



瀚恒

HANNA
MOORE +
CURLEY

欧洲专利商标律师事务所

Newsletter- Summer 2020

Warm wishes to you for the Dragon Boat Festival

1. **Brexit Update- Strategies for EU Trade Marks and EU Designs**
2. **How are the new Rules of Procedure at the Boards of Appeal at the EPO impacting practice at the EPO Boards of Appeal?**
3. **EPO Board of Appeal in decision T 844/18 confirms the earlier decision of Opposition Division to revoke patent EP 2771468 on CRISPR gene editing technology.**
4. **AI and Virtual Reality – What is patentable at EPO?**
5. **Question of double patenting to be considered by the EPO enlarged board of appeal.**

1. Brexit Update- Strategies for EU Trade Marks and EU Designs

The UK has left the European Union (EU) in the process referred to as “Brexit” as of 31st January 2020. Since 31st January 2020, the UK is no longer a member state of the EU. However, there are still many aspects of trade that must still be discussed between the UK and the EU. According to the Withdrawal Agreement between the UK and the EU, there is a transition period up to 31 December 2020, while EU law will continue to apply in the UK. However, from January 1st 2021, EU law will no longer apply in the UK.



It is important for EU trade mark and EU design rights owners to ensure they are up to date on what will happen to IP rights in the UK because of the transition period ending on 31st December 2020, and what will happen from 1st January 2021.

At Hanna Moore + Curley, we focus on IP strategies for our clients, and therefore, we wish to provide the following information as to what will happen after the end of the transition period on 31st December 2020 for IP rights, so that there is certainty for planning IP strategy with our clients:

Patents

- European patents are granted under the European Patent Convention (EPC). Brexit has no impact on European patents because the EPC is not an EU treaty. Therefore, even after Brexit, the UK will remain a member of the EPC and the same system will operate at the EPO.
- The PCT system and UK national patents (either filed directly at the UK Intellectual Property Office or as regional patent applications from the EPC) are also NOT affected by Brexit. The Unitary patent system is delayed because of a legal challenge in Germany and a decision from the German Court is expected during 2020.
- The UK Government has indicated that it is committed to the following processes to protect EU IP rights in the UK in the transition period: <https://www.gov.uk/government/news/intellectual-property-and-the-transition-period>

For owners of existing registered EUTM and RCD right:

The UK government has confirmed that the rights in all existing registered EU trade marks and registered EU designs will continue to be protected in the UK after Brexit, and to be enforceable in the UK, by granting an equivalent registered trade mark or registered design in the UK; and that this process will be carried out automatically by the UKIPO, and will involve “minimal administrative burden” for rights owners, except of course, that rights owners will need to ensure that they set up a system for paying the UKIPO renewal fees, as well as the EUIPO renewal fees for the parallel EU and UK registrations. The trade mark or design rights granted by the UKIPO will be treated the same as if the rights had been applied for and registered under UK law. This means that there will be “equivalent” UK registered trade marks and designs which, after Brexit, will exist in parallel to the registered EU trade marks and designs respectively.

These “equivalent” UK trade marks and designs registrations:

- will be subject to payment of renewal fees to the UK Intellectual Property Office (UKIPO);
- can form the basis for proceedings before the UK Courts and the UKIPO’s Tribunal; and
- can be assigned and licensed independently from the corresponding EU rights.

For Applicants whose EUTM or RCD is pending at the end of the transition period of 31st December 2020: From 1st January 2021, businesses, organisations and individuals having EU trade mark and EU design applications which are pending, will have to re-file their applications with the UK Intellectual Property Office (UKIPO) using the UK application process for registering trade marks and designs in the UK.

For Applicants seeking EU and UK Rights after end of the Brexit transition period:

From 1st January 2021, separate applications will be required for the UK and EU territories. Our recommendation is that from now on, clients intending to file EUTMs, with important interests in the UK, should file both UKTMs and EUTMs in parallel. Similarly, clients intending to file registered community designs (RCDs) should consider parallel RCD and UK registered design filings.

2. How are the new Rules of Procedure at the Boards of Appeal at the EPO impacting practice at the EPO Boards of Appeal?

[T1687/17](#) is one of the first cases that has been heard before the EPO Board of Appeal and gives us an example of the new format of an abridged decision under the new [Rules of Procedure of the Boards of Appeal \(RPBA\)](#). The abridged decision in [T1687/17](#) is very short and was published only a week after the Oral Proceedings were held, thereby also being issued very soon after the Oral Proceedings, and thereby complying with the requirement to be “timely” in accordance with Art. 15(9) RPBA. The RPBA contains new provisions allowing the Boards to issue written decisions in abridged form, either with the consent of the parties for decisions given at oral proceedings or, if the decision of the Board of Appeal agrees with the decision appealed against, without needing the consent of the parties.

