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## Newsletter- Spring 2021

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**Wish you good health and a happy, healthy, joyful and  
prosperous year of the Ox**

- 1 . BREXIT AND TRADEMARKS: ENSURING CONTINUED PROTECTION in the United Kingdom
- 2 . STATUS UPDATE ON UNITARY PATENT AND UNIFIED PATENT COURT (UPC)
- 3 . COMPUTER IMPLEMENTED INVENTIONS (CII) AND PATENTS – COMPARISON OF EPO AND CNIPA
- 4 . BOARDS OF APPEAL ARE COMPETENT TO OVERTURN A FINDING OF FACT AT FIRST INSTANCE (T 1604/16)

## 1. Brexit and Trademarks: Ensuring Continued Protection in the United Kingdom

[本文中文翻译点击这里](#)

The United Kingdom has left the European Union (EU) and the legal transition period ended on December 31st 2020. Therefore, from 1 January 2021, EU law no longer applies to the United Kingdom (UK). This has brought huge changes to trademark law in the United Kingdom and European Union that are relevant to all owners of UK and EU trademarks.

Since 31 December 2020, European Union trademarks (EUTMs) no longer provide protection in the United Kingdom. There following is a summary of the current status:

### REGISTERED EUTMS

On 1<sup>st</sup> January 2021, the UKIPO has automatically created a “comparable” (so-called “cloned”) United Kingdom trademark (UKTM) for every *registered* EUTM. Comparable UKTMs will

- be recorded on the UKIPO register;
- keep the original EUTM filing, priority, and seniority date(s); and
- be fully independent rights that can be challenged, assigned, licensed, and renewed separately from the original EUTM.

Owners of EUTMs will **not** need to apply for a comparable UKTM; and will **not** receive a UK registration certificate (The comparable UKTM can be viewed in the UKIPO online register but no registration certificates will be issued by the UKIPO for comparable rights).

Where the original right is an EU designation of an International Registration (IR), the comparable UKTM will be a national UKTM and will not be a UK designation of the IR. This means that a renewal fee **MUST** be paid to the UKIPO for the national UK trade mark.

The registration number of the comparable UKTM will be the last eight digits of the original EUTM registration number with the prefix UK009 (where the original right is a EUTM) or UK008 (where the original right is an EU designation of an IR).

### PENDING EUTMS

Where an EUTM application is still pending on 1 January 2021, owners will have until **30 September 2021** to *apply* to register a comparable UKTM.



The comparable UKTM will also retain the renewal date of the original EUTM; however, a separate renewal fee will need to be paid to the UKIPO where it falls due from 1 January 2021 (even if the original EUTM was renewed at the EUIPO prior to 31 December 2020). Where the comparable UKTM is derived from an EU designation of an IR, it will no longer be part of the World Intellectual Property Organization (WIPO) system and renewals must be paid to the UKIPO.

The application will

- retain the filing, priority, and seniority date(s) of the pending EUTM application; and
- be subject to the usual UKIPO application fees (there will therefore be a duplication of application costs at the European Union Intellectual Property Office (EUIPO) and UKIPO).

The application must

- relate to the same trademark as the pending EUTM application; and
- seek protection in respect of goods and/or services identical to, or contained within, the pending EUTM application. If the goods and/or services differ, the application will be given a new filing date and could lose priority over a later-filed UKTM.

#### **PENDING CANCELLATION ACTIONS AT THE EUIPO**

Where an EUTM was subject to ongoing cancellation proceedings (revocation or invalidity) at the end of the transition period on 31 December 2020 and is subsequently cancelled, the outcome shall be applied to the corresponding comparable UKTM.

This means that where an EUTM is subject to cancellation proceedings at the end of the transition period and is subsequently cancelled, whether wholly or partially, the UK comparable trademark will also be cancelled to the same extent—without the need to bring a new cancellation action before the UKIPO. However, if the grounds for cancelling the EUTM do not apply in the United Kingdom, the owner of the comparable UKTM may file a request at the UKIPO requesting that the comparable UKTM not be cancelled.

