

Recent Patent Developments (UK; EP; US)

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Part I - UK Developments

- ▶▶ UK Patent Office opinion service
- ▶▶ Gaming applications
- ▶▶ Methods for doing business
- ▶▶ Human embryonic stem cells
- ▶▶ Other changes of note

Part I - UK Developments

▶▶ UK Patent Office opinion service

- ▶ Anyone (infringement or validity)
- ▶ £200 fee
- ▶ Issued within 3 months

- ▶ Request may be refused (frivolous; vexatious; attempted re-run)
- ▶ Published in the OJ
- ▶ Anyone may file observations (4 weeks from publication)

- ▶ Withdrawal terminates proceedings
- ▶ Non-binding, and no damages, etc
- ▶ Appeal - “review” possible

Part I - UK Developments

▶▶ Gaming applications

- ▶ Statutory bar
 - ▶ “a scheme, rule or method for playing a game” – Section 1(2)(c)
- ▶ Traditional UK PO approach
 - ▶ “An apparatus comprising ... playing pieces and a board ... with the playing piece(s) being moved in accordance with specific rules”
- ▶ Shopalotto.com Limited [2005] EWHC 2416 (Pat)
 - ▶ “... if the only contribution to the art lies in excluded subject matter, it is not patentable”

Part I - UK Developments

▶▶ Methods for doing business

- ▶ Statutory bar
 - ▶ “a scheme, rule or method for doing business” – Section 1(2)(c)
- ▶ Traditional UK PO practice
 - ▶ Objection raised; Applicant responded; Examiner issued lengthy Decision
- ▶ Efficiency changes - increasing numbers of business method applications
 - ▶ After 1st response from Applicant, the Examiner decides whether to invite the Applicant to an early Hearing; Decision is issued by Hearing Officer
 - ▶ No reasoning is given – just a cross-reference to HL judgement in *South Bucks District Council and Another v Porter (No. 2)* [2004] UKHL 33
 - ▶ See Practice Notice Patents Act 1977: Interpreting section 1(2) [2002] RPC 40
 - ▶ UK Patent Office is less favourable than EPO

Part I - UK Developments

▶▶ Human embryonic stem cells

- ▶ Statutory bar
 - ▶ “use of human embryos for industrial or commercial purposes are not patentable”
– paragraph 3(d) of Schedule A2 to the Patents Act 1977
- ▶ Methods for obtaining stem cells from human embryos are not patentable
- ▶ Human embryonic pluripotent stem cells are patentable
 - ▶ Human embryonic totipotent stem cells are not patentable
 - ▶ In contrast, in the EPO, human embryonic stem cells are not currently patentable

Part I - UK Developments

▶▶ Other changes of note

- ▶ Renewals
 - ▶ 'end of the month'
- ▶ Restorations
 - ▶ 'unintentional' (previous requirement = 'reasonable care')
- ▶ Emergency filings
 - ▶ an earlier filing may be used as 'the specification'
- ▶ Security provisions – UK residents
 - ▶ “military technology” or subject-matter “prejudicial to national security”

Part II - EP Developments

- ▶▶ General observations on EPO practice
- ▶▶ Enlarged Board of Appeal Decisions (and referrals)
- ▶▶ EU developments

Part II - EP Developments

▶▶ General observations

- ▶ The Hague versus Munich
- ▶ Summons to Oral Proceedings
- ▶ Higher burden on Applicant at the date of filing
 - ▶ Technical Board of Appeal 3.3.4 versus 3.3.8
- ▶ Specific and credible function for gene sequences

Part II - EP Developments

- ▶▶ Enlarged Board of Appeal Decisions
 - ▶ G1/03 and G2/03 – ‘disclaimers’
 - ▶ G1/04 – methods of diagnosis

- ▶▶ Pending Enlarged Board of Appeal referrals
 - ▶ G1/05, G1/06 and G3/06 – divisional applications
 - ▶ suspension of EPO proceedings at 1st instance
 - ▶ G2/06 – human embryonic stem cells

Part II - EP Developments

» Software Directive

- ▶ multiple rounds of amendment prior to tabling before EU Parliament
- ▶ approval would have effectively curtailed software patents in Europe
- ▶ final rejection of the Directive by the EU Parliament

- ▶ Still no harmonisation across Europe re software patents, and in particular interpretation of the phrase “computer program as such”

- ▶ EPO continues to follow ‘Hitachi’ – “technical” features are considered for novelty and IS considerations irrespective of whether the technical effect falls within an excluded area

- ▶ UK PO is less lenient based on its interpretation of the CPFH Decision

Part II - EP Developments

- ▶▶ Bolar provisions – Marketing Authorisation for generics
 - ▶ avoids/ minimises the need for new clinical data when seeking MA for generics (reliance on an earlier MA for a ‘reference medicinal product’)
 - ▶ generics MA is known as an ‘abridged’ MA
 - ▶ additional data generation for abridged MA is exempt from patent infringement

 - ▶ ‘reference medicinal product’ must have been authorised for 8 or more years in the Community
 - ▶ generic product can’t be placed on the market until at least 10 years have elapsed from the initial MA for the ‘reference’ product

- ▶▶ Directive 2004/27/EC = 30 Oct ‘05 implementation deadline

Part III - US Developments

▶▶ Proposed changes

- ▶ draconian restrictions re 2nd continuation filing practice
 - ▶ reclassification of 'divisional' filings
- ▶ “10 claims” practice, else “examination support document”
- ▶ peer review process