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IP Law Update

Autumn 2018

Welcome to the autumn 2018 edition of the Withers & Rogers IP Law Update. This e-newsletter provides a round-up of our articles covering some of the most significant intellectual property cases that have been decided in the UK and Europe in the past year.

2018 has seen some interesting science hitting the headlines, from SpaceX®'s rocket launch to Amazon®'s cashier-less grocery store, to Uber®'s self-driving cars. A great deal has also been written about medical advances, especially the huge potential of the CRISPR-Cas9 gene editing technique. The headlines, of course, represent only the tip of a huge iceberg of work by dedicated researchers for many years. We are privileged as IP advisors to get to work behind the scenes as an important part of the commercial strategy.

Some of the cases we've reported on have been headlines themselves. The beginning of 2018 saw the EPO revoking an important patent relating to the CRISPR technology. Frustratingly for the high profile US universities that owned the patent, the fatal issue was that the right to claim priority in respect of the provisional applications had not been correctly assigned. Priority was also an issue in a different EPO case we reported on. These cases show that, however brilliant the technology, it's still essential to follow the formal procedures correctly.

Outside science, the big talking points for the past couple of years continue to rumble on, namely Brexit and the unitary patent and how, if at all, these can co-exist. It's still unclear how this will be resolved, but we are following events closely and keep our website updated with the latest news.

We hope that you find the articles useful. As always, please feel free to get in touch with your usual contact if you have questions about any of the issues raised here, or more generally. We very much look forward to working with you over the coming months.

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Inside...

Patent Cases - UK

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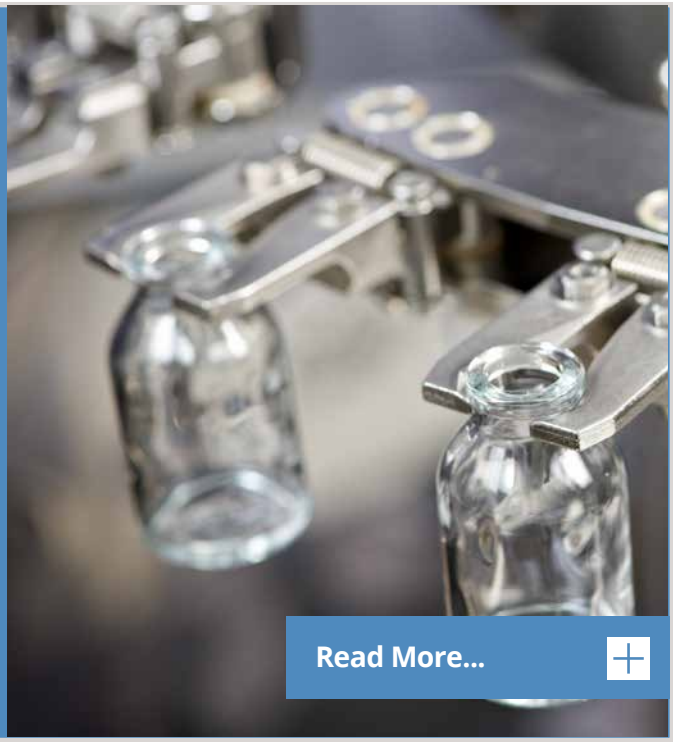
Life after Actavis – questions answered

By Elizabeth Swan

Generics (UK) Ltd (t/a Mylan) & Anor v Yeda Research And Development Company Ltd [2017] EWHC 2629 (Pat)

It's now over a year since the Supreme Court's momentous ruling in the Actavis case. As always, life goes on, and everyone tries to adjust to the "new normal". This case addresses some issues raised by the Actavis case, and gives us some clues as to how the new normal will pan out.



