

circumstances, that those means are suitable for putting, and are intended to put, the invention into effect in the UK".

In this case, the claimed product was a device for sanitizing and simultaneously embossing packaging foils "...comprising at least two embossing rolls that are connected to a driving system". The defendants supplied rolls into the UK, but no other part of the claimed device. As such, they did not infringe the claim on a primary basis but had provided an essential element of the claim.

However, the defendants had only been shown to have supplied rolls into the UK after an order had been placed by an undercover agent acting for the patentee. The patentee was not able to prove that the rollers had been supplied to anyone who was a person "other than a licensee or other person entitled to work the invention"; therefore this supply could not infringe.

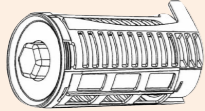
The patentee's fall back was to argue that the supply was evidence of a threat and intention to infringe. In this regard, it was noted that the defendants made no enquiries as to whether the person whom they were supplying was authorised to work the patent. Therefore the defendants would, apparently, have supplied the rollers regardless of whether the agent was acting on behalf of the patentee or an unauthorised party. This was sufficient for the court to find evidence of a threat to carry out contributory infringement.

The issue of whether Darsail's web site could be held to be an offer to sell within the UK was also considered. It was decided that the website was an offer to supply the disputed rollers, despite the fact that the website did not provide an option to click and purchase. However, the website was directed to the world at large and it was found that the average customer within the UK of the relevant goods would not regard the site as being aimed and directed at him. At most it was an offer to supply customers who included customers in the UK and thus it did not constitute an offer to supply in the UK.

Toby Gosnall

Invalidity of registered design for a hidden part of a complex product

A registered Community design (RCD) has been found invalid for being invisible during normal use of the product. The RCD 000831995-0002 protected a design for a vaporiser for an aromatic odour neutralizer, as shown below. Instructions provided with the product as sold indicated that it was a refill product, for use within an air-freshener housing.



The Community Registered Design Office (OHIM) was asked to consider whether the design was invalid for failing to fulfil the requirement that a design applied to, or incorporated in, a product that constitutes a component part of a complex product may only be considered to be new and to have individual character if the component part, when incorporated into the complex product, remains visible during normal use of the latter. "Normal use" is defined as use by the end user, excluding maintenance, servicing or repair work. It was suggested that the vaporiser was hidden within the air-freshener housing during normal use and therefore a design for the vaporiser could not validly be the subject of a RCD.

In defending the invalidity case, the proprietor argued that that the vaporiser was an independent product in itself and could be used without a housing. A print out from a website indicating this possibility was produced as evidence.

However, the Invalidity Division of OHIM found the proprietor's evidence unpersuasive because it related only to a theoretical possibility. The only "real" use of the vaporiser was held to be use together with a housing, as indicated in the instructions provided with the commercial product. In such a use, the vaporiser was hidden within the housing. The RCD was therefore declared invalid because it lacked any visible feature that fulfilled the requirements of novelty and individual character.

Meanwhile, in an appeal decision on RCD No. 253778-0001, the OHIM Board of Appeal clarified the meaning of the requirement that a component part of a complex product be visible in normal use. The RCD related to chaff cutters, which are the rotating cutting parts of shredding machines. In normal use, the cutting parts are typically obscured by waste material placed in a hopper above the parts, and even when not so obscured, rotation prevents the features of the parts from being seen.

However, when waste material is delivered to the shredder by truck, the driver views the cutting parts using a mirror for safety reasons, whilst if delivered by conveyor belt, a safety camera is used to monitor the shredding process. The Board held that this was enough to consider the cutting parts as visible; the component part need not be visible in its entirety at every moment of use but rather it was sufficient that the whole of the component could be seen some of the time, in such a way that all its essential features could be taken in.

The Board suggested that component parts which are not visible in normal use are excluded in principle from RCD protection because "no-one cares what they look like". It therefore appears that if something is in the least part visible in normal use, the law considers that there is at least a possibility that someone might care what it looks like, and so it may qualify, in principle, for protection.

Carl Yelland

DEVELOPMENTS IN IP

New countries set to join the Madrid Protocol system

Preparations are underway in Thailand, New Zealand, India and Colombia for these countries to join the Madrid Protocol system. This system provides for International

registration of a trade mark by virtue of a single application that designates those countries party to the system where the applicant would like to try and obtain trade mark protection. There are over eighty countries that are party to the Madrid Protocol system. At present, there is not a confirmed date for the expansion of the system to cover any of the four new countries, but once one is set this will be reported.

