

## **MEDICAL USE (USA)**

Allows patenting of  
medical methods

## **MEDICAL USE (UK)**

s.4A(2) permits  
substances for use in a  
medical method

## **MEDICAL USE (UK)**

s.4A(1) excludes  
medical use

## **PRES. OF INFO.**

### **BBC T163/85**

A physical improvement  
by technical means

## **ALICE v CLS BANK**

Claims were to an abstract  
idea. Implementing as  
software was not enough to  
make it patentable.

## **EXCLUSIONS (USA)**

- Laws of nature
- Physical phenomena
- Abstract ideas

# **TECHNICAL EFFECT**

Vicom T208/84

Physical change to either a mechanical object or an electrical signal

# **DIAGNOSTIC METHOD**

1. Examination (data)
2. Comparison
3. Deviation (symptom)
4. Decision (attribution)

# **PRES. OF INFO.**

Philips T1194/97

Data not characterised by content ∴ allowable

# **NOVELTY**

*Art. 52 EPC*

*s.2 PA 1977*

## **COMPUTERS, AT&T**

- i. Tech. effect outside computer
- ii. Architectural level effect
- iii. Computer operates in new way
- iv. Increased speed / reliability
- v. Problem overcome, not circumvented

## **TECH. CONTRIBUTION**

Merrill Lynch

“must be a technical  
contribution or advance”

# **NOVELTY OF PURPOSE**

Mobil Oil G2/88

Friction Reducing Additive

# **MEDICAL USE**

1st s. 4A(3) PA 1977

2nd s. 4A(4) PA 1977

# **PRIORITY**

Paris Convention

*Article 4*

# **EMPLOYEE INVENTIONS**

*s. 39 PA 1977*

## **POZZOLI TEST**

- 1A. Skilled person
- 1B. CGK
2. Inventive concept
3. Differences
4. Obvious

## **WINDSURFING TEST**

1. Inventive concept
2. Skilled person
3. Differences
4. Obvious

## **ABSOLUTE GROUNDS**

Distinctive = s.3(1)(b) TMA

Descriptive = s.3(1)(c) TMA

## **SIECKMANN CRITERIA**

Clear

Precise

Durable

Objective

Self contained

Easily accessible

## **SECONDMENT**

Owned by the  
employer, not the host

## **RELATIVE GROUNDS**

Identical mark      s.5(1)  
+ identical goods      *TMA*

No likelihood of confusion

## **RELATIVE GROUNDS**

Identical mark      s.5(2)(a)  
+ similar goods      *TMA*

Likelihood of confusion req.

## **RELATIVE GROUNDS**

Similar mark      s.5(2)(b)  
+ identical or      *TMA*  
similar goods

Likelihood of confusion req.



## **AURAL SIMILARITY**

- Syllables in common
- Length of word
- 1st syllable dominates

## **VISUAL SIMILARITY**

- Words > devices
- Length of words
- Structure of words

## **RELATIVE GROUNDS**

- Mark with reputation
- Detriment to distinctiveness

*s.5(3)(a) TMA*

## **PRIORITY**

Patents = 12 months

T. Marks = 6 months

Reg. Des. = 6 months

## **PASSING OFF**

1. Goodwill
2. Misrepresentation
3. Damage to goodwill

## **NON-ORIGIN FUNC.**

Blurring = erosion

Tarnishment = unsavoury  
connotations

## **UK SEARCH**

Patents Form 9A

£180 (£150)

search fee

## **UK APPLICATION**

Patents Form 1

£90 (£60) fee

within 12 months

## **PROBLEM & SOLUTION**

1. Closest prior art
2. Differences
3. Technical effect
4. Objective technical problem
5. Obvious?

## **UK COMPLIANCE PERIOD**

**4½ years**

*(or one year from 1st exam report)*

## **UK EXAMINATION**

Patents Form 10

£130 (£100) fee

6 months after publication

## **UK INVENTOR INFO.**

Patents Form 7

within 16 months

# **PCT EXAMINATION**

Chapter 1 = no IPE

Chapter 2 = IPE demand

# **PCT APPLICATION**

Form RO/101

+ transmittal fee

+ search fee

+ filing fee

# **NON-PCT STATES**

Taiwan

Pakistan

Iraq

# **EPC STATES**

## **38 EPC states**

Extension = Bosnia-Herzegovina,  
Montenegro

Validation = Cambodia, Moldova,  
Morocco, Tunisia

## **PCT 30 MONTHS**

UAE            Japan

Brazil           Mexico

Canada           Saudi Arabia

China            USA

## **PCT 31 MONTHS**

Australia           Russia

EPO            South Africa

UK            India

N-Zealand

# UNITY OF INVENTION

## *Art. 82 EPC*

Single general inventive concept  
2 months to respond

# EPO DIVISIONALS

## Form 1001

Pay filing fee + search fee

Additional fee for 2<sup>nd</sup>+ gen

All backdated renewals

# PRIOR ART CAT.S

X = relevant alone

Y = relevant combined

A = tech. background

E = earlier pat., later pub.