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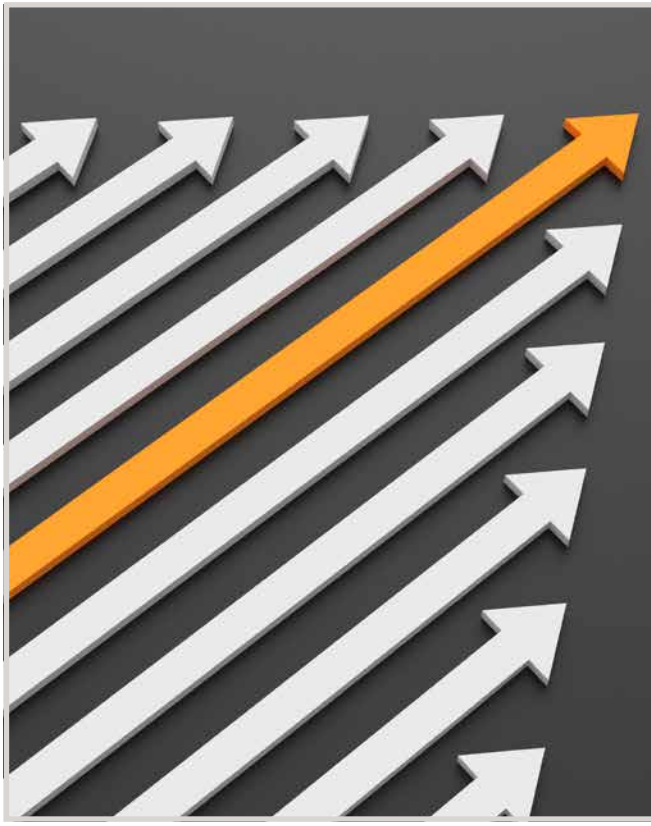

Protecting the unpatentable: Arrow declarations

By Dr Abbie Fisher

Arrow Generics Ltd & Anor v Merck & Co, Inc [2007] EWHC 1900 (Pat)

The UK courts are nothing if not imaginative. A few years ago when the "unconventional" patent strategy of one company led to difficulties for another company in obtaining commercial certainty via any of the traditional remedies, the High Court considered the possibility of issuing a new kind of declaration. This has been known as an "Arrow Declaration". In this latest development the Court of Appeal decided that GSK's claim for an Arrow declaration could proceed to trial.

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Patent Cases - UK

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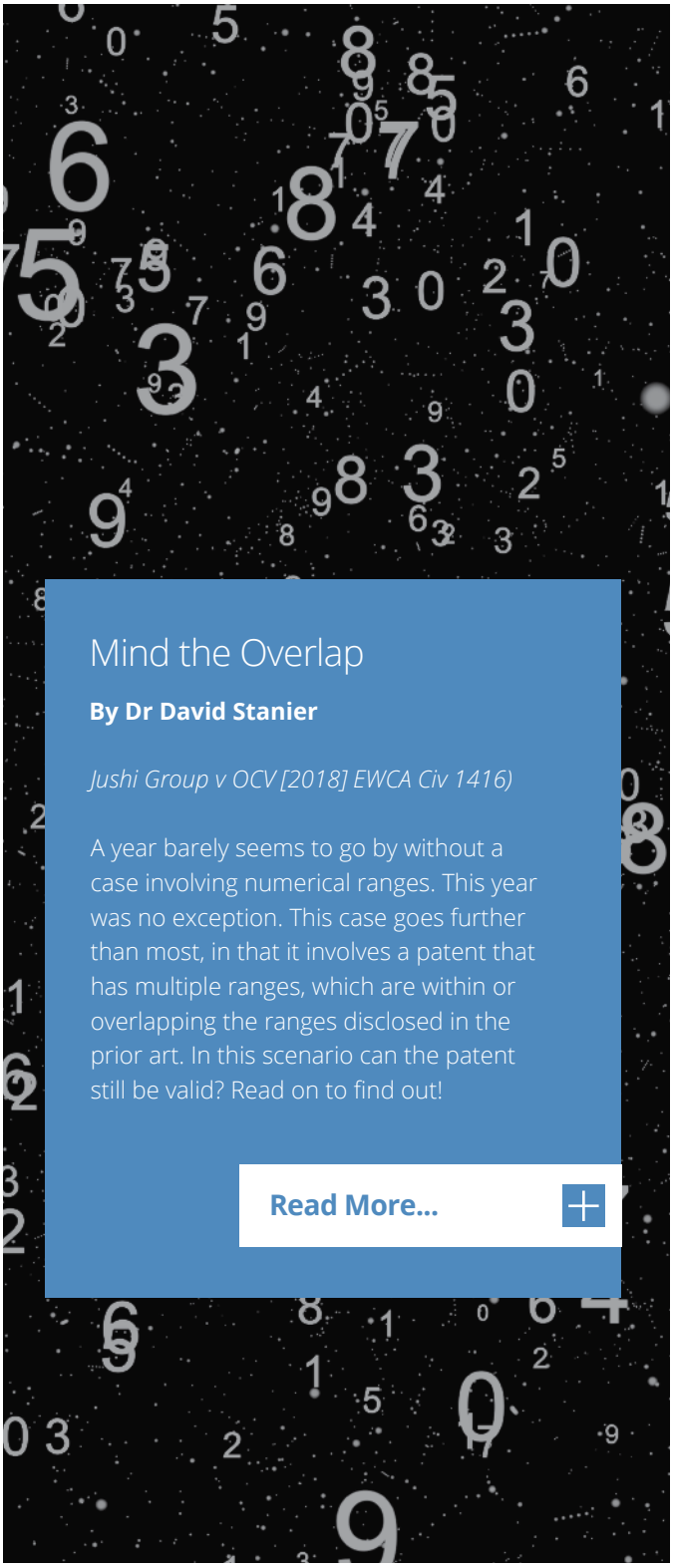