#### **RECOMMENDATIONS FOR TRADEMARK OWNERS**

**In our opinion, the following actions are highly advisable as part of your strategy for Europe following the end of the post -Brexit transition period:**

##### *Review Portfolio*

- Consider if there is any requirement for the comparable UKTM: owners may opt out of the comparable UKTM.
- Filing of parallel applications in the European Union and United Kingdom will be required in the future, if protection is needed in the UK as well as in the EU-27 countries.
- Ensure genuine use of trademarks: use of the trade mark in the UK will no longer be sufficient to support EUTMs.

##### *Assignments*

- Assignments of EUTMs that are effective on 1 January 2021 will also apply to the comparable UKTMs, even if an assignment has not yet been recorded at the EUIPO.

- If the assignment has not been recorded at the EUIPO, the comparable UKTM will be granted to the assignor.

#### *Licences*

- Licences in the original EUTM that authorise acts in the United Kingdom will be treated as if they apply to the comparable UKTM and should be recorded at the UKIPO.
- Licensors should notify any licensees of the new comparable UKTM and ensure the comparable UKTM does not breach any existing agreements.

**UK Address for service:** We have offices in the UK, in the EU and in China and we are ready to help.

## 2. Status update on Unitary Patent and Unified Patent Court (UPC)

[本文中文翻译请点击这里](#)



Following a long, delayed process with delays caused by Brexit and also by the Constitutional Challenge in Germany which was decided during 2020, the next step in order for the Unitary Patent and the Unified Patent Court (UPC) to come into force, is that the Unitary Patent Court Agreement must be re-ratified by Germany.

The completion of the German ratification procedure would mean a very important step would be taken for entry into force of the Unitary Patent system.

The status of the re-ratification process is that the German Bundesrat (i.e. the constitutional body that is part of the legislative process) approved the Unitary Patent Court Agreement and its Protocol on Provisional Application (PPA) on December 18 2020, three weeks after the Unified Patent Court Agreement received approval in the German Parliament (“the German Bundestag”). To complete the German ratification procedure, the legislation will have to be signed by the government and President and published in the Federal Law Gazette.

However, two new constitutional complaints against ratification of the Unified Patent Court Agreement have been filed with Germany’s Federal Constitutional Court. As a result of these constitutional challenges, the German ratification of the Unified Patent Court Agreement has been put on hold at the request of the German Federal Constitutional Court due to the constitutional complaints that have been filed

According to several media reports, the constitutional complaints were filed on Friday, December 18<sup>th</sup> 2020, the same day that the parliamentary ratification procedure in Germany resulted in the approval of the UPC legislation by the German Bundesrat, as I described above.

Neither the identity of the plaintiffs nor the grounds of the complaints are currently available. The constitutional complaints mean a new cause of a further delay in the long history of the attempt to establish a Unified Patent Court and Unitary Patent system in Europe.

Without ratification of the Unitary Patent Agreement by Germany, the UPC and the Unitary Patent cannot commence. The new complaints are likely to lead to further severe delays.

If these constitutional complaints are overcome, two more countries as well as Germany will have to ratify (or otherwise consent to) the PPA for the provisional application phase to come into force. Now, the expected time line of the provisional application phase starting in 2021 and the UPC potentially starting in late 2021 or at the start over 2022, is once again put into question.

