

IP

IP Federation

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REVIEW

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Improving the intellectual property
framework to meet the needs
of innovative industry



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Advancing industry's view on intellectual property since 1920

The IP Federation was founded in 1920 as the Trade Marks, Patents and Designs Federation (TMPDF) in order to coordinate the views of industry and commerce in the United Kingdom, and to make representations to the appropriate authorities on policy and practice in intellectual property (IP) matters.

AIM

The IP Federation's aim is to improve the IP framework to meet the needs of innovative industry by representing, nationally and internationally, the views of UK-based businesses. Today the Federation has over 40 IP-intensive member companies operating in a wide range of sectors and product groups, among which are many of the largest companies in the UK, as well as smaller companies. Its membership of influential innovative companies that both own and license IP has wide experience of how IP works in practice to support the growth of technology-driven industry and generate economic benefit. As a cross-sectoral industry organisation covering all technologies, the IP Federation is able to offer a viewpoint which is authoritative and balanced.

Most if not all industrial and commercial firms use or are affected by intellectual property rights, even if they are not particularly concerned with innovation protected by patents and designs. Nearly all firms own trade marks and copyright material. All are affected by competition law and the rights of others. The work of the IP Federation is therefore of value to everyone.

While many firms leave day-to-day matters concerning the acquisition, defence and enforcement of rights to professional attorneys, it is still important to take a direct interest in the policy background, to ensure that proper rights are available, can be secured in a straightforward and efficient way and can be litigated without unnecessary complexity and expense.

ACTIVITIES

The IP Federation initiates proposals and follows developments at national, European and international levels across all fields of intellectual property. It has a close relationship with the Confederation of British Industry (CBI) and provides professional input on intellectual property matters to the CBI, as well as representing it in certain meetings of BusinessEurope (the Confederation of European Business) concerning intellectual property. The IP Federation is also an invited observer at diplomatic conferences and meetings of standing committees of the World Intellectual Property Organization (WIPO).



CONTACTS

The IP Federation maintains good contacts with the UK Intellectual Property Office (IPO), and members of its council and committees participate in several focus groups and practice working groups which provide expert opinion to the UK Government and its agencies on intellectual property matters. It also has good contacts with the European Patent Office (EPO) and is represented on bodies which advise the EPO.

It is represented on the UK user committees of the Intellectual Property Enterprise Court (IPEC) and Patents Court.

The work of the Federation is of value to everyone.

The IP Federation also maintains contacts with parliamentarians both in Westminster and in the European Parliament. In the UK, it has close contacts with the Chartered Institute of Patent Attorneys (CIPA), the Chartered Institute of Trade Mark Attorneys (CITMA) and FICPI-UK, the UK association of the International Federation of Intellectual Property Attorneys, and is a member of IPAN (the IP Awareness Network). Internationally, the IP Federation exchanges views and maintains good contacts with similar IP user organisations in other countries.

MEMBERSHIP

The IP Federation has a council, which meets monthly to agree Federation policy, a governance committee, and a number of technical committees, to which detailed consideration of issues may be delegated. Most members pay a fee that entitles them to a council seat, as well as on any or all of the committees. Some members pay a lower fee that allows them to join any or all of the committees. All members may vote at the AGM at which (*inter alia*) the president of the Federation, any vice-presidents, and the governance committee are elected. If you would like to join the Federation, please contact the Secretariat at the address on the back page of this brochure.

You can find a list of IP Federation members 2022 at the back of this publication on page 52.

President's Introduction

A few years ago I remember being struck by some remarks about intellectual property made by Yuichi Ishizuka, president of my company Canon Europe.

We'd asked him along to an award ceremony to celebrate successes in the IP Group. Without any prompting from me he simply said, 'IP is like air; without it we can't breathe'.

Not only were these words encouraging for my team but they also reassured me that our senior management recognises the vital role IP plays in supporting business expansion. And this was from a leader who had spent most of his career in sales, not in R&D. Like air, IP is invisible, so when someone from outside our IP community points out the value of IP we should be fortified.

'IP is like air; without it we can't breathe'. - Yuichi Ishizuka, President of Canon Europe

But whilst it's good to feel valued by our business colleagues, how do we think IP is seen in society as whole? What do politicians and other opinion formers in our society think about IP? The TRIPS waiver for COVID-19, adopted in the WTO after much debate in June 2022, tells us something about that.

However, the world survived the pandemic based on the rapid development of effective vaccines. Isn't the real story that the technologies and knowledge that enabled vaccine development were the result of investments in R&D over many decades? Those investments in R&D, at least by the private sector, were incentivised by the IP system and by patents in particular.

Without the IP system, would we have been in the position to develop effective COVID-19 vaccines in time? Of course, we don't know for sure, but nor should we take it for granted that those investments by the private sector will continue if patent rights are no longer guaranteed. Could we then end up facing the next pandemic without the necessary technologies and knowledge?

This isn't the place to re-open the debate over the waiver. Clearly a global pandemic requires new thinking. We should keep in mind that balance has always been the key to a successful IP framework. We should also always be willing to look for improvements in the IP system. My own view is that the TRIPS waiver is a lesson to us. Those of us who believe IP is not just good for companies, but also good for society as a whole, should get ready to speak up for IP.

We should also always be willing to look for improvements in the IP system.

In the IP Federation we have long advocated taking an evidence-based approach to the debates before us. Investments in R&D, supported by a balanced and predictable IP framework, have delivered amazing results across a variety of sectors: life-changing medicines; computers and processors; mobile communications; and green technologies. This side of the story deserves to be told too. We should be proud to say, 'IP is like air'.

Tireless is another good descriptor for the Federation.

Let me finish by recognising the fantastic contribution to the Federation by my two vice-presidents, Sonia Cooper and Danny Keenan, whose work in data, copyright and designs help us to be the organisation we aspire to be: comprehensive in our coverage of all IP matters.

For that I thank our two staff, David England and Helen Georghiou, all our members, our policy advisors and solicitor associates, and especially our committee chairs.



Matthew Hitching
President

IP Federation



Inside in-house

A chance to share a virtual coffee with Belinda and Suzanne as they reflect on being an in house IP attorney.

SUZANNE: Well, Belinda, we first met when Roger [Burt] introduced us, as he thought we might get along? At that point though, you had been in the biz for a few years, and I had just started out, having just moved from private practice to in-house at Arm. What can you remember of your first few years in-house?

BELINDA: Yeah, he did, and good question. When I made the shift from private practice to working in-house at IBM (many years ago now), I thought that the roles would be rather similar – a steady diet of drafting, patent filings, amendments, Oral Proceedings, and more amendments – just without the step of having to wait for client instructions, or, I hoped, without having to keep track of and bill a client for every 6 minutes (0.1 hr) of my working day! Actually, it was not too dissimilar at the beginning, though luckily the timekeeping/invoicing did vanish. I started with ‘easy stuff’ with which I was familiar – mainly amendment work, and at least one draft per month, but over the last almost 20 years it has changed in almost every aspect (although I still dabble occasionally with the odd amendment!). The role in fact is constantly changing as the company does, and I still get queries popping up on topics which I have never considered before – this week’s example being copyright levies in Spain and the process of obtaining an exemption for laptops used only for business use! But it was not until I joined IP Federation Council in 2011 and listened to the other representatives there that I realised what a broad and varied job that of an in-house patent attorney truly is!

SUZANNE: Yes, I remember my first [IP Federation] meeting, I was shit scared and late (trains!) and I met David Barron outside, funnily enough. We’d met before and so I was relieved to see a familiar face. He’d been ‘sent out’ as we were voting in our solicitor associates, something we do every year, one of the many, many things about the IP Fed I hadn’t realised before I joined. Carol Arnold was President then, and I was super impressed that we had a female leader. Though she wasn’t the first as I’ve later discovered. Anyway, it didn’t take long to work out the wide variety of the topics we discuss every month, as you only had to look at the agenda, then and now. From national laws covering all forms of IP, to international laws and, over the years, wider topics such as EDI (equality, diversity and inclusion), trade, privilege and exhaustion. Oh, and Brexit, do you remember the Brexit years? I think the whole thing impacted James (Horgan) as President first and then you?

BELINDA: Oh my goodness yes. Things have not just changed within IBM, but at the IP Federation too. When I first joined the IP Fed Council, taking over from Roger Burt as IBM’s representative (and I remember being completely awed by all the amazing and talented people around the table, and suffering a major bout of imposter syndrome!), the topics of primary focus were EU patent reform, the proposed introduction of a patent box in the UK and the recommendations of the recently issued Hargreaves Review on copyright. ‘EU patent reform’ at that time had the aim of an EU-wide patent and a Unified Patent Litigation System (UPLS), but the process had stalled with Spain and Italy’s refusals to agree on the translation arrangements for the EU patent.



An ‘enhanced co-operation’ procedure between certain member states had just been suggested, and many further years were spent trying to influence and improve this reform package, now referred to as the ‘UPC’, whilst also commenting in relation to designs, copyright, trade secrets, groundless threats, SPLH (patent harmonisation) to name but a few! With Brexit, the focus shifted to the impact on IP rights, especially those EU-wide rights, such as Community TMs and designs, which previously covered the UK, and more recently the remit of the IP Fed has broadened even further to include proposed free trade agreements, because these often seem to include IP provisions. I remember also watching the IP Presidents at the time – James Hayles and then Bobby Mukherjee – and thinking that I would never be ready to take on that role. I needed quite a lot of encouragement to even think about it, but I am so glad that I did – it was hard work but extremely rewarding. But I don’t think I would have been able to get internal approval to take on the role if it had not been for the changes

“I remember watching the IP Federation Presidents at the time and thinking that I would never be ready to take on that role.”

Continued

to the leadership structure implemented in 2017 to a presidential 'troika' of President and 2 Vice Presidents (one 'outgoing' and one 'incoming') rather than a single 2-year presidential term. The support from my Vice Presidents, James (Horgan), and yourself Suzanne, made such a difference and the job far more fun – thank you! Tell me, is there anything you would like to share about your time in the Federation?

SUZANNE: Sure, and I certainly reflect on my time as President quite fondly (and proudly). I remember being 'tapped on the shoulder' and asked to stand by Gill Smith of Dyson (now retired) and as you, thinking I couldn't possibly contribute anything! I had the same imposter syndrome feelings, but then reflected on why she'd asked, and I think it's down to the fact that everyone who represents a membership company (of which we have about 42), brings something unique to the conversation. Indeed, you and I have been on a number of panels at conferences discussing this – not one in-house role is the same as another, not even within companies in the same sector. And then there's the different sectors we represent and the different company sizes. In fact, when I think about it, I'm not sure any one of us does the same as another on a day-to-day basis. Some of our members have a fulltime policy role for their companies, some companies license IP rather than sell goods, some draft and prosecute in-house, some outsource most to their counsel (and so are mainly portfolio managers, educators and invention harvesters). Some are the world's leading SPC specialists, some are leading our work on trade and some spend a lot of time managing litigation, and more recently focus has also shifted to the regulation of AI and data. Having said that though, the one thing I didn't expect

when I took up the mantle from yourself, was that we would immediately be plunged into a global pandemic and most Council meetings I'd have to chair from my home office.


BELINDA: Definitely! Shifting to online meetings was tough as I really missed the face-to-face networking, and the useful exchanges over coffee/lunch, which I had completely taken for granted right up until then. I now appreciate how valuable that aspect of IP Fed is and so I try to attend Council meetings in person whenever I can, despite the additional travelling time involved. Suzanne, can you briefly tell us about the IP Federation's work on EDI and what being a Policy Advisor to the IP Fed entails?

SUZANNE: Yes, indeed, as Policy Advisor I focus on those areas which I am most passionate about – EDI as you've mentioned, and also trade, having represented the Federation as President during the UK's leaving of the EU, specifically overseeing our work on the CPTPP. Though reflecting on it now, even this role has changed over the years, as it used to be solely for retired members who had made a significant contribution to the Federation. Whilst I haven't retired (yet), I hope that I have at least made a positive impact over the last few years! As the thing I'm most proud of particularly is our work on EDI, supporting IP Inclusive right from the beginning and especially our work on improving social mobility into the profession with In2scienceUK.

BELINDA: Yep, that is really important. The IP Federation seems to be going from strength to strength, with an ever-increasing team of engaged and active members and I am very grateful to be a part of it.

SUZANNE: Me too and many thanks Belinda.

Belinda Gascoyne, IBM
Suzanne Oliver, Policy Advisor



“The role in fact is constantly changing as the company does, and I still get queries popping up on topics which I have never considered before.” - Belinda

Driving greater inclusion and diversity

The IP Federation's commitment to improving diversity and inclusion in the IP professions has been led by the dedicated D&I working group formed last year.

Following the work on the IP Inclusive Equality, Diversity and Inclusion (EDI) Charter, the group has focused upon the Senior Leaders' Pledge. This has been an initiative of IP Inclusive which has been very successful with IP professionals working in private practice. It comprises a series of personal commitments to be made by senior leaders in an organisation to their actions to improve diversity and inclusion. It was identified that some of these pledge commitments might be difficult for an employee of a large organisation with its own diversity policies and strategies. A new Senior Leaders' Pledge for leaders of departments in larger organisations, including our IP Federation members, has been agreed and will be launched over the next few months. This will allow our members to demonstrate their personal commitment to diversity and inclusion.

The IP Federation has continued to support outreach activities in 2022 that aim to promote and widen access to STEM careers and the IP professions.

IP INCLUSIVE'S CAREERS IN IDEAS MENTORING SCHEME

Was developed to help individuals interested in careers in the IP professions by pairing would-be recruits with mentors. Members of the IP Federation D&I working group (Julie Browne (Shell), Gordon Harris (Gowling WLG) and Jane Swift (Johnson Matthey) have acted as mentors in 2022 for this excellent initiative.

IN2SCIENCEUK WORKSHOP ON INTELLECTUAL PROPERTY CAREERS (19 AUGUST 2022)

In2scienceUK is an organisation committed to promoting social mobility and diversity in STEM. They empower young people from disadvantaged backgrounds to achieve their potential through life-changing opportunities that give them insights into STEM careers and research and boosts their skills and confidence.

The event was directed at children of secondary school age yet to make decisions about which career path to follow.

The IP Federation has continued to support outreach activities in 2022 that aim to promote and widen access to STEM careers and the IP professions.

Vikki Townsend (Senior Patent Attorney, Rolls-Royce plc. and member of the IP Federation D&I working group) opened the talk on IP careers by sharing her own background as the child of a single, unemployed parent growing up in an industrial northern town in Thatcher's Britain attending the local state school. She explained children like her were not expected to achieve at university and succeed in professional careers, but with the encouragement and support of her father and a couple of good teachers she was able to do so. The panel of atypical IP professionals all had similar personal stories to tell.

Continued

Vikki went on to explain the goals of the IP Federation and IP Inclusive to encourage a more diverse pool of applicants to join the profession and to retain this talent by supporting them in their careers through initiatives such as the mentoring programme.

After a brief introduction into what IP is, Vikki went on to summarise the various STEM careers available in the IP profession including: patent attorney, patent examiner, patent analyst, patent engineer, patent searcher and, of course, inventor! She continued by speaking more about the skills needed to be a patent attorney as distinct from the qualifications, and summarising her own experiences having worked in industry, government and private practice. To close, Vikki recommended the Careers in Ideas website as a helpful resource to prospective future candidates.

The other panellists, Bobby Smithson (Appleyard Lees IP), Janine Swarbrick (HGF Ltd) and Fred Nicolle (Simmons & Simmons), each shared their personal and inspiring stories and career experiences.

Jo Maniscalco from In2scienceUK sent her gratitude following the successful event.

"I just want to follow up with you after your workshop on Friday to say a massive thank you for your time and contributions!"

I thought the session went really well! You were all really clear and engaging and gave great insights and advice for the students to get thinking about. I hope you enjoyed delivering it and thanks again for taking the time to do so!

We have already collected a bit of feedback from the students and here are some comments I'd like to share with you:

'I really liked this workshop, it was refreshing to hear that you just need to do what you enjoy and that with many of the patent attorneys they didn't actually know what they wanted to do. It was very informative and gave lots of detailed information about the career of a patent attorney.'

'It was good, it gave me a better insight into the different careers and what they involve'

"The workshop was really insightful and eye opening. It definitely gave me a lot to think about and relieved some stress regarding my career options."

STEM WOMEN UK ENGINEERING EVENT (22 SEPTEMBER 2022)

This event was directed at women undergraduates currently studying for STEM or combination STEM degrees.

