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The CJEU says “no” to borders, not to chocolate bars



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No patent shield for Native American tribes

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The clock ticks on

Alasdair Poore



The Corpus Clock at Corpus Christi College and the reflection of King's College Chapel

One of the remarkable features of the Corpus Clock¹ is its deliberate imperfections, if that is not a contradiction in terms. While it ticks, it doesn't do so steadily². Every minute or so there is a hiatus. The grasshopper stutters briefly while eating time across the escapement teeth³, and the time is only shown correctly once every five minutes.

Eighteen months ago, I wrote about the clock in the context of Brexit, reflecting as it does King's College Chapel, the building of which spanned the first Brexit. I likened Theresa May to Henry VIII, not just because of the assumption of Henry VIII powers (to

legislate by statutory instrument), but also because of the break with Europe in 1532 to 1534, and because her approach to her [political] partners was rapidly trending towards that of Henry VIII's approach to his wives. There are analogies to be drawn in relation to the respective "religious" affiliations to "Leave" and "Remain" as well, with "EU-ist" threats and counter threats being made.

The clock ticks on, and with its slightly erratic progress the analogy seems even more apt now. I am not sure how to count the number of Cabinet colleagues Theresa May has executed. The difference may of course lie in her potential political assassination, whereas Henry VIII died

of natural causes, although there is some speculation that this was partly attributable to a jousting injury sustained shortly after Brexit 1.

The end of September saw some progress in what commentators see as the Government's stuttering approach towards the Brexit 2 deadline – although I optimistically believe that there is much more going on behind the scenes at least on the IP side, than is revealed in public. This progress was the UK Government "removing" one layer of uncertainty by publishing "Technical Notices" relating to IP⁴, in the event of No Deal. It resulted predictably in a swarm of news releases from patent and trade mark attorneys and IP lawyers attempting to distil the essence of what will happen if there is no deal. Some comments on these below but first a quick update. [Also see page 13.]

There are other events happening. At the CIPA Congress last month, Sir Colin Birss also drew a clock-like analogy – to the cyclic nature of law making at least in the courts. An example is the history of the doctrine of equivalents, which once had a significant place in English jurisprudence, then reached a low point, and is now on the rise again – and speculation as to whether patent attorneys' approach contributes to the feedback loop which leads to these cycles. There are two further major Supreme Court decisions lined up for the coming months to draw attention away from Brexit 2: *Warner Lambert v Actavis* promising to fuel the debate on sufficiency and plausibility, with implications well outside the pharma field, as well as on abuse of process and the freedom to amend patents regardless of past behaviour, and secondary infringement; and *Actavis v ICOS*, on obviousness and inventive step, which

is relevant not just to clinical trials and high throughput chemical screening, but also possibly in many wider areas such as inventive step in computer-implemented inventions when it is obvious the relevant technology developments are on the business roadmap.


More on Congress in later issues, but one particular topic which deserves attention was the implications of artificial intelligence (AI) – or machine analysis – to patent practice, and a particularly notable talk by John Bambridge from the EPO describing the extent of use of AI in the EPO: the use of AI in “Pre-search” assisting examiners in finding the most relevant documents; in “Pre-classification” to carry out a preliminary allocation of patent applications to suitable classes; and in the pipeline assistance for building queries for searching, predicting patents which may be opposed (for staff forecasting), pre-identification of clarity objections (which could be fed back to attorneys and, not surprisingly, may even identify individual drafting styles!). This is with the obvious aim of improving efficiency and quality within the IPO by allowing examiners to focus on the key aspects of examination, with assistance from machine analysis. But John contemplated making some of these tools accessible to patent attorneys to assist in drafting, by addressing potential issues before filing. Or anticipating them and circumventing them? Is there another cycle about to develop here?

Turning then to the “Technical [Crash]⁵ Notices”, for those who still find that the details are not very memorable (because they are not really very different from what one might expect). As far as trade marks and designs and patents are concerned these contained no real surprises. For patents, there were of course no surprises as patents are either UK national patents or EPC patents, over neither of which the EU has any jurisdiction. There are aspects such as SPCs and a number of special issues (such as genetic inventions and the Bolar exceptions) that are EU originating. They will remain in place. A welcome addition was the UK’s continuing support for the Unified Patent Court and Unitary Patent. We hope that Germany will see its duty to press this forward, if it is found constitutional, with only the minimum delay needed for a decision on constitutionality. For trade marks and designs, registered rights existing on Brexit Day would be given effect to in the UK. The critical, but not very new aspect, is that applications not completed by **29 March 2019** would have to be applied for afresh with a nine-month time limit. The UK will give effect to Community Unregistered Design Right and create a new UK equivalent – so that we can maintain the tally of having at least three different forms of design right.

For Geographic Indications, there was no such luck. The UK will set up its own TRIPS compliant GI scheme. Existing rights in the UK will be preserved – but

the GI logo will be changed, necessitating changes for producers. In relation to UK GIs taking effect in the EU the notice says: “we anticipate that all current UK GIs will continue to be protected by the EU’s GI schemes”. But if that is not the case then there may be a fresh start for those UK GI holders in the EU.

The stand out Technical Notice on IP is that on exhaustion of rights, which will give unilateral exhaustion to goods put on the market in the EU but not vice versa (i.e. those put on the market in the UK will not necessarily give rise to exhaustion of rights in the EU). This adds to the uncertainty in relation to trade mark (and other IP) related agreements. It adds more uncertainty, as there is a good argument that if the UK offers exhaustion of rights to the EU (i.e. for goods put on the market in the remaining EU/EEA Member States) it also has an obligation under TRIPS to offer the same exhaustion of rights approach to all other countries in the world – i.e. international exhaustion. Of course, that may not mean much in the short term if the UK courts do not recognise this; it is just a breach of the UK’s treaty obligations.

Nothing daunted by this (mostly) increase in certainty about protection of existing rights in the event of no deal, plenty of attorneys are still spreading the message of uncertainty. “You must take advice.” Or “you should file in the UK now”. And maybe they are right to do so. Perhaps the apparent perceived disorganisation of the current Government does justify the thought that maybe they will not manage to get even that legislation through, or that it will be voted down in Parliament in an effort to raise the stakes in a version of the Chicken of Nations. We hope that there is enough flexibility in the European Union (Withdrawal Act) 2018 to allow the Courts to give effect to most of the points in the Technical Notices, even if disaster were to happen. There are plenty of other things to get more worried about in that scenario. Meanwhile to clock tick erratically but inexorably on. 

References

1. <https://www.corpus.cam.ac.uk/about-corpus/corpus-clock/introduction-corpus-clock>
2. See video at <https://youtu.be/SXOZdPhNUBU>
3. https://en.wikipedia.org/wiki/Corpus_Clock
4. <https://www.gov.uk/government/news/ip-and-brex-it-the-facts>; <https://www.gov.uk/government/publications/trade-marks-and-designs-if-theres-no-brex-it-deal/trade-marks-and-designs-if-theres-no-brex-it-deal>; <https://www.gov.uk/government/publications/patents-if-theres-no-brex-it-deal/patents-if-theres-no-brex-it-deal>; <https://www.gov.uk/government/publications/copyright-if-theres-no-brex-it-deal/copyright-if-theres-no-brex-it-deal>; <https://www.gov.uk/government/publications/exhaustion-of-intellectual-property-rights-if-theres-no-brex-it-deal/exhaustion-of-intellectual-property-rights-if-theres-no-brex-it-deal>
5. i.e. ones applicable if the UK crashes out of the EU without a deal



Chief Executive's report

Lee Davies

Elections to Council

The one hundred and thirty-sixth Annual General Meeting of the Institute will be held on **Wednesday 5 December 2018**, at CIPA's offices in Halton House. Registration will commence at 5.00 p.m., with the AGM starting promptly at 5.30 p.m. The AGM will be followed by networking, drinks and light refreshments. On behalf of the Institute, I hope you will be able to attend and very much look forward to seeing you then.

We are still waiting for confirmation from the Privy Council that the amendments to the Bye-laws have been approved. At its meeting in September, Council agreed to schedule the AGM for December to give sufficient time under the current Bye-laws for nominations for President, Vice-President and Council to take place. In the event that the Privy Council approves the Bye-laws before the AGM, we will conduct the election under the revised constitution.

Julia Florence, CIPA's Vice-President, has confirmed that she will stand for election as President at the AGM. Should the new Bye-laws come into effect before the AGM, Julia will become President on 1 January, 2019, under the transitional arrangements. Richard Mair, member of Council and Chair of the International Liaison Committee, has been nominated to stand as Vice-President at the AGM. Under the transitional provisions in the new Bye-laws, the person elected as Vice-President will serve as President from **1 January 2020**.

There will be at least four vacancies on Council, rising to five vacancies under the new Bye-laws. A number of members have had conversations with me about the work of Council and the commitment involved. I am confident that we will secure enough nominations to fill the

vacant seats. Please do not hesitate to contact me if you are thinking about standing for Council and would like to know more about the election process.

IP Inclusive Week

12–18 November 2018 is IP Inclusive Week! IP Inclusive has been one of the great initiatives spanning all of the IP professions in recent years. Launched in 2015, following a round-table meeting

Inclusive is encouraging everyone in the IP professions to do at least one thing, however small, to improve diversity and inclusion (D&I). It could be anything from an in-house coffee-and-cake discussion on your organisation's D&I policies, to a wider event with others in your region, or something in between.

IP Inclusive will be organising a number of events in and around IP Inclusive Week, some through the

“ IP Inclusive is encouraging everyone in the IP professions to do at least one thing, however small, to improve diversity and inclusion. ”

on diversity in IP hosted by CIPA, IP Inclusive has the support of the Chartered Institute of Trade Mark Attorneys (CITMA), the IP Federation (IPFed), the UK association of the International Federation of Intellectual Property Attorneys (FICPI-UK) and the UK Intellectual Property Office (UK IPO). IP Inclusive draws on representation from across the IP professions, including patent and trade mark attorneys, IP solicitors and barristers, patent and trade mark administrators, information scientists, IP office examiners and HR professionals from IP practices.

This year will see the inaugural IP Inclusive Week, held on 12 – 18 November. During that week, IP

Women in IP, IP Out and IP&ME support groups. More importantly, however, are the things others are doing during IP Inclusive Week. IP Inclusive wants to hear about the activities that are being planned, so that these ideas can be shared and to celebrate the great things that will be happening. There will be a concerted social media campaign leading up to and during IP Inclusive Week. Follow the activities on Twitter via #IPInclusiveWeek or keep in touch with what is happening on the IP Inclusive Week blog (<http://www.ipinclusive.org.uk/ip-inclusive-week>). Please feel free to get involved using your own social media channels: tweet, blog and send IP Inclusive photos and reports for publishing online. 

Council Minutes

Minutes of the Council meeting held on Wednesday 6 June, 2018, at 14:30.

Item 1: Welcome and apologies

S.F. Jones (President, in the Chair), J.A. Florence (Vice-President), C.P. Mercer (Honorary Secretary), A.R. Brewster, J.D. Brown, R.J. Burt, P.G. Cole, C.M. Hammer, A.C. Instone (by phone), J.T. Jackson (by phone), R.P. Jackson, R.D. Mair, A. Mukherjee, E. Nytko-Lutz, B.N.C. Ouzman (by phone) and V.B. Salmon. Lee Davies (Chief Executive) and Charlotte Russell (Executive Assistant) were in attendance.

Apologies: A.J. Rollins (Immediate Past President), M.P. Dixon, S. Ferrara, S. Harte, G.J. Icton, A.D. Poore, G.V. Roberts and S.M. Wright.

Item 2: Conflicts of interest

164/18: There were no conflicts of interest.

Item 3: Minutes

165/18: The Minutes of the Council meeting held on Wednesday 6 June, 2018, were approved, following amendment.

Item 4: Brexit

166/18: Stephen Jones advised Council that he had discussed the proposal to lobby government for the UK to remain a member of the EUIPO after Brexit, considered at the June Council meeting, with Tania Clark, President of CITMA. Stephen said that remaining in the EUIPO post-Brexit remained CITMA's preferred position but that CITMA's current work with government was based on the belief that this was unlikely to happen. Stephen said that, in terms of any position taken by CIPA to lobby government on remaining in the EUIPO, much would depend on the outcomes from the Prime Minister's meeting with the Cabinet at Chequers to determine the content of the Brexit white paper, in particular the position taken on other

agencies such as the European Medicines Agency, the European Chemicals Agency and the European Aviation Safety Agency.

Bobby Mukherjee informed Council that he had taken the proposal to the IP Federation and that it would come as no surprise to hear that industry was in favour of remaining in the EUIPO. Rob Jackson said that he understood the reasons for waiting for the publication of the white paper but felt that CIPA had nothing to lose in lobbying government on this issue. Rob added that there appeared to be agreement across the principal IP representative bodies and that he could see no downside to CIPA acting now. Stephen Jones said that he agreed with Rob's general position but that he favoured waiting until the publication of the white paper. Rob accepted that it was probably wise to wait but added that he felt it was already late in the day and that soon the opportunity to influence government would be lost.

Julia Florence said that she held out some hope that it might be possible to lobby on this issue as the line in the sand in terms of the CJEU seemed to be not so well-defined when government was considering remaining in other EU agencies. Richard Mair agreed and urged Council to lobby the government if the white paper indicated a desire to remain in key EU agencies. Stephen Jones said that CIPA would wait for the outcomes from the Cabinet meeting at Chequers and asked the Trade Marks Committee to take the lead on developing CIPA's position on remaining in the EUIPO following the publication of the white paper, with the support of Neil Lampert.

Action: The Trade Marks Committee to review the government's Brexit white paper and to advise Council on the

position CIPA should adopt with respect to remaining in the EUIPO.

167/18: Stephen Jones advised Council that CITMA had received a response from the European Commission's Brexit task force in relation to its letter on pending EUTM applications, stating that there was no intention to reopen the matter as it had been fully considered by the EU's chief negotiator. Stephen added that he did not see any value in CIPA writing a similar letter at this time and that the matter would be resolved if the UK was able to remain in the EUIPO. Rob Jackson observed that businesses from further afield than the UK would suffer as a result of the EU's current position on pending applications. Alicia Instone reminded Council that the issue was wider than trade marks and that there was the need for consistency with designs applications. Stephen Jones said that it would make sense for CIPA to focus its energy on the UK remaining a member of the EUIPO.

Item 5: Bye-laws

168/18: Lee Davies advised Council that the members had voted in favour of approving and adopting the amendments to the Bye-laws at the General Meeting held at Halton House on 6 June 2018, at 5 p.m. Lee added that 476 members had voted in the ballot, with 449 members voting online and 17 members voting by way of a postal ballot.

- 435 members voted for the Special Resolution (91.4%)
- 30 members voted against the Special Resolution (6.3%)
- 11 members abstained from voting (2.3%)

Lee said that he had forwarded the revised Bye-laws to the Privy Council

together with the necessary supporting documents and that he had been advised that it would take six to eight weeks for the Privy Council to formally approve the Bye-laws. In response to a question from Andrea Brewster on the process for electing Council members and Officers, Lee said that the process to be followed this year would be dependent on when approval was received from the Privy Council. Lee added that he hoped to receive notification from the Privy Council in time to arrange an Annual General Meeting in October or November of this year. Once the Bye-laws come into effect, the current Vice-President, Julia Florence, will succeed automatically to the presidency on 1 January 2019, under the transitional provisions. At the AGM, CIPA will need to elect a President to serve from 1 January 2020, who will serve as Vice-President from 1 January 2019, and sufficient Fellows to make up the number of ordinary members of Council to 24. Lee said that, in this scenario, the call for nominations will close not less than 28 days before the AGM, with Council publishing a list of nominations.

Lee advised Council that if he did not receive confirmation that the amendments had been approved by the Privy Council in good time, CIPA would need to hold an AGM under the existing Bye-laws on a date to be determined by Council, most likely in October or November. The Vice-President, President and members of Council elected at the AGM would take up office with immediate effect. Julia Florence confirmed that, should this scenario be the case, she would stand for election as President as required by the current Bye-laws. Lee added that the call for nominations would close at an Ordinary General Meeting to be held at least 21 days before the AGM. Lee added that, irrespective of the timing of the notification from the Privy Council, the initial call for nominations for Council and for Officers had been published in the *Journal*.

Item 6: Regulatory issues

169/18: Stephen Jones advised Council that he was continuing to work with colleagues from IPReg and CITMA on the appointment of the new Chair of IPReg and that the list of applicants had been reduced from 12 to five following the preliminary round of interviews with the recruitment agency. Stephen said that it was a very strong and diverse field of candidates and that he was optimistic that a Chair would be appointed following the panel interviews.

170/18: Lee Davies provided Council with an update on the application of the Money Laundering, Terrorist Financing and Transfer of Funds (Information on the Payer) Regulations 2017 to the work of patent attorneys following recent correspondence with the Treasury. Vicki Salmon said that, in her reading of the Regulations, she took the view that patent attorneys could be bound by the Regulations when undertaking work such as providing IP advice or undertaking due diligence during the buying or selling of businesses. Rob Jackson said that he felt that this was an expansive reading of the Regulations. Paul Cole agreed, adding that he did not see how the Regulations could be read in this way. Andrea Brewster said that she agreed with Vicki Salmon's interpretation and wanted to know in what circumstances the Regulations might apply and what obligations this might place on attorneys.

Vicki Salmon said that it was impossible to say with certainty that the Regulations did not apply to the work of patent and trade mark attorneys. Stephen Jones added that there seemed to be a case that the Regulations might apply in certain aspects of work carried out by attorneys but not in the general sense of drafting and prosecuting applications. Lee Davies said that he was receiving questions from members about the application of the Regulations and that he needed to be able to answer members with a degree of clarity and certainty. Stephen Jones said that the

core work of attorneys appeared to fall outside of the scope of the Regulations but that there might be areas of work undertaken by attorneys, such as due diligence in the buying and selling of businesses, where the Regulations applied. Rob Jackson said that he still disagreed with this interpretation of the Regulations and that, if Council perceived this to be a serious concern, it might be beneficial to seek counsel's opinion.

Stephen Jones said that, having heard Council members speak for and against the application of the Regulations to the work of patent and trade mark attorneys, he would like to revisit the conflicting counsels' opinions given to CIPA and IPReg when the issue was looked at previously. Stephen added that, in the light of the revisions to the Regulations and the concerns expressed by some members of Council, CIPA, CITMA and IPReg should commission counsel to provide a new opinion on the Regulations and the questions would have to be carefully framed.

Action: Stephen Jones to review the opinions given to CIPA and IPReg. Lee Davies to liaise with Keven Bader, Chief Executive of CITMA, and Fran Gillon, Chief Executive of IPReg, on a joint approach to counsel for an opinion on the applicability of the Regulations to patent and trade mark attorneys.

Item 7: IPO and EPO matters

171/18: Council noted the letter from Benoît Battistelli, former President of the EPO. Stephen Jones informed Council that he had met with António Campinos, the new President of the EPO, at the opening of the EPO's new offices in The Hague, where he was also introduced to King Willem-Alexander of the Netherlands.

Item 8: Committees and committee reports

172/18: International Liaison Committee Richard Mair advised Council that the visit from the American Intellectual

Property Law Association's Practice in Europe Committee went very well, with Sir Henry Carr and Andy Williams, the UK IPO's Director of International Policy, attending the event. Richard added that the round-table meeting and seminar had been preceded by a breakfast meeting on diversity.

173/18: Congress Steering Committee

John Brown informed Council that the dinner on the evening of Congress would be a separate event but that the Committee hoped delegates would take the opportunity to stay on. John said that Stephen Jones and Julia Florence had agreed to send an invitation to members in a bid to increase attendance at the dinner. John added that there would be an IP Inclusive drinks reception immediately after Congress. John advised Council that the early bird registration period would end on 31 July 2018.

174/18: Internal Governance Committee

Catriona Hammer advised Council that the Internal Governance Committee had met earlier that day, primarily to meet with the auditor and receive the annual accounts and audit report. Catriona said that the Committee had agreed some adjustments with the auditor and that the auditor was preparing an amended set of accounts for approval at the August meeting of Council.

Catriona reported that the auditor had indicated that HMRC was taking an interest in membership organisations. Lee Davies added that he had heard this through his network of chief executives and that HMRC was looking at the way membership bodies employ members in casual roles such as examiners and invigilators. Catriona informed Council that the Committee had revisited CIPA's position on the giving of gifts, such as gifts for speakers, and had reached the view that Council and its committees should not routinely give gifts to speakers and other contributors to the work of the Institute. Catriona added that

there would always be occasions when Council wanted to reward significant contributions as a one-off and that instances such as this should go to the Committee for approval.

175/18: Professional Development Working Group

Council noted the report from the Professional Development Working Group.

176/18: Media & PR Committee

Council noted the report from the Media & PR Committee.

177/18: Life Sciences Committee

Julia Florence advised Council that the Committee had considered a request to intervene in the Kymab appeal to the Supreme Court but had decided not to do so on the grounds that there was no obvious point of law to write in support of. Paul Cole said that he was disappointed with this decision as he felt that there were elements of the case that brought the patent system into disrepute. Stephen Jones said that he felt sure that the Committee would have given the issues its full consideration before arriving at its conclusions.

Item 9: Officers' reports

178/18: Council noted the Officers' reports.

Item 10: Chief Executive's Report

179/18: Council noted the Chief Executive's report.

Item 11: Applications for election

180/18: **Fellows.** Council approved the following first time Fellow applications: Natalie Falls; James Henry Evans; Benjamin Howard Chapman; Michael Chester; Martin Brian Crow; Katherine Louise Brown; Paul Hussey; Jegannath Korukottu.

Council approved the following second time Fellow applications: Abigail Frances Welford; Frazer James Bye; Ekaterina Langford; Fergus Tyrrell; Gregory Seth Roberts; Edward Paul Cavanna; Gavin

Cullen; Christopher John Anderson; Nathalie Ann Esther Cohen; Robert Waddingham; Edward Louis Nation; Siobhan Durran; Daniel Hirons; Rebecca Mack; Hoi Kan Chung; David William Lucas.

181/18: **Students.** Council approved the following Student Membership applications: Meg Booth; Kathryn Bradley; Elitsa Peeva; Kevin Rich; Lingjun Gao; Elaine Taylor-Shaw.

182/18: **Associates.** Council approved the following first time Associate membership application: Paul Farrell.

Council approved the following second time Associate membership applications: Helen Lavery; Andrew Hutchinson.

Item 12: Resignations, etc

183/18: Council noted the report on resignations.

Item 13: Any other business

184/18: Stephen Jones advised Council that he had written to Sir David Kitchin, congratulating him on his elevation to the Supreme Court.

185/18: Roger Burt asked Council if it was content for him to continue to represent CIPA in the Design Council's Spark programme. Roger explained that Spark is the Design Council's initiative to help new inventors and innovators turn their ideas into commercially successful products. Roger said that he had just completed his fourth year as a judge, with 300 entries being honed down to ten showcase finalists competing for investment. Council thanked Roger for his involvement in the Spark programme and approved his future participation.

Item 14: Date of next meeting

186/18: Wednesday 1 August 2018.

The President closed the meeting at 16:58. **D**

Lee Davies, Chief Executive

Nagoya and Brexit

Should the UK remain a member of the Nagoya Protocol after Brexit?

If so, what needs to change? A paper by the Life Sciences Committee.

The Nagoya Protocol to the Convention on Biological Diversity (CBD) is well-intentioned, but not well-balanced. It obstructs important research on genetic resources, so work on crucial topics such as human health and food security is complicated, delayed or does not happen. It needs to be interpreted and enforced in a way which gives proper weight to all three objectives of the CBD, as well as to other important public policy objectives. The EU regulation that applies it fails to do this. Therefore, on Brexit, it must not be transposed unchanged into UK law.

History

The CBD¹ was negotiated and signed in 1993, in order to safeguard biodiversity. Nearly all countries are members, with the significant exception of the US. This gives important benefits to the US (noted later). It has three objectives (set out in article 1):

1. to conserve biodiversity;
2. to promote its sustainable use; and
3. to share equitably the benefits resulting from such use.

It pursues these objectives by ‘*reaffirming*’ (Preamble) that member states ‘*have sovereign rights over their own biological resources*’. Article 15 recognises that ‘*access*’ to genetic resources (GR) is controlled by ‘*national governments*’ (CBD members: i.e., Parties). It relates to the provision of GR by national governments – Parties to the CBD – where those Parties are either ‘*countries of origin*’ of that GR, or have received them under CBD agreements from other

Parties. Parties are to facilitate access to GR – for ‘*environmentally sound uses*’. Access is subject to ‘*prior informed consent*’ (PIC) from the ‘*provider country*’, and is to be on ‘*mutually agreed terms*’ (MAT), which may include any conditions acceptable to both provider and recipient.

Two difficulties immediately arise:

1. What is ‘*access*’?
2. Which GR is the provider country’s ‘*own*’?

Take the latter first. Is mere presence of a GR in a country sufficient to make that GR the country’s ‘*own*’? No doubt it is sufficient to give the country ‘*sovereign rights*’ over the GR, in the sense of the ability to control what happens to it while it remains in the country (including the power to control export). However, sovereignty (unlike ownership) ceases at national borders. Article 15 gives two classes of GR which the Party may control access to – GR for which it (Party A) is the ‘*country of origin*’ and GR which it has received from another country (Party B) under a CBD agreement. It seems implausible to regard the latter GR as the ‘*own*’ GR of Party A – so it is reasonable to assume that only GR for which Party A is the ‘*country of origin*’ is Party A’s ‘*own*’. ‘*Country of origin*’ is defined in the CBD (article 2) as ‘*the country which possesses those genetic resources in in-situ conditions*’ (e.g. growing wild). A Party is clearly entitled to control ‘*access*’ to a GR growing in its territory in the wild as long as it remains in that country.

But, now, what does ‘*access*’ mean? One simple interpretation is ‘*physical*

access’. If you have in your possession a sample of a GR, you have the physical access that enables you (within broad limits) to do what you like with it. If you do not already have a sample in your possession, you may need to negotiate with a ‘*provider country*’ to provide you with one, subject if required to PIC from that country and MAT.

Another interpretation is ‘*legal access*’². According to this, the owner of a GR sample has no inherent right to do anything with it that has not been (specifically or by clear implication) approved by the ‘*provider country*’ that previously possessed it. This interpretation is favoured by most developing countries. Under it, any new research on a GR may first require the specific formal approval of the country providing it. And if in the course of such approved research a new line of inquiry opens up, a new negotiation for PIC and MAT is required. For more discussion contrasting ‘*physical*’ with ‘*legal*’ access, see https://www.publiceye.ch/fileadmin/files/documents/Biodiversitaet/The_two_worlds_of_Nagoya_11-16.pdf.

A third question is often raised. What happens where two or more countries have identical GR? Who controls that? The answer (probably – this is not necessarily agreed) is that each country controls that GR of which it is the country of origin. That other countries have rights in GR of similar or identical structure is not relevant. The right arises from derivation, not from identity alone – so it is analogous to copyright, rather than an absolute right in a particular structure, such as a patent might give. Of course, where several countries may be the source of widely distributed GR

of the same or similar structure, finding out who controls rights in a particular sample may be impractically difficult.

