

IP

IP Federation

REVIEW

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Improving the intellectual property
framework to meet the needs of
innovative industry for a century



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.

AIMS

The IP Federation's aim is to bring about improvements in the protection afforded by intellectual property rights throughout the world, to the advantage of inventors, manufacturers and consumers alike. 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.

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 2021 on the inside back cover of this publication.

President's Introduction

It is a pleasure and honour to introduce this edition of the IP Federation's annual review. In a departure from tradition, I feel compelled this year not to reflect on the work we have done, but to address the work ahead.

More than ever, society is aware of the challenges humankind is facing. The pandemic and the urgent action needed to address climate change have required us all to consider what, collectively, we can do to overcome these challenges. The private sector's role in addressing them is crucial. It requires collaboration and a new paradigm of thinking.

As we consider how the intellectual property system can help address these issues, we need to consider the many ways that we innovate. An IP system that is balanced enables the spectrum of collaboration that is necessary to drive innovation at scale and across communities, embracing diversity in thinking. And it is a spectrum. There is a broad misconception that the IP system exists to solely allow rightsholders to exclude others. However, the IP system functions at its best when we understand that intellectual property rights are a means to promoting innovation and not an end in themselves. Open source provides us with a clear example of how being open can lead to exponential benefits, allowing organisations

to achieve more than they can alone, at speed. Open source can be misunderstood as being somehow "anti IP". However, open source heavily relies on IP rights to enable collaboration. While some activities thrive on open source, industry also requires the ability to compete, differentiate and recover costs on R&D. The rapid development of vaccines has demonstrated the importance of IP rights in

An IP system that is balanced enables the spectrum of collaboration that is necessary to drive innovation at scale and across communities, embracing diversity in thinking.

supporting the research and development in response to the pandemic. The landscape is nuanced, and industry relies on the right tools to allow for both open collaboration and closed development.

Where rights are balanced, the assessment of *fair* becomes important. There are a number of issues, some of which will be the subject of government consultations, that the IP Federation will consider in the year ahead where the assessment of *fair* will be relevant. As we come together

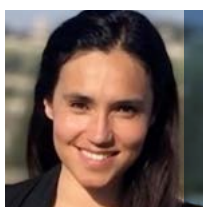
to review these consultations, I personally think it is useful to look at comparable systems that have worked. For example, as we think of how to manage the proliferation of standard-essential patent licences required for applications relating to the Internet of Things, many of which will play a part in our green recovery, can we learn from approaches to copyright licensing? We will

be discussing this and more as our cross-sector membership comes together to provide thoughtful analysis on how the IP system supports the private sector in enabling the UK to become a global hub for innovation and science and technology superpower.

How do we create an environment where we drive innovation in this way? Industry works best when it can innovate by using the IP system as a tool that enables sharing, collaboration and competition. This can be

achieved where exceptions are crafted within our IP framework and where businesses have the flexibility to navigate how best to use these tools. The private sector will best address these issues in an environment that allows business values to be aligned with societal values, by identifying that a greener approach does equate to a healthier bottom line and by working with a functional and balanced IP framework to enable essential innovation that is both open and closed.

As ever, our efforts in the future will be built on the foundations laid in the past, and I cannot end this introduction without acknowledging the work of the IP Federation. Since I have been involved in the Federation, I have been continuously impressed at the scope and quality of discussions and work of this group. I am excited to build on the great work of the past year to address the challenges ahead. I am also humbled by the supportive and collaborative nature of our Council meetings as we discuss issues through these challenging times. I would like to express my deep gratitude to all members, but particularly to Scott Roberts Immediate Past President, whose unwavering passion for IP is contagious, and to our incoming Vice-President Matthew Hitching, whose thoughtful perspectives I hugely appreciate. Finally, thank you to our secretariat of two, David England and Helen Georghiou who make all things IP Federation possible.