New Art 15(9) RPBA also introduces the requirement for decisions to be issued “in a timely manner”. In the past, decisions of the Boards of Appeal could sometimes take months to be issued in writing following oral proceedings, so it is good to have an early example of just how quickly decisions might be issued with the abridged format.

The decision notes that the parties confirmed at the hearing that no new arguments were raised during the appeal proceedings – providing a clear reasoning for the abridged form of the decision. The reasoning of the Board merely refers to passages from the first instance decision, and even the minutes of the decision are rather short, referring again to the facts put forward in the appealed decision.

Parties to appeal, especially appellants, should take note that the Boards of Appeal are ready to use the new RPBA to provide speedy decisions on appeals and will not hesitate to prevent repetitive arguments being made by representatives. In this particular case, the Board made use of Art. 15(8) RPBA, thereby not needing explicit consent of the parties to deliver an abbreviated (abridged) decision.

Nevertheless, in case the Board of Appeal seeks the consent of parties (Art. 15(7) RPBA) to make an abridged decision, then the patent attorney must have a legitimate reason ready to argue why the Board should not deliver an abridged decision. Also, for Third Parties who may be watching for the decision, a legitimate reason can be indicated, to try and force an unabridged decision on an appeal case, although it is not clear at what stage such indication should be filed by Third Parties to avoid an abridged version of the decision being issued.

This decision sends out the message from the EPO that the purpose of an EPO appeal is not to have a second chance at arguing the same case. Appellants must show why the first instance decision was wrong; this is not the same argument as why the patent is still valid or invalid according to the appellant. Even after hearing arguments at oral proceedings, the Board in T1687/17 still found that there was no new position taken by the parties, compared to the first instance procedure, and therefore dismissed the appeal.

3. EPO Board of Appeal in decision T 844/18 confirms the earlier decision of Opposition Division to revoke patent EP 2771468 on CRISPR gene editing technology



The EPO issued a [statement](#) on 17th January 2020 confirming that the Patentees' appeal was dismissed, and confirming the revocation of CRISPR patent No. EP2771468. The EPO also confirmed that no questions were referred to the Enlarged Board of Appeal.

This case was decided on a legal point to do with priority date and entitlement to a validly claimed priority date and therefore, is relevant across all technologies.

Background:

By way of general background to the facts of this case, [CRISPR](#) is a type of gene-editing technology that enables a "cutting" and "pasting" of genes into DNA and can therefore provide the ability to change the DNA of an organism. This case did not rely however on the fundamentals of the technology but, rather, on the fundamentals of determination of priority rights as defined by the EPO.

The EPO opposition division had revoked the patent for lack of novelty in view of intermediate prior art. This prior art became relevant because the opposition division did not consider as valid, the patentee's claim to priority from a US provisional application naming more applicants than the subsequent PCT application, from which EP 2771468 was derived. Since the applicant omitted from the PCT application had not transferred his rights to the applicants of the PCT application, the priority claim was considered invalid by the EPO.

As detailed by the Board, the facts to be determined were as follows:

“A and B are applicants for the priority application. A alone is the applicant of the subsequent application. Is this priority claim valid even without any assignment of priority right from B to A? The appellants say that the answer is ‘yes’ and the respondents that the answer is ‘no’”.

The importance of the technology raised the profile of the case but fundamentally, the Decision of the Board of Appeal has followed current EPO case law and practice in what is referred to as the “all applicants approach” whereby every applicant for a priority application, or their successor in title, must be named as an applicant for the priority claiming application.

The Board of Appeal confirmed that the EPO Opposition Division (OD) was correct in deciding that the claim to priority date of CRISPR patent [EP2771468](#) was invalid and therefore the claimed subject matter lacks novelty over documents published during the time between the priority date in question and the filing

date of the PCT application. Accordingly, the Patentees' appeal was dismissed by the Board of Appeal and the Opposition Division's decision to revoke the patent has become final.

European practice point and advice:

European practice on this point therefore remains the same. All applicants for a priority application or their successor(s) in title should be named on the priority claiming application at the date of filing.

