



Clear direction



Technology and Engineering **UPDATE**

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Affordable and rapid protection for designs in Europe

The registered Community design (RCD) system provides a quick and economical way to protect designs in all 28 countries of the European Union (EU). The coverage of an RCD will also expand automatically to cover any new countries that join the EU.

RCD protection is particularly well suited to technology startups that have a limited budget, such as those that are going through the crowdfunding process. However, the RCD system is also used effectively by individuals, small to medium sized entities and multinational corporations.

An RCD protects the outward appearance of a product, as opposed to the way in which a product functions. The design does not need to be eye-catching or even aesthetically pleasing, although there are exclusions for designs that are contrary to public policy or morality. Designs that are solely dictated by their technical function (e.g. the arrangement of pins on a plug and socket) also cannot be validly registered.

In most cases, an RCD will be used to protect the appearance of a product that is entering the market. However, an RCD can also protect graphical designs, such as screen icons, graphical user interfaces, symbols, repeating patterns, animations, logos and typefaces.

An RCD is deemed to be valid if the design is new and has individual character. A design is new if no identical design has been made available to the public before the filing/priority date of the RCD application. A design has individual character if it produces a different overall impression on an informed user who is familiar with designs that were available to the public before the filing/priority date of the RCD application.

Any disclosures made by the designer within a 12 month period before the filing date of an RCD will not affect the validity of the RCD. Valid RCD protection can therefore be secured even after a product is launched, when valid patent protection would no longer be possible in Europe.

We almost always recommend filing unshaded line drawings in an RCD application to maximise the scope of protection. Line drawings result in a broader scope of protection than photographs or shaded images, where the shading or texture of the surfaces might unduly limit the scope of protection of an RCD. It is also important to decide whether colour is an important component of the design.

Features of a design can be disclaimed from an RCD by showing the non-limiting features in a dotted line. If a design comprises dotted lines or stripes then care must be taken to ensure that these features are not accidentally disclaimed from the scope of the RCD.

An RCD will likely proceed straight to registration, usually within a few weeks of the filing date, because the Community designs office (OHIM) does not carry out a substantive examination on the design. The RCD would only be examined substantively if a third party applies to invalidate the registration or if the RCD is ever involved in litigation. An RCD lasts for a maximum 25 year term, renewable in 5 year blocks.

It is important to bear in mind that the representations of the design in an RCD will be published shortly after it is registered, which can occur less than one week from filing. If a design must be kept confidential, for instance if the design is for a product that has not yet been launched, then publication of the RCD can be deferred by up to 30 months from filing/priority. An RCD application

can therefore remain unpublished until a request for publication is filed at an appropriate time, such as after the public launch of a product.

Once an RCD has been registered, it is possible to put customs in any or all of the 28 EU countries on notice for infringing products that might be imported. Customs will seize products that appear to infringe the RCD and notify the proprietor. An RCD can therefore be used together with a customs application to effectively police the importation of infringing products into the EU.

Please contact us here at Forresters if you would like any further information about RCD protection.

[Andy Harding](#)





UK IPO 'IP Audits Plus' scheme - would your company benefit from £3,000 of funding?

The 'IP Audits Plus' scheme funded by the UK IPO offers funding £3,000 (including VAT) which works on a referral basis and is available to companies engaged on one of the IPO's partner's business support schemes. These partners are the GrowthAccelerator programme, Welsh Government and Scottish Enterprise.

What activities fall in the scope of IP Audits

Plus?

The aim of the scheme is to help SMEs develop their IP strategies by having an IP Audit conducted by a qualified IP professional of their choice. The aim is to cover all aspects of an SME's IP. For example, it may include the following activities (not exhaustive):

- **Patents:** producing a schedule of pending applications, granted patents and potential patentable technology and review status information;
- **Trade marks:** producing a schedule of registered and unregistered trade marks, reviewing search protocol before introducing a trade mark;
- **Designs:** assessing registered and unregistered rights, considering suitability of protection available under Design Right and Unregistered Community Design Right;
- **Copyright:** reviewing copyright works, e.g. websites, marketing/promotional material, software, photography, considering ownership entitlement of existing copyright works;
- **Freedom to operate searches:** searching third party rights to identify potential infringement risks against products / methods of manufacture with regard to patents, trade marks and designs; and
- **Patent landscaping:** analysing the patent space around areas of technical interest to your company, analysing competitor portfolios.