Lucy Walker

Information disclosure requirements for European patent applications

The European Patent Office (EPO) will soon require certain information on prior art known to the applicant to be submitted as a matter of course. The provisions will apply for new applications filed in Europe, either as a direct filing or out of the PCT, from 1 January 2011. European law has always contained a provision that allows the Examiner to request prior art information to be submitted, but it has rarely been used.

The new rules will require that any search results received on patent applications from which priority is claimed must be submitted on filing the application in Europe. If these search results are received after filing the European patent application, they must be provided to the EPO without delay.

If at the time examination commences no priority application search results have been submitted, the applicant will be specifically invited to file the search results within a period of two months, or confirm that there are no search results to make available. Failure to reply will lead to the European application being deemed withdrawn.

The possibility for the Examiner to request submission of details of any prior art information known to the applicant will still apply for all European patent applications. It remains to be seen whether this provision will be invoked more frequently.

Yvonne Johnson

Proposals to replace the Patents County Court

Lord Justice Jackson, of the Court of Appeal, has reviewed the costs incurred in civil litigation in England and Wales. He has arrived at some specific recommendations for intellectual property actions, aimed in particular at reducing the cost of access to justice for small and medium-sized enterprises (SMEs). At present, there are two main fora in England and Wales in which patent disputes can be litigated: the Patents Court, which is part of the High Court, and the Patents County Court (PCC), both of which are based in London. The PCC was created in 1988 in order to generate a lower cost alternative to High Court proceedings, but the unification of court procedure brought in by the Wolff reforms has meant there is little practical difference between the two courts, especially as far as litigation costs are concerned.

As such, Lord Jackson has recognised that companies, and SMEs in particular, would appreciate a lower-cost route to resolving their disputes. Therefore he has proposed replacing the current PCC with a new Intellectual Property County Court (IPCC), in which parties would be obliged to set out their cases in much more detail early on in the proceedings, more of the procedure would be carried out on paper, and the length of oral hearings would be substantially reduced. Cross-examination would be eliminated, unless a party can convince the judge that the benefit of doing so exceeds the costs involved.

The costs recoverable by the winning party in the IPCC would be restricted to £50,000 for patent infringement and validity cases and £25,000 for other cases such as trade mark or copyright disputes. There would be also be a limit of £250,000 on the damages recoverable from an infringer, in line with the IPCC's role as a lower-cost forum.

There are also proposals for an IP small claims track to be brought in within the IPCC, for very small claims (worth less than £5,000), with practically no costs recoverable.

Whether the reforms will be implemented remains to be seen, but Lord Jackson's review made it clear that it has been appreciated that smaller companies feel the need to be able to resolve disputes in the courts at lower cost than at present, and with greater predictability of the costs for which they could be liable should they lose.

David Harris

Patentability of stem cells

Following on from the European Patent Office's Enlarged Board of Appeal decision in G2/06 to revoke a patent for a method of obtaining embryonic stem cell cultures, which necessarily involved the destruction of a human embryo, the question of patenting stem cell technology has again been raised.

In this regard, the German Patent Court has now referred questions to the European Court of Justice (ECJ) regarding the correct interpretation of Article 6 of Directive 98/44/EC on the legal protection of biotechnological inventions. This Directive indicates subject matter that shall be considered unpatentable, including the use of human embryos for industrial or commercial purposes.

Greenpeace had brought a case to revoke Brüstle's German patent covering the use of certain cells for the treatment of neural deficiencies, such as Parkinson's disease or multiple sclerosis. Greenpeace argued that a human embryo had been killed to harvest the cells, because originally the stem cells were derived from blastocysts and human life starts with the fusion of sperm and ovum, meaning blastocysts are embryos in the sense of the law.

The patentee asserted that in the UK, France, Spain, Sweden and Denmark the term "embryo" refers to fertilized eggs 14 days after fertilization, whereas the patent claims the use of stem cell lines harvested from blastocysts 4 to 5 days after fertilization. Therefore the patent only utilises products that are not correctly viewed as embryos.