Why Nagoya?

When the CBD came into force, it was hoped that considerable benefits would flow to less-developed countries that were economically poor but rich in biodiversity. Disappointment that this was not happening led to the Nagoya Protocol, emphasising the ‘equitable sharing’ objective of the CBD. The Protocol was negotiated in 2010 and came into force on 12 October 2014 when 50 countries had ratified it. The EU is a member, and the UK has also ratified in its own right.

Nagoya controls research with GR. In principle, doing research (at least with a view to development) on a GR requires PIC and MAT from the ‘provider country’, in accordance with the CBD, if the ‘provider country’ asserts its rights (many Nagoya members, including the UK, do not). Nagoya is weighted heavily towards countries who provide genetic resources. It does nothing directly to conserve biodiversity or to promote its sustainable use. It may well cut back the benefits to provider countries that it aims to increase.

EU Regulation 511/14

Nagoya is currently enforced throughout the EU by EU Regulation 511/14³. This is over-prescriptive in two respects. First, it fails to balance the third CBD objective of benefit-sharing with the other two. Secondly, it disregards all other important objects of public policy. These include research freedom in general; and in particular easing research on vital objectives such as human health and food security. Even so, it does not meet the full aspirations of developing countries to control GR research.

In principle, the Regulation takes the view that ‘physical access’ is what Nagoya controls. Thus, under the Regulation, samples of GR received by a researcher before the operative date (which is set at one year after Nagoya came into force, so 12 October

2015) are not controlled. However, ‘research’ on GR samples accessed after that date is strictly controlled. Before commencing ‘research’, researchers must use ‘due diligence’ to satisfy themselves that the GR has “been accessed in accordance with applicable access and benefit-sharing legislation or regulatory requirements” of the ‘provider country’ and that (if required) there are benefit-sharing arrangements in place (Regulation article 4.1). Note the use of the passive tense – it is not only the access of the enquiring researcher that is in question, but of all in the chain of ownership of the GR (back until 12 October 2015, apparently). Declarations of ‘due diligence’ are required at two points: when a researcher has received research funding (public or private) for work on the GR (Regulation article 7.1); and “at the stage of final development of a product” resulting from the research (Regulation article 7.2).

‘Due diligence’ requires either a formal certificate regarding the resource from the ‘provider country’ as filed with the Access and Benefit-sharing Clearing House (ABSCH)⁴ of the Nagoya Protocol; or (if, as most often⁵, there is no such certificate) the researcher must ‘seek, keep and pass on to other [researchers]’ ‘information and documents on’ when and where the GR was accessed; a description of the GR; the direct source; presence or absence of conditions on benefit-sharing, etc.

These requirements are dauntingly complex. They are far too broadly framed. They should have been designed to control the activities of researchers seeking GR samples from **within** countries claiming rights in their resources. As it is, nearly **all** GR first accessed after 12 October 2015 requires ‘due diligence’ – even if it is native to, and accessed in, a country such as the UK where no such rights are claimed. There are some narrow exceptions, but these are quite inadequate. For example, Article 4.8 of the Regulation provides that if the GR is implicated in a grave public health threat, research may be started before the requirements are met:

but if formalities are not completed within three months, such (potentially essential and life-saving) research must stop! Three months is too short to agree PIC and MAT – often it is not enough even to find out who has authority to make such agreements⁶. In some cases countries have simply refused any access. The government of Indonesia invoked “viral sovereignty” in order to deny access to a new strain of avian influenza (H5N1) virus that was first detected in that country⁷. More general concerns have been expressed about monitoring and treating of infectious disease (for example by the Wellcome Foundation, see footnote 6).

A Regulation so complicated and all-embracing must put researchers off. To be confident of operating legally, one will need frequent and expensive legal advice, and often expensive and protracted investigations of the history of specific GR samples – and in many cases undertaking difficult and lengthy negotiations with a ‘provider country’ to obtain necessary permissions. This will only be practical for the largest international organisations. Even they may not consider seeking such permissions worthwhile where they judge a particular GR unlikely to lead to a commercial product. For many SMEs and academics, the only practical option will be to avoid many areas of GR research.

The Regulation fails in two important respects. It discourages extending uses of GR, in direct opposition to two of the three objectives of the CBD. Making research more difficult frustrates the development of new uses for GR. And fewer new uses mean fewer benefits to share. It also seriously interferes with other legitimate objects of public policy. It inhibits important research, for example on public health and agriculture. It limits the freedom to do many kinds of research – which should not be curtailed without clear need. A 2014 paper by Darren Smyth concluded: “*that the regulation will hamper research in the EU, while producing little concrete benefit for the countries of origin.*”⁸

What should be done?

Regulation 511/14, in its current form, **should not remain part of UK law**. Should the UK also leave Nagoya? A case could be made that the UK should leave Nagoya. It brings no clear benefit for UK citizens. While nearly 100 other countries are members, there are several significant countries who have not yet joined. Australia and Brazil have signed but not so far ratified; Canada has not signed; the US has not signed Nagoya or ratified the CBD. The consequences for the US of not being bound by the CBD or Nagoya are that companies working in the US are free to develop new products without the constraints of either. They are then free to sell these products around the world without restriction – even into countries bound by the CBD and Nagoya, where carrying out the original research would have been illegal without PIC and MAT.

Another possible drawback of Nagoya has recently emerged. Provider countries are pressing to extend the obligations of Nagoya to cover not only research on samples but also use of published information derived from such samples (in particular, DNA sequences published in databases). This demand, if agreed, would alter the whole basis of the CBD. No longer would CBD control use only of physical samples, but also of derived published information – *in perpetuity!*

It is often alleged that developing country members of Nagoya, rich in GR, will be unwilling to make their GR available to non-member countries, so that leaving the Protocol would disadvantage UK researchers. However, it seems likely that most such countries overvalue the financial benefits obtainable from their resources, as well as underestimating the difficulty and cost of realising these. If so, any losses to the UK could be small. Where valuable resources were identified, it would still be possible for special agreements to be negotiated that would benefit all parties.

However, on balance, it does not seem advisable to leave Nagoya. Politically it would be difficult. If

done now, it might complicate Brexit negotiations. Developing countries set great store by Nagoya. It is seen, perhaps wrongly, by other countries, and by much of the British public, as an agreement important for the environment. Also, to get full benefit from leaving Nagoya, it would probably be necessary also to leave the CBD, which would be even more difficult politically.

What the UK should seek to do – as a long-term aim – is establish a sensible and practicable framework for interpreting and applying Nagoya. This should recognise the rights of ‘provider countries’ to control ‘their’ genetic resources (that is to say, samples of resources for which they are the ‘country of origin’) *while those samples are within their boundaries*. ‘Sovereignty’ applies within national boundaries, not worldwide. Once such GR was outside these boundaries, the rights of ‘provider countries’ would be limited to enforcing contractual terms against parties with whom they had made access agreements. Breach of such terms – or exporting GR in defiance of local laws – might also be offences against the laws of ‘provider countries’. The duties of other countries should be limited to requiring nationals

not knowingly ‘utilising’ GR which had been exported from a ‘provider country’ illegally or passed to them in breach of an access agreement. But in general there should be no duty of ‘due diligence’ to determine if GR had been ‘legally accessed’, in the absence of some reason to suppose it had not. This should be combined with appropriate exceptions in cases of need, e.g. for research to combat pathogens.

To introduce a new law in the UK conforming with such notions would require new legislation, drafted with some care. It could not be an immediate or short-term aim. But relaxing the grip of Regulation 511/14 on UK research is too urgent to wait. On Brexit, the Regulation could be transposed into UK law in the Great Repeal Bill, but with specific exceptions. Thus, Article 4.8 (imposing special requirements on pathogen research) could be omitted, and preferably also Article 7.1, so that any obligation to show ‘due diligence’ would be deferred until a product was ready for launch. This could be combined with instructing the enforcing agency (NMRO⁹) to concentrate on ensuring that any GR sample collecting in Nagoya ‘provider countries’ was conducted in accordance with local laws. **D**

References

1. Available at <https://www.cbd.int/convention/text/>
2. See discussion of ‘Legal access’ in <http://webarchive.nationalarchives.gov.uk/20140603093549/http://www.ipo.gov.uk/ipreview-c4e-sub-roberts.pdf>
3. <http://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:32014R0511&from=EN>
4. At <https://absch.cbd.int/>
5. On 31 May 2017, the ABSCH site listed only 52 such certificates – 47 of which were issued by India.
6. According to the Wellcome Trust [September 2014, quoted in Nature, <http://www.nature.com/news/biopiracy-ban-stirs-red-tape-fears-1.16028>], “The protocol has the potential to hamper disease monitoring. Red tape could make it harder to quickly share samples across borders, which in turn could cripple efforts to monitor drug resistance in malaria, for example, or outbreaks of *Escherichia coli*.”
7. See <https://academic.oup.com/heapol/article/25/6/476/583821/Haggling-over-viruses-the-downside-risks-of>; also <http://www.tandfonline.com/doi/abs/10.1080/09512748.2014.909523>
8. Smyth D, <https://www.chemistryworld.com/opinion/we-need-to-talk-about-nagoya/7408.article>
9. <https://www.gov.uk/government/organisations/national-measurement-and-regulation-office>

European Trade Marks and Community Designs after Brexit

CIPA's President writes to Theresa May urging action on EUIPO Brexit issue,
CIPA press release 17 September 2018

CIPA President Stephen Jones has written to Prime Minister Theresa May, and to the “Brexit” Secretary Dominic Raab, urging the Government to include the UK's continued participation in the European Union trade marks and design systems in ongoing negotiations with the EU.

Brexit will have no effect on the existing arrangements for patents because the European Patent Office is not an EU institution, but European Trade Marks and Community Designs are filed at the European Union Intellectual Property Office (EUIPO). To avoid the Government having to create new equivalent UK trade mark and design rights to provide continued protection for rights holders, with potentially significant inconvenience and cost to businesses of all kinds, Mr Jones asked Mrs May to add the EUIPO to the list of EU agencies in which the UK would continue to participate after Brexit. In the White Paper on the future relationship between the United Kingdom and the EU, the Government lists these as the European Chemicals Agency, the European Aviation Safety Agency and the European Medicines Agency. This would also be consistent also with the commitment in the White Paper to explore other options on intellectual property, including participation in the proposed new Unified Patent Court and unitary patent system.

Mr Jones reminded the Prime Minister that, given the White Paper's emphasis on frictionless trade between



the UK and the EU, including between the Republic of Ireland and Northern Ireland, the provisions for protection of trade marks and designs were of crucial importance. In CIPA's view, the best way of ensuring continuity would be the UK's continued participation in the EUIPO system, under new arrangements that recognised the UK would not be a Member State, as proposed for the other agencies listed. Mr Jones said:

“CIPA urges the Government to add the EUIPO to the list and explore with the EU ways in which the UK can continue to participate in a common registration system for trade marks and designs after leaving the EU. This will greatly benefit UK and EU businesses as well as our trading partners in the rest of the world, and facilitate the commitment in the White Paper to providing the means for continuation of frictionless trade between the UK and the EU.”

Registration of Trade Marks and Designs after Brexit

Letter sent to The Rt. Hon. Theresa May MP, The Prime Minister, from CIPA's President, Stephen Jones, 28 August 2018:

I am writing to you on behalf of the Chartered Institute of Patent Attorneys (CIPA) to urge the importance of the UK's continued participation in a common registration system for trade marks and designs after leaving the EU.

Members of CIPA represent clients in intellectual property matters including patents, trade marks and designs. Their clients come from the UK, Europe and all over the world, including businesses large and small, individuals and institutions.

The white paper on the future relationship between the United Kingdom and the European Union (“The White Paper”) recognises that intellectual property (IP) rights play an essential part in encouraging the universal benefits of innovation and creativity, as well as protecting the reputation of products and services, and CIPA notes the Government's commitment to the further development of the UK as an innovation-driven economy.

In that regard we welcomed the UK's ratification of the Unified Patent Court Agreement as an international court that will be a dispute forum for the EU's unitary patent and for European patents. As the White Paper notes, both of these will be administered by the European Patent Office, which is not an EU institution, and thus unaffected by Brexit. CIPA was pleased therefore to see the commitment in the White Paper for the UK to work with other contracting states to make sure

the Unified Patent Court Agreement can continue on a firm legal basis and the UK can stay in the Court and the unitary patent system after the UK leaves the EU.

Given the White Paper's emphasis on frictionless trade between the UK and the EU, including between the Republic of Ireland and Northern Ireland, the provisions for protection of trade marks and designs are of crucial importance. As a member of the EU, the UK is now part of the system for EU-wide registration of trade marks and designs administered by the EU Intellectual Property Office (EUIPO). CIPA and other intellectual

property organisations in the UK have emphasised the need to ensure continuity in the protection of trade marks and designs after Brexit, and the best way of ensuring that would be the UK's continued membership of the EUIPO's registration system.

The White Paper envisages that the UK would continue to participate, after Brexit, in certain EU agencies including the European Chemicals Agency, the European Aviation Safety Agency and the European Medicines Agency, under new arrangements that recognise the UK will not be a Member State. CIPA urges

the Government to add the EUIPO to that list and explore with the EU ways in which the UK can continue to participate in a common registration system for trade marks and designs after leaving the EU. This will greatly benefit UK and EU businesses as well as our trading partners in the rest of the world, and facilitate the commitment in the White Paper to providing the means for continuation of frictionless trade between the UK and the EU.

I have written today in similar terms to your Cabinet colleague the Secretary of State for Business, Energy and Industrial Strategy. **D**

No deal technical notices

CIPA's response to no deal technical notices. Press release 24 September 2018

The technical notices on intellectual property issued by the Government on 24 September spell out the consequences for the various forms of IP if the UK were to leave the EU without a deal. This is still said by the Government to be "unlikely given the mutual interests of the UK and the EU in securing a negotiated outcome."

CIPA has been engaging with the Government on what it would like to see in a negotiated solution, and has welcomed an approach which would see the UK able to participate in the UPC, the Unitary Patent, and, if possible, the EUIPO, despite Brexit.

It has to be recognised that leaving the EU without an agreement would put us in a different situation. The technical notice on patents, nevertheless, makes clear that the existing regimes for patent protection in the UK, including via European patents granted by the EPO, will not be affected, and that UK-based European patent attorneys will continue to have rights to represent clients before the EPO, in accordance with CIPA's "business as usual" message. This will also be the case for SPCs, which will be continued in the UK under domestic legislation, and for the rules relating to patenting biotechnology inventions.

The technical notice recognises different possibilities for the UPC in the event of no deal, depending on the timing of any ratification by Germany, and whether the court comes into effect before or after the date of Brexit. However, the notice makes clear that the UK will explore whether it would be possible to remain within the Unified Patent Court and unitary patent systems, even in a 'no deal' scenario.

For trade marks and designs, the notice reiterates the already stated intention that the UK will replicate EU rights on the UK register "with minimal administrative burden" (which will need

to be defined, but we hope it means that there will be no official fees) and that the holders of pending applications will be able to refile for a UK equivalent right within nine months of the date of exit so as to preserve their filing and priority dates.

The Government has confirmed that unregistered Community designs will continue to be protected in the UK, and that the UK will create a new unregistered design right in UK law, which mirrors the characteristics of the EU unregistered design right. The UK will amend legislation to ensure that it functions effectively once the UK is no longer part of the EU system for designs.

Other aspects of the technical notices deal with exhaustion of rights, confirming that the UK will continue to recognise the EEA regional exhaustion regime from exit day, and copyright.

CIPA will continue to work with the UKIPO and other arms of Government to urge the best approach to preserve the rights of the users of the system and their representatives. Where you are able to engage with your MP or other potential influencers please do urge them to make sure that IP gets appropriate priority in the Brexit negotiations. The various technical notices can be found at these links:

- **Patents** if there is no Brexit deal – <https://www.gov.uk/government/publications/patents-if-theres-no-brexit-deal>
- **Trade marks and designs** if there is no Brexit deal – <https://www.gov.uk/government/publications/trade-marks-and-designs-if-theres-no-brexit-deal>
- **Copyright** if there is no Brexit deal – <https://www.gov.uk/government/publications/copyright-if-theres-no-brexit-deal>
- **Exhaustion of rights** if there is no Brexit deal – <https://www.gov.uk/government/publications/exhaustion-of-intellectual-property-rights-if-theres-no-brexit-deal>

WIPO fax service for PCT applications

In the PCT newsletter in December 2017, it was announced that fax services at the International Bureau of WIPO would be discontinued for PCT applications in the near future.

The newsletter explained that, due to the cessation of the analog lines, the reliability of the fax services cannot be guaranteed. It can now appear to the sender that a transmission has been successful even though some or all of the transmission has in fact been lost.

Whilst this potential decline in reliability was acknowledged by CIPA in a meeting with representatives from WIPO in April 2018, it was pointed out that there are situations where this service is required e.g. when other services are not available. As a result, WIPO reassured those present at the meeting that the fax services will not be turned off until there is a completely reliable backup system in place. This backup system will

be a simple independent online service that facilitates the depositing of documents, providing a receipt in return.

WIPO has now confirmed its intention to end fax services from the end of the year, subject to the planned backup system being in place by the start of December 2018. More information is available in a WIPO PCT circular, number C. PCT 1545*. Fax users should certainly beware the risks associated with fax and be prepared for an alternative way of working as the world moves on.

* In case you haven't seen, the circular has now been published and can be found at: <http://www.wipo.int/pct/en/circulars/> or <http://www.wipo.int/pct/en/circulars/2018/1545.pdf>

Theo Carter (Student)

UK delivering world-leading EPAs

European qualifying examination results demonstrate the high quality of the UK's patent attorneys. CIPA press release, July 2018







The 2018 European qualifying examination (EQE) results demonstrate that, year-on-year, the high standard of training in the UK is delivering world-leading European patent attorneys. The rigorous EQE papers determine whether candidates have the knowledge and ability to represent clients before the European Patent Office (EPO).

The 2018 results continue a clear trend of UK candidates outperforming their counterparts in Germany and France by considerable margins across all EQE papers (see tables below). The widest differences in this year's results were for paper D, which the EPO says aims to "assess candidates' ability to answer

legal questions and to draft legal assessments". The pass rate for UK candidates (62%) was more than double that of German candidates (25%) and significantly higher than that of French candidates (35%).

CIPA President Stephen Jones said that the high quality of UK training, provided by CIPA members and supported by CIPA, was central to UK candidates consistently performing so well in the EQE. He said: "The excellent performance of UK candidates in the EQE is a clear indication of the first class service that clients of the UK's European Patent Attorneys can expect to receive."

EQE pass rates for candidates in the UK, Germany and France, for 2017 and 2018:

	A (Drafting)	B (Amendment)	C (Opposition)	D (Law)
 United Kingdom – 2018	61%	84%	71%	62%
 Germany – 2018	50%	73%	44%	25%
 France – 2018	49%	70%	40%	35%
 United Kingdom – 2017	77%	85%	70%	74%
 Germany – 2017	51%	71%	49%	32%
 France – 2017	56%	68%	59%	38%

See the full CIPA press release online for more information

No patent shield for Allergan

Native American tribes do not enjoy sovereign immunity, which would protect their patents from challenge in the Patent Trial and Appeal Board of the USPTO. By **John Richards** (Fellow).

 On 20 July 2018 – in *Saint Regis Mohawk Tribe, Allergan Inc v Mylan Pharmaceuticals Inc* – a panel of the US Court of Appeals for the Federal Circuit (Dyk, Moore and Reyna JJ) held that Native American tribes do not enjoy sovereign immunity which would protect their patents from challenge in inter partes review (IPR) proceedings before the Patent Trial and Appeal Board (PTAB) of the United States Patent and Trademark Office (USPTO).

The court characterized such tribes as “domestic dependent nations” that possess an “inherent sovereign immunity”, and suits against them are generally barred “absent a clear waiver by the tribe or congressional abrogation”. However, this immunity does not extend to actions brought by the federal government¹. After consideration of the recent Supreme Court decisions in *Oil States Energy Services v Greene’s Energy Group, LLC*² and *SAS Institute Inc. v Iancu*³, the Federal Circuit held that IPR proceedings are more like an agency enforcement action than a civil suit brought by a private party, and concluded that tribal immunity is not implicated.

The case arose following decisions by the Patent Trial and Appeal Board of the USPTO (PTAB) that the sovereign immunity the US Constitution affords to the individual states protected patents owned by the states and state entities from challenge in *inter partes* review in the PTAB⁴. (Also see November [2017] CIPA 24.) Following this, and noting that case law had held that Native American tribes also possessed a degree of sovereign immunity, Allergan transferred patents relating to its Restasis® drug to the Saint Regis Mohawk Tribe and sought to withdraw from IPR proceedings that had been brought by Mylan and others seeking to have claims of the patents declared invalid. The tribe sought dismissal of the proceedings on the basis of its sovereign immunity. The tribe adopted an intellectual property project to promote the prosperity of the tribe. The PTAB had rejected both requests, which led to the appeal to the Federal Circuit.

The nature of sovereign immunity

Sovereign immunity is a judicial doctrine that prevents the government or its political subdivisions, departments, and agencies from being sued without its consent. The doctrine stems from the ancient English principle that the monarch can do no wrong. After citing a number of earlier cases, Brewer J. in *Price v United States*⁵ stated:

“It is an axiom of our jurisprudence. The government is not liable to suit unless it consents thereto, and its liability in suit cannot be extended beyond the plain language of the statute authorizing it.”

28 USC 1498 provides for suits for compensation against the federal government if it uses a patented invention without permission as follows:

- a. Whenever an invention described in and covered by a patent of the United States is used or manufactured by or for the United States without license of the owner thereof or lawful right to use or manufacture the same, the owner’s remedy shall be by action against the United States in the United States Court of Federal Claims for the recovery of his reasonable and entire compensation for such use and manufacture.

The Constitution of the United States (1789) sets out the powers the states transferred to the federal government when it was adopted. These include the power to legislate for the grant of patents. The 10th Amendment to the Constitution (1791) specifically reserves to the states or the people any powers not delegated to the US by the Constitution. The 11th Amendment (1795) provides that the Judicial power of the US shall not be construed to extend to any suit in law or equity, commenced

or prosecuted against one of the US by citizens of another state, or by citizens or subjects of any foreign state. The 14th Amendment (1868) provides that “No state shall... deprive any person of... property without due process of law” and gives Congress the power to enforce this by “appropriate” legislation.

In 1992, Congress enacted legislation to make the states as well as instrumentalities of states and officers and employees of states acting in a governmental capacity liable for patent infringement in the same way as non-governmental entities⁶. However, the Supreme Court held this legislation to be unconstitutional in *Florida Prepaid Postsecondary Education Expense Board v College Savings Bank*⁷ on the ground of usurpation of a state’s right to sovereign immunity. Under the 14th Amendment Congress’ power to enact such a law to protect the property rights of patent owners was subject to it being “appropriate”. The Supreme Court found that there was insufficient evidence that state use of patented inventions was sufficiently large a problem for the remedy enacted by Congress to be “appropriate”.

It was against this background that the PTAB had held that patents owned by state entities were protected from challenge unless the state had waived its sovereign immunity, for example by seeking to enforce the patent⁸. In reaching its conclusion on the application of state sovereign immunity to PTAB proceedings, the PTAB noted that in *Federal Marine Commission v South Carolina State Ports Authority*⁹, the Supreme Court had interpreted the 11th Amendment to encompass a broad principle of sovereign immunity, not only limiting the judicial authority of the federal courts to subject a state to an unconsented suit, but also precluding certain administrative proceedings, depending on the nature of those proceedings, from adjudicating complaints filed by a private party against a non-consenting state.

PTAB proceedings in *St Regis Mohawk Tribe v Mylan*

When confronted with the St Regis Tribe’s claim for sovereign immunity and Allergan’s attempt to withdraw from the proceedings, the PTAB first held that the Federal Marine Commission decision noted above did not necessarily apply to the sovereign immunity of tribes because this had a different basis from the sovereign immunity of the states¹⁰. *Inter partes* review proceedings were created by a federal statute of general applicability. Case law has held that such statutes normally apply to tribes unless they would affect intramural matters of the tribe, they would abrogate rights guaranteed by Native American treaties or the legislative history indicates that the law was not intended to apply to the tribes. None of these apply here.

Proceedings in the Federal Circuit

As noted above, the Federal Circuit addressed the issue on a rather different basis from the PTAB. In its view, IPR proceedings were “like cases where an agency chooses whether to institute

“ Sovereign immunity is a judicial doctrine that prevents the government or its political subdivisions, departments, and agencies from being sued without its consent. ”

a proceeding on information brought by a private party”. The Federal Marine Commission case had recognized that immunity would not exist in such a situation. In the Federal Marine Commission case where it had been held that immunity did apply, at least for states, the Commission had lacked any discretion to refuse to adjudicate complaints brought by private parties. In IPR proceedings, the Director of the USPTO was much more involved so that, as noted above, the proceedings were more akin to federal government enforcement of a federal law than adjudication of a suit between a private party and a sovereign. Finally, IPR proceedings were significantly different from those in federal courts. Part of the reasoning in the Federal Marine Commission case had been that sovereign immunity should not be circumvented simply by transferring a proceeding from an Article III court to an equivalent agency tribunal. This was not the case with IPR proceedings. In concluding, the Court noted:

“In this case we are only deciding whether tribal immunity applies in IPR. While we recognize there are many parallels, we leave for another day the question of whether there is any reason to treat state sovereign immunity differently”.

What about other claims to sovereign immunity?

Traditionally, sovereign immunity applied to foreign sovereigns as well as domestic ones as an application of comity. However, as countries and their agencies have become more involved in commercial activities, this approach has been modified by statute in many countries. In the US, the Foreign Sovereign Immunities Act¹¹ removes sovereign immunity in cases:

“in which the action is based upon a commercial activity carried on in the United States by the foreign state; or upon an act performed in the United States in connection with a commercial activity of the foreign state elsewhere;

or upon an act outside the territory of the United States in connection with a commercial activity of the foreign state elsewhere and that act causes a direct effect in the United States.”¹²

In *Intel Corp. v CSIRO*,¹³ CSIRO had offered licences under some of its US patents on wireless technology to equipment manufacturers. CSIRO indicated that if licences were not taken it would “consider litigation”. The manufacturers brought declaratory judgment actions on the basis that they were apprehensive of being sued. CSIRO sought to have the actions dismissed on the ground of sovereign immunity, arguing that merely seeking licensees was not a commercial activity. The Federal Circuit disagreed, holding that sovereign immunity did not apply because the actions were “based on CSIRO’s commercial acts of obtaining and asserting a US patent.” It therefore seems that foreign sovereigns and their agents are not immune from PTAB proceedings in which the validity of their patents may be challenged.

