



NEWSLETTER

Fee Changes at the Trade Marks and Designs Registration Office of the EU (OHIM) as from May 1st, 2009 / Act for Simplification and Modernisation of the German Patent Law" passes the German Parliament / Recent and Future Developments in EP Patent Practice / German Federal Court of Justice, Decision of December 16th, 2008: "Olanzapin"

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/ Fee Changes at the Trade Marks and Designs Registration Office as from May 1st, 2009

Due to significant changes to the fee structure for Community trademark applications the costs have fallen by around 40%. Essentially, the official registration fees have been completely abolished accompanied by a slight increase in the application fees.

Previous fees for a CTM application (including up to 3 classes)

	Application fee	Registration fee	Total fee
E-filing	EUR 750	EUR 850	EUR 1,600
Paper-filing	EUR 900	EUR 850	EUR 1,750

New fees effective from May 1st, 2009 (including up to 3 classes)

	Application fee	Registration fee	Total fee
E-filing	EUR 900	EUR 0	EUR 900
Paper-filing	EUR 1,050	EUR 0	EUR 1,050

Additional class fees for each class after the first three classes when filing the application will remain at EUR 150, whereas additional class fees at registration will be omitted.

CTM applications which are already in the pipeline will benefit from the new fee system. Pursuant to transitional arrangements applicants do not have to pay the old registration fee if the application is not ready for registration, i.e. the CTM Office has not issued the request letter for payment of the registration fee by May 1st.

Furthermore, the registration fees for designation of the EU under an International Registration (Madrid Protocol) will be reduced from EUR 1,450 to EUR 870.

These new fees will become effective 3 month after the effective date, namely August 2009. By implication, during this time period it will be less expensive to file a CTM application directly with the CTM Office than designating the EU under an International Registration.

Author: Friederike Brauer

/ "Act for Simplification and Modernisation of the German Patent Law" passes the German Parliament

On May 28, 2009, the German Parliament passed the "Act for Simplification and Modernisation of the German Patent Law" (Gesetz zur Vereinfachung und Modernisierung des Patentrechts).

The core aim of the new law is to streamline the patent invalidity system in Germany. In Germany, the patent infringement courts are not concerned with questions regarding the invalidity of the patent. Invalidation of German patents (as well as of German parts of European Patents) falls under the exclusive jurisdiction of the Federal Patent Court ("Bundespatentgericht"). Appeals against the decisions of the Bundespatentgericht are handled by the Federal Supreme Court ("Bundesgerichtshof").

Under the new provisions of the Act, fact-finding and the introduction of evidence is to be concentrated to the largest possible extent in the first instance before the Federal Patent Court. Appeals before the Supreme Court are now mainly limited to the legal revision of the first instance decision.

There are further regulations aiming at reducing the length of the procedure, for example specific guidelines to the parties given by the court as to which aspects of the case are considered to be of importance to its decision in order to direct the parties to focus their submissions accordingly (qualified guideline / "qualifizierter Hinweis").

The new Act will change and particularly shorten the patent invalidity system in Germany considerably.

Author: Wolfgang Sandmann

/ Recent and Future Developments in EP Patent Practice

As of April 1st, 2009 the EPO has changed their fee structure. Now, an additional fee of EUR 12 for the 36th and each subsequent page of an application is due, wherein the figures, claims and the abstract need to be counted as well. Pages rendering a sequence listing in the proper WIPO standard are not counted. For Euro-PCT applications this additional page fee is calculated on the basis of the corresponding International application as published. For example, a Japanese language publication of a PCT application entering the regional European phase comprises 40 pages description, 9 pages figures, 10 pages claims and one page abstract and bibliographic data. This results in an additional fee of EUR 300 to be remitted as part of the filing fee. If a European application is filed by reference to a previous application the number of pages of the certified copy which has to be provided to the EP application forms the basis for the calculation of the page fee. Applicants can take into account this new fee by amending their templates for patent applications as to condense as much text or information on one application page as possible.

Hence, it is advisable to ideally exploit the formats of application documents as set out in the

EPC, i.e. utilizing minimum margins, minimum-size capital letters and 1,5 spaced typing.

Additionally, EPO introduced a flat designation fee of EUR 500 covering all contracting states if the applicant does not withdraw selected states explicitly.

Further, excess claims fees are altered: for each claim from the 16th to 50th EUR 200 are due, and for the 51st and each subsequent claim EUR 500 are to be paid.

As of April 1st, 2010, EPO introduces time limits for the filing of divisional applications.

- a) Voluntary divisional applications of the applicant will only be allowed within a period of 24 months from the first office action by the EPO examining division in respect of the parent application.
- b) If during the examination proceedings the EPO examining division issues a notice of non-unity a divisional application can be filed within 24 months. If the examining division issues an other notice based on a different ground of lack of unity a further term of 24 months for filing a divisional application is due.

- c) The new provisions will immediately apply for all pending applications on April 1st, 2010.
- d) A grace period of 6 months will allow the filing of voluntary divisionals until October 1st, 2010 regarding already pending applications. Therefore, all pending applications should be studied for eventually filing a voluntary application within this grace period.

A mandatory response to the written opinion issued with the European search report will be introduced by April 1st, 2010. This reply from applicants, required before entering examination, will allow them six months to research and justify any issues raised in the written opinion. For Euro-PCT applications where the EPO was not the International search authority a supplementary European search report is issued to which a mandatory response is required within six months as well. The new regulations will affect European applications where the European search report or supplementary European search report is issued after April 1st, 2010.

