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IP Law Update

Summer 2016

Welcome to the Summer 2016 edition of the Withers & Rogers IP Law Update. This e-newsletter provides a round-up of our articles covering some of the most recent IP case law, as well as important developments in the IP landscape in both the UK and Europe.

2016 has been a busy year so far, with a range of interesting decisions in all areas of IP. It has also witnessed many aspects of the Unitary Patent Court (UPC) being finalised.

A number of high profile trade mark decisions have been handed down including those involving big names such as Adidas and H&M; there have been helpful cases clarifying the UK courts' approach to patent claim construction, especially in the pharmaceutical sector; and guidance from the UK Supreme Court has been provided on how registered design rights are to be interpreted.

There have also been significant changes to the EU trade mark regime, including to the body responsible for overseeing registered community trade marks and designs and new decisions in the field of supplementary protection certificates.

We hope these articles will be of interest and provide a useful insight into many of the changes happening within the UK and European intellectual property scene. If you would like to know more about any of the issues covered, please do not hesitate to get in touch.

Finally, a word about 'Brexit'. There is a lot of noise and speculation at the moment on what the UK's EU membership referendum result will mean for IP in Europe. At present, the UK is still a member of the EU, so nothing has changed. Should an exit actually happen, there is a high degree of confidence that appropriate UK legislation will be passed to effect a seamless transition to national IP rights. In addition, we will continue to be able to act before the EPO, and we are confident that measures will be put in place for Withers & Rogers to continue representation before the EUIPO for trade mark and design matters. See the statement on our website **here**.

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Inside...

Patent Cases

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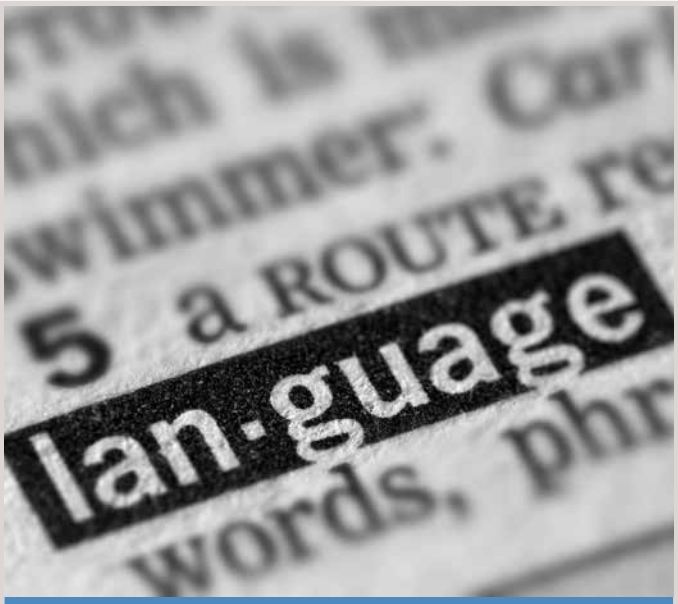

Court of Appeal rejects Rovi's claim construction

By Jon Hauser

Rovi Guides Inc. v Virgin Media Limited & Virgin Media Payments Limited & TiVo Inc.

Claim language remains all important in determining the scope of protection of a granted patent. As this recent decision between Rovi Guides Inc. and Virgin shows, although the disclosure of the patent as a whole should be considered in order to understand a claimed invention, it is the specific language that is used in the claims that sets out the scope of the protection.

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Clearing the way: the tests for obviousness and insufficiency clarified

By Katherine Banks

Actavis UK Limited & Ors v Eli Lilly & Company

A recent High Court decision explains the tests for obviousness and insufficiency resulting from a "clearing the way" action brought by Actavis against Eli Lilly. Mr Justice Carr found that the patent was not obvious as there was no fair prediction that the alleged invention would succeed. The judge found that this same fair prediction was not required when considering the issues of sufficiency.

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Medical use claims – the more the better after all?

By Kirsty Simpson

Board of Appeal (T1021/11)

It has been common drafting practice to include both pre-EPC 2000 Swiss-type claims and post-EPC 2000 purpose-limited second medical use claims in the same patent application. Once again, whether or not this is allowable has been considered by the EPO Boards of Appeal.

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Patent Cases

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Inventions made by university employees – entitled or not?

By Katherine Banks

University of Warwick v Dr Geoffrey Graham Diamond

A recent decision of the UKIPO on entitlement highlights the importance of robust record keeping and the need for clear contractual relationships between employees and employers. This is especially true in the academic sector where research staff, PhD students and various funding entities all play a role in the development of new IP.

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An update on the revamped UK IPO Opinion service

By Jon Hauser

The revamped UKIPO Opinion service has been up and running for around 30 months. We review some of the cases that have been heard and the effectiveness of the new system.

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The strength of a settlement

By Alexandra Orrin

Stretchline Intellectual Properties Ltd v H&M Hennes & Mauritz UK Ltd

Following a long running dispute involving Stretchline's patent for a tubular fabric composition, this recent High Court decision explores remedies that are available for alleged infringement following a settlement. This decision provides useful guidance on the finality of settlement agreements and the repercussions if breached.

