MICHALSKI HÜTTERMANN

PATENT ATTORNEYS

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Unitary Patent system makes it through Parliament in United Kingdom

On 8 February 2018, with Order SI 2018/184, the UK Privy Council in Great Britain accepted the protocol on the immunities of judges in the Unified Patent Court that ratification of the Unitary Patent system still requires.

With this step, a little over a year after Great Britain announced that it would ratify the Unitary Patent system,[1] the system has now successfully passed all parliamentary hurdles in Great Britain, and only the formal filing of the ratification document remains. This is anticipated as soon as the UK Intellectual Property Office formally requests British Foreign Minister Boris Johnson to do so.

At the same time, it is expected that Great Britain will then formally ratify the protocol for the Unified Patent Court (UPC) Agreement as well, so that the so-called UPC protocol phase[2] can begin on time.

In contrast, no schedule is in sight for a decision on the part of the German constitutional complaint.[3] It does, at least, appear on the list published on February 21 of cases that the German Federal Constitutional Court intends to rule on this year. Interestingly, the constitutional complaints against the European Patent Office on account of lack of similarity of the Boards of Appeal also appear on this list.

The constitutional complaint has not yet been made public either; nonetheless, some of the opinions that were requested by the Federal Constitutional Court, and for which it had set an (extended) deadline of the end of 2017, have been published. These are:

- opinion by the German Bar Association (DAV)
- opinion by the German Federal Bar (BRAK)
- opinion by the GRUR; and
- opinion by the EPLIT.

And in our own affairs…

This year, our patent seminar will be held on 11 April 2018 at the Industrie-Club Düsseldorf; we are pleased to have Dr. Stefan van der Vlugt (Bayer), Dr. Torsten Kettner (WILO) and James D. Smith (Ecolab) as external speakers.

If you would like to participate in this free seminar, please send an email with your postal address to: seminar@mhpatent.de.

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Andreas Gröschel will speak on the Unitary Patent System at the PATENTE 2018 Congress on 13 March 2018.

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Dr. Aloys Hüttermann will speak on the European Patent Office's decisions G1/15 and G1/16 at the Düsseldorfer Patenttagen on 15 March 2018.

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Our practice is participating in Startup-Woche 2018. Guido Quiram, Dr. Ulrich Storz, and invited investors will give a presentation to event participants on the business aspects of commercial

All of the opinions argue in favor of dismissal of the constitutional complaint; most of the opinions, especially that of the DAV, even go so far as to characterize the constitutional complaint as impermissible.

In total, three additional opinions have been received, as reported in the Kluwer IP Blog, namely those of the German government, the EPO, and EPLAW, of which only the last is expected to be published in the near future.

Based solely on the relatively extensive opinions in reaction to the constitutional complaint, which itself is quite long at over 150 pages, a decision by the Federal Constitutional Court on whether to initiate proceedings in this case should not be expected very soon at all.

However, 27 organizations and state organs were initially given the opportunity to submit opinions, so (only) seven responses must be taken into consideration. Thus, with a bit of luck a decision might be issued after Easter.

When is a claim of priority effective before the EPO?

In a startling proceeding, the responsible Opposition Division in the first opposition proceedings against the Broad Institute's CRISPR/Cas patents has rejected patent EP 2 771 468 on grounds of lack of novelty[4].

This resulted from the circumstance that the patent, which claimed a total of twelve priority-establishing US provisional applications, was denied priority for the critical prior applications, so that the applicant was now opposed by his own disclosure.

Among the reasons for this was that an inventor named as an applicant in the two earliest applications had assigned his priority rights not to the Broad Institute, but rather to Rockefeller University – but the latter was not a co-applicant of EP 2 771 468.

The patent holder filed an appeal immediately after the oral hearing, which was initially scheduled to last four days but ended on the second day, so the proceeding is still ongoing.

Even aside from this patent with its extraordinary commercial importance, the fundamental questions raised are of interest, namely:

- Is the decision as to whether a claim of priority is effective determined by national law (here: US law), or does the EPO itself have decision-making authority here?
- Does effective claiming of the priority of an application that includes multiple applicants require identity of applicants or, if applicable, a priority assignment by all unnamed applicants, or is partial identity sufficient?
- Must such an assignment of priority rights have been executed before the date of the later application?

The text of the decision has not yet been published – but in its comments for the summons to the oral hearing, the Opposition Division expressed itself quite unambiguously regarding all three questions:

intellectual property rights for financing start-ups and for enhancing corporate value, using examples from actual practice.

This free event will be held on 17 April 2018 from 4:00 to 5:30 PM at our office. You can register with the Startup-Woche organizers at their Web site.

Proposals and Questions

If you have any proposals or questions, please don't hesitate to contact us here.

- It had already been established in the very old decision J15/80 from 1981 that the EPO ultimately has decision-making authority for the question of whether the priority is effective.
- An effective claim requires complete identity of the applicants or an appropriate assignment of priority rights in effect prior to the filing of the subsequent application that is claiming priority.

The question of whether and how priorities are effective arises frequently, especially for US provisional applications, since in this case the inventors are also the applicants. Since some of these applications and the resulting patents are very valuable, and thus the question of priority is frequently discussed in opposition proceedings, there have already been calls to change the practice here.[5]

Whether and to what extent the Board of Appeal will do so, and whether perhaps the matter will even be referred to the Enlarged Board of Appeal, remains to be seen.

MHP partner Dr. Ulrich Storz is one of nine opponents in the present case.

[1] see our newsletter 4/2016, available here
[2] see our newsletter 1/2017, available here
[3] see our newsletter 4/2017, available here
[4] regarding the complex of intellectual property rights in the CRISPR/Cas technology, see also *Storz*, J. Biotechnology, 2018, 86-92
[5] for example, *Bremi*, GRUR Int, 2018,128, cf. also *Pahlow*, GRUR Int, 2017, 393

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