

Newsletter - September 2006 Issue

DCB Patent Law Seminar 2006

on November 10, 2006

De Clercq, Brants & Partners will organize a patent law seminar on November 10, 2006 in the idyllic surroundings of Sint-Martens-Latem entitled: **“The patent law landscape in life sciences: what to remember for the future?”**

Many of the subjects covered in this Newsletter will be further analysed and commented during the Seminar. Also this year, we are privileged to have distinguished speakers from the European Patent Office, the European Commission, De Brauw Blackstone Westbroek, Howrey, and our own firm.

You can find the full program and reply form via:
www.dcbpatent.com/DCBseminar2006.pdf



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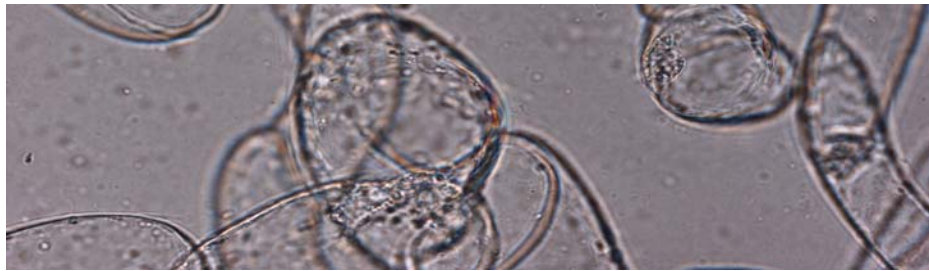
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Referral to EBA regarding embryonic stem cell patents (G 2/06)

Not entirely surprising, the Technical Board of Appeal (TBA) in the WARF case has referred a number of questions relating to the patentability of embryonic stem cells to the Enlarged Board of Appeal (EBA). In case **T1374/04**, Wisconsin Alumni Research Foundation (WARF), claim 1 of patent application EP 96903521.1 reads: "A cell culture comprising primate embryonic stem cells which (i) are capable of proliferation in vitro culture for over one year, (ii) maintain a karyotype in which all chromosomes normally characteristic of the primate species are present and are not noticeably altered through culture for over one year, (iii) maintain the potential to differentiate to derivatives of endoderm, mesoderm, and ectoderm tissues throughout the culture, and (iv) are prevented from differentiating when cultured on a fibroblast feeder layer."

Relevant provisions in this context are Rule 23d(c) EPC: "Under Article 53(a), European patents shall not be granted in respect of biotechnological inventions which, in particular, concern the following: [...] (c) uses of human embryos for industrial or commercial purposes;" and Rule 23e(1) EPC according to which "the human body, at the various stages of its formation and development [...] cannot constitute patentable inventions."



The following questions have been referred to the EBA:

1. Does Rule 23d(c) EPC apply to an application filed before the entry into force of the rule?
2. If the answer to question 1 is yes, does Rule 23d(c) EPC forbid the patenting of claims directed to products (here: human embryonic stem cell cultures) which - as described in the application — at the filing date could be prepared exclusively by a method which necessarily involved the destruction of the human embryos from which the said products are derived, if the said method is not part of the claims?
3. If the answer to question 1 or 2 is no, does Article 53(a) EPC forbid patenting such claims?
4. In the context of questions 2 and 3, is it of relevance that after the filing date the same products could be obtained without having to recur to a method necessarily involving the destruction of human embryos (here: e.g. derivation from available human embryonic cell lines)?

With regard to question 2, and the submission of the appellant that such exception to patentability needs to be interpreted narrowly, the referring Technical Board of Appeal (TBA) held that the EBA had already acknowledged in decision G 01/04 that the principle that exclusions from patentability need to be interpreted narrowly "did not apply without exception".

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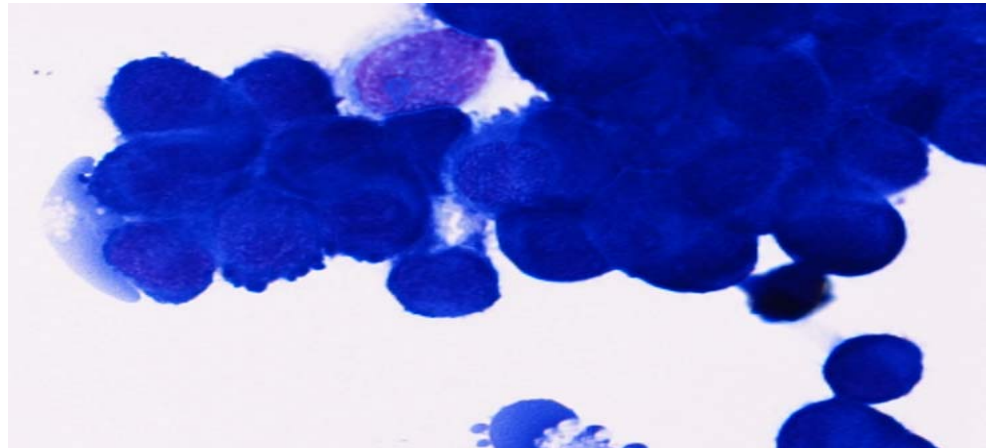
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The referring TBA also expressed the opinion that the use of the term “use of human embryos” does in its view not refer to any specific claim category, and is as a consequence not confined to claims claiming directly the use of human embryos. In the view of the referring TBA, the provision might refer in general to ethical objections against the exploitation of certain technology in the claimed subject matter of the patent (application). The TBA further doubts whether the European legislator, when drafting Art. 6(2)(c) of the Biotech directive 98/44/EC, from which Rule 23d(c) EPC stems, had any specific claim category in mind, but was seeking to define the essence of the inventions which should not be patentable.