Sonia Cooper
President

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IP Federation Biographies

The article entitled 'Stepping up to the Plate' in the *IP Federation Review 2020* was written by Ruth Barcock, Policy Advisor to the IP Federation, with input from Gordon Harris, partner at Gowling WLG. The article entitled 'Celebrating our 100th birthday ... by fighting COVID-19 and improving social mobility' was written by Annsley Merelle Ward and first appeared in a slightly longer form on the renowned IPKat blog.

A week in the life (of an in-house patent attorney)

With apologies to Samuel Pepys and Helen Fielding, the extract below is fictional and intended to capture the variety and challenge of life working as part of an in-house IP department.

MONDAY

Early start today – I’m meeting with a project team to discuss their latest developments. We filed a priority patent application last year and are now reviewing recently generated data to determine claim scope before foreign filing. We spend a fascinating couple of hours digging into the results and technology, it’s a highly competitive area so I think there may be filings from third parties, we need to be careful to maintain priority and I draw some timelines for the project team to try to explain why that matters. The project team also has some creative thoughts around names for the technology.

Spend the afternoon drafting my new claim set and sending to the project team as well as setting up a call for next week between them and our trade mark attorney to discuss the naming. I start thinking about a presentation I’m doing for the tech department next week on “IP basics”, this morning’s discussion really helped set out where there may be gaps in understanding the nuances of patent law and why it’s relevant to their work.

Unusually for a Monday I’m out this evening at a local IP networking event. We don’t have as many events as London based firms, so it’s important to make local connections wherever possible. We often get in external speakers who are specialist in a particular area of law to help upskill our internal attorneys and this is a great way to meet them.

TUESDAY

I bump into Bob in the coffee queue – he’s super excited about a presentation he’s giving later this week. He looks a bit sheepish when I ask if he’s cleared it with a patent attorney – I promise to look at it today if he sends to me asap. Spend the rest of the morning reviewing the slide deck and prepping a quick draft to put on file before Thursday. Speak to Bob about scope and we discuss what he can (and can’t!) say in the Q&A section. He’s travelling to the conference tomorrow, so we agree to meet up next week to review the work in more detail and file a follow up priority case and discuss terms for a watching search.

Departmental meeting this afternoon on case law developments in our area – great discussion on how a recent UK court of appeal judgement could impact the way we prosecute our cases. We discuss data that we could ask the scientists to generate to help. My boss is going to talk to the head of R&D about adding extra arms to some of their standard experiments – the additional results will really add support to our claims. We have a great relationship with the technical side of the company, it’s important to understand the business direction and objectives when developing IP strategy.

This works both ways too – we spend time educating our senior leaders about IP and why it’s relevant.



WEDNESDAY

A prosecution day today! One of my key cases recently entered national phase and it's handled externally so I've got office action draft responses from outside counsel to review for about ten different countries. It's interesting to see how similar law can be applied so differently between for example China, India, Brazil and Europe. I have an overall strategy for the case but need to really tailor my claims for local requirements, making sure I don't lose sight of the critical scope we need in each country. Luckily our outside counsel uses local agents who are super knowledgeable and there's also a lot of experience in various jurisdictions within the department that I can draw on.

THURSDAY

I have an opposition hearing in a month or so where I am leading the advocacy and I get in to find that we just received some auxiliary requests from the patentee. Spend the morning working through the file and my notes with my opposition buddy, thinking about the amendments and how we can address them.

The project team also has some creative thoughts around names for the technology.

Then this afternoon we both sat down with our internal technical expert to talk about how the amendments (if granted) could be relevant the work that we want to do on a key product. Had to remind her that it's a first instance hearing so we're some time away from a final result, but we're hopeful we'll be successful.

(Note to self – remember to contact communications ahead of time to prepare a Q&A in case the media picks up on the hearing.)

FRIDAY

Catch up day today – the corporate and departmental things have been building up a little. I take a couple of compulsory learning modules on “conflicts of interest” and “bribery and corruption” then I review progress against my performance and development objectives as next week is my monthly check in with my manager.

