

# D YOUNG & CO

## PATENT

### NEWSLETTER *no.93*

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[In this issue:](#)

**Lufthansa v Astronics** 04

[Reference signs and claim interpretation](#)

**German Federal Constitutional Court** 05

[Complaints regarding the EPO inadmissible](#)

**Disclosing an invention before filing a patent application** 06

[Why a non-disclosure agreement in Germany is not enough](#)

**UP & UPC** 09

[Major milestones remain unchanged](#)

**Webinar invitation** 10

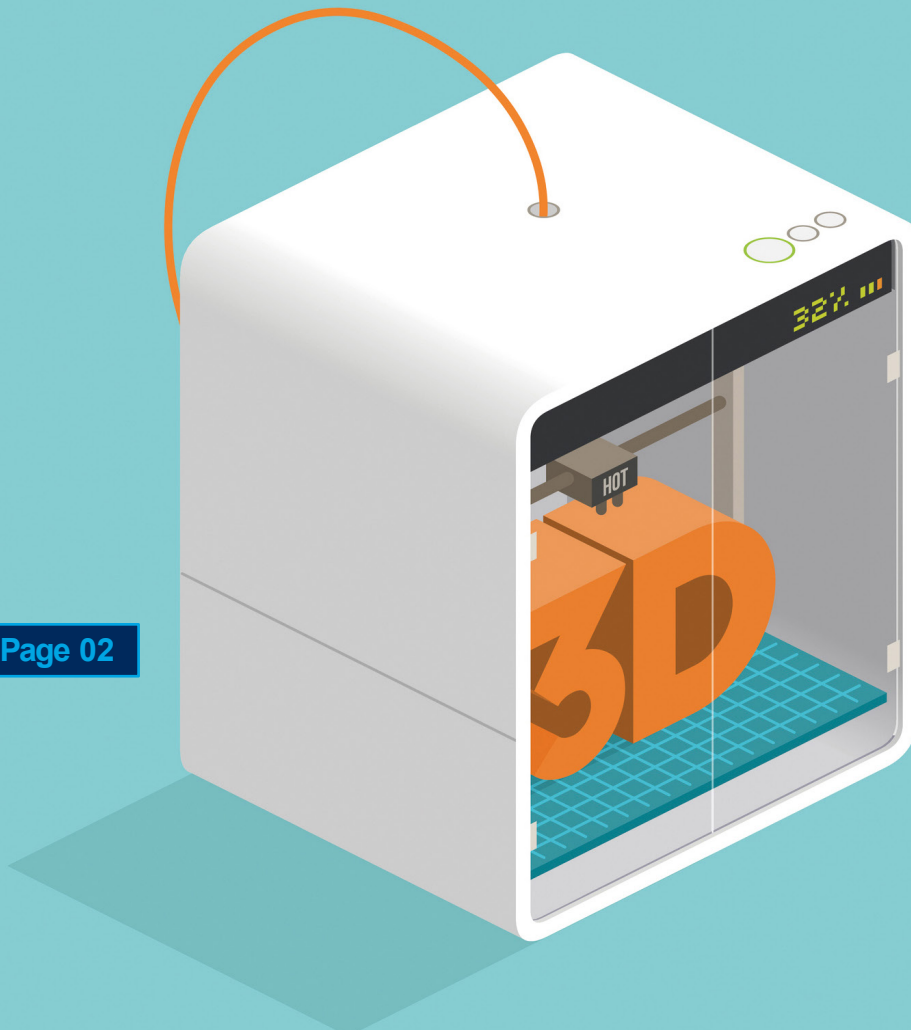
[European biotech patent case law](#)

Also: proposed reforms to EU design registrations, new DPMA President Eva Schewior & USPTO fee reductions for smaller-sized applicants.

## How can I patent products made by 3D printing?

### Challenges posed by latest EPO guidance on additive manufacture

Full Story [Page 02](#)





Welcome to the latest edition of our newsletter. The start to the year has been exciting in that we are all beginning to meet our clients, friends and overseas contacts for the first time in a number of years. Our patent teams look forward to visiting and receiving contacts and clients in our London, Munich and Southampton offices. Readers will notice a growing number of articles relating to German law developments from our team in Munich. The Munich office continues to grow and offers our clients support with complex German legal issues. If you find yourself in Munich, please do come and visit us!

Our website continues to include up-to-date information on developments in the UP and UPC. If you have any questions please contact your usual D Young & Co attorneys.

**Anthony Albutt, Editor**

## Events



### European biotech patent case law

**21 February 2023, webinar**

Partners Simon O'Brien and Tom Pagdin present our popular European biotech patent case law webinar at 9am, noon and 5pm. Registration now open to reserve your webinar seat.

### Open-source software & patents: protecting your clients & their innovations

**9am-11am, 24 May 2023, webinar**

Partners Alan Boyd and Anton Baker present this MBL (Management, Business, Law) "Learn Live" online event.