With regard to question 3, the referring TBA refers to previous case law of the Technical Boards of Appeal, where it was held that, even in cases where a specific provision dealt with a particular type of invention, even in those cases the general provision of Art. 53(a) EPC is still applicable. This is particularly clear in the “Harvard mouse” case T 0315/03, where besides a particular test laid down in Rule 23d(d) EPC, it is also necessary to apply the test of Art. 53(a) EPC, once it would be concluded that on the basis of the test laid down in Rule 23d(d) EPC, the invention would not be excluded from patentability.

With regard to question 4, the appellant has submitted that the relevant point in time for determining whether or not the claimed products could be obtained without having to recur to the destruction of human embryos was the date on which the decision on the patentability of the subject-matter was taken. The referring TBA understands this as to mean that for the determination whether the claimed subject-matter concerns an invention falling under Rule 23d(c) EPC or the exploitation of which would be contrary to “ordre public” or morality within the meaning of Article 53(a) EPC the factual and legal situation subsisting when the decision is given is the relevant one. The referring TBA points in this context to case T 0315/03, where the there competent TBA held the contrary view, i.e., that assessment is made as of the filing or priority date; evidence arising after that date may be taken into account provided it is directed to the position at that date.

The case is pending as **G 2/06**.

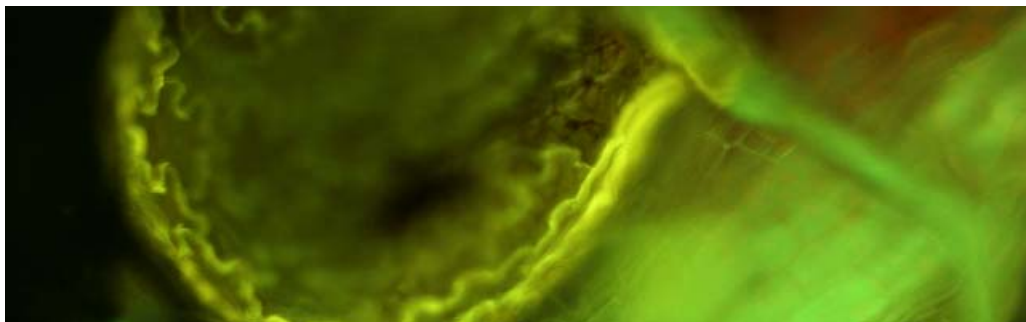
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Referrals to EBA relating to divisional applications (G 1/05, G 1/06, G 3/06)

The EBA of the EPO has, besides the sensitive questions relating to embryonic stem cells, also various difficult and important questions to answer regarding divisional applications. The outcome of these referrals might have a major impact on patent filing strategies.

As the TBA said in case T 1409/05, the primary legislative purpose of divisional applications is to provide a possibility of obtaining protection for inventions which are non-unitary. The same should hold for sequential divisional applications. Also in other circumstances, even when the patent application contains a unitary group of inventions, applicants may be interested in filing divisional applications, and thus having specific parts or part of the invention separated from the rest of the invention, which can be for strategic, economic or scientific reasons.

It goes without saying that decisions which influence the behaviour of applicants to file divisional patent applications are of major importance. The patent community is then also eagerly awaiting the decisions in the referrals.

In case **T 0039/03**, the facts of the case were the following: European patent application No. 99 100 131.4 (publication No. EP 0 911 885) was filed as a divisional application to the earlier European application No. 93 116 174.9 (publication No. EP 0 591 949) of which mention of the grant was published on 28 July 1999. The applicant and appellant has appealed against the decision of the examining division refusing the divisional application on the ground that none of the requests before it met the requirements of the EPC. The examining division *inter alia* reasoned that the divisional application did not comply with Article 76(1) EPC because the feature of "the grains having an average width in the range of 0.002 to 1 cm" as set out in several independent claims was not disclosed in the earlier application. With its statement setting out the grounds for appeal dated 12 December 2002 the appellant filed replacement claims 1 to 9 and presented arguments in support of novelty and an inventive step of the claimed subject matter.

The TBA has referred to the following questions to the EBA:

- (1) *Can a divisional application which does not meet the requirements of Article 76(1) EPC because, at its actual filing date, it extends beyond the content of the earlier application, be amended later in order to make it a valid divisional application?*
- (2) *If the answer to question (1) is yes, is this still possible when the earlier application is no longer pending?*
- (3) *If the answer to question (2) is yes, are there any further limitations of substance to this possibility beyond those imposed by Articles 76(1) and 123(2) EPC? Can the corrected divisional application in particular be directed to aspects of the earlier application not encompassed by those to which the divisional as filed had been directed?*

This case is pending as **G 1/05**.

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In case **T 1409/05**, the following factual constellation was at issue. The present application (A3) is the third in a sequence A1, A2, A3 of divisional applications, each divided from its predecessor, and stemming from a root (originating) application A0. The root and the first divisional A1 have been granted. The second divisional A2 was refused for non-compliance with Article 76(1) EPC as were its sibs B2 and C2.

Claim I of A3 as filed has the same wording as claim I of A2 as filed. A2, itself a divisional, was refused for non-compliance with Article 76(1) EPC. According to the Examining Division, application A3 did not comply with Article 76(1) EPC, and was refused, thereby applying the reasoning that non-compliance with Article 76(1) EPC of a divisional as filed necessarily entailed non-compliance of a divisional of that divisional.

The TBA stated that the subject-matters of claim I of both the present application A3 and its predecessor A2 (as filed) indisputably extend beyond the scope of claim I of A1.

The TBA has referred the following questions to the EBA:

(1) In the case of a sequence of applications consisting of a root (originating) application followed by divisional applications, each divided from its predecessor, is it a necessary and sufficient condition for a divisional application of that sequence to comply with Article 76(1) EPC, second sentence, that anything disclosed in that divisional application be directly, unambiguously and separately derivable from what is disclosed in each of the preceding applications as filed?