Following the referral, the ECJ will now have to rule on what is meant by "human embryo" in the context of EU law. Further, if the blastocysts used are viewed as human embryos, the ECJ will then need to decide whether the therapeutic applications covered by the patent are correctly viewed as commercial or industrial purposes. It is to be hoped that the ECJ will provide more general guidance on patentability in this field, as compared to the EPO decision that was clearly limited to addressing the specific facts of the case.

Yvonne Johnson

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THE INFORMATION IN THIS REVIEW SHOULD NOT BE RELIED UPON AS BEING A COMPLETE STATEMENT OF THE LAW ON ANY SUBJECT. WE RECOMMEND SEEKING ADVICE BEFORE PURSUING ANY ACTION.



BARKER BRETTCELL

Spring 2010 News Review Compiled by Barker Brettell for its Clients

FIRM NEWS

Promotions at Barker Brettell

Barker Brettell is delighted to announce the promotion of two of its attorneys with effect from 1 April 2010.

Simon Robinson has been promoted to be a Partner of Barker Brettell. Simon is a patent attorney based in our Southampton office and specializes in the fields of physics, electronics and computer-implemented inventions.

We are also pleased to announce that Lucy Walker has now been made an Associate of Barker Brettell. Lucy is a trade mark attorney based in our Birmingham office and is experienced in all aspects of trade mark work.



Simon Robinson Lucy Walker

New Birmingham offices

Barker Brettell's head office will be moving location later this year. The new premises, which will bring all of Barker Brettell's Birmingham employees under one roof, is a flagship development for the area and one of the first buildings in Birmingham to achieve the BREEAM* 2008 Very Good Environmental and Sustainability standard.

All of our clients and contacts will soon be receiving information about the move, and our new contact details. However, the Birmingham office fax and email details will remain unchanged by the move.

IP UPDATE

Patent fee changes

The UK Intellectual Property Office (UK IPO) has made changes to the patent fee system, which take effect from 6 April 2010. The changes are intended to enable the UK IPO to realign its processing costs with its fees. Fee reductions for handling matters electronically are also increased, to encourage e-business, for both environmental and efficiency reasons.

The main changes are:

- a 50% increase in the regular search fee, from £100 to £150
- an increase in the examination fee from £70 to £100
- a £20 fee reduction for e-filing the request for search or request for examination
- a new £50 fee for registering rights acquired in a patent or patent application
- a new fee of £350 for requesting that the UK IPO continues the examination of contested inter partes proceedings, once a counter-statement has been filed
- a new £150 fee for requesting the restoration of a right to claim priority for a PCT application filed at the UK IPO
- increases of £20 in the renewal fees for years 5 to 12, and more dramatic increases in the renewal fees for years 13 to 20, with the 20th year renewal fee increasing the most, from £400 to £600.

It is worth noting that for renewal fees that have a due date before 6 April 2010 the old fee rate will apply, even if the renewal fee is paid late, within the grace period. However, for all other renewals paid from 6 April 2010 onwards, the new rates will apply.

Meanwhile, from 1 April 2010 new fees will apply at the European Patent Office (EPO). In this regard, most of the fees payable to the EPO will increase by about 5%. The new fee amounts will apply where the fee is paid on or after 1 April 2010.

Yvonne Johnson

UK trade mark invalidity decisions have estoppel effect

The UK Intellectual Property Office (UK IPO) has issued a practice notice drawing attention to the potentially far reaching effect of its decisions in trade mark invalidity cases, which can now have a res judicata effect. Therefore if a decision of the UK IPO on whether a trade mark is invalid is not appealed, it is no longer possible to bring proceedings in the High Court regarding the same issues. The notice advises that in the case of trade mark invalidity actions before the UK IPO that are based on relative grounds, i.e. where the applicant is requesting that a trade mark be removed from the register because of its earlier mark or unregistered right, a full oral hearing will be required.

This practice announcement has arisen as a result of a UK High Court decision in the case of W and SM Evans v Focal Point Fires Plc. Focal Point is a sizable UK manufacturer of fuel effect fires and in 2000 it registered the trade mark Firecraft in the UK. William and Susan Evans had traded, as a partnership, under the name Firecraft, in the field of bespoke fireplaces since the 1990s. The partnership had not itself sought registration of the mark Firecraft, but in 2007 challenged the Focal Point registration. It was argued that the registration should not have been granted because at the time the application for registration was filed the partnership had established unregistered rights in the Firecraft mark, which prevented the use of the mark by Focal Point under the law of passing off.

