

VEREENIGDE NEWS

International newsletter of VEREENIGDE

Dear Reader,

In the previous edition of this newsletter, it was predicted that better times were on the horizon. Fortunately, the signs that the worst part of the economic crisis is over are beginning to manifest themselves more clearly these days. This adds to our belief that the world's drive to innovate was hardly slowed down, if at all, by the crisis.

Our focus to position ourselves as a European firm was acknowledged by Managing Intellectual Property, which, in their October 2009 issue, ranked VEREENIGDE among the world's 16 best PCT filers for 2009. And if this were not enough, on 24 June we received from Managing Intellectual Property 'The Netherlands Prosecution IP Firm of the Year award for 2010'. This is for sure a boost for the firm, and another stimulus to keep up the good work.

To meet the anticipated demand for IP services, we have continued enlarging our workforce in most of our offices. Today, VEREENIGDE's office totals close to 60 patent and trademark attorneys and attorneys-at-law, a number which is expected to grow further in the near future. In this respect, I am pleased to announce that as from 1 July next, Hajo Kraak, Johannes van Melle and Frits Schut will become partners of our firm. As of that date, Martin Hatzmann will retire as a partner. As much as we welcome the new partners, we shall miss Martin for all that he has done for VEREENIGDE over the years, for his commitment to our clients and his expertise as an IP specialist.

This edition of VEREENIGDE NEWS again contains items that will no doubt be of great interest to you, including a number of recent Decisions. We also address the language of the proceedings at the European Patent Office and the use of community trademarks in the Netherlands. Last but not least, our Green Team reports on the latest developments in 'green' IP.

We sincerely hope that this issue provides you with useful information on current IP issues.

Cees Jansen, Chairman



Cees Jansen

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More scope for European patents for inventions that relate to medical treatment

by Lars de Haas

In its decision G1/07 (Medi-Physics), the Enlarged Board of Appeal of the European Patent Office (EPO) has ruled that current patent office practice on exclusion of methods of medical treatment from patentability has been too restrictive.

Background

The European Patent Convention (EPC) excludes patents in respect of 'methods for treatment of the human or animal body by surgery or therapy and diagnostic methods practised on the human or animal body' (Article 53(c) EPC 2000). It is widely accepted that the purpose of the exclusion is to ensure that medical practitioners can choose the best possible treatment or diagnosis for their patients without fear of being liable for patent infringement. However, the legislator has chosen to address this by means of exceptions to patentability which do not simply define an immunity for medical practitioners. This has the effect that Article 53(c) EPC can be more far reaching than is necessary for its purpose.

Under current practice, the exclusion to patentability can reach claims that cover commercial body care and simple interventions on the body such as injections. The exclusion can also have the effect that protection is excluded for a device-related invention, when the invention can only be defined by the operation of the device in the context of the body. For example, in the case at bar in G1/07, a problem arose for a claimed MRI imaging technique because a reference to a contrast agent was needed to define the invention. The claim did so by means of a step of administering the contrast agent to a patient.

One line of cases from the EPO Boards of Appeal has held that the exclusion of patents in respect of methods of treatment by surgery applies to any claim that includes a significant conservative intervention on the body. The issue of interpretation of the exclusion of methods of treatment by surgery reached the Enlarged Board of Appeal because some Boards of Appeal had mitigated this approach by limiting the effect of the exclusion to 'curative treatment', which would preserve patentability of claims that involve treatment for other purposes, such as MRI imaging.

Scope of the exclusion of treatment by surgery

The decision of the Enlarged Board in G1/07 rejects the limitation of the exclusion of treatment by surgery to curative treatment. However, the Enlarged Board spontaneously concluded that current patent office practice applied the exclusion too broadly. The exclusion should apply only to method claims with features that cover treatment with health risks that make it necessary to reserve the treatment for medical practitioners.

The Enlarged Board outlined the playing field, although it declined to give a final definition of what is excluded as treatment by surgery. The exclusion only applies to method claims and it depends on the features of the claim. If a treatment by surgery





or diagnosis is not covered by any feature of the claim, the exclusion is not triggered merely because the claimed method could be used during a surgical operation (e.g. for imaging during the operation) or because it could be used for diagnostic purposes. On the other hand, the exclusion is triggered if a feature of the claim covers a treatment by surgery, even if the relevant feature is formulated at a level of abstraction that does not specifically identify a treatment by surgery, or if other features of the claim specify other non-surgical steps to achieve some non-surgical object.