(2) If the above condition is not sufficient, does said sentence impose the additional requirement

(a) that the subject-matter of the claims of said divisional be nested within the subject-matter of the claims of its divisional predecessors? or

(b) that all the divisional predecessors of said divisional comply with Article 76(1) EPC?

This case is pending as **G 1/06**.

In case **T 1040/04**, the following facts were underlying the referral decision:

The disputed patent was granted on the basis of European divisional patent application No. 00 201 515.4 filed in accordance with Article 76 EPC on the basis of earlier European patent application No. 97 928 169.8 filed on 7 June 1997 and published as WO-A-97/47834.

During the opposition procedure, paragraph [0016] of the description of the patent as granted was deleted. This paragraph was part of the divisional application, as filed, (see paragraph [0017] of the published application) but was not present in the earlier application WO-A-97/47834.

The Board considered that there was at least one feature present in said paragraph, which defined subject-matter extending beyond the content of the earlier application.

The Board therefore concluded that the requirements of Article 76(1) EPC were neither met by the divisional application at its filing date, nor by the patent as granted.

The TBA has referred the following question to the EBA:

Can a patent which has been granted on a divisional application which did not meet the requirements of Article 76(1) EPC because at its actual date of filing it extended beyond the content of the earlier application, be amended during opposition proceedings in order to overcome the ground of opposition under Article 100(c) EPC and thereby fulfill said requirements?

This case is pending as **G 3/06**.

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ECJ overrules Advocate General in SPC case (C-431/04)

In an interesting case relating to Supplementary Protection Certificates (SPC's), the European Court of Justice (ECJ) has ruled differently than Advocate General L  ger in his Opinion.

Case C 431/04 dealt with the following facts. The MIT is the holder of a European patent, for which it filed an application on 29 July 1987. That patent covers, inter alia, the alliance of two elements, polifeprosan, a polymeric, biodegradable excipient, and carmustine, an active ingredient already used in intravenous chemotherapy with inert excipients and drug additives for the treatment of brain tumours. Gliadel comes in the form of a device which is implanted into the cranium for the treatment of recurrent brain tumours. The mechanism of its action consists in the carmustine, a highly cytotoxic active ingredient, being released slowly and gradually by the polifeprosan, which acts as a bioerodible matrix. The preparation Gliadel is protected by European Patent 0 260 415.

A marketing authorisation for Gliadel was granted in Germany by a decision of 3 August 1999. Relying on that authorisation, the MIT asked the Deutsches Patent- und Markenamt to grant it an SPC for Gliadel. It requested in its main application that an SPC be granted for carmustine in combination with polifeprosan. Its alternative application sought an SPC for carmustine only.



The Deutsches Patent- und Markenamt rejected that application for an SPC by a decision of 16 October 2001, on the ground that polifeprosan could not be considered to be an active ingredient within the meaning of Article 1(b) and Article 3 of Regulation No 1768/92. It also held that no SPC could be granted for carmustine on its own on account of the fact that that active ingredient was already covered by a marketing authorisation, and had been for a long time. The MIT lodged a complaint against the decision of the Deutsches Patent- und Markenamt before the Bundespatentgericht. That court rejected the complaint by a decision of 25 November 2002. The MIT then lodged an appeal on a point of law before the Bundesgerichtshof (Federal Court of Justice) against the decision of the Bundespatentgericht.

In support of its appeal, it claims that polifeprosan is an essential component of Gliadel since it enables carmustine to be administered in a therapeutically relevant way for the treatment of malignant brain tumours, thereby contributing to the efficacy of the medicinal product. It is consequently not a mere excipient or an ancillary component. The Bundesgerichtshof decided to stay the proceedings and to refer the following questions to the Court for a preliminary ruling:

‘1. Does the concept of “combination of active ingredients of a medicinal product” within the meaning of Article 1(b) of Regulation [No 1768/92] mean that the components of the combination must all be active ingredients with a therapeutic effect?’

2. Is there a “combination of active ingredients of a medicinal product” also where a combination of substances comprises two components of which one component is a known substance with a therapeutic effect for a specific indication and the other component renders possible a pharmaceutical form of the medicinal product that brings about a changed efficacy of the medicinal product for this indication (in vivo implantation with controlled release of the active ingredient to avoid toxic effects)?’

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The questions asked in fact relate to the fundamental question whether Article 1(b) of Regulation No 1768/92 must be interpreted so as to include in the concept of 'combination of active ingredients of a medicinal product', inter alia, a combination of two substances, only one of which has therapeutic effects of its own for a specific indication, the other rendering possible a pharmaceutical form of the medicinal product which is necessary for the therapeutic efficacy of the first substance for that indication.

As set out in Article 1(b) of Regulation No 1768/92, 'product' means the active ingredient or combination of active ingredients of a medicinal product. However, Regulation No 1768/92 does not define the concept of 'active ingredient'. Hitherto it has been assumed that an active ingredient has to be understood as (a) pharmacologically active compound(s), which means that SPC's would only cover novel and first-to-the market drugs. According to the ECJ, the expression 'active ingredient' is generally accepted in pharmacology not to include substances forming part of a medicinal product which do not have an effect of their own on the human or animal body.

The ECJ then brings into mind the basic principle underlying SPC's, i.e., that attention must be drawn to the fact that in point 11 of the Explanatory Memorandum to the Proposal for a Council Regulation (EEC), of 11 April 1990, concerning the creation of a supplementary protection certificate for medicinal products, it is specified that "[t]he proposal for a Regulation therefore concerns only new medicinal products. It does not involve granting an [SPC] for all medicinal products that are authorised to be placed on the market. Only one [SPC] may be granted for any one product, a product being understood to mean an active substance in the strict sense. Minor changes to the medicinal product such as a new dose, the use of a different salt or ester or a different pharmaceutical form will not lead to the issue of a new [SPC]." In the view of the ECJ, it is apparent from that memorandum that the pharmaceutical form of the medicinal product, to which an excipient may contribute, does not form part of the definition of 'product', which is understood to mean an 'active substance' or 'active ingredient' in the strict sense.



