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US Priority Documents to be Obtained Directly by the EPO

The European Patent Office (EPO) has announced that with effect from 16 January 2007 it will obtain directly from the US Patent Office copies of US patent applications from which priority is claimed in European patent applications. This change affects particularly non-PCT-based European patent applications.

Therefore, from now on US applicants filing a non-PCT European patent application at the end of the priority year will not normally need to supply copies of the priority application(s).

This brings this aspect of the EPO filing procedure for US applicants into line with the procedure that has for some time applied to Japanese applicants.

The EPO retains the power to call on applicants to file any priority documents that it cannot obtain directly from the US or Japanese Patent Office.

→ http://www.european-patent-office.org/epo/president/e/2007_01_11_e.htm

David Brown – For further information email dbrown@haseltinelake.com

Countdown to EPC 2000

As mentioned in the February 2006 issue of this Newsletter, the amendments to the European Patent Convention (EPC) that were agreed in 2000 (EPC2000) will come into effect at the latest on 13 December 2007.

Over the next months, we will be drawing your attention to changes that may affect the EPO-related practice of you and your chemical and life sciences clients.

In this Newsletter we mention the following:

- All therapeutic uses of compounds and compositions will be claimable in “compound/composition X for use in novel therapeutic application A” format from the EPC2000 start date. This applies also to European and PCT patent applications that are then pending. This format arguably offers better protection than the Swiss format in some situations. Therefore, we recommend to use this format from now on. (EPC200, Article 54(5)).
- Translations of priority documents that are not in English, French or German will no longer be required unless priority is an examination issue. Therefore, the procedure of the EPO requesting such translations at the time of approving the text proposed for grant will stop. (EPC2000, Rule 53(3)).
- A European patent application with a filing date on or after the EPC2000 start date will automatically designate all of the Contracting States. This means that the novelty-only pre-publication prior art effect of such applications against later European patent applications will automatically apply in relation to all Contracting States. It will remain open to applicants to drop one or more states, for example by failing to pay all the designation fees, by positively withdrawing designations after filing or by failing to validate nationally after grant (EPC2000, Article 79). The current provisions of Article 54(4) EPC, whereby the novelty-only prior art effect of prior unpublished European patent applications applies only in relation to Contracting States commonly designated between the respective applications, will continue to apply in all European patents and pending applications having a filing date prior to the EPC2000 start date.

David Nash – For further information email dnash@haseltinelake.com

Malta Becomes the 32nd EPC Contracting State

On 1 March 2007 Malta became a Contracting State to the EPC. Malta can be designated in any European patent application filed on or after that date, and the EP designation in any PCT patent application filed on or after that date automatically includes Malta.

→ www.european-patent-office.org/news/pressrel/2007_03_01_e.htm

Cristina Reverzani – For further information email creverzani@haseltinelake.com

Must Naturally Occurring Nucleotide Sequences be Claimed as “Isolated” in Europe?

According to an article published in the 2006 fourth quarter edition of the Reports of the European Patent Institute (epi information), this interesting question has been discussed in the Committee on Biotechnological Inventions of that Institute.

According to the article, there are different opinions within the European Patent Office as to whether the word “isolated” must be explicitly stated. Our view and experience is that it is possible in principle to obtain grant of claims to such sequences, particularly non-human sequences, without the requirement for the sequence to be stated as “isolated”.

Rule 23e(2) EPC (Rule 29(2) EPC2000) provides that an isolated human nucleotide sequence may constitute a patentable invention, but does not explicitly require that the “isolated” language appears in the claim. Rule 23c(1) EPC (Rule 27(1) EPC2000) provides that biological material which is isolated from its natural environment shall in principle be patentable, but again does not explicitly require that the “isolated” language appears in the claim.

The article points out that removing the word "isolated" from a claim during examination may add new matter. It follows that it is good practice to draft PCT applications and priority-founding applications in such a way that either claiming option can be followed in the later national/regional procedures.

→ epi information 2006/04, pages 119 to 121

David Brown – For further information email dbrown@haseltinelake.com

First Decision in G 1/05 (EPO Divisional Practice)

The Enlarged Board of Appeal of the European Patent Office issued on 7 December 2006 its first decision in the case G 1/05, in which a review of the EPO's practice on divisional applications is being carried out (see the May 2005 and the January and May 2006 issues of this Newsletter).