Any definition of excluded treatment by surgery must cover the core of the medical profession's activities, for which its members were specifically trained and for which they assume a particular responsibility. The Enlarged Board emphasized that, in view of the legislative text, it was the nature of the treatment encompassed by the claim that was decisive for the exclusion, not who performed the treatment.

However, because the Enlarged Board defined this nature in terms of health risks that necessitate involvement of medical practitioners, this distinction may make little difference.

In the context of the case at bar, the claimed method should be excluded from patentability because the referring board found that the claimed method encompassed implementation by an invasive step (i.e. an injection into the heart) representing a substantial physical intervention on the body which requires professional medical expertise to be carried out and which entails a health risk even when carried out with the required professional care and expertise.

The exclusion should not, however, be construed too expansively. The Enlarged Board explained that the definition of 'treatment by surgery' should ensure that:

- In principle safe routine techniques are not excluded from patentability, even when of invasive nature.

Uncritical methods involving only a minor intervention and no substantial health risk should not fall under the definition.

- A treatment that involves administration of a non-therapeutic agent is only excluded if it has a health risk associated with the mode of administration and not solely with the agent as such.
- The exclusion does not apply to methods which are merely directed to the operation of a device without themselves providing any functional interaction with the effects produced by the device on the body.
- Methods are not excluded in which health risks are disregarded (non-conservative methods), such as methods that involve killing animals.

Tattooing, piercing, hair removal by optical radiation and micro abrasion of the skin, and other techniques that are carried out in a non-medical, commercial environment like cosmetic salons and beauty parlors did not need to be excluded from patentability.

How to avoid exclusion

Although some inventions will not be able to escape exclusion from patentability, careful drafting of the claims and description will make it possible to avoid the exclusion for many inventions. The EPC emphasizes that product claims do not fall under the exclusion and the Enlarged Board has explicitly endorsed several ways to avoid that method claims fall under the exclusion of treatment by surgery.

One way is to disclaim embodiments that involve treatment by surgery. This can be applied, for example, to avoid a rejection of claims on cosmetic methods by disclaiming implementation by means of treatment by surgery. It might even be used to disclaim embodiments of certain medical methods. For example, in the case at bar, a disclaimer of the embodiment of administering the contrast agent by injection into the hearth might avoid the exclusion, leaving coverage for administration by inhalation. In order to prepare for such disclaimers, it may help to avoid describing only embodiments wherein the claim features involve treatment by surgery and to make clear that the invention is not limited to specifically described non-surgical embodiments, if any.

Another way to avoid the exclusion could be to omit all features that cover treatment by surgery from the claim or, where possible, to use features such as “using pre-delivered...” or “using a pre-implanted ...” instead. Whether the patent office will accept this depends on whether it can be argued that the ‘teaching of the invention is complete’ without the treatment features. Obviously, this will not be possible when the teaching of the invention is how an agent should be administered or how a device should be implanted by treatment by surgery.

Applicants should be prepared to counter examiner’s arguments that the steps of delivery of agents, implanting a device etc. are essential for the definition of the invention when, in reality, the teaching of the invention pertains to how the agent or device is used. This may involve formulating the problem which is solved by the invention in technical, rather than medical terms, in a way that makes it possible to argue that the solution can be defined without including treatment by surgery. Arguments about the ‘contribution to the art’ of the invention may also work. Under

the related exclusion of diagnostic methods, the Enlarged Board explained that a claimed method of forming an image, even for medical purposes, can be said to be ‘complete’ without a step of diagnosis using the image. Therefore, such a method was not an excluded diagnostic method.

It may be easier to avoid the exclusion



with method claims directed at the operation of devices. The Enlarged Board pointed out that methods which are merely directed to the operating of a device without themselves providing any functional interaction with the effects produced by the device on the body, are teachings in which the performance of a physical activity or action that constitutes a method step for treatment of a human or animal body by surgery or therapy is not required in order for the teaching of the claimed invention to be complete. Even if, in such a case, the use of the device itself requires the application of a surgical step to the body or if the device is for therapeutic treatment, the

same does not apply to the claimed method for operating the device.