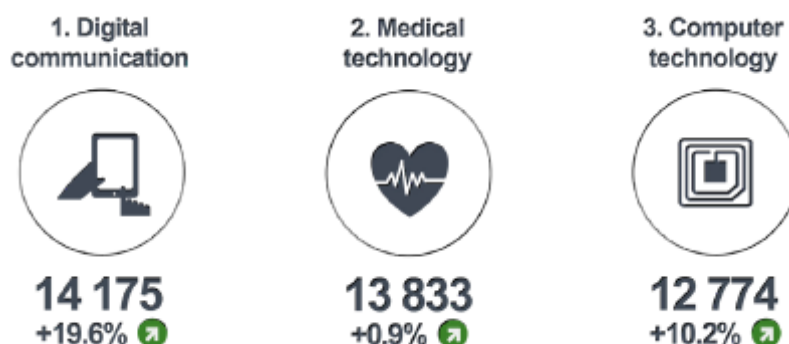
The Unitary Patent system is put into serious doubt as to when the system will come into force. These new constitutional challenges are likely to push out the start date by at least 2 years, in my opinion, due to the time needed to hear the constitutional challenges and the associated delays in waiting for a decision from the Court. Furthermore, in the meantime, the UK will already have left the EU by then since about 2 years. During that time, there are likely to have been many political changes in the EU and some of these will also impact on the push for the Unitary Patent system to start. At present, in the opinion of this author, it is difficult to see that the Unitary Patent system would start even within the next 5 years.

### 3 . Computer Implemented Inventions (CII) and Patents – Comparison of EPO and CNIPA

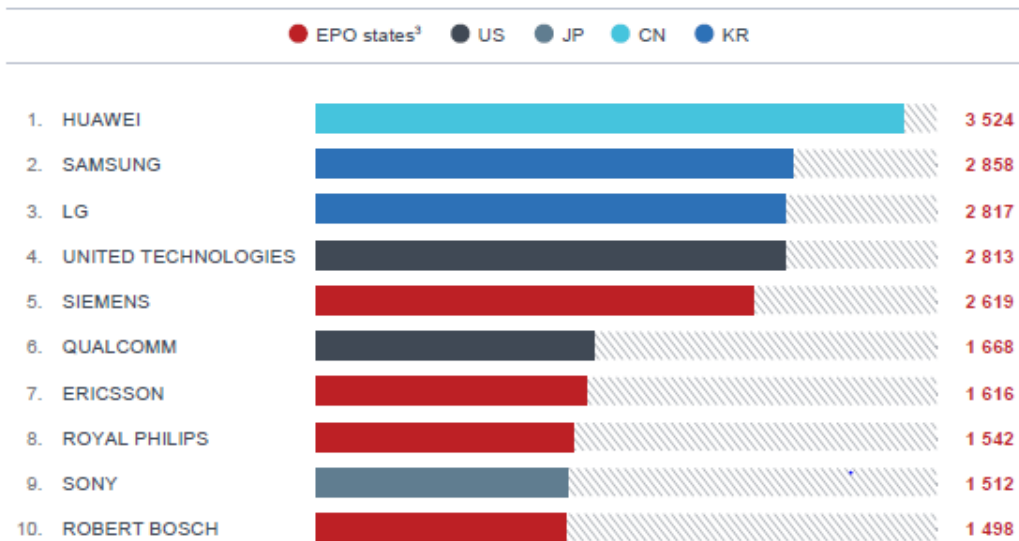
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In view of the reported growth in patent applications filed in the Digital Communications and Computer Technology and originating in China, we highlight the publication of a Comparative study on computer implemented inventions/software related inventions (Report 2019 EPO and CNIPA) and provide an overview of some interesting findings and observations.

The two of the fastest growing fields of technology, based on statistics for Patent Applications received at the European Patent Office in 2019 were Digital Communication and Computer Technology.



The growth in patent applications in 2019 has been based on developments relating to 5G technologies and by the rise of artificial intelligence. This is also reflected in the statistics which show the top 10 applicants at the EPO in 2019. The top applicant in 2019 was the Chinese company Huawei.