The decision is concerned purely with procedural matters relating to qualification of Board of Appeal members to serve on the Enlarged Board.

Therefore, the substantive outcome of the case is still awaited, with even more interest now than before in view of the fact that the US Patent and Trademark Office is now also looking at possibly restricting applicants' ability to repeatedly refile patent applications.

→ http://www.european-patent-office.org/dg3/g_dec/pdf/g050001.pdf

David Rushton – For further information email drushton@haseltinelake.com

Patentee Prevented from Reversing, at Oral Proceedings, an earlier Admission of Prior Publication

In Decision T1449/05, EPO Technical Board of Appeal 3.4.3 decided not to admit amended claims filed by the patentee respondent at the start of the appeal Oral Proceedings, where these involved a reversal of the patentee's consistent previous express and implied position - both in the patent and in the opposition proceedings up to that time - not disputing public availability of particular prior art as asserted by the opponent.

The Board considered that to allow such a significant change in the patentee's position at such a late stage would severely damage the interests of the opponent, and would probably necessitate an adjournment of the Oral Proceedings, both of which were undesirable.

→ <http://legal.european-patent-office.org/dg3/pdf/t051449eu1.pdf>

John Hutchison – For further information email jhutchison@haseltinelake.com

Promotion of an SPC- or Patent-protected Product Infringes in Germany

In the decision "Simvastatin" of 5 December 2006 (BGH X ZR 76/05) the German Federal Court of Justice (BGH) decided that promotion of a pharmaceutical composition which is protected by a supplementary protection certificate (SPC) represents an infringement of the SPC rights, even when it is explicitly stated in the advertisement that no deliveries will be made and that the product will only be available after expiry of the SPC term. This decision is considered to be equally applicable to infringement of a patent. The BGH stated that § 9 sec. 1 no. 1 of German Patents Act may be different in this respect from UK law, but that anyway German law protects the patentee against premature promotion activities. Costs and damages were awarded to the patentee.

→ www.bundesgerichtshof.de - Entscheidungen 2006 – X. Zivilsenat ZR 76/05

Ulrich Benedum – For further information email ubenedum@haseltinelake.com



DAVID NASH, Partner – Bristol

UK & European Patent Attorney
MA Natural Sciences
Cambridge University

Email: dnash@haseltinelake.com
Tel: +44 (0) 117 910 3200

DAVID BROWN, Partner – Bristol

UK & European Patent Attorney, UK & European Trade Mark Attorney
MA Natural Sciences
Cambridge University

Email: dbrown@haseltinelake.com
Tel: +44 (0) 117 910 3200



ULRICH BENEDUM, Partner – Munich

European Patent and Trade Mark Attorney
German Patentanwalt
Dipl.-Chem., PhD

Email: ubenedum@haseltinelake.com
Tel: +49 (0) 89 6227 1760

DAVID RUSHTON, Associate – Bristol

UK and European Patent Attorney
BSc Chemistry, PhD Chemistry
Newcastle University

Email: drushton@haseltinelake.com
Tel: +44 (0) 117 910 3200



CRISTINA REVERZANI, Attorney - Munich

Italian and European Patent Attorney
US Patent Agent (37C.F.R.§10.9(b))
Degree in Chemistry, Milan University

Email: creverzani@haseltinelake.com
Tel: +49 (0) 89 6227 1760

JOHN HUTCHISON, Attorney – Bristol

European Patent Attorney
BSc Chemical Physics (Edinburgh University)
PhD Physical Chemistry (Cambridge University)

Email: jhutchison@haseltinelake.com
Tel: +44 (0) 117 910 3200



www.haseltinelake.com

London: Lincoln House, 5th Floor, 300 High Holborn, London WC1V 7JH
Tel: +44 (0) 207 611 7900 Fax: +44 (0) 207 611 7901

Leeds: West Riding House, 67 Albion Street, Leeds LS1 5AA
Tel: +44 (0) 113 233 9400 Fax: +44 (0) 113 233 9401

Munich: Theatinerstrasse, D-80333 Munchen, Germany
Tel: +49 (0) 89 6227 1760 Fax: +49 (0) 89 485 686

Bristol: Redcliff Quay, 120 Redcliff Street, Bristol BS1 6HU
Tel: +44 (0) 117 910 3200 Fax: +44 (0) 117 910 3201