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G 1/23: New referral questions on public accessibility to the Enlarged Board of Appeal of the EPO

In decision G 1/92, the Enlarged Board of Appeal of the European Patent Office had already decided in 1992 how the term "made available to the public ..." in Art. 54(2) EPC is to be understood for an obvious use of products: "If the person skilled in the art can without undue burden determine the composition or to open up the inner structure of the product and to reproduce it both the product and its composition belong to the or internal structure to the prior art."[1] The principle applies that the mere possibility of direct, unambiguous access to certain information is sufficient to make it accessible.[2]

In the current decision T 438/19, the referring Board of Appeal asks by the following first referral question whether the converse also applies:

1. Is a product which was put on the market before the date of filing of a European patent application to be excluded from the state of the art within the meaning of Article 54(2) EPC solely because its composition or internal structure could not be analyzed and reproduced by a person skilled in the art without undue burden before that date?[3]

The Board of Appeal noted that the first of the two passages of decision G 1/92 quoted above could give the impression that a product placed on the market only becomes prior art when the composition or internal structure of the product can be discovered without undue burden and the product can be reproduced.[4] On the other hand, however, the question arose whether the complete exclusion of a product placed on the market could be meant as relevant prior art, since it is only a prerequisite for a possible analysis of this product that "the product itself is accessible to the public".[5]

In essence, therefore, the referring board is asking whether it is not only the composition or the internal structure of a product that may be concealed from the skilled person, but not the product itself. On superficial consideration, the argument in favor of such a strict approach is that prior art must be executable, otherwise it does not qualify as citable prior art. The referring board also makes this consideration.[6] However, here again the question arises whether in the individual case every feature of a product must really be analyzable, or whether it is not sufficient that certain features of the product allow the skilled person to draw certain conclusions.

The board noted that there were different views of technical boards of appeal on the first question referred. In some cases it was decided that a corresponding product was not prior art at all if the skilled person could not analyze it. In some cases it was decided that in such a case the composition or the internal structure of the product did not belong to the prior art, but the product did. There were also different degrees of analysis that were considered sufficient to classify the composition or internal structure of a product as accessible.

Accordingly, and also against the background of the specific case (see below), the Board asks two further questions for reference in order to also take account of this identified diversity in the case law:

[1] Point 1.4 of the reasons for the decision in G 1/92
[2] Point 2 of the reasons for the decision in G 1/92
[3] Translation of the question submitted
[4] Point 8.2 of the reasons for decision in T 438/19
[5] Point 8.3 of the reasons for the decision
[6] Point 9 of the grounds for the decision

In Our Own Affairs

Another award in IAM 1000

In IAM 1000, our firm is again recommended to all those who want to diligently file their patents and successfully defend their rights before the EPO. Dr. Stefan Michalski, Dr. Aloys Hüttermann, Dr. Dirk Schulz and Guido Quiram are personally named as belonging to the 1000 best patent attorneys worldwide.

Financial Times - Our firm is among Europe's Leading Patent Law Firms 2023

We are pleased to announce that our firm has been included in the fifth edition of the Financial Times Special Report "Europe's Leading Patent Law Firms", published on June 15, 2023.

2. If the answer to question 1 is no: Is technical information about this product which was made available to the public before the filing date (e.g. by publication of a technical brochure, non-patent or patent literature) prior art within the meaning of Article 54(2) EPC, irrespective of whether the composition or the internal structure of the product could be analyzed and reproduced by a person skilled in the art without undue burden before that date? [3]

3. If the answer to question 1 is yes or the answer to question 2 is no, what criteria are to be applied to determine whether the composition or the internal structure of the product can be analyzed and reproduced without undue burden within the meaning of Opinion G 1/92? In particular, is it necessary that the composition and the internal structure of the product are fully analyzable and identically reproducible? [3]

After reviewing the so-called Travaux Préparatoires, i.e. the documents of the creation of the EPC, the board comes to the conclusion that a requirement of practicability as it seems to result from G 1/92 goes beyond the scope of what was understood by "available to the public" in Art. 54(2) EPC[7].