Conclusion

The bright idea that assignment of a patent to an entity possessing sovereign immunity might insulate it from challenge in inter partes review or post grant review seems to have run its course, although it remains possible that a different conclusion will be reached where the sovereign immunity is claimed by one of the states who have federated themselves to form the US. ▣

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Notes and references

1. *E.E.O.C. v Karuk Tribe Hous. Auth.*, 260 F.3d 1071, 1075 (9th Cir. 2001); *United States v Red Lake Band of Chippewa Indians*, 827 F.2d 380, 383 (8th Cir. 1987).
2. 138 S. Ct. 1365 (2018)
3. 138 S. Ct. 1348 (2018)
4. *Reactive Surfaces LLP v Toyota Motor Corp.*; *NeoChord Inc. v University of Maryland*; *Covidien LP v University of Florida Research Fund*
5. 174 us 373 (1899)
6. Patent and Plant Variety Protection Remedy Clarification Act
7. 527 U.S. 666 (1999).
8. As had been the case in *Ericsson Inc. v University of Minnesota*
9. 535 U.S. 743
10. As noted above, sovereign immunity of the states derives from the fact that when the Constitution was adopted, the states retained all rights that were not expressly transferred to the federal government. Sovereign immunity for tribes has a different basis. The pre-independence practise of governing relations with Native American tribes by treaties continued after independence (see Marshall J. in *Worcester v Georgia*, 31 USC 515 (1832)). However, the Indian Appropriations Act 1871 changed this practise and made the tribes subject to statute.
11. 28 USC 1602 et seq.
12. 28 USC 1605(a)(2), Similar provisions are found in the UK State Immunity Act 1978, which in section 7 also has specific provisions relating to intellectual property rights, and in the European Convention on State Immunity, which in article 8 also has specific provisions relating to intellectual property.
13. 455 F.3d 1364 79 USPQ2d 1508 (Fed. Cir. 2006)

Framing new technical problems in AI inventions

Artificial intelligence (AI) is an inherently computer-implemented technology. More often than not AI depends on a fresh view of data, and it is unquestionably of the tension between ideas, methods of doing business and computer programs – excluded subject-matter, and solutions to technical problems, which of course opens the door to patent protection. **Rachel Free** (Fellow), in her thought-provoking article, proposes framing a new technical problem and solution, that of securing ethical outputs from the system, as a basis for providing patentable subject-matter in relation to an AI invention.

One of the requirements to obtain valid patent protection in Europe (and arguably in many other jurisdictions), for a computer-implemented invention (CII), is to have a technical problem that is solved in a technical manner, which is new and inventive. Ideally, patent attorneys are able to incorporate in the patent specification at the time of drafting, several of the technical problems and solutions that they find, in order to aid prosecution of the patent application to grant.

Artificial intelligence (AI) inventions are treated in a similar manner since they are essentially a sub-set of CIIs. In considering seeking patent protection for AI inventions, it is interesting to consider whether AI inventions exhibit any new types of technical problems as compared with those that we are familiar with for CIIs in general.

Fundamental technical problems for CIIs

Many of the technical problems addressed by CIIs relate to a small set of high-level problems. These can be identified as:

1. saving resources (memory, processing capacity, bandwidth, space, time, power);
2. improving accuracy (of simulation, prediction, control of processes or equipment); and
3. improving security.

In some cases, one of these problems may be subsumed into another. For example, improving accuracy of a prediction may

be part of the problem of saving a resource. However, for the sake of argument, let's assume there are three fundamental technical problems of CIIs.

Note that the three fundamental technical problems are intended to be expressed at a general or high level, independent of a specific task (as “task independent problems”). Examples of problems which include the specific task (“task-specific problems”) are ones like “how to recognise a face from an image depicting a person” or “how to control a manufacturing plant” or “how to reduce burden of user input to a computer”. In the world of patents, if the claim scope is broad (not tied to a task) then one or more of the fundamental technical problems is needed to form a basis of patentability. I have included improving security as being a task independent problem because it is applicable in many different types of specific task.

There are other problems CIIs typically address but are arguably not considered as technical problems at all, due to their abstract nature. Some of these abstract problems are fundamental to CIIs and, more particularly, are fundamental to AI inventions. Examples in AI are: how to represent knowledge/data in a way best suited to the task at hand, how to represent uncertainty, how to search a huge search space/compute an optimisation. Many of these tasks are building blocks used in AI technology.

New technical problems

In the case of AI inventions, I have been finding that there are a number of new technical problems arising that it is difficult to

incorporate into a list of high-level, or fundamental, technical problems. Because these problems are common to many types of AI inventions, I argue that these are new fundamental technical problems, rather than task-specific ones. Some examples are set out below.

Generating a rationale for an AI decision:

An example of this is the claim language paraphrased below and taken from European patent publication number EP3291146 Fujitsu ('146). The claim is directed to an invention where a conventional neural network is mapped into a form where nodes of the neural network have semantic labels. A technical problem here is how to make the behaviour of a neural network more interpretable by humans. When a trained neural network computes a prediction, it is difficult for scientists to give a principled explanation of why the particular prediction was computed as opposed to a different prediction. Such a principled explanation is desirable for ethical reasons. The claim language in '146 captures a new technical problem: "how to make a prediction computed by a neural network more interpretable by humans".

Paraphrased claim 1 of EP3291146

A method for use with a convolutional neural network, CNN, used to classify input data, the method comprising:

- *after input data has been classified by the CNN, carrying out a labelling process in respect of a convolutional filter of the CNN which contributed to classification of the input data, the labelling process comprising using various complicated filters to assign a label to a feature of the input data represented by the convolutional filter;*
- *repeating the labelling process for each convolutional filter used;*
- *translating the CNN into a neural-symbolic network in association with the assigned labels;*
- *extracting, from the neural-symbolic network, knowledge relating to the classification of the input data by the CNN;*
- *generating and outputting a summary comprising the input data, the classification of the input data assigned by the CNN, and the extracted knowledge, and an alert indication that performance of an action using the extracted knowledge is required.*

Implementing the right to be forgotten

Another example is the problem of how to efficiently remove data about a person from a machine-learning system or a knowledge base, which has been created using data about the person and data about a huge number of other people. This problem is also referred to as "how to enable the right to be forgotten". Removing data about a person is extremely difficult where that data has become subsumed in a complex representation of data inside a computer, such as a deep

neural network, without completely retraining the neural network. Removing data about a person from a knowledge base is also extremely difficult for the same reason. Ways of tracking which data has been used in which parts of the knowledge base and removing the effects of data need to be invented. This would overcome the high costs of completely retraining or reconstructing the neural network or knowledge base. These problems are very complex, and more than mere administration since they could not be done manually and since there is no straightforward solution currently known.

Determining accountability where an autonomous agent is involved

Determining accountability, for example, when an autonomous vehicle is involved in a collision or event resulting in death of a human or other harm is a very real obstacle to securing acceptance of autonomous decision-making systems. The problems involved in determining which entity is accountable are known to be extremely difficult to solve. Indeed, a recent report from the European Commission proposed that because of this difficulty a sensible and pragmatic way forward is to make the autonomous AI agent itself the entity which is accountable¹. As a step towards this, tamper-proof ways of recording state of the autonomous vehicle need to be invented, and ways to trigger when it is appropriate to record such state so that after an event involving harm, the recorded state can be used as evidence. How to record state of the autonomous agent in tamper-proof ways will become even harder in future because there will be a possibility for the AI agent to be deceptive. Humans will need to invent ways to record state in ways guaranteed to represent ground truth.

Driving "acceptable" behaviour

A further example is how to create a trained machine-learning system to perform a task in a manner that is acceptable to humans, so that, for example, it is not biased against particular sections of society. A machine-learning system trained to recognise faces might inadvertently be biased against people from a particular ethnic group, depending on the training data used. If a solution to this problem is more than mere abstract statistics, there is potential for a technical solution.

The "problem" of ethics using AI

If we think about the new technical problems of AI inventions discussed above, these are all concerned with so-called "AI ethics". That is, they reflect the values that societies hold concerning how to use and create AI. The AI ethics value of each of the examples is:

- In the case of generating a rationale for a decision computed by a neural network, that humans should have a right to know that an automated decision is being used and how the automated decision has been made when

that decision uses personal data and the decision has a legal effect on the person.

- In the case of how to remove data about a person from an AI system, that humans have a right to withdraw consent to use of their data in some cases, and that the withdrawal of consent should be effective.
- In the case of determining accountability, that it should be possible to determine which human entities and legal persons are responsible or accountable for artificial, or semi-artificial, autonomous agents.
- In the case of unacceptable behaviour such as avoiding bias, that AI (or at least its use) should be fair and not discriminate against particular sections of society.

Returning to the list of fundamental CII problems, note that the first and second (efficient use of resources, and greater accuracy) relate to objective determinants based on the laws of nature, whereas the third, improving security, arises from and is determined by human-made requirements. Adding the AI ethics-related “technical” problems to the list, would be adding further human-made requirements, determined on the basis of human made rules of ethical conduct. There are potentially several new entries into the list in this class, including: how to achieve transparency; how to give data privacy rights; how to enable accountability; and how to ensure fairness.

Do AI ethics-related problems have anything in common?

If AI ethics-related problems have something in common, then perhaps we can replace them in the list by a single new fundamental problem.

In my view, the AI ethics-related technical problems do have commonality, which is: “how to address the risks that come with increasingly able AI”. I would, therefore, argue that we should add this problem to the list of fundamental technical problems of CIIs. The rationale for each of these is that:

- generating a rationale for a decision computed by a neural network will help humans to control the AI as AI becomes more “able”;
- implementing the right to be forgotten gives individuals the ability to control AI in the use (or abuse) of their personal data as the use of AI becomes more pervasive;
- enabling accountability to be determined such as by recording the ground truth state of an AI agent in a tamper-proof way gives humans the ability to know what an AI agent has done; and
- avoiding bias enables humans to ensure AI agents act fairly, again as the use of AI becomes more pervasive.

I have therefore argued that the fundamental technical problem to be added is “how to address the risks of increasingly able AI”².

What is the relevance of a “new” fundamental technical problem to patent drafting and patent prosecution of CII inventions?

- The list of fundamental technical problems provides a resource to help the patent drafter work with the inventors to identify technical problems to be mentioned in the patent specification.
- During prosecution the list can also be used to identify and frame technical problems based on material in the specification, although it is much harder to rely on problems that are not already expressly mentioned in the specification.

In addition to using the idea of a wider set of fundamental technical problems, and specifically the addition of ethics-based technical problems, practitioners also need to take account of the formally different steps that the European Patent Office and the UK IPO apply in implementing the patentability test.

Organic nature of technical problems in European patent law

One of the joys of the European Patent Convention is that it contains no definition of the word “technical” and so there is room for organic growth of members of the set of fundamental technical problems as technology itself organically grows. When examining the technical or non-technical nature of problems, examiners typically look to the nature of the problem and the skill set of the person or team of persons who have solved the problem. If the nature of the problem is abstract, administrative, aesthetic, or a business problem, it is outside the set of technical problems. Generally speaking, the AI ethics problems mentioned above are not abstract, administrative, aesthetic or business problems and they will be solved by technical people such as engineers and data scientists. Therefore, there is a strong argument that the AI ethics problems mentioned above are technical problems and will be incorporated into the set of technical problems by organic growth and eventual recognition in case law.

Is there a need for a new signpost for technical subject-matter addressing the risks of increasingly able AI?

In contrast, the UK courts and the UK IPO adopt the *Aerotel* test, with the further elucidation provided by Lewison J in *HTC v Apple*³, with five signposts to whether the actual or alleged contribution is actually technical in nature.

When UK IPO examiners come to examine AI ethics-related inventions they will apply the *Aerotel-Macrossan* test⁴, and consider the five signposts in *HTC v Apple*, since these are part of the examination methods applied for CIIs.

The *Aerotel* test comprises four steps:

1. properly construe the claim;
2. identify the actual contribution;
3. ask whether it falls solely within the excluded subject-matter; and

- check whether the actual or alleged contribution is technical in nature.

With AI ethics-related technical problems, the contribution will lie in ways to make AI computation interpretable by humans, ways to remove data from already trained AI systems, ways to make AI fair, and ways to assist with accountability of AI. I have already argued above that these are technical problems, which are sub-problems of the fundamental technical problem of how to address the risks of increasingly able AI. Assuming these contributions are in software it can be argued that the contributions are solely excluded subject-matter. If the check at step 4 of the test fails, then the possibility of valid patent protection in the UK for AI ethics-related technical problems is in doubt. Perhaps the five signposts can help?

The five signposts are set out below for ease of reference. None of the signposts are particularly helpful for AI ethics inventions, although, as noted below, there is perhaps an argument that signpost two is. Legal certainty would be better if we can “grow” a new signpost, which points to “how to address the risks that come with increasingly able AI” as being a direction in which technical problems are potentially to be found.

The five signposts originated through a review and analysis of European Patent Office case law, which was made several years ago in *AT&T Knowledge Ventures/Cvon Innovations v Comptroller General of Patents*⁵. Lewison J (as he then was) set out five signposts that he considered to be helpful when considering whether a computer program makes a relevant technical contribution. In *HTC v Apple*⁶, Lewison LJ reconsidered the signposts.

Notes and references

- See JURI draft report of 31 May 2016 PE582.443 2015/2103(INL) setting out a series of recommendations on civil law rules on robotics.
- I would note that others have suggested a more fundamental problem, namely that of how to control super-intelligent machines. (In *Superintelligence* (Oxford University Press 2014), Nick Bostrom argues that as AI advances there will eventually be an exponential explosion in the rate of improvement of AI cognitive ability, which results in a singleton super-intelligence that will pose an existential risk to humanity.)
- HTC v Apple* [2013] EWCA Civ 451
- Aerotel Ltd v Telco Holdings Ltd & Ors* Rev 1 2007 RPC 7
- AT&T Knowledge Ventures / Cvon Innovations v Comptroller General of Patents* [2009] EWHC 343 (Pat) (AT&T/CVON).
- HTC v Apple* [2013] EWCA Civ 451

Signpost one – the claimed technical effect has a technical effect on a process which is carried on outside the computer (from *Vicom*). With regard to the AI ethics problems mentioned above there is no control of a process outside the computer when these problems are solved. Therefore, signpost one is not applicable.

Signpost two – the claimed technical effect operates at the level of the architecture of the computer; that is, whether the effect is produced irrespective of the data being processed or the applications being run. (from *IBM T0006/83*, *IBM T0115/85*)

We can try to argue that signpost two points to the technical nature of the AI ethics problems mentioned above. This is because solutions to the AI ethics problems should be independent of the nature of the data being processed. In the case of how to enable accountability to be determined, the AI agent needs to have innovative technology for recording its state in a secure manner, and if this innovative technology were independent of the type of data involved, then signpost two arguably applies. However, signpost two is inapplicable where the solution is data-type dependent.

Signpost three – the claimed technical effect results in the computer being made to operate in a new way (from *Gale*).

We can try to argue that signpost three points to the technical nature of the AI ethics problems mentioned above, for example, where a new operating system has built-in AI ethics. However, if the AI ethics are application specific, it will be harder to apply signpost three successfully.

Signpost four – the program makes the computer a better computer in the sense of running more efficiently and effectively as a computer (from *Vicom*, *Symbian*).

There is an argument that signpost four is not applicable to the AI ethics problems mentioned above because those AI ethics problems are not about efficient running of the computer. There is another argument that a computer which has functionality for (even as software) the avoidance of ethically non-compliant processing runs more effectively, since it produces an ethically acceptable outcome with a greater degree of confidence.

Signpost five – the perceived problem is overcome by the claimed invention as opposed to merely being circumvented. (from *Hitachi T0258/03*)

Signpost five may or may not apply to the AI ethics problems mentioned above depending on the solutions to those AI ethics problems. □

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Nestlé v Mondelez

Give the Kat a Break: the CJEU says “no” to borders, not to chocolate bars

In a reminder, timely in the context of Brexit, of what the EU single market means and its implications for a “unitary” right, the CJEU confirms¹ (unsurprisingly) that an EU trade mark should serve as a distinctive sign across the whole EU. The CJEU found that the EUIPO was wrong in failing to express its findings in respect of all Member States. That is, they were wrong not to make a positive finding of acquired distinctive character in some of the Member States, albeit those had lower proportion of the EU population. They should try again. **Alasdair Poore** (Fellow) examines the decision – emphasizing that this is not a defeat for Nestlé, but one more step in a drawn out and confusing battle. It has implications for non-traditional trade mark protection in an era when IP owners are challenging the traditional boundaries of IP protection more frequently, and could provide further food for thought on securing perpetual protection for a client’s product shape. The CJEU’s (sensible) remarks on the difference between “facts” and “the means of proving such facts”, are also something which have equal relevance outside the field of trade marks.

The recent decision of the CJEU in the KitKat case (*Nestlé v Mondelez*) (referred to as *Nestlé 2* below, because it is the second CJEU decision on KitKat shape marks) cannot have passed even the most ardent patent-focused attorney by.

A defeat in Nestlé 2?

Some of the media have portrayed the CJEU decision as a defeat for Nestlé². For example, *The Daily Telegraph* reported: “Nestlé suffers defeat in decade-long KitKat court battle: Nestlé has lost a legal battle over whether the shape of its KitKat chocolate bars can be protected by an EU trade mark, after a dispute lasting more than a decade with Cadbury.” (*The Daily Telegraph*, 25 July 2018); and a more confused *Business Matters* reported: “Nestlé defeated in legal case to copyright the shape of KitKat bars: A European court rejected an appeal by Nestlé today to copyright the shape of its KitKat chocolate bars.” (*Business Matters*, 25 July 2018)³ – resonating with square bananas?

However, this is just one step in a variety of proceedings in which Nestlé has sought to protect the KitKat chocolate bar – perhaps not surprising in the light of Nestlé advertising expenditure over the years⁴. There was, of course, a real defeat in the UK, arising out of Nestlé’s UK trade mark application. Those proceedings also lead to a reference to the CJEU. Arnold J, somewhat exasperated with the CJEU decision, found Nestlé’s trade mark application was not registrable⁵, and was upheld on appeal⁶ (*Nestlé 1*). The two decisions show that there are still interesting questions for Nestlé ahead; and Nestlé may yet succeed in the UK, through retaining its Community Trade Mark in the *Nestlé 2* proceedings.

The challenge of shapes

When the Trade Marks Act 1994 came into force, many attorneys who contemplated the use of the enhanced scope of potential trade mark protection to shapes as a means of

obtaining some form of perpetual protection for clients' embodiments of their technical inventions.

A considerable amount of water has flowed under the bridge since then, with cases in (and arising from) the EUIPO and UKIPO making clear that a simplistic view to protect a product shape as a trade mark would almost always be very difficult. Cases such as *Philips v Remington* in 1999⁷, illustrate this. Shape protection runs into several objections, both under CTMR article 7(1)(b), (c), and (d)⁸, which are broadly: “distinctiveness” objections; and article 7(1)(e)⁹, which relate to there being other “value” in a shape, such as the function it performs or its aesthetics (“value” objections) – corresponding to Trade Marks Act 1994 sections 3(1) and 3(2) respectively. The distinctiveness ones can be overcome by showing acquired distinctive character; “value” objections cannot¹⁰. In relation to the KitKat bar, Nestlé overcame the “value” challenges at an earlier stage of the proceedings. They were left having to show the shape of the bar was distinctive.

The underlying issue with distinctiveness objections is firstly that shapes of products are not usually seen by consumers as a pointer to the origin of the goods¹¹. That applies to many shapes of products themselves or often their packaging. Typically, a product has a shape for functional or aesthetic reasons, rather than as an indication of origin. And secondly, that it is even more challenging to show in many cases that consumers would appreciate the shape as a badge of origin if it is not significantly different from other shapes that manufacturers might use – “within the norms and customs in the sector”^{12,13}. (Interestingly, there may be a question whether this still applies in a field where manufacturers typically do have unique product designs

for their products – say for mobile phones. In this case, the objection could be raised on an alternative basis that such a shape consists exclusively of signs or indication which have become customary in the bona fide and established practices of the trade¹⁴.)

Distinctiveness objections can be overcome by showing that the mark has acquired distinctive character¹⁵. The objective here is to show that the consumer has learnt or been taught that the shape indicates where the product comes from, and is the current challenge faced by the four-finger bar shape.

For KitKat and a number of similar cases, there is typically a further hurdle to cross. That is that the shape is often accompanied by other indications which are definitively used as a badge of origin. In the case of the “four-finger bar” this is the presence of the trade mark KitKat. The mark appears as a highly distinctive logo on its packaging and in stylized script embossed on the four-finger bar itself. That means that evidence based on the actual products, as they are marketed, is often ambivalent as to whether consumers are recognizing the shape as a badge of origin, rather than relying on the more conventional trade mark such as KitKat.

The pedigree of Kat shape protection

Nestlé has had a long history of pursuing its cause in seeking trade mark distinction for the KitKat, including its attempt to register “Have a break” as a trade mark. Of relevance here are the parallel UKIPO and EUIPO proceedings in respect of the four-finger bar shape alone. This history is illustrated in the Table [see page 24]. It is of particular interest because the latter stages of the proceedings in the UK and the EU leapfrogged each other, with opposite conclusions (although now not final ones in the EU) being reached on acquired distinctive character in the UK.

It also illustrates the challenging nature of the decision on acquired distinctive character, especially where this depends on showing such acquired distinctive character for a shape which has generally been seen only in conjunction with a clearly distinctive brand.

What did the CJEU decide in Nestlé 2

To understand this, we need to go back to the decision of the Board of Appeal. Its task was to review the decision of the Cancellation Division of the CTMO, that Nestlé had not shown that the four-finger bar shape had “acquired distinctive character” through use of the shape as a trade mark. In reaching the conclusion that it had not acquired distinctive character, the Cancellation Division reviewed the evidence including survey evidence, based on surveys conducted in Member States. The survey evidence showed, for a significant proportion of those surveyed, “the immediate and spontaneous attribution of the contested trade mark to the product bearing the word mark KITKAT”¹⁶. The number of people responding in this way



represented a significant proportion of the population of the EU as a whole¹⁷, and the Board of Appeal specifically found that the shape had acquired distinctive character in ten out of the (then 15) Member States. On that basis the Board had found that the shape mark was registrable. However, they did not make any finding as to whether the shape had acquired distinctive character in the remaining five Member States¹⁸.

On appeal to the General Court, in essence the Court held that the Board of Appeal had answered the wrong question. Nestlé must show that the shape had acquired distinctive character **throughout the EU** – and since no finding had been made in respect of five Member States that question had not been answered. Therefore, it annulled the Board of Appeal decision – a finding as to ten Member States was not a finding as to the whole EU, and as the trade mark rights have a unitary character across the EU, acquired distinctive character must be assessed across the whole EU.

The General Court, incidentally, found that in each of the ten Member States (including the UK) for which the Board of Appeal had found that the shape had acquired distinctive character; they agreed with that conclusion.¹⁹

Turning to the CJEU, its task is to determine whether the correct legal test has been applied (and not to (re-)assess the facts); the CJEU held that the test proposed by General Court was correct²⁰. The question to be assessed was whether the mark had acquired distinctive character **across the whole EU**; and that was not to be shown just by establishing that it had acquired distinctive character in Member States representing a substantial portion of the population of the EU.

The Kat has another life

As noted above, the CJEU decision has been portrayed as by some as a defeat for Nestlé. That is clearly not the case – what it means is that Nestlé must go back a few squares and persuade the EUIPO that the evidence (and any additional evidence that they are permitted to adduce) shows distinctive character **across the whole EU**.

The CJEU has added a pointer as to achieving this – not necessarily by surveying consumers in every Member State. In future that could be quite costly, especially now there are 28 (maybe soon to be 27 Member States), rather than the 15 Nestlé has to contend with. As the CJEU explained (in a common sense

Table: Parallel UKIPO and EUIPO proceedings in respect of the four-finger bar shape

OHIM / EUIPO	UKIPO	
21 March 2002		CTM Application filed
28 July 2006		CTM Registered
23 March 2007		Cadbury apply to cancel CTM
	8 July 2010	UK Application filed
	29 October 2010	UK Application published
11 January 2011		CTMO Cancellation division find invalid
11 December 2012		CTMO Board of Appeal found registrable
	20 June 2013	UK Cadbury opposition successful; mark rejected for all but cakes and pastries
	17 January 2014	UK: On appeal, mark refused for cakes and pastries and reference to CJEU on acquired distinctive character
	16 September 2015	UK reference: CJEU gives opinion on test of acquired distinctive character
	20 January 2016	UK: On resumed appeal, mark rejected entirely
15 December 2016		CTMO: General Court found the BoA had not made sufficient findings and annulled the BoA decision (but concluded that finding of acquired distinctive character in, amongst others, the UK was correct)
	17 May 2017	UK: Court of Appeal confirm rejection of mark entirely
25 July 2018		CTM: CJEU upholds General Court decision annulling BoA decision, but states that findings of GC on acquired distinctiveness (e.g. for UK) were not binding.

evidence pointer for many cases), it is important to distinguish between **the facts to be proved** (distinctiveness across the EU), and **the means of proving those facts**²¹ – so it may be possible to combine survey evidence in one Member State with other evidence to show that consumers elsewhere in the EU would have the same appreciation of the significance of the shape.

Can the Kat be in two places at once?