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## 3D printing

# How can I patent products made by 3D printing?

## Challenges posed by latest EPO guidance on additive manufacture

**R**ecent years have seen rapid growth in the use of additive manufacturing, also known as 3D printing. Additive manufacture can help to enable intricate design geometries which would not be feasible using traditional manufacturing techniques, allow bespoke parts to be created on-site based on scanning of requirements (for example, dental implants made based on a scanning of moulds taken from a patient), and reduce distribution costs by transmitting the product electronically as a 3D model, rather than shipping a physical product.

This last point may create challenges for those who are seeking protection for their innovations.

**Although other forms of intellectual property can also be considered in some cases, if the innovation is based on a technical principle which could be implemented in a variety of designs with different visual appearances, patents may be the most useful form of IP right.**

### A practical example

Assume that an innovator is able to obtain a valid patent that includes a product claim that defines the functional or physical characteristics of a 3D-printable product. This innovator wishes to use the patent to prevent loss of income due to their potential customer's 3D printing a product based on a design supplied electronically by a competitor, instead of buying from the innovator.

If the customer is doing the 3D printing in a country covered by the patent, then the customer is arguably the manufacturer who infringes the patent. However, the innovator may be reluctant to pursue their own potential customers for patent infringement, and there may be a prohibitively large number of customers to pursue. It may be more efficient

for the innovator to target the acts done by the competitor, rather than the customers.

It could be argued that the competitor has directly infringed the product claim by supplying a patented product to the customer. However, there may be uncertainty over whether a court would rule that an electronic representation of the product is covered by a claim to an apparatus having certain functional or physical features. Another argument could be that the competitor jointly infringes the patent with the customer because they procured the act of infringement by the customer who manufactured the patented product, but this would bring the customer into the dispute. Also, it could be argued that the competitor indirectly infringes the product claim by supplying, as "means relating to an essential element of the invention", the electronic file defining the 3D geometry of the product, knowing that the customer intends to use it to manufacture the product. However, indirect infringement can be harder to prove than direct infringement, and may require that both the competitor and customer are in the same country or other territory covered by a single patent.

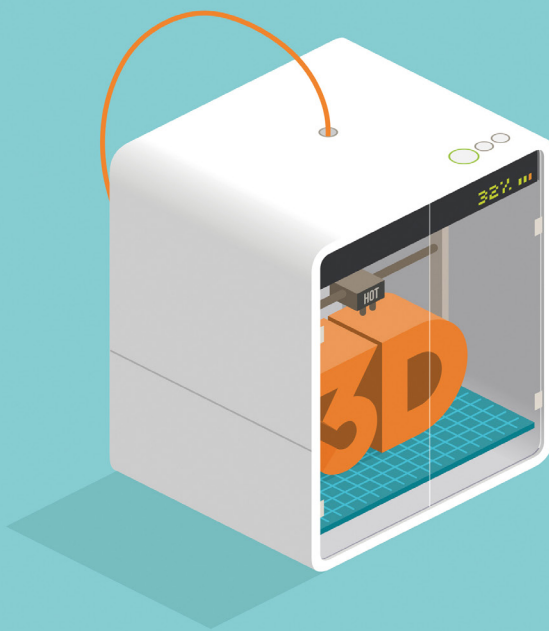
What if the competitor is in a country covered by the patent, but the customer is not? The above lines of argument would be unlikely to help in that case. To deal with this scenario, it can be useful to include in the patent a claim defining a data structure providing a digital representation of the product. This could allow you to argue that, as the patented "product" is the data structure rather than the physical product, the competitor directly infringes by "manufacturing" the claimed data structure when they create the computer-aided-design (CAD) model of the product.

However, D Young & Co's experience has been that there can be considerable divergence in how patent examiners handle such claims to a digital representation of the product. We have seen similar claim wording accepted by one examiner but rejected by another at the same patent office.

### EPO Guidelines for Examination

In the most recent update of its Guidelines

## Strategies for obtaining effective patent protection for 3D printable products



example, slicing the 3D model to generate a series of 2D layers, and mapping each layer of the sliced model to the instructions for controlling the 3D printer to lay down material for each layer) may take place at the 3D printer itself. Therefore, the EPO's example claim might still leave some scope for a competitor in a patented territory who creates and supplies a 3D model file to a customer outside the territory to argue they do not infringe because they do not provide instructions for controlling an AM device.

### Strategies for patent protection

So what should be done to increase the chances of gaining effective patent protection for a 3D printable product? Although there is some uncertainty in this area this is not a reason not to pursue patent protection at all. It may be better to have an intellectual property right which creates uncertainty for your competitors than to have no such right at all. Also, the patent may still have value in protecting against infringement based on the product being manufactured by traditional subtractive manufacturing techniques.

for Examination the European Patent Office (EPO) has clarified the extent to which claims to a digital representation of the geometry of an object are patentable. On the one hand the new guidance is helpful in confirming that protection is available for such claims, contrary to the position of some examiners who argue that such claims can never be allowed.

