PATENT ISSUES

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The patent has expired – so I am free to make the product, right?

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Patentability of Database Management Systems and Information Retrieval

The revised Guidelines for Examination at the EPO which will enter into force on 1 March 2021 include a whole new chapter G-II, 3.6.4 on the patentability of database management systems and information retrieval. Database management systems are technical systems that are implemented on a computer for storing and retrieving data using various data structures for efficient data management.
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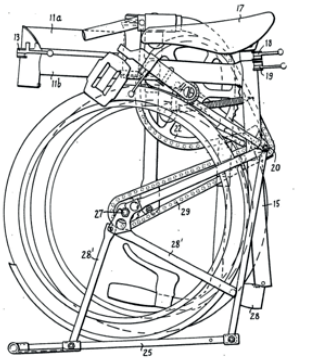
The patent has expired – so I am free to make the product, right? - Hold on - it's not that simple.

The "Brompton" folding bike is a commuter icon. Brompton protected its folding mechanism for two decades with a 1979 patent, and after expiry Korean company Get2Get clearly thought they were free to make a similar bicycle. Isn't that, after all, how the patent bargain is supposed to work? Brompton's response was to sue in Belgium for infringement of copyright in the design drawings of the bike. The European Court of Justice has now ruled on the case, in a decision with significant implications for owners of patents in the mechanical arts.

The Get2Get "Chedech" bicycle uses the same three-fold design as the Brompton bicycle, to ensure that the bicycle can fold into three different positions. Get2Get argued that the appearance and design were dictated by this technical solution. Relying on earlier Court of Justice case law, Get2Get argued that such an appearance therefore cannot be protectable under under copyright law.

The questions before the Court of Justice were whether copyright protection, governed by Directive 2001/29/EC of 22 May 2001, can extend to works whose shape is necessary to achieve a technical result, and what criteria was the court to take into account: The existence of other possible shapes which allow the same technical result to be achieved? The effectiveness of the shape in achieving that result? The intention of the alleged infringer to achieve the same result? The existence and expiry of a patent? These questions have troubled the Courts in the UK since the controversial 1978 Catnic v Hill & Smith judgment (never followed in England, but never overruled either), holding that a patentee in electing for patent protection abandons copyright in their drawings.

Following our website report of the case, we look at the Court of Justice conclusion and what it means for those who are considering creating a design that has gone off-patent.



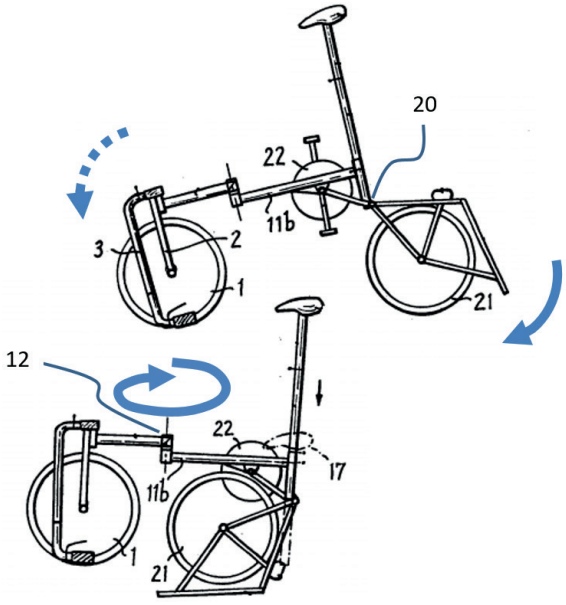
Brompton's Patent

Let us first look at the expired European patent in this case - EP0026800 filed on 3 October 1979, granted on 30 May 1984 and expiring on 2 October 1999. Claim 1 related to two pivots that allowed the rear wheel to be folded under the main frame and the front wheel to be folded alongside it into the very compact folded configuration familiar to Brompton bicycle owners.

There were also of course more detailed dependent claims. These, and indeed any claim that could have been drawn up to read onto any aspect of the design described in the patent application, have now expired. In fact, the patent description more-or-less limited itself to the technical features of the folding mechanism. It did not describe every feature of the drawings, such as the shape of the tube of the frame (which has no curvature in the patent drawings), or the number, thickness and pattern of the spokes of a wheel, or the colours of the various parts. Patent drawings are not considered to be to-scale (though these drawings may have been) and so this patent did not (and could not) claim every detail of the design of the bicycle depicted in the drawings. Where does the expiry leave these unclaimed, undescribed features?

Get2Get's bicycle

There were certainly similarities between Brompton's bike (sold in its current form since 1987) and that of Get2Get.But many of the similarities are at least partly due to the general functionality of a bicycle, or the specific patented folding functionality of Brompton's bicycle.



Claim 1 of Patent EP0026800

A folding bicycle comprising . . . first pivot means (20) interconnecting the rear wheel assembly and the main frame (11) such that the rear wheel assembly can pivot . . . into a folded position in which the axle of the rear wheel is located beneath the main frame and the rear wheel lies substantially between the [unfolded] positions occupied by the front and rear wheels characterised [by] . . . . second pivot means (12) whereby the front wheel assembly (1, 2, 3) is foldable into a position . . . alongside the rear wheel (21) when the rear wheel assembly is in its folded position, and in that the pedal mechanism (22, 23) [and] in the folded condition [of the pedal mechanism] the distance between the axes of the rear wheel and the pedal mechanism is less than in the unfolded condition.

Brompton

Get2Get

Functionality in EU Copyright Law

There are specific exclusions in trade mark and design law for shapes dictated by technical function, and in its case law (for example, C-48/09 Lego and C-205/13 Hauck) the Court of Justice has referred to the need to avoid extending or circumventing the patent system by granting equivalent protection via other means. There has therefore been a temptation (to which the European Intellectual Property Office has often succumbed) to see the existence of a parallel patent as an absolute bar to getting trade mark or design protection. By way of contrast, EU copyright law does not contain any explicit functionality exclusion, though in relation to software the Court of Justice has in the past held that the functionality itself cannot be protected by copyright (C-406/10 SAS), and that no copyright can exist in features "dictated by technical considerations, rules or constraints which leave no room for creative freedom" (C-604/10 Football Dataco). The Brompton case was the first time the Court of Justice had to answer directly the question of copyright in relation to functional features of product shapes, and the effect of parallel patent protection.

