



The British Association of the International Federation
of Intellectual Property Attorneys

NEWSLETTER

December 2014

In this issue

- President's letter
 - Recent Business
 - Autumn Dinner – 15 October
 - FICPI at the IPO – 21 October
 - Meeting with new Minister – 30 October
 - FICPI Exco meeting – Nov 2014
 - FICPI Open Forum, Barcelona, Nov 2014
 - World Congress, Cape Town, Apr 2015
 - Future events
 - Diary
-

PRESIDENT'S LETTER

Dear FICPI Friends

It has been a busy few months since our last newsletter, and Christmas is almost upon us.

Having met our latest IP Minister, we are in good hands, at least until next May's election. The continued stability of senior roles at the IPO is also good for the IP system in the UK and the profession, as they continue to listen to our voice when needed.

However, change is necessary – many of you will know I will be stepping down as President of FICPI-UK at the next AGM, and I am pleased to report that Simon Rees has agreed to stand for election. I think FICPI-UK will be in very good hands.

Plans for both our annual meeting next year and the 2016 ABC meeting are underway, and we will report on these further in the New Year.

In the meantime, have a relaxing Christmas!

Robert Watson

RECENT BUSINESS

In August Robert circulated a message some of which is worth reminding you of

Circulation of Treasury survey on Patent Box

The IPO's request for information on the effect of the patent box system, from attorneys and clients, was passed on.

Appointment of a new Minister for IP

A letter had been received from our new Minister for IP, Baroness Neville-Rolfe (see report below).

Consultations

FICPI-UK filed a response to the recent consultation on minor changes to the Patent Rules 2007 as result of the IP Bill relating to:

- The extension of the Opinion Service
- Payment of renewal fees following restoration of EP (UK)s

The IPO have recently released the Government response. Only four responses to the consultation were received, and the two suggestions made in our response will be taken up. The amendments will come into force on 1 October 2014.

Both FICPI and FICPI-UK filed responses to the consultation on the draft proposal for a European Litigation Certificate (attached) – my thanks to Alan Senior for co-ordinating the UK response whilst I was away.

The consultation by the UKIPO on changes needed to implement the UPC closed on 2 September – I would be grateful to receive any comments. (In the event we did not submit anything on this complicated area).

AUTUMN DINNER

15 October 2014

H H Judge Richard Hacon of IPEC spoke at our Dinner Meeting on 15 October at Brasserie Blanc, Chancery Lane. Twenty or so members attended.

Having entertained us with the tale of a pigeon in one of the High Court rooms (the official pigeon catcher has to be called, extreme measures are eventually taken), the Judge went over the now familiar background to IPEC, stressing the importance of the Rule changes in 2010, which introduced the caps on costs and damages and allow vigorous case management from the bench, e.g. the banning of evidence, discovery and submissions the Judge thinks will be pointless.

Customers are satisfied, in that the work load has gone up while the High Court lists have not shrunk so a demand has been met.

He referred to the cheap and quick small claims track, which has altogether changed the culture of enforceable property in that part of the market, rewarding in a small but significant way those who previously had no hope of remedy, e.g. photographers.

The IPEC has been recognised overseas as a model, which is encouraging and enhances the UK reputation for access and resolution. Less satisfactory is the continued reluctance of patent attorneys to handle cases and appear. Judge Hacon strongly encourages us, as did Sir Colin Birss when in the same position on the P.C.C. He says that while cross examination is certainly a bit

specialised, there are plenty of other things we ought to be able to do and anyway it does not happen at all in many cases. So let us be encouraged.

Alan Senior

FICPI AT THE IPO **21 October 2014**

Liz Dawson represented FICPI at the last **PPWG MEETING** held on 21 October 2014 in Newport. The meeting began with an **update on the IPO's research programmes**, including the "eight great technologies" initiative and the work of the Economics, Research and Evidence team, more about which can be found on the IPO's website.

The IPO is undertaking a review of all **rights granting fees**. This is at the analysis stage and will involve looking at ways in which the IPO can use fees to shape customer behaviour. Ideas on patent aspects of this subject are to be sent to Debbie Cooke. The subject of the Unitary Patent obviously came up in this context but no light was shed on that.