However, it should be noted that the IP Audits Plus funding cannot be used to seek IP protection by preparing and filing for IP protection, e.g. filing an application for a patent, registered trade mark or registered design. Having said that, the funding can be used to identify potential IP rights within a company that could be protected.

What do you get at the end of it?

A company that qualifies for the scheme will be provided with a report summarising key recommendations and next steps on how to use its IP more effectively. Forrester's has prepared advice in regard to patent landscaping for clients embarking on a new sector and potential copyright / trade mark infringement in relation to a competitor's package design.

Who can apply?

You must be an SME that is working with any of the recognised partners listed above. To successfully qualify, you must demonstrate a sound business need and submit a short application detailing the anticipated benefits of the audit to the partner you have engaged. The process is generally quite swift with applications being decided on within a few days.

How can Forrester's help?

We can help from the initial stages of preparing an application to qualify for the audit through to conducting the IP audit and preparing the required audit report. Please contact your usual Forrester's contact if you would like more information.

Dr Jagvir Purewal



An update on the EU unitary patent and the Unified Patents Court

Since Italy joined the unitary patent earlier this year, the unitary patent will be a single patent covering 26 of the EU member states. Of the EU member states, only Spain and Croatia will not be covered by the unitary patent.

The unitary patent will be available in addition to existing national patents and European patents. Once a European patent has been granted in the normal way, it will be possible to request that it takes effect as a unitary patent, covering these 26 EU member states.

Under the current system, once a European patent is granted, it must be validated individually in each country, and renewal fees are also payable separately for each country in which the patent is validated. An advantage of the unitary patent is that only one renewal fee needs to be paid each year in respect of the 26 member states, and this will reduce the administrative burden for patent owners.

The level of the renewal fees for the unitary patent were decided earlier this year. The cost of renewing a unitary patent for the first ten years will be a little over €4,500, and the cost for renewing a unitary patent for the full 20-year term will be a little over €35,000. These fees are set to be roughly equivalent to the combined renewal fees that would be payable if a European patent was validated in the four most popular countries under the existing system. Therefore, whether this represents a saving depends on how many countries the patent owner would have validated the patent in under the old system. If a patent would have been validated in, say, 10 countries, the saving on renewal fees will be considerable. However, a downside of this system is the lack of flexibility when renewing. If a patent owner had validated a patent in 10 countries under the old system and, for example, after five years did not have the budget to continue renewing the patent in 10 countries, he would be able to save costs by picking fewer countries in which to continue the patent renewals. With the unitary patent, if the patent owner does not have the budget to continue renewing the patent, the patent owner cannot save costs by choosing a subset of states in which to renew the patent – the patent will cease to have effect in all 26 member states if the renewal fees are not paid.

A saving can be made if the patent is prosecuted in English, as once a transitional period is over the translation requirements will require that only the claims are translated into French and German in order for the unitary patent to have effect in all 26 member states. There will not be separate translation requirements for each member state as under the current system. Instead, high-quality machine translations of the patent, prepared by the EPO, will be available for users who do not use the language of the patent.

As part of implementation the unitary patent, the 26 member states needed to agree on how the revenues generated from the unitary patent would be shared. This has now been decided and is an important step towards realising the unitary patent. Before the unitary patent is available, the Unified Patent Court (UPC) needs to be set up. The UPC will be a specialised central patent court for dealing with both existing European patents and unitary patents.

Existing European patents will come under jurisdiction of the UPC, unless the European patent is opted out of the UPC. By default, all European patents (including existing patents, validated under the old system) are automatically opted into the UPC, and patent owners must actively opt out if they wish to avoid this and continue to operate under the old system. In order to opt a European patent out from the UPC, the Registry of the UPC will need to be notified and a fee (which is likely to be €80 per opted out patent family) will have to be paid.

The agreement on the UPC has to be ratified by 13 member states, including France, Germany and the UK in order for it to come into force. So far, 8 member states have ratified the UPC. The EU Commission is calling for the other member states to ratify the agreement on the UPC as soon as possible, so that the unitary package (the unitary patent and the UPC) can enter in force by the end of 2016, with a view to opening the UPC at the start of 2017.