Vikki Townsend joined the panel to talk about her experience as a woman working in a predominantly male engineering sector. She took the opportunity to promote the patents profession as a great STEM career option for women who have studied or worked in engineering, and to raise awareness of the efforts being made by IP Federation members and IP Inclusive to build more diverse work teams, where all people from all genders and backgrounds can feel valued and included.

The event was well attended (oversubscribed, in fact!) and promoted widely on LinkedIn. The organisers gave very positive feedback to the panel.

Vikki Townsend, Rolls-Royce plc

Julie Dunnett, Policy Advisor, IP Federation

Julie Browne, Shell International Ltd



“The Great Reformation”

The 2022 IPReg consultation on proposals for changes to regulatory arrangements.

The Intellectual Property Advisory Board (IPReg) was set up in 2010 by the Chartered Institute of Patent Attorneys (CIPA) and the Chartered Institute of Trade Mark Attorneys (CITMA) to be the independent regulatory body for both patent attorney and trade mark attorney professionals in the UK. In early 2022, IPReg opened a consultation on significant and wide-ranging proposals to change the regulatory framework for regulated attorneys.

The IP Federation submitted a response on 17 March, and the consultation closed on 31 March 2022. IPReg later reported that they received a further 35 written responses from individual attorneys, firms, representative bodies such as CIPA and CITMA, as well as the Legal Services Consumer Panel. IPReg also published a response to the consultation and an updated version of their impact assessment on their website.

In our submission, we congratulated IPReg on the very large task they had undertaken to try to improve the profession in all aspects and we felt there was much merit in many of the proposals that had been made. However, it was also felt that many changes proposed by IPReg were very much focused on private practice, as opposed to in-house attorneys. Further, that we had major concerns about the far-reaching nature of some of the changes, specifically the effects of the application of the principles (Chapter A) “*to all regulated persons... in all aspects of their life, be this within professional practice or private life*”.

Other changes included changes to the way continuous professional development (CPD) was earned and recorded, training, billing, as well as applicable insurance frameworks.

Following their review of all proposals submitted, the Federation was invited to a roundtable event hosted by IPReg to communicate with their major stakeholders. The event occurred virtually on 27 July 2022, and attendees included Suzanne Oliver (Policy Advisor, IP Federation), Alan Kershaw, Fran Gillon, Shelley Edwards, Emma Reeve and Emily Lyn (all IPReg), Keith Loven, Alasdair Poore (both CIPA), Michelle Ward, Kate O’Rourke, Keven Bader (all CITMA), Andrea Brewster (IP Inclusive) and Zoe Bailey (Withers & Rogers). A second, follow-on, call between our current President, Matthew Hitching, and IPReg representatives closely followed, and a summary of the main topics discussed across both calls follows:

1. The Overarching Principles – after wide ranging and strong feedback to the “Overarching Principles” section, IPReg have fundamentally changed from their original approach. Due to the depth and strength of feedback they had received, IPReg have seen the need to clarify that the section only applies “if there is a causal nexus between the behaviour and the person’s ability to carry out their professional conduct”. New wording is thus proposed.
2. Changes to CPD rules – there will now be a transitional period of 18–24 months to the new system, and help and advice will be given to people who need it.

3. Ability for in-house attorneys to do *pro bono* work, such as CIPA clinics – this topic is still in discussion between the IP Federation and IPReg.
4. Definition of client – in our consultation response and on subsequent calls, we impressed the need for a flexible and open definition of ‘client’, as well as an understanding of the difference in many aspects between in-house attorneys and private practice. In the UK, there are far more attorneys regulated by IPReg in private practice than in house. On both occasions, IPReg has stressed the point that whilst these differences are not explicitly called out in the regulations, the specific needs of the in-house attorney are never far from mind.

The Federation was invited to a roundtable event hosted by IPReg to communicate with their major stakeholders.

Many of the proposed changes will come in 2023 (given the Legal Services Board (LSB) approve the proposals). However, in some areas, such as with the changes to private practice categories, the proposed changes won’t come into effect until 2025. Due to the minority position of the in-house attorney, the IP Federation has an important voice in this regard, and so we will continue to ensure that in-house attorneys continue to be represented through a fair and balanced regulation process.

Suzanne Oliver, Policy Advisor

The IP Federation and the IP Minister(s)

This is not the original opening line of this piece. Just a week before this article's deadline, it started, *"By the time you read this there may be a new IP Minister"*. Fast forward a week or so, and there was a new Prime Minister. Jacob Rees-Mogg, the former Business Secretary in whose department an IP Minister worked, had just resigned. His IP Minister, Dean Russell, was in the post for only 6 weeks. New Prime Minister Rishi Sunak had yet to appoint a Minister for IP. As if that wasn't enough, between then and publication of this *IP Federation Review*, a new Department for Science, Innovation and Technology has been established as part of a wider departmental and ministerial reorganisation. It is there, not in the new Business and Trade Department, that responsibility for IP now resides. Which brings me back to my original sentence. By the time you read this there may be a new IP Minister.

The rapid pace of ministerial shuffling as ministers, and prime ministers, come and go has led to (currently) four IP ministers having been in the post since 2020. There may be a fifth before very long. In that time, there have also been six Business Secretaries and four Prime Ministers.

The IP Federation has been building relationships with ministers and politicians responsible for and interested in IP since 1920. Since 2007, it has worked with 15 ministers responsible for IP. During this time the IP Federation saw the successful fight for a Central Division of the Unified Patent Court (UPC) to be in London, with the toasting of champagne with Baroness Neville-Rolfe (the then IP Minister in 2015) following the inking of the deal for the London's UPC location at Aldgate Tower. It has also seen the withdrawal from the UPC in July 2020 (there were no champagne toasts with the then IP Minister Amanda Solloway MP). Only two years and four IP ministers earlier, the then President of the IP

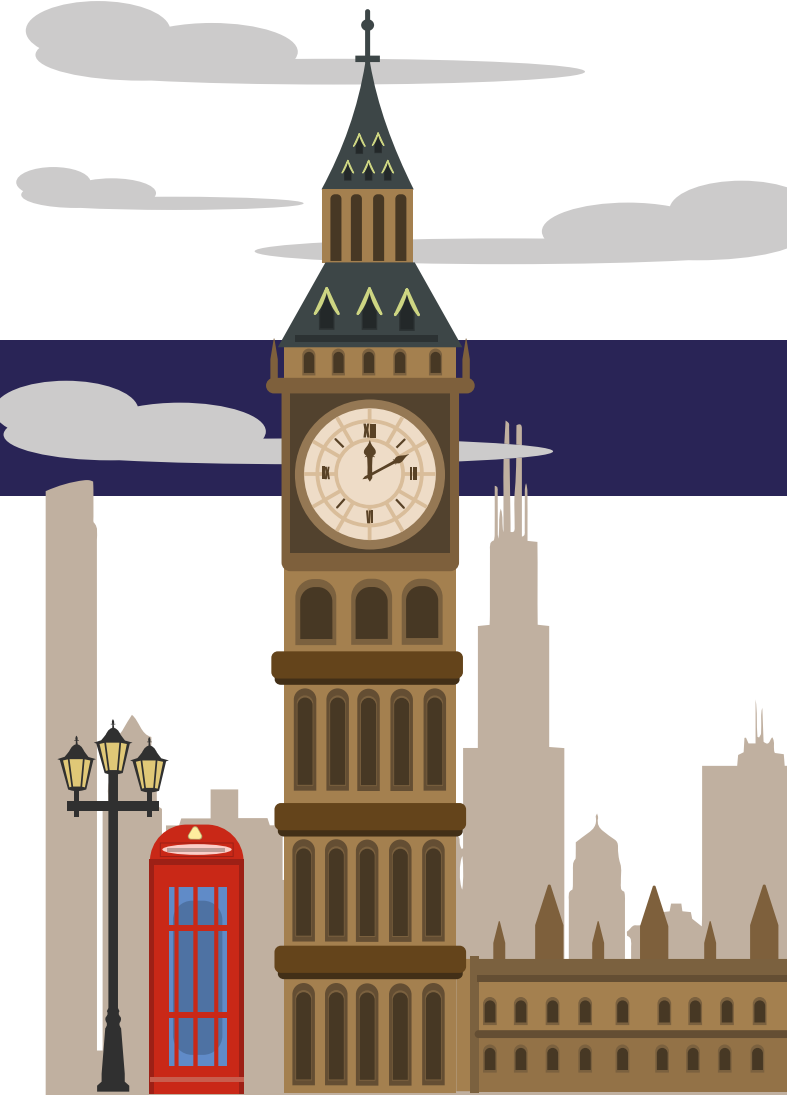
Federation James Horgan wrote to the then IP Minister, Sam Gyimah MP, urging that the UK *"should ratify the Unified Patent Court Agreement as soon as possible... to enable negotiations to commence rapidly to secure the legal basis on which the UK can stay in the UPC."*

Brexit – its ongoing effects and outstanding trade deals – continues to be a priority issue for the IP Federation's engagement with Government. What IP laws and regulations stay, go or are amended. The terms of trade

By the time you read this there may be a new IP Minister.

negotiations which impact important issues (e.g., grace periods as in the case of Comprehensive and Progressive Agreement for Trans-Pacific Partnership (CPTPP) being one). How long businesses have to comply with incoming legal and regulatory changes.

These are all executive suite questions that impact whether and how businesses operate in the UK. The recent Retained EU (Revocation and Reform) Bill which proposes to revoke or amend statutory and case law derived from the EU, including IP law, is the next key piece of IP-related legislation that will have immediate repercussions for UK business. As with every major development impacting IP law in the last 100 years, the IP Federation will be there representing innovative UK industry on the proposed legislation and seeking to ensure that any legislation does not damage but enhances the UK's high quality IPR framework.



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Despite being at the coalface of business, IP invariably gets lumped together with another brief. In 2016, the then IP Minister's brief also included energy. So, while the Minister of State for Energy was looking at the policy responsible for oil and gas, supply security and fuel poverty, they were also responsible for IP and the EU single market.

*To know where you are going
you need to know where you
have been.*

A more recent IP Minister was the Minister for Enterprise and Markets who, besides IP, was responsible for SMEs, COVID-19 business support, consumer and competition policy business frameworks, labour markets, EU issues and Brexit opportunities. The new Prime Minister has shaken up the portfolios in what was the Department for Business, Energy and Industrial Strategy, among others. Whatever eventually settles following that reorganization, if history is to be repeated, IP will be the one of the last issues to be assigned to a minister.

It is trite to write in these pages that IP is critical to business and, in turn, the economy. That it accounts for over 80% of the value in the business. That without IP protection and a balanced system which encourages investment and use for new entrants into the market, businesses and the economy fail to grow. That the rapid pace of development in technology and the creative industries means that IP law and policy need to be quick footed and future proofed to ensure that IP is fulfilling its role in promoting, protecting and encouraging industry. That to know where you are going you need to where you have been.

With IP Ministers changing on average every 10 months and with other national priority items on their brief, developing and delivering effective IP policy is an understandably herculean task. However, the IP Federation has remained a constant stalwart in helping to ensure that the direction of UK IP law and policy promotes industry. So, if by the time you read this, we do have another IP Minister, the IP Federation will be there, looking forward to working with them and bringing its experience of where we have been to inform where IP law and policy should go for the benefit of UK industry's present and future successes in the global economy.

Annsley Merelle Ward, WilmerHale LLP



The IP Federation's activities

THE IP FEDERATION'S CAMPAIGNS

The IP Federation has invested considerable time and resource in 2022 in support of its aim of improving the intellectual property (IP) framework to meet the needs of innovative industry. Set out below are a number of key successes in which the IP Federation played a leading role.

1. The IP Federation has engaged and continues to engage effectively with senior levels of Government on the potential impact of future free trade agreements (FTAs) on the UK's continued participation in the non-EU European Patent Convention (EPC).
2. The IP Federation has continued to have constructive discussions on various IP issues following the UK's departure from the EU. Strong and effective relationships have been reinforced with the Department for International Trade (DIT), Department for Business, Energy & Industrial Strategy (BEIS) and Intellectual Property Office (IPO), and other key stakeholders. Topics have included trade policy, exhaustion of rights, Unified Patent Court (UPC) and supplementary protection certificates (SPCs).
3. Most notably, the IP Federation has been heavily involved in trade negotiations between the United Kingdom and a number of Commonwealth states, including Australia, Canada, India and New Zealand. In the context of the recently signed UK-Australia FTA and UK-New Zealand FTA, we successfully opposed possible introduction of a patents grace period in those FTAs, thereby ensuring compatibility with UK's obligations under the EPC.
4. The IP Federation has directly contributed to the work of the Industry Trilateral in formulating a harmonisation proposal across key issues in patent harmonisation including: the definition of prior art; conflicting applications; grace period; prior user rights and defence of intervening user; and mandatory 18-month publication.

5. The IP Federation has made a strong contribution to meetings of Business Europe's Patents Working Group on behalf of the CBI, with whom we have a close working relationship.
6. The IP Federation sits on the newly-established CBI/ Industry Trade in Services Council. We also support the meetings of the CBI's trade association International Trade Group.
7. We celebrate our diversity of thought in action through the work of the IP Federation Council, Governance Committee, and other committees and working groups - notably the Diversity and Inclusion working group. Our approach to consultations, e.g. exhaustion and standard essential patents (SEPs) shows that we are inclusive and encourage diversity of thought in our inputs.
8. Our 2021 edition of the annual *IP Federation Review* received very positive feedback, demonstrating excellent work from across the membership, including the various committees and working groups, especially the newly established Communications Working Groups.
9. On the exhaustion of rights consultation, we provided a strong submission on a complex topic covering the range of members' views, and briefed the All-Party Parliamentary Group for IP. The outcome was that UK Government announced on 18 January 2022 that it had decided against moving to a new International exhaustion regime, representative of the majority view of our membership.
10. The IP Federation has been lobbying for the United Kingdom to adopt a broader text and data mining (TDM) exception to copyright infringement. On 12 June 2022, the Government published its response to the consultation on Artificial Intelligence (AI) and Intellectual Property (IP).

Following this consultation, the Government has accepted the need to create a new data mining exception for copyright and database rights. This will make it easier to analyse material for machine learning, research and innovation.

11. The IP Federation has been campaigning for a number of years for intellectual property judgments to be excluded from the scope of the Hague Convention on the Recognition and Enforcement of Foreign Judgments. On 12 July 2022, the European Council adopted a decision on the accession of the EU to the 'Convention on the recognition and enforcement of foreign judgments in civil or commercial matters'. Article 2 states that this convention shall not apply to a number of matters, notably intellectual property.
12. The Intellectual Property Regulation Board (IPReg) recently consulted on proposals for changes to their regulatory arrangements. They singled out our organisation in their summary of responses published on 21 July 2022, in connection with the relationship between in-house patent attorneys and their employers, saying that they will be discussing the application of the new arrangements with the IP Federation, to make sure everything works as it should.
13. Over a long sustained period spanning various IP Federation presidencies, we have strongly supported the Unified Patent Court (UPC) system. This is finally coming to fruition, with the adoption of the court's Rules of Procedure and its Table of Fees, which enter into force on 1 September 2022, and progress made on the appointment of judges. Other actions included adoption of the Organisational Rules of the UPC's Patent Mediation and Arbitration Centre, and confirmation the locations of the local and regional divisions of the Court of First Instance.

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IP FEDERATION STATEMENT ON THE RUSSIAN INVASION OF UKRAINE

The IP Federation strongly condemns the Russian invasion of Ukraine.

Companies may find the following links useful on the situation in Russia, Belarus and Ukraine.

UK IPO Statement

- [Information relating to sanctions and operational matters](#)

UK Government sanctions on Russia

- [Guidance on the UK's sanctions regime relating to Russia](#)

UK Government Export Support Service (ESS)

- [Ask the export support team a question](#)

Ukrainian Intellectual Property Institute (UIPI)

- [UIPI statement dated 1 March 2022](#)
- [Ukrainian Chamber of Commerce and Industry statement dated 24 February 2022](#)

European Patent Office (EPO)

- [Standing together for peace in Europe](#)

WIPO and EUIPO

- [Statement by EUIPO Executive Director Christian Archambeau](#)

Intellectual Property Regulation Board (IPReg)

- [IPReg statement on Russia and UK IP business](#)

Chartered Institute of Patent Attorneys (CIPA)

- [Support for Ukraine and its IP professionals](#)

REVIEWING THE DESIGNS FRAMEWORK – CALL FOR VIEWS

The IP Federation submitted a response to the UK Intellectual Property Office's [call for views](#) on reviewing the designs framework which closed on 25 March 2022.

For full details, click [HERE](#). To see all our policy papers, click [HERE](#).