For Euro-PCT applications where the EPO was the International search authority no supplementary European search report is issued, and an invitation to respond to the written opinion/international search report drawn up by the EPO will be issued shortly after entry to the European regional phase. The time limit for responding to this invitation is only one month. If no reply is filed in due time, the application will be deemed withdrawn. Therefore, applicants should start preparing comments and/or amendments already before or shortly after entering the regional phase. The new provisions regarding the mandatory reply to the written opinion where the EPO was the International search authority will be applicable to applications where an invitation to amend the claims has not yet been issued by the EPO on April 1st, 2010.

This information is simplified and must not be regarded as a statement or advice of law or practice.

Author: Dr. Tobias Kleimann

/ German Federal Court of Justice, Decision of December 16th 2008: "Olanzapin"

In December 2008, the Federal Court of Justice (BGH) decided:

"The disclosure of a chemical structural formula in principle does not entail the disclosure of the individual compounds encompassed by this formula."

In the first instance, the Federal Patent Court had revoked the patent in nullity proceedings, deciding that the subject-matter of the patent was not novel because a generic formula which encompassed Olanzapin, the specific claimed compound, had already appeared in an earlier publication. However, the Federal Court of Justice corrected the decision and maintained the patent.

This decision is of considerable significance for patent law in the field of chemistry, and had been awaited with some anticipation, also on account of the

events leading up to the decision. Whilst the EPO Boards of Appeal regularly deal with questions of this nature in the second instance, the German Federal Court of Justice, as the final instance for German administrative and judicial proceedings, only rarely has the opportunity to decide on such fundamental matters. The Federal Court of Justice was at last able to deal with this matter – whether the disclosure of a general chemical formula similarly entails the disclosure of all individual compounds of this formula in a manner prejudicial to novelty – in the "Fluoran" decision in 1988 (GRUR 1988, pp. 447-450). On that occasion, the Federal Court of Justice had left it open in the head note as to whether a previously disclosed formula always anticipated the chemical formulae it covered, but in the discussion of facts on which the decision was based, the court reached the conclusion that this was indeed the case.

The "Fluoran" decision caused major difficulties for patent applicants in the following years, as it is very common for a specific, innovative compound to fall within the scope of an earlier, general disclosure. Until now this decision made it difficult to meet the novelty criterion for a specific chemical compound, even if it was not obvious in view of a previous unspecific generic disclosure and exhibited notable advantageous properties. The "Fluoran" decision therefore had the result that it was generally assumed in the literature, in the German Patent Office and in the Federal Patent Court that a general chemical formula was prejudicial to the novelty of all individual compounds which it specifically encompassed.

This was particularly problematic because precisely the opposite was established in the case-law of the Boards of Appeal of the EPO, i.e. that a generic formula actually does not disclose all the individual compounds with this formula. For example, in the decision T181/82 it was decided that the disclosure of "C₁-C₄ alkyl" did not entail the disclosure of a specific butyl radical. The discrepancy between the case-law of the EPO and the Federal Court of Justice could therefore lead to the absurd legal situation where the German part of a European patent could be overturned in nullity proceedings in Germany on the basis of lack of novelty. This problem is summarised, for example, in "Auswählerfindungen auf dem Gebiet der Chemie – Brauchen wir einen deutschen Sonderweg?", B. Hansen, GRUR International 2008, pp. 891-899.

The case was particularly interesting because in an unusual course of action, the Düsseldorf Provincial Court of Appeal issued a temporary injunction against a supposed infringer of the patent even though the Federal Patent Court had, at this time, already passed the decision to revoke the patent based on lack of novelty. The courts usually issue a temporary injunction due to patent infringement only if there is no

doubt as to the validity of the patent. However, the Düsseldorf Provincial Court of Appeal was so convinced that Olanzapin was novel that the court disregarded the contradictory decision of the Federal Patent Court. The Federal Court of Justice has retrospectively affirmed the judgement of the Düsseldorf Provincial Court of Appeal.

The "Olanzapin" judgement of the Federal Court of Justice expressly confirms that it shall not abide by the earlier "Fluoran" decision insofar as it has different implications from the "Olanzapin" decision. The Federal Court of Justice also expressly states that it views the decision as being in accord with the case-law of the Boards of Appeal of the EPO.

The conclusions made by the Federal Court of Justice in the "Fluoran" decision on the disclosure of prior art documents are so general as to be of significance even for practitioners in technical fields other than chemistry.

The "Olanzapin" decision is also of general interest for another reason. The Federal Court of Justice also discusses the EPO's problem-solution approach for the assessment of an inventive step in the grounds for the decision. The court claims, almost heretically, that this approach, which is considered highly objective by the EPO, would result in a retrospective point of view, which is to be avoided. Specifically, the Federal Court of Justice does not consider it appropriate to evaluate the inventive step starting from a single "closest prior art" document. Rather, the state of the art as a whole should be taken into consideration. This provides interesting possibilities for those in the field when arguing in favour of (or against) an inventive step in German proceedings.

The decision (BGH X ZR 89/07) is published in GRUR 2009, pages 382 f.

Author: Dr. Gregor Steglich

The contents of this Newsletter are intended to inform on recent developments in national and international industrial property protection. We have taken considerable care in the preparation of the contents, cannot however assume responsibility for the correctness and completeness of the information given. Should you have any questions on the topics dealt with in the Newsletter, please contact us by email at the address given below.



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