That does not mean that the challenge is easily resolved. As noted above, in the UK the High Court had already found, before the

General Court made its decision but after the Board of Appeal decision, and the Court of Appeal had decided, after the General Court decision but before the CJEU decision, that the four-finger bar shape does not have acquired distinctive character sufficient to justify registration. Through the broad coincidence of timing the courts in both UK and CTM jurisdiction were able to comment on the relevance of the others decision. Faced with this situation, the courts reached different decisions. However, to an outside observer the evidence looks very similar in each case, so one is left asking whether the courts really are applying

Notes and references

1. Joined cases C84/17 P, C85/17 P and C95/17 P, *Société des produits Nestlé SA v Mondelez UK Holdings & Services Ltd*, www.bailii.org/eu/cases/EUECJ/2018/C8417P.html
2. <https://www.telegraph.co.uk/business/2018/07/25/Nestlé-suffers-defeat-decade-long-kitkat-court-battle/>
3. <https://www.bmmagazine.co.uk/news/Nestlé-defeated-in-legal-case-to-copyright-the-shape-of-kit-kat-bars/>
4. The figures are fairly confusing, but in the UK proceedings were reported to be between £3 and £11 million a year between 1996 and 2007, and sales in 2005, 2006 and 2007 were between £25 and £33 million.
5. *Société des Produits Nestlé SA v Cadbury UK Ltd* ([2016] EWHC 50 (Ch) – www.bailii.org/ew/cases/EWHC/Ch/2016/50.html)
6. [2016] EWHC 50 (Ch): www.bailii.org/ew/cases/EWCA/Civ/2017/358.html
7. *Koninklijke Philips Electronics NV v Remington Consumer Products Ltd*, CJEU, C-299/99
8. Devoid of distinctive character; signs which may serve in the trade to designate the character of goods; signs which have become customary in the trade .
9. Shape [or other characteristic] of the goods, necessary to obtain a technical result, or which gives substantial value to the goods.
10. Article 7(3), TMA1994 section 3(1), proviso
11. *Nestlé 2*, CA: para 20: “Specifically, average consumers are not in the habit of making assumptions about the origin of products on the basis of their shape or the shape of their packaging in the absence of any graphic or word element, and it may therefore prove more difficult to establish distinctiveness in relation to such a three-dimensional mark than in relation to a word or figurative mark: see, for example, Case C-136/02P *Mag Instrument v OHIM* [2004] ECR I-9165 at [30].” and para 21: “Secondly, it follows that the more closely the shape for which registration is sought resembles the shape most likely to be taken by the product in question, the greater the likelihood of the shape being devoid of distinctive character: see, for example, *Mag Instrument v OHIM* at [31].”
12. *Nestlé 2*, CA para 28: “The shape was within the norms and customs of the sector or was a mere variant on common shapes for chocolate bars and biscuits, that is to say, rectangular bars with breaking grooves resulting in individual pieces or fingers. It was therefore not such as to permit average consumers to distinguish the product from those of other undertakings and was *prima facie* devoid of distinctive character.”
13. See for example the recent London taxi case: *The London Taxi Corporation Limited v Frazer-Nash Research Limited (2) Ecotive Limited* [2017] EWCA 1729 (www.bailii.org/ew/cases/EWCA/Civ/2017/1729.html)
14. CTMR article 7(1)(d), TMA 1994 s3(1)(d)
15. CTMR article 7(3), TMA 1994 s3(1) proviso
16. General Court, para 101
17. General Court, para s143, 169 (almost 50% of the public representing almost 90% of the population of the (then) EU)
18. General Court, para 170 to 173: “173. In that regard, it must be pointed out that the Board of Appeal did not explicitly answer the question whether it had been established that the contested trade mark had acquired distinctive character in Belgium, Ireland, Greece and Portugal. However, it is apparent from a combined reading of paragraphs 83 and 88 of the contested decision that those territories were not included among those of the Member States in respect of which the Board of Appeal considered that it had been established that the intervener was identified as the commercial origin of the product having the shape of the contested trade mark.” Note that in the EUIPO argument, they apparently framed this as “a considerable percentage of them spontaneously and immediately associated that shape with the word mark KITKAT or the intervener.” (emphasis added) – the precise issue on which the UK courts had made a reference to the CJEU.
19. General Court paras 146-167
20. CJEU, Para 87, 88
21. CJEU, para 79
22. 2014 EWHC 16, para 54 www.bailii.org/ew/cases/EWHC/Ch/2014/16.html
23. General Court, para 65
24. CA: para 105
25. General Court, paras 86-91
26. CJEU, para 80-83
27. Office decision: para 109 (<https://www.ipo.gov.uk/t-challenge-decision-results/o25713.pdf>) – “i. There is no evidence that the shape of the product has featured in the applicant’s promotions for the goods for many years prior to the date of the application.”
28. CA: para 123: “It is clearly acknowledged on both sides that survey evidence will not often be enough on its own, and that in many cases evidence of the efforts made to educate the public as to the mark being distinctive of the proprietor’s product will be needed. Those points are, as it seems to me, backed up by the need to show that the consumers’ perception of the mark, taken alone, as designating the proprietor’s product arose in consequence of the use of the mark as a trade mark and as a result of the mark’s capability of distinguishing the product concerned from those of other undertakings.”



the same test. This brings us back to *Nestlé 1*, and the CJEU's response to the reference made by Arnold J as to the test for acquired distinctive character.

Readers may recollect that in *Nestlé 1*, the Court asked the CJEU (to paraphrase)²² whether, for there to be acquired distinctive character, it was sufficient for a consumer, when shown the mark, to make an association with a particular manufacturer or other source of the goods; or was it necessary that the consumer should “rely” on the mark as indicating the source – such that it would influence their purchasing decision.

To Arnold J's frustration, the CJEU chose to answer a different question:

“the trade mark applicant must prove that the relevant class of persons perceive the goods or services designated exclusively by the mark applied for, as opposed to any other mark which might also be present, as originating from a particular company.”

That this is not an easy test to apply is demonstrated by the fact that the parties in *Nestlé 2* were still arguing about the conclusion before the General Court²³. It (and indeed the “reliance” test) is even more difficult to apply in practice when combined with the problem of generally having two marks (a distinctive brand and a “shape mark”) always appearing together. In that case it will almost always be a hypothetical question, as the consumer will not actually meaningfully be faced with a similar purchasing choice in real life. If they see a four-finger bar sold without any wrapping, and see that it does not bear the usually KitKat trade mark, will they think: “this can't be a KitKat because it does not say KitKat”; or will they assume it is a KitKat but naked of the usual markings? And does that matter? The test proposed by Floyd LJ is perhaps the most helpful conceptual test:

“I have found it helpful to have in mind a basket of unwrapped and otherwise unmarked chocolate bars, in the shape of the mark applied for, available for selection in a shop or supermarket. For there to be acquired distinctiveness, the consumer must perceive these goods as being KitKats, or as originating from the people who make KitKats, and not from others. A perception that they looked like KitKats is not enough. Acquired distinctiveness carries with it an indication of exclusive trade origin.”²⁴

The CJEU and General Court²⁵ acknowledged that it may well be the case that other evidence (and not just direct evidence of consumer perception, such as survey evidence) may be relied on as helping to show that consumers would perceive the goods as originating from a particular company. But mostly this is not likely to be directly probative of a consumer response. This makes it even more difficult to predict the outcome of the test in any particular case. The CJEU further observed that it is not always necessary that evidence be submitted in respect of each individual Member State for example:

“due to a geographic, cultural or linguistic proximity between two Member States, the relevant public of the first has a sufficient knowledge of the products and services that are present on the national market of the second.”²⁶

So the answer is very probably, however unsatisfactory, that even if a uniform test is applied, the Kat may be found in two different places by different courts – giving rise to an inevitable uncertainty in the Member State unitary continuum. Nestlé may yet succeed in protecting the mark in the UK.

Some implications for shapely Kats?

The conclusion from the CJEU's decision in *Nestlé 2* must be that:

1. The Kat is not dead (yet).
2. Future Kats (otherwise, other “shape of goods” marks) will find it more challenging to be registered as CTMs, because of the need to establish acquired distinctive character across the whole EU; and the same will apply to other marks that lack inherent distinctive character, such as somewhat descriptive words, at least in areas of the EU where those words are understood.
3. For shape marks, if the applicant encourages the appreciation by consumers that the shape has a trade mark meaning, that may be apparent in surveys of consumers, but will also likely be relevant to a court's assessment of whether the shape has a trade mark character, and has acquired distinctiveness. For the UK, this may also be relevant to a point made both by the hearing officer in *Nestlé 1*²⁷ and by the Chancellor in the Court of Appeal²⁸ in *Nestlé 1*: that the shape should have acquired distinctive character **through its use as a trade mark**.
4. For the attorney, there may be scope for engineering their client's product position such that they can obtain perpetual protection for the shape as a trade mark, but that is likely to need careful long-term planning.

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Patent decisions

Standards essential patents | Infringement | Validity | Construction | Obviousness

Koninklijke Philips NV v (1) Asustek Computer Incorporation, (2) Asustek (UK) Limited, (3) Asus Technology Pte. Ltd, (4) HTC Corporation, (5) HTC Europe Co. Ltd
[2018] EWHC 1826 (Pat)
19 July 2018; Arnold J

This decision relates to the second of a number of technical trials in a series of proceedings between Philips on the one hand, and Asustek and HTC on the other.

Philips was the proprietor of European Patent (UK) No. 1623511, relating to a radio station in a communication system. The patent had been declared as essential to the 4G UMTS standard. Philips claimed that the mobile devices made by Asustek and HTC (the defendants) infringed the patent by virtue of their compatibility with the UMTS standard. The defendants counterclaimed that the patent was not essential to the UMTS standard and was in any event invalid for obviousness over a document referred to as “C.S2000”.

Philips did not contest the validity of the patent as granted, but only as proposed to be amended. Of the proposed amended claims, only claim 3 was relevant with two contentious points of construction.

The first contentious point related to the meaning of the term “data transmit power”. The defendants argued that this meant the total transmit power, whilst Philips argued that it could mean the total transmit power or the transmit power of an individual data channel. The second contentious point related to the meaning of the term “predetermined time

period”, which the defendants argued meant any finite period of time. Philips on the other hand argued that it meant a specific period of time over which a data block is transmitted. The judge looked to the patent specification and agreed with Philips that the description gave both terms a clear meaning.

On the basis of the judge’s claim construction, it was common ground that the defendants had infringed claim 3. The issue that remained then was whether claim 3 was obvious over C.S2000.

C.S2000 was a lengthy document relating to the Physical Layer Standard for cdma2000. Cdma2000 was a 2.5G telecommunication standard that had already been superseded by 3G at the priority date of the patent. Furthermore, C.S2000 was the first release of the Physical Layer Standard that had itself been superseded by later releases at the priority date. The defendants relied on a small passage of C.S2000 and argued that the skilled person would see the similarities between cdma2000 and UMTS, and that it would be obvious to implement the technical teachings of the small passage to UMTS. Philips disputed the technical meaning of the passage that the defendants had adopted and argued the skilled person working towards the UMTS standard would not look to an obsolete standard. The judge took into account expert evidence and concluded in favour of Philips.

In summary, the patent in amended form was found valid and infringed. □

The UK patent court case reports are prepared by John Hull, Anna Hatt, Jonathan Markham, Matthew Ng and Sarah-Jane Poingdestre of Beck Greener.

All the court decisions listed in this section are available on the free-to-use website www.bailii.org.

Patent Case Law Seminars 2018

Bristol • Thursday 1 November

London • Thursday 15 November

Glasgow • Wednesday 28 November

Manchester • Wednesday 12 December

The CIPA Patent Case Law Tour is returning for 2018. For more details visit:
www.cipa.org.uk/whats-on/events

CPD: 3.5; Prices: £234 (members £156)

The tour will focus on patent decisions from the UK and US courts and the EPO Boards of Appeal in 2018. Back by popular demand the speakers on the road show are:

- ▶ **Dominic Adair**, Bristows LLP
- ▶ **Gemma Barrett**, Bristows LLP
- ▶ **Dr Jonathan Markham**, Beck Greener
- ▶ **James Porter**, UK IPO
- ▶ **Anthony Tridico**, Finnegan LLP

IPO decisions

Patentability – section 1(2)

Khalil Arafat

BL O/479/18; 2 August 2018

The invention related to a system for verifying the authenticity of printed sheet material, e.g. paper documents. The examiner maintained that the invention was a business method, and that it lacked an inventive step. The applicant argued that the invention could not be a business method per se because the claim was directed to an apparatus, which included various distributed hardware. The applicant argued that the examiner's analysis incorrectly dissected the apparatus into constituent parts and dismissed those parts individually as being known, without acknowledging the invention as embodied by the application as a whole. The applicant further argued that the functionality provided by the new apparatus was not merely a business method, but instead allowed the user to stockpile a store of un-activated (but securable) sheet products, and enabled quick and easy conversion into secure form. The hearing officer agreed with all of the applicant's arguments, and concluded that the invention was not excluded as a business method. The hearing office further found that the claims were inventive. The application was remitted to the examiner to complete examination.

Entitlement – section 37

Rosie Vernon v Christopher Ebejer & Paul Wickens

BL O/521/18; 22 August 2018

A patent was granted to the sole inventor, Christopher Ebejer (one of the defendants). Subsequently, the inventor agreed to form a company with Paul Wickens, the co-defendant, and another party. The company had allegedly been formed as a temporary measure, with the claimant Rosie Vernon as sole director, with the intention to change the names of the directors and shareholders later. Transfer of the patent to the company was recorded in the Register. Subsequently, two further transfers were recorded: from the company to the claimant; and from the claimant to the defendants. The claimant then initiated proceedings claiming entitlement to the patent. The claimant refused to appear at the hearing, and did not agree to be cross-examined, claiming a concern for her personal safety. The hearing officer considered compelling an appearance under rule 82, but decided against doing so as it would almost certainly have required a Court order to enforce. As a result, those parts of the claimant's evidence, which were contested and not supported by other evidence, were disregarded.

The defendant claimed that the original bill of sale was invalid, as the inventor had not been made a shareholder of the company as agreed in the bill of sale, and further because the company

was not formed at the time the bill of sale was signed. On the first point, the hearing officer found that this did not make the transfer of the patent invalid, though it may give the inventor cause for action for breach of contract. On the second point, the hearing officer found that because the company was not formed at the date of the bill of sale, the agreement was between the inventor and the claimant personally. Thus, ownership of the patent passed to the claimant, Ms Vernon, rather than to the company. As such, the second recorded assignment, to the claimant, was in effect a nullity.

The claimant contended that she did not agree to the further transfer of the patent to the defendants, and alleged her signature was forged, providing a report from a handwriting expert as evidence of the difference between her true signature and the signature on the document. The report was, however, stated to be not intended for Court purposes, and so was given little weight by the hearing officer. The only other evidence of the alleged forgery was the claimant's witness statement, which had to be disregarded due to the claimant's refusal to submit to cross-examination. The hearing officer found that the transfer was valid, and that the defendants were the true proprietors of the patent. The claimant's claim to entitlement therefore failed.

Requests for opinions – section 74A

Element Six Limited

Opinion 13/18; 2 August 2018

An opinion regarding validity was requested regarding a patent relating to a touch trigger probe for taking measurements on machines, the requester citing 12 documents as being relevant for novelty or inventive step. The proprietor filed observations, in part arguing that some of the documents contained statements regarding sphericity of a probe tip that were outdated and would not be considered in later technology. The requester then filed two further documents in response to counter the arguments put forward by the proprietor, one document containing similar statements regarding sphericity showing that the requirements had not changed over time and the other raising a new question of novelty regarding one of the dependent claims. The examiner considered that the first document was directed to the question of whether the requirements for sphericity had changed over time and, because it showed a flaw in the proprietor's observations, allowed it to be considered. The other document, however, raised a new question of novelty, which the requester could have provided when

Patent decisions of the comptroller can be found on the IPO website via <http://bit.ly/ipodecisions>, and opinions issued under section 74A via <http://bit.ly/opinion-requests>.

David Pearce (Barker Brettell) and
Callum Docherty (Withers & Rogers)

requesting the opinion. The proprietor would have been denied the opportunity to comment if the document were to be introduced, so the document was not considered. The examiner then went on to consider the other documents and arguments, and found the patent to be invalid for lack of novelty, although some of the dependent claims were found to be novel and inventive.

Extension of time limits – rules 107, 111

Aisha Kasim

BL O/540/18; 29 August 2018

A self-represented applicant (Ms Kasim) filed a patent application, paying the application and search fees. The application was then published, but no examination fee was paid in due time, resulting in the application being terminated before grant in October 2015. The applicant requested reinstatement of the application in a letter in May 2018, but without the use of Patents Form 14. The applicant argued that, due to her unfamiliarity with procedures she had not filed the required Form 10 in time and any notifications, i.e. the notification of publication stating the due date for requesting examination, may have been lost. The IPO's view was that it was too late to request reinstatement, and that the notification of publication had been sent to the applicant's correct address. The applicant claimed not to have received the notification. The case was then referred to senior officials, to be considered under the terms of rules 107 (correction of irregularities) and 111 (delays in communication services), and the applicant was offered a hearing.

Under the rule 107 ground, the applicant argued that the level of customer service she received from the IPO was inadequate, that she had only found out of the termination of the application

by calling the office rather than being notified in writing, and that changes of address might not have been recorded properly. The hearing officer considered that there were no specific irregularities that could be pointed to, and that changes in the applicant's address were updated correctly and quickly. All correspondence had been sent to the correct address for service at the right time, including the notice of publication, and there was no requirement for termination of applications to be notified by post. No irregularity in procedure could therefore be identified, resulting in failure of the rule 107 ground.

Under rule 111, the applicant argued that she had never received the IPO notification of publication letter, which resulted in her not paying the examination fee in due time. The hearing officer considered that, while the letter was sent out correctly, there was no evidence of what happened afterwards. The applicant had submitted all the evidence it was reasonably possible to provide, and it was reasonable to judge the evidential burden on the balance of probabilities rather than beyond reasonable doubt, referring to *Matsushita Electric Industrial Co.'s Patents* [2008] EWHC 2017 (Pat). Since it appeared that the applicant would have taken action had she received the letter, the reason she did not appear to be, on the balance of probabilities, that she did not receive it. It was therefore logical to conclude that something went wrong in the postal system, which was at least the main reason for the failure to file Form 10 in due time. The rule 111 ground therefore succeeded.

The hearing officer considered that third-party terms would need to be imposed, given that the application had been identified as terminated, and proposed terms to be agreed with by the applicant, following which an order could be made to extend the period for requesting substantive examination under rule 111. □

New Students Induction Day – 19 November 2018

As we sadly wave goodbye to the Summer and start to look forward to our Winter events CIPA would like to announce that it has another session of its New Students Induction day on Monday 19 November 2018

The New Students Induction Day will be a chance to learn more about CIPA, PEB, IPReg and more! The day will include:

- an introduction to the commercial context of the IP attorney's work
- an overview of CIPA Informals
- basic business practice, including professional ethics and client care
- an introduction to the training and qualification systems for patent attorneys
- network with other members within the profession

An excellent opportunity for trainees to meet and share experiences, particularly for those based outside London.

Kindly note that in order to attend this event, you must be a Student member of CIPA.

For more information please see the CIPA website or email cpd@cipa.org.uk

EPO decisions

Request for correction – rule 139 and 140 EPC

T 0506/16: *Highly conductive polymer electrolytes and secondary batteries including the same / DOW Global Technologies LLC*

TBA decision of 20 June 2018

Chair: **E. Bendl**

Members: **A. Haderlein, P. Guntz, G. Glod and O. Loizou**

During the course of prosecution the examining division issued the notice of an intention to grant the patent but annexed only two out of the four pages of the claims to the notice; a first page containing part of claim 1 and a second page containing claims 7-13 but omitting what should have been page two with the end of claim 1 and claims 2-6 and what should have been page four with claim 14. The applicant then filed translations of the claims, which both contained the full set of claims. The patent then granted with just the two pages of claims in accordance with the notice of intention to grant.

This was an appeal by the patentee against the decision of the examining division to (1) reject as inadmissible the request for correction of the granted patent under Rule 139 EPC; (2) refuse the request for correction of printing errors in the patent specification; (3) refuse the request for correction of the granted patent under Rule 140 EPC; and (4) reject as inadmissible the request to consider the decision to grant null and void and to issue a further communication under rule 71(3) EPC.

The TBA dismissed the appeal. The patentee had requested that the specification of the granted patent be corrected to include claims 1 to 14 and, as such, it had requested a ‘patent correction’ in the sense of G1/10. However, according to G1/10 such a request is inadmissible whenever made and therefore the patentee was in fact arguing that the rationale of G1/10 did not apply because of differing underlying facts. The TBA disagreed with the patentee. The Enlarged Board’s decision in G1/10 was not confined to situations where a request is filed under rule 140 in pending opposition proceedings but extends to all such requests submitted after the decision to grant and

the TBA noted that the Enlarged Board had in fact referred to examples where the error was made by the examining division. Rule 139, to which the patentee also referred, was also not applicable as it is only available leading up to patent grant and only applies to documents filed with the EPO, not those issued by the EPO. The TBA also held that this was not a case of a printing error or error in publication because the English text of the printed specification matched the documents attached to the last intention to grant. It pointed out that the obligation to check the text to be granted lies with an applicant and they bear the responsibility for any errors in the text regardless of who is responsible for the error. Lastly regarding the argument that the decision to grant was null and void as arising from a substantial procedural violation, the TBA noted that for a null and void decision to be set aside, an appeal must be filed against it. However, the patentee had not done that here, but rather had filed for a request for correction of the granted patent and the appeal was directed to the refusal of this request.

Lack of inventive step – article 56 EPC

T 2570/11: *Method for the treatment of multiple sclerosis by inhibiting IL-17 activity / UCB Pharma, S.A.*

TBA decision of 12 July 2017

Chair: **G. Alt**; Members: **B. Claes, L. Bühler**

This was an appeal against the Opposition Division’s decision revoking the patent for lack of inventive step. The claimed subject-matter was in the form of a Swiss-type medical use claim relating to the use of an antibody with interleukin-17 (IL-17) inhibitory activity for the treatment of multiple sclerosis (MS). The relevant prior art (referred to as D2) presented the results of a study focusing on the expression of IL-17 (a pro-inflammatory cytokine) in MS patients. D2 established a possible link between a high expression of IL-17 and the incidence of MS. However the study acknowledged that the mechanism of action of IL-17 in MS was unknown and qualified certain statements about the possible role of IL-17 in MS as “hypothetical”.

The Board rejected the patentee’s appeal and held that the patent was obvious since D2 established IL-17 as a potential drug target for the treatment of MS and the skilled person would have been prompted by D2 to test inhibiting IL-17 activity in patients with MS

Legal Board of Appeal (LBA) and Technical Board of Appeal (TBA) decisions are available on the EPO website at <https://www.epo.org/law-practice/case-law-appeals/recent.html> and similarly decisions of the Enlarged Board of Appeal (EBA) can be downloaded from <https://www.epo.org/law-practice/case-law-appeals/eba/number.html>. A list of the matters pending before the Enlarged Board is included at <https://www.epo.org/law-practice/case-law-appeals/eba/pending.html>.

Recent notices and press releases of the EPO are published at <http://www.epo.org/service-support/updates.html> and <http://www.epo.org/news-issues/press/releases.html> respectively, and recent issues of the Official Journal can be downloaded from <https://www.epo.org/law-practice/legal-texts/official-journal.html>.

This month’s contributors from Bristows are **Aida Tohala, Matthew Raynor** and **Claire Phipps-Jones**

in the reasonable expectation of having a therapeutic effect for MS, even if not a curative one. Further, the skilled person would have had all the necessary tools to proceed since animal models for MS were available as well antagonistic IL-17 antibodies.

In rejecting the appellant's arguments, the Board held that, although the cytokine network in the context of MS was complicated and poorly understood at the priority date, this did not prevent D2 contributing to the elucidation of the cytokine network in MS and therefore serving as a "promising springboard" to the claimed invention. The skilled person would derive from D2 that IL-17 played an important role in MS and therefore this document identified and validated IL-17 as a potential drug target.

The case highlights the difficulties faced by patentees in defending the inventiveness of a patent from prior art which identifies a potential drug target even if the prior art does not provide any significant insight into the mechanisms by which the target may work on the disease or contain relevant experimental data in support.

Resumption of proceedings for grant – rule 14 EPC

J 0004/17: Pharmaceutical compositions including low dosages of Desmopressin / Reprise Biopharmaceutics LLC
 Legal Board of Appeal decision of 16 May 2018
 Chair: C. Vallet; Members: J. Geschwind and P. Guntz

This was an appeal by the party alleging entitlement to a patent in national entitlement proceedings against the decision of the Legal Division to resume grant proceedings despite a pending appeal in the national entitlement proceedings.

In this decision the Legal Board of Appeal rejected the appellant's argument that a decision to resume proceedings under rule 14(3) EPC can only be issued when there is evidence of abuse of proceedings so as to maliciously divert

the entitlement proceedings in order to stop or delay the grant of the patent. Rule 14(3) EPC gives the deciding bodies of the EPO the discretion to decide upon the date of resumption of the proceedings based on all the considerations that have been developed in the case law. In this instance, the Legal Division had exercised its discretion appropriately to conclude that the stay of the grant proceedings should be lifted considering the specific facts of the case which it thought were most relevant and balancing the interests of the parties. The Legal Board was allowed to consider the failure of the first instance proceedings on entitlement at least to assess the further procedural steps in which parties may engage in the national proceedings and the impact on those proceedings' expected duration. Further the Legal Board was entitled to consider the impact of the length of the stay (in this case already six and a half years) in combination with the point in time when the entitlement proceedings had been initiated and the lifetime of the patent.

Despite this, the Legal Board of Appeal allowed the appeal on the basis of new facts and circumstances of which the Legal Division had not been aware. First, the parties *agreed* to allow results of US discovery into the entitlement proceedings resulting in a delay to the national proceedings. Secondly, despite acting reasonably, in compliance with the procedural law and judicial practice in the national entitlement proceedings, the respondent (the defendant in the national entitlement proceedings) was not acting with any urgency in those proceedings, instead filing pleadings at the very latest opportunity. While not an abuse, this approach was considered: "fundamentally in contradiction with the reasons it has given in favour of a resumption of the grant proceedings". When weighing up the interests of the parties the Legal Board of Appeal therefore concluded that the stay of grant proceedings had to be maintained, as delay willingly taken cannot be used as proof of unbearable harm caused by the duration of the stay of proceedings. ▢



Catching Up With Canada

Update On Canadian Patent & Design Practice, CIPA webinar, Wednesday 24 October 2018

A review of recent developments in Canadian patent and design practice, including:

- An overview of proposed changes to Canada's Patent Rules, introducing shorter deadlines for national phase entry and requesting examination
- The evolving role of the inventive concept in the obviousness analysis based on recent court decisions
- An overview of changes to Canada's Industrial Design Regulations, which come into force on 5 November 2018

- Canada's accession to the Hague Agreement

This webinar will be of interest to those responsible for overseeing patent and design filings or IP strategy in Canada to ensure that you are aware of forthcoming changes in Canada, including changes to important deadlines. The webinar will focus on providing practical tips and information to help you work effectively with Canadian professionals to safeguard your clients' interests as Canada heads through a series of major changes to its IP legislation.

