MICHALSKI HÜTTERMANN

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Can the UK remain in the Unitary Patent system?

The IP community was not alone in being relatively unprepared for the outcome of the "Brexit" referendum in the United Kingdom. Although we had highlighted the consequences of such a result in our previous newsletter, few in our firm expected "Brexit".

It is therefore all the more impressive that within just a few days of the referendum, Prof. Winfried Tilmann presented a proposal[1] as to how the United Kingdom could remain in the Unitary Patent system even after leaving the EU.

Shortly after the referendum, a number of organisations in the UK intellectual property sector, namely the IP Federation on behalf of industry, the Chartered Institute of Patent Attorneys (CIPA) and the Intellectual Property Lawyers Association, commissioned a report from Richard Gordon QC, a respected barrister and a specialist on European law at Brick Court Chambers.

In the report[2] now submitted, he and his colleague Tom Pascoe also consider that it would be possible for the UK to remain within the Unitary Patent system.

The two proposals are similar, and are worth briefly presenting here.[3] They assume that the United Kingdom will ratify the Agreement on a Unified Patent Court while still a member of the EU, which will be the case for the foreseeable future.

The United Kingdom's inclusion in the Unitary Patent system would then be possible under an agreement pursuant to Article 142 of the European Patent Convention, under which contracting states may agree that joint validation is required. The two reports do not see any problems with European law in this area.

Inclusion in the Unified Patent Court is a more difficult question: a CJEU opinion in 2011 (1/09) on a

A new type of "patent troll"?

Patent trolls, also known as NPEs (Non-Producing Entities) and PAEs (Patent Assertion Entities), were previously a primarily US-American phenomenon.[1]

The recent emergence of an applicant that is more of "a European-style patent troll" therefore comes as a surprise. The company in question is IP Gesellschaft für Management mbH from Cologne.[2]

This applicant has taken advantage of the fact that according to Article 54(3) of the European Patent Convention an earlier application published on the same day as a later application is filed only affects the novelty of the later patent and not its inventive step.

As most parties are aware, it is usually relatively easy to establish novelty for the European Patent Office on the basis of "trivial features" that are more or less an integral part of the actual inventive concept.

International patent applications are published electronically and – in European time – in the early morning. If an applicant is fast enough, they can file an application of their own on the basis of an older application published on the same day, creating novelty by adding largely trivial features. In principle, that applicant could then be granted a patent for the item in question from the European Patent Office. The older application published on the same day is certainly not a barrier to the award.

This possibility has to date been used at least once by IP Gesellschaft für Management mbH, for example with EP 2 740 458, filed on 2 December 2013 and published on 3 August 2016. It claims a number of priorities, including one dated 31 January 2013.

Our latest news

The 2nd *Bergische Patent- und Markenakademie* is being held in November/December 2016 in partnership with Museum Plagiarius in Solingen. Dr. Cersten Bethke, Guido Quiram, Dr. Ralf Malessa and a number of guest speakers will be giving talks on a range of industrial property areas. The seminar runs over three evenings, 3 and 17 November 2016 and 1 December 2016. Each event starts at 18:00 in Museum Plagiarius.

The invitation and booking information is available here

We look forward to seeing you.

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As in previous years, our firm is once again running two preparatory courses for EQE 2017. The courses will focus primarily on appropriate assessment techniques and strategies for avoiding errors, which relate to papers C and D of the EQE.

There are still places available on the course on 22/23 November 2016.

precursor of the Unitary Patent system, the "unified patent litigation system", found that it was not compatible with EU law. This led many commentators to conclude that non-EU states, at that point specifically Switzerland, could not be involved in a European patent court.

Both Tilmann and Gordon and Pascoe now, however, point to the fact that the CJEU opinion did not explicitly rule out such inclusion. The essential aspect for the CJEU was rather extensive powers for the yet to be established court to refer cases to the CJEU.

Both reports consider the UK's inclusion as potentially fully consistent with EU law were the UK to provide undertakings and enter into relevant agreements with the EU. To this end, however, the Agreement itself would have to be changed, as it currently states that only EU Member States can be members.

Including the United Kingdom would, however, most certainly require the necessary commitments and a recognition of the primacy of European Union law on the part of the UK. Whether or not this is politically feasible remains to be seen – although it should be noted here that the UK already succeeded in greatly reducing the role of the CJEU during the development of the Unitary Patent system. In practice, the primacy of EU law is likely to have more theoretical than practical implications, and this could facilitate British ratification.

Without calls for ratification from the sectors concerned, in particular industry and above all British industry, ratification is, however, unlikely. The report by Gordon and Pascoe was only published a few days ago; it was therefore not to be expected that such initiatives would already be underway. Whether or not this will change in the future remains an interesting question.

[1] *Tilmann*, GRUR 2016, 753, first published in the EPLAW Blog on 27 June 2016
[2] Available here
[3] For a more detailed discussion of the proposal by *Tilmann*, cf. *Hüttermann*, Mitt. 2016, 353

Claim 1 relates to

"A packaging comprising a multitude of at least 2 administration units comprising substance A or of at least 2 administration units comprising substance B".

Substances A and B are known from the older WO 2013/016155, which is also cited in the patent and which was published on 31 January 2013, in other words on the same day as one of the priority applications for EP 2 740 458.

We do not currently know whether IP Gesellschaft für Management mbH has already attempted to make money out of their patents, which is after all the standard practice of patent trolls. Most of the property rights filed by the company to date that have been published are, however, still at the filing stage.

Therefore further developments remain to be seen before it is decided whether and to what extent these property rights are valid, and whether, for example, entitlement proceedings could be successful.

[1] For the background and the difficulty in defining the term, see *Ann*, Produktpiraterie – »Anständige Verletzer« einerseits, »Produktpiraten« andererseits, VPP-Rundbrief 2014, 93.
[2] We were made aware of this company by our client Sanofi/Aventis, from whom we have been given explicit consent to publish this newsletter.

The course is free of charge and will be held on our premises.

The lecturers are Dipl.-Ing. Andreas Gröschel, Dr. Aloys Hüttermann, Dr. Ulrich Storz and Dr. Torsten Exner.

For registration or more information, please contact eqe@mhpatent.de. Please provide your full name and the company or law firm for which you work when you register.

We look forward to seeing you.

Questions and feedback

We welcome your questions and feedback. Please contact us here.