

VEREENIGDE NEWS

International newsletter of VEREENIGDE

Dear Reader,

It is without doubt that the economic crisis has changed the world. Many companies find themselves confronted with a decreased demand for their products and services. As a result, we have observed a shift in IP activities. Companies are often forced to reduce costs.

At the same time, however, it is widely believed that the present crisis has merely a temporary impact and that better times are on the horizon. This actually spurs companies to continue and even increase investing in research and development and, accordingly, in their IP. Preparing for the future is important. Taking a 'wait and see' approach is now seen as a risk of falling behind and losing market share in the future.

VEREENIGDE is fully aware of these developments and continuously seeks to optimize the IP strategy of its clients in view of the present situation and the future. On our part, we keep investing in the firm to expand and optimize our services, and to strengthen our position as a European firm. This is highlighted by the fact that our office in Munich is now fully staffed.

In this issue you can read about the activities of our new Green Team, which, inter alia, aims to find efficient solutions in terms of IP to the realization and promotion of sustainable innovation. We will also focus on the latest developments in European divisional patent applications, trademarks, the April 2010 EPO rule changes and patent-ability of stem cells. Last but not least, we pay attention to the fact that next year, it will be 100 years ago that the modern patent law was introduced in the Netherlands.

If, after reading this issue, you have any questions, please do not hesitate to contact us. We will be pleased to answer them.

Cees Jansen, Chairman



Cees Jansen

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New EPO rules for divisional applications

by Annemie Jaeken

On 1 April 2010, new EPO rules for divisional applications will enter into force. The new rules introduce a new time limit for filing divisional applications.

The new rules for divisional applications have a major impact on users of the European patent system. In addition, it is questionable whether the effect desired by the EPO will be achieved.

Applicants of European patent applications will need to consider in a rather early stage of the examination procedure whether they want to file a divisional application or not.

Furthermore, creating a sequence of divisional applications may become difficult.

On the plus side of the ledger, the new rules will allow filing divisional applications in non-EPO languages, such as the language of a parent application which was filed in a non-EPO language.

Current practice

Currently, a divisional application can be filed as long as the parent application is pending. This means that nowadays a divisional application can be filed up to, but not including, the day the parent application is granted.

A common practice is to file a divisional application shortly before grant of the parent application, for example for pursuing a different invention therein or for pursuing broader claims or simply to have an application pending. Also, a divisional application is often filed

to buy additional examination time, for instance by filing a divisional application shortly before oral proceedings in examination. Some applicants create a sequence of divisional applications in order to have at least one European application pending.

Such practices are now frowned upon by the EPO. In a landmark decision of the Enlarged Board of Appeal (G1/05), the Board found that the creation of a sequence of divisional applications, each containing the same broad disclosure as the original patent application, unsatisfactory and a misuse of the patent system. It called upon the legislator to define a remedy.

The alleged misuse of divisional applications is argued by the EPO with the following numbers. Approximately 5% of all European patent applications are divisional applications. Approximately 7% of all divisional applications are divisional applications of the second generation, this is approximately 0.35% of all European patent applications. Approximately 1% of all divisional applications are divisional applications of the third and higher generation, which is approximately 0.05% of all European patent applications. The EPO associates the alleged misuse in particular with divisional applications of the second and higher generation. On 25 March 2009, the legislator,

namely the Administrative Council of the EPO, decided to amend Rules 36(1) and 36(2) to limit applicants' use of divisionals to keep the application pending before the EPO.

New rules

The new rules impose time limits for filing divisional applications that depend on whether or not the divisional is in response to an objection for lack of unity.

Voluntary divisional application

A voluntary divisional application is a divisional application that is filed by the applicant, for example for buying additional examination time, or to pursue broader claims, or to have another application pending. A voluntary divisional application must be filed within twenty-four months of the first communication of the Examining Division in respect of the earliest application. By the "earliest application" is meant the very first European patent application in the series in which such a communication was issued.

A search report with a written opinion is not a communication of the Examining Division, but of the Search Division, and therefore does not trigger the time limit. A first communication of the Examining Division is usually a communication under Art 94(3) EPC or, if a first action is an allowance, Rule 71(3) EPC.