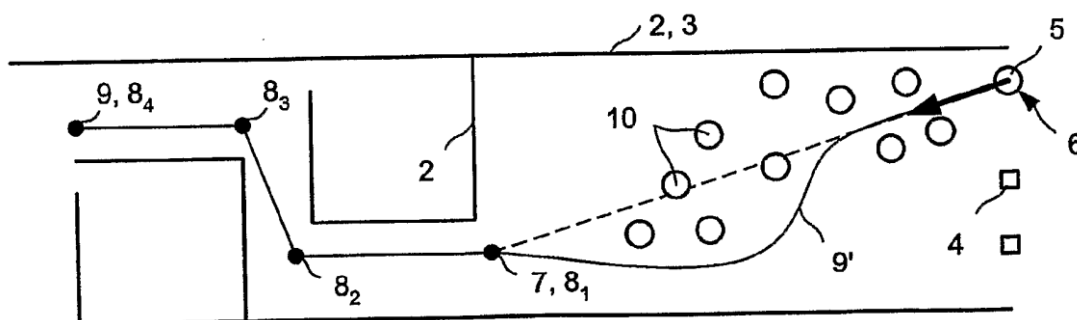
4. AI and Virtual Reality – What is patentable at EPO?

We have previously discussed the case referred to the [Enlarged Board of Appeal as G1/19](#).

Since the referral to the Enlarged Board of Appeal, a number of European patent applications relating to computer-implemented inventions have had the examination stayed, waiting for the decision from the EPO Enlarged Board of Appeal.

The referral to the Board of Appeal in G1/19 is still awaiting hearing before the EPO Enlarged Board of Appeal.

The case is concerned with an application for simulating movement of an autonomous entity, a human, through an environment, with a view to better understanding a proposed building design and determining how the design might be improved to better serve its function. So, referring to the figure below, a designer creates an architectural venue design (2,3), specifies the constituents of a pedestrian population (5,10) that is typical for the venue being designed, and performs a number of simulations of pedestrian flows (6-9). The simulation results are then examined and the design is revised if necessary.



During examination of the application, the Examining Division had objected that the invention as claimed was purely abstract or lacked inventive step in the light of other such simulation software.

At the Oral Proceedings with the EPO Examining Division, the Examining Division refused the application on the grounds of being non-technical subject matter, and this decision to refuse the application was appealed by the Applicant.

In assessing the Appeal, the Board noted a decision particularly favoured by patent practitioners in this field, [T 1227/05](#) (Infineon). Notably, the Board in the Infineon case, in setting aside the original decision to refuse the application, referred to a still further IBM decision [T 453/91](#) where a Board of Appeal had insisted on the addition of a step of "materially producing the chip so designed" to a claimed method for designing a chip. The Board in the Infineon case did not require the applicant to do so, a decision which the Board in the case in question regarded as involving a conflict sufficient to merit a reference to the EPO Enlarged Board of Appeal to determine the correct application of the European Patent Convention in these cases.

While the reference appears to involve 3 questions, the second question, in fact, divides into two questions, and the questions can be broken down as follows:

1. Can the computer-implemented simulation of a technical system or process solve a technical problem by producing a technical effect which goes beyond the simulation's implementation on a computer, if the computer-implemented simulation is claimed as such?
2. **A.** If the answer to the first question is yes, what are the relevant criteria for assessing whether a computer-implemented simulation claimed as such solves a technical problem?
B. Is it a sufficient condition that the simulation is based, at least in part, on technical principles underlying the simulated system or process?
3. Do these answers change, if the computer-implemented simulation is claimed as part of a design process, in particular for verifying a design?

[EPO case law](#) and the updated [EPO Guidelines for Examiners](#) provide excellent guidance in relation to questions 1 and 2A, and are relatively straightforward.