Conclusion

The Enlarged Board’s decision emphasizes that the EPC does not have a vague general exclusion of ‘medical methods’ from patentability. The exclusion of Article 53(c) EPC 2000 is specifically limited to methods of treatment by surgery, methods of treatment by therapy, and to diagnostic methods.

In its earlier decision G1/04, the Enlarged Board already made it clear that the exclusion of diagnostic methods does not apply if a method can be claimed without a feature of arriving at a diagnosis, for example if it merely claims measuring physical effects. The present decision G1/07 deals with treatment by surgery and shows that one should avoid including claim features that cover bodily interventions that involve health risks which necessitate execution by a medical practitioner. Only the exclusion of ‘treatment by therapy’ has not been the subject of referral to the Enlarged Board. Boards of Appeal’s decisions suggest that this exclusion applies if a claim has a feature that covers a treatment that can have a therapeutic effect, even when claimed for a non-therapeutic purpose.

Although G1/07 may provide more scope for European patents, it also leaves uncertainty. Where possible, one should not rely only on method claims. It should be kept in mind that, although the Enlarged Board is the final authority on the law of the EPO, its decisions are not binding on the national European courts, which courts decide on validity after the grant of European patents. The national courts tend to follow Enlarged Board decisions, but there is no certainty that courts in some European countries will not exclude claims that are allowed under G1/07.

No absolute protection for gene sequences in Europe?

by Bart van Wezenbeek

In the case C-428/08, the Advocate-General of the European Court of Justice recently issued his conclusion.

The case deals with questions of the Dutch Court of First Instance on the interpretation of the Biotech Directive in relation to the general patent law. Especially important was whether a claim directed to a gene sequence would have a scope of protection that was determined by the normal patent law and thus, an absolute scope of protection like any chemical compound, or whether the protection of a gene sequence would be solely limited to the protection as defined in the European Directive on the Protection of Biotechnological inventions (Directive 98/44/EG), i.e. a purpose-bound protection.

The specific case on which the Dutch court referred questions to the European Court of Justice was the case *Monsanto vs. Cefetra*, where Monsanto has a European patent on a gene that was used to make soybean plants resistant to glyphosate. The plants were grown in Argentina, where Monsanto had no patent protection, and the soy meal from these plants was imported into Europe. It was in confession between the parties that there still was intact DNA in the meal, in which the complete gene was available. The court held that this could be called infringement on the basis of the absolute protection for chemical compounds. On the other hand, there was the Biotech Directive. According to Article 9 of this directive, protection conferred by a patent for a product containing or consisting of genetic information is extended (or limited) to all material

in which the product is incorporated and in which the genetic information is contained and performs its function. Thus, according to the directive, there is only protection if the genetic material performs its function. In the present case, however, the DNA in the meal did not exert its function at the moment of the alleged infringement.

The Advocate-General has studied the question in depth, also relying on the legislative history of the directive. Some of his arguments were:

- 1) The question that has to be answered is generally applicable in all cases where a product is imported in the European Union that is obtained by production (in a non-European country) of a genetically modified plant on which a European patent is vested.
- 2) For determination of patentability of a genetic sequence it is prescribed in the directive that a function of the sequence be given. This requirement is meant to distinguish between an invention and a discovery.
- 3) An absolute protection would mean that a gene sequence is protected for all its possible



G3/08: Enlarged Board declines to give opinion on of computer implemented

by Lars de Haas

In its opinion G3/08, the Enlarged Board of Appeal of the European Patent Office (EPO) declined to answer questions referred to it by the President of the EPO about the patentability of computer-implemented inventions (CII). According to the Enlarged Board, the decisions by the Boards of Appeal (Boards) on this issue showed no divergence that needed resolution.

- functions. This would (in view of 2 above) lead to the patenting of a discovery, i.e. grant of a patent for a function that is yet unknown at the moment of filing.
- 4) If a sequence were to be granted absolute protection, Article 9 of the directive would have no meaning (since it would not add any protection).
 - 5) Function-limited protection (although with respect to human gene sequences) has been implemented in the German and French national patent laws on the basis of the directive.
 - 6) A *de minimis* solution to resolve the dispute would be unwanted since there would always be uncertainty as to the metes and bounds of such a *de minimis* rule.

