

IP Law Update

August 2010

Important Deadlines:

EPO divisional applications – before October 1, 2010

EPC Law News:

amended Rule 141 / new Rule 70b EPC regarding foreign search results - effective January 1, 2011

EPO Case Law News:

G01/10 (T1145/09) - "Correction of grant decision after initiation of opposition proceedings"

G02/10 (T1068/07) - "Disclaimer"

G02/07 & G01/08 "Essentially biological processes"

National Case Law News:

DE FSC: X ZR 79/07 – right of inventor for compensation beyond German Employee Inventor Act

Miscellaneous:

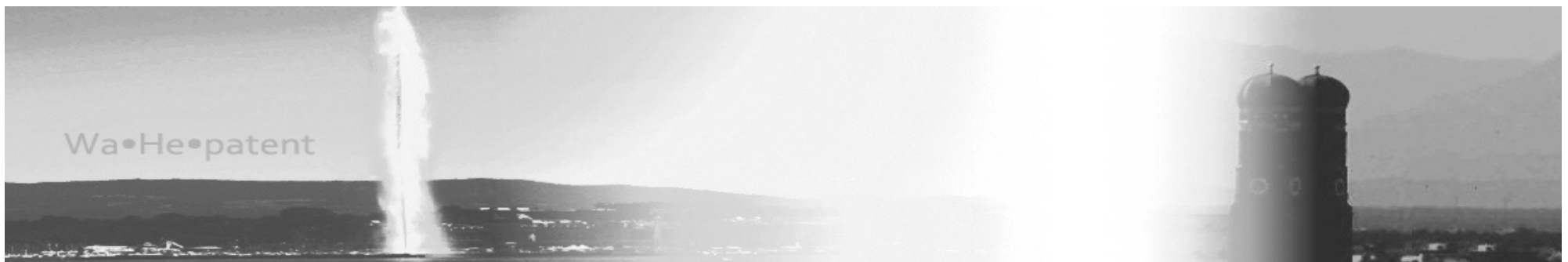
Serbia becomes EPC member state as of October 1, 2010

WAGNER + HELBIG

Patentanwälte

Intellectual Property Counselors

München – Genève



IP Law Update

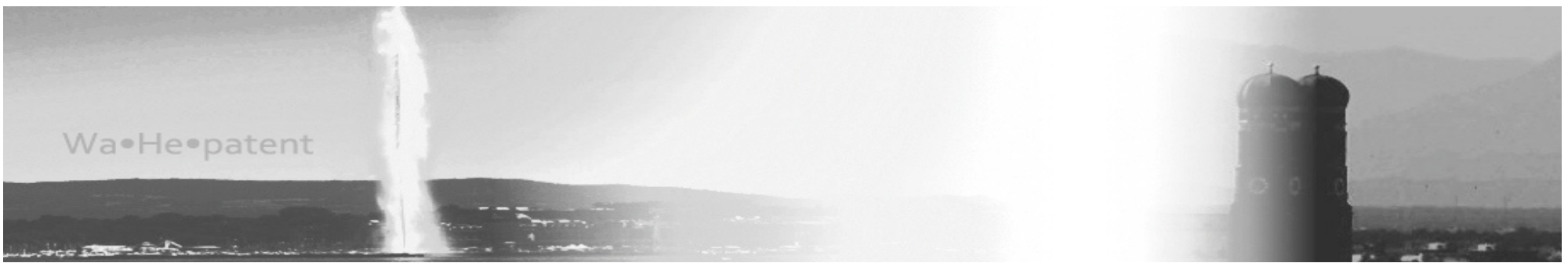
August 2010

Important Deadline: October 1, 2010 **EPO divisional applications (new Rule 36 EPC):**

According to new EPC Rules effective as of April 1, 2010 for old cases wherein an office action (Art. 94 (3) EPC) has issued 24 months before April 1, 2010 (i.e. the 24 months deadline for filing a divisional application would have expired) a transitional deadline (6 months as of April 1, 2010) is available for filing divisional applications which ends on October 1, 2010