Arthur Laycock



Repeal of Section 52 of the CDPA – an update

Section 52 of the Copyright, Designs and Patents Act 1988 (the 'CDPA') limits copyright protection for certain artistic works (including drawings, paintings, photographs, sculptures, collages and works of architecture such as buildings) when the work has been manufactured industrially. When more than 50 copies of such artistic works are made, then the current period of copyright protection is limited to 25 years. Other artistic works are protected by copyright for the life of the creator plus 70 years.

After much debate, the Government finally passed a law in 2013 to repeal Section 52 of the CDPA, thus ceasing the exception and extending protection to the full term of the life of the creator plus 70 years.

In March 2015, the Government implemented a Commencement Order which would have made the repeal effective from 6 April 2020. Following the introduction of this Order, the Government received a claim for judicial review, challenging the compatibility of the Order with EU law. The Government has now revoked the Commencement Order and will not continue with the earlier transitional arrangements. The Government is now planning a new consultation, based on revised transitional provisions, including a new implementation date for the repeal.

We will keep you updated with developments.

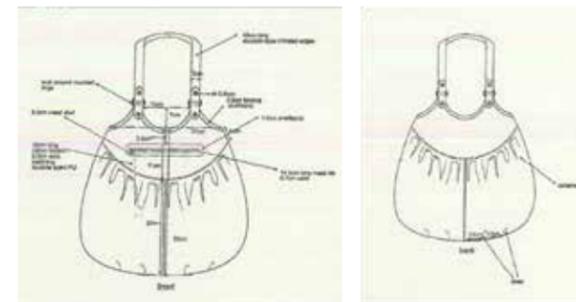
Designs: YSL versus H&M – guidance on 'individual character'

In 2006, the Office for Harmonisation in the Internal Market ('OHIM') registered two Community designs (numbers 000613294-0001 and 0002) for handbags in the name of Yves Saint Laurent ('YSL'), shown below:



For a design to be registrable, it must be novel and have 'individual character'. The individual character of a design is determined by its 'overall impression' on the 'informed user', bearing the freedom of the designer in mind.

In April 2009, H & M Hennes & Mauritz (H&M) applied to invalidate the YSL designs, asserting that YSL's designs created the same overall impression on the informed user as H&M's earlier design:



In 2011, the OHIM rejected H&M's initial applications for a declaration of invalidity. H&M then appealed the decisions, and the Board of Appeal considered the informed user and the freedom of the designer in more detail.

The Board of Appeal defined the informed user as "an informed woman, who is interested, as a possible user, in handbags". Whilst the freedom of the designer was considered to be high, the Board of Appeal recognised that the designs had common elements such as i) their upper contours and ii) their handles in the form of straps attached to the body of the bags by a system of rings, reinforced by rivets. However, the Board of Appeal concluded that the common elements did not detract from the individual character of the YSL designs arising from the differences in shape, structure and surface finish. In 2013, the Board of Appeal rejected H&M's appeals.

Following the rejections from the Board of Appeal, H&M appealed to the EU General Court (EUGC).

The EUGC agreed with the findings of the Board of Appeal, determining that the differences between the designs were significant and that the similarities between the designs were insignificant in the overall impression which they produced. The EUGC found that the impression produced by the YSL designs was "characterised by classic lines and a formal simplicity whereas, in the case of the H&M design, the impression would be that of a more 'worked' bag, characterised by curves and a surface adorned with ornamental motifs". The EUGC also highlighted that assessment of the overall impression produced by a design includes the manner in which the product is used, noting that: "the straps and the handle of the designs... manifestly lend themselves to different uses... the contested [YSL] design represents a bag to be carried solely by hand, whereas the earlier [H&M] design represents a bag to be carried on the shoulder." The EUGC dismissed the appeals.

This case provides useful guidance on the aspects to be considered when determining the 'individual character' of a design. As always, please contact us if you would like to discuss this particular case or any other design matters.