However, the EPO has caveated its guidance by stating that, for a computer-readable medium storing data representing the geometry of a 3D printable device to be patentable, it would be required that the data "defines the instructions for operating the AM [additive manufacturing] device". The EPO's reasoning is that it has been established in case law that abstract descriptions or models are not considered technical, even if the entity described by that model is technical, so something more is needed to provide the "technical effect" required for patentability. The EPO's position is that if the claim encompasses data which only defines a digital description or 3D model

of the product, but the claimed data is not defined as specifically adapted to additive manufacturing of the product, that data could be used to merely visualise the product in a CAD software tool, which is considered not to be a technical use of the data.

### Example EPO claim wording

Therefore, the EPO's recommended example claim wording is: "A computer-readable medium storing data which defines both a digital representation of the product of claim 1 and operating instructions adapted to control an AM device to fabricate the product using the digital representation of the product when said data is relayed to the AM device".

This guidance is perhaps unhelpful to innovators of 3D-printable products, because the file which is transmitted electronically to the customer may be in a format such as STL or OBJ, which merely defines a general 3D model indicating the product geometry, but does not comprise specific instructions for a 3D printer. In practice, the actions for creating such 3D printer instructions (for

However, to increase the options, our practical advice is to include in the patent both a conventional product claim, defining the product in terms of its physical features, and a claim to a digital representation of the product which is filed initially **without** specifying the operating instructions adapted to control an additive manufacturing device. Also include (either as a further dependent claim or in the description of the patent), basis for restricting the digital representation claim to being adapted for control of an additive manufacturing device. By filing the broader wording of the product claim initially, this can give wider options in case patent offices in some countries are less strict than the EPO or the case law changes in future. However, including the fallback option means you can retreat if necessary. In any case, including the digital representation claim widens the options for arguing for infringement compared to a patent including only the product claim itself.

**Author:**  
**Robbie Berryman**



# Lufthansa v Astronics

## Reference signs and claim interpretation

As patent professionals know, the description and claims of a patent achieve different things. The claims legally define the invention that is protected. The description gives example “embodiments” of the invention. However, they are also linked. In particular, according to Article 69 EPC, the associated protocol and established UK case law, the description may be used to interpret the claims.

### Reference signs

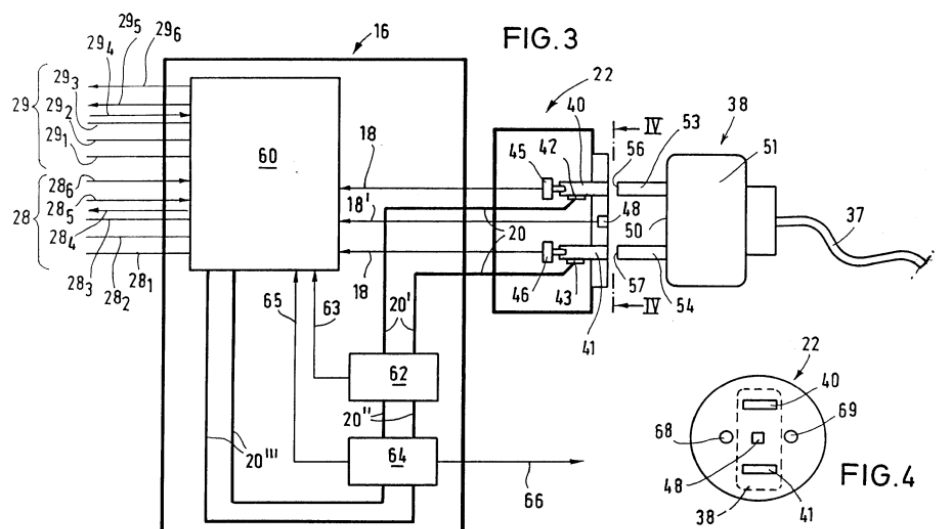
An additional consideration for UK designations of European patents arises from Rule 43(7) EPC which says that reference signs of drawings of a patent application shall preferably be included in a claim if they increase the claim’s “intelligibility”. This rule explicitly says that such reference signs “shall not be construed as limiting the claim”. This is supported by UK case law, which finds that reference signs “...help a real reader ... see where in the specific embodiment a particular claim element is...” but that the claim “...must be construed as if the numbers were not part of it”.

But how is this achieved in practice? Once a reader has seen a reference sign in a claim and seen that same reference sign in a drawing of an embodiment, is it possible to construe the claim without (perhaps unconsciously) imparting limiting characteristics of that embodiment onto the claim?

