

New Partner in Chemistry & Life Sciences Group

We extend our warmest congratulations to Cristina Reverzani of the Chemistry & Life Sciences Group, who has been appointed Partner of the firm with effect from 1 May 2009.

Former Yugoslav Republic of Macedonia Joins the EPC

The Former Yugoslav Republic of Macedonia, formerly an Extension State to the European patent system, became the 35th Contracting State to the European Patent Convention (EPC) on 1 January 2009. Any European patent application having a filing date, or derived from a PCT application having a filing date, on or after 1 January 2009, will be able to designate the Former Yugoslav Republic of Macedonia, and the former option of designating that country as an Extension State does not apply to such applications.

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San Marino to Join the EPC

San Marino will become the 36th Contracting State to the European Patent Convention (EPC) on 1 July 2009. Any European patent application having a filing date, or derived from a PCT application having a filing date, on or after 1 July 2009, will be able to designate San Marino.

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Customs Authorities Can Exercise Administrative Powers under Local Law in Agreed-Destruction Cases

In Case C-93/08, the European Court of Justice (ECJ) recently had the opportunity to consider whether Council Regulation 1383/2003/EC concerning Customs Action against Suspected IP Infringing Goods allowed the Customs Authority (here: in Latvia) to impose an administrative penalty for IP infringement under local law on an importer, after he had agreed with the IP holder that the goods were to be destroyed. The court held that, where local law provides a Customs Authority with such powers, they are not exhausted, and can be applied, where the simplified procedure of agreed destruction under Article 11 of the Regulation has been used.

→ [http://curia.europa.eu/jurisp/cgi-bin/form.pl?lang=EN&Submit=Rechercher\\$docrequire=alldocs&numaff=C-93/08](http://curia.europa.eu/jurisp/cgi-bin/form.pl?lang=EN&Submit=Rechercher$docrequire=alldocs&numaff=C-93/08)

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UK House of Lords Dismisses Appeal in Pharmaceutical Sufficiency Case

In February 2009 the UK House of Lords (English Supreme Court) unanimously dismissed the appeal in the Lundbeck/Generics case, and affirmed the decision of the Court of Appeal (see the June 2008 edition of this Newsletter).

→ <http://www.publications.parliament.uk/pa/ld200809/ldjudgmt/jd090225/gener-1.htm>

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EPO Enlarged Board Decision in the WARF Referral

In the June 2006 issue of this Newsletter we reported the referral of certain questions to the EPO Enlarged Board of Appeal, concerning the patentability of human embryonic stem cell cultures. The Enlarged Board decision (G2/06) was issued at the end of last year. It held that primate (including human) embryonic stem cell cultures are unpatentable, even if the actual (and probably very many years previous) use of the human embryos to form the cultures is not claimed. Further, the Enlarged Board held that it is not relevant whether, after the filing date, the same products could be obtained by other means that did not involve the destruction of human embryos.

→ [http://documents.epo.org/projects/babylon/eponet.nsf/0/428862B3DA9649A9C125750E002E8E94/\\$FILE/G0002_06_en.pdf](http://documents.epo.org/projects/babylon/eponet.nsf/0/428862B3DA9649A9C125750E002E8E94/$FILE/G0002_06_en.pdf)

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Pharmaceuticals Companies' Attempts to Control Parallel Importation By Restriction of Supply Reviewed by the ECJ

In Joined Cases C-468/06 to C478-06, the European Court of Justice (ECJ) recently had the opportunity to consider whether the tactic of refusing to supply pharmaceuticals to certain wholesalers in Greece, or of restricting supply to close to the requirements of national consumption, breached European competition law. Provided the relabeling/repackaging requirements are complied with (see the June 2007 issue of this Newsletter), the price differential between the Greek market and other EU countries can support parallel importation of lawful Greek pharmaceuticals into other EU countries, and resale there in competition with the pharmaceuticals company. The ECJ pointed out that competition between parallel traders within the EU is one of the few legitimate forms of competition that can be envisaged in the case of a patented product. It held that refusal, by a pharmaceuticals company, to supply a long-standing customer who places an ordinary order and abides by regular commercial practice amounts to abuse of a dominant position. However, the determination of whether a particular order from a wholesaler is "ordinary" is a matter for the national court to decide, taking into account surrounding circumstances, such as the historical business relations and the size of the customer's local market.

→ [http://curia.europa.eu/jurisp/cgi-bin/form.pl?lang=EN&Submit=Rechercher\\$docrequire=alldocs&numaff=C-468/06](http://curia.europa.eu/jurisp/cgi-bin/form.pl?lang=EN&Submit=Rechercher$docrequire=alldocs&numaff=C-468/06)

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Law of Double Patenting Under Scrutiny in the EPO

EPO Board of Appeal 3.3.07 has recently reviewed the extent to which double patenting is prohibited under the European Patent Convention (EPC). The potential for double patenting exists particularly in a parent/divisional family. In decision T307/03 the Board appeared to create a ground of examination objection for double patenting. However, this has been criticised by commentators (see for example <http://ipkitten.blogspot.com/2009/03/derk-visser-on-double-patenting.html>), who argue that the EPC deliberately does not provide for such an objection to be raised in the EPO examination procedure. It also contrasts with the liberal former attitude, exemplified by decision T587/98. In the separate decision T936/04, the Board further held that an objection of double patenting is not available to an opponent in (post-grant) EPO opposition proceedings. It is too early to assess whether objections of double patenting will become more common, or more difficult to overcome, in the parent/divisional situation in the EPO. We will report any developments as and when they arise.

→ <http://legal.european-patent-office.org/dg3/pdf/t030307ex1.pdf>

→ <http://legal.european-patent-office.org/dg3/pdf/t040936eu1.pdf>

→ <http://legal.european-patent-office.org/dg3/pdf/t980587ex1.pdf>

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First Successful Claim of UK Employee Compensation

The English High Court made its first ever award of compensation to employee inventors in a contested case in February 2009, in the case of *Kelly and Chiu v GE Healthcare* (Case HC07C01131). The court determined that Drs Kelly and Chiu should be awarded the sums of £1m and £0.5m respectively for their contribution to the radioactive imaging product Myoview.

→ <http://www.bailii.org/ew/cases/EWHC/Patents/2009/181.html>

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ECJ Case C-452/07 Terminated

To update the announcement from the January 2008 issue of this Newsletter, we advise that Case C-452/07, relating to interpretation of the rules concerning the deadline for applying for a Supplementary Protection Certificate, has now been terminated without a substantive answer to the question.

→ [http://curia.europa.eu/jurisp/cgi-bin/form.pl?lang=EN&Submit=Rechercher\\$docrequire=alldocs&numaff=C-452/07](http://curia.europa.eu/jurisp/cgi-bin/form.pl?lang=EN&Submit=Rechercher$docrequire=alldocs&numaff=C-452/07)

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