Mandatory divisional application

A mandatory divisional application is a divisional application that must be filed by the applicant if the applicant

wants to pursue subject matter for which a non-unity objection has been raised in the parent application. A mandatory divisional application must be filed within twenty-four months from any communication in which the Examining Division raises a non-unity objection in the earlier application, provided it was raising that specific objection for the first time.

By the “earlier application” is meant the previous application in the series in which the non-unity objection was raised by the Examining Division. Again, a search report and written opinion on the search in which the non-unity observation is made does not trigger the time limit because it is a communication issued by the Search Division.

The first communication of the Examining Division in which the non-unity objection is raised does trigger the time limit. This communication is usually the first communication of the Examining Division repeating the findings of the Search Division. However, it can also be a subsequent communication issued in the course of the proceedings in which the non-unity objection is raised for the first time. If, in a (further) subsequent Examining Division’s communication issued in relation to the same application, the non-unity objection is repeated, the time limit does not start again.

Language

In addition to the introduction of the above time limits, the language

requirement for a divisional application will be modified as well. Under current EPO practice, a divisional must be filed in the language of the proceedings of the parent application, which by definition must be English, German or French. When the new rules enter into force, the divisional application may be filed in the language of the earlier application, also if that language was a non-EPO language. A translation has to be filed within two months of filing the divisional application. Translation errors may be corrected throughout the proceedings.

Transitional provisions

The new rules enter into force on 1 April 2010 and shall apply to all divisional applications filed on or after that date. Transitional provisions will apply. If the two-year time limit would have expired before 1 April 2010, a divisional application may still be filed up to 1 October 2010. If the two-year time limit is still running on 1 April 2010, it will do so at least until 1 October 2010. This means that for many pending applications, a divisional application, if any, has to be filed before 1 October 2010. The time limits are excluded from the easy-to-handle remedy of ‘further processing’. Non-compliance with the time limit can only be re-established if all due care can be proven.

Consequences

The new rules for divisional applications imposed major consequences on the user of the European patent system. They mark the end of the current practice of

filing a divisional application at any time. Also, it will become more difficult to create sequences of divisional applications.

End of current practice

In the new regime, it will no longer be possible to continue the current practice of filing a divisional application at any time before grant of the parent application, for example shortly before grant of the parent application. In the absence of a request for accelerated examination, the grant of the parent application generally takes more than two years from the first communication from the Examining Division. With the new rules, filing a divisional application at that time would generally be too late. This is expected to create more uncertainty on the part of the applicants, because it may not be sufficiently clear for the applicant where the application is heading when termination of the two-year period is imminent.

The applicant may therefore choose to file one or more divisionals, to be better safe than sorry. This may lead to more, instead of fewer, divisional applications, contrary to the effect envisaged by the EPO.

Sequence of divisional applications: Voluntary divisionals

Creating a sequence of divisional applications should still be possible, but if non-unity is not an issue, this has to be done within two years of the very first Examining Division’s communication on the very first European application. Nevertheless, this time limit may be too short for

the applicant to have an idea where the application is heading. Therefore, the applicant has the possibility to request accelerated search and/or examination under the PACE program. The accelerated proceedings might be sufficient to bring the application to grant within the two years and thus, place the applicant in a better position to make an informed decision as to whether or not to file a divisional application. However, if (too) many applicants file such a request under the PACE program, this may create a backlog at the EPO, which undermines the accelerated character of the proceedings. This can already be observed now in some fields of technology.

Another strategy to accelerate prosecution at the EPO may be to demand preliminary examination of the International application, when the EPO is the ISA and IPEA. Upon entering the regional European phase after the PCT-phase, a swift reply to the invitation to file amendments under Rules 161/162 EPC becomes due (see the article by Marlon Blood), and the proceedings merely continue where they ended with the IPRP, giving the applicant a head start for the European examination.

One needs to also bear in mind that the Technical Boards of Appeal have issued some decisions in which it finds authority under the EPC for rejecting applications for double patenting. In a recent decision, a Board of Appeal came to the conclusion that a patent application may be denied for double patenting even when the divisional application contains claims that are broader than the claims in the parent application. So, a fast track procedure for a parent application pursuing limited claims and a divisional application in which broader claims are pursued, may encounter resistance from the EPO. Following this decision, the Examining Division may object more

often to possible double patenting. Some signs thereof have already been observed.