PLAUSIBILITY – ENLARGED BOARD OF APPEAL CASE 2/21

On 29 April 2022, the IP Federation filed an *amicus curiae* brief for consideration by the Enlarged Board of Appeal in relation to case [G 2/21](#).

The following questions are referred to the Enlarged Board of Appeal:

If for acknowledgement of inventive step the patent proprietor relies on a technical effect and has submitted evidence, such as experimental data, to prove such an effect, this evidence not having been public before the filing date of the patent in suit and having been filed after that date (post-published evidence):

1. Should an exception to the principle of free evaluation of evidence (see e.g. G 3/97, Reasons 5, and G 1/12, Reasons 31) be accepted in that post-published evidence must be disregarded on the ground that the proof of the effect rests **exclusively** on the post-published evidence?
2. If the answer is yes (the post-published evidence must be disregarded if the proof of the effect rests exclusively on this evidence), can the post-published evidence be taken into consideration if, based on the information in the patent application in suit or the common general knowledge, the skilled person at the filing date of the patent application in suit would have considered the effect plausible (*ab initio* plausibility)?

3. If the answer to the first question is yes (the post-published evidence must be disregarded if the proof of the effect rests exclusively on this evidence), can the post-published evidence be taken into consideration if, based on the information in the patent application in suit or the common general knowledge, the skilled person at the filing date of the patent application in suit would have seen no reason to consider the effect implausible (*ab initio* implausibility)?

Insofar as the Board answers question 1 in the affirmative, the IP Federation believes questions 2 and 3 should also be answered in the affirmative. That is, it should be permissible to take into account post-filed data if, based on the information in the patent application in suit and/or the common general knowledge, the skilled person at the filing date of the application would have seen no reason to consider the technical effect implausible (including if they considered the technical effect to be plausible based on the information in the patent application and/or the common general knowledge).

THE IP FEDERATION HAS MOVED

From 20 May 2022 our new registered office address has been –

2nd Floor
Halton House
20–23 Holborn
London
EC1N 2JD

Our phone number and e-mail remain the same.



IP FEDERATION PRESIDENT'S RECEPTION 8 JULY 2022

Matthew Hitching was elected as the new President of the IP Federation at our AGM on 8 July 2022. The handover by Sonia Cooper, Immediate Past President, was commemorated at the IP Federation President's Reception held at Bristows LLP.

REFERRALS TO THE ENLARGED BOARD OF APPEAL – G 1/22 AND G 2/22 (ENTITLEMENT TO PRIORITY)

On 28 July 2022, the IP Federation filed an *amicus curiae* brief for consideration by the Enlarged Board of Appeal in relation to G 1/22 and G 2/22 (entitlement to priority).

The following points of law are referred to the Enlarged Board of Appeal by interlocutory decisions of 28 January 2022 in cases T 1513/17 and T 2719/19 (consolidated proceedings):

1. Does the EPC confer jurisdiction on the EPO to determine whether a party validly claims to be a successor in title as referred to in Article 87(1)(b) EPC?
2. If question I is answered in the affirmative: Can a party B validly rely on the priority right claimed in a PCT-application for the purpose of claiming priority rights under Article 87(1) EPC in the case where;

(I) a PCT-application designates party A as applicant for the US only and party B as applicant for other designated States, including regional European patent protection and;

(II) the PCT-application claims priority from an earlier patent application that designates party A as the applicant and

(III) the priority claimed in the PCT-application is in compliance with Article 4 of the Paris Convention?

In summary, the IP Federation's position is that question 1 should be answered in the negative: the EPO does not have jurisdiction to determine whether a party validly claims to be a successor in title as referred to in Article 87(1)(b). If the EPO did have such jurisdiction (which the IP Federation does not believe), question 2 should then be answered in the affirmative: it would be the case that the established joint-applicant approach to assessing priority would be the correct one to adopt. A PCT application should be considered as a single, indivisible application until it exits the international phase and applicants should be considered as joint-applicants, irrespective of designations for different states, and that the priority rights cannot be split for different designations, depending on which applicant has been named for each designation.

RETAINED EU LAW (REVOCATION AND REFORM) BILL

The IP Federation submitted views on the Retained EU Law (Revocation and Reform) Bill in response to the request by the Public Bill Committee for written evidence before the deadline of 22 November 2022.

In this submission, the IP Federation's evidence reflects our core expertise and focuses primarily on intellectual property (IP) implications of the bill, although some of the issues we raise have more general application. In summary, we are extremely concerned by the degree of uncertainty the bill is giving rise to, the effect it is having on business innovation and investment, and the dangers that will arise if the complex process of IP law reform is rushed, incomplete or flawed.

For full details, click [HERE](#). To see all our policy papers, click [HERE](#).

BENEFITS OF BEING IN THE IP FEDERATION

As set out on the IP Federation's website, membership benefits include:

- Authoritative representation at national and international level
- Access to legislators and officials
- A non-sectoral forum to exchange ideas and opinions on key intellectual property issues as they relate to IP
- Excellent networking and learning opportunities for new and established IP attorneys
- Advance notice of forthcoming legislative proposals and practice changes
- Monitoring service for all consultations, both at national and at EU Commission level
- Regular alerting service, newsletters and policy papers

See also the Activities tab on the IP Federation website (under "Our Work") for the latest news.

SOCIAL NETWORKING

As well as having its own website, the Federation has web presence through social networking sites, with a page on Facebook, a profile on LinkedIn and a Twitter account – @ipfederation. We now have a thousand followers, including some notable figures in the IP world. This is the easiest way to be notified of any new policy papers and other news items on our website.

David England, IP Federation Secretary

IP Federation Objectives 2022/23

The IP Federation aims to improve the IP framework to meet the needs of innovative industry by representing, nationally and internationally, the views of UK-based businesses.

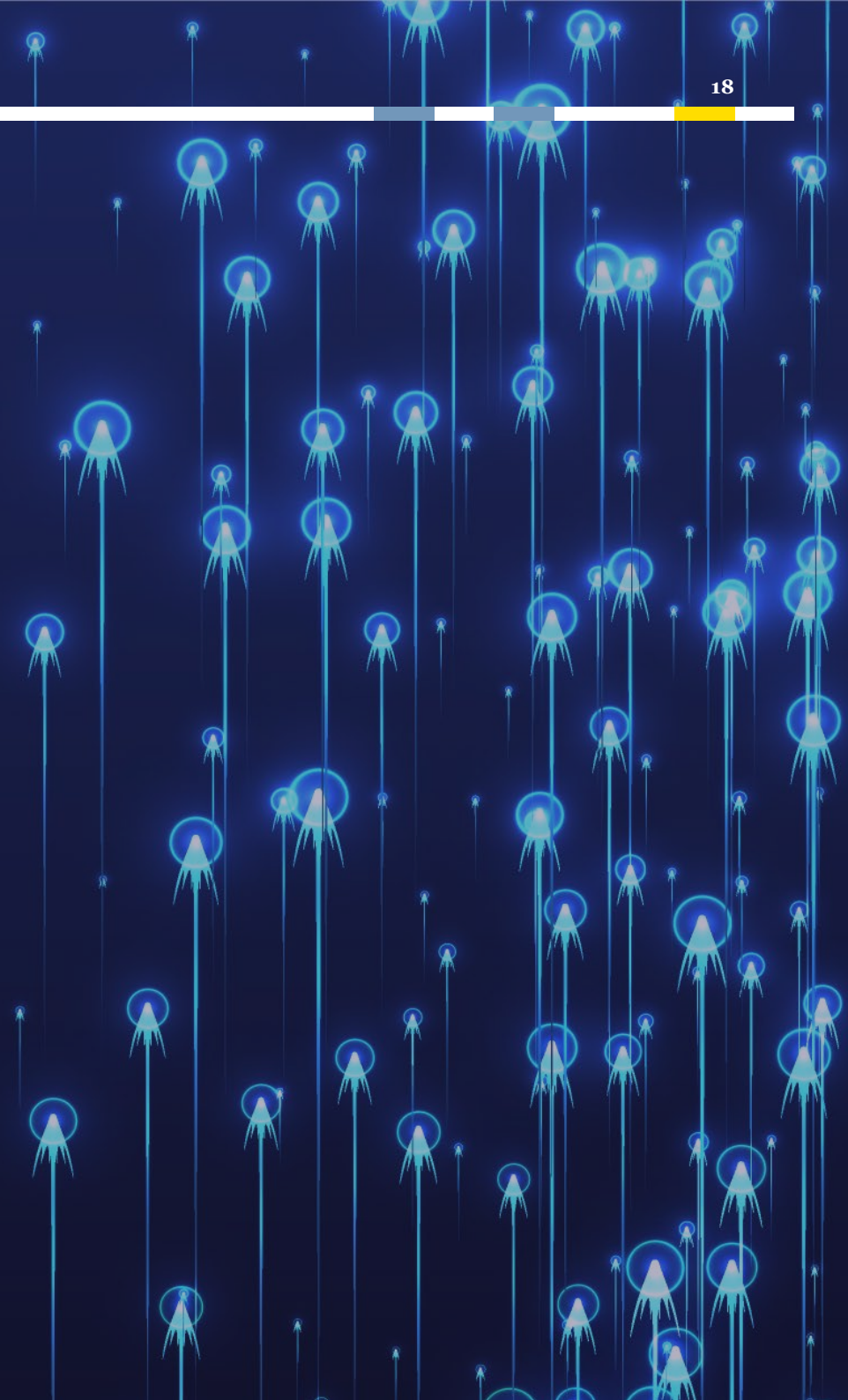
Its membership of influential innovative companies that both own and license IP has wide experience of how IP works in practice to support the growth of technology-driven industry and generate economic benefit. As a cross-sectoral industry organisation covering all technologies, the IP Federation is able to offer a viewpoint which is authoritative and balanced.

OBJECTIVES

To drive the best possible outcomes from the IP system for UK business and society by:

1. Improving equity, diversity and inclusion in the intellectual property ecosystem.
2. Promoting a balanced, fair and robust IP framework that stimulates innovation, improves sustainability and benefits society.
3. Promoting IP systems globally that offer speed, quality, procedural flexibility and affordability for IP owners including SMEs, and that provide fair and predictable outcomes balancing the needs of IP owners and third parties.
4. Providing persuasive and timely input to policy makers. In particular, ensuring that industry's views on IP are understood by the UK Government, including the UK's Chief Trade Negotiation Advisor, and taken into account during the negotiation of free trade agreements (FTAs).
5. Driving improvement of the global patent system by active participation in substantive patent law harmonisation work in the UK and internationally, by continuing to provide a policy advisor to support the work of the Industry Trilateral, IP5, B+ and associated working groups.
6. Raising awareness of the way in which the IP system can support innovation, collaboration and dissemination of technology and knowledge, to drive the best possible outcome for society.
7. Providing a source of informed news and comment to both our members and the public on developing areas of IP policy and law, and a forum for discussion.
8. Engaging directly and collaboratively with key organisations in the intellectual property ecosystem both in the UK and globally.

The Patent System



Patent Law Harmonisation Review

This review, as in previous years, is concerned with progress on procedural patent law harmonisation at the IP5 Offices and discussions on substantive patent law harmonisation (SPLH) taking place before the B+ group of developed countries.

PROCEDURAL PATENT LAW HARMONISATION

A virtual meeting between the Heads of the IP5 Offices and industry was held on 8 June 2022 and jointly chaired by the EPO and BusinessEurope. It was the 10th anniversary of such meetings.

The meeting was split into two: a celebration of 10 years of the Offices working with industry (with an update of recent achievements) and a strategic topic: “sustainability”. There were short videos on both topics prepared by the EPO.

UPDATE OF RECENT ACHIEVEMENTS BY THE OFFICES

1. Interested parties can now subscribe to an e-mail alerting service to be notified of data changes in relation to specified applications as a result of the Global Dossier Alerting Project. It is hoped that all the Offices can complete their planned work on the Global Dossier Project.
2. Project briefs have been issued for work on classification of AI inventions, AI assisted CPC, the collection of existing materials on examination of AI inventions and a comparative study on examination practices at the Offices in relation to AI inventions. The Offices agreed to collaborate with the industry task force on this topic and it was suggested that a catalogue of terms and definitions used would assist.

3. A key issue to be resolved in the IP5 Collaboration and Search Project is how this should be financed. IT resource is also required. A detailed progress report on this work would be welcome.
4. In the Global Assignment Project, the Offices are looking at: using common forms, alignment of the Offices’ requirements and a repository for Global Assignments (WIPO had been suggested in the past).
5. Allowable features in drawings: There has been good progress on this and industry looks forward to an “IP5 Safe Format” brochure.

Feedback was provided that it was hoped that the IP5 Offices would use harmonisation as a tool to reduce the administrative burden on applicants. The US Information Disclosure Statement and documents sharing (through Global Dossier) were given as examples. The Offices should promote digitalisation and machine translation; digital signatures was given as an example of where cooperation would be beneficial.

THE STRATEGIC TOPIC: SUSTAINABILITY

EPO President Campinos introduced this topic, and the EPO Chief Sustainability Officer Roberta Romano-Götsch spoke about the establishment of the EPO Observatory. How can the IP5 Offices/Industry collaboration promote sustainability?

Thierry Sueur (BusinessEurope) responded on behalf of industry that it was important to stress the inter-relationship between innovation, sustainability and IP. The Offices and industry should exchange information on this and how to promote greater understanding of it.



The following were mentioned:

- The JPO work with WIPO on WIPO Green, the use of licensing to stimulate innovation and enable new technologies to be developed and exploited, patent landscape information needs to be more widely available and the USPTO’s report on IP Intensive Industries (published on March 17th) which, amongst other things, showed a lack of diversity and inclusion amongst patent inventors. The EPO/EUIPO report on IP Intensive Industries and economic performance in the EU was published in October 2022.
- BusinessEurope is leading an IP5 Industry working group tasked with providing a proposal to the Offices by the end of quarter one of 2022 on the increased use of e signatures.

Continued

SUBSTANTIVE PATENT LAW HARMONISATION

A virtual meeting of the IP Offices of the B+ group and the Industry Trilateral, AIPPI and FICPI was held on 21 September 2022 and chaired by the head of the French INPI, Pascal Faure.

The Australian, Canadian and Japanese Patent Offices and the EPO reported on their surveys/consultations on the grace period. There was overwhelming support for SPLH and for a grace period (Europe 62% for, 25% against). The Australian and Canadian Offices specifically mentioned their support for a 12-month grace period based on the national filing date. The EPO and Japanese reports were the more detailed.

In the EPO consultation, the IT3 Elements Paper was preferred over the AIPPI/FICPI proposals as a whole, but AIPPI/FICPI were preferred on Conflicting Applications and prior user rights (PURs). The accelerated publication proposal in the Elements Paper was seen as a big positive. The EPO felt that modifications were required in the Elements Paper on PURs and for when the Statement (identifying the pre-filing disclosures of the applicant which are to be graced) needs to be filed; these would assist in ensuring that the new system would be a first-to-file one. The EPO also reviewed its survey carried out earlier in the year which showed that SMEs and universities would favour a grace period. The JPO reviewed its study showing the benefits of the grace period to SMEs and universities. It is understood that the B+ is continuing its work on this topic and has set up a number of working groups to report back at the 2023 B+ meeting.

ATTORNEY CLIENT PRIVILEGE

This was also discussed at the B+ meeting. A revised version of the proposal was presented by the Swiss IPI. There are still some concerns over whether this adequately covers in-house IP staff and these are being considered by the IP Federation and BusinessEurope.

TRILATERAL HEADS MEETING WITH INDUSTRY

The Industry Trilateral held a face-to-face meeting with the Trilateral Offices in North Carolina on 8 November 2022. Topics under discussion included: digitalisation efforts and initiatives before the Offices that support innovation and business communities and promote the use of the IP system; reports by the Offices on IP-intensive industries and how these support the economy; ways that the Offices and industry can engage and support small and medium-sized enterprises and encourage them to participate in the IP ecosystem; and how to make the innovation system more inclusive. The Offices referred to a number of reports they had published over the last year on the topics and outlined what they propose to do in the future. Industry provided feedback - for example it would be useful if the Offices used consistent methodology in preparing reports - and suggested how the message that IP is good for society could reach a wider audience. There was also a discussion on how the Office/Industry cooperation could create further efficiencies in the IP system in the future and the Industry Trilateral proposed a number of specific projects in this respect.

Tony Rollins, Policy Advisor



Licensors and licensees – Have you discussed your UPC strategy?

The arrival of the Unified Patent Court ('UPC') and Unitary Patent has been widely welcomed, as has the news that the system is planned to go live on 1 April 2023, despite the pleasure being tinged with disappointment given that the UK is not a part of it.