The outcome of the invalidity action before the UK IPO was that the registration was declared invalid. Focal Point did not appeal and its registration of Firecraft was therefore removed from the UK trade mark register. Focal Point continued to use the mark on an unregistered basis and the partnership decided to launch an action for passing off before the UK High Court.

It was decided that the UK IPO had already ruled on the passing off issue when declaring the UK registration invalid on the basis of the prior unregistered rights, because by finding the registration invalid the partnership's unregistered rights under the law of passing off were acknowledged. Therefore the principles of issue estoppel and abuse of process prevented re-litigation of the point. As a result, summary judgement in favour of the partnership was granted.

The issue of the status of decisions of the UK IPO in inter partes matters, such as invalidity and opposition actions, has been the subject of debate for some time. As recently as 2007, the UK Court of Appeal decided in Special Effects v L'Oreal that UK IPO decisions in opposition matters do not normally give rise to estoppel and re-litigation between the parties on the issues involved can be possible.

The recent judgement clearly draws a distinction between invalidity and opposition proceedings and suggests that, so far as invalidity is concerned, decisions by the UK IPO in cases based on relative grounds will cause a res judicata effect. Therefore a UK IPO decision as to whether or not a mark should be removed in view of an earlier mark or unregistered right will have consequences in subsequent proceedings relating to the same marks and rights.

As a result, parties contemplating, or involved in, trade mark invalidity proceedings before the UK IPO will need to take into account the implications of a negative judgement. If launched or defended, it seems clear that such proceedings will become

more costly, complicated and hard-fought in view of the serious implications of an invalidity decision for subsequent actions for infringement or passing off.

Jill Matchett

Speedier grant of European patents

The European Patent Office (EPO) and the Japanese Patent Office (JPO) have begun a collaborative fast-track examination procedure, called the Patent Prosecution Highway (PPH) program. As reported in earlier editions of the Newsletter, similar PPH arrangements exist between other national patent offices, in particular between the UK, Japanese and US offices. The EPO/JPO program is running on a trial basis from 29 January 2010 to 28 January 2012. The program can allow European patent applications to be examined more quickly when there is already a determination from the JPO that claims directed to the same invention are patentable, and vice versa. This should lead to patents being issued more quickly by those offices.

Meanwhile, the existing PPH trial between the EPO and the US Patent and Trademark Office (USPTO) has been extended to run until 30 September 2010.

A new PCT based PPH pilot program has also been announced. This allows the work carried out by any one of the EPO, JPO or USPTO as the International search or examination authority to be utilised in subsequent national examination before one of these three offices, provided that this work had determined one or more claims to be allowable. Again, the applications under this PPH scheme will be fast-tracked. The PCT based PPH pilot program commenced on 29 January 2010 and is due to run until 28 January 2012.

If you would like to discuss whether any of your patent applications are eligible for any of the PPH programs please contact your usual patent attorney.

Simon Robinson

Use of a keyword – is it trade mark infringement?

A number of trade mark cases before the courts in various European countries are debating whether the use of a third party's trade mark as a keyword amounts to trade mark infringement, either by the party using the keyword or the party selling use of the keyword. A majority of these cases, including L'Oreal v eBay and Interflora v Marks & Spencer, have referred questions to the European Court of Justice (ECJ) for guidance as to how the EU law should be applied before issuing their decisions.

In the case of Google France v Louis Vuitton, the Advocate General has handed down his initial opinion, which is that the use by a third party of another party's trade mark as a keyword will not amount to trade mark infringement by the party using the keyword or the party which sold the right to use the keyword. The Advocate General's opinion is not binding on the ECJ but can give an indication as to the thought process that could be followed.

No doubt when the ECJ issues its final decision in this case, a barrage of decisions will issue from pending cases that have been awaiting the ECJ guidance. The ECJ's ruling is expected in the first half of this year.

Lucy Walker

Burden of proof for internet prior art against patent applications

The European Patent Office (EPO) recently issued guidelines clarifying how prior publications found on the internet - so called "internet citations" - can be used. There has also been a recent case involving a patent application of Ranger Services Limited at the UK Intellectual Property Office (UK IPO) where the use of internet citations was considered. This matter is increasingly relevant to patent examination as more prior art documents are only found, or are at least published first, on the internet.