On the basis of these arguments, the Advocate-General concluded that, according to the system of the directive, the protection for a gene sequence should be limited to situations in which the genetic information exerts its function. This holds both for the protection of the sequence and for the material in which the sequence is incorporated.

The Advocate-General clarifies that the protection should not be limited to only those cases in which the gene is 'turned on'. It is clear that for application of the directive, in particular Art. 9, genetic information exerts its function if this genetic information a) is part of living material; b) is transferred to the progeny if the living material multiplies; and c) constantly, or any time in certain circumstances, exerts the function for which it is patented. Although this is only the conclusion of the Advocate-General, it is very common that the European Court of Justice will follow the advice and will respond to the referred questions along the lines of the present conclusion.

National effect

Although it may be disappointing that the Enlarged Board did not lend its authority to criteria for the patentability of CII, the observation that case law of the Boards is not inconsistent may already be important as regards its effect on decisions by the courts in individual European countries.

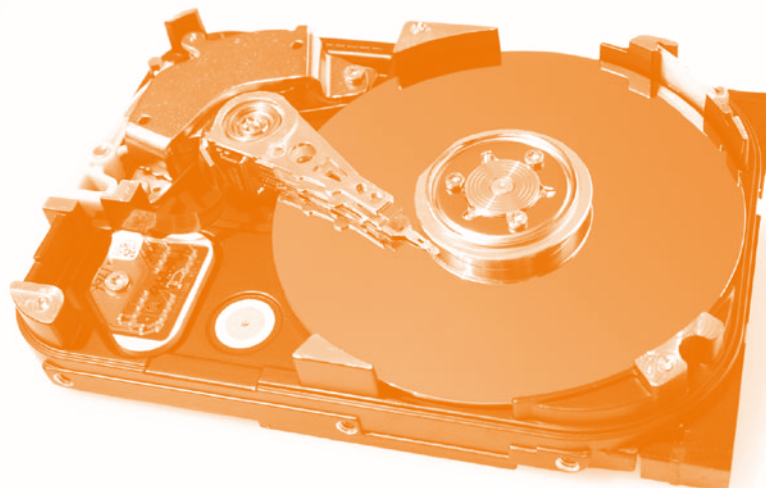
For example, the English Court of Appeal has observed earlier in its *Aerotel* decision (2006) that it was premature to follow the decisions of the Boards on this issue because they were inconsistent. The Court of Appeal was conscious of a need to place great weight on the decisions of the Boards and it indicated that it might have to reconsider its own approach to CII if and when the Enlarged Board ruled on the question, to remove the alleged inconsistency between the Boards' decisions. Now that the Enlarged Board

has ruled that there is no inconsistency, this could be a reason for the English courts to follow the decisions of the Boards.