Accordingly, we remind you to carefully review your patent application portfolios to make sure the necessary actions of filing divisional applications have been finalized with the European Patent Office before October 1, 2010 to have divisional applications available where so desired.

link: <http://www.epo.org/patents/law/legal-texts/InformationEPO/archiveinfo/20090820.html>



IP Law Update

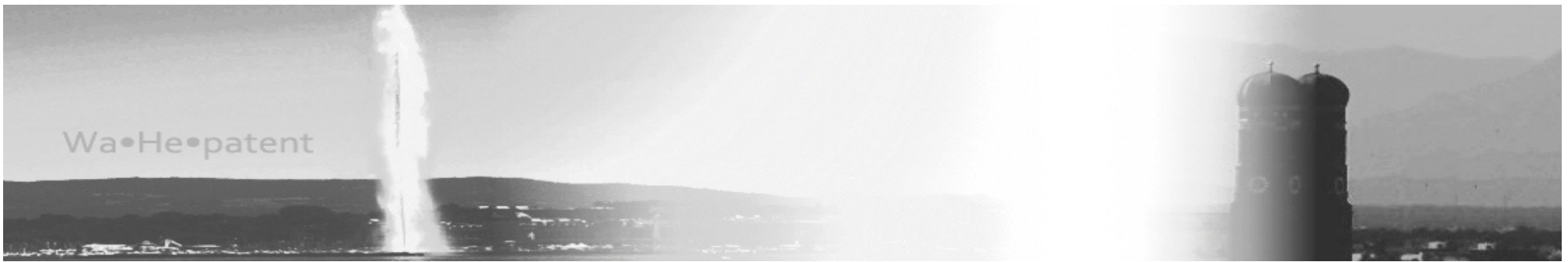
August 2010

**EPC Law News: effective January 1, 2011 (for applications filed on or after)
amended Rule 141 EPC / new Rule 70b EPC regarding information on prior art
and foreign search results:**

Amended Rule 141 (1) EPC:

- *applications for which priority has been claimed (Art. 87 EPC)*
- *prior search results have to be filed with EPO together with EP application, or on entry into the EP phase (Euro-PCT)*
- *a copy of the original search result is required (national and international)*
- *copies of the documents cited in the searches are not required*

link: <http://www.epo.org/patents/law/legal-texts/journal/informationEPO/archive/20100803.html?update=law>



IP Law Update

August 2010

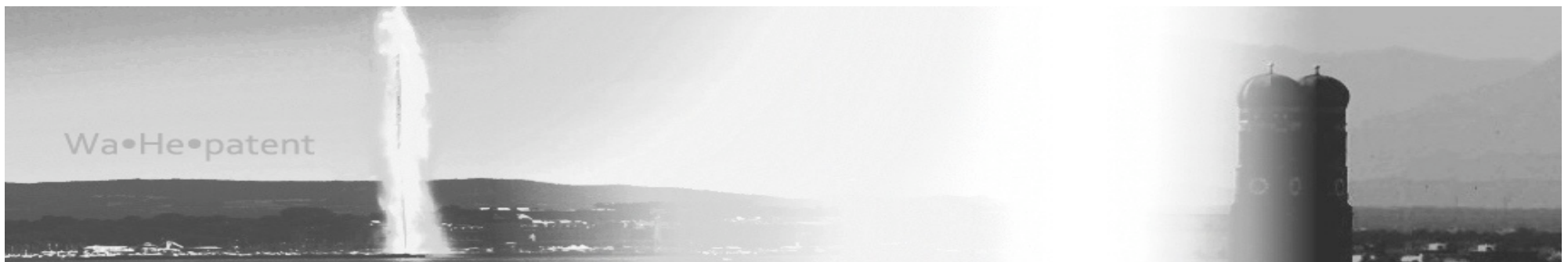
EPC Law News: effective January 1, 2011

amended Rule 141 EPC / new Rule 70b EPC regarding information on prior art and foreign search results:

Amended Rule 141 (2) EPC:

- *a copy of the search results is deemed to be duly filed if available to the EPO (may be determined by the President and EPO)*
- *so far this applies to applications for which the earlier search report has been drawn up by the EPO*
- *this may be extended in cooperation with national patent offices in the future*

link: <http://www.epo.org/patents/law/legal-texts/journal/informationEPO/archive/20100803.html?update=law>