The Answer

The CJEU judgment starts from the position that, where features reflect free and creative choices that are made by the creator, rather than choices dictated by the technical requirements, these can have copyright protection. However, the tone is more positive than in previous case law: *"subject matter satisfying the condition of originality may be eligible for copyright protection, even if its realisation has been dictated by technical considerations, provided that its being so dictated has not prevented the author from reflecting his personality in that subject matter, as an expression of free and creative choices."* So, functional features may qualify. On the other hand, the mere *"possibility of choice as to the shape of a subject matter"* is not sufficient per se to conclude that there is a protectable copyright work (as it has also recently held for designs, see our earlier article "Doceram – clarity or confusion on functional designs?"). As for designs, the question is what the designer's intentions were and whether the result reflects his personality; *"the existence of an earlier, now expired, patent … should be taken into account only in so far as those factors make it possible to reveal what was taken into consideration in choosing the shape of the product concerned."*

Dual protection by patent and copyright is therefore undoubtedly possible, and the expiry of the patent has no effect on the existence of the copyright.

This stance reflects another Court of Justice decision just two months earlier, in C-237/19 Gömböc concerning a trade mark which had previously been protected by a design registration. They commented there that:

> *"the objective of the [substantial value] ground for refusal of registration [], like that of the [functionality] ground, is, indeed, to prevent the exclusive and permanent right that a trade mark confers from serving to extend indefinitely the life of other rights in respect of which the EU legislature has sought to impose time limits. … However, such an objective does not mean that EU intellectual property law prevents the coexistence of several forms of legal protection." "… the fact that the appearance of a product is protected as a design does not prevent a sign consisting of the shape of that product from benefiting from protection under trade mark law" … and thus, "the ground for refusal of registration provided for in that provision must not be applied systematically to a sign which consists exclusively of the shape of the product where that sign enjoys protection under the law relating to designs"*

The Consequences

The Court of Justice has kicked away the possibility of a knee-jerk denial of copyright protection for patented designs, leaving patentees free to attempt to enforce their copyright in the EU for the designer's life plus seventy years (following the Court's decision in C-168/09 Flos). All a competitor can safely conclude is that the functionality itself is not protectable by copyright, and a designer of a putative off-patent product must take great care not to copy features where there is creative choice in their shape. This can be a low bar. In C-683/17 Cofemel (concerning leisurewear) the Court of Justice held that, contrary to the approach in many countries, aesthetic value does not part of the determination of whether a work attracts copyright protection.

Although this outcome is favourable to Brompton, a UK company, it is not so helpful for UK copyright law as the UK transitions to complete departure from the EU. At present, Section 51 of the Copyright, Designs and Patents Act says that "It is not an infringement of any copyright in a design document or model recording or embodying a design for anything other than an artistic work or a typeface to make an article to the design or to copy an article made to the design." So, in the UK, it is safe to copy a design after design rights have expired, provided the design is not elevated to the status of being an "artistic work" (a sculpture or work of artistic craftsmanship). It remains to be seen whether the UK Courts will attempt to interpret Section 51 to follow these most recent Court of Justice cases, or whether they will stick with the original intent of the UK legislation.

By David Musker

New EPO Guidelines on Antibodies

Conventional antibodies are large, Y-shaped proteins naturally produced by plasma B-cells and composed of two identical light chains and two identical heavy chains, both containing variable and constant domains. They may exist as single molecules or e.g. in the case of IgM as pentamers or dimers in the case of IgA. Antibodies are designed by nature to bind specifically to antigen targets via the antigen binding region which contains complementarity-determining regions (CDRs) present in the fragment antigen binding (Fab) variable region.

Patenting of antibodies presents significant challenges, in particular relating to how the novel antibody is to be clearly defined. Moreover, rapid and extensive development, in a field that is now quite crowded, has led EPO examiners to assume that the person skilled in the art has quite extensive knowledge of routine techniques for improving such properties as affinity or immune response. This often leads to challenges in presenting a convincing case for inventive step.

The forthcoming Guidelines for Examination at the European Patent Office have a new section encapsulating some of the office practice that has become established in this field.

Claiming antibodies

The new Guidelines discuss different ways in which an antibody may be defined in patent claims. Thus, conventional antibodies, recombinant antibody derivatives or new antibody formats can be defined by their own structure (amino acid sequences), by nucleic acid sequences encoding the antibody or by reference to the target antigen. If defining by the target antigen, it is often necessary to define further functional features. Combinations of functional and structural features can be used and indeed are often necessary. The new Guidelines include comments on each of these approaches and also on defining by the production process, the epitope or the hybridoma producing the antibody.

When defining a conventional antibody by its structure, the EPO has adopted a practice of requiring at least six Complementary Defining Regions (CDRs). Normally this calls for three CDRs of each of the variable domains of the light and the heavy chains that are responsible for binding to the antigen. This already-adopted practice is set out in the new Guidelines. If the claim has fewer than 6 CDRs, it will, under the new guidelines, be objected to under Article 84 EPC because it lacks an essential technical feature. Exceptions are possible if it is experimentally shown that one or more of the 6 CDRs do not interact with the target epitope or if the claim concerns a specific antibody format or variant allowing for epitope recognition by fewer CDRs.

CDRs when not defined by their specific sequence must be defined according to a numbering scheme for example chosen from that of Kabat, Chothia or IMGT.

An antibody can be functionally defined by the antigen to which it binds, as long as the antigen is clearly defined in the claims. If the antigen is defined by a protein sequence, no sequence variability and no open language (e.g. an antigen comprising…) is permitted.

An antibody can also be defined by its ability to bind to a well-defined antigen or a portion thereof in combination with a negative feature as for example: “Antibody binding to antigen X and not binding to antigen Y”.