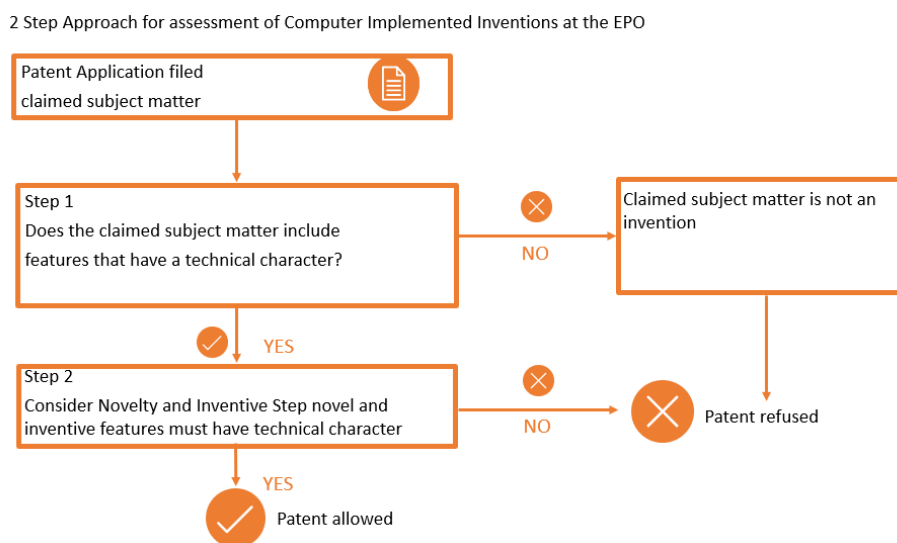
Source: EPO.  
Status: 27.1.2020.

Many applicants are now seeking to obtain protection for computer implemented inventions and digital communication inventions in multiple jurisdictions including at the EPO, in China and in the US.

[Comparative study on computer implemented inventions/software related inventions \(Report 2019 EPO and CNIPA\)](#)

In this context, it is interesting to discuss and highlight a Comparative Study done by the Chinese Patent Office (CNIPA) and the European Patent Office (EPO). The study focussed on comparing the provisions of the legal frameworks, guidelines and practices of each of the offices when examining Computer Implemented Inventions. The study includes a comparison of the 2 step approach used by the EPO for evaluation of Computer Implemented invention with the 3 step approach applied at CNIPA, summarised below as follows:

**EPO 2 step approach for the assessment of Computer Implemented Inventions**



Step 1 (EPO) is directed to assessing whether the claimed subject matter meets the Article 52 European Patent Convention (EPC) definition of an invention has been further developed in view of the Case Law of the Board of Appeals of the European Patent Office, which provides guidance that exceptions to patentability are narrowly construed in practice.

**Step 1 (EPO) Does the Claimed subject matter Technical character?**

- a requirement distinct and separate from the other requirements of novelty, inventive step and industrial applicability.
- a claim directed to information, its analysis, and/or its presentation, as such, may not pass the first step (Art. 52(2) and (3) EPC) (“**as such**” to mean that here is only numerical input and output, and no relation to the physical world).