The key issue with an internet citation is to establish the date of publication. The EPO guidelines clarify that an internet citation cannot be used where the date of publication cannot be determined. An applicant may therefore evade an internet citation by arguing that the date of the citation cannot be proved. However, in the event that the text of the citation states a publication date this will be taken on face value unless evidence is provided that challenges this.

Of course, many internet citations do not include a stated publication date. The burden of proof then lies with the person raising the document (the patent office examiner or the opponent) to establish a date of publication, possibly using an internet archiving website such as www.archive.org. Although the validity of the dates provided by such websites has been queried, the EPO guidance permits their use. The approach taken is that whilst such websites might not contain all published documents, and therefore are not a comprehensive source of information, if they do give a date for a relevant document then that date can be used; it is then for the owner of the patent application to prove the date is invalid.

With regard to the level of proof required for the date of publication of an internet citation, in the UK case the patent applicant contended that the burden of proof of "beyond reasonable doubt" should be used, as in criminal cases. However, both the EPO and UK IPO have confirmed that the lower, civil, standard of "on the balance of probabilities" is sufficient.

Accordingly, to successfully argue against an internet citation as being in the public domain it will be necessary to show evidence as to why the particular publication date relied on is incorrect. Broad arguments based on the unreliability of publication dates on the internet will not usually be accepted.

Andy Locke

New decisions on second medical use claims and the language of European patent applications

The Enlarged Board of Appeal (EBA) of the European Patent Office (EPO) has issued two decisions providing clarification on points of European practice.

The first decision, G2/08, confirms that protection for a new medical treatment using a known substance is possible under the EPC2000 law that came into force in December 2007, even when the substance is already known for use in a different treatment regime for the same illness. The protection of so-called "second medical uses" should apply to any specific use of the substance in a therapeutic method, provided this use is not known and is inventive.

Essentially, if a method of treatment using a known substance would be patentable were it not for the exclusion from patentability of methods of treatment, then a claim to the substance for this new use should be permitted. This includes situations where the novel and inventive feature is a new dosage regime. This is consistent with the UK Court of Appeal decision in Actavis UK Ltd v Merck & Co Inc.

The EBA also found that the "Swiss type" claim language used for second medical use

claims prior to EPC2000 was no longer acceptable. This claim language, covering use of a substance in the manufacture of a medicament for the treatment of a specified therapeutic application, was developed by case law due to a lack of statute in this area. The fact that EPC2000 fills the gap in the statute means that the case law is no longer required. Accordingly, inventions in this field must use the language permitted by Article 54(5) EPC, namely claiming the substance for use in the specific treatment. However, the EBA indicated that this bar on Swiss type claim language would not have retroactive effect. Instead, it would only affect patent applications having an earliest date (priority date or filing date) three months or more after the date of publication of G2/08 in the Official Journal.

The second case, G4/08, rules out the possibility of switching the official language of the proceedings for European patent applications. Specifically, the EBA has stated that for a European regional phase application where the PCT application was published in an EPO official language (English, French or German) the European application has this language, by default, as the official language of the proceedings. This language cannot be changed by providing a translation into a different EPO language on filing, nor can it be changed on request, even if all parties agree.

This decision is not unexpected; the rule that had specifically allowed the language of the proceedings to be switched was deleted from EPO law in 1991. However, rules remain that allow the applicant to correspond in any of the languages of the EPO and to use any of the languages of the EPO at oral proceedings. Therefore the main effect of the ruling is that the specification, and any subsequent amendments, must be in the language of the proceedings, and that the EPO will issue its communications in that official language.

Yvonne Johnson

IP ANALYSIS

Hidden dangers in threatening to sue for infringement

Two recent cases have reiterated the care that must be taken when addressing potential infringement of intellectual property rights. UK law contains provisions that protect the public from intimidation by certain threats issued by a patent proprietor, if those threats are ultimately groundless. Similar provisions also apply for trade marks and designs.

The first of the cases involved Riemser's patent covering a device for insect bite treatment. Riemser believed that Zeno's device for treating acne might infringe its patent and wrote to a large number of Boots stores stocking Zeno's product, drawing attention to its European patent and suggesting that Zeno had adopted the same technical solution. The letter did not allege that Boots was infringing the patent, or mention that patent infringement proceedings might be brought, and it was asserted by Riemser that the sole purpose of the letter was to discover whether the patent had been infringed. However, the UK High Court found that, in the circumstances, a reasonable person would have understood the letter to amount to a veiled threat of infringement proceedings.