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The court further refers to Regulation (EC) No 1610/96 concerning the creation of a supplementary protection certificate for plant protection products, which is deemed relevant by the ECJ in interpreting Regulation No 1768/92 concerning the creation of a supplementary protection certificate for medicinal products, where it is stated in point 68 of the Explanatory Memorandum that:

- it would not be acceptable, in view of the balance required between the interests concerned, for the total duration of protection granted by the SPC and the patent for one and the same product to be exceeded;
- that might be the case if one and the same product were able to be the subject of several successive SPC's;
- that calls for a strict definition of the product;
- if an SPC has already been granted for the active substance itself, a new SPC may not be granted for that substance, whatever changes may have been made regarding other features of the plant protection product (use of a different salt, different excipients, different presentation, etc.);

The ECJ concludes then that the inevitable conclusion is that a substance which does not have any therapeutic effect of its own and which is used to obtain a certain pharmaceutical form of the medicinal product is not covered by the concept of 'active ingredient', which in turn is used to define the term 'product'. Therefore, the alliance of such a substance with a substance which does have therapeutic effects of its own cannot give rise to a 'combination of active ingredients' within the meaning of Article 1(b) of Regulation No 1768/92.

Thus, a definition of 'combination of active ingredients of a medicinal product' which includes a combination of two substances, only one of which has therapeutic effects of its own for a specific indication, the other rendering possible a pharmaceutical form of the medicinal product which is necessary for the therapeutic efficacy of the first substance for that indication, might, on any view, create legal uncertainty in the application of Regulation No 1768/92.

The ECJ then finally concludes that the answer to the questions referred must be that Article 1(b) of Regulation No 1768/92 must be interpreted so as not to include in the concept of 'combination of active ingredients of a medicinal product' a combination of two substances, only one of which has therapeutic effects of its own for a specific indication, the other rendering possible a pharmaceutical form of the medicinal product which is necessary for the therapeutic efficacy of the first substance for that indication.

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New regulation on compulsory licensing of patents relating to manufacture of pharmaceutical products for export to countries with health problems (Reg. 816/2006)

Regulation 816/2006 was adopted on 17 May 2006. The Regulation is a further implementation of the so-called Doha agenda of the TRIPs council. The Regulation introduces a system of grant of compulsory licenses to generic manufacturers for the production of pharmaceutical products under patent or SPC protection with a view to be exported to eligible importing developing countries in need of such products in order to address public health problems. Any person can submit an application for the production of such pharmaceutical products, under the conditions laid down in the Regulation (Article 6) to the competent authority in the member state where patent or SPC protection have effect to obtain a compulsory license.

Eligible countries are the least-developed countries as in the United Nations list, or any country that has made a notification to the TRIPs Council of its intention to the system as an importer, or certain other countries listed in the OECD Assistance Committee's list of low-income countries. Applications should contain, besides the country of import, also the quantity of product required (Article 6). The patent or SPC right holder must be notified, and can give his comments (Article 7), with possibilities to appeal in conformity with national law. The Applicant must provide satisfactory evidence to the authority granting the license that he has made efforts to obtain authorisation from the patent or SPC holder and that these efforts have not been successful (Article 9). In cases of emergency, the applicant does not have to provide such evidence.

The license shall be non-assignable and non-exclusive. Furthermore, the license will be limited to the manufacture of such quantities which do not exceed what is necessary to meet the needs of the importing country or countries cited in the application (Article 10). The license will also be for a fixed duration only. The licensee is responsible for payment of adequate remuneration to the right holder. In case of emergency, the remuneration shall be fixed to a maximum 4 % of the total price of the total price to be paid by the importing country. In all other cases, the remuneration shall be determined taking into account the economic value of the use authorised under the license to the importing country/countries concerned, as well as humanitarian or non-commercial circumstances relating to the issue of the license (Article 10(9)).

Measures must be taken to avoid that the products are being re-imported, or that the product are being distributed in other countries than the ones mentioned in the application, including termination of the license. To that effect, the products must be clearly identified through specific labelling or marking, special packaging and/or colouring/shaping (Article 10(5)). Custom authorities can take action in order to prevent re-importation (Article 14).

This regulation has entered into force on 29 June 2006.

It is to be seen what the effect of this new Regulation will be. Preventing re-importation in the European Union will definitely not be easy, and one can doubt whether the packaging and colouring measures will be sufficient, in view of known and widespread repackaging practices to achieve re-importation.

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EPO case elevates threshold for passing inventive step requirement (T1329/04)

In case T 1329/04, the TBA has given a ruling which might have or not have consequences for the fulfilment of the inventive step requirement, and more in particular with regard to evidence supporting inventive step which has been filed after the filing date.

Claim I of the main request before the TBA reads:

"1. A polynucleotide encoding a polypeptide [-] selected from the group consisting of:
(a) a polynucleotide having the nucleic acid sequence of SEQ ID NO:3;
(b) a polynucleotide encoding a polypeptide having the amino acid sequence of SEQ ID NO:4;
(c) a polynucleotide which is an RNA sequence corresponding to the polynucleotide of (a) or (b);
[...]"

