

September 2006

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### Patent Cross-Border Injunctions Held Up in Customs, and Torpedoes Torpedoed

The European Court of Justice (ECJ) ruled on two important patent cases relating to cross-border injunctions in July 2006, **GAT v. LuK** (Case No. C-4/03) and **Roche Nederland v. Primus** (Case No. C-539/03).

Cross-border injunctions have been issued by certain courts, particularly in the country of domicile of alleged patent infringers or of one of them (Articles 2 and 6 of the Brussels Convention on the Enforcement of Judgments in Civil and Commercial Matters). How courts should consider defences based on invalidity has, however, never before been clearly resolved. Article 16(4) of the Convention provides that questions of patent validity must be judged by the courts of the State in which the rights exist, i.e. a country-by-country approach.

In these judgements the ECJ has held that Article 16(4) is not subsidiary to Articles 2 and 6, so that patent infringement suits in which validity is an issue (almost all of them) must be judged country-by-country in Europe.

In **GAT**, a “torpedo” tactic had been used by the alleged infringer, who filed a pre-emptive action for declaration of non-infringement of a French patent in a German court, in an attempt to move jurisdiction. The ECJ held that “Article 16(4) is to be interpreted as meaning that the rule of exclusive jurisdiction laid down therein concerns all proceedings relating to the registration or validity of a patent, **irrespective of whether the issue is raised by way of an action or a plea in objection**”.

In **Roche**, the ECJ held that “Article 6(1) must be interpreted as meaning that it does not apply in European patent infringement proceedings involving a number of companies established in various Contracting States in respect of acts committed in one or more of those States, even where those companies, which belong to the same group, may have acted in an identical or similar manner in accordance with a common policy elaborated by one of them”.

It can be seen that patent enforcement in Europe has now come full circle to the pre-EPO days of country-by-country enforcement, and the next chapter will be the outcome of continued political efforts to establish supranational patent rights and/or supranational patent enforcement systems in Europe.

→ <http://curia.europa.eu/jurisp/cgi-bin/form.pl?lang=en>

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### Update on Implementation of the EC IP Enforcement Directive

It appears that, in contrast to the Biotechnology Directive (98/44/EC) and the Directive introducing the European-style Bolar Exemption (2004/27/EC) (see the October 2005 and January/February 2006 issues of this Newsletter), the implementation of the IP Enforcement Directive (2004/48/EC) is proceeding smoothly.

Further to the report in the June 2006 issue of this Newsletter, we are now informed that Italy, Netherlands and Spain have implemented Directive 2004/48/EC or are about to. The adjustments are generally the same as those previously reported for the UK, namely providing for court orders against defendants to disclose details of suppliers, and providing for the court to assess damages taking all economic and other factors into account where appropriate. As and when we have further information on other countries we will report it.

→ [http://europa.eu.int/eur-lex/pri/en/oj/dat/2004/l\\_157/l\\_15720040430en00450086.pdf](http://europa.eu.int/eur-lex/pri/en/oj/dat/2004/l_157/l_15720040430en00450086.pdf)

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### Purely Psychological Research Tool Inventions Not Patentable in the EPO

In Decision T619/02, EPO Technical Board of Appeal 3.4.02 recently had the opportunity to look at what constitutes “technical character” in an invention relating to a psychological research tool.

The European Patent Convention (EPC) in its current form implicitly requires for patentability that essentially all ways of performing an invention must have “technical character”. The revisions to the EPC due to come into force at the end of 2007 (see the February 2006 edition of this Newsletter) will make this explicit (EPC 2000, Article 52(1)).

The claimed invention was a method in which a human was initially presented with odours simultaneously with

visual/auditory stimuli to which the human might respond. Odour/stimulus associations were subsequently assessed and the data used to select odours that would strengthen positive perceptions of commercial products. Some of the claim requests of the appellant related to a method of odour selection and some to a method of making a perfumed product and the resulting perfumed product. Importantly, all the data generated by the method was essentially subjective.