Although companies have been warned many times over the years that the UPC was due to open soon and they should start their preparations, it has sometimes seemed too remote to worry about. Now, at last, it can be said that it will happen and therefore preparations must be made.

This article looks at one aspect of those preparations – one that sometimes gets overlooked – the need to review a company's European patent licences (both in and out).

Few licences will have provisions in them requiring licensors to discuss their opt-out strategy with their licensees. Therefore, the parties should discuss and agree a way forward. Indeed, it could be a discussion which might be needed with multiple licensees if a patent has been licensed in numerous territories across Europe.

WHAT WILL HAPPEN AND WHEN?

The event that will fire the starting gun is the deposit by Germany of its instrument of ratification of the UPC Agreement ('UPCA'). Provided this takes place in December 2022, the UPCA will come into force on 1 April 2023 (being the first day of the fourth month after the deposit), the UPC will open for business and the two Regulations setting up the Unitary Patent will become operational.

Assuming this timetable does not slip, the Sunrise Period will start on 1 January 2023. This is a three-month period which will allow patentees to register opt-outs of their current European patents, patent applications and related supplementary protection certificates before the UPC opens for business.

WHAT DOES OPTING OUT MEAN?

Much ink has been spilt on the benefits of opting out or remaining in the system and how this feeds into a company's litigation strategy.

The UPC is planned to go live on 1 April 2023

In summary, opting out means that the UPC will not have jurisdiction over a company's European patent and jurisdiction will remain exclusively with the national courts. This prevents a single, centralised invalidity attack being launched before the UPC, something that many patentees worry about, particularly as the UPC is an untried forum. However, the decision to opt out is not irrevocable; it is possible to opt back into the system, which a patentee can choose to do before launching an application for a multi-territory injunction. In contrast, remaining in the system means that both the UPC and national courts have jurisdiction over a European patent for the transitional period (7 years plus a possible further 7 years from 1 April 2023).

Continued

WHO CAN AND CANNOT OPT OUT?

An opt-out must be filed through the case management system and is only valid when performed by all the proprietors of a European patent and all holders of existing supplementary protection certificates. Licensees have no role to play in the opt-out process.

For exclusive licensees, this could be of particular concern. Such licensees often have the right to enforce the licensed patent given that it is their business which is directly affected if infringing products are put on the market. As can be seen from the brief description above, their ability to determine the litigation strategy of a licensed patent will be significantly affected by whether the patentee has opted out or not.

HOW SERIOUS IS THIS ISSUE FOR LICENSORS AND LICENSEES?

The need to discuss and decide on an opt-out strategy is of particular importance for parties to a licence (usually an exclusive licence) which grants the licensee the ability to issue proceedings to enforce a European patent in their licensed territory. If there is no discussion and co-ordination between the patentee and licensee, future enforcement strategy could be unwittingly affected.

For example, if a European patent is not opted out and, after 1 April 2023, an exclusive licensee issues infringement proceedings in a single UPC Contracting Member State (because that is the licensed territory), the defendant could respond with a centralized invalidity attack before the UPC. The patentee's right and the right upon which the patentee's other European licensees rely is put at risk.

Alternatively, a licensee licensed in more than one Contracting Member State might choose to start an action before the UPC to enforce the patent in multiple countries. This, again, would inevitably be met with a centralised invalidity attack.

In both these examples, there is a wider knock-on effect on future litigation strategy. As noted above, where a patent has been opted out, it can be withdrawn by the patentee (but not a licensee – the licensee has no say in the matter). However, where an action has been started before the UPC, it prevents any future ability to opt out the patent. There is no distinction in the UPCA as to the types of action that block the opt-out, whether an infringement or invalidity action, whether the action is for provisional measures or is an action on the merits, whether it is concluded or not, or even whether the same parties are involved.

It should also be noted that withdrawing an opt-out is only possible if no action has been brought before a national court at any time. The wording of the UPCA indicates that it does not matter whether the national court action was started before or after the UPCA entered into force, rather it is the existence of the earlier national action which prevents the opt-out being withdrawn. As such, starting an action in a national court locks the European patent into the national court system.

The effect of a licensee's actions could therefore be far-reaching; a patentee's (or possibly another licensee's) strategy of withdrawing an opt-out to commence a multi-territory infringement action could be blocked because proceedings were started in a national court beforehand. These problems only multiply where there are numerous licensees each with the ability to bring proceedings in their own licensed territories.

CONCLUSION

It is likely that patentees who have licensed their European patents will opt out their patents as they seek to reduce the risk to their licensing income by avoiding a central invalidity attack. This may suit most licensees, but possibly not all as some may want to assert their licensed rights before the UPC.

Discussions regarding whether to opt out or not should therefore be had between licensors and licensees of European patents sooner rather than later so that, if the decision is taken to opt out, the patentee can do so in the Sunrise Period and before the UPC becomes operational. Such discussions should also include a review of who has the right to bring future proceedings and where, so that one party does not find that their options have been inadvertently curtailed by the actions of the other.

There is a wider knock-on effect on future litigation strategy

Katharine Stephens, Bird & Bird LLP

Amending the requirement for Description Amendments: the EPO's hot topic of 2022

Patent lawyers are well-aware of the influence a patent's description can have on the monopoly granted by the claims of that patent. Whilst, strictly, what matters is the patent's claims, any ambiguity takes one back to the description. European Patent Convention ("EPC") Rule 42 specifies that the description must describe the invention such that it can be understood by reference to the underlying technical problem to be solved. The material included in a patent's description therefore matters. Too little may limit the patentee's ability to rely on a wider interpretation in post-grant amendments or enforcement against an allegedly infringing product. Too much material risks falling foul of the European Patent Office's ("EPO's") strict new Guidelines for Examination ("the Guidelines") on inconsistencies between the description and the claims (section F-IV-4.3). Under these Guidelines, examiners can require amendments to the description, including by the explicit disclaiming of certain embodiments as not being part of the invention. This, of course, can have significant implications, particularly when assessing infringement by the doctrine of equivalents.

2022 saw a plethora of EPO Board of Appeal decisions grappling with description amendments, with differing views. So where do we stand?

THE BACKGROUND: T 1808/06 (2008) AND THE 2021 EPO GUIDELINES FOR EXAMINATION

T 1808/06 set out the general approach to the claims being supported by the description, in the context of claim amendments: *"the adaptation of the description to amended claims must be performed carefully in order to avoid inconsistencies between the claims and the description/drawings which could render the scope of the claims unclear. Any disclosure in the description and/or drawings inconsistent with the amended subject-matter should normally be excised."* The position was considerably reinforced in 2021 by amendments to the Guidelines, which required either the deletion of embodiments in the description that were not covered by the independent claims; or an explicit statement disclaiming an embodiment as part of the invention.

THE CLAIMS TAKE PRECEDENCE: T 1989/18 (DECEMBER 2021)

The end of 2021 marked the first divergence from the strict description amendment requirements. The Examiner refused the application on the basis that the patent's description of the invention identified subject matter that was broader than the claims. The Board of Appeal set this decision aside. It placed considerable weight on the language of Art. 84 EPC that the claims must be "clear and concise" (or "clear in themselves", to use the wording of the decision). The subsequent mention of the "description" in Art. 84 related only to the subject matter of the claim and not its clarity.



The position was considerably reinforced in 2021 by amendments to the EPO Guidelines.

Neither was the Board of Appeal persuaded that Art. 69 EPC (on the use of the description to interpret claims), nor EPC Rule 42 (disclosure of the claimed invention in terms of the technical problem and its solution), nor EPC Rule 48 (obviously irrelevant or unnecessary matter in an application), had legal basis to require description amendments in that case.

SPRING CONFUSION: 2022 EPO GUIDELINES UPDATE, AND T 1024/18

In early 2022, updated Guidelines saw the wording of section F-IV-4.3 edited again. Although the requirement to delete or disclaim certain embodiments remained similar (*“The applicant must remove any inconsistencies by amending the description either by deleting the inconsistent embodiments or marking them as not falling within the subject-matter for which protection is sought”*), the 2022 update appeared to provide the patentee with some leeway: *“For borderline cases where there is doubt as to whether an embodiment is consistent with the claims, the benefit of the doubt is given to the applicant”*.

However, hot on the heels of the updated Guidelines was another Board of Appeal decision, T 1024/18 (March 2022). Among other issues, the decision addressed description amendments. It specifically called out – and disagreed with – T 1989/18. Two embodiments in the description were cited as being inconsistent with the claims. Referring again to Art. 84 EPC, the Board of Appeal concluded that, although the claims may well be “clear”, *“the criterion that the claims be “supported by the description” is not in any way subordinate to the requirement of “clarity” of the claims, but is a requirement of its own”*. As such, consistent with a strict approach, the Board of Appeal found the claims must be consistent with the description throughout, *“not only in some part”*. In the absence of an amended description, the patent was revoked.

REFERRAL TO THE ENLARGED BOARD OF APPEAL, OR ARE THE DECISIONS RECONCILABLE?

Plenty more decisions on description amendments came during the remainder of 2022. Numerous cited and disagreed with the decision in T 1989/18, holding up the decision of T 1024/18 as the correct approach: the claims must be consistent with the description *throughout*, regardless of whether the claims were clear on their own. This position was seemingly confirmed by the EPO directly, following an “expert workshop” it hosted in June amidst the confusion. However, whilst the balance of decisions certainly weighs on the side of the strict approach advocated for in the EPO Guidance, there have still been decisions that conclude that the claims have primacy: T 1444/20 (April 2022) concluded that in circumstances where redundant subject matter in the description did not impair the understanding of the technical problem, no description amendment was necessary; and indeed that T 1989/18 was correct to find there was no legal basis to require the removal of matter which is obviously irrelevant or unnecessary.

Might we see a referral to the Enlarged Board of Appeal? Perhaps. Or maybe an October 2022 decision gives hints at the way through. In T 2194/19, the Board of Appeal steered clear of citing T 1989/18, but did decide that the conclusion that all embodiments must fall within the scope of the independent claims is one that *“cannot be derived from the EPC”*.

Rather, it appears to suggest a case-by-case approach: *“it may well be that, in a given case, there is such an inconsistency or contradiction between the claims and an “embodiment” of the description. But this has to be justified by the examining division.”* Such an approach will not give practitioners the confidence they desired. 2023 will surely see more activity in the description amendment saga.

Plenty more decisions on description amendments came during the remainder of 2022.

Alex Calver, Senior Associate, WilmerHale LLP

Amicus curiae briefs at the European Patent Office (EPO)

In 2022, the IP Federation submitted two *amicus curiae* briefs to the Enlarged Board of Appeal of the EPO in relation to pending referrals.



The first, submitted in April 2022, was in relation to the G 2/21 “plausibility” referral. The Board issued a preliminary opinion on this matter in October 2022, and held a hearing in November 2022 with the final decision still being awaited. The second brief, submitted in July 2022, related to the G 1/22 and G 2/22 “Entitlement to priority” referrals. The Board is yet to provide anything of substance on this matter, but they are expected to do so in 2023.

G 2/21 - PLAUSIBILITY

G 2/21 relates to the filing of post-published evidence to support the plausibility of an invention. The three questions referred to the Enlarged Board of Appeal in G 2/21 can be summarised as:

1. Should there be an exception to the principle of free evaluation of evidence (see e.g., G 3/97, Reasons 5, and G 1/12, Reasons 31) in that post published evidence demonstrating a technical effect must be disregarded if the only proof of that effect is exclusively within the post published evidence?

2. If the answer to question 1 is yes, can the new evidence be taken into consideration if, based on the information in the patent and the common general knowledge, the skilled person would have considered the effect plausible at the filing date (*ab initio* plausibility)?
3. If the answer to question 1 is yes, can the post published evidence be taken into account if there was no reason at the filing date to consider the technical effect implausible (*ab initio* implausibility)?

IP FEDERATION SUBMISSION

In summary, the IP Federation’s submission was that post filed evidence should be admissible to support a technical effect that the skilled reader of the patent would not have considered implausible. This is because the role of plausibility should be limited to preventing speculative patenting.

Furthermore, this would be in line with policy considerations underlying the first-to-file system in the European Patent Convention (EPC). Unlike a first-to-invent system, the

The role of plausibility should be limited to preventing speculative patenting.

EPC approach encourages patentees to disclose their inventions early in the development cycle, which is often before they can explore the full scope of their discovery. It is only fair, therefore, that once they have disclosed a plausible technical effect in their patent application, a patent proprietor can then file post-filed data as necessary to support the scope of the claims.

PRELIMINARY OPINION

In the preliminary opinion, regarding question 1, the Board indicated that post published evidence should not, as a matter of principle, be disregarded as doing so would deprive the party submitting and relying on it of their ‘right to be heard’ in Article 113(1) EPC and their rights in relation to the ‘means and taking of evidence’ in Article 117(1) EPC.

Continued

While this suggests that the first referred question is to be answered “no”, the Board nevertheless went on to consider some of the issues raised by questions (2) and (3). The Board indicated that this guidance is to be limited to the question of plausibility in the assessment of inventive step (and not sufficiency).

The Board’s preliminary indication was that post published evidence showing a technical effect may be taken into account where there would have been no significant reason for the skilled person to doubt the effect (i.e., where the claimed effect was *not implausible*) provided that the technical effect relied upon is encompassed by the technical teaching of the patent and embodies the same invention. The Board therefore currently is favouring the more lenient “allowable if not implausible” standard with slight modifications to prevent a patentee from relying on a completely unrelated technical effect from that of the original disclosure.

It appears, therefore, that the Board’s initial view is in line with the IP Federation’s position.

G 1/22 AND G 2/22

These referrals relate to the question of the EPO’s joint application approach to priority for PCT(EP) applications. Article 118 EPC states that, where the applicants for a European patent are not the same for different contracting states of the EPO, they shall be regarded as joint applicants and that unity of the application will thus not be affected. The issues in this case boiled down to whether this principle can be extended to PCT joint applicants, where named applicants for a PCT application are different for different designated states.

The questions referred to the Board are summarised as:

1. Does the EPC confer jurisdiction on the EPO to determine whether a party validly claims to be a successor in title as referred to in Article 87(1)(b) EPC?
2. If question 1 is answered in the affirmative: Can a party B validly rely on the priority right claimed in a PCT-application for the purpose of claiming priority rights under Article 87(1) EPC in the case where:
 - a. A PCT-application designates party A as applicant for the US only and party B as applicant for other designated states including regional European patent protection, and
 - b. The PCT-application claims priority from an earlier patent application that designates party A as the applicant. and
 - c. The priority claimed in the PCT-application is in compliance with Article 4 of the Paris Convention?

IP FEDERATION SUBMISSION

In summary, the IP Federation’s submission was that question 1) should be answered in the negative: the EPO does not, and should not, have jurisdiction to determine whether a party validly claims to be a successor in title as referred to in Article 87(1)(b). Further, even if the EPO did have such jurisdiction, question 2) should then be answered in the affirmative: it would be the case that the established joint-applicant approach to assessing priority would be the correct one to adopt. This is because a PCT application should be considered as a single, indivisible application until it exits the international phase and applicants should be considered as joint applicants, irrespective of designations for different states, and that the priority rights cannot be split for different designations, depending on which applicant has been named for each designation.

The submission in relation to question 1 centred on three key points:

- 1) The contracting states of the EPC have not delegated this authority to the EPO (as is clear from the *travaux préparatoires*);
- 2) Drawing on the analogy to the provisions of the EPC relating to entitlement (Art. 61 EPC) highlights that no jurisdiction in respect of such disputes is given by the EPC, and that instead this is a matter for national courts; and
- 3) The determination of such national law questions by the EPO raises a number of practical difficulties given its composition and expertise.

The submissions in relation to question 2) focussed on the principle of equal treatment which requires application of the same rules and practice to Euro-PCT applications unless there are specific prevailing PCT provisions (see Article 150 EPC). It was submitted that there are, however, no PCT provisions excluding the application of the joint-applicants approach to Euro-PCT applications, but rather there are stipulations supporting the approach that during the international phase international applicants are to be regarded as joint applicants even if they are not the same in respect of the different designated States.

The IP Federation also noted, on a practical level, that the joint applicant approach has been adhered to for many years and has historically been relied upon by a number of applicants in their overall filing strategies at the EPO. Briefs submitted by other industry groups also reflect this point and it is hoped that the Board will consider the implications of this in their opinion.