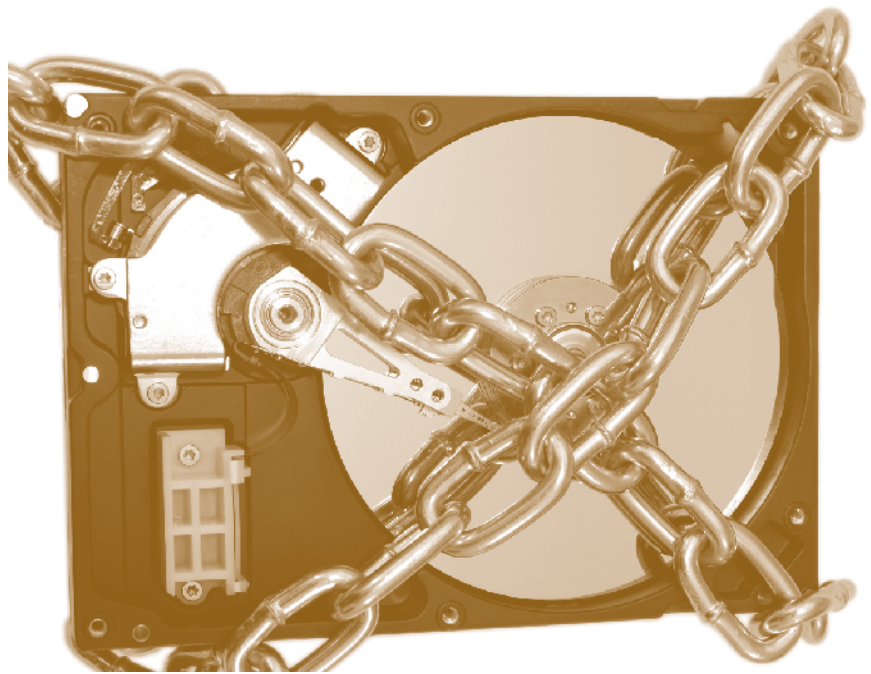
Background

Apart from novelty and non-obviousness, the main hurdle that must be taken in Europe to obtain a patent for a CII is that it must be shown that the invention provides a 'technical contribution to the art'. The usual patent office practice for judging this is to ignore claim features that do not contribute to the solution of a technical problem and to judge inventive step in relation to the remaining features of the claim.

The view of the Boards on the legal basis for the condition of 'technical contribution' has shifted through the years. Currently, it is seen exclusively as part of the conditions for 'inventive



patentability inventions



step' (Article 56 of the European Patent Convention (EPC)). In the past it was also applied in the context of Article 52 EPC. Article 52 specifies that patents shall be granted for inventions that are new, involve an inventive step and are susceptible of industrial application but, to the extent that a patent application relates to computer programs as such, programs for computers are not regarded to be such inventions.

The case law of the Boards of the EPO holds that Article 52 EPC implies a requirement of 'technical character'. In the past, the requirement of 'technical contribution' was sometimes used as a condition for 'technical character'. However, under current case law, technical character is judged independently of technical contribution. The Enlarged Board illustrated this through the example of a cup carrying a picture without technical effect. Such a cup will lack inventive step because it lacks technical contribution, but this does not detract from the fact that the cup has technical character.

The shift of removing the condition of 'technical contribution' from the test for technical character has ultimately led to the shift from excluding claims on computer program products (disks) with inventive programs to allowing such claims.

Inconsistency versus legal development

The EPO President has the right to refer a point of law to the Enlarged Board if two Boards have given different decisions on that question. In G3/08 the EPO President based

her questions on the observation that currently the Boards accept claims directed at computer program products (e.g. disks) containing computer readable instructions of inventive computer programs, whereas earlier decisions of the Boards had excluded the allowability of such claims. The questions went on to suggest a host of criteria that could be imposed as a condition for 'technical character'.

The Enlarged Board observed that the President's right to refer questions was limited to cases where this was needed to ensure uniform application of the law. Unlike common law courts, the Boards were not required to uphold their own precedent. A shift of the case law was possible, and when it was the result of legal developments, especially in new fields of law such as that of the patentability of CII, such a shift did not make a referral by the President admissible.

The Enlarged Board was of the opinion that the shift with respect to computer program products was the result of such a legal development of case law. The shift had made the earlier decisions irrelevant and thus did not leave an inconsistent situation. Under these circumstances, the Enlarged Board did not have the power to act as a higher instance ranking above the Boards. At most it was regrettable that the Board had not explicitly stated that

the more recent decision deviated from an earlier decision.

The Enlarged Board emphasized that a presidential referral was not admissible merely because the European Parliament and Council have failed to adopt a directive on CII patenting or because consistent rulings by the Boards are called into question by a vocal lobby.

The Enlarged Board noted in passing that it was 'surprising' that the President did not direct any of the questions to the validity of the 'technical contribution' criterion as part of judging an inventive step. The Enlarged Board speculated that the President could not identify any divergence in the case law on this issue, despite the fact that (at present) approximately seventy decisions issued by a total of fifteen different Boards cited this case law. The Enlarged Board itself was not aware of any divergence in this case law, suggesting that the Boards are quite comfortable with it in general.

As the condition of 'technical contribution' is the real hurdle for computer implemented inventions, this note of the Enlarged Board can be seen as a clear signal that the case law is now well established and consistent and that it will not be set aside by the Enlarged Board.

Swiss-type claims no longer acceptable in Europe

by Bart van Wezenbeek

Recently, the Enlarged Board of Appeal, in case G 2/08, issued a decision on the patentability of a method for therapy in which the new and inventive feature was a new dose regimen for an already known drug and medical indication.

