.

The court similarly noted that a party in Rule 220.1 of the UPC Rules of Procedure, which sets out which decisions of the UPC may be subject to appeal, has a wider meaning. In this rule the term party applies to third parties adversely affected by a decision or order of the court, including a third party under Rule 190 and a member of the public making a request for document access under Rule 262.1(b) of the UPC Rules of Procedure.

The court thus concluded that all applicants of any application or action before the UPC are required to be professionally represented, unless this requirement is explicitly waived by the Rules of Procedure. Since no such exemption exists for applicants under Rule 262.1(b) of the UPC Rules of Procedure, the court held that the member of the public in *Ocado v Autostore* will require representation

Case details at a glance

Decision level: Court of Appeal, Luxembourg
Case: UPC_CoA_404/2023
Judgment: Order
Parties: Ocado Innovation Limited (respondent)
Action: Appeal under UPC RoP 220.2
Date: 08 February 2024
Decision: dycip.com/upc-coa-404-2024

Related article

“Transparency of UPC proceedings: Court of Appeal to rule on “reasoned requests” for file access”:
dycip.com/upc-proceedings-file-access

in the appeal proceedings, and indeed should have been represented before the Court of First Instance. The court commented that it did not find this requirement for representation to be “unnecessarily burdensome”, and furthermore considered members of the public filing a request for document access to be in an adversarial situation where professional representation would be appropriate.

The Court of Appeal's order makes clear that, in general, applicants for any application or action before the UPC will require professional representation. This requirement would appear to place a reasonably significant barrier in the way of members of the public seeking access to pleadings or evidence, despite the relatively permissive regime for document access expected to develop following the Court of Appeal's subsequent decision in *Ocado v Autostore*.

UK-based European Patent Attorneys have full rights of representation before the UPC, there being no nationality or residence requirement to act as a representative. D Young & Co is therefore able to provide professional representation for parties seeking to access documents relating to UPC proceedings. Please contact your usual D Young & Co representative for further information. We will continue to monitor this area and report further as new developments arise.

Authors:

Rachel Bateman & Khalil Davis



Members of the public requesting document access must be professionally represented



Patents in the media UKIPO report review

🔗 Useful link

“Emerging public perceptions of intellectual property in UK media”, UKIPO, 29 February 2024: dycip.com/ip-ukmedia-ukipo

The general public tends to derive its understanding of intellectual property (IP) from reporting in the media. As part of its Futures Initiative, with an objective to assess IP as it is viewed by society, the UK Intellectual Property Office (UKIPO) commissioned a report entitled “Emerging public perceptions of intellectual property in UK media”. In this article we will take a brief look at the findings, particularly as they relate to patents.

The report, which recommends various follow-up studies, looks specifically at IP reporting in UK newspapers (print and online) over a ten year period from 2012. It reveals an overall increase in the number of mentions of IP over that time, suggesting an improved public awareness, if not depth of understanding.

It is noteworthy that news stories mentioning IP tend to arise when the IP has relevance to current events or has a celebrity link or “wow factor”, such as the financial size of a settlement. Interest in, and factual information about, IP per se seem not to be motivating factors for reporting. The stories hence often have an emotive element, for example focusing on “David and Goliath” disputes, with the press often adopting the side of the perceived underdog based on sympathies rather than legal accuracy. The prevalence of social media allows the public to easily engage with and comment on news stories, which can further perpetrate misinformation and distort the facts. The report suggests that in some cases out-of-court settlement of IP disputes may have been driven by a party’s desire to protect its brand from further public criticism, in preference to receiving a legal ruling even if that was likely to be in their favour.

Regarding patents, the general upward trend in news coverage is observed. A spike in 2013 corresponds to the so-called “mobile phone patent wars” between the likes of Apple and Samsung. Many people own a mobile phone to which they have immense brand loyalty, so this subject had a broad public interest, allowing consumers

The UKIPO looked at IP reporting in UK newspapers from 2012-2022



to take sides, driving continued appetite for the story. The Covid-19 pandemic produced another notable increase in patents stories over the course of 2020. As vaccines were developed, a debate arose about whether the World Trade Organization should introduce a waiver under the trade-related aspects of intellectual property rights (TRIPS) agreement to allow patented vaccines to be produced without a patent licence, to increase vaccine supplies for low-income countries. This was supported by the US Government, and opposed by the UK, the European Union and pharmaceutical companies such as Pfizer. Reported arguments against the waiver included alleged discouragement of future vaccine innovation by the pharmaceutical sector, and concerns about unsafe vaccine production. Covid vaccination programs were of great public concern at the time, so the matter was widely reported.