The move of the IPO website to **GOV.UK** was discussed and initial feedback considered. Initial views were fairly positive or at least "not as bad as we expected" and ongoing feedback is welcome to Andrew Rees. Suggestions at the meeting included making the MoPP available in a different, e.g. html, format and the same for the current version of the Act and Rules. A MyIPO function is currently under test and about to go to beta phase for the electronic issuing of certain communications such as grant letters and preliminary examination reports.

On the subject of **future filing trends** backlogs continue to be a problem for the IPO as demand continues to increase. The IPO has recruited 49 new examiners which although welcome will have an initial negative impact until they become productive. Users were asked whether they thought the Patent Box was having any effect on demand but most had noticed no difference in filing patterns since it was introduced.

Following concerns raised by the IP Federation, the IPO has investigated how much paper mail has been **lost in the post** to its knowledge and the IPO's procedure for recording loss of post was discussed.

As usual we were filled in on **EPO matters**, by Sean Dennehey. Some minor amendments to the Implementing Regulations are to take place relating to delivery of items to the EPO and use of the ten day period in connection with electronic notification by the EPO. In his capacity as chair of the Committee on Patent Law, Sean continues to take an interest in EPO performance and particular matters discussed included timing of ISRs on PCT applications, amendments of specifications by examiners and operation of EPO deposit accounts.

Harmonisation discussions continue amongst the B+ countries with the last meeting having taken place in September. Two strands of work are presently being discussed, grace period and privilege. There is a particular appetite to reach a consistent position on the latter and progress is being made.

On 30th October, Liz Dawson and Simon Rees attended an **INFORMAL ROUNDTABLE DISCUSSION WITH THE IP ATTACHÉS**. Tom Duke (China), Sheila Alves (Brazil) and Christabel Koh (South East Asia) gave a short overview of their work, challenges and achievements. Grega Kumer, Senior IP Advisor based in the UK Mission Geneva also talked about his work at WIPO. The main take home message was that if we have clients with IP issues in China, Brazil on South East Asia there is a lot that the IPO's people on the ground can do.

Liz Dawson

REPORT ON ROUNDTABLE WITH MINISTER FOR IP

30 October 2014, BIS, 1pm to 2-30pm

Present:

Baroness Neville-Rolfe, Minister for IP
John Alty, CEO, UKIPO
Sean Dennehy, Deputy CEO, UKIPO
Harriet Smith, BIS

Gill Smith, Dyson	Carole Arnold, IP Federation
Clive Davenport, FSB	Isabel Davies, Law Society IP Group
Chris McLeod, ITMA	Mandy Haberman
Bobby Mukherjee, BAE	Jeremy Blum, Bristows/BBG
Robert Watson, FICPI-UK	

The Minister introduced the meeting by reminding us of the importance of IP intensive interests to the UK, being responsible for 1/4 employment and 37% of GDP.

She had asked for this meeting in order to learn more about the issues we faced and to find out what the government and IPO could do to improve matters.

A wide range of issues were raised, which I have attempted to summarise below.

- Importance of education, both in for providing the UK with scientists, engineers and designers, and also in raising awareness of IP. This was discussed extensively, and the new IPO competition Studentship was mentioned. [look into and consider publicising]
- Importance of quality IP rights, along with certainty and increased harmonisation. The UP was discussed in this regard and the continuing challenge of not knowing the costs associated with the system, especially for those managing large portfolios. Also the uncertainty over EU Trade Secret provisions and copyright came up.
- Importance of the private IP profession as an UK industry. This came up in the context of the UPC, and appropriate regulation. Groundless threat provisions were mentioned as being a barrier to UK litigation. Remaining part of the EU was also raised as being important to the IP framework in the UK, and the private IP profession.
- Funding for small businesses to encourage investment in IP.
- Importance of protecting brands - the issue of parasitic copying is currently under review.

Overall, it was a very positive meeting, and the new Minister is clearly very keen to make an impression before the elections next May.