### The case

This issue was raised by the appellants (Astronics & Ors) in this case who contested the first instance decision (which found the respondent’s patent to be valid and infringed), on the basis that, among other things, the first instance judge had erred by taking reference signs into account when construing claim 1.

The patent related to the safe provision of electrical power to an electronic device (for example, a laptop) in an aircraft. Claim 1 defined a voltage supply apparatus, comprising a socket connectable to the device via a plug and a supply device for applying a supply voltage to the socket.



A plug detector detects two contact pins of a plug inserted in the socket and the supply voltage is applied only if the two contact pins are detected simultaneously. Figures 3 and 4 of the patent (shown above) showed an embodiment of the apparatus.

The validity of claim 1 depended, in part, on interpretation of the word “inserted”. At first instance, the judge agreed with the patentee that this meant “fully inserted”. On the other hand, the appellants argued this meant “partially inserted”.

The appellants took issue with the first instance judge’s use of the reference signs 45 and 46 (for the “plug detector”) and 53 and 54 (for the “contact pins”), which were included in claim 1, in determining that “fully inserted” was the correct construction. In particular, the appellant argued that the judge’s consideration of the reference signs 45, 46 and 53, 54 in determining that the plug detectors must at the “bottom of the holes” which receive the contact pins and that the contact pins must “make contact” with the detectors for detection to occur amounted to “[taking] the reference numerals into account.”

LJ Birss disagreed with the appellants. He concluded that the first instance judge had used the reference signs for “orientating himself” but that the actual first instance

### Case details at a glance

Jurisdiction: England & Wales

Decision level: Court of Appeal

Date: 14 January 2022

Citation: [2022] EWCA Civ 20

Decision: [dycip.com/LufthansavAstronics](https://dycip.com/LufthansavAstronics)

### Useful links

- Article 69 EPC: [dycip.com/Article69EPC](https://dycip.com/Article69EPC)
- Protocol on the Interpretation of Article 69 EPC: [dycip.com/interpretationArticle69](https://dycip.com/interpretationArticle69)
- UK Supreme Court judgment, 12 July 2017: [dycip.com/UKsupremecourtjudgement](https://dycip.com/UKsupremecourtjudgement)
- Rule 43(7) EPC: [dycip.com/rule437EPC](https://dycip.com/rule437EPC)
- England & Wales Court of Appeal (Civil Division) decision: EWCA Civ 1062: [dycip.com/courttofofappeal1062](https://dycip.com/courttofofappeal1062)

interpretation of claim 1 “starts and ends with the claim language itself”. LJ Birss further concluded that “there is nothing wrong with using the reference numerals to describe how the claim works by reference to the figure”. It was therefore decided that the interpretation of “inserted” as “fully inserted” had been arrived at correctly.

### Our thoughts on this decision

Would the judge have come to the same conclusion on construction if the reference signs 45, 46 and 53, 54 had not been included in the claims? For example, might the claim construction have been broader if only reference signs to a more “general” embodiment had been included in the claims? Might the inclusion of reference signs have been avoided altogether by showing they were unlikely to increase the “intelligibility” of the claim according to Rule 43(7) EPC?

It’s difficult to say in hindsight. However, putting aside the fact that a narrower claim construction actually helped the patentee in this particular case (for reasons of validity), it is perhaps something worth thinking about when being asked to add reference signs to claims by EPO examiners, and when wanting to maintain a broad claim scope.

Author:  
Arun Roy





# German Federal Constitutional Court Complaints regarding the EPO inadmissible

## Useful links

- BVerfG press release 12 January 2023: [dycip.com/bvg-news-12jan23](https://dycip.com/bvg-news-12jan23)
- Decision of the Second Senate of 08 November 2022: [dycip.com/decision-8nov22](https://dycip.com/decision-8nov22)
- BVerfG decision 2 BvR 2368/99: [dycip.com/2BvR2368-99](https://dycip.com/2BvR2368-99)
- BVerfG press release 09 July 2021: [dycip.com/bvg-news-9jul21](https://dycip.com/bvg-news-9jul21)
- BVerfG decisions 2 BvR 2216/20 and 2 BvR 2217/20: [dycip.com/2BvR2216-20](https://dycip.com/2BvR2216-20)
- BVerfG decision 2 BvR 739/17: [dycip.com/2BvR739-17](https://dycip.com/2BvR739-17)

In a joint decision of 08 November 2022, published on 12 January 2023, the Second Senate of the German Federal Constitutional Court (Bundesverfassungsgericht - BVerfG) dismissed five constitutional complaints challenging decisions of the Technical Boards of Appeal and the Enlarged Board of Appeal of the European Patent Office (EPO) as inadmissible.