Mind the Overlap

By Dr David Stanier

Jushi Group v OCV [2018] EWCA Civ 1416)

A year barely seems to go by without a case involving numerical ranges. This year was no exception. This case goes further than most, in that it involves a patent that has multiple ranges, which are within or overlapping the ranges disclosed in the prior art. In this scenario can the patent still be valid? Read on to find out!

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Outstanding Benefit and Multinational Companies

By Alex Harvey

Ian Alexander Shanks v Unilever Plc, Unilever NV and Unilever UK Central Resources Ltd [2014] EWHC 1647 (Pat)

The UK Court of Appeal also had the call to consider a claim for employee compensation. This can be due when an invention made by the employee but owned by the employer is of "outstanding benefit" to the employer. Determining whether or not a benefit is outstanding, always the tricky bit, requires regard to be taken of the size and nature of the employer's undertaking. In this case the employer was Unilever, and so the employee was concerned that for such a big company it would be unduly difficult to find that a benefit was outstanding.

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Patent Cases - EPO

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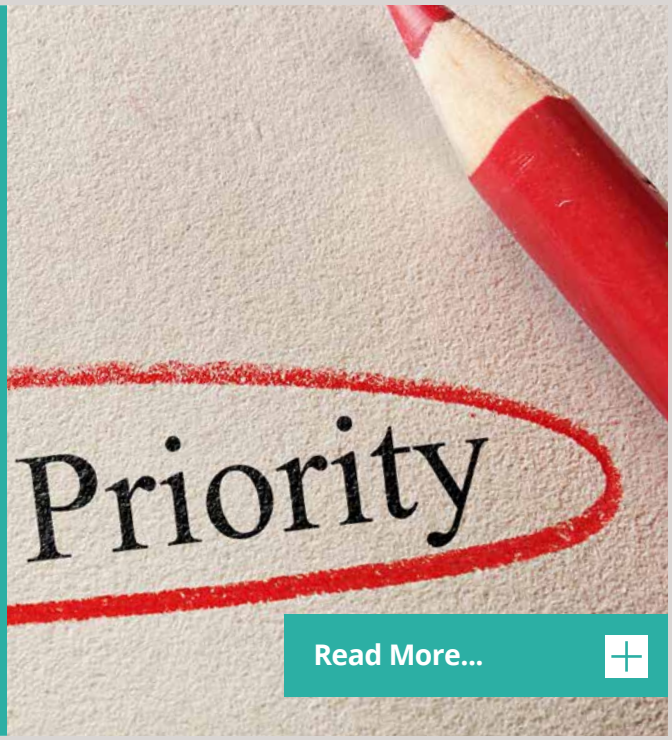
Assigning priority rights in Europe – How to stay out of trouble