The full decision (and original images) can be found here: <http://curia.europa.eu/jcms/upload/docs/application/pdf/2015-09/cp150098en.pdf>

James Cornford



Partial priority – a toxic issue

The issue of toxic divisionals and toxic priority has been a hot topic for discussion in recent years. A new referral to the European Patent Office's Enlarged Board of Appeal (G1/15) has the potential to clarify the situation. In the meantime, all examination and opposition proceedings at the European Patent Office, in which the decisions will depend entirely on this issue, are to be stayed.

A recap on toxic divisionals and priority

A toxic divisional situation can arise, for example, when an original priority establishing patent application describes an invention in a relatively narrow way. A subsequent European parent patent application is then filed claiming priority from that original application. This parent application includes the narrow description of the invention from the original application but the claimed invention is broader than the original narrow description of the invention. Subsequently, a European divisional application is filed based on the parent application. The divisional application includes the same narrow description of the invention as the original priority establishing application.

Therefore, in the parent application, the broad claim is not entitled to the benefit of the filing date of the original priority establishing application across its entire scope. Nevertheless, the narrow description of the invention in all three applications falls within the scope of the broad claim and is entitled to the benefit of the filing date of the original priority establishing application.

The divisional application will be published after the filing of both the original priority establishing

application and the parent application. However, on publication, the divisional application becomes potentially citeable prior art, insofar as the narrow description of the invention is concerned, against the broad claim of the parent application for the purposes of novelty only (see Article 54(3) EPC).

As the broad claim in the parent application encompasses the narrow description of the invention but is not entitled to the benefit of filing date of the original application, the divisional application can destroy the novelty of the claimed invention in the parent application. Therefore, by filing the divisional application, the validity of the parent application can be jeopardised.

The same situation can arise in other situations, such as cases which do not have a parent-divisional relationship but which share a common priority claim.

Partial priority

However, if a claim in a European patent application gives rise to a limited number of clearly defined alternatives then each alternative can be given a different priority date (see the Enlarged Board of Appeal decision in G 2/98). This is generally known as 'partial priority' as part of the claimed invention receives the benefit of the filing date of the original priority establishing application and the other part does not.

Therefore, continuing with the example, if the narrow description of the invention is a clearly defined alternative with respect to the broader claim of the parent application, then different priority dates can be assigned to the different parts of the claimed

invention. In other words, the part of the claim covering the narrow description of the invention has the benefit of the filing date of the original application and the other parts of the claim do not. This means that the divisional application is not citeable against the parent application because there is no part of the claimed invention which is taught in the original priority establishing application and which is not entitled to the benefit of its filing date.

A lot, therefore, rests on whether the claimed invention can be separated into a limited number of clearly defined alternatives. If partial priority can always be used to split a claimed invention into (i) the subject matter which is entitled to priority and (ii) the subject matter which is not entitled to priority, and partial priority applied according to this split, then the issue of toxic divisionals and toxic priority will largely disappear.

The questions

With this in mind, five questions have now been referred to the Enlarged Board of Appeal:

Where a claim of a European patent application or patent encompasses alternative subject-matters by virtue of one or more generic expressions or otherwise (generic "OR"-claim), may entitlement to partial priority be refused under the EPC for that claim in respect of alternative subject-matter disclosed (in an enabling manner) for the first time, directly, or at least implicitly, and unambiguously, in the priority document?

If the answer is yes, subject to certain conditions, is the proviso "provided that it gives rise to the claiming of a limited number of clearly defined alternative subject-matters" in point 6.7 of G 2/98 to be taken as the legal test for assessing entitlement to partial priority for a generic "OR"-claim?

If the answer to question 2 is yes, how are the criteria "limited number" and "clearly defined alternative subject-matters" to be interpreted and applied?

If the answer to question 2 is no, how is entitlement to partial priority to be assessed for a generic "OR"-claim?

If an affirmative answer is given to question 1, may subject-matter disclosed in a parent or divisional application of a European patent application be cited as state of the art under Article 54(3) EPC against subject-matter disclosed in the priority document and encompassed as an alternative in a generic "OR"-claim of the said European patent application or of the patent granted thereon?

The questions leave open a number of different directions in which this issue could be addressed and the final question deals with the further issue of whether a divisional application can be cited against its own parent (or vice versa) even if partial priority is not allowed.