Eden Winlow, and Myles Jelf Bristows LLP

The TRIPS Waiver

The snappily named Agreement on Trade-Related Aspects of Intellectual Property Rights (or TRIPS for short as the full name hardly trips off the tongue) is a World Trade Organization (WTO) agreement badged as “the most comprehensive multilateral agreement on intellectual property to date”. It was signed in 1994 and is a “minimum standards” agreement which sets a baseline for IP protection; Members are able to provide more comprehensive protection if they wish and under certain circumstances flexibilities to the minimum standards are permitted.

This agreement made headlines across the world in 2021 following proposals first tabled by India and South Africa at the WTO that a waiver should be agreed enabling Members to have more flexibility than currently allowed under TRIPS in respect of vaccines, therapeutics and diagnostics for the treatment or prevention of COVID-19. I finished my 2021 article on this matter with the following words: *“It remains to be seen whether next year’s IP Federation Review article is talking about the impact of the introduction of a waiver or not – watch this space!”*

So, what has happened in the intervening year? Following a frantic scurry of activity at the WTO 12th Ministerial Conference (MC) in June 2022, a waiver was adopted to much fanfare and publicity in respect of vaccines only.

The waiver as agreed essentially makes it easier for entities in developing country Members of the WTO to use the compulsory license provisions of TRIPS, i.e. to produce patented vaccines without the need to seek a voluntary license from the patent holder. Opponents of the waiver had argued that there was sufficient supply to meet the WHO targets, and that the true barrier to vaccine access was equitable distribution, vaccine

hesitancy and trade barriers. This Bloomberg tracker – More Than 12.7 Billion Shots Given: Covid-19 Vaccine Tracker – shows that vaccine distribution is still uneven, with many of the world’s least wealthy nations remaining unprotected at a meaningful level.

The waiver however appears to have made little difference to this since it was passed in June. As far as this author is aware, no companies have yet sought to use the increased flexibilities of the waiver. Could this be because they are not needed? One way forward to increase capability and capacity for vaccines manufacture in developing countries is through voluntary licensing. Hundreds of voluntary licences and agreements have been put in place since the start of the pandemic, and the focus is now moving to increasing vaccine manufacturing capability in Africa in ways that can work for the continent. Consider the innovative “turnkey” manufacturing modules in containers that BioNTech has developed – BioNTech introduces first modular mRNA manufacturing facility to promote scalable vaccine production in Africa.

Another argument made by opponents of the waiver was that the true barriers to access were not related to IP. That still appears to be the case. For the first time since the pandemic began, the global supply of vaccines is not currently a constraint. The key will be to remove barriers to deployment such as access to refrigeration, provision of syringes with vaccines, training of local healthcare workers and support to overcome vaccine hesitancy.

More than 12.7 billion shots given

So, now that the waiver has passed and the world is moving towards full vaccination is the story over? I think not. The Ministerial Decision included the following statement: *“No later than six months from the date of this Decision, Members will decide on its extension to cover the production and supply of COVID-19 diagnostics and therapeutics.”* The discussion around therapeutics is even more challenging than that around vaccines. A vaccine by its nature is limited to a single indication – it protects against one pathogen. A therapeutic medicine on the other hand can often have many indications as indicated by the fact that half of the approved therapeutics for the treatment of COVID-19 were already approved for the treatment of other conditions. Similar arguments in respect of the true barriers to access also apply. Many pharmaceutical companies are signing voluntary patent licences that enable access in low and middle income countries such as Shionogi and the Medicines Patent Pool (MPP) sign licence agreement for COVID-19 oral antiviral treatment candidate to increase access in low- and middle-income countries.

At the time of writing, WTO Members are holding fortnightly negotiation discussions, but no draft text has yet been circulated. Given this, it seems unlikely that any consensus can be reached before the deadline of 17 December 2022, although many would have said the same ahead of MC12 in June. Once again, I need to finish an article with the words: *“It remains to be seen whether next year’s IP Federation Review article is talking about the impact of the introduction of a waiver or not – watch this space!”*

Susan Chiappinelli, GlaxoSmithKline plc

FRAND: Busy UK Courts, and the European Commission's Initiative on a New Framework for Standard-Essential Patents (SEPs)

Litigation over the Fair, Reasonable And Non-Discriminatory ('FRAND') terms involved in licensing telecoms patents again kept the UK Patents Court busy in 2022. The year kicked off with a trial to determine FRAND terms for InterDigital's cellular SEP portfolio in *InterDigital v Lenovo*, and a 5-week trial to determine the same for Optis's portfolio in *Optis v Apple* over the summer followed the fourth and final technical trial between the parties. *Philips v Xiaomi*, *IP Bridge v Huawei*, and *Ericsson v Apple* all settled to clear the Court's diary, whilst jurisdictional challenges and technical trials kept litigators busy in *Nokia v OnePlus*, *InterDigital v OnePlus*, *Philips v Oppo* and *Kigen v Thales*.

At the heart of the initiative is the aim of addressing inefficient licensing, hold up, hold out, and forum shopping.

Both the UK Intellectual Property Office (IPO) and The European Commission launched calls for views, to both of which the IP Federation responded. This article focuses on the European Commission's initiative, which sought views on a new framework for SEPs. At the heart of the initiative is the aim of addressing inefficient licensing, hold up (e.g., behaviour by a SEP owner to extract licensing royalties which are excessive and therefore not FRAND, thereby abusing its monopoly rights), hold out (e.g., where a SEP owner claims that a potential SEP licensee resists or delays taking a licence to a SEP portfolio), and forum shopping (when litigants look to have disputes heard in jurisdictions they consider most favourable to them). A lack of transparency was said

to be a major factor in hampering SEP licensing, which the Commission said in turn slows the pace of innovation in a world that is increasingly reliant on the numerous technologies underpinned by SEPs. By calling for feedback from industry participants (which was received in May 2022), the Commission intends to develop guiding principles and processes to better industry understanding of the underlying SEPs themselves, which it hopes will enhance the efficiency of SEP negotiations, licensing, and enforcement and improve the competitiveness of EU businesses.

The IP Federation was among the 74 respondents to the Commission's consultation. As was highlighted to the Commission, the IP Federation's members comprise the spectrum of innovative and influential companies: those who are predominantly users of SEPs (licensees); those who are owners of SEPs, and key contributors to standards (licensors); and those who appreciate the permeation of SEPs into industries that may not, yet, be affected. With this spectrum, consensus on some 60 questions posed by the Commission was understandably difficult. The IP Federation did, however, set out various factors that should be taken into account in the initiative, all of which were in line with the aims of the Commission's initiative: encouraging innovation within an IPR system that is effective for large and small companies; maintaining open debate and consultation; increasing transparency of licensing practices, whilst observing necessary confidentiality issues; and improving the quality and neutrality of information available on patent essentiality.

The Commission's feedback is expected in the second half of 2023. In the meantime, the Commission has published a summary of the consultation responses.



The Commission's feedback is expected in the second half of 2023.

Responses were predictably divided between potential SEP licensees and SEP licensors, but some interesting points emerge.

Respondents estimated that the costs of SEP exposure, per product, amounted to an average of €230,000, where such SEP costs and risks are shared throughout the supply chain. Around 70% of potential SEP licensees take a licence without litigation, with negotiations taking on average, 3 years and 3 months. Information availability and asymmetry regarding SEPs, their owners, checks on their essentiality, the standards to which they are said to be essential, and licence rates and terms that cover those SEPs, were key items the respondents are concerned with.

The FRAND landscape will continue to develop considerably over the course of the next year in the UK and Europe.

Alex Calver, Senior Associate, WilmerHale LLP

Highlights from the UK Patents Court 2022 - Validity

It is almost invariably the case that a standard patent dispute should entail the question of infringement and validity. Leaving the updates on Infringement to fellow IP Federation associate Alex Calver of WilmerHale, we will focus on validity.

OBVIOUSNESS

The principles governing the assessment of obviousness have been looked at by the courts in some depth in recent years. Fundamentally there is a single question. Is it obvious? Aside from the question as to whether it is possible to infer the nature of the skilled person from what the specification assumes about his/her abilities (Meade J said no in *Optis v Apple*, Mellor J said yes in *Alcon v AMO*), we have a fairly extensive and consistent body of case law explaining the law on obviousness and illustrating its application. The attribution of the characteristics of a skilled person is an important point though, as noted by Birss J (as he was then) in the *Illumina* case: “It would be wrong and unfair to the public to define a team so widely that their common general knowledge is so dilute as to make something seem less obvious than it really was”. Defining the attributes of a skilled person would equally impact the assessment of sufficiency, as noted by Mellor J in *Alcon v AMO*.

Fundamentally there is a single question. Is it obvious?

NOVELTY

The same goes for novelty. We all know that to anticipate, the prior art disclosure must ‘plant the flag’, and that still holds true. Perhaps it is worth adding that Mellor J reminded us that “...the notion that one cannot strip out inconvenient detail from the prior art applies also/especially in the context of anticipation” in *CommScope Technologies v SOLiD Technologies*.

SUFFICIENCY

In recent years, in keeping with the rapid developments in the case law, the UK Patents Court has focused in some detail on the state of play with respect to sufficiency. There is an outstanding point, on the date at which sufficiency is to be assessed, which remains ripe for review by the higher courts, but nothing significant has happened on that issue in 2022. Instead, judgments in 2022 indicate that the governing principles have largely settled too, but for the purposes of this publication, we have cherry-picked a couple of interesting judgments worth raising in relation to *Classical Insufficiency* and *Biogen Insufficiency*.

CLASSICAL INSUFFICIENCY

Classical insufficiency arises when the directions in the patent are inadequate to enable the person skilled in the art, using their common general knowledge (CGK), to perform the invention without undue burden.

In *Saint-Gobain Adfors v 3M*, the case about 3M’s patent to dish-shaped abrasive particles with a recessed surface area, Michael Tappin QC illustrated the application of the classical type of insufficiency as it now stands. Saint-Gobain’s challenge was that the skilled person could not, without undue burden, produce particles with an average ‘Tc/Ti’ ratio at the upper end of the claimed range. Michael Tappin QC held that the claimed range of 1.25–5.00, for the average ratio, was a relevant range, so, the patent would be insufficient if it did not enable a skilled person to make, without undue burden, abrasive particles *at both the upper and lower end of the claimed range*.

In the context of the undue burden challenge, 3M sought to rely on a cross-reference to a US patent contained in 3M’s patent. The document explained that, depending on process parameters, the same identical production tooling could produce abrasive particles of the requisite character.

However, the judge said that the “*fundamental problem*” for 3M was that none of this was addressed by its expert in his reports, nor put to Saint-Gobain’s experts in cross-examination. The judge stated:

“My understanding is that in order for a skilled person to consult a document for a particular purpose, it must be made clear that the skilled person should consult a document for that purpose. Further, in my judgment, the question of what a skilled person would do, when faced with a cross-reference and the document cross-referred to, is one on which expert evidence is admissible, and indeed required if a party wishes to establish that the skilled person would alight on particular text and find it of assistance in a particular way.”

It follows, for 3M to have succeeded on this point, evidence would have been needed that the skilled person would have alighted on the passages relied upon and would have appreciated that they would provide a solution to the problem, namely of making dish-shaped abrasive particles with an average Tc/Ti ratio towards the upper end of the claim. The judge said that the *ability to make particles at the top of the range needed to be “abundantly clear”*.

Some of the content within this article is covered in more detail at Gowling’s annual patents review, [A Slightly Slippery Slope](#).

EXCESSIVE CLAIM BREADTH / BIOGEN / LACK OF PLAUSIBILITY INSUFFICIENCY

The ‘*Biogen*’ / ‘excessive claim breadth’ / lack of plausibility type of insufficiency is met where the extent of the monopoly claimed exceeds the plausible technical contribution to the art made by the invention as described in the specification. The question of whether the specification adequately discloses the invention is one of degree. It is permissible to define an invention using general terms provided the patent discloses a principle of general application in the sense that it can reasonably be expected the invention will work with anything falling within the scope of these terms. This ‘*reasonable prediction*’ test is approached by adopting a three-step test:

- First, identify what it is which falls within the scope of the claimed class
- Second, determine what it means to say that the invention works – what is it for?
- Third, determine whether it is possible to make a reasonable prediction that the invention will work with substantially everything falling within the scope of the claim?

In 2022, in *Sandoz v BMS*, Meade J concluded that BMS’ patent to apixaban was invalid for lack of plausibility. The judge said that, *in order for a patent not to be insufficient for excessive claim breadth*, it must be possible for the person skilled in the art to make a reasonable prediction (i.e.: plausible or credible) *that the invention will work with substantially everything falling within the scope of the claim*.

What it means for the invention to “work” is to be determined from the specification where the claim is not explicit (although the patentee is not restricted to the most ambitious assertion made). When considering insufficiency the court is addressing a patent which has been granted and is required to start from a presumption of validity – the burden should be on the challenger to prove that the patent is invalid. However, it seems that the burden of proof seems to have been placed on the patentee in this case.

SUMMARY AND CONCLUSIONS

While the recent jurisprudence relating to insufficiency has largely settled UK law in this area including by reference to principles developed in the European Patent Office, some aspects of the law present challenges for patent owners seeking patent protection at a relatively early stage of R&D. In 2022, a patent supposedly protecting a medicament that does, in fact, “work” has been found invalid for lack of plausibility in the disclosure of the specification. Indeed, there is a downside for a patentee in seeking early protection – the patent expires sooner. However, the opportunity to acquire enforceable monopoly rights is at the heart of the patent system and stimulates technical progress. This area of patent law may yet benefit from being revisited by the Supreme Court in 2023.

Gordon Harris and Ailsa Carter,
Gowling WLG (UK) LLP

Infringement - interesting rulings on the doctrine of equivalents in the UK Patents Court

Five years since the doctrine of equivalents was introduced by the Supreme Court decision in *Actavis v Eli Lilly* [2017] UKSC 48, there are still questions as to its scope (ironically) in the UK.

We dive into three decisions handed down in 2022 to see how the doctrine has progressed.

TEVA V NOVARTIS [2022] EWHC 2847 (Pat). In this decision His Honour Judge Hacon (sitting in the High Court) addressed a question that had not been considered by the Supreme Court in *Actavis*: how should numerical ranges be approached in the context of infringement by equivalence?

The invention concerned a swallowable film coated tablet for the treatment of iron overload. Claim 1 provided for a pharmaceutical formulation “*comprising deferasirox or a pharmaceutically acceptable salt thereof present in an amount from 45% to 60% by weight based on the total weight of the tablet [...]*”. Although the precise figures for Teva’s formulation were confidential, on a normal construction Teva’s allegedly infringing product, Teva DFX, fell outside the claim because its deferasirox content was higher than the claimed range. There was therefore no literal infringement. An infringement finding would thus have to be based under the doctrine of equivalents.

The parties differed as to the what the inventive concept of the patent was: Teva argued it was “*almost entirely about the 45–60% range*”; whereas Novartis argued it was the “unexpected increased bioavailability and reduced food effect” of the formulation (‘food effect’ being the ability to take the tablet with a light meal), with the 45–60% range not featuring. The Judge rejected both. Novartis’s inventive concept was held to import technical effects that were not present in the claims. Teva’s was too simplistic. The Judge came to his own formulation of the inventive concept that largely followed the claim language that included the various other excipients, and, crucially, the range of deferasirox.

Turning to the evaluation of a numerical range in the context of equivalence, the Judge cautioned against a strict approach whereby a numerical range “*invariably implies strict compliance*”. To do so, would mean that “*a product or process 0.1% outside the range could never be an equivalent. Alternatively, what about 1% or 5%?*”. Grappling with the issue, the Judge turned back to the Court of Appeal decision in *Smith & Nephew v Convatec* [2015] EWCA Civ 607, later endorsed by *Jushi v OCV Int. Capital* [2018] EWCA Civ 1416, which held that “*... the approach to be adopted to the interpretation of claims containing a numerical range is no different from that to be adopted in relation to any other claim*”. There was therefore no ‘one-size-fits-all’ approach: compliance with the numerical range could be given more or less weight, depending on all relevant facts.

The Judge’s assessment focussed on the first and third *Actavis* questions. On the first – does the variant achieve substantially the same result in substantially the same way as the invention (i.e., is the inventive concept the same) – he said “No”. Although the skilled formulator has leeway regarding the other excipients if the deferasirox content is in the range, if the deferasirox content is outside the range, there was no evidence before the Court on the corresponding changes to the other claimed excipients to show that they, too, would work in the combination claimed by the invention. Alleged similarities in bioavailability of the parties’ products was no answer to this first *Actavis* question.

The patent was in any event also found invalid over the prior art.