Claims directed to antibodies that are further characterised by further properties of the antibodies such as binding affinity, neutralising properties, induction of apoptosis, internalisation of receptors, inhibition or activation of receptors are already addressed in the Case Law of the Boards of Appeal. (See, e.g. T0299/86 and T1300/05.) The Guidelines emphasise the burden of proving any unusual parameters to ensure they do not disguise a lack of novelty and the need for an enabling disclosure across the whole scope claimed, and whether a functional definition allows the skilled person to clearly determine the limits of the claim.

Product-by-process definitions, though possible, are disfavoured. They are susceptible to lack of clarity if there may be variants that could render the scope of the resultant antibodies unclear.

An antibody may be defined also by its epitope, i.e. the antigenic determinant of a molecule, especially the specific

portion or part of an antigen to which an antibody binds which may represent linear or conformational binding sites. Epitopes may, for example, be formed by protein or peptide sequences or parts thereof forming conformational binding sites, by hormones, by oligo- or polysaccharides as such or in glycoproteins (e.g. in blood group determining regions of proteins), sites on glycolipids, by lipopolysaccharides or the like. An example is the set of specific amino acids of an antigen which are specifically recognised and bound by the paratope, the binding portion of a complementary antibody.

However, since an antibody defined in this way cannot be easily compared with known antibodies binding to the same antigen the same principles as for the functional features apply.

If the epitope is a "linear epitope" (i.e. the antibody interacts e.g. with continuous amino acids on the antigen), it needs to be defined as a clearly limited fragment using closed wording (e.g. epitope consisting of). If the epitope is "non-linear" or "discontinuous" (i.e. the antibody interacts with multiple, distinct segments e.g. from the primary amino-acid sequence of the antigen), the specific amino acid residues of the epitope need to be clearly identified.

New antibodies must also show an Inventive step

According to EPO case law and the new Guidelines, it is not enough that a claim defines a novel antibody binding to a known antigen. Techniques for finding novel antibodies are so routine that the EPO also requires a surprising technical effect to satisfy the need for inventive step. Examples of surprising technical effects might include an improved affinity, an improved therapeutic activity, a reduced toxicity or immunogenicity, a high specificity, an unexpected species cross-reactivity or a new type of antibody format with proven binding activity.

In the case of binding affinity, the structural requirements for conventional antibodies inherently reflecting this affinity must typically comprise the six CDRs and the framework regions because the framework regions also can influence the affinity.

Comment

Open structural claim language is not permitted, as it will be taken as lacking novelty over any known antibody, because existing antibodies will bind to the undefined region of the target antigen. In our experience, an exception to this principle can be argued if variability around specific epitopes is possible or specific antibody binding sites are present within an antigen.

Antibodies can be inventive if technical difficulties are overcome in producing or manufacturing the claimed antibodies, and we would add that technical difficulties in identifying the antibody may also be relevant.

The new guidelines are not expected to say anything on T cell receptors (TCRs). These represent a special class of antigen binding molecules similar to antibodies. Due to their specific binding properties, especially soluble derivatives of TCRs may also fulfil patentability requirements in a way comparable to antibodies.

By Manuel Kunst

New EPO Guidelines on Patentability of Database Management Systems and Information Retrieval

New Guidelines for Examination at the EPO, which are expected to enter into force on 1 March 2021, will include a whole new chapter G-II, 3.6.4 on the patentability of database management systems and information retrieval. Database management systems are technical systems that are implemented on a computer for storing and retrieving data using various data structures for efficient data management. Consequently, methods performed in a database system constitute methods using technical means and are not excluded from patentability under the EPC.

Features specifying the internal functioning of a database system are generally considered to be based on technical considerations, i.e., to have technical character, and may therefore contribute to inventive step. For example, in T 1924/17 the Board of Appeal concluded that the claimed database system was based on technical considerations "that concern a specific manner of improving response times for queries by automatically using different data stores, relational database management systems and NoSQL data stores, to manage data tables". However, not all features of a database system necessarily contribute to its technical character. For instance, a feature related to the accounting of costs for using the database system is usually not considered technical.

Information retrieval

The Guidelines distinguish between i) the execution of structured queries by a database management system and ii) information retrieval, i.e., the determining what information to retrieve. Information retrieval includes, e.g., searching for information in a document, searching for documents as such, and searching for metadata that provides information about other data.

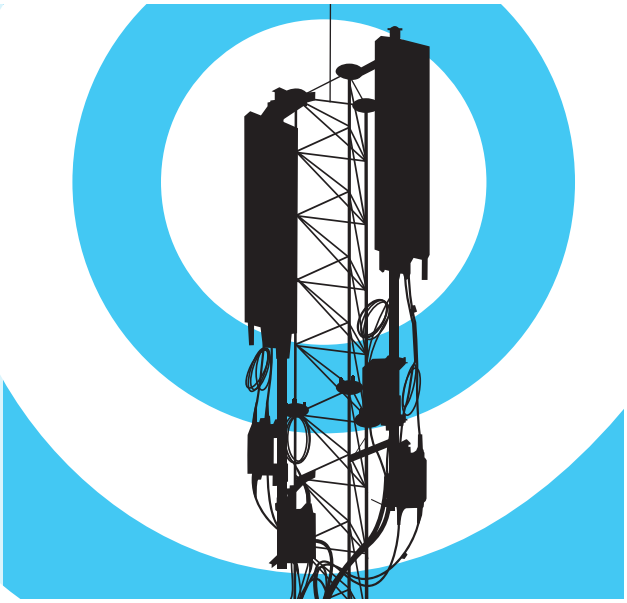
A user may, for example, enter a search query into a web search engine using informal natural language. If the subsequently performed method of information retrieval is solely based on non-technical considerations such as cognitive content, linguistic rules or other subjective criteria (for instance, relevance to friends in social networks), it is considered non-technical. For example, using for information retrieval a mathematical model that calculates the probability of a search term being semantically similar to another term by analysing the co-occurrence frequency of the two terms in a collection of documents does not make a technical contribution per se since it is based on considerations of a purely linguistic nature instead of technical considerations. In contrast, optimising the execution of structured search queries with respect to the required computer resources is considered technical.