The patent application related to claimed polynucleotides, which according to said patent application would be encoding a protein which was classified as being a member of the TGF- β superfamily. In the words of the TBA, starting from the closest prior art, the problem to be solved can be defined as isolating a further member of the TGF- β superfamily. The solution provided is the polynucleotide of SEQ ID NO:3 encoding the polypeptide of SEQ ID NO:4, denoted GDF-9 (claim I(a) and (b)). In the view of the TBA, the question to be answered was to see whether it is plausible that the molecule as defined above constitutes a further member of the TGF- β superfamily. In the patent application, GDF-9 was described, and did not exhibit the most striking structural feature known in the state of the art which serves to establish whether or not a polypeptide belongs to the TGF- β family: namely the presence of the seven cysteine residues with their characteristic spacing; in fact, only six cysteine residues are present. Furthermore, GDF-9 had only 34% homology with known TGF- β family members, which is far below the 70 to 90% homology normally shown in a given subgroup. The TBA concluded in this respect that, in view of the arguments given above, GDF-9 cannot be clearly and unambiguously identified as a member of the TGF- β superfamily by only using a "structural approach".

The TBA further reasoned that the situation could most probably be looked at differently if it had been demonstrated in the application as filed that GDF-9 played a role similar to that of the transforming factor- β (as was the case for all of the factors which initially served to define the superfamily). Yet, **there is no evidence at all in this respect**. In fact, the application only discloses that expression of GDF-9 is localised in ovarian tissues, which *per se* is useful but insufficient information in relation to any function the molecule might have.

In the patent application it was admitted that "..., the sequence of GDF-9 is significantly diverged from those of other family members". According to the TBA, functions of members of the TGF- β superfamily previously isolated from ovarian follicular fluid (inhibins) or shown to inhibit ovarian cancer (MIS) are recited, and tentatively and presumptively attributed to GDF-9. Further putative roles are also suggested for GDF-9 which cover some of the effects observed with TGF- β . In the view of the TBA, in a first to file system, it is particularly important that "the application allows to conclude that the invention had been made, i.e. that a problem had indeed been solved, not merely put forward at the filing date of the application.[...]"

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In the board's judgment, enumerating any and all putative functions of a given compound is not the same as providing technical evidence as regard a specific one." The appellant filed post-published evidence, establishing that GDF-9 was indeed a growth differentiation factor. In the view of the TBA, this evidence could not be "regarded as supportive of an evidence which would have been given in the application as filed since there was not any. The said post-published documents are indeed the first disclosures going beyond speculation. For this reason, the post-published evidence may not be considered at all."

The TBA reasons that inventive step must be "must be ascertained as from the effective date of the patent. The definition of an invention as being a contribution to the art, i.e. as solving a technical problem and not merely putting forward one, requires that it is at least made plausible by the disclosure in the application that its teaching solves indeed the problem it purports to solve. Therefore, even if supplementary post-published evidence may in the proper circumstances also be taken into consideration, it may not serve as the sole basis to establish that the application solves indeed the problem it purports to solve."

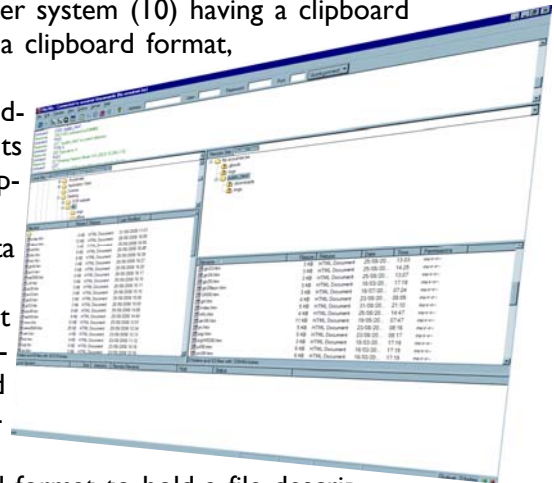
The exact consequences of this decision are yet difficult to predict. In the worst case, it brings an end to the long-standing practice that evidence of inventive step may be submitted after the filing date, which in turn might have major consequences for patent applicants, as it would force them to wait filing a patent application until firm and experimental evidence of inventive step has been gathered. In the best case, the scope of this decision is limited to the very specific facts and circumstances of this case.

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A method of operating a computer is not a computer program (T 424/03)

In case **T 424/03**, the following claimed invention was in issue:
Claim 1 reads: "A method in a computer system (10) having a clipboard for performing data transfer of data in a clipboard format,

said method comprising the steps of:
providing several clipboard formats including a text clipboard format, a file contents clipboard format and a file group descriptor clipboard format,
selecting data that is not a file for a data transfer operation,
using the file contents clipboard format to hold said data by converting said selected data into converted data of said file contents clipboard format and storing the converted data as a data object,
using the file group descriptor clipboard format to hold a file descriptor holding descriptive information about the data that is to be encapsulated into a file during the data transfer operation,
completing the data transfer by providing a handle to said data object,
using said handle to paste said data of said data object to a data sink,
using said descriptive information to enable the computer system to create a file at the data sink and
encapsulating the data object into said file."



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Claim 5 is directed to a computer-readable medium having computer executable instructions adapted to cause the computer system to perform the method of one of claims 1 to 4.

The TBA agreed with the position taken by the TBA in case T 0258/03 that a method involving technical means is an invention within the meaning of Article 52 (1) EPC (interesting detail is that the then competent TBA distinguished its position from decision T931/95-Controlling pension benefits System/PBS PARTNER-SHIP).

According to the TBA in T 424/03, claim 1 relates to a method implemented in a computer system. A computer system including a memory (clipboard) is a technical means, and consequently the claimed method has technical character. The TBA goes even further, and holds that "the claim category of a computer-implemented method is distinguished from that of a computer program. Even though a method, in particular a method of operating a computer, may be put into practice with the help of a computer program, a claim relating to such a method does not claim a computer program in the category of a computer program. Hence, present claim 1 cannot relate to a computer program as such."

The Board also considers the claimed method steps to contribute to the technical character of the invention. These steps solve a technical problem by technical means in that functional data structures (clipboard formats) are used independently of any cognitive content (see T 1194/97 - *Data structure product/Philips*) in order to enhance the internal operation of a computer system with a view to facilitating the exchange of data among various application programs. The claimed steps thus provide a general purpose computer with a further functionality: the computer assists the user in transferring non-file data into files.