Thus, the Board seems to imply that, in accordance with the legislature's intent, the answer to the first question referred would have to be no and the answer to the second question referred would have to be yes. An answer to the third question would be superfluous. It can therefore be assumed that the Enlarged Board of Appeal will at least include a more thorough examination of the travaux préparatoires in the reasons for its decision if it should come to a different conclusion.

A categorical exclusion of a product under the criterion "not reproducible without undue burden" may lead to the less desirable result that a product, although it can be purchased by anyone, is not usable as prior art. If strictly applied, this is likely to lead to unrealistic results in many cases, and always when the person skilled in the art could have more than a mere black box in his hands.

It is therefore to be hoped that the Enlarged Board of Appeal will adequately answer all three questions referred.

The underlying case further illuminates that categorically excluding a commercially available product as prior art can be a sharp weapon in the hand of a patent owner: The closest prior art is a document that contains an embodiment example describing the use of a commercially available polymer. The embodiment example thus anticipates all but one feature of claim 1 of the patent in suit. The missing feature can be supplemented by a combination document. In the board's opinion, claim 1 should thus fall. The patentee counters in the appeal that the polymer cannot be sufficiently analyzed by the skilled person within the meaning of G 1/92 and thus cannot be reproduced. With a categorical exclusion of the polymer, the embodiment example and thus the closest prior art would be considerably devalued. The opponent refers, inter alia, to further documents from which the skilled person could obtain various properties of the polymer.

In the underlying case, the fate of the patent in suit thus appears to depend on the response of the Enlarged Board of Appeal.

News from the Unitary Patent System

On June 1, 2023, the unitary patent system started, an event whose importance for industrial property protection, not only in Europe but worldwide, can hardly be overestimated.

[7] Point 10.4 of the reasons for the decision

In Our Own Affairs

Still in the first month of the entry into force of the unitary patent system, the handbook „Unitary Patent and Unified Patent Court" by Prof. Dr. Aloys Hüttermann has been published in English.

Wasilis Koukounis LL.M. was moderator and co-organizer, Prof. Dr. Aloys Hüttermann speaker at the 2nd VDI/VPP Seminar on the Unitary Patent System on June 19/20 at the Industrieclub Düsseldorf.

To date, around 25 lawsuits and applications for temporary injunctions[8] have been received by the court, as expected the vast majority at the German local chambers. A first decision has already been made; an injunction in connection with a trade fair was issued by the Düsseldorf local chamber.

Several other preliminary injunctions have been filed with the Munich Local Chamber, but an oral hearing will be held here, so initial decisions are not expected before September.

By June 1, the end of the so-called "sunrise period"[9], it is estimated that approximately 500,000 "opt-outs" had been filed. With an estimated 1.5 million IP rights that can be "opted out", this results in an "opt-out" rate of one third, which is lower than expected. According to initial evaluations, non-European IP owners in particular have made use of the opt-out.

Finally, the final agreement concerning the third location of the central chamber[10] was announced a few days ago. Originally, London was planned, but since Great Britain is no longer part of the Unitary Patent System, a new third location had to be found. As expected, this will be Milan.[11] Somewhat more surprising, however, is that in the course of the reallocation, the division of competences has also been changed. Instead of assigning the IPC main classes A and C intended for London to Milan, it has now been decided that (only) class A will be assigned to Milan, while main class C will be assigned to Munich, both with the restriction that supplementary protection certificates will be negotiated in Paris.[12]

Class A is headed "Daily living necessities", but many pharmaceutical products also fall into Class A (mostly A61K). Thus, there will be a split between Milan and Munich in the pharmaceutical sector.