A current topic of public interest fuelling some patents news coverage is artificial intelligence (AI). Some companies are using AI to produce inventions, but patent law in the UK and widely elsewhere requires an inventor of a patented invention to be human. Hence, there have been several patent court cases addressing whether AI can be named as an inventor. These attract news reports in view of public uncertainties and fears about AI.

Those familiar with the IP industry will recognise frequent inaccuracies in IP news reporting, with various terms frequently misused and misapplied. Interestingly, the report observes that errors are less common in stories about patents than other types of IP, such as trade marks and copyright. As well as poor terminology, there is often a lack of clarity about differences in IP law in different jurisdictions, or that IP rights have geographical boundaries. It is unclear whether errors arise from lack of understanding by journalists, or a disregard for the importance of accuracy. Since public perception of IP depends so much on media reporting, which is often factually inaccurate and warped in emphasis, public misunderstanding and undesirable effects thereof can flourish. The report suggests that there may be social benefits to investment in educating journalists in IP matters by the UKIPO.

The report also suggests that there may a link between IP rights holders’ behaviour and public responses to IP news stories. It therefore seems important that public understanding of IP is improved, which can be potentially be enabled by the press.

Author:
Cathrine McGowan

Not an invention Excluded subject matter at the UKIPO

A patent may be granted for an invention which, among other requirements, is new and which involves an inventive step over the prior art. However, not every development is actually considered to be an “invention”. Indeed, Section 1(2) of the UK Patents Act 1977 defines a non-exhaustive list of things which are not considered as inventions for the purposes of the UK Patents Act 1977 (known as excluded subject-matter areas). These include, among other things, a mathematical method, an aesthetic creation, a method of doing business, and a program for a computer. Similar exclusions apply also to European patent applications under Article 52(2) of the European Patent Convention (EPC). A patent will not be granted if the claimed invention falls solely within one or more of these excluded subject-matter areas.

A recent decision by the hearing officer to refuse patent application GB2213917.4 highlights the way in which excluded subject matter is applied at the UK Intellectual Property Office (UKIPO).

The invention

The invention in GB2213917.4 related to a method of converting a restricted payment account on a portable electronic device of a first user to a new primary account, where the restricted payment account is a sub-account of a primary account of a second user.

As an example, a child (a first user) may have a restricted payment account on a smartphone linked to a payment account of their parent (a second user). Then, when a certain threshold is met, such as the child reaching a certain age, the child may be presented with a conversion option to enable conversion of the restricted account to a new primary account. This effectively breaks the ties with the parent’s account such that the parent can no longer place restrictions on the child’s account. Furthermore, information such as transaction history is no longer shared between the child and parent. Accordingly, the applicant, Apple Inc, had argued, as described also in the application, that the invention improved security of establishing payment accounts and protected user privacy.

Aerotel v Telco Holdings shows how excluded subject matter is applied at the UKIPO



The law

In order to assess whether an invention falls within the excluded subject-matter areas defined by Section 1(2) of the UK Patents Act 1977 it is necessary to apply the relevant case law. In *Aerotel v Telco* ([2006] EWCA Civ 1371) the Court of Appeal set out the following test:

1. Properly construe the claims.
2. Identify the actual or alleged contribution.
3. Ask whether it falls solely within the excluded subject matter.
4. Check whether the actual or alleged contribution is actually technical in nature.

Applying step two of the *Aerotel* test, the hearing officer assessed the contribution of GB221917.4 to lie in the process of converting an existing restricted account to a new unrestricted account: using personal information stored by the electronic device when setting up the original restricted device.

The next step was then to consider whether this contribution falls solely within excluded subject matter: step 3 of the *Aerotel* test.

In order to make this assessment the hearing officer considered guidance from paragraph 35 of *Halliburton Energy Services Inc’s* applications [2012] RPC 12, which explained that implementing a business method on a computer does not itself make any technical contribution. While the conversion process

Case details at a glance

Jurisdiction: United Kingdom
Decision level: UKIPO
Applicant: Apple Inc
Citation: BL O/0010/24
Date: 08 January 2024
Decision: dycip.com/bl-O-0010-24

Useful link

Aerotel Ltd v Telco Holdings Ltd & Ors, [2006] EWCA Civ 1371, England and Wales Court of Appeal, 27 October 2006: dycip.com/aerotel-telco-2006

Halliburton Energy Services Inc [2012] RPC 12, England and Wales High Court, 05 October 2011: dycip.com/halliburton-energy

takes place on an electronic device based on metadata stored on the device, this does not make the business method technical. Indeed, the hearing officer considered that improved security of establishing payment accounts and protected user privacy was achieved by an adaptation of a computer-implemented business method to avoid the sharing of personal data based on information already held within the electronic device.