Speakers: **Thomas Bailey & Jennifer Marles** (Oyen Wiggs Green & Mutala LLP) ♦ CPD: 1 ♦ Prices: £72 (£48 CIPAmembers)

Trade marks


Decisions of the GC and CJ


Ref no.	Application (and where applicable, earlier mark)	Comment
<p>GC</p> <p>T-129/16</p> <p><i>Claranet Europe Ltd v EUIPO; Claro SA</i></p> <p>14 November 2017</p> <p>Reg 207/2009</p> <p>Reported by: <i>Ciara Hughes</i></p>	<p>claranet</p> <p>– communications and telecommunications apparatus and instruments, computer software, telephones (9)</p> <p>– data transmission subscriptions, subscriptions to a database, subscriptions to telecommunications service (35)</p> <p>– telecommunications, communications by telephone, data transmission services, telecommunications services, providing telecommunications connections to the internet or databases (38)</p> <p>– design, installation and maintenance, updating and rental of computer software, technical assistance services in the fields of telecommunications and IT (42)</p> <p>CLARO</p> <p>– telecommunications (38)</p> <p>(Benelux mark)</p>	<p>The GC upheld the BoA's decision that there was a likelihood of confusion between the marks pursuant to article 8(1)(b).</p> <p>It was not disputed that the relevant public was both the public at large and the professional public in the telecommunication sector. The BoA's assessment that the goods and services at issue were partly identical and partly similar was similarly not disputed.</p> <p>Although the average consumer would normally perceive a mark as a whole, they would pick out elements of a word mark, which conveyed meaning. The GC endorsed the BoA's decision that the word element 'net' would be perceived as a descriptive of communications networks. The marks were therefore visually similar to an average degree, as they coincided in the first four letters, which were also the distinctive element of the mark applied for.</p> <p>The pronunciation of the signs diverged due to the additional syllable in the mark applied for and the different vowel sounds created by the second syllable of each mark. Contrary to the BoA's assessment, the GC held that the signs were aurally similar to an average degree only.</p> <p>A conceptual comparison was not possible as the earlier mark was meaningless for the relevant public in the Benelux.</p> <p>Notwithstanding the error in assessment of aural similarity, the GC concluded there was still a likelihood of confusion.</p>

The reported cases marked * can be found at <http://www.bailii.org/databases.html#ew> and the CJ and GC decisions can be found at http://curia.europa.eu/jcms/jcms/_6/home

Abbreviations used: A-G = Advocate General; BoA = Board of Appeal; GC = General Court; CJ = Court of Justice of the EU; CTM = Community Trade Mark; EUIPO = European Union Intellectual Property Office; EUTM = European Union Trade Mark; IPEC = Intellectual Property Enterprise Court; PDO = Protected designation of origin; PGI = Protected geographical indication



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Ref no.	Application (and where applicable, earlier mark)	Comment
<p>GC</p> <p>T-102/17</p> <p><i>Galletas Gullón, SA v EUIPO; Hug AG</i></p> <p>16 November 2017</p> <p>Reg 207/2009</p> <p>Reported by: <i>Emma Green</i></p>	<p>GULLON DARVIDA</p> <p>– cookies (30)</p>  <p>– cookies and biscuits, wafers, zwieback (30)</p> <p>IR designating various EU Member States, Danish, Finnish and UK national marks</p>	<p>The GC upheld the BoA's decision that there was a likelihood of confusion between the marks pursuant to article 8(1)(b).</p> <p>The opposition against the word mark had been filed in the name of Hug AG, who sought to rely on marks registered under its prior name, Hug AG Zwieback & Biscuits. It was submitted that ownership of the registration had not changed, and that Hug AG was entitled to bring proceedings in its new name. Before the Opposition Division, Hug AG had adduced the record of the earlier IR (which listed Hug AG Zwieback & Biscuits as owner of the registration). Hug AG sought to adduce further evidence before the BoA to clarify its entitlement to bring the proceedings.</p> <p>The GC held that the BoA was entitled to exercise its discretion to take such evidence into account, as it was additional evidence – within the meaning of rule 50(1) – to allay any doubt regarding entitlement to file the opposition. The BoA did not fail to give sufficient reasons for exercising its discretion and correctly assessed that there had been a clear and unambiguous change of name which involved no change of ownership.</p> <p>As regards likelihood of confusion, the BoA was entitled to find that the marks had an average degree of visual and phonetic similarity. On the basis of the evidence of genuine use filed, the relevant public was the public at large in Germany – as such, the conceptual comparison of the marks was neutral as the words 'gullon' and 'darvida' held no meaning for the German-speaking public. On account of the identity of the goods, the GC upheld the BoA's decision that there was a likelihood of confusion.</p>
<p>CJ</p> <p>C-381/16</p> <p><i>Salvador Benjumea Bravo de Laguna v Esteban Torras Ferrazzuolo</i></p> <p>23 November 2017</p> <p>Reported by: <i>Emma Green</i></p>	 <p>– apparatus for lighting, heating, cooking, refrigerating, water supply and sanitary purposes (11)</p> <p>– consultancy in the field of energy saving (42)</p>	<p>Following a request for a preliminary ruling from the <i>Tribunal Supremo</i> (Supreme Court of Spain), the CJ clarified the interpretation of article 18 in relation to the recovery of ownership of a EUTM by a person other than a representative or agent. Mr Bravo had filed an EUTM application for the figurative SHOWER GREEN mark, which was subsequently registered in his name. Mr Ferrazzuolo considered himself to be the lawful proprietor of the mark, so brought an action before the <i>Juzgado de lo Mercantil</i> (Commercial Court, Alicante), to recover ownership. Hearing the case on appeal, the <i>Audiencia Provincial</i> (Provincial Court, Alicante) considered that it was appropriate to apply national law, as the regime for recovery of ownership under article 18 – namely concerning applications filed by disloyal representatives or agents – did not apply.</p> <p>The CJ confirmed that recovery of ownership of a EUTM registered in the name of an agent or representative without the proprietor's authorisation was governed exclusively by article 18, however, this did not govern actions for recovery of ownership in any other situation. As such, and on the basis that a EUTM must be regarded as an object of property, in situations which fell outside the scope of article 18, national trade mark law in EU Member States regarding recovery of ownership would apply.</p>

Ref no.	Application (and where applicable, earlier mark)	Comment
<p>GC</p> <p>T-906/16</p> <p><i>Laboratorios Ern SA v EUIPO – Sharma (NRIM Life Sciences)</i></p> <p>28 November 2017</p> <p>Reg 207/2009</p> <p>Reported by: <i>Thomas Pugh</i></p>	<p>NRIM LIFE SCIENCES – medical and veterinary preparations and articles (5)</p> <p>RYM – pharmaceutical and sanitary preparations (5) (Spanish mark)</p>	<p>The GC upheld the BoA's decision that there was no likelihood of confusion between the marks pursuant to article 8(1)(b). Notwithstanding the identity of the goods, the BoA was entitled to find that there was no likelihood of confusion on account of the normal level of distinctiveness of the earlier mark, the low similarity of the signs at issue and the above average level of the public's attention.</p> <p>Although the words LIFE and SCIENCES played a secondary role to the word element NRIM at the beginning of the mark applied for, they could not be regarded as negligible in the overall impression created in the mark.</p> <p>The GC endorsed the BoA's assessment that the identity or high similarity of the goods was offset by low degree of visual and phonetic similarity.</p>
<p>GC</p> <p>T-1/17</p> <p><i>La Mafia Franchises, SL v EUIPO; Italian Republic</i></p> <p>15 March 2018</p> <p>Reg 207/2009</p> <p>Reported by: <i>Emma Green</i></p>	 <p>– footwear (except orthopedic), clothing, T-shirts, caps (25) – business management and organisation consultancy services; business management assistance; business management consultation; advisory services relating to business management; commercial management assistance in relation to franchises; advertisement services; issuing of franchises relating to the food and drinks and cafés (35) – services for providing food and drink, bars, cafeterias, cafés (43)</p>	<p>In invalidity proceedings, the GC upheld the BoA's decision to uphold the application for a declaration of invalidity on the basis the mark was contrary to public policy and infringed pursuant to article 7(1)(f).</p> <p>The GC confirmed that the word element 'la Mafia' was distinct from the other elements on account of its size and central positioning and that it therefore was the dominant element of the mark.</p> <p>The GC upheld the BoA's assessment that the word element was understood world-wide as referring to a criminal organisation originating in Italy, which engaged in intimidation, physical violence and murder to conduct drug and arms trafficking, money laundering and corruption throughout the EU. The word element of the mark therefore brought to mind the name of a criminal organisation which had deeply negative connotations in Italy and was responsible for serious breaches of public policy.</p> <p>The fact that the purposes of the mark was not to shock or offend, but instead allude to the Godfather film series was irrelevant to the negative perception of the mark by the relevant public. The other word elements and the rose image contributed to the trivialisation of the perception of the criminal activities and convey a globally positive image of the serious harm done by the organisation to the fundamental values of the EU.</p>

Ref no.	Application (and where applicable, earlier mark)	Comment
<p>CJ</p> <p>Joined cases C-85/16 and C-86/16</p> <p><i>Kenzo Tsujimoto (“KT”) v EUIPO; Kenzo</i></p> <p>30 May 2018</p> <p>Reg 207/2009</p> <p>Reported by: <i>Henry Elliott</i></p>	<p>KENZO ESTATE</p> <ul style="list-style-type: none"> – wine, alcoholic beverages of fruit, western liquors (33) – marketing research on wine, providing information on wine sales, retail or wholesales services for liquor (35) – educational and instruction services relating to wine, testing and certifying of sommelier certification, publication of books on wine (41) – providing foods and beverages; providing temporary accommodation (43) <p>KENZO</p> <ul style="list-style-type: none"> – soaps, perfumery, essential oils, cosmetics, hair lotions (3) – leather goods, bags, hand bags, trunks and suitcases (18) – clothing, footwear (except orthopaedic footwear), headgear (25) 	<p>The CJ upheld the GC’s decision (reported in February [2016] CIPA 29) that the mark applied for would take unfair advantage of the reputation of the earlier mark pursuant to article 8(5) and no due cause for its use had been demonstrated. The GC had correctly ruled that the BoA was justified in using its discretion in taking into account evidence of use of the earlier mark in assessing its reputation, even though such evidence was lodged after the expiry of the period specified for adducing evidence of earlier rights.</p> <p>The GC rightly assessed the similarity of the marks. KT’s argument that the “ESTATE” element was distinctive was inadmissible as it related to a finding of fact by the GC. The GC was fully entitled to find the marks were similar.</p> <p>Contrary to KT’s submissions, the GC’s assessment of the reputation of the earlier mark for clothing, cosmetics and perfume did not relate to late-submitted evidence but to evidence submitted in earlier cases on which the OD had relied in the cases under consideration.</p> <p>The GC had examined KT’s argument that the use of his forename in the mark applied for constituted due cause. The mere fact that “KENZO” was KT’s first name was irrelevant to the issue of whether use of that term constituted due cause under article 8(5). In the circumstances, the GC was entitled to find that the use of the mark applied for would be likely to take unfair advantage of the reputation of the earlier mark without due cause.</p>
<p>GC</p> <p>T-882/16</p> <p><i>Sipral World SL v EUIPO; La Dolfina, SA</i></p> <p>7 June 2018</p> <p>Reg 207/2009</p> <p>Reported by: <i>Louise O’Hara</i></p>	<p>DOLFINA</p> <ul style="list-style-type: none"> – leather and imitations of leather, and goods made of these materials not included in other classes (18) – clothing, headgear, footwear (25) 	<p>In cancellation proceedings, the GC upheld the BoA’s decision to revoke the registration in its entirety pursuant to article 51(1)(a). The appeal related specifically to the BoA’s decision that genuine use had not been demonstrated in relation to T-shirts and caps. The BoA had, however, correctly concluded that, whilst the photographs, sworn statement, licence agreement, invoices and catalogues showed that the mark had been used during the relevant period, the evidence was insufficient to establish genuine use.</p> <p>The sworn statement was incapable of establishing genuine use of the mark as it failed to address the number of T-shirts distributed under the mark. Furthermore, there was no evidence to indicate that the T-shirts, which were acquired by a nightclub to distribute to its customers, had been acquired with the consent of Profit Good, the previous owner of the mark during the relevant period.</p> <p>Invoices submitted were similarly insufficient to demonstrate use, failing to particularise the goods sold or dated outside the relevant period. The mark had been commercialised under a non-exclusive licence agreement: as the purchasers had been redacted from the remaining invoices, it was possible that sales under the mark had been to other licensees, which rendered the invoices incapable for showing public and outward use of the mark.</p>

Ref no.	Application (and where applicable, earlier mark)	Comment
<p>GC</p> <p>T-413/17</p> <p><i>Karl Storz GmbH & Co. KG v EUIPO</i></p> <p>19 June 2018</p> <p>Reg 207/2009</p> <p>Reported by: <i>Aaron Hetherington</i></p>	 <p>– encoders; compact discs; computer programs; computer screens; computer peripheral devices; television receivers; GPS apparatus; interfaces; mobile phones; monitors [computer hardware]; monitors [computer programs]; optical apparatus and instruments; projection apparatus; stereoscopes; teaching apparatus; intercommunication apparatus (9)</p> <p>– apparatus for use in medical analysis; veterinary instruments and apparatus; apparatus for use in orthodontics (10)</p> <p>– scrap books; pictures; paintings, printed matter; books; photographs [printed]; paper articles and stationery; printed publications (16)</p>	<p>The GC partially upheld the BoA's decision that the mark applied for was descriptive of the goods at issue and lacked distinctive character pursuant to article 7(1)(b) and (c), but overturned the decision insofar as it related to stationery goods.</p> <p>The stylisation of the mark was not striking enough to prevent the element '3D' from being clearly recognisable and enable the relevant public to call to mind the concept of three-dimensionality. The fact that the appearance of the mark itself was three-dimensional would only reinforce that notion to the public.</p> <p>The BoA divided the goods at issue into eight separate categories and provided reasoning why the mark was descriptive of the goods in each category. The GC upheld the BoA's decision in respect of seven of the eight categories. However, in relation to 'stationery', the BoA had failed to provide proper reasons why the mark was descriptive in relation to those goods. The GC therefore annulled the decision insofar as it related to stationery.</p>
<p>GC</p> <p>T-807/16</p> <p><i>MIP Metro Group Intellectual Property GmbH & Co. KG v EUIPO; Association Française de Normalisation</i></p> <p>7 June 2018</p> <p>Reg 207/2009</p> <p>Reported by: <i>Charlotte Peacock</i></p>	<p>N & NF TRADING</p> <p>– business management; import and export trading services; advertising (35)</p> <p>– transport services; storage services; packaging and delivery services (39)</p>  <p>– business management; business administration; advertising (35)</p> <p>– transport services; storage services; packaging services (39)</p>	<p>The GC upheld the BoA's decision that there was a likelihood of confusion between the marks under article 8(1)(b). The BoA correctly assessed the marks at issue in their entirety. In the earlier mark, 'NF' was the dominant element given that it occupied the centre of the mark and was significantly larger than the word 'ENVIRONNEMENT', which would be perceived by consumers as referring to the ecological qualities of the relevant services. The word element 'TRADING' in the mark applied for, had a low level of distinctiveness for the relevant services. The relevant public would understand the dominant element of the mark 'N & NF' as referring to two separate entities, namely 'N' and 'NF'.</p> <p>The GC endorsed the BoA's assessment of visual and phonetic similarity. Neither 'NF' nor 'N & NF' conveyed any specific conceptual meaning so there was no conceptual difference to offset the visual and phonetic similarities.</p> <p>Contrary to the BoA's finding, the earlier mark had not acquired enhanced distinctiveness. Although the evidence submitted demonstrated that 'NF' had a long history of use in France to certify certain goods and services and, as a result, enjoyed a reputation in relation to being a sign of certification, the evidence failed to demonstrate that the</p>

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		<p>mark had a high capacity to identify the services in question as originating from a particular undertaking.</p> <p>Notwithstanding its weak distinctive character as a component of the mark applied for, the element ‘NF’ held an independent distinctive role, and on that basis the GC upheld the decision that there was a likelihood of confusion.</p>
<p>GC</p> <p>T-859/16</p> <p><i>Sociedad Anónima Damm (“SAD”) v EUIPO; Schlossbrauerei Au, Willibald Beck Freiherr von Peccoz GmbH & Co. KG</i></p> <p>19 June 2018</p> <p>Reg 207/2009</p> <p>Reported by: <i>Robert Milligan</i></p>	 <p>– beers, mixed drinks containing beers; wheat beer; mineral and aerated waters and other non-alcoholic beverages; fruit beverages and fruit juices; syrups and other preparations for making beverages (32)</p> <p>– alcoholic beverages (except beers) (33)</p> <p>– services for providing food and drink; temporary accommodation (43)</p> <p>KELER / KELER 18</p> <p>– beers, mineral water and soft drinks and other non-alcoholic drinks, drinks and fruit juices, syrups and other preparations for making beverages (32)</p> <p>(Spanish marks)</p>	<p>The GC upheld the BoA’s decision that there was no likelihood of confusion between the marks under article 8(1)(b).</p> <p>The GC confirmed that the goods in classes 32, 33 and the term ‘providing food and drink’ in class 43 were similar but that ‘temporary accommodation’ in class 43 was dissimilar.</p> <p>The GC found that the signs were visually, phonetically and conceptually dissimilar. On a visual comparison, the GC found that the figurative element of the applied for mark was distinctive because of its heraldic connotations, its size and central positioning within the mark. Phonetically, the marks coincided only in relation to the groups of letters ‘ke’ and ‘er’, whilst conceptually there was dissimilarity as the earlier trade mark had no meaning.</p> <p>The GC therefore held that the BoA had been correct to find no likelihood of confusion.</p>
<p>GC</p> <p>T-707/16</p> <p><i>Enoitalia SpA v EUIPO; La Rural Viñedos y Bodegas SA Ltda</i></p> <p>11 July 2018</p> <p>Reg 207/2009</p> <p>Reported by: <i>Louise O’Hara</i></p>	<p>ANTONIO RUBINI</p> <p>– alcoholic beverages (except beers), wines (33)</p>  <p>– alcoholic beverages (except beers); wine, sparkling wine, fortified wine (33)</p>	<p>In invalidity proceedings, the GC upheld the BoA’s decision that the word mark was invalid for alcoholic beverages pursuant to articles 53(1)(a) and 8(1)(b) as there was a likelihood of confusion with the earlier figurative mark.</p> <p>The GC dismissed Enoitalia’s submission that the surname “Rubini” was common in Italy and therefore not a dominant element when considering the distinctiveness of the mark. Even if commonality of the name could be demonstrated, Italy was only part of the relevant territory of the EU: elsewhere the surname was less common.</p> <p>The GC overturned the BoA’s decision that there was conceptual similarity between the two marks. The fact that both marks were “of Italian origin” was insufficient to bring them together in the minds of consumers.</p> <p>Despite this, the GC endorsed the BoA’s conclusion that, as the differences between the marks were relatively minor and the goods were identical, there was a likelihood of confusion on the part of the relevant public.</p>

Ref no.	Application (and where applicable, earlier mark)	Comment
<p>GC</p> <p>T-71/17</p> <p><i>France.com v EUIPO</i></p> <p>26 June 2018</p> <p>Reported by: <i>Francesca Rivers</i></p>	 <ul style="list-style-type: none"> – advertising (35) – electronic publication (41) – data processing equipment and computer software (9)  <ul style="list-style-type: none"> – advertising (35) – online publication (41) – provision of an online travel database (39) 	<p>The GC upheld the BoA's decision that there was a likelihood of confusion between the marks pursuant to article 8(1)(b). The GC confirmed that France.com was not entitled within the opposition proceedings to rely on its use of the domain france.com, the trade name France.com, Inc. or its prior use of an identical mark to the earlier mark. Had France.com wished to challenge the validity of the earlier mark, it had been open to them to oppose, or otherwise apply to invalidate, the French Republic's registration. There was no infringement of articles 8(2) and 41(1).</p> <p>The GC confirmed that the name of a Member State within a mark may indicate the geographical origin of the goods or services at issue. Consequently, that element carried only weak or very weak distinctive character given its descriptive function.</p> <p>The BoA erred in its assessment of the visual similarity which the GC held to be low, not average. The marks possessed three common elements: the word FRANCE, a stylised image of the Eiffel Tower and the colours blue, white and red, but differed in many other elements, such as the pentagonal shape and '.com' element in the mark applied for and scarf motif in the earlier mark. Phonetically, the marks were almost identical, given that many consumers would refer to the mark applied for as 'France', perceiving the '.com' element as referring to a website. The marks were conceptually identical. Despite the weak distinctive character of the earlier mark, there was a likelihood of confusion given the high degree of phonetic and conceptual similarity and identity and similarity of the services.</p>
<p>GC</p> <p>T-774/16</p> <p><i>Consejo Regulador del Cava v EUIPO; Cave de Tain L'Hermitage, union des propriétaires</i></p> <p>12 July 2018</p> <p>Reg 1308/2013 and Reg 207/2009</p> <p>Reported by: <i>Aaron Hetherington</i></p>	 <ul style="list-style-type: none"> – wines with a registered designation of origin; <i>vin de pays</i> (33) 	<p>In invalidity proceedings pursuant to articles 52(1) and 7(1)(j), the GC upheld the validity of the mark endorsing the BoA's decision that the mark did not infringe the concept of 'evocation' pursuant to article 103(2)(b) Reg 1308/2013. The GC held that the BoA had not disregarded the 'essential function' of a PDO, namely to indicate the specific geographical provenance of a product which enjoyed inherent special qualities due to its origin.</p> <p>The GC dismissed <i>Consejo Regulador del Cava's</i> submission that the BoA had failed to attach an image to the product protected by the PDO CAVA. The BoA had correctly assessed that CAVA designated a sparkling wine produced in various provinces in Spain. The mark at issue did not include or refer to CAVA, instead incorporating the word CAVE. This word would have been understood by French and Spanish speakers to refer to a wine cellar. 'Tain' is a city located in south-east France, diluting the possibility of evocation to the PDO CAVA. Regardless of the language spoken, average wine consumers in the EU would be aware that 'cave' precedes locations in the name of a wine produced in France. This further precluded the possibility of evocation of the PDO CAVA.</p> <p>Even though the goods were partially identical, the marks did not share a sufficient degree of similarity. The invalidity action could therefore not be maintained pursuant to article 7(1)(j).</p>

Protected designation of origin (PDO)

EUIPO v Instituto dos Vinhos do Douro e do Porto, IP (“IVDP”) CJ (Second Chamber); C-56/16 P; 14 September 2017

The CJ considered the interpretation of the scope of protection of a PDO and whether such a designation may also amount to an ‘earlier right’ for the purposes of invalidity proceedings under article 53. **Archie Ahern** reports.

IVDP applied to invalidate the registration for the mark PORT CHARLOTTE, covering whisky, on the basis of its prior registration for a PDO PORT/PORTO for port wine under Regulation 1234/2007. The invalidity action alleged infringement of article 53(1)(c) on the basis that the mark took advantage of the distinctive character and reputation of the PDO contrary to article 8(4), and infringement of articles 53(2)(d) and 52(1)(a) on the basis that the mark lacked distinctive character pursuant to article 7(1)(c). By its decision, the GC annulled the BoA’s decision to dismiss the application for a declaration of invalidity. The CJ set aside the judgment of the GC.

After hearing the Opinion of A-G Sánchez-Bordona (reported in September [2017] CIPA 40), the CJ held that the GC had correctly determined that the protections afforded to PDOs under articles 118m(1) and (2) of Regulation 1234/2007 governed in a uniform and exclusive manner both the authorisation of, and limits to, commercial use of PDOs and PGIs under EU law and therefore, in the specific context, there was no need to apply the conditions for protection under Portuguese law.

By reference to the decision in *Budějovický Budvar v Rudolf Ammersin GmbH* (C-478/07) – a decision relating to beer but considered applicable by analogy to the parallel legislation relating to wines under Regulation 1234/2007 – the CJ noted that PDOs were afforded comprehensive protection by EU legislation under Regulation 510/2006, which aimed to create a uniform and exhaustive system of protection across all Member States. However, the CJ held it did not follow from the decision in *Budějovický Budvar* that the exhaustive nature of this system of protection would not be applicable to situations where the national law of a Member State provided additional or stronger protection to PDOs than that afforded by Regulation 510/2006 alone. The CJ therefore held that the GC had erred in law in its interpretation that the protection conferred on PDOs under Regulation 1234/2007 could be afforded additional protection by the national law of a Member State, where that PDO was an “earlier right” within the meaning of article 53(1)(c).

In the absence of any factual evidence to the contrary, the CJ agreed with the GC’s finding that the relevant public would understand the sign PORT CHARLOTTE to designate the name of a place, without making a link to PORTO or PORT. It therefore

agreed with the BoA that the sign PORT CHARLOTTE could not be regarded as use of the PDO.

This was the case even though the PDO “Port” formed an integral part of the mark at issue as the average consumer would not associate a whisky bearing the word “Port” with a port wine covered by the PDO. This was not least because of the differences between the two products including the ingredients, taste and alcohol content, which are well understood by the average consumer and thus there was no evocation of the PDO within the meaning of article 118m(2) (b) of Regulation 1234/2007.

Stay pending outcome of counterclaim for invalidity

Hansruedi Raimund v Michaela Aigner CJ (Ninth Chamber); C-425/16; 19 October 2017

Following a preliminary ruling from the *Oberster Gerichtshof*, the CJ considered whether it was open to a EUTM Court to rule on an infringement action concerning a mark filed in bad faith, before a decision on a counterclaim for a declaration of invalidity had been handed down. The CJ held that an infringement action could not be dismissed before a decision on the counterclaim had been handed down, but that the infringement action may be dismissed before that decision became final. **Emma Green** reports.

The parties both used the word *Baucherlwärmer* in relation to a herbal mixture to be added to alcohol. Mr Raimund owned a EUTM registration for the mark and brought an infringement action before the *Handelsgericht Wien* (Commercial Court, Vienna, Austria) challenging Ms Aigner’s use of the mark in relation to the sale of her products. Ms Aigner claimed that the EUTM registration had been obtained improperly and in bad faith and brought a counterclaim for a declaration of invalidity of the EUTM registration before the same court.

The proceedings on the declaration of invalidity were stayed pending a ruling on the infringement action, which was ultimately dismissed on the basis that Mr Raimund had filed the EUTM application in bad faith. An appeal was filed on the basis that the lower courts considering the infringement action was not entitled to rule on the question of bad faith, when there had not been a final decision on the counterclaim for the declaration of invalidity.

The *Oberster Gerichtshof* (Supreme Court) stayed proceedings and referred two questions to the CJ regarding the application of article 99 and whether it was necessary for the court to first uphold the counterclaim for a declaration of invalidity before being entitled to dismiss an infringement action on the grounds of bad faith.

The CJ ruled that, whilst it was apparent from article 99 that a EUTM was to be presumed valid, it was not possible to determine on the wording of the provision alone whether, where a counterclaim for invalidity has been filed in the context of an infringement action, the EUTM court must uphold the counterclaim before it could dismiss the action for infringement.

The CJ had regard to article 104(1) which requires a EUTM Court to stay infringement proceedings under article 96 where the validity of the EUTM was already in issue before another EUTM court or an application for revocation or a declaration of invalidity had already been filed before the EUIPO. The CJ considered that it would be illogical to permit an infringement action to be dismissed on the grounds of bad faith before ruling on the counterclaim regarding validity of the mark, as this would render the rules relating to actions pending before different EUTM courts to be stricter than those concerning actions pending before the same EUTM court.

The CJ confirmed the following:

1. Given the unitary character of the EUTM and the objective of preventing inconsistent decisions in such matters, the declaration of invalidity of a EU trade mark based on such an absolute ground for invalidity must have effect throughout the Union and not only vis-à-vis the parties to the infringement action.
2. That requirement meant that the EUTM court concerned must rule on the counterclaim for a declaration of invalidity before ruling on the action for infringement.
3. As such, article 99 was to be interpreted that an infringement action on the basis of article 96 may not be dismissed on the basis of an absolute ground for invalidity, without the court having upheld the counterclaim for a declaration of invalidity brought by the defendant to the infringement action, and based on the same ground of invalidity.
4. Furthermore, to ensure the principle of effectiveness was observed, a EUTM court would not be precluded from ruling on the infringement action even though the decision on the counterclaim for a declaration of invalidity had not become final.