It's also my turn to present at the case-law meeting next week so I take a tour through the IP blogs and the recent CIPA journal for interesting cases. Finally, I review my watches for third party publications and grants relevant to the projects I support – spot one that I mark for a potential opposition and set up a discussion with that project team next week.

Off to the pub!

Susan Chiappinelli
GlaxoSmithKline plc



Diversity and Inclusion progress

...and IP Federation activities in 2021.

The Question of improving diversity and inclusion in the UK's IP profession remains a key commitment of this organisation. Last year we planted a flag committing the IP Federation to do more in this area, and now we are making good on that commitment.

Last year in The IP Federation Review we pointed to the dangers of the Covid-19 pandemic worsening accessibility to the IP profession and having an adverse impact on the number of available jobs. The likelihood was that this would particularly affect black, Asian and ethnic minority people who were suffering more from the impact of the pandemic and who are disproportionately over-represented in the poorer communities.

School closures and classroom restrictions have had a very serious impact on the education of a generation of children, but especially those from under-privileged areas where additional support, which has been available to the better off, has been sadly lacking. This means that in the coming years more is going to have to be done to ensure that the huge talent pool which exists in under-privileged communities is not lost to industry and the IP world.

As one of its founding members, the IP Federation has a longstanding association with IP Inclusive – the organisation created by Andrea Brewster to promote the cause of diversity and inclusion

in the IP professions. In 2021, members of the IP Inclusive Management Board (IPIM), including the IP Federation, agreed to a reconstitution of IPIM with individual rather than organisational members in order to give IP Inclusive greater autonomy to achieve its objectives. However, this change does not mean that the link between the IP Federation and IP Inclusive is now any less strong. The IP Federation continues to be a critical friend and to provide related support to IP Inclusive.

The IP Federation has now also created an internal working group dedicated to the furtherance of diversity and inclusion initiatives amongst its members. The working group, chaired by Gordon Harris (IPIM and Gowling WLG), also comprises IP Federation President, Sonia Cooper, Vikki Townsend (Rolls-Royce), Ruth Wright (BT), Julie Browne (Shell), Julie Dunnett (policy advisor, IPIM and formerly GKN), and Suzanne Oliver (policy advisor and formerly Arm). Several of the working group's first members are either individual members of the reconstituted IPIM



or the advisory board that has recently been created. The connection between the organisations therefore remains at the heart of the IP Federation's work in this area. Employees of IP Federation members are also involved in various IP Inclusive committees.

The working group members who are active in IP Inclusive are going to be working towards creating a version of the IP Inclusive's Charter that underpins its activities and which allows IP Federation members to be able to sign up with confidence.

A key object in getting IP Federation members signed up to the IP Inclusive Charter, as well as encouraging strong diversity policies within our member companies, is to enable them to use their leverage with professional firms that they instruct to drive diversity and inclusion metrics across the whole of the IP profession. As instructors of IP professionals – patent attorneys, solicitors or barristers – IP Federation members are in a strong position to require positive diversity and inclusion policies in the firms they instruct and to require sight of key metrics to assess performance. The working group will develop this proposal and possible methods of implementation through the year.

One of the projects run by IP Inclusive is called "Careers in Ideas" (<https://careersinideas.org.uk/>). The objective of Careers in Ideas is to use mentoring and encouragement to open up the possibilities for careers in IP to people at all stages of their educational development, from school-children to post-graduate students. The IP Federation is a keen supporter of the work of the Careers in Ideas initiative through provision of funding for specific projects and IP Federation members also being involved in the Careers in Ideas task force.

There will be continued discussions between the two organisations about how IP professionals from within the membership of the IP Federation can continue to be involved in Careers in Ideas and provide an insight into the in-house IP role in industry.