By Frank Harner

EPO's Board of Appeal Decision T1201/14

The vast majority of applications include a priority claim. Normally this is never contested and no-one thinks twice about it. However, as this case shows, the EPO has strict rules about when and how the right to claim priority for a European application can be assigned. Not following the rules properly can prove to be a fatal flaw, often discovered years down the line, as was the case in this recent decision by the EPO's Board of Appeal.



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EPO revokes Broad's CRISPR-Cas9 patent

By Dr Kirsty Simpson

EPO's Opposition Division Decision to revoke EP2771468

Gene editing is a hot topic at the moment. It has the potential to revolutionise the way we treat many important diseases, and could even be used to prevent genetic disease arising. Unfortunately, however, for several high profile US universities, patents relating to the gene editing technology CRISPR-Cas9 are subject to the same rules on priority as all other patents. This case fell foul of the EPO's strict rules discussed above.

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Patent Cases - EPO

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Clarification on Undisclosed Disclaimers provided by EPO Enlarged Board of Appeal

By Bruce Dean

EPO's Enlarged Board of Appeal Decision 1/16

Enlarged Board of Appeal decisions from the EPO are relatively rare and often come around because there has been a divergence in the case law of the regular Boards of Appeal. A Board of Appeal itself or the President of the EPO can refer a case to the Enlarged Board, it is not an option for a party in the appeal. This decision relates to undisclosed disclaimers, a means of amending a claim to exclude subject matter that isn't really fully relevant because either: a) it's disclosed in a patent document that wasn't published before the relevant date; b) it represents an accidental anticipation; or c) it relates to non-technical subject matter. The decision addresses the standards to which undisclosed disclaimers need to adhere.

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EPO allows eighth petition for review

By Dr Georgia Mann

EPO's Enlarged Board of Appeal Decision R4/17

There is one scenario in which a party to an appeal can end up in front of the Enlarged Board of Appeal. This is if they file a petition for review, which is a formal request to the Enlarged Board of Appeal to review a decision by the Board of Appeal. However, it is only permitted under certain very limited circumstances, and although 151 had been filed, this was only the eighth to be sucessful.

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Supplementary Protection Certificates