On this basis, the hearing officer decided that the underlying problem of sharing personal data was circumvented through a non-technical modification of the authorisation requirements of a business process. In other words, the invention did not provide a technical solution to the underlying technical problem but rather circumvented the technical problem through changes to the business process. This was not sufficient to avoid the excluded subject-matter restrictions.

The application was refused under the excluded subject-matter restrictions as relating to a method for doing business and a program for a computer.

Conclusion

When drafting a patent application, care must be taken to describe the invention in a way which focuses on the patentable aspects of the invention and minimizes the risk of the application being refused for excluded subject matter.

Author:
Simon Schofield



Registration of transfers of rights and licences at the EPO Electronic signatures and entitlement to sign

A number of changes have come into effect in relation to the registration of transfers of rights and licences at the EPO. This article sets out two of the significant changes.

Use of electronic signatures

To record a transfer of ownership of a European patent or European patent application before the European Patent Office (EPO) a written document (such as an assignment) must be filed in order to evidence the transfer. The assignment document must be signed by all parties, that is, the assignor(s) and assignee(s). In recent years there have been a number of changes relating to the form of the signature on the assignment document.

2022: EPO accepts qualified electronic signatures on assignment documents

As reported in our May 2022 article, "Recording assignments with electronic signatures at the EPO", following a Notice from the EPO published in Official Journal 2021, A86 on 22 October 2021, the EPO for a brief time additionally accepted some very specific forms of electronic signature. Specifically, for the purposes of recording a transfer of ownership, the EPO accepted assignment documents that had been signed using a qualified electronic signature as defined in EU Regulation No 910/2014 (also known as the eIDAS regulation). This regulation required a very particular form of qualified digital certificate to be used that was backed by a supervisory governmental body in the EU. Given these strict requirements, most of our clients continued to have assignment documents executed with handwritten signatures when recording transfers at the EPO.

Related article

"Recording assignments with electronic signatures at the EPO", published 05 May 2022:

[dycip.com/electronic-signatures-may2022](https://www.dycip.com/electronic-signatures-may2022)

2023: EPO stops electronic signatures on assignment documents

As discussed in our October 2023 article,

"J 0005/23: EPO stops use of electronic signatures on assignment documents", a decision from the Legal Board of Appeal (J 0005/23) on 04 September 2023 further slowed the increase in use of electronic signatures at the EPO. The decision of the Board of Appeal found that "signature" in the sense of the laws governing the requirements of an assignment means a handwritten signature or mark.

Related article

"J 0005/23: EPO stops use of electronic signatures on assignment documents", published 02 October 2023:

[dycip.com/j0005-23-electronic-signatures](https://www.dycip.com/j0005-23-electronic-signatures)

2024: EPO enables electronic signatures from 01 April 2024

A further development came to light on 29 February 2024. On the news section of the EPO website, an announcement was made with respect to changes regarding transfers and licences due to come into effect from 01 April 2024. In this announcement it was reported that the use of electronic signatures will be enabled. The new concept will be applicable for the registration of transfers of rights and licences for European patent and unitary patent (UP) procedures. The EPO indicated that a broad range of signatures will be accepted. Specifically, contracts and declarations submitted as evidence to support requests for the registration of a transfer of rights and requests for the registration or cancellation of the registration of licences or other rights may be authenticated by:

1. a handwritten signature
2. a facsimile signature
3. a text string signature
4. a digital signature under the conditions specified by the EPO

A facsimile signature is an image reproduction of the handwritten signature and a text string signature is a string of characters between two forward slashes, for example: /D Young/. Regarding the digital signature, the EPO has

Useful link

EPO website news release, 29 February 2024, "Transfers and licences: changes from 1 April 2024": [dycip.com/epo-electronic-signatures-apr2024](https://www.dycip.com/epo-electronic-signatures-apr2024)

Related articles

"Recording assignments with electronic signatures at the EPO": [dycip.com/electronic-signatures-may2022](https://www.dycip.com/electronic-signatures-may2022)

"J 0005/23: EPO stops use of electronic signatures on assignment documents": [dycip.com/j0005-23-electronic-signatures](https://www.dycip.com/j0005-23-electronic-signatures)

relaxed the rules on these. Specifically, the EPO will accept digital signatures that use public key infrastructure (PKI) technology, including advanced and qualified electronic signatures within the meaning of the EU's eIDAS Regulation. It will also accept digital signatures that do not use PKI technology if they are filed electronically, are legible, are not infected with a computer virus and do not contain other malicious software.