Since this decision deviates from earlier decisions on double patenting, it is to be expected, or maybe hoped for, that a rejection based on double patenting will be referred to the Enlarged Board of Appeal. However, until then, this decision, although out of line with earlier decisions of Boards of Appeal, may create additional uncertainty when pursuing voluntary divisional applications.



Sequence of divisional applications: Mandatory divisionals

Creating a sequence of divisional applications should be easier if a non-unity objection is raised because, then, a divisional application can be filed from an earlier divisional application as long as a new non-unity objection is raised in the earlier application.

Much is still unclear with respect to filing a series of divisional applications in case a non-unity objection has been raised.

The consensus now seems to be that when the parent application contains subject matter A+B+C

and the Examining Division raises a non-unity objection for three inventions, a divisional application can be filed for A+B, while C can be pursued in the parent application. In the divisional application for A+B, the Examining division will object against non-unity for two inventions A and B. A second divisional application can be filed for A within two years of the communication of the Examining Division with respect to non-unity of A and B in the first divisional application. Invention B

can be pursued in the first divisional application.

However, this approach has not yet been confirmed by the EPO. In addition to the new rules for divisional applications, a new rule with respect to multiple independent claims in the same category (see the article by Marlon Blood) will enter into force. If the Search Division sees multiple claims in the same claim category, it shall invite the applicant to indicate for which claims a search has to be conducted. The Examining Division, in turn, invites the applicant to restrict the claims to cover searched subject matter only. This gives the EPO the possibility

EPO rule changes - Part II

to choose between a non-unity objection and an objection to multiple independent claims in the same category when the latter applies, which may result in different time limits for filing a divisional application.

Summary

Applicants need to timely consider whether they want to file a divisional application before 1 October 2010 for their pending applications.

In addition, applicants may wish to consider strategies for advancing prosecution of their applications prior to examination by the EPO Examining Division to make a more informed decision on whether or not to file voluntary divisional applications.

Furthermore, applicants will be able to file divisional applications in the same non-EPO language as the parent application to preserve the option of correcting translation errors in the divisional.

Since the applications need to be reviewed on a case-by-case basis, applicants are advised to contact their patent representative.

by Marlon Blood

In addition to the above-explained rule changes concerning divisional applications, further miscellaneous rules changes also will come into effect on 1 April 2010.

Response to the extended European search report (Rule 70a)

Existing practice does not require a response to the extended European search report (which comprises the European search report and the written opinion).

It is currently not uncommon for an applicant to make no response and for the first substantive examination report to simply refer back to the written opinion. The new practice makes it mandatory to file a response.

Unsearchable subject matter (Rule 63)

An examiner may sometimes reach the conclusion that the subject matter of the claims makes it impossible to perform a meaningful search. Under existing practice, in such circumstances, the examiner unilaterally either issues a reasoned declaration to that effect or, as far as is practicable, draws up a partial search report. Under the new practice, before the examiner takes any unilateral action, the applicant is given the opportunity to file a statement indicating the subject matter to be searched. If the statement enables a search to be performed, a search report is drawn up. If the statement does not enable a search report to be performed, the previous practice of either issuing a reasoned declaration to that effect or, as far as is practicable, drawing up a partial search report is followed.

Multiple independent claims (Rule 62a)

Rule 43(2) requires that there should be only one independent claim per category (device, method etc) except in the circumstances that it explicitly sets out. Under existing practice, this objection is first raised in substantive examination in respect of a group of searched claims. Under the new practice, the Rule 43(2) issue is considered before the search is performed. The applicant is given an opportunity under new Rule 62a to indicate which claims it wishes to be searched.

Entering the EP regional phase (Rule 161)

Under existing practice, all Euro-PCT applications may be voluntarily amended shortly after entering the EP regional phase in response to a routine communication providing an invitation to do so. The communication has a 1-month deadline and no action is mandatory. Under the new practice, for Euro-PCT applications in respect of which the EPO acted as the ISA and the IPEA in the international phase, a communication is routinely issued shortly after entering the EP regional phase requiring a response to the objections raised in the international phase. The communication has a 1-month deadline, but a response, which effectively amounts to a regular office action response, is mandatory. For other Euro-PCT applications

VEREENIGDE among top PCT filers

In the October 2009 issue of *Managing Intellectual Property* (MIP), patent firms are ranked by the number of international patent (PCT) applications filed. VEREENIGDE holds the 16th position in PCT filings worldwide and first position for the Netherlands. VEREENIGDE is the only Dutch firm, indeed the only firm from continental Europe, in the top 20.