There is no such thing as "too early" when it comes to raising awareness of IP as a career path. In2scienceUK (<https://in2scienceuk.org/>) is an outreach organisation that aims to provide young people from low-income and disadvantaged backgrounds with an opportunity to gain practical insight into the STEM sector as well as the knowledge and confidence to progress to university. This year, the IP Federation has supported the excellent work of In2scienceUK not only through sponsorship of a number of students participating in the In2scienceUK STEM programme, but also by IP Federation members conducting a workshop on Intellectual Property and careers in IP called "Intellectual Property, what's that got to do with me?" as part of In2scienceUK's summer workshop program.

Our working group will continue to explore what additional opportunities there may be for involvement with social mobility and STEM outreach bodies in the future.

Of course, giving presentations and mentoring requires resources – it makes no sense to reinvent the wheel every time someone has an opportunity to present. We are looking at formal resource sharing arrangements with IP Inclusive to help create a bank of slides, props and other materials to support anyone getting involved in projects to encourage young people into the IP professions.

...diversity continued

When she was our President, Suzanne Oliver set out a series of objectives which the IP Federation wants to take forward, and this will be the task of the working group. It is worth restating those objectives (in an abbreviated form) here:

1. Improve the image that we project to people
2. Reach new people and places, widening the range of educational and training establishments we engage with, including targeting students before they make career-limiting choices.
3. Recruit more fairly, both on advertising/ outreach and objective decision making.
4. Address financial barriers to entry and progression – finding ways to offer financial support.
5. Explore bold systemic changes to entry requirements, for example apprenticeship.
6. Collect data to help targeting outreach work.
7. Work together as a sector, including with government agencies, to make the measures we take more effective.
8. Work with outreach charities and organisations to enable us to reach the right people.

Those are inspiring goals, and it will be the objective of the D&I working group to use them as a guide for its work in this vitally important area.

Gordon Harris
Gowling WLG (UK) LLP



The IP Federation's activities and campaigns

The IP Federation has invested considerable time and resource in 2021 in support of its aim of improving the intellectual property (IP) framework to meet the needs of innovative industry. Here are some of our key successes

1. The IP Federation has engaged and continues to engage effectively with senior levels of Government on the seeking the best possible future free trade agreements (FTAs). A key concern has been the potential impact on the UK's continued participation in the non-EU European Patent Convention (EPC). A document (agreement in principle) was published reflecting what the UK and Australian negotiating teams jointly decided as of 16 June 2021 should be included in the agreement once it is finalised. This confirmed that there is no commitment to introduce a UK grace period or patent term adjustment in the UK–Australia FTA.
2. On 22 June 2021, the Government announced that it recognises the importance and value of the UK's participation in the EPC and that it has no intention of leaving the EPC. It also indicated that this has not changed with the decision to accede to the Comprehensive and Progressive Agreement for Trans-Pacific Partnership (CPTPP). In CPTPP accession negotiations, the Government will ensure that the UK upholds its existing international obligations, including those of the EPC to which the UK is already party.
3. 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, UPC and supplementary protection certificates (SPCs).
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 BusinessEurope's Patents Working Group on behalf of the CBI, with whom we have a close working relationship.

One of the IP Federation's chief lobbying tools is its policy papers. These are all available on the website at: www.ipfederation.com

The policy papers on the website represent the views of the innovative and influential companies that are members of the IP Federation. Members are consulted on their views and opinions and encouraged to debate and explore issues of policy, law and practice. Only after consensus is achieved are policy papers settled and published.

The policy papers are sent as appropriate to key individuals and organisations, including Government Ministers and departments and judges.