Data structures

Regarding data structures used in database systems the Guidelines apply the same principles as described in Chapter G-II, 3.6.3 "Data retrieval, formats and structures". If the data structures serve a functional purpose, i.e., contain functional data such as an index, a hash table or a query tree facilitating data access, they are considered of technical character since their aim lies in controlling the operation of the database system. On the other hand, data structures that are solely defined by cognitive data are not considered technical beyond the mere storing of the data. Data is classified as cognitive data if it is only relevant to the human user. Apart from functional data and cognitive data a data structure may, for example, include features solely aimed at facilitating the work of the programmer. However, facilitating the work of the programmer is not a technical function, and corresponding features can therefore not contribute to inventive step.

By Britta Fischer

UK Supreme Court Confirms that Global Licence of SEPs is FRAND



On 26 August, the UK Supreme Court handed down its long-awaited decision on the subject of fair, reasonable and non-discriminatory (FRAND) licensing of standards-essential patents (SEPs) relating to the 2G, 3G and 4G mobile communications standards ([2020] UKSC 37). This was a combined decision on appeals from separate decisions from the Patents Court:

- Unwired Planet v Huawei
- Conversant v Huawei & ZTE

In Unwired Planet v Huawei, the UK patents court granted an injunction against Huawei under a portfolio of SEPs relating to the various standards. The injunction was stayed pending appeal and would be lifted if Huawei agreed to take a licence under FRAND terms determined by the court, which included a licence of Unwired Planet's global patent portfolio, not just the UK patents. Similar issues were raised in the Conversant case, although this case gave rise to additional grounds of appeal. See our website for more on the cases leading to the appeal to the Supreme Court.

The issues before the Supreme Court were:

1. Should an injunction be granted under an SEP unless the defendant agrees to a global licence, and can the court determine the terms of such a licence?
2. Is the English court the appropriate forum for such a determination?
3. What does the non-discriminatory requirement of FRAND mean?
4. Under what circumstances should an injunction under an SEP be refused as a breach of EU competition law?
5. In general, under what circumstances should an English court grant an injunction rather than damages?

The Supreme Court's decision on each of these issues:

1. English courts have no power to determine infringement and validity of national patents of other countries. However, the ETSI IPR policy under which the relevant standards were set gives the court the jurisdiction to determine the terms of a FRAND licence. Licences under SEPs are normally global, because of the cost and complexity of negotiating separate licences for each country, so a FRAND licence is normally a global licence.

   The IPR policy does not prevent an SEP holder from seeking an injunction in a national court; injunctions are necessary as an incentive for an implementer to agree to a licence on FRAND terms.
2. The owner of a portfolio of SEPs is entitled to decide in which jurisdictions to enforce the patents. In the Conversant case, the only other possible jurisdiction for the dispute was China, but the parallel Chinese proceedings sought only to determine the terms of a FRAND licence for China, and not a global FRAND licence; hence the Chinese courts did not have jurisdiction.
3. Non-discrimination is a general rather than 'hard-edged' requirement. It does not mean that the SEP owner must offer the same, most favourable terms to all licensees; that approach was considered but rejected when the ETSI policy was drafted.
4. Unwired Planet had complied with the conditions for set down in the CJEU's decision in Huawei v ZTE, under which an injunction under an SEP would not be in breach of competition law. Unwired Planet had given sufficient notice before commencing proceedings and had provided key terms of a licence shortly after commencing proceedings, but Huawei had never made an unqualified offer to accept a licence on FRAND terms.
5. In most patent cases, judges have exercised their discretion to grant an injunction rather than an award of damages. In the case of an SEP, the potential licensee should be presented with a simple choice of either accepting a FRAND licence or stop infringing the SEP. If there were no risk of an injunction, there would be no incentive for implementers to agree voluntarily to a licence.

Comment

The Supreme Court's decision has confirmed the ability of the English courts to determine a global FRAND rate, but does this mean that the English courts will become the forum of choice for settling SEP disputes? Or conversely, will implementers stay out of the UK market to avoid being sued in the English courts and thereby forced into a global FRAND licence?

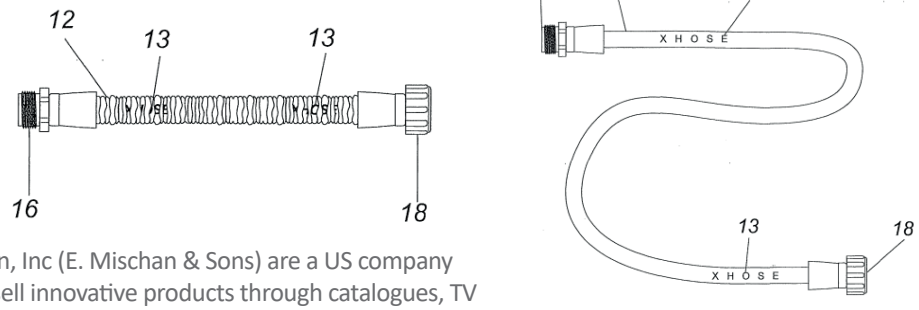
There is nothing in the Supreme Court's decision to suggest that the English courts should have exclusive jurisdiction on the determination of a FRAND licence, and in other future cases similar issues may come before other national courts, which may also decide the terms of a global FRAND licence. This situation has arisen because the ETSI IPR policy did not dictate a forum for settling the terms of FRAND licenses, instead leaving this to be determined by national courts, as the English courts have done in this case.

By James Cross

Obviousness before the UK Court of Appeal

For those fortunate to have gardens, the English spring and summer of 2020 were hot and glorious. As soon as COVID lockdown ended, folks flocked to the DIY stores. Gardening products were in high demand. Winter had been wet, so there was no hosepipe ban as there had been in 2018. Hoses were selling well, including a new self-expanding type of garden hose.

A self-expanding hose is one that, when not in use, shrinks to a compact size for storage but expands under normal mains water pressure to many times its at-rest length.



Emson, Inc (E. Mischan & Sons) are a US company who sell innovative products through catalogues, TV sales and retailers. Emson offered a patented self-expanding garden hose under the brand "**XHose**", but, a leading UK hose manufacturer, Hozelock, entered the market and Emson sued for patent infringement.