The answers to these questions will have a direct impact on the toxic divisional and priority issues, but will also have wider implications. An outcome is not expected for another year or two. In the meantime, the President of the European Patent Office has announced that certain decisions which depend entirely on these questions can be stayed until the outcome of the referral.

Russell Sessford



Forresters at Advanced Engineering Show 2015

Forresters exhibited at the Advanced Engineering Show at the NEC in Birmingham on 4-5 November 2015.

The Advanced Engineering Show group of events is dedicated to the UK's engineering, technologies, capabilities and services sectors. Forresters' representatives **Russell Sessford**, **Jack Gunning**, **Greg Smith** and **Stephanie Thomas** were on hand at stand G53 to answer delegates' intellectual property questions.

We had vouchers available for delegates to pick up from our stand, the voucher entitled the delegate to a free 30 minute consultation, a one hour seminar providing protection advice and an on-site IP audit of their business.

Visitors to our stand entered our prize draw to win a Build Your Own V8 Engine worth £50.00.

For further information - <http://www.advancedengineeringuk.com/>



Forresters ranked in Legal 500 2015



We are proud to announce that Forresters has been listed in the Legal 500 as a leading firm in the field of Intellectual Property.

Legal 500 is one of the leading independent legal directories. It ranks firms and attorneys in over 50 specialist areas of law.

We have been ranked in tier 2 for trade marks and tier 3 for patents.

Business with Birmingham 2015 Innovation Competition

Forresters is proud to sponsor the Best Innovative Idea for Exploitation category at the University of Birmingham's Business with Birmingham Innovation competition.

This competition at the University of Birmingham is open to companies of any size, based in the UK only. The application calls for you to explain your invention and how the competition prize will be used to protect and exploit the IP. Applications will be judged according to potential for commercial viability, likelihood of success and benefits to the partners involved.

The winner of the category will receive £5,000 of IP advice from Forresters including patent and trade mark attorney support.

The deadline for entering this competition is 21 March 2016. To enter visit: <http://www.birmingham.ac.uk/partners/business-club/innovation-competition.aspx>



Forresters ranked in Chambers 2015



For the third year running Chambers and Partners' Chambers UK 2015 has listed Forresters as a leader in the field of Intellectual Property.

Chambers UK is one of the leading independent legal directories. It ranks firms and attorneys in over 50 specialist areas of the law.

Partner Promotions

We are pleased to announce recent changes in our partnership with the introduction of our partner, Lloyd Hoarton taking on the role of Managing Partner here at Forresters.



Lloyd has been a partner at Forresters for 16 years. He graduated in aerospace systems engineering at Southampton University. He handles patent and design prosecution work in diverse engineering fields including miniature precision motors, white goods, digital watermarking, social computing, cyber-security and nano-engineering whilst retaining an active involvement in encryption techniques, telecommunications, electronics and computer/software related inventions.

We are also delighted to announce that following their contribution to the continuing success of Forresters, our attorneys Charlotte Teall and Chris Bond have joined the partnership.



Charlotte joined Forresters in 2006 with a background in biochemistry. She holds an MSc in the management of intellectual property from Queen Mary University of London. During her undergraduate studies at Imperial College London, Charlotte worked as a research assistant at a major international pharmaceutical company, where she became particularly interested in stem cell technologies.



Chris graduated from the University of Oxford (New College) with a first class Master's degree in Chemistry in 2005 and has worked at Forresters since then. The findings of his final year research project were published in The Journal of Organic Chemistry.

Promotions at Forresters



We are delighted to announce that Dr Nick Palmer has been promoted to Senior Associate. Nick is involved in many areas of intellectual property, with much of his time spent advising clients on their ability to sell and protect new products. This work involves analysing innovative features of a product and reviewing patents and designs registrations owned by third parties worldwide, to ensure that the client is free to make and sell the product.



David Murphy became Senior Associate on 1 November 2015. David has an MSc in the management of intellectual property, which he obtained from Queen Mary, London. His legal training is underpinned by the broad and varied scientific knowledge acquired during his studies for a BSc in biomedical sciences at Keele University.

Our appointment of these talented patent attorneys, further strengthens Forresters' ability to deliver exceptional service to our clients

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Clear direction

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