On the third question – would such a reader of the patent have concluded that the patentee none the less intended that strict compliance with the literal meaning of the relevant claim(s) of the patent was an essential requirement of the invention – he said “Yes”. On the facts in this case the skilled formulator would adhere strictly to the 45–60% range of deferasirox. On that basis, Teva DFX would fall outside the claims on a normal construction and under the doctrine of equivalents, as a result of its claimed numerical range. The patent was in any event also found invalid over the prior art.

ADVANCED BIONICS V MED-EL [2022] EWHC 1345 (Pat). In this case before Mr Campbell Forsyth (sitting as a Deputy Judge), the technology concerned rotating disk magnets in implantable cochlear devices that are MRI-safe. On a normal (purposive) construction of the claims, Advanced Bionics' device was held to infringe the patent under s. 60(1). The Judge went on to consider equivalents, in case he was wrong on literal infringement. Like *Novartis*, the equivalence case fell down on the third of the Actavis questions: the patentee did intend strict compliance with the claim language. In this instance, that meant the magnets rotating in one plane parallel to the coil housing, whereas the allegedly infringing product's magnets had the ability to also rotate off-parallel. This case shows how a product can be infringing when claims are assessed purposively, but not when approached as an equivalent.

VERNACARE V MOULDED FIBRE PRODUCTS [2022] EWHC 2197 (IPEC). This case provided a successful invocation of the so-called *Formstein* defence to infringement by equivalence. Vernacare's patent covered a paper pulp wash bowl that could be lifted easily and without fear of disintegration. MFP's washbowl did not infringe on the normal interpretation due to differences in the ridge design. Faced with the doctrine of equivalents, the Judge agreed with MFP that either: the broadening of the claim to catch the 'equivalent' was such that the ridge design was part of the common general knowledge (i.e., the patent was obvious); or, under the third limb of *Actavis*, the patentee intended strict compliance with its ridge design and the product was not equivalent. The case takes UK case law on *Formstein* beyond the *obiter* decisions of Birss LJ and HHJ Hacon in *Facebook v Voxer* [2021] EWHC 1377 and *Technetix v Teleste* [2019] EWHC 126 (IPEC), respectively, and further aligns the UK's position on the availability of such a defence with other European Patent Convention countries.

This case shows how a product can be infringing when claims are assessed purposively, but not when approached as an equivalent.

Alex Calver,
Senior Associate, WilmerHale LLP



The Broader IP Landscape

International Trade and Intellectual Property

INTRODUCTION

It's been a hugely busy year for the IP Federation and its Trade Working Group tracking and trying to influence the UK Government's efforts to secure new trade deals, and ensure that their IP provisions are, as far as possible, supportive of the needs of innovative industry. Since my report on international trade and IP in last year's *IP Federation Review 2021*, I would highlight the following key developments.

The IP Federation, through its Trade Working Group, continues to engage actively with, amongst others, the UK Government-DIT and IPO in particular, the CBI and overseas governments/business stakeholders in the sphere of international trade and IP. It is an unprecedented and intensely busy time, with different complex trade negotiations being undertaken at pace by the UK with different partners across the world. The IP Federation's sustained strong engagement and considered expert inputs in this area in support of the UK Government's objectives are, we believe, beginning to produce positive results at a crunch time. The strong trusted relationship we have built up with the Government – DIT, IPO is a great asset.

In the last year, the IP Federation has provided detailed strong submissions in writing to the UK Government in response, for example, to the DIT calls for inputs on (a) UK trade with India, and (b) the UK's free trade agreement (FTA) with the Gulf Co-operation Council (GCC). Further, in early September this year, the IP Federation responded robustly in writing to the UK Parliament's House of Commons International Trade Committee Inquiry Call for Evidence on UK Trade Negotiations: Comprehensive and Progressive Agreement for Trans-Pacific Partnership (CPTPP) Accession.

IP FEDERATION'S GENERAL PRINCIPLES: NEGOTIATING NEW FREE TRADE AGREEMENTS (FTAs)

The IP Federation continues to urge the UK Government to adopt five general principles in negotiating all new FTAs.

It's been a hugely busy year for the IP Federation and its Trade Working Group.

The first is that there is a crucial relationship between world-leading innovation and a system of IP rights which is robust, balanced, understood, and enforceable. Secondly, the Government should have the ambition of exporting the UK's world-class IP system in all its FTAs. Thirdly, multilateral and bilateral trade agreements both have their place; some issues are better dealt with multilaterally than bilaterally. Fourthly, the value of existing agreements should not be undermined; in this regard, the IP Federation welcomes the Government's previous assurances, especially in relation to the UK's membership of the European Patent Convention (EPC). Finally, the UK should be active in the World Trade Organization and the World Intellectual Property Organization.



Continued

UPDATE ON CPTPP/FTAS

UK accession to CPTPP

The UK remains on track in completing its CPTPP accession objective by the end of this year, and has entered the final phase.

A number of countries are reportedly already in the CPTPP accession queue after the UK, including China, Taiwan, Ecuador, Costa Rica. There is interest in CPTPP accession apparently from the Philippines, Uruguay, and Thailand, too. This in practice likely means that the UK's prospect of getting reservations in the current CPTPP negotiations, if needed, will not be straightforward. Existing CPTPP member states will want to set a strong precedent with the UK to preserve their high, robust standards in any future CPTPP negotiations with other interested countries, China for example, who may wish to accede to the CPTPP.

Addressing IP provisions in CPTPP accession negotiations

The interaction between UK-CPTPP (based on existing CPTPP text) and bilateral negotiations involving CPTPP member states (including the signed ones in Australia, New Zealand, Japan and other ongoing ones such as in Canada, Mexico) covering different key areas such as intellectual property continues to be incredibly important.

In the context of the CPTPP accession negotiations, the IP Federation urges the UK Government to be robust: avoiding putting at risk UK membership of the EPC should be a priority. Reservations relating to provisions for a patent grace period (and extending patent term for patent office delays) as currently set out in the CPTPP should not be regarded as second-order UK demands to be set aside.

Of course, there will be a number of issues of national interest which the Government will need to weigh. But a primary purpose of the IP system is to serve and support innovative business, and the terms of CPTPP accession should take full account of their impact on British industry.

It is not the concept of a grace period *per se* which is the problem. A properly formulated, internationally harmonised grace period, with suitable safeguards against misuse and to preserve legal certainty, is to be welcomed. The IP Federation is supporting efforts in Europe and internationally to achieve that goal. There may therefore be ways forward. One is that any application of the CPTPP grace period to the UK would be suspended pending global harmonisation of the grace period. This would not only address the risk posed to the UK's EPC membership, it would also pave the way for a truly effective international grace period regime which properly meets the needs of business.

UK–Australia FTA

This bilateral agreement, UK's first one negotiated from scratch since leaving the EU, was signed on 16 December 2021.

UK–New Zealand FTA

This bilateral agreement, UK's second one negotiated from scratch since leaving the EU, was signed on 28 February 2022.

Signing both of these agreements (Australia, New Zealand) furthers the UK's objective of joining the CPTPP. The IP provisions in both agreements (as signed) are compatible with the EPC. This is a specific area in which IP Federation provided strong support to the Government. Both of these agreements are going through the Parliamentary scrutiny process in their respective countries, so neither agreement is yet in force. We are monitoring progress.

UK–India FTA negotiations

Five rounds of negotiation have been completed at the time of writing. The UK and India together had originally committed to complete the majority of negotiations by Diwali-time this year (24 October 2022). This “deadline” has however passed. It remains to be seen how these negotiations progress, particularly bearing in mind the latest political developments.

What is clear to the IP Federation is that IP outcomes in India are not as favourable as in other major countries. For example, our businesses typically experience real challenges in securing patents in India and enforcing the rights there. The various real business IP-related challenges in India erode the value of UK innovations and the investment the UK government is making to focus on growing the UK as a global innovation hub. The UK–India FTA therefore provides a golden opportunity to deal with these challenges, to the mutual benefit of UK and India businesses. At the outset, the IP Federation has advocated for a strong, balanced and comprehensive IP Chapter in the FTA. At a minimum, we ask that the UK Government secure a trade agreement that commits the parties to work together to help India improve its IP regime.. Realistically, we accept that this work will take time, recognising fully its strategic importance to both countries (India, UK being the fifth and sixth largest economies in the world).

The UK remains on track in completing its CPTPP accession objective by the end of this year, and has entered the final phase.

Continued

UK–GCC FTA negotiations

Round 1 of negotiations has been completed, to date. Detailed substantive negotiations (round 2) are expected to follow, soon. In its submissions, the IP Federation requests, inter alia, the UK Government to press vigorously for immediate reinstatement of the central GCC Patent Office system in place prior to January 2021; and in future for any changes to the system to be notified to business and properly consulted upon. More generally, we encourage the Government to have the ambition of exporting the UK's world-class IP system to the GCC.

Other

It is obviously not possible to comment here on the full scale of UK trade negotiations currently being undertaken, or the IP Federation's efforts to influence them. This is partly because of the breadth of the waterfront, but also because some of the IP Federation's close engagement with Government is subject to NDA. We continue to monitor closely the landscape, including implementation of relevant trade agreements, such as the UK–EU trade and cooperation agreement.

We continue to follow the developments in regard to Canada and Mexico (amongst others). Through the CBI, we continue to advocate that substantial benefits with these trading partners can be delivered from using IP in the trade context, without relinquishing critical aspects of the UK's existing and highly rated IP framework including its existing Treaty obligations. In the field of criminal sanctions for trade secret misuse, we continue to urge the Government to consult us if they are minded in negotiations with Canada and Mexico to adopt stronger criminal sanctions than those that currently exist in the UK.

CLOSING REMARKS

Having a world class IP ecosystem and improving IP frameworks in other countries to provide improved foreign market access to UK innovators and exporters will be central to the UK's efforts to build a global Britain and shape a competitive, dynamic, and modern economy on the world stage. There are a number of complementary routes to achieving this goal, of which UK accession to the CPTPP is one. In pursuing its trade objectives (which the IP Federation continue to support strongly), the UK Government should be seeking a win-win outcome which delivers substantial benefits without relinquishing key aspects of the UK's existing and highly rated IP framework, including its existing treaty obligations such as under the EPC and the Strasbourg Convention.

It is therefore critical that the UK Government is resolute in negotiating acceptable IP provisions in its CPTPP/FTA negotiations with its partners across the world. Failure to do so would lead to very serious consequences and undermine the Government's aspirations to make the UK a science and technology superpower and global innovation hub.

Dr Bobby Mukherjee,

Chair of IP Federation Trade Working Group



Build a global Britain and shape a competitive, dynamic, and modern economy on the world stage

Privilege on intellectual property law advice and patent attorneys and levelling up?

INTRODUCTION AND WHO GETS LEGAL ADVICE PRIVILEGE

In common law jurisdictions legal advice privilege is generally afforded to communications between a lawyer and their client. In the UK the right to legal professional privilege is a general rule of our common law that communications between a lawyer and their client should be privileged from disclosure. The underlying principle is that legal advice privilege is in the public interest and a person should be able to make full and free disclosures to their legal advisors, even where such disclosures could be adverse to their interests were they made to a third party.

There have been notable attempts to extend legal advice privilege beyond communications with lawyers. For example, the accountancy profession sought to have it extended to communications relating to tax advice, an area of law where clearly they are well qualified to advise. That proposition was, in the end, rejected by the Supreme Court in 2010 by a majority of five justices to two, in the *Prudential case*¹. Despite there being sympathy (not just from the dissenting justices), the Supreme Court made it clear that legal professional privilege only extends to communications with members of the legal profession and it can only be extended by statute. Lord Neuberger, while finding against extending privilege beyond lawyers, clearly thought the position made little sense and commented:

“Why, as a matter of pure logic, that privilege should be restricted to communications with legal advisers who happen to be qualified lawyers, as opposed to communications with other professional people with a qualification or experience which enables them to give expert legal advice in a particular field.”

So, we are left with the very clear position that legal advice privilege may only be extended beyond the legal profession by way of statute. Despite, the sympathy of the Supreme Court the position for accountants remains unchanged. Of course, patent and trade mark attorneys already enjoy extended rights to legal advice privilege for certain communications, via Section 280 of the Copyright Designs and Patents Act (“CDPA”) 1988 and Section 87 of the Trade Marks Act (“TMA”) 1994. However, the scope of advice that may be protected is arguably subject to some limitations.

HARMONISING THE POSITION ON PRIVILEGE IN IP AND THE GROUP B+ DRAFT AGREEMENT

The position of privilege afforded to patent attorneys and trade mark attorneys is mixed internationally. There has been discussion for many years on whether there should be efforts to internationally harmonise the privilege afforded to legal advice communications concerning intellectual property and extending to cover communications between patent and trade mark attorneys and their clients. The position is complicated by the fact rules differ across jurisdictions and privilege in the main only has relevance in jurisdictions where there is an obligation of Discovery (Disclosure) in litigation. It is in this context that the IP Federation has been monitoring with close attention the progress of the draft multi-lateral “*Agreement on Cross-Border Aspects of Client-Patent Attorney Privilege*” prepared by the Group B+. This draft agreement itself has undergone a number of iterations over the years and the current draft betrays what is clearly a heavily negotiated document and this does not help it with clarity. Despite virtuous ambitions stated in its recitals, to cover all aspects of intellectual property, it is now only focussed on patent law and a loosely defined category of



“*patent advisors*”. The UK itself has only observer status in relation to the negotiation of this agreement and is not currently a proposed signatory.

In the context of the work IP Federation has been undertaking in relation to considering the draft Group B+ agreement, it has given rise for us to take a step back and consider the current status of patent and trade mark attorney privilege and whether it is fit for purpose in the modern age. We intend to continue this review work in the year ahead and the extent to which, if any, the statutory provisions provided under the CDPA 1988 and TMA 1994 would benefit from any changes to reflect the modern working practices of the profession. That work is currently ongoing, and we will share further updates in due course.

Continued

¹ R (Prudential plc and another) v Special Commissioner of Income Tax and another [2013] UKSC 1



In the meantime, we have surveyed the current position of legal advice privilege in the UK as it applies to intellectual property law and patent attorney communications and summarise below. While this is focussed upon patent attorney privilege and related advice much applies equally to trade mark attorneys.

A RECAP ON PRIVILEGE IN THE UK ON PATENT LAW ADVICE

We will primarily address the issue of legal advice privilege as it applies to communications relating to patent legal advice. We do not focus on litigation privilege, which has broader application, though a summary of its provisions in relation to patent attorneys is provided below for completeness.

We will primarily address the issue of legal advice privilege as it applies to communications relating to patent legal advice.

LEGAL ADVICE PRIVILEGE:

Legal advice privilege applies to confidential communications between a lawyer and a client made for the dominant purpose of giving or receiving legal advice.

The Courts do not consider patent attorneys to be lawyers for this purpose but statute does extend some legal advice privilege to communications between European Patent Attorneys and their clients when they are advising on protection of inventions (Section 280 CDPA 1988). Statute provides that such privilege does not extend beyond what would be provided for lawyer communications.

Notably legal advice privilege is extended to all lawyers. When considering who is a lawyer the Courts do not distinguish between domestic and foreign lawyers. Thus foreign lawyers are treated in the same way as UK lawyers. There is also no distinction made between in-house and external lawyers. Incidentally, US patent attorneys are given legal advice privilege because they are considered to be lawyers. US patent agents are not considered to be lawyers.

We will below consider more closely how legal advice privilege is extended to UK patent attorneys and European Patent Attorneys.

LITIGATION PRIVILEGE:

Litigation privilege applies to communications between a client / lawyer and a third party, created for the dominant purpose of litigation in progress or in reasonable contemplation.

For both types of privilege the dominant purpose is critical. However, litigation privilege, as it can cover communications with third parties, has the potential to protect wider categories of documents / communications than legal advice privilege.

The statutory provisions of litigation privilege as it applies to patent attorneys and trade mark attorneys are governed by the Legal Services Act (“LSA”) 2007 and the Rights to Conduct Litigation and Rights of Audience and Other Reserved Legal Activities Certification Rules (the “Certification Rules”) 2012. Section 190 of the LSA 2007 applies to an “authorised person” providing litigation services in relation to the conduct of litigation and to an “authorised person” providing advocacy services in relation to the exercise of rights of audience. It holds that *“Any communication, document, material or information relating to the provision of the services in question is privileged from disclosure in like manner as if P had at all material times been acting as P’s client’s solicitor”*, where “P” is a person who is not a barrister or solicitor.

WHICH PATENT ATTORNEYS CAN BENEFIT FROM LITIGATION PRIVILEGE?

Because Section 190 of the LSA 2007 affords privilege to communications, documents, materials or information relating to the provision of services by an authorised person, it is important when determining the extent of privilege to understand the level of authorisation (if any) of the patent attorney to provide the services in question.