The EPO and the WARF stem cell patent

(where the EPO did not act as the ISA and the IPEA in the international phase), the existing practice remains unchanged.

Consequences

These further rules changes have the consequence of bringing forward the time when the applicant must consider certain substantive issues that hitherto have often been left until the formal start of substantive examination.

In respect of European applications, or Euro-PCT applications where a supplementary search is performed, for example, when the USPTO or the JPO are the ISA, we will be encouraging our clients to regard the now mandatory response to the extended European search report as the effective start of substantive examination and we will frame our advice accordingly.

In respect of Euro-PCT applications where the EPO acted as the ISA and IPEA in the international phase, we will be encouraging our clients to regard the mandatory response to the above-mentioned communication (with a 1-month response deadline) issued shortly after entering the European regional phase as the effective start of substantive examination in the European regional phase. For our direct clients, we will work preemptively to mitigate the effects of the tight 1-month deadline. For our relevant associate clients, as soon as we are instructed to make an EP regional phase entry, we will send a reminder emphasizing the need to shortly make a substantive submission.

by Tatiana Sazonova and Mark Einerhand

According to the provisions of Art 53(1) EPC, “European patents shall not be granted in respect of inventions the commercial exploitation of which would be contrary to ‘ordre public’ or morality, provided that the exploitation shall not be deemed to be so contrary merely because it is prohibited by law or regulation in some or all of the Contracting States”.

The Wisconsin Alumni Research Foundation (WARF) European patent application no. 96903521.1 was rejected by the Examining Division as being not patentable pursuant to Art 53 EPC. In this application, an independent product claim was directed to a cell culture of stem cells (i.e., a final product). The Examining Division refused the application, because a pre-implantation embryo that was destroyed in the process of generating the stem cells is the only source of stem cells identified in the application.

The applicant appealed the decision. In view of the importance of this issue, the Board of Appeal referred several questions to the highest judicial body at the EPO - the Enlarged Board of Appeal.

The decision of the Enlarged Board of Appeal

i) Applicability of Rule 28(c) EPC

New Rule 28 EPC lists several inventions for which the EPO will not grant patents. Rule 28(c) EPC specifies that no patents shall be granted for inventions concerning uses of human embryos for industrial or commercial purposes.

The new rule was incorporated into the EPC during the prosecution of

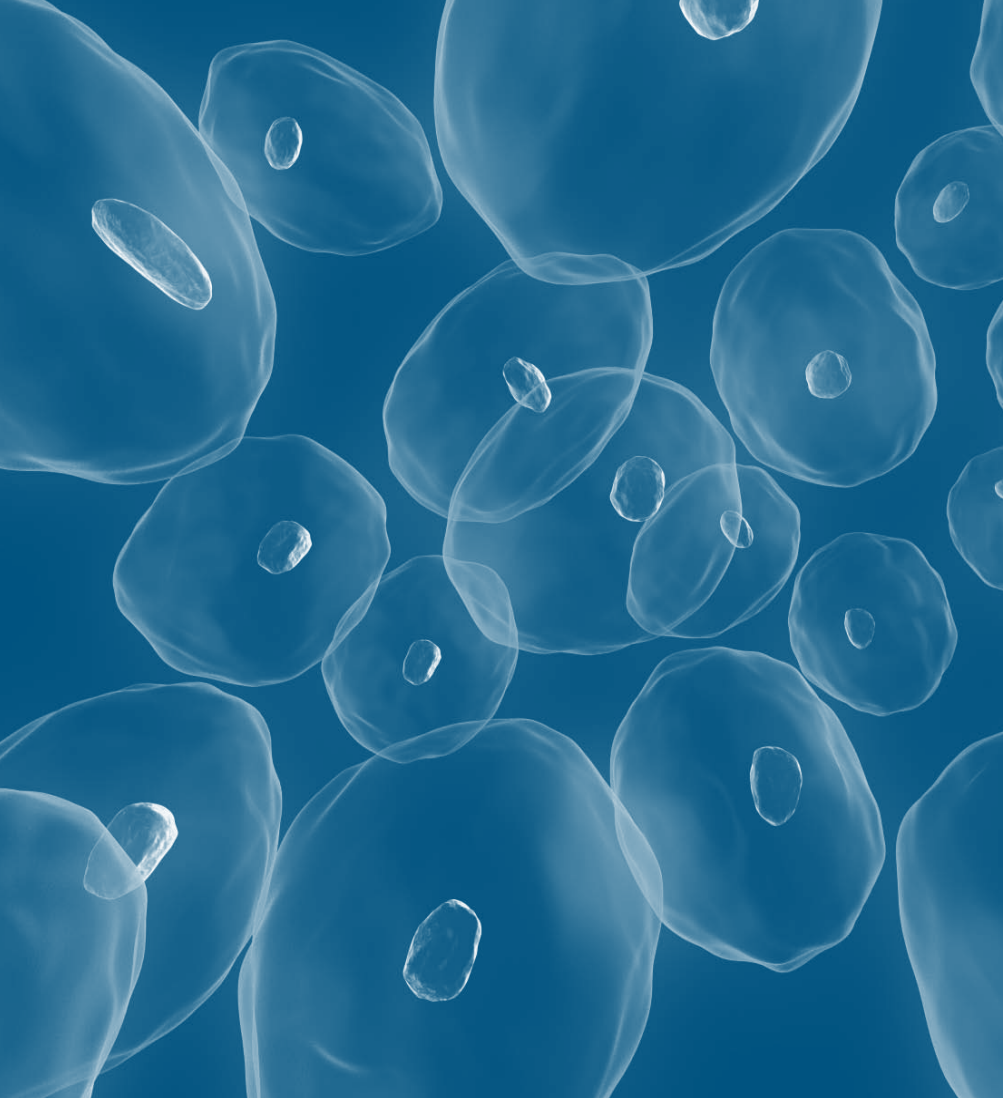
that application before the EPO. The question was whether the new rule applied to the present case.

