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Liberal Divisional Practice Continues at the EPO

The Enlarged Board of Appeal of the European Patent Office (EPO) issued its Decisions on 28 June 2007 in the consolidated cases G1/05 and G1/06, following its review of the divisional practice of the EPO (see the May 2005, January and May 2006 and April 2007 issues of this Newsletter).

In summary, the existing liberal practice is to be **maintained**. It will continue to be possible to amend any divisional application or resultant patent, to remove any new matter that was present when the divisional application was filed, subject to the normal rules of amendment. Furthermore, in a "cascade" situation of a sequence of parent - child - grandchild applications (the "child" and "grandchild" applications being divisional applications) there are no additional limitations on what the "child" and "grandchild" applications may claim. In particular, the claim scope of earlier applications in the sequence is not relevant.

→ <http://www.epo.org/patents/appeals/eba-decisions/number.html>

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UK Patent Damages, Account or Costs Not Negated by Later Revocation in the EPO

The English Court of Appeal has recently had the opportunity to consider whether an award of damages, or account of profits, or legal costs, in a final judgement of the Courts finding infringement of a valid European Patent (UK), is affected by later revocation of the European Patent in EPO opposition proceedings (**Unilin Beheer BV v Berry Floor NV and others**).

The Court held that such a financial award is *res judicata* and cannot be affected by the later final decision of the EPO after the UK proceedings have become final. However, any injunction will automatically terminate at the time of the later revocation.

The Court's decision was influenced by the reports of the various working groups that set up the modern European patent system in the 1960s and 1970s. It had been recognised at that time that the system was not intended to interfere with the post-grant civil legal procedures of the member states (Judgement of Jacob LJ, paragraph 73). The Court also took into account that a final judgement of a Court ordering financial compensation to a patentee creates a piece of property or a vested right, which the patentee can trade or use as security for a loan (Judgement of Jacob LJ, paragraph 43(iv); Judgement of Arden, LJ, paragraph 95). Even if later revocation by the EPO negates the patent right from the start, i.e. *ex tunc* (which it does), it has no effect on the property right that is bound up in the final judgement that by then exists.

Jacob LJ, the leading intellectual property judge in the English Court of Appeal, could not resist the opportunity to exhort politicians to greater efforts to rationalise the system for litigation of patents in Europe. The following comments from his judgement provide a flavour:

"Unless and until sensible judicial arrangements are put in place, the litigation of European patents in various national courts and the EPO will remain a messy, expensive and prolix business. One would hope that the politicians would find a way to put various national interests on one side for the sake of European industry as a whole. But despite attempt after attempt that has not yet been possible." (paragraph 17)

"In truth asking which tribunal is "top" is simply not helpful – there is just the untidy compromise inherent in the EPC and one which cannot be properly resolved unless and until a rational patent litigation system for Europe is created." (paragraph 26)

→ <http://www.bailii.org/ew/cases/EWCA/Civ/2007/364.html>

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More European Patents Lost through Use of Unclear Parameters

Continuing our series highlighting cases where the EPO Boards of Appeal have revoked patents or refused applications because of the use of unclear parameters or poorly described parameter test methods in the claims (see the October 2005 and December 2006 issues of this Newsletter), we offer the following further recent examples, together with the particular troublesome parameter that in each case brought the patent or application down:

T734/05 - "surface to saturation ratio", that is, the relative concentration of an agent on the surface of an absorbent substrate in comparison with the interior (a spectroscopic measurement technique was mentioned, but with no clear instruction as to how to use the data to calculate the ratio)

T575/05 - "thickness" as applied to an absorbent compressible sheet (no teaching of the pressure under which the thickness is to be measured)

T179/05 - "pore volume" as applied to pores in a certain size range in a water-swellaible polymer (the described

measurement technique, which relied on measuring a change in concentration of a dextran solution used to swell the polymer, was rendered effectively useless because it was so sensitive that the results would be wildly thrown by the smallest experimental error)

T484/05 - "free carbon index" of a branched hydrocarbon (the patent contained contradictory statements of how to measure this parameter, which was an unusual parameter for which no independent published description was available)

→ <http://www.epo.org/patents/appeals/search-decisions.html>

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Appellant-Patentee's General Right to Revert to Claims as Granted Affirmed

In an important clarifying decision, Decision T386/04, EPO Board of Appeal 3.2.03 has recently confirmed that the patentee, appealing in opposition proceedings against a first-instance revocation of the patent or maintenance of the patent in an amended (claim-restricted) form, always has the right on appeal to request maintenance of the patent as granted (i.e. dismissal of the opposition), even if his main request in the first instance (Opposition Division) was for a narrower set of claims than had originally been granted, provided that such re-broadening of the claims in the appeal is not an abuse of procedure (Reasons, paragraph 1). The first-instance main request is to be seen as a non-final "formulation attempt" to find a valid set of claims up to and including the scope as originally granted.

This flexibility available to a patentee does not extend to the situation where it is respondent to an appeal filed by an only-partially-successful opponent. In that situation, by not itself appealing, the patentee in principle restricts his role in the appeal to essentially defending the amended patent against further restriction or revocation in the appeal.

→ <http://legal.european-patent-office.org/dg3/pdf/t040386eu1.pdf>

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Example Written in the Present Tense Supportive of Inventive Step in Biotech Case

In Decision T472/06, the Galligani biotech Board of Appeal recently had the opportunity to consider how examples written in the present tense should be interpreted, and particularly the weight to be given to them in providing evidence of an inventive step, i.e. evidence making it credible that the objective problem had been solved by the invention.

The Examining Division had refused the application on the basis that Example 2 was written in the present tense and merely showed how to make the claimed genes, not that they could be expressed *in vivo* as asserted.

The Board noted that the invention opened up a new and uncharted territory, and that the detailed preliminary results given in Example 1 provided a credible start to a logical chain leading to the invention, of which Example 2 was seen as a step. Also, a post-published document (D6) contained actual data from *in vivo* expression experiments using the gene constructs of Example 2, confirming the results stated generally in Example 2. The fact that Example 2 was written in the present tense did not render it ineffective to support the claims.

→ <http://legal.european-patent-office.org/dg3/pdf/t060472eu1.pdf>

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