Robert Watson

REPORT ON FICPI EXCO MEETING, BARCELONA

2-5 November 2014

This successful EXCO was attended by over 100 delegates, an unusually large number, about one third of whom had guests with them. I was there as FICPI UK delegate with Robert Watson (UK President and Chair of CET Group 2) as sub-delegate.

It was held at the Hotel Rey Juan Carlos I, a pleasant hotel and very good for the purpose. Next door was the enormous multi-roomed conference centre where the subsequent Forum was held. The only drawback was the distance from the City's attractions.

The previous EXCO was as recent as April, and so there was perhaps less business than usual to attend to. However, we followed the usual procedure which starts with reports from the main officers; President (Bastiaan Koster), Secretary General (Julian Crump), Treasurer (Marc Chauchard) and the President of CET (Eric Le Forestier).

Bastiaan mentioned recent visits to the EPO, USPTO, WIPO, AIPPI and ABA. FICPI also co-hosted a symposium on grace period in Tokyo reported at EXCO/ES14/CET1308. Visits to the IN, CN, KR and JP patent offices are coming up.

CET visits were also made to OAMI, PCT working groups, CJEU, and various Commission DGs. FICPI was due to be represented at the consultation on UPC Rules Procedure on 25 November.

Reports of the work done before and at the EXCO can be seen on the FICPI.org website, library section; Barcelona; papers; open documents. Most notable are:

EXCO/ES14/1102 – concerning the Black and White Trade Mark issue with OHIM. This is an excellent report and submission by Andrew Parkes on a strange and ominous development in OHIM.

EXCO/ES14/CET 1303 and 1304 – interventions in the Supreme Court of Canada where utility issues are a cause of great concern (“the promise of the patent” problem); unfortunately, in a way, Apotex settled the case while our meeting was in progress so the work can not be used just now.

EXCO/ES14/CET 1401 and 1402 on the Unitary Patent translation costs compensation scheme and UPC litigation certificate;

1403 and 1404 are Amicus briefs filed on two Enlarged Board cases, G1 and 2/14; G3/14.

Paper 1502 concerns submissions to the Indian PTO on pharma applications, Swiss-type claims, filing of new evidence, patentability of mixtures and cosmetic treatments that Sharad Vadehra co-authored.

I also mention 1603, concerning a presentation made by FICPI (Leo Jessen) to the B+ meeting on client attorney privilege in September.

There are other papers, e.g. on the ICANN Submission, prior user rights, national entry of PCT cases at WIPO, Utility Models which also represent excellent work and which were approved and ratified, and 1501 which concerns submissions made on the US PTO guideline amendments following Mayo and Myriad.

Financially, FICPI operations break even or better at the moment and we have reasonable reserves. Nevertheless, the pressure on costs and expenses is unrelenting, and are partly why in the next three year term, beginning next April, there will only be annual EXCOs. There are, too, grumbles about the membership fees from several quarters which raise long term issues. Unfortunately, Alastair Neill has stood down as President of the Financial Advisory Board, after many years service. This oversees and advises on the Federation's financial matters, but the Bureau is addressing the issues the Board has drawn attention to in recent years under his leadership.

On the positive side, the Federation is growing in terms of countries represented, groups in Russia, Poland, Romania and Turkey being particularly mentioned as successful.

There were two sessions of three parallel workshops. I attended these on CIIs and unity of invention which were interesting and the other four went well too. Position papers or resolutions may result.

One of the best supported concerned “Communication between Firms”. Many people showed interest in the idea of standardising communication formats and data sharing between attorney firms, and the workshop on Retainer letters was, likewise, successful. These spring from the “Professional Excellence Commission” which Danny Huntington leads and which is making a significant contribution. Workshop reports are in the open part of the EXCO papers.

Three resolutions were passed: the first “Protection of trade secrets in the EU” urges authorities to continue work towards harmonisation of the law of trade secrets. Dis-harmony is as damaging to commercial activity as anything on the IP front.

Secondly: “Trade marks in Black and White”, addresses the question mentioned above about the current discussions in OHIM on the principles of common practice in this area.