Zeno's device was found to not infringe Riemser's patent, and thus the perceived threat was a groundless one. Therefore Zeno was able to obtain relief from Riemser for the damage caused by the groundless threats.

In the second case, Grimme started an action against Scott for manufacturing and selling a potato separator. Grimme had patent and unregistered design rights in respect of the product. Grimme's solicitors wrote to a number of Scott's clients advising them that action was being taken against Scott. Although the letter explicitly stated that Grimme did not intend to take action against the recipient, the letter also "reserved all its rights in the matter" and indicated that contact would be made again. The UK High Court decided that the letter was a veiled threat of infringement proceedings. It considered that the ordinary recipient would read the letter to suggest that although Grimme did not currently intend to commence proceedings, it would be likely to do so in the future if it succeeded in its action against Scott.

Although it was found that some of the roller designs were infringed, the veiled threat of infringement was viewed as having been made with regard to all the roller designs. Therefore the threat had not been justified in its scope, and so a groundless threat had been made in respect of some of the designs.

These two cases act as a reminder that a proprietor should be cautious in selecting the wording and intended recipient of any letters or statements issued in connection with actual or possible infringement proceedings. Extreme care should be taken and advice should be sought as early as possible if there is any suspicion of potential infringement of rights.

Jo Kent

Protection of luxury brands versus free trade

The online auction retailer eBay has once again locked horns with manufacturers of luxury goods, specifically in the form of Louis Vuitton. Louis Vuitton has for several years waged law suits against eBay, in various EU countries, arguing that the sale of its luxury goods on the eBay site has a detrimental impact on the exclusive nature of the goods and as such should be prohibited. In reply, eBay has forcefully argued that such a control on the distribution of the goods is contrary to the principles of free competition and is anticompetitive.

In the latest decision handed down by the French courts, the ruling has gone in favour of Louis Vuitton. It has enabled Louis Vuitton to prevent the sale of its genuine goods on the eBay site and has also extended to enabling the company to stop the sale of counterfeit items. However, this cannot be taken as the final position for the sale of luxury items, because, in contrast to the French decision, the UK courts dismissed a corresponding claim made by L'Oreal. The UK decision did, however, hold eBay liable for the sale of fake fragrances and cosmetics.

eBay has indicated that it will file an appeal against the French decision on the basis that it constitutes an unfair restriction of trade to allow such a limitation on the sale of genuine goods and counterfeit goods. It can be expected that eBay will continue to defend its ability to sell as broad a range of goods as possible.

This is clearly a difficult path for the courts to tread, as an attempt is made to preserve the integrity of brand owners on the one hand but also to enable free trade and fair competition on the other.

Rosalyn Newsome

CASE LAW

Clarification as to the patentability of surgical methods

The much anticipated decision G1/07 of the Enlarged Board of Appeal (EBA) of the European Patent Office has issued, which provides guidance as to how the exclusion from patentability of treatment by surgery should be interpreted under European law. Regrettably, the EBA has chosen to provide answers to the referred questions that are

fairly specific to the case under consideration, rather than a set of definitive rules for all cases. However, in the reasoning behind the decision some useful pointers have still been provided.

The EBA noted that the exclusion was not just for surgery that had a therapeutic purpose; this would not reflect the purpose of the exclusion, which was to free the medical profession from being hampered by patents. Non-therapeutic surgery such as cosmetic surgery and sterilisation still required considerable medical expertise due to the serious nature of the physical intervention and practitioners should be free to carry out such work.

However, a definition of surgery as any non-insignificant physical intervention was broader than required to achieve the purpose of the exclusion. Procedures such as hair removal by optical radiation and microdermabrasion were routinely carried out in cosmetic salons. Equally, safe and routine procedures for obtaining diagnostic data, potentially by an invasive step such as injection, did not require exclusion from patentability, when considering the public health interest.

The EBA therefore indicated that the exclusion should cover interventions that are the core of the medical profession's activities, for which its members are specifically trained. Interventions of the kind that involve a health risk, even when carried out with professional care and expertise, should be excluded, whereas those that are "uncritical", involving minor intervention and not normally presenting any significant health risk, should be open to patentability. When the intervention involves administration of a potentially risky substance, there would be an exclusion from patentability only where a health risk is associated with the actual method of administration.