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Trade Marks

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A "RAW" deal for H&M in trade mark infringement decision?

By Martha Murray

The Hague Court of Appeal provided an interesting decision on a trade mark dispute between clothing manufactures H&M and G-Star over the use of the term "RAW".

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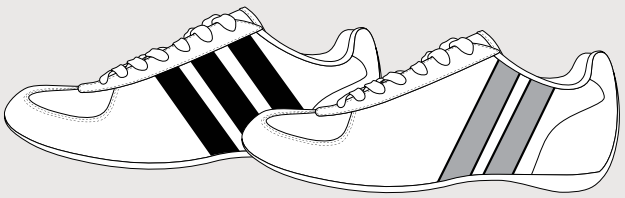

ECJ upholds General Court decision in favour of Adidas

By Martha Murray

Shoe Branding Europe BVBA v Adidas AG

A reversal in a trade mark decision between Adidas and Shoe Branding Europe by the CJEU offers some useful points of clarification for some very simple marks. If graphically indistinct marks manage to obtain an acquired distinctiveness to the public, the protection conferred by such marks can be broad indeed.

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EU trade mark law reform

By Fiona McBride

The European Council has published news of changes to the Community Trade Mark Regulation and a new Trade Mark Directive, most of which were effective from March 2016. These include changes to the law, for instance in relation to certification marks and defences to infringement, as well as an overhaul of the administrative bodies and systems used to handle trade mark applications.

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High Court trade mark decision leaves tobacco companies fuming

By Charles King

Volvo Trademark Holding AB v OHIM

New restrictions on cigarette branding imposed by the UK government were considered contradictory to trade mark law by the tobacco industry. The industry challenged the new restrictions arguing that the exclusion of figurative marks from packaging was unlawful.

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Designs

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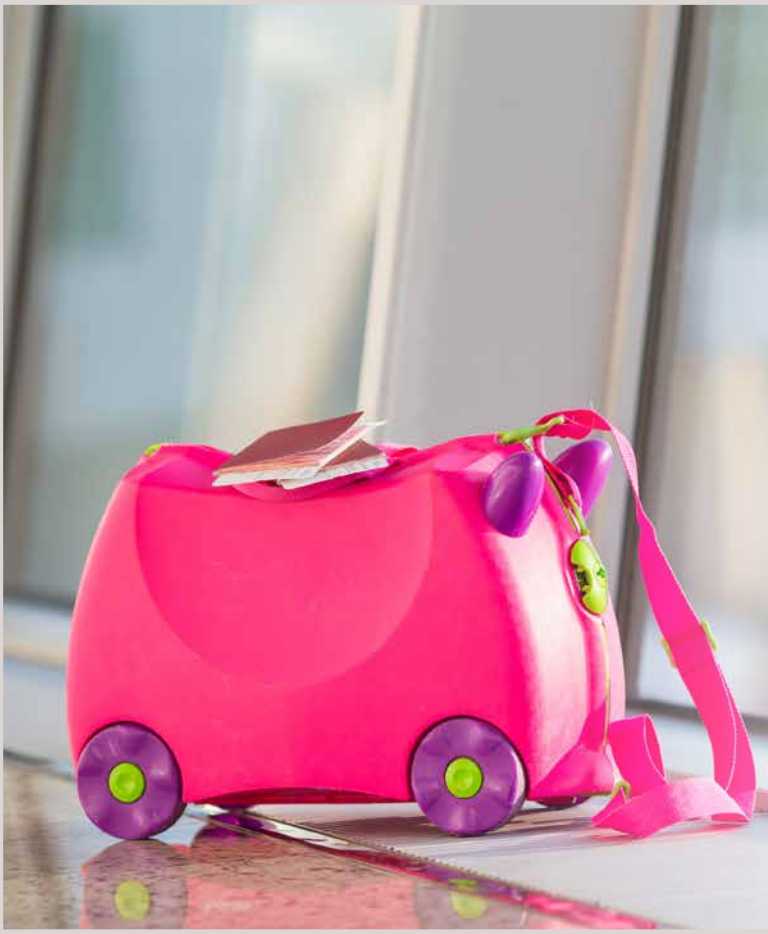

Case closed: Supreme Court dismisses Trunki's design appeal

By Charles King

PMS International Group Plc v Magmatic Limited

This high profile case involving child suitcase manufacturer Trunki (Magmatic Limited), offers many lessons for applicants looking to protect their products using registered designs. The decision of the Supreme Court highlights the importance of filing well thought out design drawings and the value of filing multiple applications in certain circumstances.

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SPCs

Eligibility of medical devices for SPCs

By Bruce Dean

(14W(pat)45/12)

Supplementary Protection Certificates (SPCs) provide valuable patent term extensions that compensate both the pharmaceutical and agricultural industry for the delays suffered in bringing their products to market as a result of complex marketing authorisation processes. In light of recent decisions from both the UK and German legal systems, is the current SPC legislation in need of change?

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