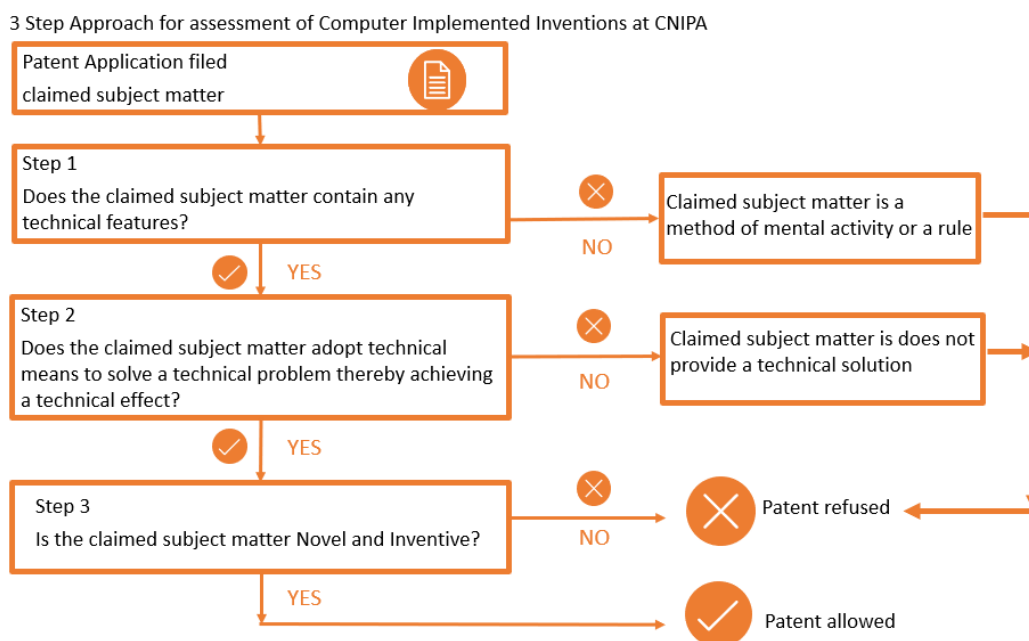
A computer program is considered to have a technical effect if it produces a “further technical effect” when run on a computer. In particular, a technical effect **going beyond the normal physical interactions between the software and the hardware on which it is run.**

Circulation of electrical currents in the computer program does not represent a further technical effect.

**Step 2 (EPO): Consider Novelty and Inventive Step. Do the novel and inventive features which have technical character?**

The examination of novelty and inventive step takes both technical and non-technical features into consideration. The assessment of inventive step takes into account technical features as well as features, when taken in isolation, are non-technical, but, in the context of the invention, contribute to producing a technical effect. Inventive step is considered based on the problem solution approach.

**CNIPA 3 step approach for the assessment of Computer Implemented Inventions**



In contrast to the approach of Article 52 EPC, Chinese Patent Law (CPL) provides in Article 2.2 CPL a positive definition of what is considered to constitute an invention. In addition, a list of exclusions, is provided in Art. 25.1 CPL.

**Step 1 (CNIPA) Is the claimed subject matter relate to a mental activity or rule?** Assess eligibility including whether the claim merely relates to an algorithm, mathematical computing rules, computer programs *per se*. If this is the case, the claim is considered to amount methods for mental activities or a rule and, is accordingly considered excluded from patentability.

**Step 2 (CNIPA) Is the claimed subject matter is eligible in accordance with Art. 2.2 CPL?** Does the claimed subject matter meet the requirements of providing “*an aggregation of technical means applying the laws of nature to solve a technical problem*”

**Step 3 (CNIPA) Is the claimed subject matter novel and inventive?** Novelty and inventive step are assessed. It is noted that the EPO and CNIPA both adopt a problem-solution approach to assess whether inventions involve an inventive step over the prior art.

The [Report of the Comparative Study](#) provides the following summary table which compares the applicable provisions and articles of the European Patent Convention and of the Chinese Patent Law.

	EPO requirements met	EPO requirements not met	CNIPA requirements met	CNIPA requirements not met
Claim 1: method with no technical features		Art. 52		Art. 25, Art. 2.2
Claim 2: computer program which ... performs the method of claim 1		Art. 52		Art. 25, Art. 2.2
Claim 3: computer-readable medium on which a computer program is recorded, whereby the computer program when performed by a processor implements the method of claim 1	Art. 52		Art. 25	Art. 2.2
Claim 4: computer program of claim 2 on a medium	Art. 52		Art. 25	Art. 2.2, Art. 26.4
Claim 5: method with technical and non-technical features	Art. 52		Art. 25, Art. 2.2*	Art. 2.2*
Claim 6: computer program which ... performs the method of claim 5	Art. 52		Art. 25, Art. 2.2*	Art. 2.2*, Art. 26.4
Claim 7: computer-readable medium on which a computer program is recorded, whereby the computer program when performed by a processor implements the method of claim 5	Art. 52		Art. 25, Art. 2.2*	Art. 2.2*
Claim 8: computer program of claim 6 on a medium	Art. 52		Art. 25, Art. 2.2*	Art. 2.2*, Art. 26.4

\* Requirement met only if the claim adopts technical means, solves a technical problem and achieves technical effect.