It was stressed that the technical reality of the method must be assessed on a case by case basis to decide whether the exclusion applies. The specific case in question involved the injection of a contrast agent into the heart, and the EBA found that "A claimed imaging method in which, when carried out, maintaining the life and health of the subject is important and which comprises or encompasses an invasive step representing a substantial physical intervention on the body which requires professional medical expertise to be carried out and which entails a substantial health risk even when carried out with the required professional care and expertise, is excluded from patentability...".

It was indicated that a claimed method does not escape the exclusion by the inclusion of additional, non-surgical, steps. However, the use of a disclaimer to the excluded subject matter is possible, provided the established rules on disclaimers are met. Equally, an amendment could be made to remove the excluded matter, subject to the relevant requirements being met, such as basis for the amendment and the claim not becoming so broad that its scope is not supported or lacks clarity due to not setting out the essential features of the invention.

Yvonne Johnson

Designs rejected for being solely dictated by technical function

Two Board of Appeal decisions at the Community Registered Design Office (OHIM) have clarified European Union law relating to designs with a technical function. Article 8(1) of the Community Designs Regulation requires that a registered Community design (RCD) cannot subsist in features of appearance of a product that are solely dictated by its technical function.

RCD No. 253778-0001 was the first ever RCD to be declared invalid due to being solely dictated by the technical function of the product in which it was incorporated; subsequently the Board found RCD No. 273644-0001 invalid for the same reason. The designs related to a chaff cutter and a bag for packaging foodstuffs respectively, as shown below.



The Board of Appeal considered the previous legal views on the exclusion and decided that the multiplicity-of-forms approach, which suggests the exclusion applies only if the technical function could not be achieved by any other configuration, was flawed. This approach would mean that if a purely technical solution could be achieved by two alternative methods then theoretically both solutions could be the subject of a design registration. This would have the consequence that no-one else would be able to manufacture a competing product capable of performing the same technical function. This would be akin to patent protection.

The Board therefore decided that the wording of the law and a purposive approach to its interpretation favoured the conclusion reached in the 1971 UK case Amp v Utilux. Under this approach, the exclusion denies protection to those features of a product's appearance that were chosen exclusively for the purpose of designing a product that performs its function, as opposed to features that were chosen, at least to some degree, for the purpose of enhancing the product's visual appearance.

It was clarified that it is not necessary to determine what actually went on in the designer's mind, but rather an objective assessment by a reasonable observer should be used to ask whether anything other than purely functional considerations could have been relevant when a given feature was designed. Further, the fact that a feature is denied protection under the exclusion does not mean that the design must be declared invalid. The design as a whole will be invalid only if all the essential features of the appearance of the product in question were solely dictated by its technical function.

However, for the chaff cutter it was ultimately decided that "every essential feature of the design has been chosen with a view to achieving the best possible technical performance" whilst for the bag "the essential features...have been chosen with a view to designing a product that performs its function. None of those features has been chosen for the purpose of enhancing the product's visual appearance."

Ironically, the UK courts have now adopted the multiplicity-of-forms approach. On the other hand, the French courts have abandoned it in favour of the Amp v Utilux concept. **Carl Yelland**

Extent of use required for a Community trade mark to establish a reputation

The case of PAGO International GmbH v Tirolmilch Registrierte GmbH discussed what constitutes "reputation" within the European Union (EU) in respect of a Community

trade mark (CTM). Owners of CTMs with a reputation in the EU can stop third parties taking unfair advantage of that reputation, or causing detriment to it.

PAGO owned a CTM for a green glass bottle device, which was used in relation to a fruit juice widely known in Austria. Tirolmilch started packaging its own drink in glass bottles which resembled the PAGO registration. PAGO brought an infringement action against Tirolmilch in Austria and sought an injunction throughout the EU, on the basis of its CTM registration and the reputation enjoyed by its mark in Austria.

The Austrian Supreme Court decided that for correct application of the EU law in this case it required guidance from the European Court of Justice (ECJ). It therefore asked the ECJ to clarify whether, if a mark has a reputation in only one country of the EU, this is sufficient to be deemed a reputation throughout the EU.

The ECJ concluded that if a CTM has a reputation in a substantial part of the EU, then it must be deemed as having a reputation in the whole EU. The ECJ ruled that in this case Austria did constitute a substantial part of the EU. Therefore, as PAGO's CTM was well known within Austria, this was enough for the CTM to be deemed to have the required reputation in the EU.