Continued

The LSA 2007 specifies that authorisation is granted by the relevant “approved regulator”². The Chartered Institute of Patent Attorneys (“CIPA”) is listed as an approved regulator in relation to the activities of the exercise of a right of audience and the conduct of litigation under Part 1 of Schedule 4 of the LSA 2007. The right of a patent attorney to conduct litigation and their rights of audience exercisable as an authorised person are dependent on the level of Litigation Certificate and/or Advocacy Certificate (in general, “**Certificate**”) held by the patent attorney as specified in the Certification Rules 2012. The responsibility for managing the certification has been delegated by CIPA to the Patent Regulation Board (see Section 1.2 of the Certification Rules 2012).

Section 2.1 of the Certification Rules 2012 specifies that Certificates can only be granted to UK-registered patent attorneys. Thus, only UK-registered patent attorneys can be “authorised persons” under Section 190 of the LSA 2007. A firm, or body, of patent attorneys can also be authorised provided the relevant activities are conducted under the supervision of a person authorised to carry out those activities (Section 10 of the Certification Rules 2012). There are similar provisions for UK Trade Mark attorneys.

WHAT ABOUT IN-HOUSE PATENT ATTORNEYS?

Litigation privilege would look to extend to in-house patent attorneys too.

Firstly, there is nothing in the LSA 2007 or the Certification Rules 2012 that prohibits an in-house patent attorney from being an authorised person.

Secondly, Section 190(2) of the LSA 2007 affords privilege as if the authorised person “*had at all material times been acting as [the] client’s solicitor*”. The English courts have recognised that Legal Professional privilege (encompassing legal advice privilege and litigation privilege)

applies equally to communications between in-house lawyers and their employers as it does between a lawyer and their client, provided their communications were in the capacity of legal advisers³.

Based on these points it’s reasonable to conclude that litigation privilege would be afforded to communications from an in-house patent attorney provided that: i) they are an authorised person under Section 190 LSA 2007 and Section 2.1 of Certification Rules 2012; ii) the communication was given in their capacity as a patent attorney providing litigation and/or advocacy services. The position will be similar for UK Trade Mark Attorneys.

Under the common law, communications with patent attorneys are not privileged

A CLOSER LOOK AT HOW PRIVILEGE IS APPLIED IN THE UK RELATING TO PATENT ATTORNEY COMMUNICATIONS

The relevant basis for privilege in patent attorney communications is s. 280 of the CDPA 1988. The definition of patent attorney is limited to patent attorneys on the CIPA register or on the “European list”, which is the EPO’s list of professional representatives.

So, it will not cover for example a Canadian patent attorney or Australian patent attorney. Incidentally, both Canada and Australia have legislation similar to s. 280 but additionally this expressly provides for the privilege afforded to national patent attorney communications to be extended to foreign patent attorney communications (in Canada such communications would have to attract privilege in that

foreign jurisdiction). Thus, in Australia and Canada, UK patent attorney communications would potentially be privileged but the same is not true in the UK in relation to Australian / Canadian patent attorney communications.

There are two aspects to consider: i) the types of materials to which privilege applies under the schemes (e.g. communications, documents etc.); and ii) the content of those materials to which privilege applies.

Regarding i), the CDPA is clear that privilege applies to “communications” as well as “documents, materials or information” relating to the relevant content.

Regarding ii), the CDPA limits privilege to matters relating to “protection of any invention”, but also to “design, technical information or trade mark, or as to any matter involving passing off”.

As said and in relation to patents, the CDPA limits privilege to matters relating to “protection of any invention”. It is unclear how broadly the term “protection of any invention” would be construed and we are not aware of specific judicial guidance from the English courts. We are of the view the term should be construed to cover inventions belonging to third parties as well as those of the patent attorney’s own client (thus extending privilege to communications relating to, e.g. infringement opinions and freedom- to-operate opinions), though in Canada the term has been interpreted narrowly by the Courts to exclude infringement advice of a third-party patent⁴.

There are also – perhaps more difficult – questions as to whether it would cover communications relating to licences and assignments. [Also section 87 of the Trade Marks Act 1994 (“TMA”) provides for privilege to UK Trade Mark Attorneys and trade mark attorneys on the EU IPO list for communications in respect of the protection of any design or trade mark, any passing off matters].

Continued

² Section 18(1), LSA 2007

³ Alfred Crompton Amusement Machines Ltd. v Customs and Excise Commissioners (No. 2), Court of Appeal, [1972] 2 Q.B. 102

⁴ Janssen Inc. and Mitsubishi Tanabe Pharma Corporation v Sandoz Canada Inc., 2021 FC 1265

PRIVILEGE AND FOREIGN LAWYERS

There is a line of English case law, from *Lawrence v Campbell* (1859) 3 WLUK 24, *Re Duncan*, deceased [1968] P 306, and most recently in *RBS (Rights Issue Litigation)*, *Re* [2016] EWHC 3161 (Ch), confirming that communications involving a foreign lawyer that fall within the scope either of advice or litigation privilege, as those concepts are applied under English law, will be protected, irrespective of how a foreign court would treat them. This is because the English courts assess whether privilege applies under English law.

PRIVILEGE AND FOREIGN PATENT ATTORNEYS

It is clear that, under the common law, communications with patent attorneys are not privileged⁵. Indeed, it is clear, having been confirmed in the Supreme Court⁶, that common law privilege does not extend to communications with any professional who is not a lawyer, with client communications with patent attorneys only receiving privilege through statutory extension under the CDPA 1988 and LSA 2007. The CDPA 1988 and LSA 2007 are themselves explicit that privilege only extends to client communications with UK and European patent attorneys.

The question of whether privilege extends to client communications with foreign patent attorneys does not look to have been considered by the English courts. However, the position seems to be clear that the UK would not extend the protection. The Australian Courts, before statute there gave recognition to foreign patent attorney privilege, ruled that privilege would not be extended to communications with foreign patent attorneys.

AUSTRALIA

The Federal Court of Australia held in *Eli Lilly & Co v Pfizer Ireland Pharmaceuticals (No. 2)* [2004] FCA 850 that under the Australian-equivalent statutory provision for patent agents, s. 200(2) Patent Act 1990, the statutory privilege is confined to communications with patent attorneys registered as such in Australia. In that case, the judge said: “The language of s. 200(2) is clear. The privilege is confined to communications with patent attorneys registered as such in Australia. Further, there is no apparent policy reason why Parliament is to be taken to have intended the privilege to extend to communications with any patent attorney anywhere in the world. The requirements for registration in Australia set out in s. 198(4) includes residence in Australia, qualification as prescribed by regulations (which would presumably stipulate knowledge of relevant Australian law and practice), employment for a prescribed period and good fame, integrity and character. The drafters must be taken to have had such persons in mind when they used the expression “registered patent attorney”.

CANADA

The Federal Court of Canada in *Lilly Icos LLC v Pfizer Ireland Pharmaceuticals*, 2006 FC 1465 refused to acknowledge privilege for communications with foreign patent attorneys, even if such communications were privileged in their home jurisdiction. At the time of this decision, Canadian patent agents had no privilege rights (either statutory or common law).

There are, therefore, two decisions from common law jurisdictions in which foreign patent attorney privilege was explicitly not recognised. It is also perhaps noteworthy that since then, Canada (2016), Australia (2013) and New Zealand (2007) have provided statutory extensions to afford privilege to client communications with foreign patent attorneys.

US CONSIDERATIONS

In the US, a ‘choice of law’ analysis is often used. This involves identifying whether the communication involves US or foreign law. US law typically applies to communications concerning ‘legal proceedings in the United States’ or ‘advice regarding American law,’ whereas foreign privilege law typically governs communications relating to ‘foreign legal proceedings or foreign law. For patents, communications relating to the prosecution of foreign patent applications or legal advice on substantive foreign patent law typically are governed by the law of the foreign country in which the patent application is filed⁷. It is then determined whether the foreign law recognises privilege that protects foreign patent agent-client communications. If it does, those communications will be privileged⁸. If it does not, those communications will not be privileged. It, therefore, seems that a form of comity is applied in the US. However, experience is that differing views on how privilege will apply varies state by state.

In the US, a ‘choice of law’ analysis is often used.

⁵ *Wilden Pump Engineering Co v Fufeld* [1985] F.S.R. 159, CA

⁶ *R. (on the application of Prudential Plc) v Special Commissioner of Income Tax*, [2013] UKSC 1

⁷ *Golden Trade*, 143 F.R.D. at 520–521

⁸ *Foseco Intern. Ltd. v Fireline, Inc.*, 546 F. Supp. 22, 25

FINAL THOUGHTS

Communications with UK patent attorneys are not granted privilege under the common law, and the Supreme Court was clear in *Prudential* that privilege under common law does not extend to communications in connection with advice given by professionals other than lawyers. The wording of the statutory extensions under the CDPA 1988 and LSA 2007, explicitly limit the extension of privilege to communications with UK and EP patent attorneys. It is reasonable to suppose a court, faced with these facts, would conclude that the statutory extensions are indeed limited to non-foreign patent attorneys.

It is acknowledged that a limited form of privilege can exist in the US. However, in the *RBS* case (mentioned above), the judge stated that, even though their working assumption was that US law would have afforded legal advice privilege for the documents in question in that case, English law was the applicable law and under English law those documents were not protected (see paragraph 196 of that judgment). In other words, there is a judgment where the English courts have applied English law even though it is more restrictive than the foreign law. The judge in that case also stated that the use of English law to assess applicability of privilege was not “hostile to comity”⁹.

We would suggest that in the light of the above the subject of legal advice privilege and how it relates to intellectual property is an area worthy of continued consideration as to whether further statutory protection is required at home and harmonisation required internationally.

Huw Evans and Arnie Francis, Gowling WLG LLP

There is a judgment where the English courts have applied English law even though it is more restrictive than the foreign law.



⁹ RBS (Rights Issue Litigation), [2016] EWHC 3161 (Ch), §174(3)

Without a broad text and data mining exception, the UK cannot succeed in its ambition to be an AI superpower

(or even keep up with the rest of the world)

In June of 2022, the UK Government responded to the AI and IP consultation (“Consultation”) and announced plans to implement a broad text and data mining (TDM) exception, including for commercial purposes. The response also assured that “rights holders will still have safeguards to protect their content”.

This announcement came after a lengthy and thorough engagement process via the AI and IP call for views (“Call for views”) and the subsequent Consultation. No one can accuse the government of not giving this issue careful consideration.

The announcement was welcomed by the IP Federation’s members. The benefits of a text and data mining exception in the UK are clearly apparent to industry. It enables our companies to conduct better scientific research, it enables us to partner with researchers using information technology to obtain new insights and develop novel concepts from large collections of data and text. Regrettably, early this year, the IP Minister announced that the decision to implement a broad text and data mining exception was incorrect and instead of implementing the exception the UK Government will continue to consult in this area.

While some forms of analyses carried out with TDM technology could be performed by a human, the scale at which TDM can analyse documents, images and other digital data means that we are able to unlock new insights that would otherwise be prohibitively time consuming and labour intensive. TDM has applications in many sectors including healthcare, sustainable energy management and supply chain management – all urgent issues which we cannot delay addressing given the notable benefits and value-add to UK citizens.

Importantly, a copyright exception for text and data mining does not create a carte blanche for entities to infringe copyright. It simply means that the step of copying a document within an AI system to merely perform text and data mining should not be prevented by copyright. Any resulting output of a process involving text and data mining would still be subject to copyright law. This was confirmed by the UK government itself in its Call for views.

The European Union has already recognised the urgent need to allow TDM in its legislation. Also, other countries around the world including Japan, the US, Canada,

China and Singapore, several of the UK’s key trading partners, have adopted broad mandatory exceptions to their copyright laws to remove barriers to text and data mining. Compare the UK Government’s hesitancy with the action of the Ministry of Justice in Israel, that around the same time issued an opinion clarifying that existing copyright law permitted text and data mining, in order to further support AI innovation in Israel, one of many countries that have removed barriers to text and data mining. Against this worldwide context, the UK’s legislation and policy with regards to TDM may influence investment decisions and attraction of talent, causing an impact on its economy – the IP Federation’s global membership urges the UK government not to take this issue lightly, given that the UK is already behind several other jurisdictions on these matters. We are at a time of huge opportunity – with massive computing power, sophisticated algorithms and big data, we have the potential to find new innovative solutions to society’s biggest challenges. The UK cannot afford to delay in implementing a text and data mining exception.

Sonia Cooper, Immediate Past President

Evolving the UK designs framework

The past couple of years saw a great deal of activity concerning the planned revision of the EU designs system and the adjustment of design rights in the UK and the EU to the UK's departure from the EU. The focus in 2022 has shifted to exploration of opportunities to improve the domestic UK design system.

Early in the year, the UK IPO published a call for views on the current designs framework in the UK. The call for views covered both registered and unregistered rights, as well as the impact of new technologies and enforcement. The IP Federation submitted a written response and has continued to engage with the UK IPO as it moves to the next phase of consultation.

One of the most important issues that was raised in the call for views was the possibility of extending criminal sanctions to unregistered designs. The IP Federation is strongly opposed to such an extension. The IP Federation recognises that there is a place for criminal law in IP infringement where there is a clear public interest in criminality being punished, for example, where infringement involves deception of the public and/or fraud (such as in counterfeiting). The current law in regard to trade mark infringement or copyright infringement or both, deals with this adequately already. The fundamental problem with extending such measures to unregistered designs is that third parties cannot know with certainty whether any particular design is or has ever been subject to protection. This, coupled with the fact that the term is uncertain and that a legitimate right to use the design in question may exist, makes criminal sanctions wholly inappropriate. If criminal sanctions are introduced, the effect of this will be that businesses will err on the side of caution and refrain from bringing legitimate products to the market.



This will stifle innovation in the UK and reduce legitimate choice for UK consumers.

Other issues relating to unregistered designs covered by the call for views included simplification of the current regime, overlap with copyright and disclosure requirements for qualification.

Regarding potential simplification, the IP Federation expressed the view that, whilst generally being in favour of international harmonisation and simplification of IP laws, the UK has a world-leading IP system, and so harmonisation at the expense of eroding that would not be in the interest of UK industry and should be considered carefully.

Regarding the potential overlap with copyright, the IP Federation considers that, as far as possible, there should be a demarcation between patents, designs and copyright.

In particular, the IP Federation's view is that technical subject matter should be the sole purview of patent protection. Registered design legislation and supplementary unregistered design legislation both include exceptions for technical subject matter. Such safeguards are not necessarily explicit in copyright legislation, and recent evolution of EU copyright law through decisions by the CJEU in cases such as *Cofemel* (C-683/17) and *Brompton Bicycle* (C-833/18) have led to questions over whether subject matter that was intended to be protected by unregistered designs would necessarily already be protected by the much longer-lasting copyright. The UK now has the chance to make a clear break from these worrying developments by legislating to exclude technical subject matter from copyright protection, which would provide those UK industries developing new technologies with greater certainty.

Continued

Turning to the issue of disclosure requirements to qualify for unregistered design protection, the IP Federation observed that these are presently complicated in that they vary between the different rights. In the digital age the concept of “first disclosure” in a given territory has little practical meaning or effect. Public disclosures anywhere in the world rapidly become available to the relevant circles in the UK. Therefore, removal of the requirement for disclosures to be within the UK, or at least clarification of the effect of simultaneous disclosure in multiple territories including the UK, would provide much-welcomed certainty for UK businesses.

The issues touched upon in the call for views in relation to registered designs included assessment of options for examination and opposition. The IP Federation recognises the harm to legitimate business and innovation that can be caused by attempted enforcement of registrations that are clearly invalid. On the other hand, the IP Federation also recognises the benefits of a simple, fast and low-cost registration procedure for fostering increased use of registered designs and the consequent benefits to innovation. Therefore, the IP Federation supports the introduction of a two-tier registration system where the current registration system is maintained but examination is required prior to enforcement. Similarly, the IP Federation is in favour of an opposition period following publication but only where this could be achieved in a fast and low-cost manner. The primary aim would be to remove clearly invalid registrations and especially those that seek to take advantage of a pre-existing design.

The UK Government has now responded to the call for views. We were pleased to see that many of the issues raised will be subject to a public consultation.

Outside of the UK, whilst (at the time of writing) the anticipated draft legislation from the Commission regarding proposed changes to EU design law has yet to materialise, other initiatives have begun to advance. In particular, the annual meeting of the World Intellectual Property Organization General Assemblies agreed to move forward with a Design Law Treaty. A diplomatic conference for the adoption of the Treaty is expected before the end of 2024.