Numerous publications from the EPG

In preparation for the start of the unitary patent system, the Unified Patent Court has published quite a few documents, some of which will be briefly presented:

- On April 25, the list of presiding judges of the individual chambers was published. Since many chambers only have a single permanently assigned judge, it is not surprising that this judge then also became presiding judge. Exciting, on the other hand, are the decisions where there is a choice. Here, Florence Butin (Paris) and Ulrike Voss (Munich) have been selected for the Central Chamber, Ronny Thomas for Düsseldorf, Matthias Zigann for Munich, Sabine Klepsch for Hamburg, Peter Tochtermann for Mannheim, Camille Ligneres for Paris, Edger Brinkman for The Hague and Perluigi Perrotti for Milan.

- The court has also published templates for decisions and orders in general, as well as for individual decisions. To discuss these in detail would go too far, but it is interesting to note that according to the template, the court can take into account both the claim of the patent in suit and the specific infringement form attacked in the decision text for patent infringement actions.[13]

[8] The sources differ somewhat here, also not all actions can be found at the court's register, this is probably because not all have been served yet and are therefore formally pending.
[9] See our newsletters 2/2023 and 10/2022
[10] S. our newsletter 4/2022
[11] S. here: https://unified-patent-court.org/en/news/communication-administrative-committee-meeting-2-june-2023
[12] S. here: https://www.unified-patent-court.org/sites/default/files/upc_documents/decision-d_ac_03_26062023_-amendment-upca.pdf
[13] For discussion see Hüttermann, Einheitspatent und Einheitliches Patentgericht, 2nd ed. Rdn 1124ff.

In Our Own Affairs

Handbook „Unitary Patent and Unified Patent Court" by Prof. Dr. Aloys Hüttermann in the second edition

Just in time for the start of the unitary patent system, the second edition of the handbook „Unitary Patent and Unified Patent Court" by Prof. Dr. Aloys Hüttermann is published by Heymanns. The first edition (now out of print) was already published in 2016 and has been completely revised and brought up to date. In addition, the most important legal texts have been included by popular request. Already in the first edition, numerous guest authors from the most important member states of the Unitary Patent System had each included a chapter on enforcement and a comparison of their national patent infringement system with the Unitary Patent System. This was supplemented by four further chapters with comparisons to US, Chinese, Japanese and Korean law.

An English language edition is in preparation and is expected to be published in June.

- Previously, the court had only published the court fees; the caps on reimbursable agency fees had been missing. This has now been made up for, with the "Mooney/ Tilmann" draft essentially retained. This is somewhat surprising, as the limits proposed at the time were based on the assumption that British lawyers would participate in the proceedings, which is no longer the case.

- Worth mentioning is the code of conduct for the judges, especially regarding the conflicts of the technical judges.[14] In this respect, it is worth mentioning that the conflict rules do not only concern the technical judges, but also the law firms to which they belong, which could often make it difficult as a result both to handle many cases as a technical judge and to belong to an acquisition-strong and/or larger unit, be it a law firm or also a company; the fact that some technical judges have meanwhile left their law firms and continue as "soloists" may be an effect of this. It remains to be seen what the composition of the technical judges will look like in a few years and whether the court will not have to switch to employing a smaller number of technical judges on a full-time basis instead of the part-time model that has prevailed so far.

EU Commission plans drastic expansion of the competences of the EUIPO in the patent area (FRAND and SPCs) as well as regulation regarding compulsory licenses

In the last few days, the EU Commission has published three drafts which, if two of them were to become reality, would mean a drastic expansion of the competences of the EUIPO into the patent area.

On the one hand, the EU Commission plans to turn the EUIPO into a kind of "FRAND supervisory authority", i.e. summarized:

- Establish a register of standard-essential patents at the EUIPO with the understanding that a listing of a particular patent would be a prerequisite for effective enforcement within the EU;

- Enabling the EUIPO to consider whether a particular patent falls within a standard (although this would not be binding on the parties); and

- Particularly drastic: to require the parties to go through mediation proceedings at the EUIPO prior to patent infringement proceedings, whereby a license rate would also be set on the part of the EUIPO in these proceedings.