Parallel imports of pharmaceutical products

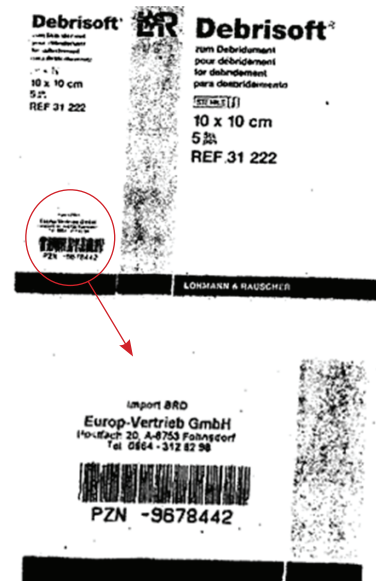
*Junek Europ-Vertrieb GmbH (“Junek”) v
Lohmann & Rauscher International GmbH & Co KG (“L&R”)
CJ (Fifth Chamber); C-642/16; 17 May 2018*

Following a request for a preliminary ruling referred from the Federal Court of Justice, Germany, the CJ held that article 13(2) – now article 15(2) – prohibited the proprietor of a mark from opposing the further commercialisation, by parallel importers, of medical devices in their original internal and external packaging where an additional label had been added by the importer, provided that the content, function, size, presentation and placement of the label did not jeopardise the guarantee of origin of the medical device bearing the mark. **Christine Danos** reports.

Background

Junek was a parallel importer of sanitary preparations for medical purposes and dressings. L&R manufactured the products. The proceedings concerned wound dressings manufactured by L&R and sold under the registered trade mark ‘Debrisoft’, which were subsequently imported by Junek from Austria, relabelled and marketed in Germany.

Junek had affixed a label on the box containing the dressings. The label contained certain information regarding the company responsible for the importation, its address and telephone number, a barcode and a central pharmaceutical number. Junek applied the label to an unprinted part of the box and it did not conceal L&R’s mark on the box, as shown in the illustration below, with the contested label located on the bottom left and enlarged in the second illustration.



Junek had not given prior notice to L&R of the importation of the product from Austria into Germany nor had it provided L&R with a sample of the modified packaging.

L&R successfully brought proceedings against Junek in the Regional Court, Dusseldorf, Germany and obtained an order which prohibited Junek from using the 'Debrisoft' mark in the course of trade without their agreement and obtained a further order for the products to be recalled and withdrawn from the market and destroyed.

Junek's appeal to the Higher Regional Court was dismissed. Junek subsequently filed an appeal to the Federal Court of Justice, Germany. In the reference to the CJ, the Court asked whether the principles developed by in *Bristol-Myers Squibb* (C427/93, C429/93 and C436/93) and *Boehringer Ingelheim* (C348/04) (more commonly known as the 'BMS conditions') applied without restriction to the parallel importation of medical devices.

Parallel importation of pharmaceutical products – the BMS conditions

In the earlier decisions, the CJ held that the proprietor of a mark may legitimately oppose the further commercialisation of a pharmaceutical product imported from another Member State in its original internal and external packaging with an additional external label applied by the importer, unless:

- it is established that the use of the trade mark rights to oppose the marketing of the relabelled products under that mark would contribute to the artificial partitioning of the markets between Member States;
- it is shown that the repackaging cannot affect the original condition of the product inside the packaging;
- the new packaging states clearly who repackaged the product and the name of the manufacturer;
- the presentation of the repackaged product is not such as to be liable to damage the reputation of the trade mark and of its owner; thus, the packaging must not be defective, of poor quality, or untidy; and
- the importer gives notice to the trade mark proprietor before the repackaged product is put on sale, and, on demand, supplies a specimen of the repackaged product to the trade mark proprietor.

In those cases, the parallel importer had opened the original packaging of the pharmaceutical products to insert a translated information leaflet, which also bore the trade mark at issue.

Parallel importation of medical devices

The CJ held that in contrast to the decision in *Bristol-Myers Squibb*, Junek had not modified the packaging of the dressings, nor had it interfered with the original presentation of the packaging other than to attach a small label which did not conceal the mark. The attachment of the label did not affect the specific purpose of the mark, which was to guarantee the origin

of the product it identified. On this basis, the Court held that the attachment of the label by Junek was not a legitimate reason that justified L&R opposing the further commercialisation of the medical device.

Concept of 'Shape'

Christian Louboutin, Christian Louboutin SAS v Van Haren Schoenen BV
CJ (Grand Chamber); C-163/16; 12 June 2018

Contrary to the opinions provided by A-G Szpunar (reported in June [2018] CIPA 43), the CJ held that a sign consisting of a colour applied to the sole of a high-heeled shoe did not consist exclusively of a shape within the meaning of article 3(1)(e)(iii) of Directive 2008/95.

Ciara Hughes reports.

In the course of trade mark infringement proceedings brought against Van Haren by Louboutin, based on the latter's Benelux trade mark registration, the *Rechtbank Den Haag* (District Court of The Hague, Netherlands) requested a preliminary ruling to clarify whether the concept of 'shape' within the meaning of article 3(1)(e)(iii) extended to the colours as well as to the three-dimensional properties of the goods.

The Louboutin trade mark at issue was a figurative mark, registered in respect of 'high-heeled shoes (other than orthopaedic shoes)' in class 25, and described as consisting 'of the colour red (Pantone 18 1663TP) applied to the sole of a shoe as shown (the contour of the shoe is not part of the trade mark but is intended to show the positioning of the mark)', as shown below.



The CJ considered that as Directive 2008/95 did not define the concept of 'shape', the meaning and scope of that concept had to be determined by taking into account its usual meaning in everyday language, the context in which it occurs and the purposes of the rules in which it was found. In the context of trade mark law, the CJ noted that the concept of 'shape' is commonly understood to mean a set of lines or contours that outline the product concerned.

As such, a colour per se, without an outline, could not constitute a 'shape'. With regard to signs consisting of a colour

applied to a specific part of a product, such as the Louboutin mark at issue, the CJ concluded that although the shape of the product or a part thereof was relevant insofar as it created an outline for the colour, such a sign could not be held to consist of that shape where the registration of the mark sought to protect the application of a colour to a specific part of the product rather than the shape itself.

The CJ highlighted that a sign, such as the Louboutin mark at issue, could not be regarded as consisting ‘exclusively’ of a shape, within the meaning of article 3(1)(e)(iii), where the main element of the sign was a specific colour designated by an internationally recognised identification code.

Accordingly, the CJ held that a sign consisting of a colour applied to the sole of a high-heeled shoe did not consist exclusively of a ‘shape’ within the meaning of article 3(1)(e)(iii).

LNDR distinctive for clothing

*Frank Industries Pty Ltd v Nike Retail BV & Ots**
Arnold J; [2018] EWHC 1893 (Ch); 25 July 2018

Arnold J held that Nike had infringed Frank Industries’ validly-registered LNDR trade marks, and committed passing off, by running its “Nothing beats a LNDR” advertising campaign. **Francesca Rivers** reports.

Women’s sportswear company Frank Industries owned UK and EU trade marks consisting of the letters LNDR in upper case. Well-known sports retailer Nike launched a marketing campaign entitled “Nothing beats a Londoner” in which it used the upper-case lettering “LNDR” as an abbreviation of the word Londoner. The lettering was used in a lock-up combining it with the famous Nike Swoosh and/or the words “Nothing beats a” or “Show you’re a”. Frank Industries issued a claim in the IPEC for trade mark infringement and passing off, and obtained an interim injunction preventing Nike from continuing its use of LDNR, LNDR, LDNER or LNDER pending expedited trial. The injunction also required Nike to delete the signs from social media accounts, but this mandatory element was partially varied and discharged on appeal (*Frank Industries Pty Ltd v Nike Retail BV & Ots* [2018] EWCA Civ 497, reported in May [2018] CIPA 39).

Validity of the marks – was LNDR inherently descriptive?

In his judgment, Arnold J dealt first with a challenge by Nike to the validity of Frank Industries’ marks based on their alleged inherent descriptiveness as an abbreviation meaning Londoner – article 4(1)(c). He said there was no evidence presented that the average consumer would perceive LNDR as meaning Londoner when used in relation to clothing without any context, still less that the sign would be perceived to denote some characteristic

of clothing. He rejected Nike’s validity challenge, holding that LNDR was inherently distinctive in relation to clothing at the relevant dates and indeed possessed moderately strong distinctive character.

Infringement under article 10(2)(b)

Arnold J considered LDNR was not an established or recognised abbreviation of Londoner at the relevant date. The lettering was capable of being used and understood either to mean Londoner or as a brand name for Frank Industries’ goods, depending on the context in which it was used. He therefore reviewed several representative examples of Nike’s use of LDNR, including use of the sign on T-shirts, on football pitch-side advertising, in a short promotional film and in the window of the company’s flagship London store. He concluded that Nike had used LDNR in relation to clothing and that the sign had played a distinctive role in, or was at the very least a distinctive component of, each of the complained-of uses he had considered. This was reinforced by the evidence of actual confusion presented. He held that:

“The distinctive character of [the LNDR marks], the close and confusing similarity between [the LNDR marks] and LDNR, the identity of the goods and the moderate degree of attention paid by the average consumer all point towards a likelihood of confusion.”

No defence under article 14(1)(b)

Nike failed to make out a defence under article 14(1)(b). Arnold J had already concluded that LNDR was not an indication of any characteristic of the relevant goods. Furthermore, considering again the factors he set out in *Samuel Smith Old Brewery (Tadcaster) v Philip Lee t/a Cropton Brewery* [2011] EWHC 1879 (Ch), Arnold J considered that Nike had not acted fairly in relation to Frank Industries’ legitimate interests. Even if Nike had acted fairly in the past, given what they now knew, their future use of LDNR would not be in accordance with honest practices.

Passing off

It was common ground between the parties that the passing off claim stood or fell with the article 10(2)(b) infringement claim. Accordingly, the claim in passing off succeeded.

Search and seizure orders

*Bayerische Motoren Werke AG (“BMW”) v Premier Alloy Wheels (UK) Ltd & Ots**
Carr J; [2018] EWHC 1713 (Ch);
 8 June 2018

Carr J granted BMW an “exceptional” search and seizure order against the respondents who were alleged to have dealt in counterfeit BMW products.

Hilary Atherton reports.

The respondents were alleged to have imported counterfeit alloy car wheels from the Far East made to designs virtually identical to those for which BMW held Community registered designs, and counterfeit wheel badges bearing signs identical to BMW’s trade marks and designs. The badges were applied to counterfeit wheels to enhance the impression that they were genuine. One of the respondents had previously given undertakings not to deal in such items when he was caught by BMW while running a different company. Other respondents had not provided undertakings but had been on notice since at least 2014 when BMW had sent them a letter before action. Since then, BMW had investigated the respondents’ activities and gathered substantial evidence over a two-year period before making this application.

Carr J noted that a search and seizure order was an exceptional form of relief. However, he concluded that the relevant conditions were satisfied:

1. there was a strong *prima facie* case of a civil cause of action;
2. the danger to BMW was serious;
3. there was clear evidence that the respondents had incriminating documents or articles in their possession;
4. there was a real possibility of the destruction or removal of evidence; and
5. the harm likely to be caused by the execution of the order on the respondents and their business affairs was not out of proportion to the legitimate object of the order.

Although the Judge had concerns about the substantial delay in seeking the order on the part of BMW, he considered that this was outweighed by the irreparable damage being suffered by BMW and the clear possibility of a danger to public safety. Further, he did not consider that any of the respondents had been prejudiced by the delay.

As the evidence already gathered by BMW was incomplete as regards the number of counterfeit goods sold and the identities and addresses of suppliers and others involved (evidence which may well be destroyed if the order was not granted), the Judge granted the order. However, he advised BMW to “get on with it much more quickly” if seeking an order of this exceptional nature in the future.

Knowledge requirement in passing off

The National Guild of Removers and Storers Ltd v Bee Moved Ltd Asplin and Kitchin LJ*; [2018] EWCA Civ 1302; 12 June 2018

The CA (Asplin LJ giving the lead judgment) dismissed NGRS’s appeal from the decision of the High Court [2016] EWHC 3192 (IPEC) (reported in February [2017] CIPA 43). The CA found that new evidence advanced by the appellants was inadmissible, as it had been available before the original trial. The CA also rejected arguments that the Judge at first instance had imputed a knowledge requirement into the test for passing off. Instead, the CA found that the question to be answered was not whether the defendants had known or been aware of the misrepresentation, but if they had actually made it at all. **Thomas Pugh** reports.

The appellant, the National Guild of Removers and Storers Ltd (NGRS), was a trade body which represented and provided services to its members who were in the removal and storage business. In exchange for upholding certain standards and paying an annual fee, members were allowed to refer to themselves as “members of the NGRS.” The first respondent, Bee Moved Ltd (BM), was a removal and storage company and was a member of NGRS from 20 April 2006 until 25 June 2010. The other respondents, Mr Burns and Mr Sampson, were both directors and 50% shareholders of BM.

At first instance, the claimant had argued that as a result of certain advertisements appearing on pages on four websites after 25 June 2010, in which BM was described as a “Member of the NGRS,” BM was liable for passing off, that the acts complained of were committed pursuant to a common design and that each of BM, Mr Sampson and Mr Burns were jointly and severally liable for them.

NGRS appealed from the decision of Mr Recorder Campbell QC in which he found that the defendants had not been liable for a misrepresentation on a specific webpage (the Really Moving webpage) as they had had no knowledge of the misrepresentation and did not intend it. It was NGRS’s case that fresh evidence had arisen that contradicted the evidence given by the defendants at trial and on which Mr Campbell had relied in coming to his decision. In addition, NGRS argued that Mr Campbell had erred in law that the defendants were not liable, as passing off was a strict liability tort and had nothing to do with the knowledge of the defendant(s).

Evidence

At first instance Mr Sampson gave evidence that shortly before the termination of BM’s NGRS membership he had logged on to the Really Moving site and “removed any reference to [BM] being a member of the claimant’s [NGRS’s] organisation from [BM’s] pages which were accessible on logging in”. NGRS submitted that Mr Sampson was not a reliable witness, and sought to adduce fresh

evidence to show this. The evidence in question was a number of screenshots from an internet archive which, it was submitted, undermined Mr Sampson's evidence and called into question the dates on which he stated he had sought to remove the references to NGRS on the Really Moving website. The CA considered the circumstances under which it would receive evidence that was not before the court below under CPR 52.21(2) and found that it was not appropriate to admit the fresh evidence. The balance in this instance lay with the finality of the litigation. Importantly, the fresh evidence could have been obtained before the trial and the issue of the state of different pages on the Really Moving website immediately before and after the cessation of BM's membership of the NGRS up to and including March 2013, had always been in issue.

Misrepresentation

The CA rejected NGRS's submission that, as passing off was a strict liability tort, it was not necessary that BM intended

a misrepresentation to be made and that Mr Campbell was therefore wrong to impute a knowledge requirement. The CA held that the issue was not one of knowledge; instead the issue was whether the misrepresentation on the webpage could be said to have been "made" by BM or whether BM was responsible for it. It was undisputed that BM had no knowledge of the existence of the directory page on which the erroneous information appeared. Had the opposite been true, or if the defendants had been aware of the page on which the misrepresentation was being made then the outcome could potentially have been different. Ultimately, the CA held that that Mr Campbell was entitled to come to the conclusion he did as, in the absence of implied consent, the misrepresentation was not "made" by BM. Mr Campbell's findings on knowledge in the first instance decision were in relation to whether BM "made" the misrepresentation and was not an "attack upon Lord Oliver's formulation of the requirements of the tort of passing off" as NGRS suggested. ▣



Contributors needed *European Patents Handbook*



CIPA and Thomson Reuters are seeking volunteers to contribute to the *European Patents Handbook*. This loose-leaf is the market leading resource in the area, and publishes three releases a year both in print and on Westlaw UK.

The main duties of a contributor include:

- Taking ownership for the monitoring and updating of one or more specific chapters in a timely manner according to agreed schedules
- Being responsible for proof checking the contribution prior to publication
- Maintaining awareness of developments in the field to which the contribution relates and anticipating how these developments might feed through to the publication
- Participating in the development and enhancement of the work and advising the publishers of such improvements as may be appropriate

We are particularly keen to seek contributors with expertise to cover the chapters on:

- Patentability of inventions
- General procedures of the European Patent Office, publications, registers and information
- Methods of payment of official fees
- The Role of the European Patent Office under the Patent Cooperation Treaty
- Prosecution of a European patent application resulting from an international patent application
- Appeal against decisions of the European Patent Office
- Grant of a European patent

Please contact **Constance Sutherland**, Senior Publisher at Thomson Reuters, for more details on this project – constance.sutherland@thomsonreuters.com

IP Inclusive update



IP INCLUSIVE

Working for diversity and inclusion in IP

By Andrea Brewster OBE

12-18 November is IP Inclusive Week!

What will YOU be doing? We are encouraging everyone in the IP professions to do at least one thing that week, however small, to improve diversity and inclusion (D&I). It could be anything from an in-house coffee-and-cake discussion on your organisation's D&I policies, to a wider event with others in your region, or something in between.

We have a dedicated blog on our website with information about what's going on and suggestions for how to get involved: see <http://www.ipinclusive.org.uk/ip-inclusive-week>. We want to hear about what you're planning! In the month before and during the week itself, we'll be tweeting regularly about #ipinclusiveweek and updating the blog. So please do the same: tweet, post news on your website, and send us your photos and reports to post on ours.

We'll be organising our own activities in and around IP Inclusive Week, some of them through our Women in IP, IP Out and IP & ME support groups. But the important thing is what you do, because IP Inclusive Week is for everyone in the IP professions: not just our supporters and Charter signatories but also the people who have not so far been involved but want to help us create a more diverse and inclusive profession.

Now for some other news. We're delighted to report that we've enough sponsorship already to press "go" on our website upgrade project. Thank you to everyone who pledged funds: the responses were both rapid and generous. We'll keep you posted as the new site develops.

September got off to a good start on the events front too, with a screening of the film *Bombshell: The Hedy Lamarr Story* as a joint project between CIPA and our Women in IP group, and a

webinar on "Unconscious bias and the IP professional". Later in the month we held a get-together for our EDI Charter signatories in Scotland, hosted by Brodies in Edinburgh: this generated our first regional "cluster", which will be sharing ideas, experiences and resources and helping one another to fulfil the Charter commitments. We hope to establish similar networks in other regions soon.

We also co-hosted drinks receptions with CIPA following the Administrators' Conference on 26 September and Congress on 27 September. The latter focused on our BAME support group, IP & ME, and featured a talk by Daniel Alexander QC on ethnic diversity at the IP Bar. And here are some more dates for your diary:

- **Tuesday 9 October, 12.30 pm:** webinar on "Dealing with strong emotions at work". Register via the "What's On" page of the CIPA website.

- **Monday 5 November, 5.30 pm:** IP Out event, with a talk by Lord Chris Smith (the new Chair of IPReg) reflecting on a lifetime of progress in LGBT+ equality. Register via the IP Out section of our website.
- **Thursday 22 November, 5.30 pm:** Women in IP event on flexible working (all genders welcome). Register via the Women in IP section of our website.

IP Inclusive is open to all IP professionals and those who work with them. For more information, visit our website, www.ipinclusive.org.uk; follow us on Twitter (@IPInclusive, @ip_out, @bameipinclusive) or join one of our LinkedIn® groups. And if you're interested in getting involved, please contact andreabrewstercipa@gmail.com. To keep abreast of everything we're doing, join our IP Inclusive Updates mailing list: there's a sign-up button on the website home page.

Announcements

The partners of Abel & Imray are pleased to announce that **Julian Crump** (Fellow) joined the firm as a senior attorney on 4 June 2018. Julian is based in the firm's Bath office and can be contacted on 01225 469914 or julian.crump@abelimray.com.

The partners of AA Thornton are pleased to announce that **Alex Bone, Sarah Darby, Nikesh Patel, Dr Marianne Privett** and **Nick South** have become partners of the firm as from September 2018. All five are CIPA Fellows. See full details at www.aathornton.com/partner-promotions-at-aa-thornton.

Mewburn Ellis welcomed **Andrew Mears** (Fellow) to the firm and the partnership. A qualified patent attorney in the UK, Europe and Singapore, Andrew joins the well-established engineering group. He will be based in the Bristol office. See more at mewburn.com.

Venner Shipley is delighted to announce the appointment of **Paul Misselbrook** (Fellow) as a partner to head up its Manchester office. See more at www.vennershipley.co.uk

Letters for the Editor and announcements should be e-mailed to: editor@cipa.org.uk

Open Innovation and Intellectual Property

CIPA webinar report, Open Innovation and Intellectual Property. 18 September 2018.

Contact cpd@cipa.org.uk for a recording

In the good old days, it was all so straightforward. Research and development was carried out by bright sparks in well-oiled corporate research centres comfortably distant from the world outside. Passive customers waited to have well-defined needs satisfied by a leisurely moving product pipeline. Patent attorneys similarly waited for the next invention off the conveyor belt, all ready to draft well-honed claims with ownership, in the name of ‘The Company’, taken pretty much as granted.

Then it all changed. Management consultants preached ‘breaking up the silos’, that ‘good ideas can come from anywhere’, even that ‘information wants to be free’. Then the accountants got to work on those expensive corporate R&D cost centres. White coats scattered to the wind, consultancies blossomed, start-ups proliferated, customers became innovators, crowd-sourcing happened. Welcome to the new landscape of open innovation, as neatly introduced by webinar chairperson, **Adrian Bradley** (Cleveland Scott York).

This is a landscape in which, patent attorneys – now mainly based in private practice – often find themselves having first to ask ‘where did this idea come from?’ and in which the answer to the question ‘who invented it?’ may or may not be the same as ‘who owns it?’, which might also not be the same as ‘who can use it?’. As many attorney hours may now be spent in tracking down paper trails and perusing agreements as in crafting patent claims. It’s all got a little bit messier!

Are patents still relevant?

Bernie Graves (Baker, Donelson, Bearman, Caldwell and Berkowitz) opened his presentation with a big question: In the new open innovation environment are patents still relevant? A vocal cohort proposes not, suggesting that they simply slow things down and are a harmful distraction. Reassuringly, Bernie reminded us of the useful role that patents play in codifying knowledge, defining rights, mitigating risk and structuring an open innovation approach so that valuable business outcomes can arise in a relatively ordered way.

And yes, open innovation can be untidy. Confidentiality and use agreements give rise to 400 plus disputes per year in the US. In practice, joint inventions do get made before agreements defining ownership are signed. Rules on the rights of joint

owners vary from territory to territory. Final agreement terms are often fixed as a scrappy compromise as parties weary of exchanging heavily marked-up drafts agree to definitions that courts later interpret in unexpected ways. Case studies can give pointers as to both pitfalls and best practice.

Case studies

In *Celeritas Technologies Ltd v Rockwell International Corporation*, there was sharing of information under a confidentiality agreement, which included provisions restricting ‘use’ of the information to be solely for the purposes of evaluating the commercial potential of the technology. Discussions ended without commercial agreement, and the receiving party later developed a different technology, but in doing so made use of some of the information received. A course of action that ended up costing them \$57m as the court found breach of contract.

In *Advanced Thermal Sciences Corporation v Applied Materials*, an extensively negotiated joint research agreement defined four categories of IP: pre-existing IP; program IP (ownership defined); separately developed IP (separately owned); and jointly developed IP (jointly owned). AMI filed ten patent applications asserting sole inventorship. The court later found that ATS had contributed to at least one claim of each patent application, and thus deemed all to be jointly developed IP. But did the parties really want jointly owned patents? Perhaps, it would have been more beneficial to agree to allocate all arising IP according to the commercial interests of the parties (e.g. by field or by placing in a new joint venture vehicle) rather than by reference to who invented?

In *Wisconsin Alumni Research Foundation v Intel*, computing expert Professor Sohi was approached by an Intel researcher to see if he was interested in receiving an unrestricted grant. Unsurprisingly, he said yes, and relatively informal funding letters were exchanged including one in which the Professor thanked Intel for their ‘gift’. A collaboration developed and at some point, the Professor filed a patent application. Later on, Intel sold an allegedly infringing product, which gave rise to a dispute. Licensing discussions began, and access rights in view of the funding by Intel were raised. The court found that the funding letters were essentially ambiguous. Overall, the situation was fuzzy, an example of lack of clarity in managing a funded academic project. The case eventually settled.

In *Caterpillar v Sturman Industries*, a joint development agreement (JDA) was executed relating to fuel injector valves. Sturman suggested an integrated spool valve for use with mechanical fuel injectors, the main area of the joint

Reporters Needed: CIPA is looking for volunteers to report on webinars and regional CIPA events. If you are interested, please contact cpd@cipa.org.uk.

development. This was rejected by Caterpillar who later began exploring the idea for hydraulic fuel injectors. The JDA reached an endpoint and a dispute arose as to ownership of the integrated spool valve. Sturman commercialized the same with other parties. The terms of the JDA were not as clear as they could have been, and the court reached a decision, which gave ownership of some aspects to Sturman and joint ownership in relation to other aspects. In the US, joint ownership gives each joint owner the right to exploit the patented invention “without the consent of and without accounting to the other owners.”

AIA and joint research agreements

As a separate point, we were reminded of the provisions of AIA 35 USC 102(c) relating to common ownership under joint research agreements, in which the prior art status of disclosures made under a joint research agreement can be different and more favorable to the applicant than for other disclosures.

In order to invoke a joint research agreement to disqualify a disclosure as prior art, the applicant must provide a statement that the disclosure of the subject-matter on which the rejection is based and the claimed invention were made by or on behalf of parties to a joint research agreement as defined. The statement must also assert that the agreement was in effect on or before the effective filing date of the claimed invention, and that the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement. Very few published US patents include such a statement, perhaps indicating that these provisions are under-used.

Overall

A valuable reminder of the new difficulties and common pitfalls posed by the open innovation environment and of how through careful good practice these may be navigated. □

Christopher Pike (Fellow)

Anti-Counterfeiting: Practice and Procedure

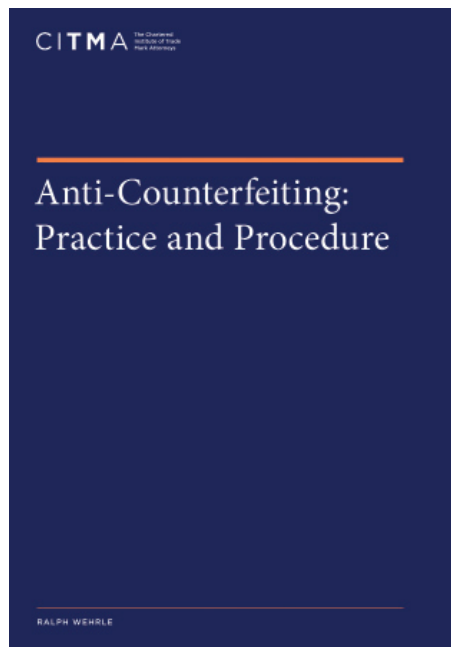
Author: **Ralph Wehrle** Publisher: **The Chartered Institute of Trade Mark Attorneys (2017)**;
ISBN 978-1-9998317-0-7; order online at www.citma.org.uk

Heading the list of the IPO’s “Topical issues for business and consumers” is the subject of counterfeit vehicle parts¹, thus it seems an appropriate time to review *Anti-Counterfeiting: Practice and Procedure* by Ralph Wehrle, a partner at Briffa with over a quarter of a century’s experience in the field.