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EPO Boards of Appeal continue to struggle with inventive step and technical character concepts for computer implemented inventions (T 1025/04, T 0049/04)

In case **T 0125/04**, the invention related to the comparative visual assessment of products ("subjects", in the wording of claim 1), such as automobiles. In order to assist a customer to evaluate a product, relevant product aspects ("components"), such as maintenance expenses or quality of engineering, are represented as a string of vectors. The horizontal length of a vector is proportional to the score attributed to the component, and the angle the vector forms with the horizontal indicates the importance of the component for the decision. The preferred embodiment is in the form of an add-in to a spreadsheet program. In evaluating inventive step, the TBA held that the steps enumerated in claim 1 relate to activities falling under the concept of information modelling as such and thus cannot contribute to the technical character of an invention within the meaning of Article 52(1) EPC. The Board also held that the task of designing diagrams is non-technical. This is so even if the diagrams arguably convey information in way which a viewer may intuitively regard as particularly appealing, lucid or logical. The TBA further reasoned that insofar as a specific manner of representation is concerned in the present case, this manner has been conceived exclusively with regard to a human being's mental capabilities and with a view to aiding a user to visually analyse data and make decisions on the basis of this analysis. It does not relate to any technical format or structure of the information processed, nor is it linked to the internal functioning of the system.

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The TBA also compared the present case with case **T 643/00**, in which case the invention concerned an apparatus for searching an image to be output. The invention was based on the idea of making the searching process easier to a user, who had conventionally to go through the images one by one on the display at a high resolution in order to select a particular image for output. This goal was achieved by arranging a plurality of images in a side-by-side manner at a low resolution and providing for hierarchical display at higher resolutions so that a comprehensive survey as well as a fast check for details were possible. The board decided that this arrangement of images on a screen contributed to a technical solution to the problem of searching and retrieving images efficiently.

The TBA sees an important difference between the two cases, as it holds that even though the invention in case T 0125/04 also concerns an arrangement of images, it is different in that only the information conveyed by the images, i.e., their "cognitive content", is relevant. The new features have to do with how this content is represented. Unlike the cited case the invention provides no information about the computer system itself, such as the location where the data are stored.

The Board concludes that the steps performed by the features in claim 1 do not have any technical effects which go beyond those obtained by the normal use of a computer. It follows that the subject-matter of present claim 1 lacks an inventive step (Article 56 EPC).

Interestingly, the TBA in case **T 0049/04** expressly disagrees with the viewpoint taken by the TBA in case T 0125/04, not surprisingly decided by a different TBA. In T 0049/04, the invention related to a method and an apparatus for enhancing the presentation of a text in a natural language on a (computer) display. The problem addressed by the application is that most people, when given the choice, prefer to read a text in print rather than on a conventional computer screen. The main reason for this is that text presentation on a computer screen is unsatisfactory compared to what is possible on a print medium because of the screen's lower resolution and contrast. Starting from a conventional computer system, the technical problem addressed by the present invention thus may be seen in providing a technical tool for enhancing natural language text presentation on a computer display. The device according to independent claim 12 solves the problem by displaying the text in shorter text segments on separate lines according to predefined rules: primary and secondary folding rules determine the division of the text into text segments and horizontal displacement rules determine the amount of horizontal displacement (indent) for each text segment. Since the folding rules, as well as the horizontal displacement rules, have parts of speech attributes as inputs, the segmenting of the text, in contrast to the line breaks made by a conventional word-processor, is determined at least in part by the syntactic structure of the text. The claimed device thus aims at enabling the user to read a natural language text faster.

As the act of reading can be seen as a mental act, the invention has inherently non-technical features. Following T 641/00, the TBA then reasons that, when an invention consists of a mixture of technical and non technical features, the non-technical features cannot support the presence of inventive step. For the assessment of inventive step of the present claims, it is therefore necessary to investigate whether the claimed subject matter contains any "non technical features".

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The TBA followed the line of reasoning applied in case T 643/00, where it was held that "an arrangement of menu items (or images) on a screen may be determined by technical considerations. Such considerations may aim at enabling the user to manage a technical task, e.g. searching and retrieving images stored in an image processing apparatus, in a more efficient or faster manner, even if an evaluation by the user on a mental level is involved. Although such evaluation *per se* does not fall within the meaning of "invention" pursuant to Article 52 EPC, the mere fact that mental activities are involved does not necessarily qualify subject matter as non-technical since any technical solutions in the end aim at providing tools which serve, assist or replace human activities of different kinds, including mental ones".

Applying the above to the present case, the TBA concluded that the means for analysing the text and dividing it into text segments relates to the physical arrangement of the overall image structure of the displayed text with a view to solving a technical problem, namely to improve the text presentation, i.e., readability, on a display. Therefore, the claimed features, viewed as a whole, do not relate to a non-invention listed in Article 52(2) EPC as such.

The TBA brought into mind the different approach of case T 0125/04, where it was held that in general, the task of designing diagrams was non-technical, even if the diagrams arguably conveyed information in a way which a viewer may intuitively regard as particularly appealing, lucid or logical.

In the view of the TBA in case T 0049/04, the differences in approach between the two cases (i.e., T 643/00 and T 0125/04) appear to stem from the different assessment of the features relating to the arrangement of images and diagrams, respectively.

In T 643/00 the functions and steps of processing the images in a specific format and allowing selection and display of an image at higher resolutions were considered to provide information to the user in the form of a technical tool for an intellectual task he had to perform, and therefore contributed to the technical solution of the technical problem of an efficient search, retrieval and evaluation of images.