Source Comparative study on computer implemented inventions/software related inventions (2019 EPO/ CNIPA)

### Example cases – of the comparative study

We note that the report provides for each of a series of **9 example cases and example claims**, a summary of the EPO analysis and a summary of the CNIPA analysis. These example cases are particularly interesting for illustrating, in practical terms and in detail, the application of each of the EPO 2 step approach and the CNIPA 3 Step approach.



## SUMMARY - TAKEAWAY POINTS OF THE STUDY

- The different approaches followed by each the EPO and CNIPA are similar and in many cases lead to similar conclusions. In examination both eligibility and patentability are considered.
- One area of practice that is different at the EPO and CNIPA, is for applications relating to data structures and formats.
- In contrast to Article 52 EPC, CNIPA provides a positive definition of what constitutes an invention. Therefore, it appears that the CNIPA approach focuses more on the step of assessing whether an invention is excluded from patentability whereas according to the second step of the EPO approach, the focus is more on the inventive step analysis.
- Assessment of novelty and inventive step is similar at both the EPO and CNIPA. Notably, both the EPO and CNIPA assess inventive step by using a problem-solution approach.
- At the EPO, features that do not produce a technical effect cannot be relied on to support inventive step. The description should contain enough technical details, that can be introduced in the claim to support/strengthen the inventive merit thereof.
- At the CNIPA, arguments in support of inventive step cannot rely on features that do not contribute in solving a technical problem by producing a technical effect. The description should include enough technical features to form a complete solution which could solve a certain technical problem.

### 3. Boards of Appeal are competent to overturn a finding of fact at first instance (T 1604/16)

[本文中文翻译点击这里](#)

Case law of the Boards of Appeal has permitted only limited re-assessment of facts that were previously presented at the Examining stage or in Opposition proceedings. However, a recent EPO Board of Appeal decision ([T 1604/16](#)) has taken a different approach to Boards of Appeal case law on this issue. In the decision handed down in the Boards of Appeal decision in [T 1604/16](#), the Board of Appeal decided that the EPO Boards of Appeal are competent to re-assess findings of fact in cases that are under appeal. The decision in [T 1604/16](#) has important implications for future appeals in particular, in relation to the aspects of an Examining or Opposition Division decision that can be made the subject of an appeal.

#### Evidence before the Boards of Appeal

The types of evidence that may be considered by the EPO are specified in [Article 117 EPC](#), and include *inter alia* documents, witnesses and expert opinions. According to established Boards of Appeal case law, no type of evidence should be given more weight than any other type of evidence, in other words, evidence provided in documentary form should be given the same importance as evidence delivered orally by a witness. This is the so-called "free evaluation of evidence" principle ([G 3/97](#)) ([Case Law of the Board of Appeal, G 4.1](#)). According to the "free of evaluation of evidence" principle, evidence presented at appeal should not carry more weight than evidence presented at the first instance i.e. at the Examining Division or in Opposition proceedings at the Opposition Division of the EPO.



Under previous case law, for instance, in [T 1418/17](#), the Board of Appeal decided that the only circumstances in which a Board of Appeal may revoke a finding of fact were those in which the first instance department a) did not consider essential points, b) took irrelevant matters into consideration or c) drew illogical conclusions.

The proprietor appealed against the decision of the Opposition Division. A key question for the Board of Appeal to decide was whether or not they could be considered competent to review the Opposition Division's finding of fact based on the available evidence.

One legal question faced by the Board of Appeal in this case was that the evidence available to the Opposition Division took a different form to the evidence available on appeal. In particular, at first instance i.e. at the Opposition Oral Proceedings, Ms Merz gave her evidence to the hearing directly in the form of a witness statement. On appeal, the Board of Appeal had only the written transcript of Ms Merz's witness statement. Unlike the Opposition Division, the Board of Appeal therefore did not have the benefit of being able to directly question Ms Merz. The Board of Appeal had to consider whether, if they reached a different finding of fact based on the transcript, would they then be going against the principle of the "free evaluation of evidence".