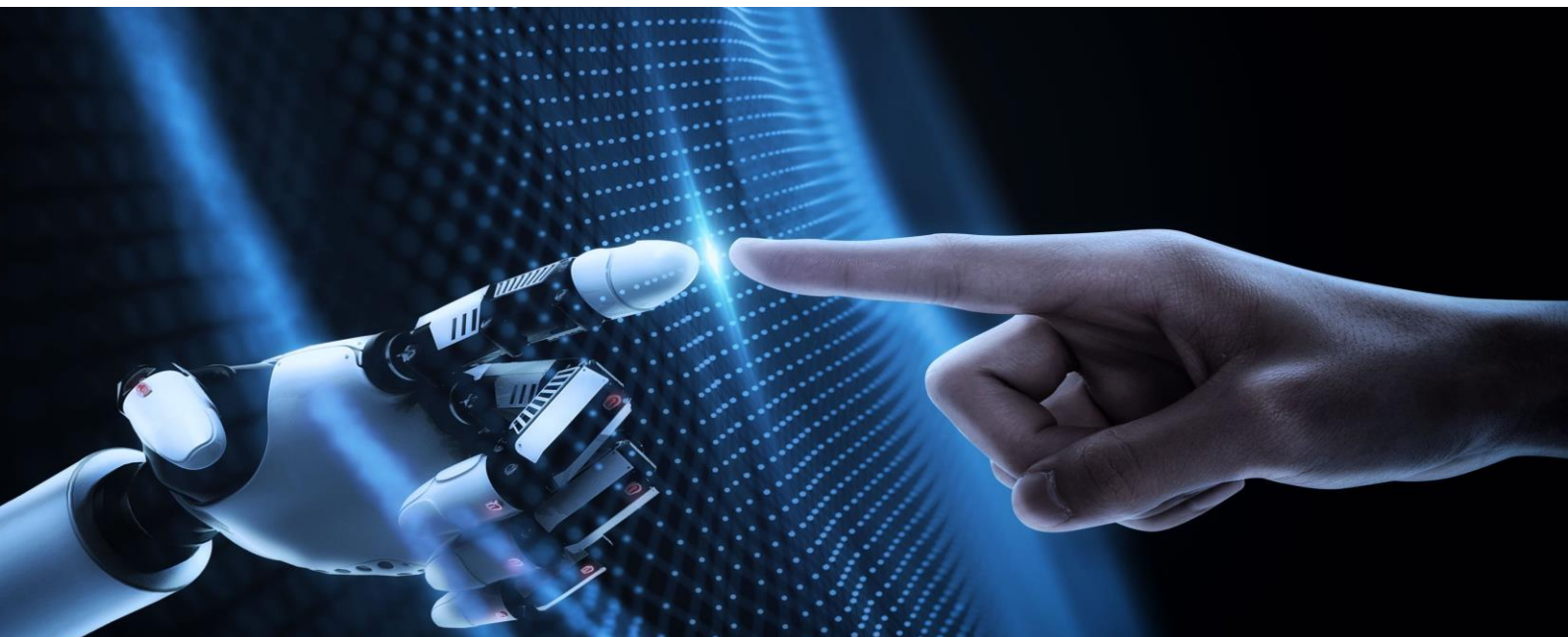
On the other hand, opinion differs as to whether the answer to question 2B could be “Yes” or should be “Possibly”, with knock-on implications for the answer then to Question 3. A “Yes” answer to question 2B could lead to the ability to cover simulation software processing data corresponding to a digital representation of a real-world object, but without necessarily requiring the software to control a real-world object. This, in turn, could lead to the EPO granting patents which are applicable solely to a virtual environment.

Some would argue that this will further encourage the developments made in this technological field, regarding it as rewarding inventive activity regardless of where it manifests itself- real or virtual worlds. It appears to us that the EPO is likely to broaden the protection for computer software at the EPO despite the prevention of patents being granted for computer programmes as *per* the wording of the European Patent Convention Article 52(2)(c)

We, at Hanna Moore + Curley are contributing, through the European Patent Institute (EPI), to the preparation of an *amicus curiae* brief on behalf of the patent profession in Europe to assist the Enlarged Board of Appeal of the EPO in coming to a decision which ensures that the patentability of genuine inventions being made in this technological field are not denied access to protection through the patent system. Our firm has been actively involved in preparing the EPI Amicus Curiae Brief which will be taken into account by the Enlarged Board before they prepare their decision.

Following the filing of the EPI brief, the EPO President also filed comments which agree with the EPI Brief and which refer to a Google case T817/16 which again involved a similar criterion for whether features in a Computer Implemented Invention (CII) claim could be regarded as technical or not.

This referral, as well as the potential upcoming changes in the EPO Guidelines for Examination, which will come into force from November 2020, are tending to increasingly open the door to the patentability of CII before the EPO.



5. Question of double patenting to be considered by the EPO enlarged board of appeal

In the case T 318/14, the Board of Appeal decided, at oral proceedings in February 2019, to refer questions concerning double patenting to the Enlarged Board of Appeal. The [written decision in the case T 318/14](#) issued on 20 December 2019, and discusses the background and issues in detail.

The leading Enlarged Board of Appeal decisions relating to double patenting are [G1/05](#) and [G1/06](#), in which issues relating to double patenting in the context of the filing of a divisional application were considered. In these cases the Enlarged Board accepted the *principle of the prohibition on double patenting*. The principle of the prohibition of double patenting is based on the idea that the applicant has no legitimate interest in proceedings that give rise to the **grant** of a second patent in respect of the same subject-matter for which he already holds a patent. There is therefore nothing objectionable in the established EPO practice that amendments to divisional applications are objected to and refused, when the same subject-matter is claimed in the amended divisional application as in a pending parent application, or a granted parent patent. It was concluded that this principle could not be applied with a view to preventing the **filing** of identical applications, because that would infringe the prevailing principle that an assessment of the EPC requirements is made on the basis of the final version of the application put forward. (**G 1/05** and **G 1/06**).

