

January 2005

### UK Patent Law Revision – Update

The UK Patents Act 2004 is being implemented in stages. The implementation details for the features mentioned in the September 2004 Newsletter are as follows:

- Revised **Employee Compensation Requirements** – implemented for all patents granted on applications filed on or after 1 January 2005 (see <http://www.patent.gov.uk/about/ippd/issues/patsact/note1.pdf>);
- Revised **Requirements for Letters before Action** – implemented on 1 January 2005 (see <http://www.patent.gov.uk/about/ippd/issues/patsact/note2.pdf>).

The date of implementation of the new procedure whereby the UK Patent Office can be asked by the patentee or any other person to provide a non-binding opinion on infringement or validity of a granted UK or European (UK) patent is not yet announced. A consultation process will take place shortly, and the Patent Office is hoping that the procedure will be operational by the end of 2005.

For full details of the revisions implemented on 1 January 2005, see <http://www.patent.gov.uk/about/ippd/issues/patsact/index.htm>

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### UK Patent Office Opinions – Introduction

As mentioned above, the new procedure for obtaining a non-binding UK Patent Office Opinion on infringement or validity is expected to be implemented by the end of 2005.

We will keep you informed of progress. At this stage, you might like to begin considering whether the procedure will be of use to you or your clients, and how you – as patentee – might deal with an adverse Opinion.

For example, if – as is expected – the procedure is quick, it may be possible for a prospective opponent to test prior art against the UK part of a granted European patent before the deadline for opposition in the EPO (nine months after the date of grant) expires.

The Opinion will be provided by an Examiner in the UK Patent Office. It will be non-binding, but publicly available.

If, however, the patentee disagrees with an adverse Opinion, he has to make a choice. He can allow the non-binding Opinion to stand on the public record and take whatever action he deems necessary to preserve the enforceability of the patent and parallel patents/applications in continental Europe and overseas. Alternatively, he can request a review of the Opinion by a Hearing Officer of the UK Patent Office. The result of such a review will have the status of a Decision at Patent Office level. Appeal to the courts is then available, and the result of any appeal will have the status of a precedent binding on lower tribunals on the same facts.

So, the **Opinion on Validity** could potentially be a useful weapon to test validity of a competitor's patent and perhaps force the patentee into a program of amendments. The procedure could have fewer downsides for a third party than traditional opposition, re-examination or revocation routes, or could be used tactically alongside the traditional routes.

See <http://www.legislation.hmso.gov.uk/acts/acts2004/40016--a.htm#13> for the text of the new statutory provisions to be implemented.

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## EPO Questions Use of Elaborate Visual Aids at Oral Proceedings

The use of ever more elaborate visual aids at EPO Oral Proceedings was examined in Decision T1110/03, rendered by Board of Appeal 3.5.2 in October 2004.

In the case in question, one of the ten opponents had been allowed to present an hour-long computer-generated slide show at the Oral Proceedings before the Opposition Division, and the Opposition Division commented that the show had been a factor in its decision to revoke the patent.

While not ruling such presentations as impermissible per se, the Board of Appeal explained the dangers in allowing such presentations at Oral Proceedings where no prior notice of content had been given.

The Board observed that a computer-generated slide show is "in essence the presentation of written material which, strictly speaking, belongs in the written procedure rather than in oral proceedings. The use of visual aids such as simple flipchart sketches or slides, or indeed short films demonstrating the workings of a machine, are normally unobjectionable, but ... there is a danger of ... unfairness ... in the unrestricted use of computer-generated slideshow presentations in oral proceedings." (Decision, paragraph 3.2).

Particular points of potential unfairness where the slideshow contains extensive written material lie in the greater speed by which words can be read as opposed to spoken or written, and the immense practical difficulties for the interpreters in multi-lingual Oral Proceedings.

See <http://legal.european-patent-office.org/dq3/biblio/t031110ex1.htm>

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## Amicus Brief Filed in EPO's Review of Prohibition on Diagnostic Methods

As is well known, the Enlarged Board of Appeal of the European Patent Office in case G01/04 is currently considering the proper interpretation to be applied to the prohibition on patenting of diagnostic methods in Article 52(4) EPC, the relevant portion of which reads as follows:

"... Diagnostic methods practised on the human or animal body shall not be regarded as inventions which are susceptible of industrial application ..."

An Amicus Brief has been filed by FICPI, arguing for the exclusion to be interpreted narrowly, so that only methods in which all the steps are carried out directly on the body, and which include an actual step of diagnosing a condition of the body, would be excluded from patentability.

The ruling from the Enlarged Board of Appeal is expected this year. We will report as soon as it is issued.

See <http://www.ficpi.org/library/veniceCET-combined/CET-1404.pdf>.

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