In the five complaints (one of which dated back to 2010) several complainants, domiciled in Germany, member states of the European Union (EU), and in third countries, asserted that the challenged Technical and Enlarged Board of Appeal decisions were based on general and manifest deficiencies in the available legal protection and violated procedural fundamental rights. These included the principle of a fair trial (Art. 2(1), in conjunction with Art. 20(3) GG), the right to one's lawful judge (Art. 101(1), 2nd sentence GG), and the right to be heard (Art. 103(1) GG), laid down in the Basic Law (Grundgesetz, GG).

The court held that the complainants domiciled in third countries cannot invoke fundamental rights of the Basic Law (Art. 19(3) GG), and, moreover, that none of the complaints were directed at violations of these procedural fundamental rights by German courts within the meaning of Arts 92 ff. GG (Arts 101(1), 2nd sentence and 103(1) GG).

The court held that, according to the established case law of the court, acts of institutions, bodies, offices and agencies of the EU cannot be directly challenged by means of a constitutional complaint. They may however be reviewed by the court if a claim can be made that such acts exceed the scope of the EU's integration agenda (Integrationsprogramm), and affect the minimum standard of fundamental rights protection that the legislator is obliged to guarantee also with regard to the EU, and that German constitutional organs are required to take steps against such acts due to their responsibility with regard to European integration

## The senate dismissed five constitutional complaints



(Integrationsverantwortung). Note that the European Patent Office (EPO) is not an institution, body, office or agency of the EU.)

Furthermore, the court held that the complainants entitled to lodge constitutional complaints (the complainants not domiciled in third countries) did not sufficiently substantiate their claim that the appeal system within the European Patent Organisation (EPOrg) fails to provide the minimum standard of effective legal protection required under Art. 19(4) GG, and that the German constitutional organs are therefore obliged to take steps to respond.

Finally, the court found that, in any case, the structural reform of the Boards of Appeal, that came into force on 01 July 2016, separated administrative and judicial tasks and granted judicial functions performed by the Boards of Appeal a high degree of institutional autonomy. Consequently, the court held that any shortcomings that may have existed, but that were not dealt with in any details by the complainants, were essentially rectified, at least to the extent that they now fulfil the minimum standard.

The court helps to ensure respect for and to give effect to Germany's free democratic basic order, in particular to the enforcement of fundamental rights

provided by the Basic Law. All (German) bodies exercising public authority are obliged to observe the Basic Law.

The present decision does not really come as a surprise, because not even the acts of institutions, bodies, offices and agencies of the EU can be directly challenged by means of a constitutional complaint. The court's sole standard of review is the Basic Law, and its course, manifested by recent decisions, underlines Germany's commitment to the European patent system founded in 1973, and the new Unified Patent Court (UPC) currently expected to open on 01 June 2023.

## Author:

Hanns-Juergen Grosse



## UP & UPC information

As preparations for the introduction of a unitary patent (UP) and launch of the Unified Patent Court (UPC) continue our library of UP & UPC updates, guides and webinars can be accessed at [www.dyoung.com/upandupc](https://www.dyoung.com/upandupc).



Readers may find our UPC Opt-Out FAQ of particular interest at this time: [www.dyoung.com/faq-opt-out](https://www.dyoung.com/faq-opt-out).

# Disclosing an invention before filing a patent application

## Why a non-disclosure agreement in Germany is not enough

**F**or start-ups, there is often a need to communicate an invention to potential business partners before a corresponding patent application is filed.

Most applicants are aware that only new subject matter is patentable and therefore will require the execution of a non-disclosure agreement (NDA) before the invention is communicated. However, due to German legal provisions regarding prior use, an NDA does not automatically overcome all problems connected with the communication of the invention before the filing of a patent application.

The concept of prior use rights as an infringement defence can be regarded as reflecting the general principle that an infringer using an invention before the applicant has filed a patent application for this invention should not be punished, because the infringer has made the invention earlier than the applicant.

Obviously, this principle should not apply if a patent infringer obtained their knowledge of the invention from the inventor themselves, and this situation is dealt with differently by different regulations in different jurisdictions. For example, the 35 U.S. Code § 273 (e)(2) denies the assertion of a right of prior use derived from the patentee, or from persons in privity with the patentee. In

An NDA does not automatically overcome problems with communicating the invention



contrast, Section 12 of the German Patent Act allows the assertion of such a right of prior use under certain conditions.

Referring to the above example, consider a situation in which the start-up obtained a patent for the communicated invention and a former potential business partner, to whom the start-up has communicated the invention

under an NDA before filing a corresponding patent application, infringes the patent.