The Enlarged Board decided that Rule 28(c) did indeed apply. The introduction of Rule 28(c) EPC did not disrupt a legal continuum, as there was no indication that the commercial exploitation of human embryos was ever regarded as patentable. Accordingly, it was decided that Rule 28(c) applies to all pending applications, even those that had been filed before that rule came into force.

ii) Effect of Rule 28(c) EPC on a claim related to an end product

The applicant defended the patentability of the claims with the argument that the claims were directed toward cell lines and not to the embryos themselves.

The Enlarged Board considered that Rule 28(c) refers to the invention and not to the claims in the context of its exploitation. Therefore, it considered it necessary to examine not just the claims but rather the technical teaching of the patent application as a whole so as to establish how the invention is carried out. When considered as a whole, it is evident that before the claimed cell culture



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can be used, it has to be made. The patent application specified that a human embryo was necessarily destroyed in the process of generating the claimed culture. Accordingly, it was decided that a claim directed to a cell culture which may only be obtained by destroying the human embryo (at the filing date) is not allowable. It was further considered that it was irrelevant whether at a later date a technique may be developed by means of which a claimed cell line can be produced without destroying the human embryo.

The EPO subsequently refused the WARF application. By doing so, the EPO diverges from the practice at the USPTO, where WARF obtained three issued patents on human stem cells.

Commentary

The decision of the Enlarged Board of Appeal made clear that the EPO will not grant patents for human embryo stem cells that require the destruction

of the embryo. Although the decision does not expressly state that commercial uses where the embryo is not destroyed are not allowed, it is likely that claims involving such use will also be refused. The wording of Rule 28(c) applies to all industrial or commercial uses of human embryos - not only those uses where the embryo is destroyed.

Since the rule refers solely to human embryos, it is likely that inventions based on stem cell cultures that are initiated from a deposited cell line will be considered allowable. Stem cells that are artificially induced from adult cells (Induced Pluripotent Stem cells or iPS) will probably also be allowable.

It is noted that in the rationale of this decision it was taken into account that neither the EU legislator, nor the EPC legislator have defined the term "embryo" in terms of its age.

Strategic trademark filing in the Benelux and the EU

by Jurriaan Cleuver

In filing trademark applications in general, the scope of protection ultimately obtained is generally determined by the designated goods and services. After all, in principle, the trademark protection provided does not surpass the goods and services for which a mark is applied (while there are of course exceptions to this general rule of law). The specific practices of designating goods and services however differ from country to country. This article elaborates on the practice of designating goods or services in Benelux and Community trademark applications as opposed to the US practice, as well as the strategically advantageous implications of these systems.