CITMA publish the book, which has a lot of ground to cover in 194 pages. The utility of it will depend on what anti-counterfeiting “practice and procedure” you are interested in.

The book starts by highlighting the challenge of defining what is even meant by the term “counterfeit”, given the risk of colloquial use, and the numerous rights potentially at issue.

It then sets out practical steps that a rights holder may take to assist anti-counterfeiting of their product. This is split into steps for protection, detection and action, all of which are sensible, if



brief bullet points over four pages. An example would be:

“As regards helping to confirm that product is an infringing product, a rights holder should consider:

- Individualising and tracking genuine product through the supply and distribution chain.”*

Among other suggestions.

I can tell you from experience that even such, prima facie simple measures, may prove complex affairs. For example, applying individually numbered holographic stickers to licensed products. This is a difficult to replicate, low-cost individualising option which permits product tracking. It offers comfort to retailers they are stocking, and to the consumer they are purchasing, genuine items, and products without such features thus stand out.

When the decision has been made this is the appropriate method to use (a challenge in itself), among many things, such stickers need to be obtained. They can be produced

internally, potentially incurring set up costs, or by purchasing from an existing supplier whom you trust to pass them solely to you, and not to make duplicates which go elsewhere. What hologram will be used, and will you change it? If so how often? Where it is to be applied; a product, packaging, both, and if so will they be the same, or different? Customers and stockists need to be educated as to the significance, which takes time and effort. If you're licensing IP to others, they may need assistance with what may be an additional, perhaps even wholly new burden. All of which is before you've started your process of recording what numbered stickers have been distributed where, and how you will track them through the supply chain.

Thus as this is but one way of dealing with a single suggestion, to cover anti-counterfeiting practice and procedure "end-to-end" as it were, this section might benefit from a little more.

The book then covers criminal provisions, many of which should be

known, for example offences under the Trade Marks Act, and others perhaps less so, such as the Forgery and Counterfeiting Act. This really is comprehensive, and where an attorney will not be making the determination as to what offence(s) have been committed, it is an excellent primer to open a discussion with a client as to what may be at issue. This is complimented by an overview of the criminal enforcement agencies, which draws useful distinctions between the powers and procedures of the Police and Crown Prosecution Service, Trading Standards Authorities, Border Force/HMRC, and others. This should help set client's expectations, and where they might offer beneficial input. Criminal proceedings are then covered.

Civil provisions are set out in detail, with procedures, proceedings and remedies, much of which should be familiar.

The book concludes with useful additional actions, including possible assistance by customs authorities, and

an overview of possible actions against online infringement.

In conclusion, if the practice and procedure you are seeking is advising your client what they could do to prevent or reduce counterfeiting, this book will give you pointers, but is not an exhaustive guide.

The practice and procedure this book excels at is in explaining to a client who believes there are counterfeit products available, who can take what action, what will happen, and thus how they might provide useful assistance.

If that practice and procedure is of interest to you, there is no more comprehensive, single guide available. **□**

Tim Allsop (Fellow)

1. <https://www.gov.uk/government/publications/topical-issues-for-business-and-consumers/topical-issues-for-businesses-and-consumers>

Non-Institute events

Professional Certificate in Trade Mark Practice

Provider: Nottingham Law School **Date:** October

Certificate in Registered Trade Mark Attorney – Intensive Course

Provider: Nottingham Law School **Date:** October

Freedom to Operate for the Life Sciences and Pharmaceutical Industries, London

Provider: Assimilate IP **Date:** 15 October

Introduction to EQE Paper C and Paper D, Milton Keynes

Provider: JDD Consultants **Date:** 1-2 November (see page 59)

Lifetime of progress in LGBT+ equality, London

Provider: IP Inclusive **Date:** 5 November

Basic Litigation Skills Course

Provider: CPD Training **Date:** 5-9 November

Preparatory seminar – EQE pre-examination, Strasbourg

Provider: CEIPI **Date:** 5-9 November

Building, Managing and Monetizing Your IP Portfolio, London

Provider: Assimilate IP **Date:** 12 November

Training for the EQE, London

Provider: QM-UL **Date:** 12-13 November (see page 57)

Women in IP event on flexible working, London

Provider: IP Inclusive **Date:** 22 November

Preparatory seminars for papers A+B, C, Strasbourg

Provider: CEIPI **Date:** 23 November

EQE Papers A&B, Paper C and Paper D courses, Milton Keynes

Provider: JDD Consultants **Date:** 26 November – 4 December

13th edition of the Pan-European IP Summit, Brussels

Provider: Premier Cercle **Date:** 28-29 November

Special course paper C for resitters, Strasbourg

Provider: CEIPI **Date:** 30 November and 1 December 2018

Freedom to Operate, London

Provider: Assimilate IP **Date:** 3 December

EQE Pre-exam course, Milton Keynes

Provider: JDD Consultants **Date:** 3-4 December (see page 59)

IP Seminar @AIRBUS, Toulouse

Provider: Premier Cercle **Date:** 6-7 December (see page 62)

See full details at www.cipa.org.uk/whats-on/non-institute-events. To list an event please email sales@cipa.org.uk

Institute Events

For a complete list of CIPA events please see the website – www.cipa.org.uk/whats-on/events



Wednesday 10 October 2018

Webinar

COPYRIGHT AND THE INTERNET

Time: 12.30–13.30

The Internet has developed into an essential piece of infrastructure for businesses and society more generally. The growth in the UK's digital economy continues apace and the government has prioritised the sector in order to take advantage of and accentuate that trend. This growth coupled with the technological innovations in the Internet sphere create significant legal challenges for those making and interpreting the law, particularly copyright law which is central to protecting digital content. This webinar will explore the foundations of UK copyright law and look at some of the ways in which the courts are dealing with copyright in the Internet age by looking at some recent leading copyright cases.

Speaker: Piers Strickland, partner at Waterfront Solicitors LLP
CPD: 1; **Prices:** £72 (£48 CIPA members)



Thursday 11 October 2018

Regional Meeting

THE MANCHESTER MEETING 2018

Time: from 12.30

Location: The Midland Hotel,
16 Peter Street, Manchester, M60 2DS

Speakers include: **John Kennedy**, Wildbore & Gibbons LLP; **Roland Böhrer**, EPO; **Julyan Elbro**, UK IPO; and **Bill Lister**, Appleyard Lees. .

CPD: 3.5 **Prices:** £234 (£156 members).



Tuesday 16 October 2018

Webinar

EPO APPEAL PRACTICE AND PRACTICAL TIPS

Time: 12.30–13.30

This webinar will cover the whole appeal procedure, including what to include in the grounds, how to respond as respondent, what to do when you receive the preliminary opinion and, importantly, how to approach the hearing. Oral proceedings in general can be one of the most critical parts of the job as a EPA and appeal oral proceedings before the Board of Appeal are literally your last chance to get it right. The webinar will include what to do, what not to do, how best to prepare, and how to deal with the things you cannot prepare for.

Speaker: Ilya Kazi, Mathys & Squire
CPD: 1; **Prices:** £72 (£48 CIPA members)



Thursday 18 October 2018

Webinar

REGULATORY DATA & ORPHAN EXCLUSIVITY FOR MEDICINAL PRODUCTS

Time: 12.30–13.30

Patents and SPCs are not the only protection for, and incentive system that encourages, pharmaceutical innovation. Regulatory exclusivities play an increasingly important role, indeed so much so that they can often determine which patents are at potential risk of

challenge. This webinar will address the two most important such exclusivities in Europe – that protecting the data filed in order to secure a marketing authorization for a new medicinal product (Data Exclusivity, or Regulatory Data Protection) and that providing market exclusivity as against similar medicinal products for the same indication where such indication is so rare that the medicinal product in issue has secured an orphan designation.

Speaker: Trevor Cook (WilmerHale)
CPD: 1; **Prices:** £72 (£48 CIPA members)



Wednesday 24 October 2018

Webinar

CATCHING UP WITH CANADA: 2018 UPDATE ON CANADIAN PATENT & DESIGN PRACTICE

Time: 12.30–13.30

A review of recent developments in Canadian patent and design practice, including:

- An overview of proposed changes to Canada's Patent Rules, introducing shorter deadlines for national phase entry and requesting examination
- The evolving role of the inventive concept in the obviousness analysis based on recent court decisions
- An overview of changes to Canada's Industrial Design Regulations, which come into force on 5 November 2018
- Canada's accession to the Hague Agreement

This webinar will be of interest to those responsible for overseeing patent and design filings or IP strategy in Canada to ensure that you are aware of forthcoming changes in Canada, including changes to important deadlines. The webinar will focus on providing practical tips and information

to help you work effectively with Canadian professionals to safeguard your clients' interests as Canada heads through a series of major changes to its IP legislation. See more details on page 31.

Speakers: Thomas Bailey and Jennifer Marles (Oyen Wiggs Green & Mutala LLP)
CPD: 1; **Prices:** £72 (£48 CIPA members)



Thursday 25 October 2018

Webinar

EDUCATING THE CLIENT

Time: 12.30–13.30

The IP practitioner is only too familiar with lay clients who possess a weak grasp of even the most basic IP law, despite frequent dealings with the practitioner through routine casework. Even fellow lawyers such as the client's in-house general commercial solicitor can find IP law challenging. This is bad both for the client and for the IP practitioner, because it can lead to a client failing to seek timely advice, in which case the client gets poor value for money from the practitioner and becomes disillusioned. Providing IP awareness training sessions to clients seems to be better than expecting clients to learn through routine casework. In this webinar, by use of actual target audiences as examples, it is suggested that an audience-focused approach (e.g. "legal-light" in the case of lay clients) allows such sessions to pay off not only for the client but also for the practitioner, who in general will not be charging for such sessions.

Speaker: Dr Michael Jewess
CPD: 1; **Prices:** £72 (£48 CIPA members)



Wednesday 31 October 2018

Webinar

SPC UPDATE

Time: 12.30–13.30

An update on SPC caselaw, the latest news on the study by the Max Planck Institute for Innovation and Competition on the legal aspects of SPCs in Europe, together with

(you can't escape it...) a discussion about the implications for SPCs of a Chequers-inspired Brexit deal (or no deal).

Speaker: Dr Duncan Curley
CPD: 1; **Prices:** £72 (£48 CIPA members)



Thursday 1 November 2018

Seminar

PATENT CASE LAW BRISTOL 2018

Time: 12.30–17.30

Location: Radisson Blu Hotel Broad Quay Bristol BS1 4BY

Join CIPA for the first stop of the Patent Case Law Tour. Our panel will focus on interesting patent decisions to have come from UK and US courts, and the EPO Boards of Appeal in the past year. See more details online and on page 27.

Speakers:

Dr Jonathan Markham, Beck Greener;
Dominic Adair, Bristows LLP;
Gemma Barrett, Bristows LLP;
Anthony Tridico, Finnegan LLP;
James Porter, UK IPO
CPD: 3.5 **Prices:** £234 (£156 members)



Monday 5 November 2018

IP Inclusive

IP OUT EVENT

Time: 17.30; **Location:** Pinsent Masons London office

IP Out event, with a talk by Lord Chris Smith (the new Chair of IPReg) reflecting on a lifetime of progress in LGBT+ equality. Register via the IP Out section of the IP Inclusive website.

IP Inclusive is open to all IP professionals and those who work with them.



Tuesday 6 November 2018 2018

Webinar

PATENT LITIGATION IN CHINA

Time: 12.00–13.00

Understanding the particular enforcement landscape in different jurisdictions is crucial to designing an effective patent filing and claim drafting strategy. This talk gives an overview on patent litigation in China and illustrates through case examples the type of claims that are upheld or slammed down when asserted before the Chinese courts. The first section of the talk will give an overview of the legal framework, court systems, remedies, and defence available in patent litigation. The second half of the talk will review in more detail the recent patent cases that are in the headline, with a focus on claim construction issues. These cases include the view of the Supreme People's Court on Markush claim in the case of Daiichi-Sankyo's patent, the Beijing Higher People's Court's judgment on indirect infringement in the case of *Iwncomm v Sony*, and series of input method litigation cases in *Sogou v Baidu*.

Speaker: Christine Yiu, Bird & Bird
CPD: 1; **Prices:** £72 (£48 CIPA members)



Thursday & Friday

8-9 November 2018

Conference

LIFE SCIENCES 2018

Location: De Vere Tortworth Court Tortworth, Wotton-under-Edge GL12 8HH

See more details online and on page 56.



Monday 12 November 2018

Webinar

HOW TO FUND LITIGATION

Time: 12.30–13.30

The first part of this webinar will look at the more traditional ways of funding, essentially self-insuring/self-funding and "Before the Event" legal costs insurance. The second part will look at alternatives, particularly "After the Event" insurance and the use of

specialist litigation funders and will describe the requirements of funders.

Speakers: Ian Wishart and Paul Wishart
CPD: 1; **Prices:** £72 (£48 CIPA members)



Tuesday 13 November 2018

Regional Meeting

THE WALES MEETING 2018

Time: from 12.30

Location: Clayton Hotel Cardiff, St Mary Street, Cardiff, CF10 1GD

Do not miss your chance to gain 3.5 hours of CPD, plus excellent networking opportunities – including a drinks reception. Speakers include Daniel Voisey (IPO) on 'Patent Search and Examination Procedures at the UK IPO'. See more details online.

CPD: 3.5 **Prices:** £234 (£156 members)



Thursday 15 November 2018

Seminar

PATENT CASE LAW LONDON

Time: 12.30–17.30

Location: De Vere Holborn Bars, 138-142 Holborn, EC1N 2NQ

Join CIPA at the De Vere Holborn Bars where we will focus on interesting patent decisions to have come from UK and US courts, and the EPO Boards of Appeal in the past year. See more details on page 27.

CPD: 3.5 **Prices:** £234 (£156 members)



Monday 19 November 2018

Seminar

NEW STUDENTS INDUCTION DAY

Time: 12.30–17.30

Location: De Vere Holborn Bars, 138-142 Holborn, EC1N 2NQ

The New Student Induction Day will be a chance for student members to learn more about CIPA, Informals, PEB, IPReg as well as talk on key skills and tips for trainees. It is also an excellent opportunity for students to meet and share

experiences, as the day of talks is capped off with a networking drinks reception.

Kindly note that in order to attend this event you must be a Student member of CIPA. This event has limited places and often gets filled up quickly, so please book now! See page 29.

CPD: 7; **Prices:** £78



Tuesday 20 November 2018

Webinar

HOW YOUR CLIENTS CAN FUND EVEN MORE INNOVATION

Time: 12.30–13.30

This webinar, delivered by TBAT Innovation Director Sam Stephens, will highlight the key sources of funding available to companies to help them to innovate and grow. It will also identify where possible funding can be secured to cover patent and IP fees.

The UK is a great place for companies to innovate and successive governments have improved the funding and tax breaks available to R&D intensive companies year on year. From tax breaks for investors through the EIS and SEIS investment schemes, the range of grants underpinning many key technology sectors to pump prime ideation and new product development, R&D Tax incentives to reward innovation and then Patent Box to further reward commercialisation and ongoing R&D activities.

The webinar will touch on all four areas giving a brief background to the scheme, the benefit to the company, opportunities to patent and IPR professional service companies and hints and tips of how to access the funds with the narrative accompanied by appropriate anecdotes and case studies.

This is an opportunity to expand your knowledge of how companies can fund innovation and how your organisation can benefit.

Speaker: Sam Stephens
CPD: 1; **Prices:** £72 (£48 CIPA members)



Thursday 22 November 2018

Seminar

UPDATE ON COMPUTERS AND IP

Time: 12.30–17.30

Location: De Vere Grand Connaught Rooms, 61-63 Great Queen Street, London, WC2B 5DA

Join CIPA and the Computer Technology Committee for an afternoon seminar with a range of speakers covering recent developments in various aspects of IP relevant to the computing industry, including case-law, the impact of Brexit, and patenting AI. See more details online.

CPD: 3.5 **Prices:** £234 (£156 members)



IP INCLUSIVE

Thursday 22 November 2018

IP Inclusive

WOMEN IN IP: FLEXIBLE WORKING

Time: 17.30

Location: Gowling WLG, 4 More London Riverside, London SE1 2AU

Women in IP event on flexible working (all genders welcome). Register via the Women in IP section of the IP Inclusive website. **IP Inclusive is open to all IP professionals and those who work with them.**



Wednesday 28 November 2018

Seminar

PATENT CASE LAW SCOTLAND

Time: 12.30–17.30

Location: Radisson Blu Hotel, 301 Argyle Street, Glasgow G2 8DL

Join CIPA at the Radisson Blu Hotel in Glasgow where we will focus on interesting patent decisions to have come from UK and US courts, and the EPO Boards of Appeal in the past year. See more details on page 27.

CPD: 3.5 **Prices:** £234 (£156 members)



Rejoining the Remotes

Going Remote part 7, by **Lucy Holloway** (Fellow)

When I wrote last month's article I wasn't looking forward to going home. Even as I was typing I was wondering if a month in the UK might change my mind. Maybe I'd be writing my next article about how I didn't want to go Serbia anymore? Perhaps unsurprisingly, that is not the case – I can't wait to get to back to my travel buddies.

It's been great to be back in the UK for a few weeks, I won't lie. I've been able to catch up with people I've missed, visit some of my favourite food spots and (crucially) refresh my wardrobe. The cold I was hoping for didn't materialise (six months of 30+ degrees and 100% humidity does rather make one long for drizzle) but I don't really feel I can complain about coming home to the best summer the UK's had in decades.

Returning to the office has been eye-opening. Deep down I've always felt that working remotely was a compromise and that being in the office was by far the better way to work. Now that I've tried both I'm not so sure. The office has some pretty huge disadvantages too. Commuting is the big one. What an utter waste of time! I cannot believe that at one stage in my life I used to spend 2+ hours of my day – every working day – sat in a car doing nothing. That's more than ten hours a week. Two days out of a whole month wasted.

Yes, it's possible to make commuting time at least passing productive – listen to an audio book perhaps. If you have the luxury of a train you can read. But that still doesn't change the fact that it's time spent doing something you don't really want to be doing, that your employer doesn't really want you to be doing either.

The first couple of days I was back in the UK I commuted into the office, and hated it. On the third day I checked the traffic and saw there'd been an accident on the motorway. There were huge tailbacks all the way to Birmingham. I simply couldn't face spending over an hour on the motorway in my borrowed aircon-free car for a journey that should have taken 20 minutes. Who would benefit from that?

So I didn't. Instead I did an hour's work at home, drove into the office when the traffic had died down, and arrived 20 minutes later with no road rage and only minimal heat exhaustion. An hour working and 20 minutes in the

car versus an hour in the car and 20 minutes working – it seemed a no-brainer to me.

I also found it harder to get work done in the office than I remembered. I always used to think my home was full of distractions, but that was before I came back to 100+ people all wanting to know how my "holiday" was going.

I'll admit that it's not really remote working that's been the revelation this year – it's flexible working. Until I joined Remote Year I was always very much of the mindset that work stays at work and home time is my own. My opinion on that has changed completely over the last few months. I absolutely love the fact that I can start work in my own living room and swap venues later on. I can work from the sofa, from the garden, even from my bed if I want. There's truth in the saying that a change is as good as a rest: swapping to a new venue can be energising when you're starting to hit a wall.



Key facts: Serbia

IPO: Republic of Serbia Intellectual Property Office
– <http://www.zis.gov.rs/home.59.html>

Equivalent of CIPA: none

Number of Registered Patent Attorneys: The Serbian IPO keeps a list of Professional Representatives, which currently shows 78 individuals and five IP firms registered.

Patent filings in Serbia have been in steady decline over the period 2008-2016, from 452 in total to 279. PCT filings are also low, but relatively steady, whereas national phase entries have declined from 73 to just five. Possibly this may be coincide with Serbia joining the EPC – it became a full member state (as opposed to an extension state) on 1 October 2010.

As well as patents, Serbia operates an industrial design system and (for certain limited subject-matter) a utility model system. Utility model filings are low, and also in decline. On the face of things design filings have increased dramatically over the last ten years. However, the overall number of designs being registered has remained relatively constant, and so possibly this is due to a reduction in multiple design applications.*

* statistics courtesy of WIPO Statistics Database

And if I need to do something else – food shopping maybe, or visit the gym – I can fit it into my day at a time that's convenient for me rather than having to skip out of work early or wait for the weekend. I find that being able to take a longer break in the middle of the day makes me more rested and efficient when I come back to work later.

There are downsides to a flexible lifestyle too of course. I'm not sat at my computer 9-5, but I still need to be available during those hours in case something urgent comes in. That's forced me to break my 'no work when not at work' rule. I check email on my phone constantly now. The me of 12 months ago would be horrified.

Flexibility can also, if you're not careful, allow work to bleed into your evenings and weekends until you feel like you never have a single day off. It's so easy to say 'I'll cut Monday short by a couple of hours to go climbing – but it's OK, I'll make it up later in the week'. Then you cut Wednesday short by an hour or two to visit a museum, and Thursday lunch runs on longer than it should... before you know it you're

working Saturday and Sunday too just to get everything done.

And of course, flexibility works both ways. I can't expect Barker Brettell to accommodate my itinerant hours unless I'm willing to make myself available on their terms when things are time sensitive, regardless of what that time might be. I didn't love having client calls at midnight when I was out in Asia, but it was the price I had to pay for being there at all.

The ability to work at a time, and maybe in a place, that's of my choosing has been transformative for me this year. Even just being able to read a document on a sofa rather than at a desk has been wonderful. Remote working certainly isn't appropriate for all jobs, and there are undoubtedly some things that need to be done in person. Even so, I can't help but think that increased flexibility, however slight, is the future. ▣

Lucy Holloway (Fellow) is an associate at Barker Brettell in Birmingham.

Host a trainee patent examiner

Opportunity for IP firms/in-house departments to host trainee patent examiners

The Informals Committee is happy to announce the opening of the annual trainee patent examiner hosting event. This will be the fourth annual running of the event, and based on feedback, it has become very popular amongst the IP community.

The IPO intends to send trainee patent examiners on day-long visits to patent attorneys in private practice and in-house departments. The aim of this event is to mirror the annual CIPA Informals event and allow trainee patent examiners to gain insight into the day-to-day activities of a patent attorney. This event is also a great opportunity for patent attorneys to show patent examiners what happens on the patent prosecution side.

The visits are scheduled to take place any time from November 2018 to the end of March 2019. Once examiners (in groups of up to six) have been allocated to an attorney firm then they will be in touch to arrange the best time for a visit to take place.

Firms and in-house IP departments can sign up by emailing their details to cipainformalsvisits@gmail.com (Please include: name of organisation, location, contact details, how many examiners can attend the visit, and any availability limitations).

A brief with more details of the visit will be sent to firms once places have been confirmed and allocated. We look forward to hearing from everyone.

Sanam Habib, Informals Patent Office Liaison

Books for review

We have some review copies of intellectual property titles. If you are interested in reviewing these for the *CIPA Journal* please contact editor@cipa.org.uk. The titles we have include:

- *Research Handbook on Contemporary Intangible Cultural Heritage* (Edward Elgar) Edited by Charlotte Waelde, Catherine Cummings, Mathilde Pavis and Helena Enright;
- *Intellectual Property and Competition Law* (Kluwer Law International) Edited by Peter Chrocziel; and
- *Kritika: Essays on Intellectual Property* (Edward Elgar) Edited by Hanns Ullrich



The Yellow Sheet

October 2018

Informals Honorary Secretary

Hello all! I'm Matthew and I'm the Informals Honorary Secretary for 2018-2019. First, I'd like to say thank you to last year's committee for the great job they did. Next to welcome in the new committee, who I'm sure will do likewise. For those that have recently joined the profession, we are here to represent you and the Yellow Sheet is where we do our official communication. For those that are still part of the Informals, I hope the exams went well and you are now looking forward to enjoying the events being planned for this year.

Across all the regions of the UK we have Social and Regional Secretaries organising events, so keep watching the Yellow Sheet blog (<https://yellowsheet.wordpress.com>) and social media channels (Facebook – CIPA Informals and Twitter – @CIPAYellowSheet). Also, if you are interested in being part of the Informals, we are always looking for more people to be involved, please get in touch.

The Foundation Lectures are planned to begin again next year and we hope to get the Advanced Tutorials going again, to get you prepared for work and the exams. Also the really successful UK Intellectual Property Office visits will happen again, remember to be quick so you don't miss out when they are announced.

With everything going on I want to remind you that your health and wellbeing is of the utmost importance and CIPA and IP Inclusive are committed to make things

happen to improve mental health for IP professionals. Please remember that you can contact LawCare's helpline on 0800 279 6888 for free and confidential support.

The CIPA New Student Day will be happening in November [see page 29] and I hope to see some of you there. Much more is planned for the year and I hope to bring you exciting news in the future.

Last thing, please remember that the committee is here to represent you, so feel free to get in touch with any comments. You can email me at cipainformalshonsec@gmail.com. Thanks all and I look forward to meeting as many of you as I can this year.

Matthew Veale

Editorial

Hello, I'm Meg, the new Yellow Sheets Editor! I have taken over the reins from Matt, who I would like to thank for doing a wonderful job, and I am excited about working with the new committee. Welcome to anyone new who has just started in the profession, the Informals committee is here to help, so please don't hesitate to contact us if you have any questions.

I'm writing this editorial whilst I sit back after a busy Saturday, watching the birds in the garden. My fiancé bought me a bird table for my birthday and we've filled it with seeds and mealworms, and we have nicknamed it the bird hotel. Unfortunately, we've had no visitors as

they appear too cautious, you'd think we were running a seedy establishment the way they're going on... maybe we should put an announcement on twitter...

Anyway, enough of the terrible jokes – my pledge for the next year is to try and get at least one groaner in per editorial, so look out for those! By the time this edition goes out UK exams will be over (woohoo) and everyone sitting them can enjoy a well-deserved rest. At least until revision for European exams starts! To celebrate the end of exams, Appleyard Lees is hosting a post-exam cocktail and canape evening in Cambridge at Novi on 18 October. Please email the Cambridge Regional Sec, Rose, for more information!

October marks the start of my favourite season – darker evenings, crisp mornings, Starbucks (other brands are available) pumpkin spice latte, Halloween and bonfire night! Don't miss this month's 'Wacky Patent', which is along the Halloween theme! By the time the November edition goes out I will officially be allowed to talk about Chr****s and new seasonal caffeinated drinks.

Enjoy the next month and I'll be back in November with some early festive cheer!

Meg Booth

Regional Secs

Manchester: To celebrate any new starters and the end of UK exam season, we will be putting on a NW social in Manchester on

the week beginning 22 October. Keep an eye out on the blog for details!

Cassandra Smith

South West and Wales: Hi all, I'm Ozgur and I'm the new Regional Secretary of CIPA Informals in the South West & Wales for 2018-19. It is a pleasure to be part of the committee following the great effort put by Matthew over the last year and I aim to continue the good work.

Regional Informals Workshops have been a great success thanks to both involvement of attorneys, firms, companies and organisations as well as the turn-out of the trainees at them. Therefore, I would like to take this chance to encourage anyone who has an idea or would like to put on an event to get in contact so we can plan something out.