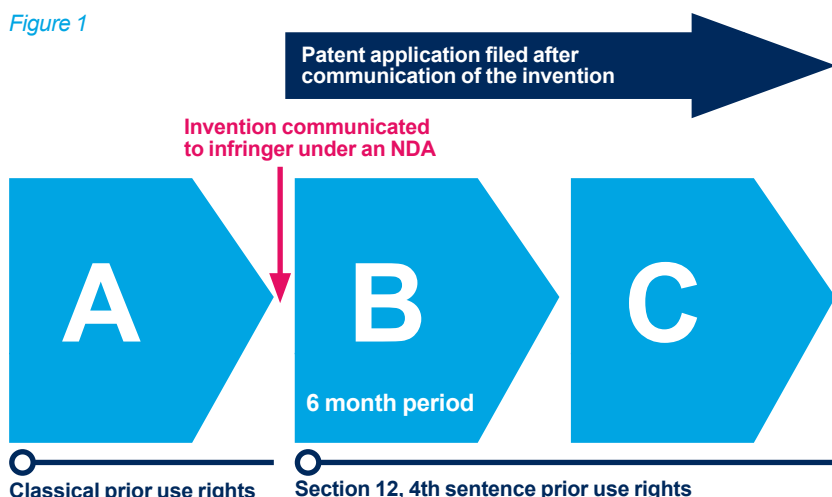
We will now discuss the question of whether such an infringer can apply a defence based on a prior use right in Germany in this case for some typical circumstances, with reference to figure 1 shown below left.

For the sake of simplicity, it is assumed that the start-up files a German patent application and that no priority has been claimed.

In the event that the infringer has put the now patented invention into practice (time period A) before the communication of the invention, and before the start-up has filed the patent application, a defence based on a prior use right is applicable in Germany.

In the event that the infringer has put the now patented invention into practice after the invention has been communicated, and did so as a result of the communication of the invention (time periods B and C), whether a defence based on a prior use right is applicable in Germany or not

Figure 1



# Welcoming Eva Schewior New President of the DPMA

**O**n 01 February 2023 Eva Schewior succeeded Cornelia Rudloff-Schäffer as President of the German Patent and Trademark Office (DPMA).

The DPMA was founded over 145 years ago, as the Kaiserliches Patentamt (Imperial Patent Office) in Berlin on 01 July 1877, and is the largest national IP office in Europe, and fifth largest national IP office in the world.

Eva Schewior worked in the Federal Ministry of Justice (BMJ) from 1994-2023 in several positions including delegation to the Permanent Mission to the European Union (EU) in Brussels. In 2004 she was appointed Head of Division for Administrative Matters of the DPMA, the Federal Patent Court and the European Patent Organisation. More recently she was Head of the Civil Law Division. Her duties included aspects of consumer protection as well as European contract law and international legal harmonisation in these areas, and the implementation of the Mortgage Credit Directive, Payment Accounts Directive and Payment Services Directive II into German law.

Eva Schewior succeeds Cornelia Rudloff-Schäffer, President of the DPMA from 2009 to 2023, and notably the first female in this role. Cornelia Rudloff-Schäffer set work-life balance as a strategic goal of the office and the DPMA is, according to Germany's women's magazine Brigitte, repeatedly one of the best employers for women. A renown expert in the field of IP protection and co-author of the standard legal commentary "Schulte, Patentgesetz mit EPÜ" among other titles, Cornelia Rudloff-Schäffer is to be thanked for more than three decades of academic, legislative and administrative work.

The DPMA is a higher federal authority operating within the portfolio of the Federal Ministry of Justice, and has almost 2,800 members of staff at offices in Munich, Jena and Berlin, examining inventions, granting patents, registering trade marks, utility models and designs, administering IP rights, and providing IP information to the public.

**Author:**  
**Hanns-Juergen Grosse**



depends on the actions of the start-up.

In order to avoid a prior use right for the infringer from arising, it is necessary that the start-up had reserved its rights in the event of the patent being granted. Ideally, this is declared immediately before the invention is communicated to the infringer. The importance of this declaration cannot be overestimated. In the absence of a reservation of such rights in the event of the patent being granted, it is often assumed in case law that a right of prior use has arisen through acts of use (BGH 07.01.1965, Ia ZR 151/63, "Lacktränkeinrichtung"), making a defence based on a prior use right applicable in Germany.

For the following situations, it is assumed that the start-up has declared the reservation of its rights in the event of the patent being granted immediately before the invention was communicated.

A first important situation is when the start-up files the patent application within a six-month period after the communication of the invention (time period B), and the infringer puts the invention into practice as a result of the communication of the invention in the time period between the communication of the invention and the filing of the patent application. In this first situation, Section 12(1), 4th sentence of the German Patent Act precludes a defence based on a prior use right in Germany.

A second important situation is when the start-up files the patent application later than six months after the communication of the invention (time period C) and the infringer puts the now patented invention into practice as a result of the communication of the invention within time period C and before the filing of the patent application.

To avoid a prior use right of the infringer from arising in the second situation the detail of communication of the start-up with the infringer is critical. The start-up needs to ensure that the infringer could not have considered themselves authorised to use the teaching of the invention for their own

purposes, and thus ensure that the infringer did not acquire the invention in good faith. Ideally, in order to do so, the start-up has explicitly declared before communicating the invention under an NDA that they do not agree to the use of the invention.