In T 125/04 on the other hand the features corresponding to the representation of the respective relevant product features as a string of vectors were considered to be non-technical on the grounds that only the **information** conveyed by the images was relevant. These features had to do with **how** this content was represented. Thus, unlike the situation in T 643/00, no information was provided about the computer system itself, such as the location where the data were stored.

The TBA in T 0049/004 expressly disagreed with the conclusions drawn in T 125/04. Firstly, the TBA concurred with the view expressed in T 643/00 that technical aspects cannot be ruled out in the design and use of a graphic interface. Furthermore, the TBA found that a feature which relates to the manner **how** the "cognitive content", such as images, is conveyed to the user can very well be considered as contributing to a technical solution to a technical problem. This would in particular be the case when, as the situation was in T 643/00, this particular manner of conveying the information enables the user to perform their task more efficiently. The TBA then concludes that it is also unable to subscribe to the *ratio* of T 125/04 which posits that the task of designing diagrams is basically non-technical even when the diagrams convey information in a way which a viewer may regard as particularly lucid and logical.



The Technical Boards of appeal continue to fight their internal struggle regarding the concept of technical character in the determination of inventive step. While the Boards have already achieved agreement on the definition of whether an invention is technical in the sense of Art. 52(1) EPC, the determination of a technical contribution in the evaluation of inventive step continues to be debated. For applicants, no legal certainty can be promised for the moment.

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Two important rulings of ECJ affect international litigation strategies

Even though the European patent system provides for a centralised granting system for European patents, once these patents have been granted, enforcement is a matter of national law and national courts.

It is known that certain courts have recognized international jurisdiction, i.e., that they are competent to rule in infringement proceedings also on cross-border issues, such as for instance measures to prevent further infringement in other countries than the country where the court decides on the matter. This has caused litigants to seek these courts, such as the Dutch Courts, to obtain cross-border measures, with a view to speed up patent litigation, and to avoid extra expenses and costs to be made for starting various national infringement proceedings.

Two recent decisions by the ECJ have seriously limited the possibility to further use such strategies. While EC Commissioner Charlie McCreevy and the EPO are promoting the importance of a centralised litigation system, the ECJ decisions seem to point to another direction, i.e., obligating litigating parties to pursue their luck in every relevant national court.

GAT/LuK (C-04/03) related to the interpretation of Art. 16(4) EEX Treaty (Convention of 27 September 1968 on Jurisdiction and the Enforcement of Judgments in Civil and Commercial Matters), which gives, in cases concerned with the registration or validity of patents, trade marks, designs, or other similar rights required to be deposited or registered, exclusive jurisdiction to courts of the Contracting State in which the deposit or registration has been applied for, has taken place or is under the terms of an international convention deemed to have taken place.

GAT and LuK, companies established in Germany, are economic operators competing in the field of motor vehicle technology. GAT made an offer to a motor vehicle manufacturer, also established in Germany, with a view to winning a contract to supply mechanical damper springs. LuK alleged that the spring which was the subject of GAT's proposal infringed two French patents of which LuK was the proprietor. GAT brought a declaratory action before the Landgericht Düsseldorf (Regional Court Düsseldorf) to establish that it was not in breach of the patents, maintaining that its products did not infringe the rights under the French patents owned by LuK and further, that those patents were either void or invalid. The case came eventually at the Oberlandesgericht, who asked a preliminary question to the ECJ: 'Should Article 16(4) of the Convention [...] be interpreted as meaning that the exclusive jurisdiction conferred by that provision on the courts of the Contracting State in which the deposit or registration of a patent has been applied for, has taken place or is deemed to have taken place under the terms of an international convention **only** applies if proceedings (with *erga omnes* effect)

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are brought to declare the patent invalid **or** are proceedings concerned with the validity of patents within the meaning of the aforementioned provision where the defendant in a patent infringement action or the claimant in a declaratory action to establish that a patent is not infringed pleads that the patent is invalid or void and that there is also no patent infringement for that reason, irrespective of whether the court seized of the proceedings considers the plea in objection to be substantiated or unsubstantiated and of when the plea in objection is raised in the course of proceedings?’

By that question, the referring court seeks in essence to ascertain the scope of the exclusive jurisdiction provided for in Article 16(4) of the Convention in relation to patents. It asks whether that rule concerns all proceedings concerned with the registration or validity of a patent, irrespective of whether the question is raised by way of an action or a plea in objection, or whether its application is limited solely to those cases in which the question of a patent’s registration or validity is raised by way of an action. If the first hypothesis would be accepted, this would imply that any cross-border infringement action, in which the validity of also the foreign (or foreign part of a European) patent is invoked in one way or the other, the court would have to conclude that it has no international jurisdiction to decide on anything else than the national patent (or national part of a European patent) of the country before which court the case is brought.

According to the ECJ, it cannot be established from the wording of Article 16(4) of the Convention whether the rule of jurisdiction set out therein applies only to cases in which the question of a patent’s validity is raised by way of an action or whether it extends to cases in which the question is raised as a plea in objection. In the opinion of the Court, the view must be taken that the exclusive jurisdiction provided for by that provision should apply whatever the form of proceedings in which the issue of a patent’s validity is raised, be it by way of an action or a plea in objection, at the time the case is brought or at a later stage in the proceedings.

The conclusion of the ECJ is then also that Article 16(4) of the EEX Treaty, is to be interpreted as meaning that the rule of exclusive jurisdiction laid down therein concerns all proceedings relating to the registration or validity of a patent, irrespective of whether the issue is raised by way of an action or a plea in objection.