The reactions to this project so far have been rather critical,[15] and voices that are at least partially positive tend to be in the minority.[16] However, there seems to be agreement that it will be extremely important for the EU to be able to recruit sufficient specialist staff, as the EUIPO has not been equipped for the patent area so far, especially such a difficult area.

[14] See e.g. https://www.juve-patent.com/people-and-business/patent-attorney-dominance-among-upc-technical-judges-leads-to-conflict-debate/

[15] Note: Previously, a leaked draft had been published on the Internet, see https://ipkitten.blogspot.com/2023/04/first-leak-and-now-question-will.html or https://www.juve-patent.com/legal-commentary/no-major-changes-in-eu-commission-final-proposal-for-frand-regulation/.

[16] About here: https://www.juve-patent.com/legal-commentary/to-proceed-as-before-would-be-a-mistake/ Judge Brinkman also expressed cautiously positive views (on the leaked draft) at the Fordham conference.

In Our Own Affairs

For the 15th time, our office is offering two free two-day preparatory courses for the C and D parts of the European Qualifying Examination (EQE) in 2023. The courses will take place on Monday/Tuesday, November 20/21, and Saturday/Sunday, December 9/10, 2023. Both courses are identical in content, so attending one course is sufficient.

The course content is primarily focused on appropriate exam techniques as well as strategies for avoiding mistakes in order to be able to successfully tackle the C and D parts of the EQE exam with these skills. It has been our experience that well-prepared exam materials significantly increase the chances of success. Therefore, we want to provide the participants with the necessary methodological knowledge in this course. In this respect, the course is to be understood as a supplement to the participants' own preparation of the legal fundamentals of the EPC. Instead, participants will learn how to convert their technical knowledge of the EPC into as many points as possible for passing the C and D parts of the EQE examination. The courses take place in Düsseldorf at our premises in Kaistrasse 16A and are free of charge. Speakers of the course are Dr. Torsten Exner, Dipl.-Ing. Andreas Gröschel and Prof. Dr. Aloys Hüttermann.

Registration is now possible (please state your full name and employer) at eqe@mhpatent.de.

In contrast, the EU's plan to create a "unitary SPC", i.e. a supplementary protection certificate for unitary patents, and thus close the gap that arose after the introduction of the unitary patent system, is likely to meet with more approval. Here, too, the EUIPO is to become the competent authority. However, it is unclear whether and how the Unified Patent Court is to be responsible for such "unitary SPCs" - should a kind of "parallel system" be created here, the applause might be limited after all.

Somewhat detached from the two proposals is the proposal for the introduction of the possibility of an EU-wide compulsory license in the event of a crisis. If necessary, an "Advisory Body" should be introduced to advise the EU on the concrete implementation - whether this will also be located at the EUIPO remains open.

All three proposals are so far only at the stage of the Commission's proposal, i.e. the Council and Parliament still have to agree. In view of the relevance of the first two drafts in particular, it will be interesting to see to what extent they become law at all and whether they are still subject to change.

Impressum:
Michalski · Hüttermann & Partner
Patentanwälte mbB

Kaistrasse 16A
D-40221 Düsseldorf
Tel +49 211 159 249 0
Fax +49 211 159 249 20

Hufelandstr. 2
D-45147 Essen
Tel +49 201 271 00 703
Fax +49 201 271 00 726

Perchtinger Straße 6
D-81379 München
Tel +49 89 7007 4234
Fax +49 89 7007 4262

De-Saint-Exupéry-Str. 10
D-60549 Frankfurt a.M.
Tel +49 211 159 249 0
Fax +49 211 159 249 20

Am Rathaus 2
D-42579 Heiligenhaus
Tel +49 2056 98 95 056