In practice, the details of each individual case will have to be considered, and there will be circumstances beyond the highly simplified situations we have discussed which will allow a successful defence based on a prior use right derived from the applicant in Germany.

As a further point, it is worth noting that the German legal provisions regarding prior use will be effective even when applied to unitary patent infringement proceedings before the Unified Patent Court, since Art. 28 UPCA refers to the national definition of, and approach to, prior use rights.

**Author:**  
**Mathias Smolarski**



## In short

An awareness that the German Patent Act provides for the existence of a right of prior use derived from the applicant or their legal predecessor is vital, especially for start-ups.

Nevertheless, if the case law and the legal provisions of the German Patent Act are carefully considered when the invention is communicated to a potential business partner, and before a patent application is filed, it can be avoided that the business partner obtains a right of prior use.



# EU design system

## Proposed reforms to EU design registrations

In what is welcome news, the European Commission has put forward a number of beneficial proposals for reforming the design registration landscape within the EU. This follows some consultations undertaken over the past couple of years.

A number of changes have been proposed that are in favour of current or future owners of design registrations in the EU. The most notable of these proposed changes include:

### Removal of the unity of class requirement for multiple designs in a registered design application

If adopted, this change would allow a single registered design application in the EU to contain multiple designs in **any** combination of Locarno Classifications.

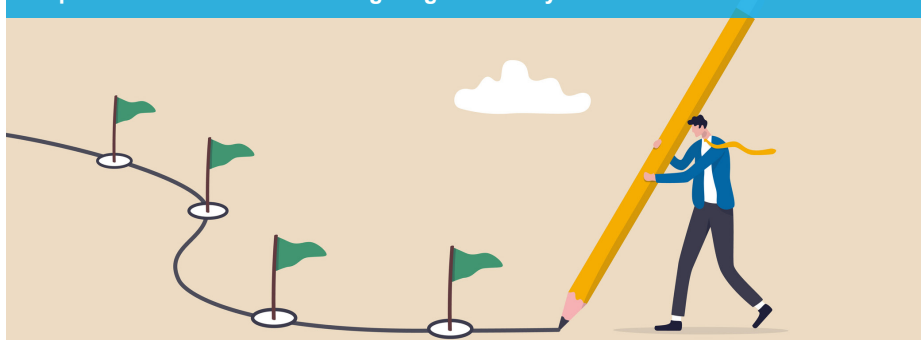
This change would then mean that designs respectively directed to, for example, a mobile phone in Locarno Classification 14; a mobile phone cover in Locarno Classification 03; and a logo in Locarno Classification 32, could then all be pursued in a single registered design application in the EU, whereas currently this would require three separate registered design applications.

### Reduction in design registration official fees

The proposal also includes a number of options to lower the official fees which would be payable to secure an EU design registration.

Specifically, and for an EU design registration application where no deferred publication is requested, a comparison between the current official fees, and the least-generous proposed reduced official fees from the proposal, are shown in the table below.

### Proposed reforms to the EU design registration system



### © symbol for design registrations in the EU

The proposal also allows for the usage of a © symbol (a "D" in a circle) to indicate the presence of an EU design registration. This would harmonise the position with EU trade marks, where it is already possible – but not mandatory – to indicate the presence of such a trade mark using an ® symbol (an "R" in a circle).

### Broadening the scope of what is protectable under a design registration

The current legislation allows for the protection of the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture, and/or materials of the product itself and/or its ornamentation (surface decoration). This definition is proposed to be broadened to also include "the movement, transition or any other sort of animation of those features".

Tying in with this, also proposed is a broadening of the term "product", as used above to mean any industrial or handicraft item, "regardless of whether it is embodied in a physical object or materialises in a digital form".

Collectively therefore, these changes

might better allow for the protection of digital designs, and potentially also those intended for application in other virtual settings, such as the metaverse.

### Broadening the rights conferred by an EU design registration

The proposal also provides that an EU design registration may be additionally used to prevent a third party from "creating, downloading, copying and sharing or distributing to others any medium or software recording the design for the purpose of enabling a product [which incorporates the subject matter of the EU design registration] to be made".

Also proposed is the introduction of new provisions to allow the right holder of an EU design registration to stop infringing counterfeit products which transit through the EU. This change therefore mirrors a corresponding change in respect of EU trade marks, where a similar "transiting" provision has already been implemented.

### Next steps

The above proposals are set to be mooted by the European Parliament and Council in the near future, and it is hoped that the proposals remain intact as part of this process. In so far as the proposals remained unscathed, the resultant changes will represent welcome news to many existing users of the EU design registration system, and will no doubt help encourage new users to the system moving forward. Interesting times lie ahead!