This decision implies that, in the context of cross-border infringement proceedings, as soon as the validity in another member state of the patent is invoked, even in case of a plea in objection, the court seized is no longer competent to give a cross-border ruling for that other member state. Ruling on anything more than the national patent (or the national part of a European patent), and on any cross-border measure relating to infringement is not allowed. The court seized is in a cross-border infringement action, where validity of the patent is invoked, only competent to rule on the national patent (or national part of a European patent). A cross-border measure relating to infringement would imply that the foreign patent (or foreign part of a European patent) is valid, and as the court seized is no longer competent to rule on this issue, this means practically the end of cross-border measures. Cross-border measures are only conceivable if the proceedings are stayed, awaiting a decision on the validity of the foreign patent (or foreign part of a European patent) before the court of the country where such patent is registered. In effect, as in most cases validity is an issue in patent cases, and in view of the above, this will virtually mean the end of international jurisdiction for cross-border infringement.

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Roche B.V Nederland and others/Primus, Goldenberg (C-539/03)

related to the interpretation of Art. 6(1) EEX Treaty, according to which a person domiciled in a Contracting State may also be sued, where he is one of a number of defendants, in the courts for the place where any one of them is domiciled. This article covers cases in which there are multiple defendants, which is not quite uncommon in patent cases.

Drs Primus and Goldenberg, who are domiciled in the United States of America, are the proprietors of European patent No 131 627. On 24 March 1997, they brought an action before the Rechtbank te s'-Gravenhage against Roche Nederland BV, a company established in the Netherlands, and eight other companies in the Roche group established in the United States of America, Belgium, Germany, France, the United Kingdom, Switzerland, Austria and Sweden ('Roche and Others'). The applicants claimed that those companies had all infringed the rights conferred on them by the patent of which they are the proprietors. That alleged infringement consisted in the placing on the market of immuno-assay kits in countries where the defendants are established. The companies in the Roche group not established in the Netherlands contested the jurisdiction of the Netherlands' courts. As regards the substance, they based their arguments on the absence of infringement and the invalidity of the patent in question. The Hoge Raad (Supreme Court), hearing an appeal on a point of law, decided to stay the proceedings and refer the following questions to the Court for a preliminary ruling:

(1) 'Is there a connection, as required for the application of Article 6(1) of the Brussels Convention, between a patent infringement action brought by a holder of a European patent against a defendant having its registered office in the State of the court in which the proceedings are brought, on the one hand, and against various defendants having their registered offices in Contracting States other than that of the State of the court in which the proceedings are brought, on the other hand, who, according to the patent holder, are infringing that patent in one or more other Contracting States?

(2) If the answer to Question 1 is not or not unreservedly in the affirmative, in what circumstances is such a connection deemed to exist, and is it relevant in this context whether, for example,

- the defendants form part of one and the same group of companies?
- the defendants are acting together on the basis of a common policy, and if so is the place from which that policy originates relevant?
- the alleged infringing acts of the various defendants are the same or virtually the same?

What the Netherlands Supreme Court in essence asked was essentially whether Article 6(1) of the Brussels Convention must be interpreted as meaning that it is also to apply to European patent infringement proceedings involving a number of companies established in various Contracting States in respect of acts committed in one or more of those States and, in particular, where those companies, which belong to the same group, have acted in an identical or similar manner in accordance with a common policy elaborated by one of them. This is the so-called "spider in the web theory". Dutch courts for instance have in the past assumed international jurisdiction in such cases.

The ECJ did not agree with the broad interpretation given by Dutch case law. The concept of "connection" is as such not found in Art. 6(1) EEX Treaty, but derives from the *Kalfelis* judgement (Case 189/87 *Kalfelis* [1988] ECR 5565, paragraph 12)

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according to which for Article 6(1) EEX Treaty to apply there must exist, between the various actions brought by the same plaintiff against different defendants, a connection of such a kind that it is expedient to determine the actions together in order to avoid the risk of irreconcilable judgments resulting from separate proceedings. Problem remains then what is to be understood by the term “irreconcilable”.

According to the ECJ, even if one would understand the term “irreconcilable” as meaning “contradictory”, there is in the present case no risk of such decisions being given in European patent infringement proceedings brought in different Contracting States involving a number of defendants domiciled in those States in respect of acts committed in their territory. In order that decisions may be regarded as contradictory, it is not sufficient that there be a divergence in the outcome of the dispute, but that divergence must also arise in the context of the same situation of law and fact. In the case of European patent infringement proceedings involving a number of companies established in various Contracting States in respect of acts committed in one or more of those States, according to the ECJ, the existence of the same situation of fact cannot be inferred, since the defendants are different and the infringements they are accused of, committed in different Contracting States, are not the same. One can seriously doubt whether the ECJ has a full understanding of the patent system and the way how it is applied, when it dares expressing such views.

Furthermore, the ECJ argues, although the Munich Convention lays down common rules on the grant of European patents, it is clear from Articles 2(2) and 64 (1) of that convention that such a patent continues to be governed by the national law of each of the Contracting States for which it has been granted.

In those circumstances, even if the broadest interpretation of ‘irreconcilable’ judgments, in the sense of contradictory, were accepted as the criterion for the existence of the connection required for the application of Article 6(1) of the Brussels Convention, it is clear that such a connection could not be established between actions for infringement of the same European patent where each action was brought against a company established in a different Contracting State in respect of acts which it had committed in that State. Further according to the ECJ, that finding is not called into question even in the situation where defendant companies, which belong to the same group, have acted in an identical or similar manner in accordance with a common policy elaborated by one of them, so that the factual situation would be the same.

The ECJ in this context further ruled that, although at first sight considerations of procedural economy may appear to militate in favour of consolidating such actions before one court, it is clear that the advantages for the sound administration of justice represented by such consolidation would be limited and would constitute a source of further risks.

In conclusion, Article 6(1) of the EEX Treaty must be interpreted as meaning that it does not apply in European patent infringement proceedings involving a number of companies established in various Contracting States in respect of acts committed in one or more of those States even where those companies, which belong to the same group, may have acted in an identical or similar manner in accordance with a common policy elaborated by one of them.

This decision means the end of the “spider in the web theory” as developed by the Dutch courts to assume international jurisdiction.

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