IP Law Update

August 2010

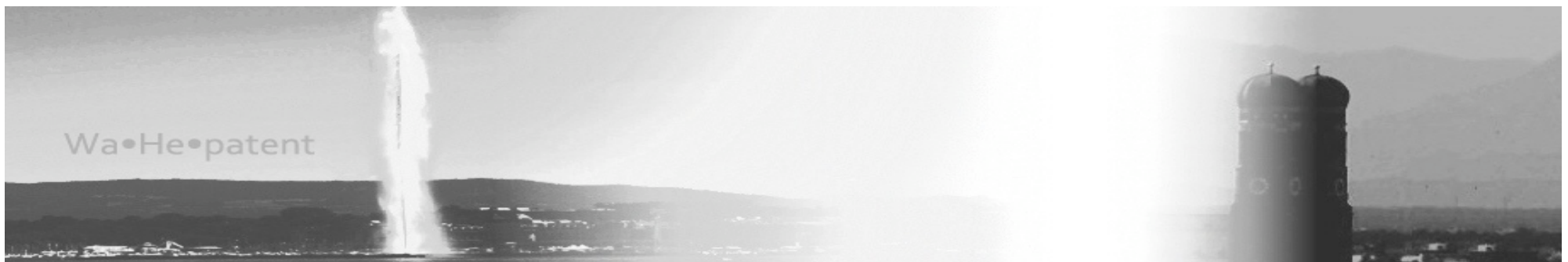
EPC Law News: effective January 1, 2011

amended Rule 141 EPC / new Rule 70b EPC regarding information on prior art and foreign search results:

Amended Rule 141 (3) EPC:

- *without prejudice to paragraphs 1 and 2 the EPO may invite the applicant to file information on prior art within a deadline of 2 months*
- *paragraph 3 will apply during the examination phase and is expected to be applied in exceptional cases*

link: <http://www.epo.org/patents/law/legal-texts/journal/informationEPO/archive/20100803.html?update=law>



IP Law Update

August 2010

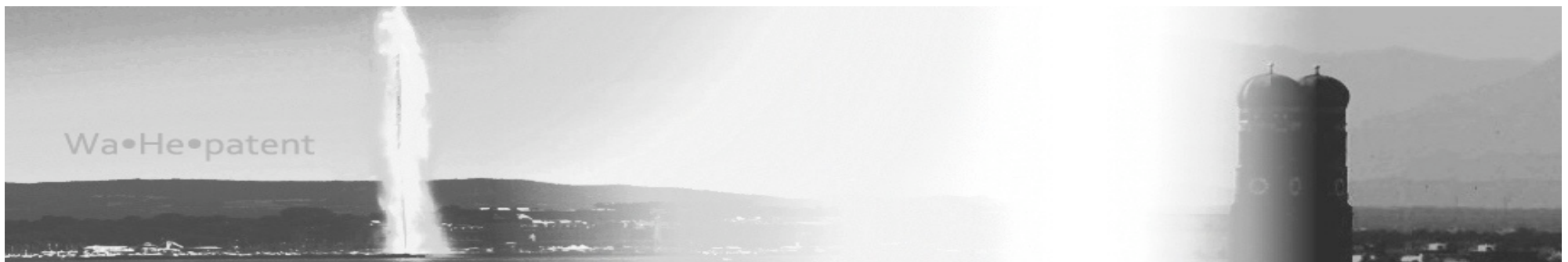
EPC Law News: effective January 1, 2011

amended Rule 141 EPC / new Rule 70b EPC regarding information on prior art and foreign search results:

New Rule 70b EPC – request for a copy of search results

- *EPO invites applicant to provide copies of relevant search results if not complied with Rule 141 earlier*
- *deadline: non-extendable 2 months => search results have to be filed or statement of non-availability (non-compliance=application is deemed to be withdrawn)*
- *Further Processing is available*
- *applies also to divisional applications*

link: <http://www.epo.org/patents/law/legal-texts/journal/informationEPO/archive/20100803.html?update=law>