It was a brave move on the part of Hozelock, because Emson had previously asserted their patent against another infringer, Tristar. Emson sued Tristar just 3 months after the patent was granted, and the patent was held to be valid and infringed. That was in 2013. Tristar appealed. The validity of the patent was upheld by the Court of Appeal.

This second time around, Hozelock defended based on the same prior art as had been relied on by Tristar, and having lost before the Patents Court, Hozelock also appealed. Brave indeed. Hozelock were asking the Court of Appeal to come to a different conclusion based on the same prior art. The only difference would be the expert evidence. Hozelock thought they had presented a better case than Tristar.

The prior art relied upon was somewhat obscure. Expert evidence was critical. The Court of Appeal were faced with a tricky case.

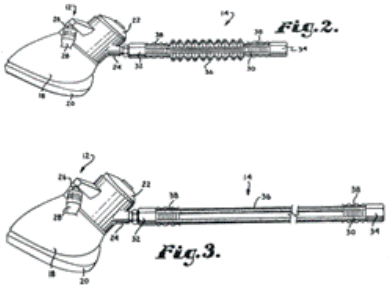
Not res judicata

In another jurisdiction, it might not be possible to re-litigate the validity of a patent based on the same prior art documents. Not so in the Courts of England and Wales. Indeed, the Court of Appeal noted ***"the previous decisions are not admissible evidence on any question of fact arising in the present case."*** The function of the judge was to decide this case on the evidence adduced by parties in this case. Indeed, the expert testimony in this case was materially different to that in the previous case.

"Obscure" prior art

The somewhat obscure prior art reference ("**McDonald**") was not a garden water hose. It was not even a water hose. It was an oxygen mask for cabin crew of an aircraft. It worked in the same way as the invention, although it had a number of shortcomings in its description that left many questions as to whether a skilled person might find its teaching applicable to a garden hose.

It is well established law that where there is prior art, however obscure, which discloses the same invention, then patent protection is unavailable. If it were otherwise, novelty would depend on the circumstances and even language of publication of the prior art. But is the same true for obviousness?



The approach to obviousness in the UK is well established and is known as the four-step "Pozzoli" approach. This case more-or-less hinged on the first step.

The four-step Pozzoli approach to obviousness in the UK

1. Identify the person skilled in the art, and then identify the relevant common general knowledge of that person.
2. Identify the inventive concept of the claim in question.
3. Identify what, if any, differences exist between the matter cited as prior art and the inventive concept of the claim.
4. Viewed without any knowledge of the alleged invention as claimed, do those differences constitute steps which would have been obvious to the person skilled in the art or do they require any degree of invention?

The Court accepted that the relevant skilled person was interested in design and manufacture of garden hoses and ***would typically have exposure to both garden and "technical hoses" used for commercial use.***

The expert for Hozelock had been employed since 1994 in design and manufacture of garden hoses and technical hoses. His evidence was that the operation of the prior art hose of McDonald did not depend on the type of fluid (oxygen versus water), and a skilled person ***"would immediately see"*** that it could be used for other hoses including a garden watering hose. The Court accepted this proposition.

This was in contrast to the conclusion in the previous case. In that case, the Court held that the relevant skilled person was ***a garden water hose designer***. The judge in that case (Mr Justice Birss) wrote ***"I think a garden water hose designer presented with McDonald... would see a document which was not addressed to him or her... used in an environment and context a very long way from garden water hoses and subject to considerations which the garden water hose designer would know they knew little about."*** It may be noted, however that Birss J. rejected the proposition that McDonald should not even to be put before a person skilled in the art at all for the purposes of testing obviousness. He said ***"I believe that is not the law."*** His conclusions were upheld by the Court of Appeal.

Dissent

In the later case against Hozelock, Lord Justice Floyd gave a dissenting opinion. He said ***"viewed against the common general knowledge of garden hoses, the invention was one of breathtaking ingenuity bringing with it real, practical advantages."***

He agreed that there is no support for the proposition that **"the state of the art"** can be different for novelty & obviousness, but he said that the policy behind denying protection for something that is obvious vis-à-vis an obscure document ***"loses its force when the evidence shows that a skilled person would not even have looked for such a document."*** McDonald was a ***"mere paper proposal"*** (quoting Ferag AG v Muler Martini [2007] EWCA Civ 15). He said it was not right to assume that a paper proposal could be successfully implemented. The shortcomings in McDonald (see inset box) that the majority had dismissed one-by-one were ***"not irrelevant in this regard".***

Alleged shortcomings in the description of McDonald

1. McDonald did not disclose the hose diameter - evidence was adduced as to typical oxygen hose diameters (narrow) and garden hose diameters (thicker) but also some evidence of overlap; anyway, the teaching was not tied to any diameter.

2. Materials unfamiliar to a garden hose designer – but the skilled person is familiar with different materials for different hoses.

3. McDonald does not disclose the gas pressure - not an issue to the judge - all the skilled person needs to know is that there is sufficient pressure to cause the tube to self-elongate. The person skilled in the art is not reading McDonald to consider how good it is as an oxygen mask; only to address problems of space, weight and kinking in a garden hose.

4. No disclosure of how to initiate flow of oxygen - again, the expert in oxygen masks probably knows this and the designer of garden hoses doesn't care.

5. No disclosure of how the hose retracted itself - doesn't matter, it's enough that it says that it does retract.

Conclusion - the lack of detail is not such that the skilled person would put McDonald aside as being altogether too confusing.

Comment

So it all came down to whether the person skilled in the art was a garden water hose designer or was a designer of hoses more generally, including hoses for a wider range of technical purposes.