The coming few years look likely to see significant changes in both the domestic and international designs frameworks, and the IP Federation looks forward to continuing to represent the views of UK industry on all fronts.



The coming few years look likely to see significant changes in both the domestic and international designs frameworks.

Danny Keenan,
Vice-President and Copyright & Design Committee Chair

IP Federation Trade Mark Committee

2022 was a year of revival and settling down. As we emerged from remote working brought about by the Covid pandemic, the new realities of work away from the office and the resulting benefits and challenges became clearer. The end of 2022 rear-view mirror was useful.

The almost immediate transition to remote working and complete cessation of travel from February 2020 throughout 2021 proved that our IP and broader service teams were nimble. In-house and external legal teams pivoted almost seamlessly to an online digital world. Teleconferencing and video calls catapulted previously camera-shy individuals to new ways of working and interaction. Trade mark offices and some courts turbocharged their digitalisation and remote functionalities. Were it not for the Covid pandemic surely these developments would have taken longer. Trade mark processes and litigation continued largely electronically and successfully.

On balance and perhaps surprisingly the wheels did not fall off. Some efficiencies were actually gained, and broader inclusivity grew as all employees and team members became universally remote and the in-person chat and social networks that can narrow universal opportunities were practically more difficult to facilitate. For global teams with overseas headquarters, where once regional offices were historically “remote or satellite offices” the opportunity for all team members wherever located to demonstrate their abilities grew. The ease of “I’ll pop along the corridor to chat with ...” was replaced by a more level playing field of remote interaction. There was also a real opportunity to understand more about the humans we worked and interacted with.

As we reconvened back in the office during 2022 and for broader in-person continuing professional education (CPE) events and social engagements, we felt an appreciation for social interaction particularly as we reflected on what was lacking during 2020/21. Yet there is still cause to recall the value created by the opportunity to focus without office banter and distraction. We all gained real time back in our working days as we avoided daily commute times and for most a better work balance. It seems a hybrid of remote and office work balance is settling in generally and neither full time return to the office or full remote working are post pandemic realities. How far and deep remote working flexibility will eventually settle may yet be determined by HR departments and leaders who face the challenges of recruitment and retention hurdles in order to compete for the best available talent on the market. The pandemic showed us that responsiveness, flexibility and agility are keys to success and a fixation with past practices less so.

The opportunity is to continue to allow time for feedback, reflection on the positives and recognition and elimination of non-value aspects of the day to day.

IP Federation has continued to create a helpful conduit for discussion.

For the work on our desks in 2022 the reality and impact of Brexit on brand owners trade mark activity were beginning to be felt. Global portfolio owners considered the value of UK national marks, the impact of proof of use requirements and duplication of tasks and costs arising from Brexit. While external advisors grappled with their team’s rights of representation in the EU and address for service questions in the UK, the impact of on-going pending EU cases and the breadth of new filing programmes consumed time in-house.

The IP Federation has continued to create a helpful conduit for discussion of these topics among IP owners and advisors enabling business and industry input and feedback to key stakeholders and policy makers.

For the duration of the pandemic there was a shift to the online and virtual world and infringing activity shifted too. Phishing attacks rose and so did online infringement. The pandemic saw brand owners tackling producers of branded counterfeit face masks who seized on opportunities to cash in.



While 2022 saw a return to some traditional infringement patterns – online infringement volume continued. Bricks and mortar counterfeit investigation activity continued to be impacted during 2022 as China remained largely locked down. With on-line dominance in our every day to day lives it is no surprise that the Metaverse and NFTs were key topics for 2022 trade mark webinars and headline subjects at the first in-person meeting of the International Trademark Association (INTA) since 2019.

After an historic peak of global 2021 trade mark applications, in 2022 trade mark offices saw a reduction in applications but for brand owners there did not feel much respite from the usual volume of oppositions generally and class 9 and 25 applications continued to weigh down the watch notice in-tray.

With online dominance in our every day to day lives it is no surprise that the Metaverse and NFTs were key topics for 2022.

Business uncertainties still prevailed in 2022 and while there were cautious steps towards gradual opening up, supply chain constriction and the turmoil brought about by the Russia– Ukraine conflict tempered hopes of a strong bounce back. Businesses generally continued to carefully prioritise the most important work with an eye on cost management.

From a trade mark perspective brand owners examined their Russian IP assets and registrations. Could trade mark acquisition, maintenance and enforcement legally continue, while respecting the legal sanctions and company policies? If it could continue, should it continue? Brand owners followed the fate of Peppa Pig in Russia with interest.

Bad faith as a general topic in light of recent cases also occupied agenda time as brand owners absorbed decisions and examined their portfolios for clarity, precision and scope of use and looked more closely at new filings to avoid potential claims of evergreening.

The National Security and Investment Act 2021

The National Security and Investment Act 2021 (“NSI Act”) came fully into force on 4 January 2022, setting up a new regime for UK government scrutiny of acquisitions and investments. The NSI Act applies retrospectively to transactions from 12 November 2020.

The NSI Act is intended to modernise UK Government’s powers to investigate and intervene in investments, mergers and acquisitions and other deals to protect national security as a foreign-direct investment (FDI) regime, while applying to UK and non-UK acquirers alike. It replaces the national security element of the Enterprise Act 2002. The regime is a hybrid mandatory and voluntary notification regime, supported by call-in powers on national security grounds.

There are currently 17 relevant sectors of activity.

The first order under the NSI Act blocking an IP licence was issued in July 2022, preventing the licensing by a Chinese company from the University of Manchester of know-how relating to vision sensing technology.

Although this is so far the only order made to prevent the acquisition of an asset, it has already proven a cause for serious concern in IP licensing because of the implications the decision holds for the range of IP licences that may be affected by the NSI Act. Following this decision, a much wider range of IP licensing activity than was previously thought to be affected should be reviewed for possible notification under the NSI Act.

A proposed transaction triggers the application of the NSI Act if it involves the acquisition of a specified level of control over certain qualifying entities or qualifying assets in certain relevant sectors.

There are currently 17 relevant sectors of activity (prescribed by statutory instrument). The sectors having perhaps the greatest impact are probably energy, communications, and computing hardware; the remaining sectors cover a wide range of other activities (advanced materials; cryptographic authentication; suppliers to emergency services; advanced robotics; data infrastructure; artificial intelligence; defence; civil nuclear; synthetic

biology; military and dual use; quantum technologies; critical suppliers to the government; satellite and space technology; transport).

“Trigger events” are broadly defined: for instance acquiring 25%, 50% and 75% of votes or shares in a qualifying entity, or acquiring a right in or in relation to a qualifying asset. Qualifying entities include UK companies and foreign companies that supply goods or services to persons in the UK. Qualifying assets include land (not limited to land in the UK), moveable property, and “ideas, information or techniques which have industrial, commercial or other economic value” such as trade secrets, source code, plans, drawings, and software.

Notification under the NSI Act is mandatory before certain triggering events, and is the acquirer’s obligation. At present, this does not extend to asset acquisitions (but could be so extended by statutory instrument), consistent with the comparatively high level of awareness of compulsory notification within M&A practitioners and the comparatively low level of awareness elsewhere including in licensing.

Continued

If a mandatory notification is required, the transaction must be approved by the Secretary of State (“SoS”) before completion. Failing to comply with this requirement renders the transaction void, and exposes the acquirer to significant criminal and civil penalties (up to the greater of 5% of worldwide turnover or £10m).

For non-triggering events, voluntary notification is available where the transaction may raise national security concerns. This is important because of the government’s “call-in” powers, under which the SoS can call in transactions for review on national security grounds, for up to five years after completion (or without time limit, following default in mandatory notification). A voluntary notification may be made to obtain a clearance protecting against call-in. It is interesting to note that the University of Manchester case, outlined above, appears to have arisen following a voluntary notification.

By avoiding any restrictive definitions, the NSI Act provides the government with a very flexible range of responses to the complex and changing threats to national security. The flip side is that a lack of definitions leaves businesses exposed to wide-ranging uncertainty over a range of different investments as national and international politics and economics change. The uncertainty is also affected by the government’s indication that it will keep the scope of mandatorily notifiable transactions under review, and possibly narrow or broaden it.

Decisions on notifications are taken by a new operational unit: the Investment Security Unit (ISU). The government’s impact assessment accompanying the NSI Bill on its first publication estimated 1,000 to 1,830 notifications annually. This expectation was in line with real experience at least over the first three months of the Act’s operation (figures for that period being reported in the first Annual Report on the NSI Act, published in June 2022).

According to the first Annual Report, notifications were, on average, either accepted within 3 days or rejected within 5 days (slightly longer for voluntary notifications). Once a notification is accepted, the SoS decision on clearance has to be made within 30 days. Transactions that are not cleared within that period are called in for a full national security assessment, requiring a case-by-case review of the entity or asset involved, the identity of the acquirer, and the type and extent of control.

Where a call-in notice is issued, the SoS must determine whether to impose remedies or clear the transaction, within an initial assessment period of 30 working days, extensible by another 45 working days (and by any other period by

By avoiding any restrictive definitions, the NSI Act provides the government with a very flexible range of responses to the complex and changing threats to national security.

agreement with the acquirer). Taken together with the initial screening period, this can mean up to 105 working days from notification to clearance. Any SoS requests for information, and the periods for response to them, may extend the process.

The NSI Act’s impact assessment estimated that 70 to 95 cases would be called in annually, and the first Annual Report is in line with that (17 transactions having been called in during the quarter-year reporting period).

The impact assessment also estimated that around ten transactions will be subject to remedies each year. In reality, this appears to be a substantial underestimate, with the real rate being nearly double the estimate.

The SoS is required to keep final orders under review, which provides a route for parties to address concerns and ask for the order to be varied or revoked.

The SoS is required to publish notices about final orders, and may publish notices about notifications and clearances. The possible effects of Freedom of Information requests should also be considered. It will therefore be prudent to consider how information is presented and to be clear what is confidential, and why.

Note that while judicial review is available in relation to the NSI Act decisions, the NSI Act imposes a highly accelerated timetable: a request for JR must be filed within 28 days instead of the usual 3 months.

In relation to its impact on IP licensing, the NSI Act clearly has implications for licensing where any element of know-how is involved. That may include for instance the right often found in patent licences that enables the licensor to call for licensing back of any improvements to the licensed technology made by the licensee. Consequently consideration of the NSI Act should now form a standard part of IP licensing practice; businesses and their commercial partners (including universities) should have processes for identifying transactions requiring NSI review, including a broad range of IP commercialisation such as licensing or monetisation, including consideration of the counterparty identity, the level of control over IP, and how the IP is connected with the 17 sensitive sector activities.

Continued

Given the uncertainties over the scope of the NSI Act, and the potentially severe downside risk, it is likely that there will be a growing number of precautionary notifications of IP licences, at least until NSI Act practice becomes more established or UK government advice gives firm reassurances on circumstances where notification is not required. It is hoped that NSI Act guidelines will become clearer and more constrained, with a clearer picture emerging of when notifications are not needed.

One specific issue is whether notification can be required on the licensing or disposal of pure patent rights. While it is arguably not necessary to notify such transactions, there remains room for doubt. The relevant definition in the Act refers to “ideas, information or techniques which have industrial, commercial or other economic value” and provides a list of various items (“trade secrets, databases, source code, algorithms, formulae, designs, plans, drawings and specifications, software”). That list does not expressly include “patents” and – at least to an IP lawyer – it appears to be a list of things that are different in kind to patent rights (i.e., not statutory rights to control identified and publicly-disclosed technology). However, the NSI Act provides the government with great flexibility in applying and broadening the legislation, and it may be prudent not to rely on legal niceties of IP law to conclude that patent licences are necessarily outside the scope of the Act.

It is worth putting the NSI Act in the international context, and in particular by contrast with the much longer-established “CFIUS” regime operating in the US (the name deriving from the responsible interagency US government Committee on Foreign Investment in the United States). While CFIUS has a long pedigree (celebrating 50 years of operation in 2025), its jurisdiction was substantially expanded in 2018 and saw a corresponding large jump in the examined transactions; the total number of filings reviewed in 2021 was around 400, leading to around 130 notifications.

Given the relative size and positioning of the UK and US economies, this may indicate that the current regime in the UK is imposing proportionally greater requirements on industry than its established US counterpart.

Dr Justin Watts, Partner,
WilmerHale LLP

Dr Bobby Mukherjee,
Chair of IP Federation Trade Working Group



IP Federation biographies 2022–2023



MATTHEW HITCHING, PRESIDENT

Matthew has been working for 30 years as a UK Chartered Patent Attorney and European patent attorney. For the first half of his career he was in private practice in central London, working in the fields of telecoms, data processing and microelectronics. Matthew's clients at that time included many Japanese companies, and it was this, and a hope of educating himself about the broader aspects of managing IP in a company, that led him to join Canon at its European headquarters just outside London in 2007. Matthew has represented Canon at the IP Federation since 2018.

Since joining Canon, Matthew has been involved in oppositions, appeals, and patent litigation in the major European countries, as well as US patent litigation, which is increasingly affecting Canon's group companies in Europe. His IP work also includes aspects of brand management, competition law, anti-counterfeit activities, standardisation activities and contractual IP issues.

Married with two children, Matthew's passions outside work are watching football, his ever-expanding collection of wines, and travel, especially to vineyard areas or Japan.



SONIA COOPER, IMMEDIATE PAST PRESIDENT

Sonia is a UK Chartered Patent Attorney and European patent attorney with over 20 years of practical experience in all aspects of intellectual property, gained both in private practice and in industry. Sonia specialises in the fields of software, artificial intelligence and telecommunications and has a degree in physics from the University of Bristol, a master's degree in the management of intellectual property from Queen Mary University of London and a graduate diploma in law from the University of Law.

Sonia is an assistant general counsel in Microsoft's intellectual property group and leads IP policy globally for the open innovation team, working closely with Microsoft Research in Cambridge. She has represented Microsoft on the Council of the IP Federation since 2017 and chairs the IP Federation data & copyright committee.

Outside work, Sonia enjoys spending time with family, friends as well as hiking and camping with her Labrador, "Sunny".

She was President of the IP Federation from 2021 to 2022.



DANNY KEENAN, VICE-PRESIDENT

Danny is a European patent attorney with almost 20 years of practical experience with managing patents, designs, trade secrets and technology-related agreements. Danny joined Unilever in the UK after completing a DPhil in physical chemistry and worked for seven years as a research scientist and technical project leader before moving to the IP department. Danny has worked on IP across all of Unilever's business groups, including personal care, nutrition and ice cream, and helped build the Unilever patent group in China.

Danny heads Unilever's global nutrition patent team, leads the technology agreements group and is responsible for the patent group at Unilever's UK R&D sites. He has represented Unilever on the IP Federation since 2016 and chairs the IP Federation copyright & design committee.

With a grown-up family, Danny now has increased time to devote to other passions outside work including watching lower and non-league football, travelling, learning languages and volunteering with a local charity.

**DAVID ENGLAND, COMPANY SECRETARY**

David joined the IP Federation as Secretary in June 2010. He is a UK and European Patent Attorney with 25 years of experience gained at Reckitt & Colman, Astra Pharmaceuticals and BTG International. During his career, he has worked extensively on the creation, defence and licensing of intellectual property (mainly patents, but also designs and trade marks), and has represented his employers on both the Patents and Designs Committees of the IP Federation.

In his spare time, David sings with the highly regarded BBC Symphony Chorus, performing regularly at venues including the Barbican and the Royal Albert Hall.

**HELEN GEORGHIOU, OFFICE MANAGER**

Helen joined the IP Federation as Admin Assistant in November 2016. This was a completely new sector for her, as she had spent over 20 years as a PA and office manager in market research companies. She then followed her personal passion and entered the world of property, where she now runs the family business. Some could say that in many respects intellectual property and physical property have similarities when it comes to ownership and rights, so joining the IP Federation made perfect sense. It has proven to be a rewarding environment.

With two daughters, a husband and a dog, there's not much time left! But where possible, Helen enjoys interior designing, socialising... and the odd vodka or two!

IP Federation Members 2022

The IP Federation represents the views of UK industry in both IPR policy and practice matters within the UK, Europe and internationally. Its membership comprises the innovative and influential companies listed here.

The CBI, although not a member, is represented on the Federation council, and the council is supported by a number of leading law firms which attend its meetings as observers. It is listed on the joint Transparency Register of the European Parliament and the Commission with identity No. 83549331760-12.

From 20 May 2022 our new registered office address has been:
2nd Floor, Halton House, 20-23 Holborn, London, EC1N 2JD

Telephone: +44 20 7242 3923.
Email: admin@ipfederation.com
Website: www.ipfederation.com

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