

June 2007

New Associate in the Chemical and Life Sciences Group

We congratulate Cristina Reverzani on her richly deserved appointment as an Associate of the firm.

UK Patent Office Name Change

The UK Patent Office has changed its name to the UK Intellectual Property Office (to be abbreviated to "UK-IPO") with effect from 2 April 2007.

Magnus Johnston – For further information email mjohnston@haseltinelake.com

Pharmaceutical Repackaging/Relabelling Conditions Clarified

On 26 April 2007 the European Court of Justice (ECJ) issued its decision in the case of Boehringer Ingelheim KG et al v. Swingward Ltd. et al (Case C-348/04), concerning the repackaging/relabelling conditions that a parallel importer of pharmaceutical products within Europe must follow in order to avoid infringement of the intellectual property rights of the original vendor, i.e. to take advantage of the "exhaustion" of those rights by the original marketing in a low-cost European country.

The decision clarifies that the parallel importer who repackages/relabels the goods for resale in the second country must show that (a) the repackaging/relabelling is necessary in order to sell the goods, (b) the original condition of the goods is not affected, (c) the repackager has been identified on the new packaging, (d) the presentation of the goods is not defective, and (e) the brand owner has been given advance notice and has been supplied with a sample of the repackaged goods.

→ http://curia.europa.eu/en/content/juris/index_form.htm

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

Claim Combinations in the EPO Need Clear Basis, Preferably in the Original Dependencies

Two decisions of the European Patent Office (EPO) Boards of Appeal have confirmed the strict approach applied to claim-combining amendments.

In Decision T577/05, the patentee in opposition proceedings attempted to formulate a claim which in effect was a combination of originally filed claims 1, 4, 8 and 11 to 16. This was held to add new matter because original claims 12 to 16 depended only on claim 1, and not also 4, 8 and 11, and there was no other teaching of that specific combination of features. The Board specifically distinguished the EPO practice from the (as it was argued) US practice of inferring multiple-dependency permutations from the order in which singly-dependent subsidiary claims are listed (Reasons, paragraph 2.4).

In contrast, in Decision T962/04 the patentee successfully formulated a valid claim which was a combination of claims 1 and 9 as granted. Since claim 9 was a multiply-dependent claim, referring back to "any preceding" claim, the specific combination of claims 1 and 9 did not add new matter (Reasons, paragraph 7).

We recommend that PCT applications are drafted using multiple-dependent claims, to maximise the possibilities for claim-combining amendments in Europe, both at examination and post-grant.

→ <http://legal.european-patent-office.org/dg3/pdf/t050577eu1.pdf>

→ <http://legal.european-patent-office.org/dg3/pdf/t040962eu1.pdf>

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

Italy – Official Fees for Intellectual Property Rights

After the decision of the Italian Parliament to abolish official fees and stamp duties for patents (including national phases of European patents), utility models and designs from 1 January 2006, the new government has now reintroduced these fees with effect from 21 April 2007.

Patent annuities are due only as from the 5th year from the application date; according to the transitional provisions, annuities due from 1 January to 30 April 2007 must be paid by the end of June 2007 (late payment until 31 December

2007 will be possible with surcharge). Fees due from 1 May 2007 must be paid by the end of the month of the anniversary of the filing date. No retroactive fees are due for 2006.

For utility models and designs, quinquennial renewal fees are due in the same way as reported above for patents. Nevertheless, for utility models and designs, fees due in 2006 must be paid at a reduced amount for maintenance up to the end of the 5-year period; such fees are due by 30 June 2007 (or by 31 December 2007 with surcharge).

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

Countdown to EPC2000

In this second instalment of our series highlighting the key changes to the European Patent Convention (EPC) that will come into effect in December 2007, the so-called "EPC2000", we mention the following:

The current procedure whereby, after entry into the EP regional phase, the EPO can be asked to search any claims of a PCT application that were not included in the International Search Report (ISR) will be stopped. Under EPC2000, the EP regional phase examination will only be conducted on subject-matter that has been searched in the ISR, and claims to unsearched subject-matter will have to be pursued in a European divisional application. If you have a PCT application for which this change in procedure will be undesirable, please contact us to see if there may be an advantage in entering the EP regional phase early.

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

Two New Referrals to the EPO Enlarged Board of Appeal

Two referrals in the chemical and life sciences areas have recently been made to the EPO Enlarged Board of Appeal. We will advise when the Opinions of the Enlarged Board are available.

In Case G1/07 (referring case: T992/03), the Enlarged Board has been asked to rule on patentability of surgical methods. The first question is whether a claimed method which includes a physical intervention step practised on the human or animal body is excluded from patent protection if the physical intervention does not *per se* aim at maintaining life and health. A subsidiary question asks whether any exclusion could be avoided by amending the wording to omit the step at issue, or disclaim it, or let the claim encompass it without being limited to it. A separate third question deals with the patentability of imaging methods which guide the surgeon.

In the second case, presumably to be named G2/07 (referring case: T83/05), the Enlarged Board has been asked to rule on patentability of a process for the production of plants which includes both crossing/selecting and technical steps.

→ <http://legal.european-patent-office.org/dg3/pdf/t030992ex1.pdf>

→ <http://legal.european-patent-office.org/dg3/pdf/t050083ex1.pdf>

David Nash – For further information email dnash@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, Associate - 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