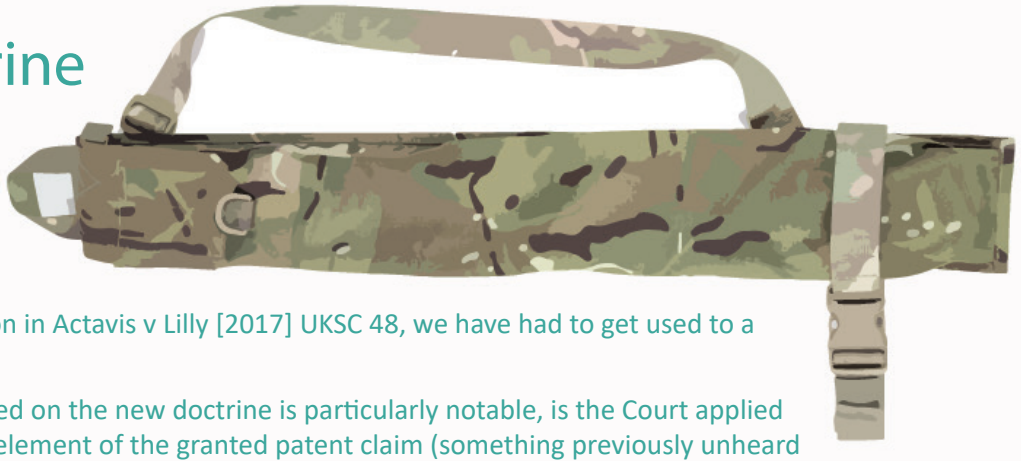
In the earlier trial, the defendants (Tristar) called a witness who was a polymer materials engineer experienced in the properties, design and durability of polymer materials and products. In the later case, the Defendants (Hozelock) called the CEO of a sister company, Tricoflex, that supplied Hozelock with its garden hoses but also sold a range of technical hoses for gases, fuels, oils, chemicals, food and water among other things. He was an **"impressive witness"** having worked on the development of garden hoses but also, as he progressed through the company, on technical hoses.

There was no disagreement between the various judges that the obscure prior art should be put before the notional skilled person. This is the approach taken by the European Patent Office in identifying the "closest prior art". It is a question not of whether the skilled person trying to make a better hose would come across the document in his or her search – rather it is a question of a skilled person who happens to be reading that document asking the question **"how can I modify this to solve an objective problem?"** In this case the problem might have been formulated along the lines of adapting the McDonald hose to use it for other purposes, such as water. But one might still question whether it is fair (or an application of hindsight) that such a person is skilled in the design of garden hoses and is not, for example, an aircraft engineer. The UK courts approach a given document in a very similar way. The notional skilled person is deemed to read any given piece or prior art with interest. Having done so, the skilled person is fully entitled to say (quoting from Asahi Medical v Macopharma): "I have read it with interest, but I am not interested." This was not such a case. The majority decided that the prior art document was within the field of the skilled person, would have been of interest and would not have been dismissed as a bad idea.

Bringing the right expert witness to court is key in many cases of obviousness. The UK courts love an expert. A good expert can be very damaging to validity of a patent. For an example of a battle of the experts, in which a Professor from the University of Sheffield played a trump hand for a patentee, see L'Oreal v RN Ventures [2018] EWHC 173, discussed on our website. ->

By Hugh Dunlop

Update on Doctrine of Equivalents in the UK



Since the UK Supreme Court's decision in Actavis v Lilly [2017] UKSC 48, we have had to get used to a doctrine of equivalents in the UK.

One Patents Court decision that hinged on the new doctrine is particularly notable, is the Court applied the doctrine to disregard entirely an element of the granted patent claim (something previously unheard of). The case in question is Excel-Eucan Ltd v Source Vagabond Systems Ltd [2019] EWHC 3175 (Pat).

It related to a patent for an ammunition bag known as the **"Link-Tail"** (GB 2489116). The bag holds linked rounds of ammunition mounted onto a long piece of webbing to enable easy feeding into a machine gun. Instead of having a zipped opening running the length of the bag through which the linked rounds could be introduced horizontally after being folded. The Defendant's bag had an opening at one end, through which the linked ammunition could be fed vertically and allowed to concertina within the bag.

Thus, the defendants' bag did not have **"an openable closure extending substantially from the first end to the second end"** as claimed. The parties agreed that it did not fall within the scope of the patent as a matter of normal interpretation.

Excel said the clever bit was the **"plug and play"** functionality of the bag, which enabled linked ammunition to be directly fed out of the bag into the gun. The judge agreed. Approval by the Ministry of Defence as a substitute was compelling evidence that it achieved the same result as the Link-Tail.

The bag from Source Vagabond simply used a method of loading the linked rounds which did not require an openable closure, and the same method of loading could be used with the Link-Tail. The linked rounds in both bags would end up sitting in a folded or concertina formation.

The Court found that skilled person would not have concluded that **"the openable closure …"** was an essential requirement.

"Link-Tail" in use, with linked ammunition fed straight from the bag into the gun, webbing-side up.

There was debate over the significance of whether the bag might be loaded upside down. The judge found that the opening of the bag did not dictate which way round the ammunition was loaded; both bags could be loaded horizontally and/or vertically and substantially the same result was achieved. She was satisfied that loading the defendant's bag vertically would achieve substantially the same result in substantially the same way as loading the claimant's bag horizontally.

Comment

Having no doctrine of equivalents gave some certainty to advising on patent infringement prior to 2017. We had **"purposive construction"** and decades of case law to guide us. Throwing that out the window leaves the potential infringer having to second guess what is the **"clever bit"** upon which everything depends and beyond which nothing is important.

In this case, one might reasonably have thought that quick loading of the bag might be as important as rapid unloading. Source Vagabond were damned by their own success in winning the MoD contract. Of course theirs was cheaper – it had no elongate zip – but it was apparently a suitable equivalent.

And what about equivalents to the prior art? Does the prior art have the same elasticity of disclosure? Well – not according to Mr. Justice Arnold in Generics (UK) Ltd (t/a Mylan) v Yeda Research and Development Company Ltd [2017] EWHC 2629 (Pat). The law on novelty has not changed and it would take another Supreme Court decision to change it.