## **EPO RENEWALS**

Due at end of 3rd year  
(36 months)

## **BASIC EPO FEES**

Filing = €120

Search = €1300

Exam. = €1635

Desig. = €585

## **EURO-PCT**

Entry at 31 months

Exam + designation  
fees due upon filing



## **USA RENEWALS**

From date of grant

3½ years

7½ years

11½ years

## **EPO OPPOSITION**

9 month deadline

Form 2300

€785 fee

## **EPO APPEALS**

2 months to file

€1880 fee

## **PARIS CONVENTION BENEFITS**

Less expensive overall

Less delay

If certain on countries

## **PCT BENEFITS**

If uncertain where to file

To buy more time

Less fees upfront (more total)

## **EPO OTHER FEES**

Grant = €925

Claims = €235 (€585)

Exten. = €102

## **UK EXAMINATION**

Two months to respond

Will not refuse on relative grounds, will notify owner

## **UK EXTENSION<sub>OF</sub> TIME**

Form TM9

£100 fee

## **UK APPLICATION**

Form TM3

£200 app. fee

£50 class fee (each)

## **DEFENCE & COUNTERSTATEMENT**

Form TM8

2 months for applicant to  
respond, non-extendable

## **FILING UK OPP'N**

Form TM7

& Statement of Grounds  
£100-200 fee (*dep. on grounds*)

## **UK OPP'N DEADLINE**

2 months to oppose

Form TM7a to extend  
by one month

## **FAST-TRACK OPP'N**

Form TM7F

£100 fee

s.5(1) & s.5(2) grounds only

## **REQ. FULL DECISION**

Form TM5

£100 fee

1 month deadline

## **COOLING OFF**

TM9C (Request) = 9 months

TM9E (Extend) = +9 months

TM9I (*by opponent*) = terminate

TM8 (*by applicant*) = terminate

## **EUTM FEES**

Basic fee = €850

2nd class = €50

3rd+ class = €150

Nat. search = €72

## **EUTM OFFICIAL LANG.**

English

French

German

Italian

Spanish

## **UK APPEALS**

Form TM55  
& Grounds of Appeal  
28 day deadline

## **EU OPPOSITION**

3 months from publication  
€320 fee

## **SENIORITY (EU ONLY)**

Within 2 months of filing  
Earlier mark allowed to lapse  
Triple identity (mark, person, G&S)

## **PRIORITY (PARIS CONV.)**

Must claim on filing  
Marks < 6 months before

## **PRE-ACTION PROTOCOLS**

Letter of claim

Essential docs enclosed

Set time limits for response

## **INTERNATIONAL REG.**

Basic app./reg. must not  
be revoked within 5 years

## **NON-MADRID PROTOCOL**

Brazil      Argentina

Canada     Hong-Kong

UAE         Saudi-Arabia

Taiwan      Malaysia



## **FILING DEFENCE**

14 days to acknowledge  
+ 14 to file defence  
(& opt. counterclaim)

## **PARTICULARS OF CLAIM**

Must be served within 14  
days of claim form

## **SERVING CLAIM FORM**

Form N1  
File at court  
Serve on defendant

# HIGH COURT TRIAL

1. Preliminary issues
2. Claimant opening remarks
3. Defendant opening remarks
4. Exam. in chief of claimant & witness
5. Cross-exam. by defendant
6. Exam. in chief of defendant & witness
7. Cross-exam. by claimant
8. Defendant closing remarks
9. Claimant closing remarks

# DOCUMENT PRIVILEGE

Advice priv. = attorney-client

Litigation priv. = docs for litig.

Common interest priv. = docs  
between parties with interest in litig.

# HIGH COURT TRACKS

Small Claims < £10k

Fast-Track £10k-£25k

Multi-Track >£25k

## **DEFENCE / CTR-CLAIM (IPEC)**

14 days to acknowledge  
Response = 42 days, or  
70 days (if no letter before claim)

## **IPEC CAPS**

Costs < £50,000  
Damages < £500,000

## **HIGH COURT APPEALS**

1st Court of Appeal  
2nd Supreme Court

## **IPEC SMALL CLAIMS**

**Claim value < £10k**

Usually copyright, TM,  
passing off, unreg. designs

## **REPLY TO DEFENCE TO CTR-CLAIM**

14 days for  
defendant to respond

## **REPLY TO DEFENCE (IPEC)**

28 days for  
claimant to respond

## **CMC (IPEC)**

Orders are made  
permitting witnesses,  
experts, disclosure, etc.

## **ALTERNATIVE DISPUTE RESOLUTION**

- Conciliation (non-binding)
- Mediation (binding)
- Arbitration (binding)
- Expert determination (opt. binding)

## **EPO 3RD PARTY OBS.**

Filed online, no fee  
Optionally anonymous  
Must be prior to grant

## **EPO TRANSFER**

No official form

Proof of transfer req'd

€100 admin. fee

## **GLOBAL APPRECIATION**

Sabel v Puma, 1988

Similarities

(visual, aural, conceptual)

& dominant features

## **EPO OPPOSITIONS**

Grounds for Opp.

*Art. 100 EPC*

## **DIVISIONAL SEARCH**

Search fee is refunded  
after filing if already  
searched in parent app.

## **RESP. TO EXAM REP.**

4 month deadline

## **71(3) RESPONSE**

4 month deadline  
€925 grant fee  
& translation of claims

## **UK TRANSFER**

Patents Form 21

£50 admin. fee