The third, “Double Patenting”, points out that objections on this ground can go too far and deprive applicants of protection that otherwise would be appropriate.

This is a good example of the work done in the CET. Its Group 3, dealing with International Patents, harmonisation and the like has been engaged on this topic for some time; and have gathered information from around the world on the different national practices. This is done via the national delegates, for instance I reported on the UK practice and for good measure that in the EPO.

In recent months delegates have been asked to contribute on the local position on Internet Sales, Privilege, and Goods in Transit issues. Things like this are very difficult to sort out but in time something fruitful may well emerge. Delegates also report, before each EXCO, on the activities of our national groups, within themselves and in their relations with IPOs.

As is often the case, the Resolutions do not go much towards the UK position which is usually pretty well developed and respected, as we know. But serious problems do arise elsewhere and one of these is the subject of a project which is creating a lot of interest at the moment, run by John Orange and concerning the value which the IP attorneys profession contributes to the IP system.

There are countries, Australia is an example, where the profession feels under threat from policy workers who have little idea, and no appreciation, of what we do. It is not really enough to say “we exist so we are useful”, and the aim is to create an academically researched and backed position paper which can be used to put forward our case when the position is challenged.

FICPI-UK Council is looking at the draft and planning to comment by the end of the year. Anyone else who wishes to consider it is more than welcome to get in touch. Input would be appreciated.

Alan Senior

REPORT ON FICPI FORUM, BARCELONA **5-8 November 2014**

This followed the EXCO and was attended by record numbers of delegates. It followed the normal format of a plenary session, on “Preparing for the Future” and then parallel patent, TM and General streams together with popular workshops. The presentations are available on the website in the “Presentations” section, 15th open forum.

Cilla Makovski has been good enough to give a positive first timer’s overview as follows:

"I enjoyed my first FICPI Open Forum. The reception for first time attendees was a good introduction, and a chance not only to meet other first timers, but also the FICPI officers, and to hear about the work of FIPI internationally. The same was true for the lunches where the 'first time attendees' tables gave me an opportunity to talk in more depth to one of the officers.

"The conference programme was excellent, so much so that several times I found it difficult to choose which stream to attend. A good time to step back from the day to day and think about the future – whether the global dossier which brings challenges and opportunities if we can file electronically at the big five Patent offices (US, EP, JP, KR and CN) - or the UPC. The session on the UPC was fascinating; looking at two case studies for possible litigation when we have the UPC. It highlighted to me that it will bring another layer of complexity and strategy for us and our clients when we are thinking about advice on where to sue for infringement or bring a revocation action. I was also impressed by everyone's friendliness – the atmosphere was most congenial, and the conference was small enough to be able to find people easily in coffee breaks and at lunch.

"The evenings too were most enjoyable – a concert in the amazing Palau de la Musica Catalana, a traditional Catalan dinner and the closing dinner at the Museu Maritim – all in congenial company."

In addition, many thanks to Reuben Jacob who kindly made a note of Session 6.1, "Reach Through Claims":

"On day two of the Forum, the second session in the Patents stream was given over to a consideration of the possible revival of reach through claims as a result of a recent German Federal Court decision. The case, and the background of EPO law against which it was decided, was ably and entertainingly described by Thorsten Bausch of Hoffmann Eitle, with the US perspective given by Karl Hermanns of Seed IP.

"The subject of reach through claims was last considered by FICPI at the Venice Forum in 2004, and on that occasion the opinion of the majority of those in attendance seemed to be that moves by patent offices such as the EPO to rule against them were welcome. Subsequently, a survey of some Asian patent offices by FICPI found that a majority were also against. Now, as a result of the decision of the German Federal Court in X ZB 8/12 - 11/9/2013, reach through claims seem to be making a come back, at least in Germany. Attendees were told that there is now no bar in principle to reach through claims in Germany as, in the characteristically robust language of the court's decisions, functionally describing a group of compounds is not precluded by the fact that such wording encompasses not only compounds already known in the art or disclosed in the specification, but also compounds that may be provided in the future; even if their provision requires inventive activity. Thus German law now appears to accord with the situation at the USPTO, where, according to Mr Hermanns, reach through claims never really went away. Although there are some limits on what claims can be achieved, based on the disclosure, it seems that reach through claims are achievable in the US, and now it seems, also in Germany."