The determination of reputation in a substantial part of the EU did not require at least a certain percentage of the EU public being aware of the reputation. The extent of the reputation could be assessed by taking into account any relevant factors, but in particular "the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it". However, it is unclear from the decision on exactly what basis Austria was regarded to be a substantial part of the EU.

This decision is good news for owners of CTMs who only have a reputation in their trade mark in one EU country. However, depending upon the criteria applied and the circumstances, smaller EU countries might not be deemed to be a substantial part of the EU.

Julia House and Rosanne Jenkins

Patent attorneys become part of the skilled team

In a recent UK Court of Appeal decision, the subject of the litigation between Virgin Atlantic Airways Ltd and Premium Aircraft Interiors Ltd was Virgin's Upper Class airline seat. These seats are able to flip over so that the back of the seat forms a flat bed. In the UK High Court, Virgin's patent had been found to be valid but not infringed by Premium's seat, which did not flip over. However, this decision was partly overturned by the Court of Appeal, which found that the patent was valid and infringed.

Virgin argued that the invention protected by its patent was not specifically related to the flip over nature of the seat, but instead to the feature that the seat extended into a particular space created by a herringbone pattern in the plane. This feature was found to be present in Premium's seat.

This case brought up several points on how the patent scope should be interpreted by the notional "skilled man" or "skilled team". In particular, the decision strongly indicated that the skilled team would not just be interpreting the technical content of the patent as a published document but would also be aware of the nuances of both patent drafting conventions and patent prosecution.

The UK Court of Appeal decided that a skilled team would obtain advice from a patent attorney when reviewing a patent. Therefore the skilled team would be aware of the practice of filing divisional patent applications and the resultant split in coverage of the subject matter. This meant that the interpretation of the patent could be influenced by the awareness that certain aspects of the subject matter mentioned in the patent were specifically protected in different patents within the chain of parent and divisional applications.

The question of how a skilled team would be influenced by the use of a two-part claim form was also discussed. A two-part claim has all the features that are part of the prior art defined first, followed by the new feature or combination of features in the second, characterising, portion of the claim. It was decided that the skilled team would be aware of this convention and would be strongly influenced by this when it interpreted the patent. Equally, the inclusion of reference numerals would not influence the skilled team when determining the breadth of protection; such numerals are not intended under European practice to be limiting.

Ben Lincoln

Is use of a trade mark in one country sufficient to establish genuine use?

The Benelux Office for Intellectual Property (BOIP) has recently ruled that use of a Community trade mark (CTM) in a single country of the European Union (EU) is insufficient to constitute "genuine use" of a trade mark within the EU. Under EU law, a CTM can be revoked on the basis of non use if within a five year period the proprietor has not put the CTM to genuine use.

Hagelkruis Beheer B.V. applied to register a CTM for the trade mark OMEL. Leno Merken B.V., the proprietor of an earlier CTM for the trade mark ONEL, filed an opposition to the OMEL application and in support of its opposition was requested to file evidence of genuine use of the mark in the EU. Leno had only used its trade mark in the Netherlands. The BOIP held that as the EU covers 27 countries, and is likely to expand even further, use in one country did not justify retaining the broad protection provided by a CTM. Therefore the opposition was rejected and the OMEL mark was allowed on the register.

This ruling has been widely criticised as being contrary to the founding principles of the CTM and the aims of developing business in a single market. The Community Trade Mark Office (OHIM) has also issued a press release reaffirming its view that use of a trade mark in a single EU country can be sufficient to constitute genuine use throughout the EU.

The decision of the BOIP has been appealed and therefore it remains to be seen whether the higher level authorities choose to follow this controversial decision.

In the meantime, in light of this decision, trade mark owners will need to carefully consider where their CTM is being used and, wherever possible, should ensure it is used as widely as possible within the EU. Otherwise, they might not be able to rely on it in order to take action against conflicting marks.

Julia House and Rosanne Jenkins

Contributory infringement of patent rights

The UK High Court judgement in the case of Boegli-Gravures SA v Darsail-ASP Ltd has given further guidance as to what constitutes contributory infringement. Under the UK Patents Act a patent is infringed if a person "supplies or offers to supply in the United Kingdom a person other than a licensee or other person entitled to work the invention with any of the means, relating to an essential element of the invention, for putting the invention into effect when he knows, or it is obvious to a reasonable person in the