This development marks an important milestone in the digitalisation and simplification of procedures at the EPO.

Entitlement to sign

In the past the EPO has been very strict with regard to a signatory on an assignment's entitlement to sign the assignment on behalf of the assignor or assignee. It has not been uncommon for the EPO to request documentary evidence of the signatory's authority to sign. This has been seen whenever the signatory was not listed as, for example, a director, president or CEO of the company.

A further development which was published on the EPO website on 29 February 2024 was in relation to a further simplification of the authority to sign requirements relating to the registration of transfers of rights and licences. Specifically, the EPO has changed its practice regarding examination of an individual's entitlement to sign on behalf of a company. Where a person is entitled to sign by virtue of their position within the company, this position still needs to be indicated. However, the EPO will no longer check the entitlement. Therefore, it is now down to the assignor(s) and assignee(s) to determine which parties are entitled to sign on behalf of the company, rather than this being assessed by the EPO based on the signatory's title and whether it was one of a few select titles deemed allowable by the EPO.

This development is likely to further improve the efficiency of processes relating to the registration of transfers of rights and licences.

Author:

Alice Stuart-Grumbar



I spy with my little eye... How to invalidate your own design!

Case details at a glance

Jurisdiction: European Union

Decision level: General Court

Parties: Puma SE v EUIPO

Citation: T 647/22

Date: 06 March 2024

Decision: dycip.com/puma-v-euipo

In its decision of 06 March 2024 the General Court confirmed the invalidity of Puma's design for the "Fenty x Puma Creeper" model due to prior disclosure by Rihanna.

Background

"Fenty x Puma" is a collaboration with the singer Robyn Rihanna Fenty (Rihanna). Rihanna partnered with Puma in 2014 as a creative director and brand ambassador. In September 2015 Puma launched the first Fenty x Puma collection, including its "Creeper" model (Fenty Creeper). Looking back at shoe styles, the crepe sole dates back to the years following World War II, but the combination with a sneaker upper (at least) appeared to be a novelty. The Fenty Creeper soon became an "it sneaker".

Designs for this model were filed in July 2016. In the EU, designs were filed for the sole standalone (registered Community design number 003320555-0001) and for the shoe model as a whole (registered Community design number 003320555-0002).

Given the popularity of the Fenty Creeper knock-offs were inevitably to follow, and Puma heavily enforced its designs.

In 2019 a third party filed invalidity actions against these registered community designs (RCDs). Interestingly enough, Puma withdrew its appeal to the Board of Appeal in relation to the sole design. The design has been declared invalid. However, the proceedings

against the RCD for the entire shoe went to the General Court after the Board of Appeal confirmed the invalidity of the design.

Decision

The General Court then confirmed that the design is in fact invalid for lack of novelty and individual character.

The reason for this was that the invalidity applicant was able to dig up Instagram posts and articles showing Rihanna wearing the Fenty Creeper model in 2014.

Puma tried to argue that:

- the images were not detailed enough to make out any of the features of the attacked RCD; and
- with regard to one photo taken from "hausofrihanna.com", the photo would be of questionable origin, could have been added to site at a later date, and it could not reasonably have become known in the normal course of business to the circles specialised in the sector concerned.

However, the General Court confirmed that the design had already been disclosed by the posts and articles in 2014. With regard to this, the General Court highlighted that Rihanna was a world-famous pop star in 2014. Therefore, her fans and those who specialised in the fashion sector "had developed a particular interest in the shoes that she wore on the day on which the

contract under which the star became the applicant's creative director was signed. It is perfectly reasonable to take the view that in December 2014 a not insignificant proportion of people who were interested in music, or in Rihanna and her clothing, viewed the photos closely to identify the shoes that the star wore, thus recognising the features of the prior design" (see paragraph 53 of the decision).