Ozgur Aydin

East Midlands: Hi, I'm Kevin. I started as a Biotech trainee patent attorney in June 2018 after a year and a half researching with GSK following my PhD. In my own time I enjoy baking, going to the gym, gaming, and having social drinks with friends. Feel free to drop me a line if you have any East Mids-related questions.

Kevin Rich

Central Scotland: Hi, I'm Rebecca, a trainee at Hindles in Edinburgh. I'll be running events in Central Scotland, mostly Glasgow and Edinburgh but potentially elsewhere too if there's enough interest. I have big plans for pub quizzes, laser quest and escape rooms and I'm always up for hearing new ideas. Keep an eye on The Yellow Sheet and the Informals Facebook group for an event in late October, and if you're not already on the mailing list, get in touch.

Rebecca Douglas

Oxfordshire: Hello all, I'm John and I'll be continuing as the Oxfordshire Informals rep for the next year. If you're brand new to the profession or have just moved to the area and would like to get involved, just

send me a quick email (jsomerton@dehns.com) and I'll add you to my mailing list. I'm planning on organizing an event in the next few months (possibly Bonfire night themed?) so keep an eye on your inbox!

John Somerton

Wacky Patent

With Halloween happening this month I thought it would be appropriate to give the 'Wacky Patent' a mystical/Halloween theme! The people reading this who know me will not be surprised to find that my first contribution is a patent concerning a method of making unicorns! As a horse-riding enthusiast and unicorn obsessive, it seemed appropriate that this, rather unusual (and slightly disturbing) patent should be my first contribution to the Wacky Patent!

The patent entitled 'Surgical Procedures' (US4429685), concerns itself with modifying animals to allow them to produce a single horn, thereby enhancing the overall development of an animal. The history of the unicorn is introduced along with various theories for their existence from unicorned

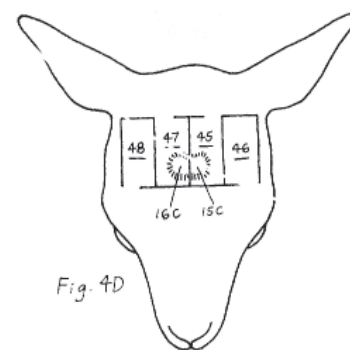
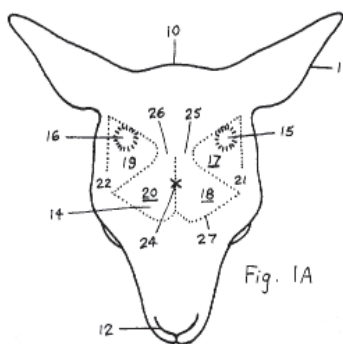
animals developed for protection of herds, to the horn possessing various magical powers. Interestingly, previous attempts at making unicorns (yes, apparently there have been various attempts at producing mythical, horned horses) concerned with moving the horn bud to the centre of the skull before it becomes fused (approximately one week following birth of the animal). According to the patent, horn transplants have been carried out on cows, sheep and goats (I always thought unicorns were majestic horses?).

The inventor's improved method also provides the animal with a higher mental capacity and greater physical capabilities and is conducted on animals that usually have horns growing from each side of its head. Not for the faint hearted, the detailed description did make me feel a bit nauseous and is, in my opinion, a bit disturbing.

I think we should stick to the cute, cartoon type of unicorns currently emblazoned on various household items and clothing found in many shops (and in many rooms of my house).

On that note – Happy Halloween! ▢

Meg Booth



PEB qualifying examination results dates

- Result issued to candidates by email – **Monday 4 March 2019**
- Results published on the PEB website – **Wednesday 6 March 2019**

The Life Sciences Committee is pleased to announce

The 2018 CIPA Life Sciences Conference

Thursday 8th – Friday 9th November 2018
De Vere Tortworth Court, Tortworth, Wotton-under-Edge, GL12 8HH
Up to 9 hours CPD

The CIPA Life Sciences Conference is the UK's premier annual educational and networking event for patent and IP professionals active in the pharma, medical technology and biotechnology sectors. Over nearly two decades the Conference has provided unrivalled expert insight into the latest developments in patents, regulatory and IP law in the global life science industry. Most importantly, the event provides a friendly environment for in-house and private practice professionals to network and share experiences.

Pre-dinner speech by Lord Neuberger

Presentation topics include:

- UK, EPO, Canada and US law updates
- Oppositions at the EPO
 - impact of the recent changes
- Current status of litigation in Europe
- SPCs and devices
- Life sciences beyond therapeutics

Prices held from last year

Full conference:

£550+VAT (members), £765+VAT (non-members)

Day one: £250+VAT (members), £375+VAT (non-members)

Day two: £130+VAT (members), £195+VAT (non-members)

To book, please visit the Institute events page of the CIPA website or contact cipa@sequenceofevents.co.uk for more information.

Limited places available, book now to avoid disappointment.

Training for the EQE

Dates: 12-13 November 2018
14-16 January 2019

Venue: Central London, venue to be confirmed

Are you training to be a European Patent Attorney? Are you preparing to take the EQE in Spring 2019? Support your studies by attending our preparatory course, learn from experienced practitioners and previous candidates, and network with fellow professionals.

This course is for candidates preparing for the main papers (A, B, C and D) of the European Qualifying Examination (EQE) of the European Patent Office. It is structured in two parts and reflects the practical nature of the examinations. Bookings for Parts 1 and 2 are now accepted.

Why book Queen Mary University of London's course?

- In-depth study of previous EQE papers in small groups and with highly experienced tutors.
- The course is continuously adjusted to the changing requirements of the examination and the profession.
- Queen Mary University of London has nearly 30 years' experience running this programme and provides close academic supervision.
- The pass rates of Queen Mary University of London trained candidates are generally in excess of 95%.

For more information and to register please go to www.ccls.qmul.ac.uk/events

www.ccls.qmul.ac.uk/events

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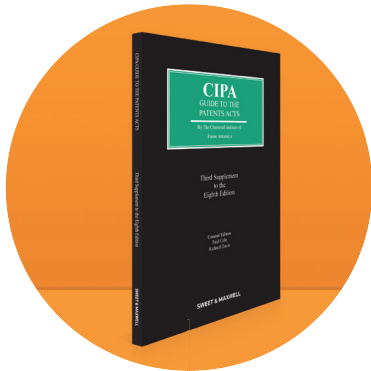
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CIPA Guide to the Patents Acts

Third Supplement to the 8th Edition

by the Chartered Institute of Patent Attorneys



December 2018

Paperback | 9780414069190 | £135

The CIPA Guide to the Patents Acts, Third Supplement to the 8th Edition updates the mainwork with the latest developments in patent law.

KEY UPDATES

- Comprehensively reviews significant UK court decisions and practice directions, IP Office decisions and EPO Appeal Board decisions up to 30 September 2018.
- Outlines UK, EPO and US decisions on eligibility, including the recent US CAFC decision in *Berkheimer v HP Inc* and its implications for UK practitioners.
- Reviews *Actavis v Icos* on “obvious to try”, expected to be heard in the Supreme Court in November 2018, and reviews other significant cases on inventive step.
- Will hopefully discuss the Supreme Court plausibility decision in *Warner-Lambert v Generics*, expected availability October 2018.
- Discusses disclaimers in the light of EPO Enlarged Appeal Board decision G 1/16.
- Updates the on-going significance of the Supreme Court decision in *Actavis*.
- Reviews the likely impact of Brexit on SPCs and summarises recent case law.
- Outlines recent patent licence decisions, e.g. in relation to FRAND licenses.
- Summarises a recent Disciplinary Rules decision on provision of terms of business.

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- IP risk management, including management of conflict matters and post-grant procedures, such as EPO opposition proceedings;
- IP agreements counselling and support; and
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Ref: 129947

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At Dyson, we've never been one to follow the herd. It's why we built our headquarters in a small town in the Cotswolds, instead of the big city. Here, we have the space and privacy we need to invent new technology that works better. And such unique technology needs protecting. We're looking for fully or part qualified Patent Attorneys with a mechanical, electrical or chemical background to help us keep these inventions safe.

You'll work directly with Dyson engineers to protect our future technology. You'll be involved in projects that span a diverse range of categories including automotive, robotics, health and beauty, and air treatment. We have an established career development programme. And we're less than an hour's drive from the thriving cities of Bristol and Bath, and just two hours from London.

If you're someone who likes to do things differently, apply at careers.dyson.com.

IP THE asset

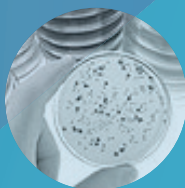
PARTNERSHIP

OXFORD

Chemistry Patent Attorney - all levels

CONTACT US IF YOU WANT TO BE AN INTEGRAL PART OF AN ENTERPRISING IP PRACTICE WITH A STRONG AND VALUED REPUTATION

- We are seeking a capable, self-motivated, part or fully qualified patent attorney specialising in Chemistry to help grow our team. New entrants to the profession may also be considered and are invited to apply. The role would primarily involve assisting and working with the newly appointed Head of Chemistry. Above all, we are looking for someone who can align with the ethos of the firm – someone who is willing to join in, work collaboratively, and become a valued member of the team. The ideal candidate will have an interest in business development and in time will be encouraged and supported to build a practice of their own.
- For all candidates a strong degree in Chemistry or a closely related discipline is a prerequisite. You will be working closely with ground-breaking, leading-edge scientific developments in many different areas including Pharma, fuel cells and energy generation, polymers and food technology. Our clients come from across the UK, Europe and the World, including the US. The work is exacting, exciting and career building and requires the highest professional standards.
- We provide our clients with a very comprehensive service. Candidates will be able to become an integral part of our clients' team. There will also be the opportunity to get involved in due diligence, commercialisation and contentious work.
- The position will be primarily based in IP Asset's Oxford office in the vibrant district of Summertown. We promote flexible working. There will also be opportunities to spend time in the London office, which has recently moved to a brand-new space in Paddington with excellent facilities.
- We offer a comprehensive internal training programme for part-qualified and single-qualified attorneys to help them become dual-qualified, with support for attorneys to attend external courses to supplement our internal programme. We also offer dual-qualified attorneys mentoring and hands-on support to help them form a business development plan, build a client base and progress to Partnership. We can offer excellent internal training due to the fact that some of our attorneys are PEB Examiners or tutor on CIPA and external courses, an invaluable asset to our employees. We are also members of IP Inclusive.
- If you want to be part of a dynamic and growing team or simply wish to discuss the possibility, do get in touch. Applications by email to recruitment@ipasset.com





JENNEWEIN BIOTECHNOLOGIE

We care for your health

Jennewein Biotechnologie GmbH is a leading manufacturer of rare monosaccharides and oligosaccharides for nutritional and pharmaceutical applications as well as for cosmetics. One of our core competences is the large-scale production of rare carbohydrates, using synthetic biology approaches in combination with our pioneering work in commercialization of biotechnological products world-wide. Our ambition is nothing less than bringing products obtained by biotechnology into the market, to the benefit of people, their health and well-being. For our new Innovation Center at Bonn, Germany, we are currently looking for a:

Patent Attorney with a background in Biotechnology / Chemical Process Engineering

Your Tasks

- Drafting and prosecuting patent applications, defending and enforcing intellectual property rights
- Monitoring business and IP activities of competitors
- Managing our IP portfolio
- Cooperating closely with inventors and with external patent attorneys in Germany and abroad

Your profile

- You are experienced in drafting and prosecuting patent applications
- You have passed the European qualifying examination
- You are enthusiastic, strategically minded and willing to take on responsibility
- You work accurately and purposefully even under stress
- You are a team player and you have excellent written and verbal communication skills
- You have a high degree of self-responsibility and dedication

We offer

- A mutual, cooperative and motivating working environment with flat hierarchies and short decision paths
- An internationally active and dynamically growing company in a high-tech sector with long-term perspectives
- A diversified range of activities involving sophisticated tasks
- An opportunity to work independently with a high level of personal responsibility
- Relocation package

If you would like to work with us as a team to develop a completely new technology on a large scale, if you are looking for a challenge and are characterized by success-oriented work, we look forward to receiving your application at career@jennewein-biotech.de.


Biotechnologie GmbH



Fully or Part Qualified Patent Attorneys

Be part of something new and exciting

The Firm

SLW in the US is a large boutique US patent attorney firm with its head office in Minneapolis represents major US and international firms, particularly in the field of electronics and computer software. SLW is an innovative provider of strategic IP services. The SLW UK practice was established in 2017 to serve SLW clients and is growing rapidly as European work is consolidated. The UK practice provides a friendly and flexible working environment.

The Role

We have opportunities for fully or part qualified European patent attorneys in electronics and computer software based in our Glasgow office. A close working relationship with our US colleagues is a key feature of the role with the potential for US travel. Clients expect strategic IP advice delivered in an integrated manner with our US colleagues, based on an understanding of the nuances and differences between US and European patent practice. There is also the opportunity to work with direct UK clients.

We offer an excellent remuneration package with benefits, including healthcare, income protection, life insurance, dental insurance and a generous pension.

The Candidate

The candidate will have a relevant degree, such as physics, electronics, or computer science, and have at least two years' experience in any technical fields in the electronics and computer software fields. The nature of the technology exposure of candidates is less relevant than their aptitude and willingness to learn new technologies.

If you are interested in joining us, please send your CV in confidence to: Dr John Collins at jcollins@slwip.com

PATENT ATTORNEY

London, Cardiff, Leeds, Newcastle
or Milton Keynes



UDL are seeking a patent attorney to join a highly successful team which is responsible for patents relating to software-implemented technologies including blockchain and cryptocurrencies.

We act on behalf of a number of prestigious clients including, amongst others, My PinPad Limited (mobile payments and authentication solutions provider) and nChain Holdings Limited (global leader in the research and development of blockchain, Bitcoin and cryptocurrency-related technologies).

You must have a minimum of a 2:1 in a relevant degree and be at least part qualified. Whilst direct experience of these exciting technologies is not essential, you will need an appetite to learn and take on your own portfolio.

Enthusiasm, attention to detail and a willingness to take on responsibility at an early stage are essential attributes, as are excellent written and verbal communication skills and an ability to work well within a team.

You will need to be able to interact with clients confidently and clearly, whilst understanding and interpreting exciting new and complex technical concepts quickly.

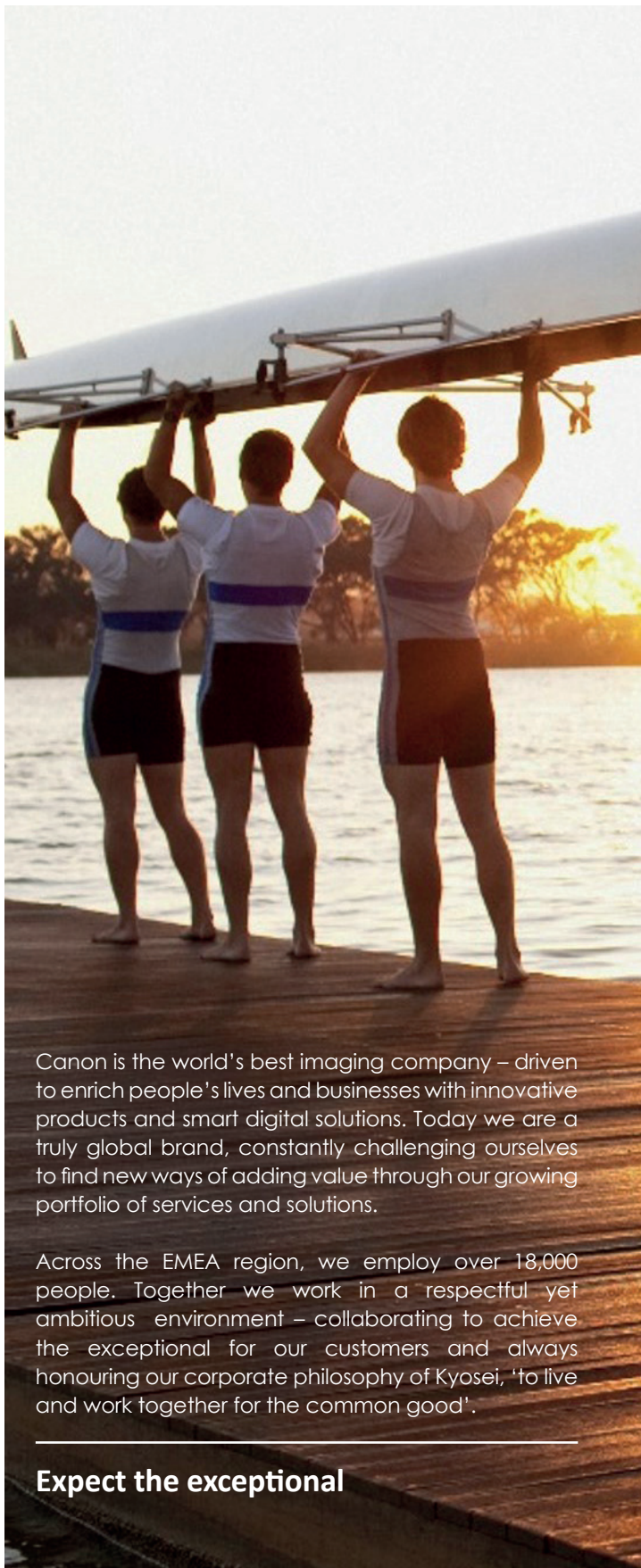
A desire to learn and explore new technologies is a key aspect of the role. The successful candidate will need to demonstrate effective verbal and written communication skills, and the drive to support our clients' growth.

The position offers excellent career prospects. UDL has an open and transparent career structure that we would be pleased to explore with you at interview. The position carries a competitive market rate salary, private healthcare, life assurance and pension scheme.

If you are interested, please send your CV and covering letter, in confidence, to:

Samantha Chambers, Practice & HR Manager, UDL LLP, Arena Point, Leeds LS2 8PA. **E-mail: careers@udl.co.uk**

Please quote reference **COMP-PA1** on your application. **Closing date: 31 October 2018**



Canon is the world's best imaging company – driven to enrich people's lives and businesses with innovative products and smart digital solutions. Today we are a truly global brand, constantly challenging ourselves to find new ways of adding value through our growing portfolio of services and solutions.

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IP Administration Manager

As an IP Administration manager you will be responsible for the overall IP administration function and managing a team of IP administrators.

The IP administration team has a manager and four staff. One of the key responsibilities is due date management with many active cases under our care. Billing is another key responsibility, since the IP Group earns income from other group companies. You will be part of the IP Group management team made up of the Head of IP, one IP director and four managers.

What we give:

With Canon, you'll get the support and encouragement you need to deliver your best, from people who share your ambition. You'll find exciting projects and products to work on and the variety of challenge and opportunity you need to succeed.

- Competitive Salary
- A range of company benefits including pension scheme and private health insurance

What we ask:

- Minimum CIPA qualified patent administrator and extensive IP administration experience
- Extensive knowledge of using and designing case management and billing systems (we use CPA Memotech)
- Fluent English

Preferred:

- Previous experience in a manager role in an in-house patent/ IP/legal department, patent attorney firm, IP solicitor firm or equivalent
- People management skills with proven track record in direct line management including recruitment, performance management, mentoring and development planning
- Experience of complex matters (oppositions, appeals, disputes, litigation, licensing, advisory matters)
- Four to eight years of relevant working experience in an international company
- Strong IT skills, including MS Excel and Word and Adobe Acrobat
- Knowledge of SQL
- Project management skills.

Interested?

Apply online at:
www.canon-europe.com/about_us/careers



Patent Attorneys London or Southampton

We are seeking part and fully-qualified patent attorneys to work in London or Southampton

Picture yourself working in one of the largest companies in the world. You are at the forefront of a transforming industry and this role will challenge you like no other. Our mission is to provide our consumers with a range of outstanding, innovative reduced risk products from which they can choose. Put simply: more choice, more innovation, less risk.

We have invested \$2.5bn over the last six years in the commercialisation and development of potentially reduced-risk cigarette alternatives and our commitment to the future is larger still.

British American Tobacco's patents team has never been busier and is currently expanding with an exciting and challenging opportunity for Patent Attorneys to join our team, based at either our global headquarters in London or at our R&D facility in Southampton. As a Patent Attorney, you will provide the company with global, business-relevant advice on how best to protect our technical innovations in key markets, as well as advising on issues relating to infringement, validity and licensing. The work of the Patents team spans a wide range of technology areas including electronics and chemical formulations, novel heating technologies and inhaled delivery mechanisms, all in support of our potentially reduced-risk cigarette alternatives including electronic cigarettes, plant biotechnology, high speed manufacturing processes & machinery, and cigarette and filter product technology. This is an outstanding opportunity for the right attorneys to develop their skills in a fast-moving commercial environment.

Essential requirements:

- ▶ a UK Patent Attorney, a European Patent Attorney, or an equivalent qualified patent practitioner with strong post-qualification experience, preferably with some in-house experience; or
- ▶ a part-qualified or recently qualified UK Patent Attorney, European Patent Attorney, or equivalent patent practitioner;
- ▶ the right candidate is more important than the technical area of expertise;
- ▶ ability to provide commercially focused advice and to interact at all levels within the business;
- ▶ ability to translate complex IP issues into easily understandable terms and to communicate these effectively both orally and in writing;
- ▶ excellent interpersonal skills, ability to manage and prioritize own workload.

For more information please contact Oana Chermenschi by e-mail on oana-maria_chermenschi@bat.com.



**BRITISH AMERICAN
TOBACCO**

CLOSING DATE:

23 November 2018



EUROPEAN PATENT ATTORNEY

SUMMARY

We are looking to appoint a recently qualified European Patent Attorney to join our growing IP department. The ideal candidate should have a degree in chemistry or a related discipline, along with patent experience gained in the chemical field.

JOB ROLE

Reporting to the Head of Intellectual Property, the Attorney will be a key player in the delivery of the Company's IP strategy, and therefore drive, enthusiasm and excellent commercial acumen are essential to being successful in the role.

SUMMARY

The role requires a high degree of autonomy and you will be expected to educate, advise and support leadership teams and project managers in your areas of the business. You should have wide experience across all aspects of IP, including freedom to operate, patent prosecution, drafting, and contentious matters. Experience in the negotiation of IP related agreements would be an advantage.

Excellent communication and relationship building skills are critical in order to succeed in this challenging and varied role.

In-house industrial experience would be advantageous but is not essential.

▶ TO APPLY

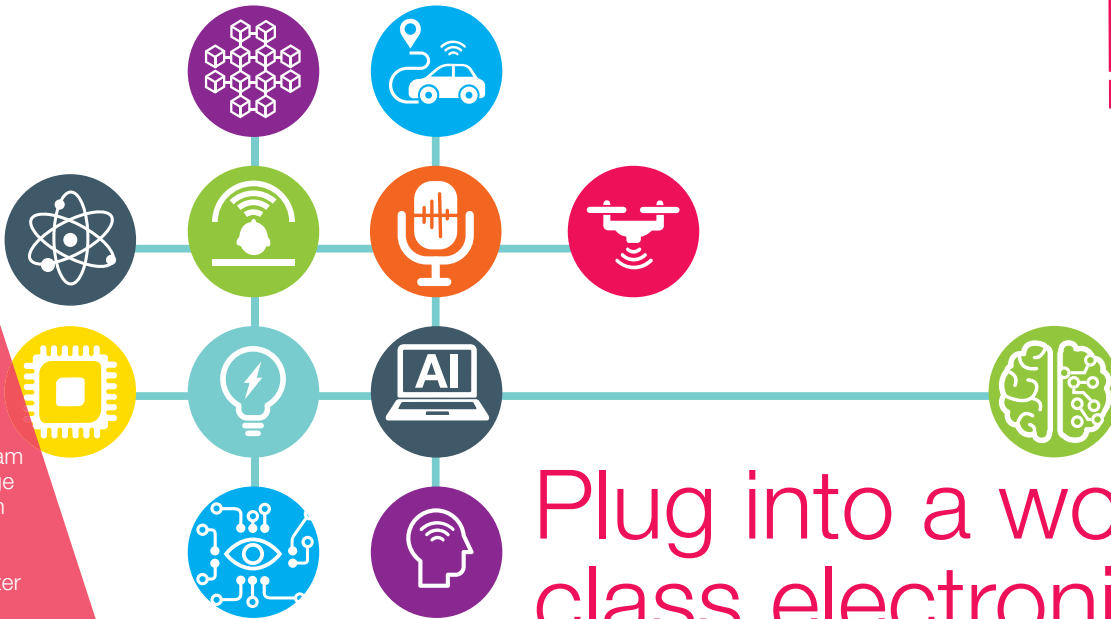
In addition to a competitive salary we also provide a range of attractive benefits, including company pension and healthcare schemes and an excellent approach to flexible working. If you believe you have the drive and potential required to join our team, please email your CV to: HR@victrex.com (No Agencies).

Victrex values diversity and encourages applications from all sections of the community.

ABOUT VICTREX

Victrex is an innovative world leader in high-performance polymer solutions, focused on the strategic markets of automotive, aerospace, energy (including manufacturing & engineering), electronics and medical. Every day, millions of people use products and applications, which contain our materials – from smartphones, aeroplanes and cars to oil and gas operations and medical devices. With over 35 years' experience, we develop world leading solutions in PEEK- and PAEK-based polymers and selected semi-finished and finished parts which shape future performance for our customers and our markets, and drive value for our shareholders.

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Plug into a world class electronics team

“From day one, I felt valued. **The variety of work is amazing; it keeps me up to date on evolving technologies.** I have close working relationships with colleagues across the network. A query about Chinese patents? Pick-up the phone to the Beijing office! **We work hard, but we have fun; the work / life balance is important.** I've learned so much from the partners; they are always happy to make time for my development. **I'm now fully qualified, but I still have access to structured training to help me develop.** There's a real mix of global brands and smaller enterprises – I get to make a real difference to the client's business strategy. **Everyone will make time to bounce ideas around if I hit a brick wall.** M&C is a genuine meritocracy. **Heaps of client contact.** Achieving a PB at the JP Morgan Corporate Challenge, then enjoying a drink with the M&C team. **I have the opportunity to shape my own career and our size means that there are many, many options.**”

We want to hear from attorneys with electronics, electrical engineering, physics, computer science or maths backgrounds who are passionate about technology, collaborative working and developing their clients and careers. If this is you, let's talk!

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With offices in London, Munich and Southampton, working at D Young & Co offers attorneys the opportunity to work with world renowned clients, alongside highly acclaimed and motivated peers, and forge exciting and successful careers.

Whether your lifestyle leads you to want a city environment, a coastal location or a country life, you can fully harness your potential by joining a firm that offers a top tier full IP law service. We have roles in Biotechnology, Chemistry & Pharmaceuticals and Electronics, Engineering & IT practices which will give you the opportunity to work alongside other specialists in your technological field.

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We are currently looking for attorneys to join our Electronics, Engineering and IT department. If you are recently qualified or an experienced attorney and are keen to combine your career with living the lifestyle you want, please contact our recruitment team on 020 7269 8550 or view our current vacancies at www.dyoung.com/careers.



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