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## **EPO Boards of Appeal clamp down on abusive delay in amendments by patentees to cure formal defects raised in oppositions**

A number of recent cases have reinforced the need for patentees to file validating amendments to cure simple formal defects at the earliest possible time or risk not being able to do so on appeal. If there is any suggestion that the patentee knowingly withheld the amendment from the first-instance opposition division - possibly hoping that the Board of Appeal would consider that curing of the defect on appeal would constitute a fresh case justifying remittal of the case and consequent delay – this may constitute an abuse of the procedure.

Thus, in EPO Board of Appeal Decision T144/09, a patentee who declined to submit an amended set of claims in the first-instance opposition procedure, deleting a phrase to answer a simple issue of new matter which had arisen through a late amendment prior to the first-instance oral proceedings, was not permitted to base his appeal on any claims from which that phrase had been deleted.

In EPO Board of Appeal Decision T23/10, a patentee who declined to delete a dependent claim in the first-instance opposition procedure, to answer a simple issue of new matter in that dependent claim, was not permitted to base his appeal on any claims from which the dependent claim had been deleted.

In summary, patentees must be very careful that any lines of amendment pursued in EPO opposition appeals were either **presented to and decided on** by the first-instance opposition division, or were **not previously foreseeable as available amendments** in the circumstances of the first-instance procedure. Otherwise, the patentee may find that the amendments are not allowed to be used in the appeal.

<http://www.epo.org/law-practice/case-law-appeals/pdf/t090144eu1.pdf>

<http://www.epo.org/law-practice/case-law-appeals/pdf/t100023eu1.pdf>

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## **Introduction of damages cap in the UK Patents County Court**

On 14 June 2011 a cap of £500,000 on the damages or infringer's profits recoverable on infringement of intellectual property rights by litigation in the UK Patents County Court came into effect.

The introduction of the cap is an important further step in establishing the Patents County Court as the forum of choice tailored to enabling small and medium sized enterprises (SMEs) to enforce their IP rights in England and Wales. The streamlined and efficient Patents County Court procedure allows an infringed IP right holder to claim up to £500,000 in damages or infringer's profit, plus his attorney costs up to £50,000, which typically will be a good proportion of his attorney's actual costs. His downside financial risk in the event of losing is limited to paying his own attorneys and a contribution of up to £50,000 towards the other (winning) side's attorney costs, although of course it is possible that he may lose the IP right as well if a counterclaim for revocation by the alleged infringer is successful.

In most cases, the decision of the court should be available within 8 to 12 months after starting the claim.

Therefore, for the first time, owners of IP in England and Wales have a streamlined and efficient forum for litigation with a tightly constrained downside risk, and yet with the potential to obtain a speedy injunction and be compensated for the infringement provided that action is taken before the damage exceeds £500,000.

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## EU Directive on herbal medicines comes into full force

On 1 May 2011 the transitional provisions to the European Directive on Traditional Herbal Medicinal Products (2004/24/EC) expired. Under the Directive, all herbal medicinal products require authorisation for over-the-counter sale in Europe, including the UK.

Traditional herbal medicines that make claims to medicinal properties must be registered and regulated by the national medicines agencies, such as the Medicines and Healthcare Products Regulatory Agency (MHRA) in the UK.

Under the scheme set up by the Directive, a register of herbal practitioners has also been established, to allow registered herbal practitioners to supply unlicensed herbal medicines under suitable controls.

The sale of herbal dietary supplements which make no claims to medicinal effects is not affected by the Directive.

<http://www.mhra.gov.uk/Howweregulate/Medicines/Herbalmedicines/PlacingaherbalmedicineontheUKmarket/TraditionalHerbalMedicinesRegistrationScheme/index.htm>

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## Recent decisions of the EPO Boards of Appeal on unclear parameters

The EPO Boards of Appeal continue to be very ready to revoke European patents in opposition proceedings, or to uphold refusals by Examiners in examination, where the claims use unclear or ill-defined parameters.

Recent examples include:

“proportion by weight of substantially rod-shaped particles having a length to diameter ratio of greater than about 5” held to be insufficiently disclosed where there was confusion about whether average or individual particle data should be used and the calculation of the weight proportion was not taught (T79/08)

“vacuum 1000 mbar” to define a process pressure was held to be insufficiently disclosed because the true meaning could not be determined (T120/08)

“at least one platelet activator that is not capable of forming a clot in less than 15 minutes” was held to be unclear because no method was described (or was standard) for measuring this parameter (T560/09)

The parameter “R = ratio of Raman scattering peak intensity in the longitudinal to thickness directions” of a biaxially oriented polyester film was held to be insufficiently disclosed because the power of the objective to use in the Raman spectrometer was not disclosed and was a critical piece of information which could not be obtained from the data in the patent (T360/08)

The parameter “lateral stiffness” of a sanitary napkin under “saturated” and “dry” conditions was held to be insufficiently disclosed because the test method did not describe the length of the napkin or the lateral curvature of the sample, and there was no clear information to distinguish “saturated” from other wet conditions of the napkin (T68/09)

<http://www.epo.org/law-practice/case-law-appeals/pdf/t080079eu1.pdf>

<http://www.epo.org/law-practice/case-law-appeals/pdf/t080120eu1.pdf>

<http://www.epo.org/law-practice/case-law-appeals/pdf/t090560eu1.pdf>

<http://www.epo.org/law-practice/case-law-appeals/pdf/t080360eu1.pdf>

<http://www.epo.org/law-practice/case-law-appeals/pdf/t090068eu1.pdf>

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