The case was appealed from a decision of the examining division refusing a patent application having a Swiss-type second medical use claim along the following lines:

1. The use of <a compound> for the manufacture of a sustained release medicament for use in the treatment by oral administration once a day prior to sleep, of hyperlipidaemia Earlier documents already disclosed the use of the compound for treatment of hyperlipidaemia and the examining division argued that the specific drug regime reflected a medical activity excluded from patentability under Art. 52(4) EPC 1973.

In the appeal (T1319/04), the Board of Appeal first concluded that, since the application was still deemed to be pending on 13 December 2007, the new provisions of Art. 53(c), 54(4) and (5) EPC 2000 would now be applicable.

The Board of Appeal considered that the question of patentability of a second medical use where the only feature likely to confer novelty is a dosage regime was a question on an important point of law. Therefore, it referred the following questions to the

Enlarged Board:

1. Where it is already known to use a particular medicament to treat a particular illness, can this known medicament be patented under the provisions of Articles 53(c) and 54(5) EPC 2000 for use in a different, new and inventive treatment by therapy of the same illness?

2. If the answer to question 1 is yes, is such patenting also possible where the only novel feature of the treatment is a new and inventive dosage regime?
3. Are there any special considerations applicable when interpreting and applying Articles 53(c) and 54(5) EPC 2000?

As usual, the Enlarged Board invited not only the appellant and the president of the EPO to submit comments, but also solicited the filing of amicus briefs.

The Enlarged Board started off by mentioning that the objective of the exclusion of Art. 53(c) EPC was to provide that non-commercial and non-industrial medical activities were free from restraint, i.e. for reasons of public health. The new Art. 54(5) EPC expressly allows patent protection of substances or compositions already known as medicines, provided their use in a method referred to in Art. 53(c) EPC be specific and not comprised in the state of the art. Since Art. 54(5) EPC refers to 'any specific use', it would be at odds with the principle of good faith, as laid down in Art. 31(1) of the Vienna Convention to give this term a limitative meaning. The Vienna Convention also does not prescribe that exceptions should be construed narrowly. In this case, it cannot be said that Art. 54(4) and (5) EPC constitute exceptions to the absolute prohibition of patenting





methods of therapy. On the contrary, they constitute provisions of equal rank aimed at allowing patent protection for products, substances or compositions. This equal ranking also follows from the legislative history.

Second medical use

In relation to the answer to question 1, the Enlarged Board argues that under the old EPC the case law indicated that a second medical use, as defined in G 5/83, was not necessarily restricted to a disease not yet treated (i.e. a novel medical indication for the substance or composition). Since it was clear from the preparatory documents of EPC 2000 that the legislator intended to codify the existing second medical use practice,

the principles laid down in the existing case law should be maintained, i.e. a broad interpretation of the wording ‘any specific use’. Such a broad interpretation would



In this case, it cannot be said that Art. 54(4) and (5) constitute exceptions to the absolute prohibition of patenting methods of therapy.



then also include novel and inventive dosage regimes, even if the drug was already known to be applicable for the same disease.

With respect to the third question, the

Enlarged Board especially considered the consequences of the new Art. 54(5) EPC in relation to the Swiss-type claims. As was mentioned in G 5/83, the Swiss-type claim for second medical use was a ‘special approach to the derivation of novelty’ and, therefore, constituted a narrow exception to the principles governing novelty. Art. 54(4) EPC now permits purpose-related product protection for any further specific use of a known medicament and hence, the necessity for a Swiss-type claim has ceased. According to the Enlarged Board, this also means that the use of Swiss-type claims must cease and it has therefore ruled that these will no longer be accepted. In order to accommodate users of the patent system, this rule will not have any retroactive effect, but will only be applicable three months from the publication of the present decision in the Official Journal of the EPO (which, at the publication date of this article, still has not occurred).

With respect to the actual protection conferred by Art. 54(5), the Enlarged Board argued that the practice which was established pursuant to the case law of EPC 1973 should be maintained according to the intention of the legislator and thus, a broad interpretation of ‘any specific use’ was opted for.