Introduction

In terms of goods and services listed in trademark applications or registrations, the Medinol case in the US has illustrated a large discrepancy between the trademark practice in the US on the one hand, and the EU on the other. Following the Medinol ruling, the validity of an entire US trademark registration may be at risk if the list of goods and services is defined too broadly, resulting from the owner's overstatement of goods and services in the trademark application, which was looked upon as 'fraud'. Although the Medinol doctrine has recently been refined in that 'should have known' is no longer the standard, the penalty of total invalidity of the trademark registration still stands in cases where there was a wilful intent to deceive in overstating the goods.

In addition to the overstatement of goods possibly having the result of a completely invalid registration, general descriptions are not accepted by the USPTO, which imposes an obligation on trademark applicants to accurately and exactly formulate the

list of goods and services in order to have the classification accepted.

Below, the reader will find an overview of the practice of the Benelux Office for Intellectual Property (BOIP) and the Office for Harmonization of the Internal Market (OHIM) in respect of the goods and services designated in a trademark registration as well as the possible consequences and advantages of overstating the goods and/or services in Benelux and Community Trademark (CTM) applications.

Application phase

Contrary to trademark practices such as in the US, neither Benelux nor CTM trademark applications (or national applications in most other EU countries, for that matter) require any formal statement regarding the goods or services. Or, more particularly, the actual or intended use thereof. The only required statement in this respect is made in the application itself, where the specific goods or services are designated. Broad descriptions of goods and/or services are generally

accepted by the BOIP and the OHIM. For instance, if the applicant has a specific interest in men's shirts, the International class heading description of class 25, which reads "clothing, shoes, headgear" will suffice; further specification of the products for which there is an actual intention to use is not required. In fact, the OHIM has advised that the designation of class headings in CTM applications covers all those goods and services possibly falling under the particular headings. Thus, not only are broad descriptions generally accepted, a broader scope of trademark protection is obtained in the process.

The goods and services under attack

During the first five years of a Benelux or CTM registration, the mark automatically remains valid for all the goods and services designated in the registration, regardless of whether there has been actual or intended use of the registered mark for these goods or services. Once the mark has been registered for over five years, it is subject to the use requirement, according to which the mark must have been in use for the designated goods or services in the previous five years, in order to remain valid for these goods or services.

Cancellation proceedings

At a certain point during the existence of a trademark registration, third parties may have an interest to attack the Benelux or CTM registration on the grounds of non-use of the mark for part of the designated goods or services.



In such event a cancellation action can be initiated against the litigious registration. This can be effected either through court proceedings, in case of Benelux registrations, or before the OHIM, in case of CTM registrations. In addition, the cancellation of a CTM may also be invoked before the court.

If successful, the action will result in the protection of the mark being stripped down to those goods or services for which the mark has been proven to be genuinely used. Only in the case where a trademark owner does not succeed in establishing any

genuine use of the mark whatsoever, or where the trademark is used only for goods or services that are not at all covered by the trademark registration, this may lead to invalidity of the entire registration.

Opposition proceedings

In the course of opposition proceedings before the Benelux Office or the OHIM, it may be required to establish the validity of the registration(s) invoked by providing proof of genuine use of the mark, insofar as the mark invoked has been registered for five years or more. Upon the applicant's request, the opponent

is required to submit evidence that the mark(s) invoked has (have) been genuinely used during the five years preceding the publication date of the opposed mark.

Should the opponent not succeed in demonstrating use of the mark during the past five years for all the designated goods and services, the registration(s) will be considered only valid for the goods or services of which genuine use has been demonstrated.

This limited scope of protection is only held applicable within the frame of the opposition proceedings. The registration itself is not affected *ex*

officio. However, when it is established that the mark has not been genuinely used for certain goods or services, any interested party may of course file a (partial) non-use cancellation action.

Maintaining a broad list of goods and services

Following case law of the Court of First Instance of the European Court of Justice, the requirement for the opponent to establish genuine use of its mark is to be regarded as “seeking to prevent a trade mark which has been used in relation to part of the goods or services for which it is registered being afforded extensive protection merely because it has been registered for a wide range of goods or services”. In other words, the mere fact that a trademark was registered for a broad list of goods and/or services, does not ensure a trademark owner that the registration is automatically upheld for all those goods or services falling within the broad categories.