### Authors:

Jana Bogatz & William Burrell



Official application fees (from filing through to registration)	Current official fees (EUR)	Proposed reduced official fees (EUR)
Design 1 in application	350	250
Each of designs 2-9 in same application	175	125



# Good news from the USPTO Reduction in official fees for smaller-sized applicants

**T**he United States Patent and Trademark Office (USPTO) has announced that the small and micro entity status discounts for utility patents, design patents and plant patents have been increased from 50% and 75%, to 60% and 80% respectively, with immediate effect.

As background, these discounts are applicable to smaller-sized entities seeking patent protection at the USPTO.

The discounts are applicable to most of the official fees payable in the process to obtain such patent protection.

Roughly speaking, small entity status can often be applicable to any entity seeking patent protection in the USA that is:

1. an individual;
2. a small business in which the number of employees does not exceed 500 (including any affiliated companies); and/or
3. non-profit organisations, including universities.

Micro entity status is more limitedly applicable, and the requirements for this are as set out by the USPTO on its website: [dycip.com/usptomicro-entity](https://www.uspto.gov/patents/small-entity).

Note that these discounts, as well as being applicable to official fees incurred during

the initial application process for the patent right in question, are also applicable to any renewal fees, which might need to be paid to keep the patent right in force for its full term, after the patent is granted. For example, the total official renewal fees which would need to be paid to maintain a US utility patent in force, for the maximum term of protection, currently stand at USD \$13,460. However with a small entity discount applied, this can lower these official renewal fee payments down to USD \$5,384, which represents a significant saving.

### Comment

It is clear that this announcement from the USPTO will be of tremendous news to many smaller-sized entities seeking to protect their IP in the USA via patent protection.

Indeed, as well as helping to reduce their costs in obtaining future patent protection in the USA, the discounts will also significantly help reduce the costs of maintaining any existing US patent rights through to their full term. Bravo to the USPTO!

### Author:

William Burrell



### Useful links

USPTO announcement "Patent fees for small and micro entities reduced" 30 December 2022: [dycip.com/USPTOannouncement](https://www.uspto.gov/patents/small-entity)

USPTO fee schedule: [dycip.com/feepayments](https://www.uspto.gov/fees)

# UP & UPC Major milestones remain unchanged

**D**espite the postponement of the UPC Sunrise Period to 01 March 2023, all other major milestones of the official UPC roadmap remain unchanged. During January 2023 the following milestones were met:

- Advanced preparatory training for UPC appointed judges was launched in Budapest, with the participation of the legally and technically qualified judges of the court. The training aimed to facilitate an in-depth understanding of the Rules of Procedure of the UPC.
- Mr Alexander Ramsay (SE) was appointed as Registrar and Mr Axel Jacobi (DE) as Deputy-Registrar of the UPC.
- The UPC has invited external users to practice the CMS sunrise functionalities. D Young & Co is actively participating in this test phase of the CMS test environment. The test environment is a copy of the CMS production environment that will be launched when the Sunrise period starts.

### UP & UPC Resources

Our frequently updated UP & UPC resources, including articles, webinars and guides, are available on demand online at: [www.dyoung.com/upandupc](https://www.dyoung.com/upandupc).

### Webinars

- Introduction to the UP & UPC
- UPC opt out
- UP & UP - jurisdiction
- Unitary patent v European patent validation
- UPC: representation and judges
- UPC: structure, language and where to start a case

### Guides

- Guide to the unitary patent (UP)
- Guide to the Unified Patent Court (UPC)
- UPC opt-out FAQs

### The USPTO has reduced official fees for smaller-sized applicants



# D YOUNG & CO INTELLECTUAL PROPERTY

And finally...

## Webinar invitation

### European biotech patent case law Tuesday, 21 February 2023



Our regular European biotech patent case law webinar returns on Tuesday 21 February 2023 at 9am, noon and 5pm UK time (GMT) with a round up of recent and significant EPO decisions presented by European Patent Attorneys Simon O'Brien and Tom Pagdin.

#### Speakers

Simon O'Brien was appointed partner in 2010 and is a Chartered and European Patent Attorney. His area of expertise encompasses both biological and chemical subject matter including the fields of molecular biology, biotechnology, biochemistry, food technology and nutrition, diagnostics, pharmaceuticals, and polymer chemistry. Simon advises on all aspects of patent law, including patent drafting and prosecution,

opposition and appeal proceedings.

Tom Pagdin joined D Young & Co in September 2012 and was promoted to partner in 2022. He is a Chartered and European Patent Attorney with a strong technical background in biochemistry, immunology, molecular biology and genetics, with particular experience in antibodies, chimeric antigen receptors, RNAi technologies, vaccines, viral vectors, diagnostics, peptides, food technology and nutritional compositions.

#### Registration

Find out more and sign up to attend at a time convenient to you:  
[dycip.com/web-bio-feb2023](https://dycip.com/web-bio-feb2023)

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