And what about a Formstein defence? This has long been available in Germany. It's a squeeze argument. If a product or process is found to infringe a patent by **"equivalent means"** under the doctrine of equivalents, but the equivalent would have lacked inventive step over the prior art at the priority date, then it is deemed to fall outside the scope of the claim. Does this apply now in the UK? The possibility is recognized in Technetix BV v Teleste Ltd [2019] EWHC 126 (IPEC), but that was a case before the Intellectual Property Enterprise Court and the patent was invalid for other reasons anyway. Formstein is definitely a defence that needs considering. Logically the scope of equivalents would be circumscribed by such prior art or the patent would be invalid. The patentee cannot run with the fox and hunt with the hounds.

By Hugh Dunlop

Revisions to Chinese Patent Law

Recent changes to Chinese patent law aim to promote the enforcement and application of patents, further bringing Chinese law in line with international practices. On October 17, 2020, the Chinese legislature accepted a revision to the Patent Law of the People's Republic of China, which will come into effect on June 1, 2021. Here are just a few highlights. A more complete list of revisions is posted on our website.

Design patents

The term of a design patent has been extended from 10 years to 15 years. The scope of protection has been expanded to include the protection for **"partial shapes of products"**.

Supplementary Protection Certificates

China has introduced the possibility of patent term extension through supplementary protection certificate (SPC). The SPC term is for up to 5 years, with the total patent protection term for drugs on the market not exceeding 14 years.

Statute of Limitations

The statute of limitations for IP infringement has been extended from 2 years to 3 years.

Damages for patent Infringement

The standards of compensation for infringement have been raised to reflect **"the actual loss of the patent holder or benefit gained by the infringer as a result of the infringement"**.

Where the amount of compensation cannot be determined by the statutory method, the available compensation has increased, to 30,000 - 5,000,000 CNY (from 10,000 -1,000,000 CNY). Maximum fines for counterfeited patent products have also been increased.

Special compensation for intentional infringement

In cases of severe intentional infringement of patent rights, compensation of up to five times the statutory measure of compensation is available.

By Handong Ran

Address for service rules - UK patents, trade marks and designs.

Do I need an address for service in the UK for my UK patents, trademarks and designs?

The answer is, generally, "yes", after 1 January 2021 and going forward, but there are exceptions whereby you can retain whatever existing address for service you may have in the EEA.

The exceptions are:

- You do not need a UK address for service for existing proceedings and pending applications;
- When you receive a "comparable" right – i.e. a UK trademark or design registration corresponding to your granted EU trademark or design, you do not need a UK address for service for the new comparable right for 3 years from 1 January 2021, including for any proceedings begun within those first 3 years.

Just to recap, you will need a UK address for service for any new action of any kind, including

- a new patent, trademark or design application,
- opposition of/defending opposition of a UK trademark (that is not a comparable right)
- challenging a UK patent/design/trademark

European Patent (UK) patent validations

Regarding UK validations of EP patents, appointment of a UK representative is optional, but if one is appointed, it must be in the UK. Granted European Patents which designate the UK are transferred onto the UK Register automatically. No validation is required. They are transferred with the applicant's details only, as the UK IPO must have authorisation before it can recognise any representative. This is current practice and will not change.

From 1 January 2021 if you wish to appoint a representative, they will need to have an address in the UK. There may be occasions where you already have a UK address for service for your European Patent, for example, the UK address of Maucher Jenkins if we acted for you at the European Patent Office. We will still need to file authorisation at the UKIPO so that the Office knows we continue to act for you in the UK.

Plant Variety Rights

Nothing specific to plant variety rights has been published by the UKIPO regarding address-for-service requirements, but the EU Withdrawal Agreement refers to plant variety rights (Art 54(1)(c)), so holders of such rights are not required to have a correspondence address in the UK for 3 years from 1 January 2021 (Art 55(2)). Thus, the situation is similar to other rights – if a representative is desired or required, then they must be a UK representative.

Any EU plant variety applications pending on 31 December 2020 must be re-applied for in the UK via the Animal and Plant Health Agency.

Conclusion

The above is a summary according to rules published by the UK government and laid before parliament to be passed before the end of 2020, when the Brexit transition period ends.

If you obtained your European patent through another firm based in the EEA, please inquire about appointing us as address for service in the UK. There are strong reasons for doing so.

As far as EU rights are concerned (EU trademarks and designs), we have already appointed our Munich or Freiburg address for all EU rights under our responsibility and we will notify clients of their comparable UK rights and appoint our London address for those rights.

By Hugh Dunlop

Brexit Guidelines: your Trade Marks and Designs after the transition period

Following the withdrawal of the United Kingdom from the European Union, European Union Trade Marks (EUTMs) and Registered Community Designs (RCDs) are deemed protected in the UK until 31 December 2020.

EU trade mark and design law will cease to apply in the UK after this date, however none of these changes will affect our ability at Maucher Jenkins to handle your European IP matters. We understand that you may still have questions and concerns and have addressed some of the most commonly asked questions on our website, such as:

Why Maucher Jenkins?

Maucher Jenkins is an Anglo-German firm with offices in the UK since 1937 and Germany since 1933. Over the years, we have grown these offices with a strong contingent of experienced British and German IP lawyers and attorneys and Registered European Lawyers (RELs). As a result, we are uniquely placed to offer our clients swift, responsive and fully tailored IP legal services in two of the most important jurisdictions in Europe.

How will Brexit change rights of representation and the capacity to act?

Any natural or legal person (including those having their domicile or principal place of business outside the EEA) can own an EUTM or RCD or file an application for an EUTM or RCD, request the renewal and pay the corresponding fee. No representation is needed.

However, as from 1 January 2021, owners of registered EUTMs and RCDs based in the UK or any other country outside the EEA will need to be represented by an EEA representative if their right is, or becomes, the subject of proceedings (such as a revocation, invalidity or a register procedure) before the EUIPO. Only IP right holders domiciled outside the EU/EEA will be invited by EUIPO to appoint a representative, and only when such a need actually occurs. From 1 January 2021, many UK attorneys and legal representatives will lose their capacity to represent parties before EUIPO. As an Anglo-German firm with professionals based and qualified in the EU, we have a continuing right to practice before the EUIPO, and are therefore well-equipped to continue to represent you in all EUIPO proceedings.