IP Law Update

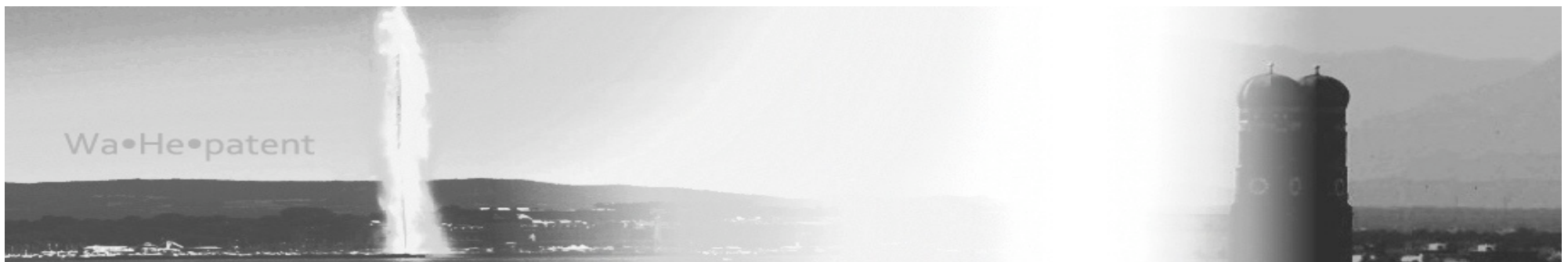
August 2010

Case Law News:

G01/10 (T1145/09) - "Correction of grant decision after initiation of opposition proceedings"

Questions referred to the Enlarged Board of Appeal:

- 1. Is a patent proprietor's request for correction of the grant decision under Rule 140 EPC which was filed after the initiation of opposition proceedings admissible? In particular, should the absence of a time limit in Rule 140 EPC be interpreted such that a correction under Rule 140 EPC of errors in decisions can be made at any time?*
- 2. If such a request is considered to be admissible, does the examining division have to decide on this request in ex parte proceedings in a binding manner so that the opposition division is precluded from examining whether the correction decision amounts to an unallowable amendment of the granted patent?*



IP Law Update

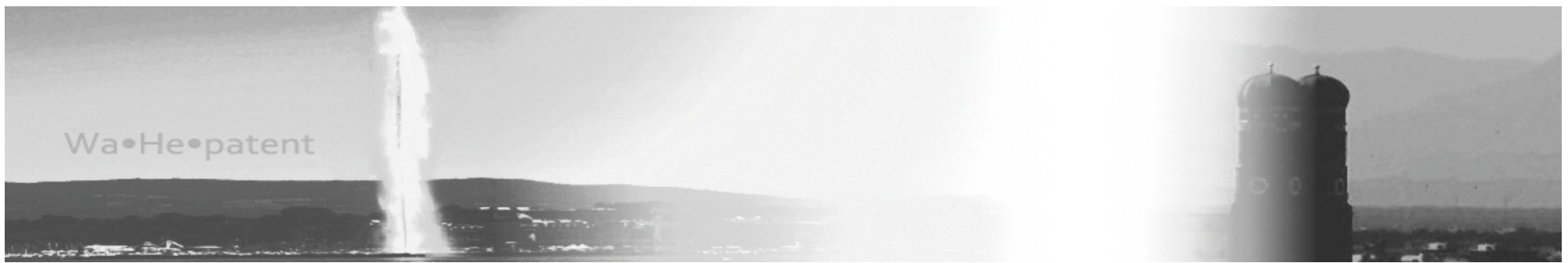
August 2010

Case Law News:

G01/10 (T1145/09) - "Correction of grant decision after initiation of opposition proceedings"

The case concerns the introduction of an “obvious error” during pre-grant proceedings with significance for the question of Art. 123 (2) EPC in the opposition.

The issue is if such an obvious error may be rectified by remittance to the Examining Division and if thus the ground for revocation pursuant to Art. 123 (2) EPC may be circumvented.