In assessing whether the mark has been used for all the designated goods and services, the scope of the specific categories of goods and/or services has to be taken into account, in particular the extent to which the categories concerned are described in general terms for registration purposes. Consequently, if the registered goods or services are sufficiently broadly defined in that they can be divided into independent subcategories, use for goods falling under a certain subcategory affords protection only for that specific subcategory within the frame of opposition proceedings. However, this does not result in an *ex officio* ruling that the registration itself is affected in any way.

On the other hand, if the goods or services for which a trademark is registered are defined so narrowly that it is not possible to make any significant subdivisions within the category concerned, the proof of genuine use of the mark for those

goods or services necessarily covers the entire category.

For instance, in an opposition case before the OHIM earlier this year, the Office deemed use for biopsy instruments, biopsy needles and biopsy guns sufficient in order to maintain the registration for all designated goods, which concerned the more general and more broadly defined “surgical and medical apparatus and instruments; biopsy gun; reusable handle biopsy gun”.

Advantages of filing broadly

The above shows that the only risk when filing the trademark application too broadly, is basically that the registration is stripped from protection for the goods or services for which it is proven that the mark has not been genuinely used in the five years preceding the cancellation action. However, such can only result from third parties initiating an action against the registration; the invalidity of the trademark registration for the non-used goods or services is not declared *ex officio*.

This practice provides possibilities for a more strategic approach in filing trademark applications. For instance, the advantage of filing for a broader list of goods and services (in particular for the International class headings) is that it enables expanding one’s initial activities under adequate trademark protection without having to file additional trademark applications. Additionally, a broad description of goods and services offers the trademark owner a wider basis to fence off competitors and prevent other parties from using a similar mark for goods or services that are similar to those mentioned in the registrations, but for which there may not be any actual use by the owner (at least during the first five years of the registration).

On the other hand of course, filing for a broader list of goods or services does bear an enhanced risk of

oppositions being lodged against the application, as the ‘broad’ application also concerns goods or services in which the applicant may not have any actual interests.

Conclusion

As the above illustrates, the practice in the Benelux or the EU in respect of filing and maintaining a broad list of goods and services is less strict when compared to the US practice in that there is no ‘fraud standard’ bearing a risk of invalidity of the registration. Additionally, there is a smaller risk of a provisional refusal issued due to an insufficiently specified description of goods or services.

While an applicant should be careful in overstating goods and services in US trademark applications, the owner of a Benelux or CTM registration may only be stripped of the ‘superfluous’ trademark protection obtained through the registration as a result of overstating the goods and services, and only after a third party has initiated (court) proceedings against that part of the registration.

Consequently, the trademark owner may thus benefit from the Benelux and EU practice in that trademark applications are allowed to be filed in a more strategic fashion.

Companies outside of the EU that are interested in filing a Benelux or CTM application (not bound by a priority application) are generally advised to file an application for the International heading in addition to the specific goods or services of interest. For instance, where men’s shirts are particularly of interest, it is generally advised that the specification of a Benelux or CTM application reads “clothing, including shirts; shoes; headgear”.

Leaving the trademark owners a broad scope of protection, the filing practice within the Benelux and EU may very well provide trademark owners a headstart on their competitors.

The Netherlands celebrate 100 years of modern patent law

by Lars de Haas

In 2010 it will be 100 years ago that the Netherlands revived its patent system in a modern form.

100 years ago, patents were a local affair: the application had to be filed in the Dutch language and the newly created patent office performed its own thorough examination. In the following 100 years the Dutch patent system has become a part of an international context. Today the European patent office conducts oral proceedings at the site of the old Dutch patent office. Dutch patents are granted with English text, having Dutch language claims, and the Dutch patent office has become an avenue to obtain European type search reports and local patent protection quickly and at relatively low cost.