Use of a CTM in the Netherlands regarded as genuine use?

by Jurriaan Cleuver

In an opposition procedure before the Benelux Office for Intellectual Property (BOIP) in January 2010, it was held that the use of a Community trademark in the Netherlands only is not sufficient to conclude that the Community trademark mark has been genuinely used. While there have not been any rulings in this specific respect, it was generally assumed that the use of a Community trademark in only one EU member state was sufficient in order to maintain the registration.

Netherlands cannot be established, there is a risk that – even in the case of obvious confusing similarity – the opposition will be nonetheless rejected based on insufficient use of a Community trademark.

An important observation with respect to this decision, however, is that it originates from the BOIP, which is not a formal Court of law; thus, this specific subject is yet to be decided upon and crystallized in case law. The opponent has meanwhile filed an appeal against this decision which will serve before the Court of Appeal in The Hague.

In any event, the decision has surprised many trademark practitioners since – particularly based on the Joint Statements – it was generally assumed that use of a Community trademark in one EU member state was sufficient for being considered genuine use of the Community trademark. Soon after the decision, the Office for Harmonization of the Internal Market (OHIM) advised that, regardless of the decision by the BOIP, it shall maintain the general point of departure of the Joint Statements and consider use in one single country as sufficient. Ultimately, it is strongly questionable whether the Court of Appeal in The Hague will uphold the BOIP's decision.

To be continued no doubt...

The owner of the Community trademark ONEL filed an opposition against the application of the mark OMEL. However, before assessing the risk of confusion between the marks, the opponent was required to establish that its mark had been genuinely used in the five years preceding the opposition procedure. The opponent stated that its mark had been used in the Netherlands only. The BOIP, thus, had to rule on the principle question whether use in the Netherlands was sufficient to keep a Community trademark registration alive.

Joint statements disregarded

As there is no answer to this principle question in the Community Trademark Regulation (Regulation) itself, the BOIP was forced to resort to the Joint Statements by the EU member states developed during the drafting of the Regulation. In the Joint Statements it was considered that use in one single member state suffices to maintain one's Community trademark registration.

However, according to the BOIP, these Joint Statements are contrary to the

general principle of the Regulation and, additionally, to the preamble of the Regulation, since – according to the BOIP – these would imply that the genuine use of a mark constitutes use in the entire EU. As a result, the BOIP ruled that the Community trademark of the opponent had not been genuinely used since the use in the Netherlands alone was not considered sufficient and, therefore, the opposition was ultimately rejected.



If genuine use outside of the Netherlands cannot be established, there is a risk that – even in the case of obvious confusing similarity – the opposition will be rejected nonetheless, based on insufficient use of a Community trademark.



Far from final

This ruling could have serious consequences. After all, Community trademarks are often applied for by Benelux companies in order to be covered in the future in the case of business expansion outside of the Benelux. If genuine use outside of the

Green patents

by Robert Lelkes (The Green Team)

The European Patent Office (EPO) is engaged in a joint study with the United Nations Environment Programme and the International Centre for Trade and Sustainable Development on the relationship between patents and the development and transfer of clean energy technologies.

As an adjunct to that project, the EPO developed new subclasses with the code 'Y02' within its patent classification system dedicated solely to selected climate change mitigation technology (CCMT) areas. There are more than 100,000 patent documents classified under this patent classification. You will soon be able to use specific Y02 codes and key words to search for patent data in your field of clean technology via the esp@cenet database at www.espacenet.com.

Below you can see a graphic presentation of EPO statistics on the worldwide relative growth rates of green patent filings relative to other fields of technology published in the February 2010 issue of *Managing Intellectual Property*. The timing of increased CCMT patent activity corresponds closely to the date of the Kyoto protocol. Recent climate change regulation and incentives are expected to further increase the need for patents

to protect the enormous investments required to bring new CCMT to market.

Also in the U.S., things are moving forward. The U.S. Patent and Trademark Office announced a pilot program to expedite examination of U.S. patent applications in 'green' technologies for U.S. patent applications having a U.S. nonprovisional or international filing date prior to 8 December 2009. Participation requires submission of a request prior to a first U.S. Office action on the merits in the application to be expedited. A first Office action in the parent of a continuation or divisional application does not count against a later-filed continuation or divisional application filed prior to 8 December 2009.

