



Newsletter 4/2016 Edition

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Great Britain to ratify the UPC agreement

On 28th November, the British government announced at the meeting of the EU Competitiveness Council, as well as on its website¹, that it will ratify the Unified Patent Court (UPC) Agreement in the near future. At the same time, Britain wants to make the necessary arrangements to remain part of the single patent system after their exit from the EU.

This news may come as a sensation, as according to the agreement Britain will have to recognise rulings issued by the European Court of Justice in this domain. Even if chances are that in reality the scope for the European Court of Justice to make decisions will be restricted, this move is surprising in light of the negative stance publicly expressed by the government towards this court. Yet the British government then made it clear that in ratifying the agreement, they are not aiming at a “Brexit Light” in other domains.

Britain already changed its patent legislation in March and consequently doesn't have much more to do. It's only a matter of weeks until the British government make good on their promise and officially ratify the agreement.

The official point in time when the agreement comes into effect is, *„the first day of the fourth month after the deposit of the thirteenth instrument of ratification”* (article 89).

This would be the deposit of the German instrument, since Germany is both the compelling and thirteenth ratifying nation – if Britain ratifies the agreement beforehand, that is. If Germany continues its ratifying process, the Unified Patent Court could in fact begin its work next year. At the same time, unitary patents would then become available.

The G1/16 referral on “disclaimers”

The Enlarged Board of Appeal is dealing with disclaimers in the case of G1/16, that is to say the possibility of excluding certain features, which were not included in the original application, by adding a negative limitation, in other words disclaiming them.

Disclaimers play a particularly huge role in the fields of chemistry and biochemistry, as well as in the pharmaceutical sector. They have already been the object of two decisions by the Enlarged Board of Appeal, namely the decisions G1/03 and G2/10.

The decision G1/03 is particularly noteworthy, as it is in logical contradiction to the course of jurisdiction taken by the European Patent Office so far, propagating a strict notion of the possibility to make changes to European applications and patents.

This judicial practice can be seen as an attempt to bring the selection invention logically in line with the disclosure, and place the inspection practice on foundations that are axiomatically secure, so to speak. This is similar what Hilbert attempted for mathematics in his Hilbert Programme¹ during the 1920s.

The G1/03 decision rules that those disclaimers not originally disclosed can be included in the claim. This was and is the major exception here and it was not surprising that the Board of Appeal has attempted to revoke this decision in hindsight several times.

A particularly successful attempt is the G2/10, which accordingly permits positively formulated features to be disclaimed by adding a negative limitation – what is perhaps surprising in practice is not logically in contradiction to the

And in our own affairs...

On 9th December 2016, as part of UNION-IP, Dr. Dirk Schulz participates in a panel discussion on the topic of “Prison or Debtors’ Prison – the personal liability of managing directors and legal advisors for infringement of property rights”. More information can be found [here](#).

The book written by Dr. Aloys Hüttermann entitled “Einheitspatent und Einheitliches Patentgericht” (Unitary Patents and the Unified Patent Court) was published by Heymanns Publishers. Besides presenting the Unified Patent system, it primarily addresses strategic issues. More information can be found [here](#).

Let's now turn to our upcoming annual patent seminar that will take place in the following year on 11th May 2017 at the Düsseldorf *Industrie-Club*. We are already attracting some notable personalities to speak at this event and a more detailed programme will be announced shortly.

If you'd like to register for

The question remains, however, whether the European Court of Justice will still consider the Unified Patent system consistent with European law after Britain leaves the EU².

However, this would only effect Britain and not the Unified Patent system as a whole. It cannot be predicted whether unitary patents would still include Britain after the relevant verdict has been reached, or whether the British local chamber would still have the power to make decisions.

Seeing as the European Court of Justice has been amiable in its jurisdictions so far, particularly in the cases of the C146/13 and C147/13 Spanish challenges³ of the Unified Patent system, a British exclusion of this sort seems rather unlikely, especially as it would only take place after Britain has left the EU, a process which could drag on for years.

Patent holders and claimants, who by all means want to err on the side of caution, could consider initially foregoing unitary patents, as well as avoiding the British local chamber, until the final placet has been made by the ECJ.

This still does not deny the fact that the Unified Patent system is finally about to be implemented, after over 40 years' worth of preparation.

¹ see [here](#)

² see our previous newsletter in detail, available [here](#), as well as *Hüttermann*, Mitt. 2016, 353

³ see *Hüttermann*, Mitt. 2015, 498

axiomatic course of the Board of Appeal, however. Having said that, G1/03 was not definitively designated as no longer being valid within this decision.

The rational logic of the questions submitted in the T 417/14 decision of 17th October this year make good for this (more details can be found [here](#)), as several such questions were posed to the Enlarged Board of Appeal, one of which questioned whether G1/03 would be set aside.

The process was initiated before the Enlarged Board of Appeal under the number G1/16 a few days ago, however a decision is not likely to be reached before the end of 2017.

Considering the attitude towards this topic is well-known, especially that of the Board of Appeal, it would be no surprise if the matter is finally closed on G1/03, the greatest bugbear for the Enlarged Board of Appeal.

In turn, the possibilities available to patent holders would be even more restricted, and the demands on the composition quality of patent applications, which are already high enough, would be increased even further. No one wants to be at a serious disadvantage like in the case of "Pemetrexed".

¹ see *Exner/Hüttermann/Michalski*, issuing patents as the Hilbert programme – possibilities and limitations of the rule-based inspection practice of the EPO, (in print)

² see e.g. ruling of the Federal Court from 14th. June 2016 – X ZR 95/15 „Pemetrexed“ Mitt. 2016, 453, as well as parallel verdicts in Great Britain

this event, please send an email with your postal address to: seminar@mhpatent.de

Proposals and Questions

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

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