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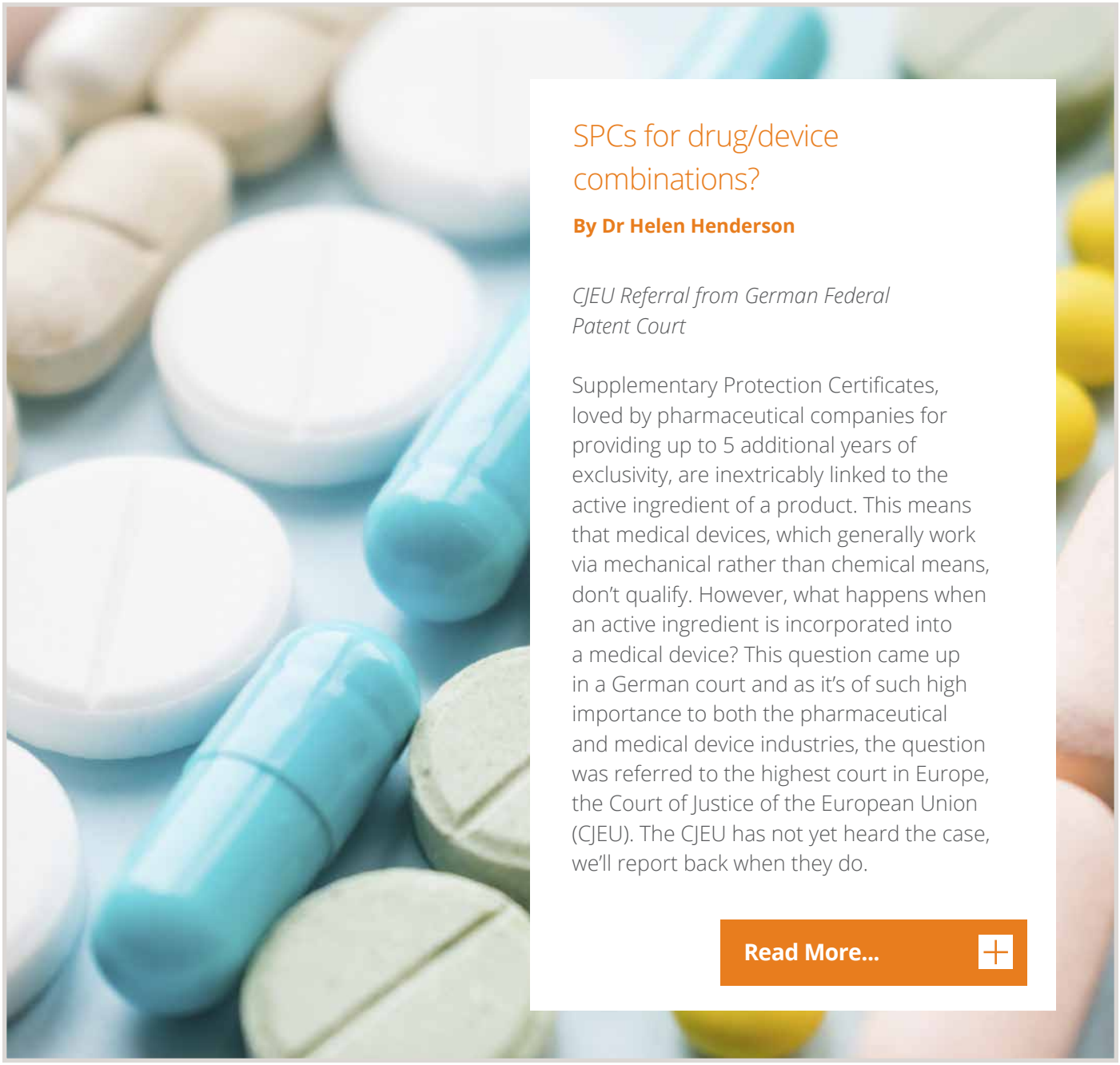

SPCs for drug/device combinations?

By Dr Helen Henderson

CJEU Referral from German Federal Patent Court

Supplementary Protection Certificates, loved by pharmaceutical companies for providing up to 5 additional years of exclusivity, are inextricably linked to the active ingredient of a product. This means that medical devices, which generally work via mechanical rather than chemical means, don't qualify. However, what happens when an active ingredient is incorporated into a medical device? This question came up in a German court and as it's of such high importance to both the pharmaceutical and medical device industries, the question was referred to the highest court in Europe, the Court of Justice of the European Union (CJEU). The CJEU has not yet heard the case, we'll report back when they do.

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Supplementary Protection Certificates

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SPC update – further question referred to CJEU regarding meaning of "protected" -

By Dr Andrew Evitt

CJEU Referral from UK Court of Appeal

Staying with SPCs and following on from the previous comments, the active ingredients of a product are eligible for SPC protection when the product is subject to a marketing authorisation, and the product is "protected" by a patent. The CJEU have previously ruled that the meaning of "protected" is narrower than simply infringing the claim, without saying where exactly the boundary between protected and not protected might lie. This is a report of another referral to the CJEU on this point, meaning there are now three pending referrals attempting to get to the bottom of what "protected" means.

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SPC update – further insight to the meaning of "protected"

By Dr Andrew Evitt

CJEU Preliminary Opinion in the Referral from High Court of England and Wales (C-121/17)

The preliminary opinion from Advocate General Wathelet of the CJEU was handed down in April and seemed to raise as many issues as it answered. We still await the full CJEU decision.