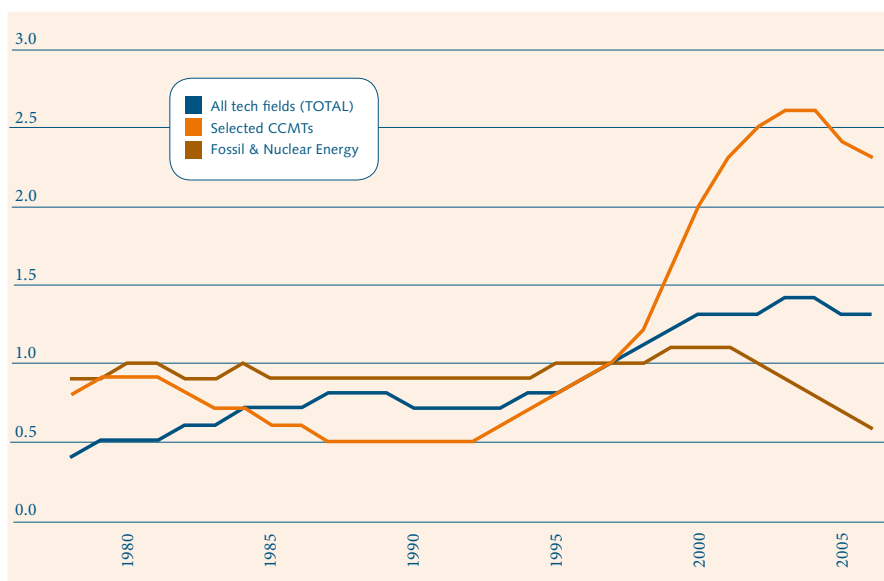
As of 21 May 2010, 950 requests for expedited examination were submitted of which 342 were accepted when

the subject matter was restricted to certain patent classifications (see our 16 December 2009 news item on www.vereenigde.com for details). According to a recent USPTO announcement, this program is now open to all kinds of 'green technology'. In view of this development, the number of granted requests is expected to increase dramatically. Since the maximum number of patent applications is limited to 3,000 this year, let us know if you would like to explore the availability of this program for your pending unexamined U.S. patent applications.

The list of countries offering the option of accelerating examination of green patent applications has been growing. Other examples include the State IP Office of the People's Republic of China (SIPO), the Korean IP Office, IP Australia, and the UK IP Office. The Patent Prosecution Highway (PPH) network offers the option of multiplying the accelerated examination effect beyond the countries offering acceleration of green technology patents.

In view of this development, disclosing the usefulness of the invention for solving environmentally relevant problems in new patent applications may facilitate obtaining expedited examination in a substantial number of countries.

Patents play a dual role in protecting the investments required to commercialize new technology while stimulating advancement in the state of the art through the spread of ideas. With public and private support for CCMT at an all time high, the time to patent your ideas in this field has never been better.



G 04/08 Language of the proceedings

Change of language of the proceedings is not possible

by Bas van Buul

In G 04/08 the Enlarged Board of Appeal of the European Patent Office (EPO) decided that, when an international patent application is filed and published in an official language of the EPO by virtue of the Patent Cooperation Treaty (PCT), it is not possible to file a translation of the application into one of the two other official languages when entering the European regional phase. As a consequence, the language of the proceedings before the EPO is fixed from the moment an international application is filed in an official language of the EPO.



In the case in question, an international patent application was filed in French under the PCT and was subsequently published in French. On entry into the European regional phase (EPO), the appointed English representative filed an English translation of the international application, with the intent that English would be the language of the proceedings. However, the English representative received official communications in French.

According to Article 14(3) EPC, the language of the proceedings shall be used in all proceedings before the EPO, meaning that all communications from the EPO will be in that language. The Enlarged Board's decision reconfirms that, although any party may use any official

language of the EPO in written proceedings (Rule 3(1) EPC), the EPO will be bound to the language of the proceedings. Moreover, any amendments of the application need to be filed in the language of the proceedings.

This also has an effect for French- or German-speaking applicants who file PCT applications in English (thereby, becoming prior art in the U.S.A. from the date of filing). As there is no possibility to change the language of the proceedings upon entry into the European regional phase, the applicants have consequently lost the advantage of having written proceedings in their native language.

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