In the appeal case **T 318/14** the applicant appealed the decision to refuse [European Patent Application EP10718590](#). The questions considered by the Board of Appeal related to double patenting arising from internal priority NOT from the filing of a divisional application. The application at issue claims priority from an earlier European Patent Application which had already been granted and has identical scope. The examining division, in refusing the application, *found that claim 1 of the sole claim request on file was directed to subject-matter which was "100% identical" to the subject-matter claimed in European patent No2251021 the priority document of the present application. This was held to be contrary to the principle of the prohibition on double patenting referred to in decisions G1/05 and G1/06*. However, the appeal from the decision of the examining division to refuse the application is motivated by the basis that a longer term of protection would be available with the later filing, in view of the fact that the filing date and not the priority date was the relevant date for calculating the 20-year term of the patent

Decisions **G1/05** and **G1/06** were made in the context of divisional applications, and there has been divergence in opinion on the issues of double patenting in past decisions. In **T 1423/07** the Board of Appeal held that double patenting was **not prohibited** for European applications claiming a European priority because of the applicant's clear legitimate interest in the longer term of protection. However, in **T 2461/10**, the Board of Appeal noted that double patenting could arise in three scenarios: (i) two applications filed by the same applicant on the same day; (ii) parent and divisional application; and (iii) a European priority application and a subsequent European application claiming this priority. The Board of Appeal in that case was of the opinion, from the *travaux préparatoires* to the EPC 1973, that prohibition of double patenting applied to all three scenarios. It also highlighted that **G 1/05** and **G 1/06** had referred to a **legitimate** interest. With reference to the *travaux préparatoires* the Board expressed doubt that the interest identified in **T 1423/07** could be considered legitimate. However, in that case the question was left open, as the claimed subject matter was not identical with that of the granted priority application.

In the case T 318/14, the Board of Appeal has referred the following questions to the Enlarged Board of Appeal:

1. Can a European patent application be refused under Article 97(2) EPC if it claims the same subject-matter as a European patent which was granted to the same applicant and does not form part of the state of the art pursuant to Article 54(2) and (3) EPC?

2.1 If the answer to the first question is yes, what are the conditions for such a refusal, and are different conditions to be applied depending on whether the European patent application under examination was filed

- a) on the same date as, or
- b) as a European divisional application (Article 76(1) EPC) in respect of, or
- c) claiming the priority (Article 88 EPC) in respect of a European patent application on the basis of which a European patent was granted to the same applicant?

2.2 In particular, in the last of these cases, does an applicant have a legitimate interest in the grant of a patent on the (subsequent) European patent application in view of the fact that the filing date and not the priority date is the relevant date for calculating the term of the European patent under Article 63(1) EPC?

The referred questions consider the issue of internal priority for which the applicant had argued that there is a legitimate interest in a longer term of protection resulting from the later filing date of the application claiming priority. In addition, the questions also cover parent and divisional applications (considered in G 1/05 and G 1/06), and parallel applications filed by the same applicant on the same date.

Now that the written decision in case **T 318/14** has issued the Referral to the Enlarged Board of Appeal can proceed.

It is noted that, where a referral to the Enlarged Board of Appeal is pending, and the outcome of examination or opposition proceedings depends entirely on the answer to the questions referred to the Enlarged Board of Appeal, **the proceedings may be stayed by the examining or opposition division on its own initiative or on request of a party or the parties.**

News from Hanna Moore + Curly

Recognised in the 2020 **Financial Times** list of top IP firms in Europe:

We are honoured to be listed in the 2020 **Financial Times** listing of Top IP firms in Europe. This listing of Europe's leading patent law firms is based on recommendations by clients and peers, as compiled by the FT's research partner, Statista. Thank you to all our clients and associates who recommended us for this honour.

In the meantime, we are still working from home due to Government restrictions to fight against the spread of Covid-19. Our IT system is supporting us well and we have adapted to the new norm of working from home. It is expected that we will be returning to our office by end of August or early September depending on how the containment of the disease is progressing.

We wish you all good health and well-being as we all look forward with resilience and know that we are strong together.



The information in this Newsletter is for general guidance only and does not constitute legal advice. Please contact Marie WALSH and Yan GUO on China@hmc-ip.com if you have any questions on aspects of International IP strategy, in particular, relating to the EPO or UKIPO.