The Board held that the appellant's requests **relating to a method of odour selection** all lacked "technical character". Human perception/recall and its underlying mechanisms lack "technical character", and the mere subjective/emotional assessment of something - without generation of (objectively) technical information on technical quality or technical significance attributable to an odor, or information that would be practically used in perfume design - was not any more technical than the thing assessed (Decision, sections 2.3 to 2.5).

On the other hand, the requests **relating to a method of making a perfumed product** were held to have "technical character" because a manufacturing method is inherently technical in character (Decision, section 4.1), but they lacked an inventive step because the point of novelty (the use of the results of the selection method) was "technically arbitrary" and did not "endow the claimed production method nor the resulting perfumed product with any technical attribute or with any technical structural or functional feature from which a technical function or technical effect could be derived" (Decision, section 4.2.1).

Therefore, all the claims were refused.

→ [http://www.european-patent-office.org/epo/dipl\\_conf/pdf/03\\_ins3\\_003\\_073.pdf](http://www.european-patent-office.org/epo/dipl_conf/pdf/03_ins3_003_073.pdf) (EPC 2000 text)

<http://legal.european-patent-office.org/dg3/pdf/t020619ex1.pdf> (Board of Appeal Decision)

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## First UK Patent Office Opinion Issued in Chem/Pharma/Bio Field

The first UK Patent Office Opinion in the fields of chemistry, pharmaceuticals and biotech issued in June 2006.

Opinion 03/06 concerned validity of European Patent (UK) No. 1343750 (Ciba Speciality Chemicals), which relates to a process for preparing phenylethylamine derivatives and also claims certain compounds *per se*. The Opinion was requested only in relation to the two independent process claims, and made no comment on the compounds.

The claims concerned nickel- or cobalt-catalysed reduction of benzyl cyanide derivatives to their corresponding phenylethylamines, and optional post-processing of the amino function to the corresponding dimethylamino function. Generally speaking, the prior art showed the process only as applied to simpler molecules, and the art had previously used more expensive catalysts for the molecules in question.

The Opinion Examiner held that prior art raised purely as an A-citation in the International Search Report and not cited during examination, and prior art raised purely in the parallel examination in the USPTO, **is** admissible. He also admitted and considered a copy of the patentee's response in the USPTO (Opinion, paragraphs 5 to 8).

The Opinion Examiner concluded that the main process claims lacked an inventive step. Although not requested to consider the dependent process claims, he did do so and concluded that some of them were obvious. He declined to express an opinion on others where the position seemed less clear (Opinion, paragraphs 29 to 36). The period for the patentee to request review of the Opinion expired on 6 September 2006, and at the time of issue of this Newsletter no request for review has been advertised.

Various advantages were asserted in the patent (reduced cost and improved catalyst recyclability) and in argument (avoidance of adverse side reactions and improved yield). The Examiner followed the UK case law that unexpected advantages not mentioned in the patent cannot be relied on by a patentee to show an inventive step (Opinion, paragraphs 23 to 27). Data supporting the yield advantage were present in the patent and were taken into consideration, even though the yield advantage was not specifically highlighted (Opinion, paragraph 27). Ultimately, however, the Opinion Examiner found the evidence of "unexpectedness" unclear and gave the benefit of the doubt on this – and on whether the prior art, on its face, pointed so clearly to the invention that any unexpected advantage could be disregarded - to the requester, not the patentee (Opinion, paragraphs 24 to 29).

Opinion 03/06 indicates that chemical, pharmaceutical or biotech patentees cannot expect to be given the benefit of any doubt in the new UK Opinion procedure.

→ [http://www.patent.gov.uk/patent/opinions/pdf\\_opinions/op0306.pdf](http://www.patent.gov.uk/patent/opinions/pdf_opinions/op0306.pdf)

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