IP Law Update

August 2010

Case Law News:

G02/10 (T1068/07) - "Disclaimer"

Question referred to the Enlarged Board of Appeal:

“Does a disclaimer infringe Article 123(2) EPC if its subject matter was disclosed as an embodiment of the invention in the application as filed?”



IP Law Update

August 2010

Case Law News:

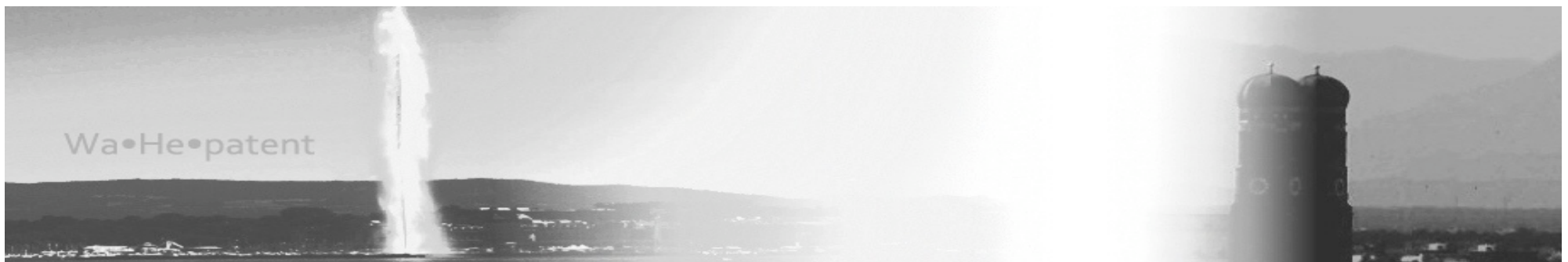
G02/10 (T1068/07) - "Disclaimer"

– "disclosed embodiment"/"undisclosed disclaimer"

The case concerns a catalytic DNA in an ex parte proceedings, allegedly implicitly disclosed features and the refusal of the application on the grounds of Art. 123 (2) EPC with the reasoning that the criteria set out in G1/03 ("Disclaimer Decision") were not met.

A disclaimer was introduced into part of the auxiliary requests during the appeal proceedings with the reasoning that in view of T1107/06 and T1139/00 G1/03 does not apply if the disclaimer was disclosed in the application as filed. Further reference was made by appellant to T1050/99 and G1/07 (point 4.2.3. of the Reasons) wherein the divergence of case law was acknowledged.

This divergence of case law and possible different conclusions in the present case was acknowledged by the Board of Appeal and thus the referral was made to the Enlarged Board of Appeal.



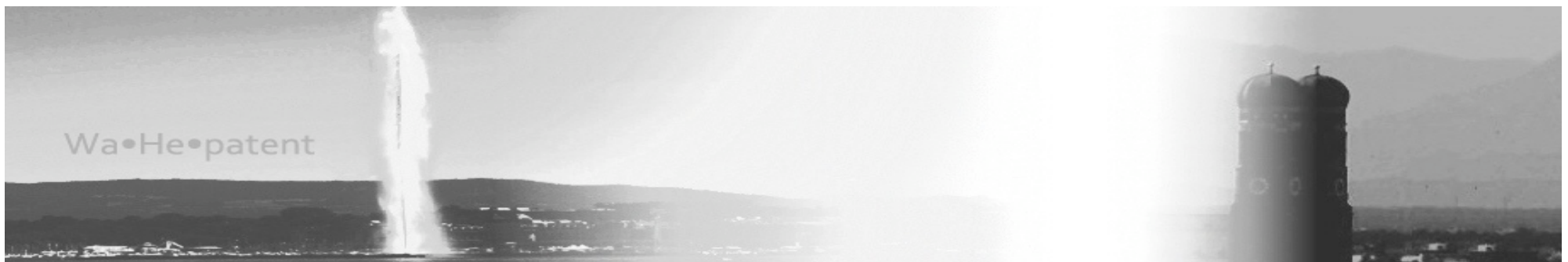
IP Law Update

August 2010

Case Law News: hearing held July 20/21, 2010 G02/07 & G01/08 "Essentially biological processes"

Questions referred to the Enlarged Board of Appeal:

1. Does a non-microbiological process for the production of plants consisting of steps of crossing and selecting plants fall under the exclusion of Article 53(b) EPC only if these steps reflect and correspond to phenomena which could occur in nature without human intervention?
2. If question 1 is answered in the negative, does a non-microbiological process for the production of plants consisting of steps of crossing and selecting plants escape the exclusion of Article 53(b) EPC merely because it contains, as part of any of the steps of crossing and selection, an additional feature of a technical nature?
3. If question 2 is answered in the negative, what are the relevant criteria for distinguishing non-microbiological plant production processes excluded from patent protection under Article 53(b) EPC from non-excluded ones? In particular, is it relevant where the essence of the claimed invention lies and/or whether the additional feature of a technical nature contributes something to the claimed invention beyond a trivial level?



IP Law Update

August 2010

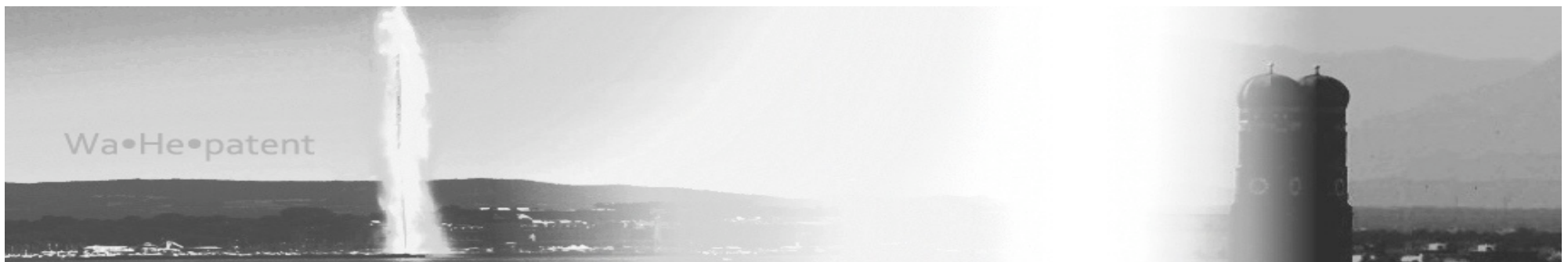
Case Law News: hearing held July 20/21, 2010 G02/07 & G01/08 "Essentially biological processes"

The two proceedings concern the so called "broccoli and tomato"- cases which have been consolidated in one hearing.

EP1069819 (Plant Bioscience Ltd.) and EP1211926 (Israeli Ministry of Agriculture) relate to plant breeding methods and marker-assisted selection. The issue is to clarify the term "essentially biological processes for the production of plants or animals".

The Enlarged Board will assess whether in view of the relevant EPC provisions marker-assisted selection is a biological breeding process or is a technical method and therefore patentable.

The decision is likely to be taken towards the end of the year and to be issued in written form 2010/2011.



IP Law Update

August 2010

National Case Law News: German Federal Supreme Court (BGH) X ZR 79/07 “Steuervorrichtung” – compensation for exclusive position

The employed inventor may still have claims against his employer even though the invention was not considered patentable by the patent office and though the invention was not claimed by the employer according to German Employee Invention Act.

If the employer has used the invention (in his entity or licenced out) and he has gained an exclusive position, the employer is obliged to render account of his profits to the employee (PatG § 6; BGB § 812 Abs. 1 (Eingriffskondiktion)).

link:

<http://juris.bundesgerichtshof.de/cgi-bin/rechtsprechung/document.py?Gericht=bgh&Art=en&sid=c1f7a6282f9a6db1ee57e61f7fd8b23e&nr=52499&pos=0&anz=1>



WAGNER + HELBIG
Patentanwälte
Intellectual Property Counselors

München - Genève

München +49 89 211 87120

Genève +41 22 362 4260

www.wahe-patent.com

Disclaimer: This communication is intended for general information purposes and as a service to clients and friends of WAGNER + HELBIG Patentanwälte. This communication should not be construed as legal advice or a legal opinion on any specific facts or circumstances, nor does it claim completeness of the described cases and it does not create an attorney-client relationship.