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Trade Marks

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London Taxi Company loses Black Cab case in the Court of Appeal

By Fiona McBride

The London Taxi Corporation Limited v. Frazer-Nash Research Limited and Ecotive Limited [2017] EWHC Civ 1729

Black cabs are a famous part of the London experience, but unfortunately for the company that owns the trade marks covering them, they are not distinctive enough in the car sector for the trade marks to be held valid. This case illustrates the increasing difficulty of registering shape trade marks.

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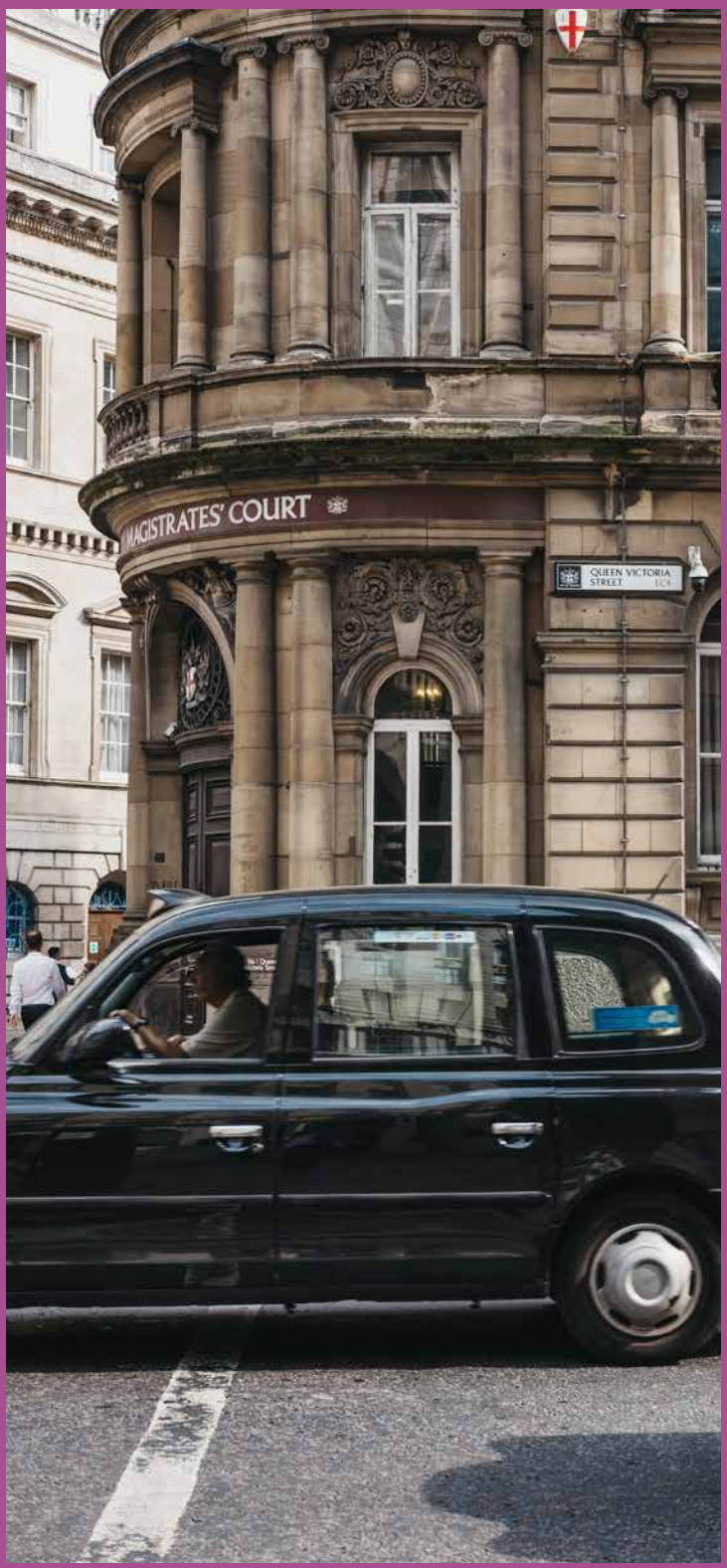

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