### **Foldable ramps**

The patent in question ([EP2293755](#)) in the recent Boards of Appeal decision [T 1604/16](#) related to a foldable ramp for loading wheelchairs into a vehicle. At the EPO Opposition Division, the patent was found to lack novelty. The Opposition Division based its decision on evidence presented by the Opponent that appeared to show prior public use before the priority date of the patent. The evidence included an invoice for the sale of a car and ramp to a Ms Merz on a date before the patent priority date, as well as a photo of the car, and a witness statement from Ms Merz.

Importantly, the photo of the car was taken after the car had been repaired following an accident; and Ms Merz's witness statement stated that the ramp shown in the photo of the car was the same ramp that had been sold to her before the patent's priority date. The Opposition Division's decision was based on a finding of fact, based on the available evidence, that the ramp in the car sold to Ms Merz and the ramp in the photo were the same ramp.

### **Re-evaluating evidence on appeal**

The Board of Appeal in [T 1604/16](#) considered themselves competent to review the Opposition Division's finding of fact, regardless of whether the circumstances specified in [T 1418/17](#) were present. The Board of Appeal argued that interpreting [T 1418/17](#) as broadly constraining the competence of the Boards of Appeal to the review findings of fact was not justified by either the EPC or established case law. The Board of Appeal in [T 1604/16](#) noted that the ability of the Boards to review a first instance decision **in full** was, in fact, necessitated by Article 6 of the European Convention on Human Rights.

After consideration of the issues of the taking of evidence, The Board of Appeal concluded that the transcript of Ms Merz's testimony could be considered to be equivalent to hearing Ms Merz's oral testimony in person. The Board concluded that they were therefore competent to reassess the finding of fact.

### **Did the Opposition Division err in their finding of fact?**

On appeal, the patent owner pointed out passages of the witness statement transcript which cast doubt on the

claim that the repairs to Ms Merz's car after the accident did not modify the foldable ramp previously installed and originally sold with the car. These included the statement that the ramp itself had been damaged in the accident. However, the Opponent had withdrawn their opposition by the appeal stage, and so the Opponent was not in a position to present any submissions in this regard. On the basis of the doubts raised by the patent owner, the Board of Appeal concluded that the Opposition Division had erred in their conclusion that the ramp shown in the photos was, on the balance of probabilities, evidence of prior use. The patent was thus maintained as granted.

### Author's opinion on possible future implications

The national courts of contracting states of the EPC and the EPO are supposed to be in alignment in applying the law. However, in practice, there can still be divergent decisions on the validity of the same European patent. One reason often given as an explanation for this divergence is the differing approaches of the EPO and the national courts when it comes to the taking of evidence. The courts typically devote considerably more time to the hearing and evaluating expert evidence and witness testimony than is the situation with the EPO. In contrast, the EPO prefers to focus on the evaluation of written, documented evidence. The decision in [T 1604/16](#) may therefore be welcome to those hoping for a greater focus on oral evidence by the EPO Boards of Appeal. However, since this decision of the Boards of Appeal was made in relation to the assessment of prior use, in my opinion, it remains to be seen as to how more widely this decision might be applied outside of the question of assessment of prior use.

### News from Hanna Moore + Curley

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

### Our office locations:

#### European Union, United Kingdom and China

Hanna Moore + Curley has offices in Dublin, Ireland in the European Union and in Belfast, **United Kingdom** and in Dalian, Liaoning Province, China. We are well placed to continue to serve all our clients at the EPO, UKIPO, EUIPO and IPOI.



*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](mailto:china@hmc-ip.com) if you have any questions on aspects of International IP strategy, in particular, relating to the EPO or UKIPO.*

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