



Newsletter 3/2018 Edition

Düsseldorf/Eszen/Munich, 2 May 2018

Great Britain ratifies unitary patent agreement

With the unitary patent agreement having already cleared the parliamentary hurdles in Great Britain in February,¹ the UK has in the meantime also formally ratified the Agreement on the Unified Patent Court, as [confirmed](#) by the cognizant minister, Sam Gyimah, on 26 April 2018 and [viewable](#) on the EU Council's web site.

Some commentators have noted that Great Britain only declared ratification subject to a [reservation](#), and that this could result in problems, believing that perhaps this ratification could even be rescinded. This reservation, which was declared back October 2015, relates solely to the planned protocol phase of the Unified Patent Court, however. In concrete terms it means that Great Britain does not accord legal personality to the court as such during the protocol phase, since Article 4 of the Agreement on the UPC, which made precisely this provision, shall not apply.

This has the consequence that Great Britain excludes the Rome I and Rome II regulations (593/2008 and 864/2007) for the contractual and non-contractual liability of the Unified Patent Court for the time being. Liability cases arising in Great Britain during the protocol phase will thus be governed by British law until the Unified Patent Court is fully in force. Such reservations are not unusual, and they do not call into question the ratification of the Unified Patent Court on the part of Great Britain.

This means that the coming into force of the Unitary Patent system now depends on Germany alone. Unfortunately, there is nothing new to report on the constitutional complaint before the Federal Constitutional Court.

In view of the recent developments – and also the fact that the Federal Constitutional Court placed the ongoing ratification process on hold at that time – it can be presumed nonetheless that the complaint will at least be handled on a priority basis.

And in our own affairs...

Because the European Data Protection Regulation (GDPR) takes effect on 25 May 2018, we will soon contact you to request your consent to continue providing you with information such as this newsletter in future. We hope you will give your consent so that we can remain in contact.

Our 11th Rhineland Biopatent Forum will take place on 14 June 2018 at our office. Speakers include Jay Erstling, former Director of the Office of the PCT and Director Advisor to the Director General of the WIPO, Maria Covone-van Hees, European Patent Office and Jonathan Miaozheng, NTD Patent Attorneys, Beijing.

If you would like to participate in this free seminar, please send an email to felsner@mhpatent.de.

Proposals and Questions

¹ see our [Newsletter 1/2018](#)

If you have any proposals or questions, please don't hesitate to contact us [here](#).

Once the complaint is resolved, however, whether it is not taken up in the first place or whether it is taken up but denied on the merits, signing by the German president and subsequent ratification by Germany can be expected to follow promptly. It is thus entirely possible that the unitary patent system may yet come into force this year.

Of course, the final status of Great Britain after Brexit is totally unresolved. Strictly speaking, according to the agreement on the Unified Patent Court only EU member states may take part in the unitary patent system, not to mention the existence of Opinion 1/09 of the Court of Justice of the European Union, which held a predecessor model of the current unitary patent system to be incompatible with EU law.

However, there are publications² on this subject, for instance by *Tilmann* or *Gordon/Pascoe*, that do not consider participation by Britain to be out of the question under certain conditions, even after Brexit. It would doubtless be necessary to amend the agreement, although this could take place without re-ratification; an explicit statement by Great Britain accepting the CJEU as the highest court of appeal might also be necessary insofar as this has not implicitly been done in any case through the ratification.

The CJEU will have the last word here, but unfortunately not until after a corresponding referral on the part of the Unified Patent Court itself. This means that several more years will pass before certainty is achieved.

G1/15 in practice – decision T 282/12

As already reported,³ in its decision G1/15, the Enlarged Board of Appeal undertook a delimitation of priority law from the systematic/axiomatic approach of evaluating the disclosure.

The recently issued decision [T 282/12](#) logically develops the principles underlying decision G1/15. Relevant to the issue here was the question of the extent to which the contested patent is accorded the claimed priority, or whether a still earlier application from the same applicant might not be considered a first filing pursuant to Art. 87 EPC.

It was important here that the critical feature was a range specification. In the priority document (D1), as in the claim, a range of 3% to 33% was specified. But the priority document itself was a continuation-in-part of an older US application (D22), in which the range of 5% to 33% was specified.

The opponent argued that D22 should be considered the first filing, and the claim should thus be accorded no priority. The patent holder countered that D22 disclosed different subject matter. If the range in the claim (= 3% to 33%) were to be changed to the range that was disclosed in D22 (= 5% to 33%), this would unquestionably represent

² see also our [Newsletter](#) 3/2016.

³ see our [Newsletter](#) 7/2017 and [Newsletter](#) 1/2017, also refer to Hüttermann, *Mitt.* 2018, 53.

an impermissible extension. That meant that D1 would be the first filing, and the priority would thus be valid.

The Board of Appeal has now ruled that such an approach analogous to Article 123 EPC, which is to say a test for impermissible extension, is out of the question: *“However, it is the Board's view that examining the validity of the priority by performing a test under Article 123(2) EPC (e.g. by assessing whether a claim C claiming priority from an application P would be allowable under Article 123(2) EPC if P were the application as filed and C an amended claim), may in some circumstances lead to wrong conclusions because the concept of "partial" validity of an amendment does not exist, whereas the concept of partial priority does.”*⁴

Instead, the concept of intrinsic partial priority must be employed, just as in G1/15. As a result, the priority for the range of 3% to 5% is valid, since this range was not disclosed in the older US application D22. In contrast, this US application D22 is the first filing for the range of 5% to 33%, and thus the priority cannot be recognized here.

With this declaration, the matter was then returned to the opposition division.

In sum, this decision is a logical continuation of the course adopted in G1/15, namely to apply different standards in judging the validity of an existing priority claim for subsidiary ranges and subsidiary terms than, for example, in evaluating novelty or in the case of amendments.

It remains to be seen whether the overall system of the European Patent Office will remain essentially intact, or whether the areas of priority, novelty, and amendments will each be subject to their own rules in future.

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⁴ see 2.9.1. of the Decision