Robert Watson has contributed the following items.

Report on UPC Session at Open Forum

The discussion of the UPC at the Forum was rather different to the typical approach, as it examined two hypothetical situations and how these might be handled under the existing UPC rules. The panel consisted of Richard Ebbink (NL), a European Patent Litigator, Daniel Alge (AT) (Patent Attorney & "Technical Judge" at the Commercial Court Vienna), Dr. Martin Chakraborty (DE) (Litigator), Dr. Klaus Grabinski (DE) (Judge Bundesgerichtshof & member of Draft committee for the RoP of the UPC), Kevin Mooney (GB) (Litigator & Chairman of Draft committee for the RoP of the UPC). Key questions were the selection of the appropriate court in which to have actions, the likelihood of injunctive relief, and bifurcation (or not). The session was well attended and gave a good idea of how the court system might run. It was refreshing not to have to discuss privilege or Patent Attorney representation rights.

Report on The future belongs to those who prepare for it today Session at Open Forum

This plenary session, chaired by FICPI Vice-President Coleen Morrison, opened the Forum and looked at the rapidly changing pace of the IP system, and the effects this has on the IP attorney profession. The first speaker (Gunther Hubert, German Patent Office) discussed the work of the Tergensee group on patent harmonisation, particular on grace periods, as well as describing the large increase in the proportion of online filing and the huge increase in their collection of documents. Alan Kasper (an ex-President of AIPLA) described the work of the Trilateral and IP5 offices, and provided some basic information on the Global Dossier. The final speaker, Yo Tagaki of WIPO, provided a great deal of detail on the WIPO CASE technical platform (an Examiner platform to enable Examiners to see the files of corresponding cases) and how this will integrate with the IP5's Global Dossier. He also explained the statistical approach taken by machine translation, as opposed to simply an electronic dictionary approach, which is why machine translations are rapidly improving.

General Comments

A number of FICPI-UK members were speakers at the Open Forum, with the UK providing 9 out of 71 speakers. There were also a solid number of UK attendees at the Forum, which this year attracted 370 delegates from a wide range of countries. Over 100 of the attendees were attending their first FICPI Forum, and the first time attendee/new member was very popular. The General Stream of the Working Program was cited by many as a reason for attending, with most of the sessions having over 100 delegates. The social events were of the usual excellent standard, including an insight into the local cultural tradition of Sardana, and a gala dinner at the impressive Maritime Museum.

FICPI WORLD CONGRESS, CAPE TOWN

13-17 April 2015

The brochure for this is available online and booking is open. In accordance with normal policy only FICPI members may attend.

The programme includes important contributions in plenary sessions from IP users and strategists, breakout sessions on pharma and software patents, trademarks and designs, discussions on the challenges for IP offices with Battistelli, Campinos and Francis Gurry, then opportunities to discuss litigation strategies, office and practice management and others.

Cape Town offers much for the visitor and we all expect a very successful Congress. FICPI UK Council hopes that many of the UK members will be able to make the trip.

FUTURE EVENTS

There will be a Forum in St Petersburg in October 2016 and one in Istanbul in Autumn of 2017. EXCO meetings will take place in Spring 2016 in Zurich and Spring 2017 in China.

Council of FICPI-UK:

Robert Watson - President
 James Fish - Treasurer
 Gareth Probert - Secretary
 Alastair Neill - Immediate Past President
 David Bannerman
 Julian Crump
 John Dean
 Terry Johnson
 Rowena Price
 Gareth Probert
 Simon Rees
 Alan Senior

Diary 2015:

13-17 Apr World Congress, Cape Town,
 South Africa

Diary 2016:

Spring EXCO, Zurich
 Oct Forum, St Petersburg

Diary 2017:

Spring EXCO, China
 Autumn Forum, Istanbul

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