

Welcome to the latest edition of Mewsnews, which features highlights of a few of the items of news and developments in European and UK intellectual property. If you would like more information on any of the topics covered, or on a specific area of interest, please get in touch with your regular Mewburn Ellis LLP contact.

disclaimers at the epo

In 2002 we highlighted an EPO Board of Appeal decision (T323/97) which apparently overturned a line of case law allowing disclaimers not having basis in the application as filed to be introduced into patent claims under certain circumstances.

Due to this apparent conflict, the issue of disclaimers has now been considered by the Enlarged Board of Appeal (EBA). The EBA specifically disapproved T323/97 and instead followed the reasoning of G1/93 that amendments having no basis in the application as filed can be made, provided that they make no technical contribution to the claimed subject matter. As a result disclaimers may now be allowed under certain circumstances.

Firstly, disclaimers can be used to establish novelty over earlier European Patent applications which are prior art for novelty purposes only under Art. 54(3).

Secondly, a disclaimer may be used to establish novelty over an "accidental anticipation", which the EBA defines as a document which is "so unrelated and remote that the person skilled in the art would never have taken it into consideration when working on the invention". "Accidental anticipations" were one of the conditions under which disclaimers were previously allowable, but the EBA has now provided a definition of this term, albeit one which has scope for interpretation and could be construed narrowly.

Thirdly, subject matter which is excluded from patentability may also be disclaimed. This covers situations such as the introduction of the term "non-human" in a claim to a method of animal cloning as in the famous "Edinburgh patent".

However, the EBA explicitly states that disclaimers are *not* allowed to overcome prior art which is, or becomes, relevant for assessing inventive step. Disclaimers can also not be used to exclude non-functional embodiments.

The EBA also decided that it was not necessary for a disclaimer to use the exact wording of the prior art document if this would result in a lack of clarity. However, the disclaimer must be drafted so that it does not remove more than is necessary to restore novelty or remove the excluded subject matter.

Whilst the decision generally restores the position before T323/97, problems remain. In particular whether an anticipation is accidental or not is subjective, and the answer may depend on the other prior art available. A new document may cause

inventive step to be reassessed and a previously "accidental" anticipation may then become relevant to inventive step. Similarly, if priority is lost, documents which were only prior art under Art. 54(3) may become relevant to inventive step.

Such situations could prove particularly problematic if the change occurs after grant. Since the scope of a patent cannot be broadened after grant, an invalid disclaimer cannot then be deleted and the patent will almost certainly be revoked with no means of redress for the patentee.

Therefore it appears that whilst disclaimers will be allowed, they should only be used with extreme caution.

spc's: eu enlargement

Since 1st May 2004 supplementary protection certificates (SPCs) have been available for medicinal and plant protection products in the new member states of the EU: Cyprus, Czech Republic, Estonia, Hungary, Latvia, Lithuania, Malta, Poland, Slovakia and Slovenia.

SPCs have the effect of compensating a patent proprietor for an effective shortening of their monopoly period resulting from the need to gain regulatory approval before their product can be placed on the market.

The general rule in the new EU states, as elsewhere, is that an application for an SPC must be filed within six months from the grant of the first marketing authorisation in the state, or within six months from grant of the patent to be relied on, if that is later. However, transitional periods in many of the new countries extend this deadline to six months from accession, i.e. *1st November 2004*.

If you would like more information on the possibility of obtaining SPCs in any country, please talk to your usual Mewburn Ellis LLP contact or to our SPC specialist, Kathryn Nicholls (kathryn.nicholls@mewburn.com).

changes to the ctm regulation

OHIM has recently made the first significant changes to the Community Trade Mark (CTM) Regulation.

In particular, with immediate effect, the complex rules which governed who was entitled to own a CTM have all been abolished and now "any natural or legal person ... may be the proprietor of a CTM". For example, companies based in the Cayman Islands will now be able to apply for, and own, a CTM.

The official search will become optional from 10th March 2008. Applicants will have to indicate on filing that they would like this search and pay a fee (yet to be determined). It remains to be seen whether this is simply the first step in phasing out the searches, since doubts have been raised about their effectiveness and value.

It will soon be possible to divide both CTMs and applications on payment of a fee. There can be no overlap in the goods/services between the divided applications. This may be useful to allow the separation of parts of an application against which an objection or opposition has not been raised, and thus earlier registration of those parts.

It will also soon be possible to recover an application if certain time limits are missed. This "continuation of proceedings" will be subject to payment of a fee and completion of the omitted act within two months of the missed time limit. Many important deadlines, including priority, opposition and renewal are not covered by this.

new epc extension state

European patent applications filed from 1st April 2004 can be extended to Croatia (HR) on payment of an extension fee. PCT applications filed from that date designating both EP and HR can enter the regional phase before the EPO with a request for extension to Croatia.

mewburn ellis llp extranet

We can now offer our clients the ability to look up details of their cases over the internet. To try our demonstration database, click on the "Client log-in" tab on our home page and enter the user name "metest" and password "metest". For more information please get in touch with Wayne Kirby (wayne.kirby@mewburn.com) or your usual Mewburn Ellis LLP contact.

uk trade mark opposition changes

Some recent changes to UK trade mark law have changed the opposition procedure in the UK. The new rules will apply to all proceedings filed on or after 5th May 2004, and to existing proceedings once the next procedural step is taken.

Where an opposition is based on an earlier registration which is more than five years old, the opponent will have to complete a "statement of use" which sets out the details of the goods/services in relation to which the earlier mark has been used in the last five years. Evidence substantiating this use will have to be filed at the beginning of the evidence round, and failure to do so for any mark will mean that the mark cannot be relied upon in the opposition. It is believed that there will be cost implications if the opponent cannot substantiate the claims made in the statement of use.

There is now provision for a "cooling-off period" in UK oppositions. This concept is similar to that currently available in CTM oppositions, although it can only be entered at the *joint* request of the parties. The cooling-off period will be a single, inextensible term of nine months and can be terminated by either party on request.

In an effort to shorten proceedings, the Registry will now issue a "preliminary indication" of the decision that is likely to be reached on the basis of similarity between the marks and the goods/services. Where the preliminary indication is accepted by both parties, the proceedings will end without any evidence rounds.

Similar changes have been made to invalidity and revocation proceedings.

community patent stalled

Despite promising recent signs, this project appears stalled, possibly fatally so. A recent meeting of the EU's Competitiveness Council failed to reach the required unanimous agreement on the proposed text, particularly in relation to the required claims translations, their legal significance and their timing. With all possible compromise positions seemingly exhausted, this could be the end of the Community Patent, at least in its present incarnation.

This information is simplified and must not be taken as a definitive statement of the law or practice. For more information on Mewburn Ellis LLP and other intellectual property matters, please contact us or visit our website at www.mewburn.com.

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