Please get in touch

We look forward to continuing to help you protect, defend and enforce your IP rights in the UK, Germany, the EU and beyond.

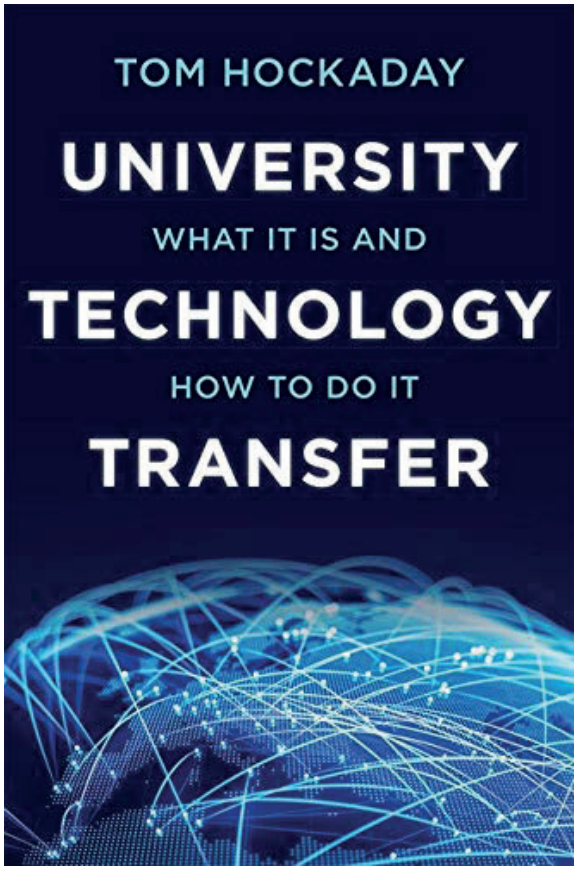
We would be delighted to assist you with any further questions you may have regarding your European IP matters, the impact of Brexit and representation of your EUTMs and RCDs and of your UK comparable registrations and replacement applications.

By James Cross
and Katie Cameron

University Technology Transfer - What it is and How to do it

Book Review

Tom Hockaday was CEO of Oxford University Innovation (formerly Isis Innovation) from 2006 to 2016 and is in a unique position to write on this subject from the point of view of a university technology transfer office. OUI has been an undoubted success story. This year (2020) the University spun out its 200th company and reports it has built up an equity portfolio worth £138m.



In his book, Tom writes about the somewhat sorry history of technology transfer prior to 1985, when legislation brought the exclusive role of British Technology Group to an end and heralded a call-to-arms for UK universities to commercialize university technologies with UK companies. That led in due course to the Oxford University model of a separately Technology Transfer Office, wholly owned by the University. Tom sets out objectively the advantages of such a model, best practices for operating a successful TTO and the dangers of less than full ownership of a TT operation.

"Technology Transfer is a good thing" he writes, explaining why, but also explaining that it is about people and not just about generating revenue. Above all, it is about helping researchers who want help to commercialize the results of their research, which is not every researcher's motivation. And it is ultimately about concluding deals. He has some numbers about how to run a TTO office and sage words for those who choose such a career: *"If … your time is taken up with amazingly interesting meetings with researchers about the technology, [and stimulating debate but you do not do any deals], you will not have done any technology transfer."*

The book is addressed to anyone interested in getting involved in University technology transfer, particularly those working within the TTO framework, but also investors and other support organizations. There are no easy answers (and this is not a light bedtime read) – what comes through most clearly is that it is about good people with a clear vision, dedicating time and putting in hard work. It's not a bonus culture – success is its own reward.

By Hugh Dunlop

News

We were delighted this year to strengthen our trade marks practice with the promotion of **Tanya Buckley to partner**. Tanya has extensive experience in working with high-profile blue-chip companies in relation to their brand management and portfolio reviews and was named in **Euromoney's Expert Guide 2020 as a leading Trade Mark Attorney**.

Dr John Parkin qualified as a Chartered Patent Attorney in March this year, winning a **CIPA prize** for the **highest mark in the patent drafting paper**. He is currently training towards qualification as a European Patent Attorney.

Our UK office has also seen the arrival of trainee patent attorney **Edward Belknap** in September. Edward has a Master's degree in Engineering Science from Oxford University, Lincoln College where he was awarded the **Gibbs prize** in his third year. His research explored the design of novel miniature tension-torsion experimental stages for in-situ micromechanical testing.

Elsewhere across our European network we have expanded our German offices with the addition of associate **Dr Britta Fischer** and trainee patent attorney **Dr Theodor Videnberg.**

Britta has been a representative to the European Patent Office since 2004, and was certified as a patent solicitor by the German Patent and Trade Mark Office in 2006. She is also authorised to act as a representative to the Swiss Patent and Trade Mark Office (IGE).

Theodor obtained his **PhD in chemical engineering** at Imperial College London in 2019. After graduation, he worked as a chemical engineer in the research & development department at Borealis, a leading polymer manufacturer before joining Maucher Jenkins in October. He is currently working towards qualification as a German and European Patent Attorney.

We are delighted to announce that our Patent and Trade Mark Attorneys have again been recognised by the **Legal 500** in their latest publication. This marks our fourth consecutive top tier ranking.

Our Trade Marks team has received a top tier ranking, with Partners **Katie Cameron** and **Angela Fox** recognised as ***"the lead duo of the firm. Medical device and life sciences trade mark specialist Tanya Buckley joined the partnership in January 2020."***

Our team ***"sets itself apart through its focus on UK and European cross-border work, and its combined prosecution and litigation offering for trade marks, designs, copyright and domain names."***

The Patents team has also received excellent feedback, with Partners **James Cross, Hugh Dunlop, Reuben Jacob, Holly Whitlock, Philip Treeby, Alvin Lam and Fiona Kellas** all earning special recognition for their work over the past 12 months.

The group's sector expertise is acknowledged: ***"the telecoms, aviation, technology and life sciences sectors account for the majority of the firm's recent highlights. Increasingly, the team is also active in green energy and AI-related matters."***

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