Outlook

Given the high threshold for an appeal to the Court of Justice of the European Union (CJEU) it is unlikely that Puma will be able to appeal. Therefore, this decision will likely put a damper on Puma's enforcement campaign, at least on the basis of any registered Community designs. On the other hand, at least in Germany, Puma may still try to rely on unfair competition claims. As the territorial scope of such claims is limited to Germany, it will certainly be more cumbersome than pan-EU enforcement based on an RCD.

Author:

Yvonne Stone



In short

Overall, the decision serves as a reminder to get designs filed as soon as possible, ideally before any disclosure to the public. Aside from that, instilling this awareness in any collaborators (for example, Rihanna) may certainly have gone a long way. After all, Rihanna was wearing the shoes in public before their official launch in September 2015. With the designs having been filed in July 2016, this was a long while before Puma's legal department was able to act or at least realise that designs would facilitate enforcement against any knock-offs.

Puma's design was declared invalid by the GC due to prior disclosure by Rihanna



D YOUNG & CO INTELLECTUAL PROPERTY

And finally...

Webinars

Biotech & techbio webinars Upcoming and on demand



European biotech patent case law & Lexology techbio masterclass webinars

European biotech patent case law

You can catch up on our most recent webinar and access a recording at a time convenient to you at dycip.com/biotech-patent-feb2024. Simon O'Brien and Tom Pagdin discuss:

- T 2036/21: Standard for credible effect/free evaluation of evidence
- T 1989/19: Allowability of post-published data to support inventive step
- T 0835/21: Enablement of functionally defined antibody claims

Our next biotech webinar will run on 25 June 2024, presented by Simon O'Brien and Nathaniel Wand. Registration is now open.

European biotech patent case law
9am, 12pm & 5pm, 25 June 2024
dycip.com/webinar-bio-jun244

Lexology techbio masterclass

Rapid growth in the use of AI-derived data in biotech innovation in recent years has been remarkable. When it comes to obtaining patent protection, should we now focus on AI-derived data or does a successful patent application in this field still hinge on the inclusion of traditional wet-lab data? Robbie Berryman and Jennifer O'Farrell discussed strategies for the effective use of AI-derived data in patent applications and questioned where and how wet-lab data fits into this process. Key topics included plausibility, inventive step and the roles and risks of negative evidence.

Techbio patents: maximising the impact of wet-lab and AI data
On demand
dycip.com/lexology-techbio-patents

Contact details

London
Munich
Southampton

T +44 (0)20 7269 8550
F +44 (0)20 7269 8555

mail@dyoung.com
www.dyoung.com

Email subscriptions@dyoung.com to update your mailing preferences or to unsubscribe from this newsletter. Our privacy policy is available at www.dyoung.com/privacy.

This newsletter is intended as general information only and is not legal or other professional advice. This newsletter does not take into account individual circumstances and may not reflect recent changes in the law. For advice in relation to any specific situation, please contact your usual D Young & Co advisor.

D Young & Co LLP is a limited liability partnership and is registered in England and Wales with registered number OC352154. A list of members of the LLP can be viewed at our registered office. Our registered office is at 3 Noble Street, London, EC2V 7BQ.

Copyright 2024. D Young & Co LLP. All rights reserved. 'D Young & Co', 'D Young & Co Intellectual Property' and the D Young & Co logo are registered trade marks of D Young & Co LLP.

Contributors

Partner, Patent Attorney
Editor
Nicholas Malden
nmm@dyoung.com
www.dyoung.com/nicholasmalden



Partner, Patent Attorney
Rachel Bateman
reb@dyoung.com
www.dyoung.com/rachelbateman



Partner, Patent Attorney
Andrew Cockerell
azc@dyoung.com
www.dyoung.com/andrewcockerell



Associate, Patent Attorney
Khalil Davis
kxd@dyoung.com
www.dyoung.com/khalildavis



Senior Associate, Patent Attorney
Laura Jennings
lej@dyoung.com
www.dyoung.com/laurajennings



Partner, Patent Attorney
Cathrine McGowan
cmg@dyoung.com
www.dyoung.com/cathrinemcgowan



Associate, Patent Attorney
Simon Schofield
sxs@dyoung.com
www.dyoung.com/simonschofield



Partner, Rechtsanwältin
Yvonne Stone
yvs@dyoung.com
www.dyoung.com/yvonnestone



Senior Associate, Patent Attorney
Alice Stuart-Grumbar
asg@dyoung.com
www.dyoung.com/alicestuartgrumbar