Before 1805, the Netherlands were a republic in which parliament granted patents on an individual basis. The earliest general patent law was established in 1809, giving Napoleon's brother, who had been named king of the Netherlands, the right to grant patents on innovations. The following year, Napoleon annexed the Netherlands to France, so that the more modern French patent law came into force. After the fall of Napoleon, the Netherlands continued to have a similar patent act, but in 1869 irritation with patents led to a decision to stop granting patents. In 1910, the Netherlands re-established the patent system, this time inspired by the German patent act. To overcome the irritations with the old patent system the new patent act required the use of claims and it established a patent office with examining divisions with power to refuse patent applications. Soon after, in 1916, VEREENIGDE was established to assist clients in the communication with the patent office. The founding fathers of the patent office travelled to London and Berlin to learn from the patent offices in those cities. It



Commemorative medal on the occasion of the 25th anniversary of the Dutch patent office. The text reads: "Patent office - protection of the inventive idea".

was decided to take over much of the German system of using a thorough preliminary examination by a pre-examiner, followed by a decision by a division with a senior examiner (sometimes a professor from a nearby university).

100 years ago, patent applications were published only when there was an intent to grant and the patent term was calculated from the date of grant. Gradually increasing examination delays led the Dutch legislator in 1963 to introduce the

system of publication after 18 months, examination delayed until requested by the applicant and a patent term calculated from the application date, which has since been followed by most patent countries worldwide.

In 1977, the search facilities of the Dutch patent office formed the basis of the search divisions of the European Patent Office, which established one of its two main seats in the building of the Dutch patent office in the Hague (Rijswijk). Oral proceedings of the European Patent Office are now often conducted at this site.

But the rise of the European patent system led to the decline of the Dutch patent office. The number of Dutch patent applications dwindled and it was felt that this made it impossible to maintain the required level of expertise. In 1995 the patent act of 1910 was replaced by a new act, wherein the Dutch examining divisions and their authority to refuse patent applications were abandoned. Today the Dutch patent office still grants local Dutch patents, which may be in Dutch or English, with Dutch claims. An extended search report is provided, usually by employing the services of the European patent office. But it is left to the applicant to address objections: the patent is granted irrespective of any objections in the search report. This makes it possible to obtain a patent at relatively low cost and much sooner than via the European route. Furthermore the Dutch patent office registers European patents that apply to the Netherlands, likewise in Dutch or English with Dutch claims.

Presenting 'the green team'



"Alternative energy", "clean tech", "green", and "sustainable" are not only buzzwords – these terms now refer to activities that, if they are not already big business, they soon will be. A combination of government funding, tax deductions and government mandates – the "green new deal" – is creating incentives to conduct research, develop new products, start new businesses, and create new brands.

Since IP protection facilitates investment in new technology and business development, IP is expected to play an important role in spurring private investment and risk-taking.

To give entrepreneurs working on the forefront of clean tech developments the support they deserve, VEREENIGDE has assembled a multi-disciplinary team of experts we've dubbed "the green team".

The green team is a dream team for addressing the special needs of clean tech developers such as patent landscaping, freedom-to-operate opinions and advice, procuring patent protection, registering and defending designs and brand names, providing strategic IP advice, and licensing and enforcing intellectual property rights. As governments are taking steps to accelerate clean tech development, the green team is here to help you accelerate IP services to match the pace.

Whether your technology relates to solar, wind, wave or geothermal energy, energy storage, fuel cells, biofuels, white biotech, hydrogen production or storage, redistribution or conservation of energy, re-use or recycling of energy or materials, reduction of environmental impact or CO₂ footprint, enablement of clean technology, or some other clean tech sector, VEREENIGDE has all the expertise you need in-house. When appropriate, we use a team approach to ensure that your needs are covered.

For further information, contact our green team members:

Cees Jansen, Otto Oudshoorn, Bernard Ledeboer, Hajo Kraak, Marco Molling, Frits Schut, Michiel van Rooij, Huub Maas, Annemie Jaeken

We look forward to hearing from you.

Robert (Bob) Lelkes
Green Team coordinator

Editorial Board
Annelies de Bosch Kemper-
de Hilster
Jurriaan Cleuver
Johannes van Melle
Rob van Niele
Otto Oudshoorn

VEREENIGDE

Johan de Wittlaan 7
P.O. Box 87930
2508 DH The Hague
The Netherlands

Telephone
+31 70 416 67 11

Telefax
+31 70 416 67 99

E-mail
patent@vereenigde.com
trademark@vereenigde.com

Website
www.vereenigde.com

OOSTENBROEK ATTORNEYS-AT-LAW

Johan de Wittlaan 7
P.O. Box 87930
2508 DH The Hague
The Netherlands

Telephone
+31 70 352 42 24

Telefax
+31 70 354 16 39

E-mail
legal@vereenigde.com

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