...our activities continued

They may also be submitted to the:

European Patent Office (EPO) and its Standing Advisory Committee before the European Patent Office (SACEPO)

European Union Intellectual Property Office (EUIPO)

World Intellectual Property Organization (WIPO)

UK Intellectual Property Office (IPO), including the Patent Practice Working Group (PPWG)

European Commission

BusinessEurope

POLICY PAPERS 2021

Policy papers submitted in late 2020 and 2021 are as follows:

PP 6/20 IP Federation position statement on the Unified Patent Court

- IP Federation position statement on the Unified Patent Court (UPC)

PP 1/21 Review of EU Design Legislation – Inception Impact Assessment -

IP Federation feedback on Intellectual property – review of EU rules on industrial design (Design Directive)

PP 2/21 Consultation on EPC and PCT-EPO Guidelines - IP Federation submission

on the Guidelines for Examination in the European Patent Office, March 2021 edition: Part F, Chapter IV – Claims (Art. 84 and formal requirements)

PP 4/21 Amicus Curiae Brief on Enlarged Board of Appeal case G 1/21 - Amicus

curiae brief on Enlarged Board of Appeal case G 1/21 (European Patent Application 04758381.0) – Oral proceedings by video conference

IP FEDERATION AND IN2SCIENCEUK PARTNERSHIP LAUNCH

In January 2021, we launched our 2021 partnership with In2scienceUK providing six young people from disadvantaged backgrounds with a placement in the virtual learning programme into different STEM fields, kick-starting their high tech career.

In2scienceUK's mission is to improve social mobility and diversity in science, technology, engineering and mathematics (STEM). They will work with over 700 young people from disadvantaged backgrounds in 2021, and we want to help them to expand since more than 2,000 young people apply to In2scienceUK each year.

Check out their amazing work at

<https://in2scienceuk.org/>

IP FEDERATION PRESIDENT'S RECEPTION 9 JULY 2021

Sonia Cooper was elected as the new President of the IP Federation at our AGM on 9 July 2021. We were hoping to commemorate the handover by Scott Roberts, Immediate Past President, at an IP Federation Centenary President's Reception but, as with last year, the Covid-19 pandemic meant that the whole event had to be done as an on-line meeting.

ARCHIVE OF THE IP FEDERATION

The Bodleian Libraries in Oxford completed the cataloguing of the IP Federation Archive in July 2021, and the catalogue is now online.

The navigation box on the right shows the sections into which the archive is arranged and each section can be expanded down to individual boxes. The IP Federation's support the cataloguing project, and the Bodleian Libraries are also most grateful to Mike Jewess for all his work on the archive, and for compiling an index which formed the basis of the catalogue. The collection inventory comprises:

General papers, 1920–2012

General meetings, 1920–1990

Federation Council, 1920–1989 and 2010

Federation Council: Minutes, 1920–1989 and 2010

Federation Council: Documents, 1942–1989

Patents Committee, 1923–1989

Merchandise/Trade Marks Committee, 1913–1989

Licensing and Competition Law Committee, 1975–1989

Copyright and Designs Committee, 1987

Monthly Reports, 1952–1989 and 2020

Federation publications, 1943–2017

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

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

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. Over the last year, we have once again increased the number of people who follow us on Twitter and 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 2021

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.

MISSION

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 IP-intensive companies 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

1. To drive the best possible outcome for UK IP-rich businesses by:
 - a. *ensuring that industry's views on IP are understood by the UK government and other actors, including the UK's Chief Trade Negotiation Advisor, and taken into account during the negotiation of free trade agreements (FTAs);*
 - b. *engaging with government ministers and senior officials, in particular the IP Minister working alongside officials, especially the IPO, in their efforts to secure IP positions which support industry; and*
 - c. *reviewing new or proposed international agreements and other initiatives, including trade agreements to promote a beneficial impact on the global IP framework.*
2. To promote diversity, inclusion and social mobility in the field of IP by:
 - a. *supporting the IP Inclusive Initiative;*
 - b. *promoting the adoption of diversity and inclusion (D&I) policies in all member organisations; and*
 - c. *continuing to directly support a social mobility charity.*
3. To drive improvement of the global patent system by active participation in substantive patent law harmonisation work in the UK and in IP5, by:
 - a. *continuing to provide a policy advisor to support the work of the IP5 B+ and associated working groups.*



4. To build and maintain influential relationships with key organisations by:
 - a. agreeing and implementing a strategy for engaging with European Union (EU) bodies, representatives of the EU Commission and EU Parliament;
 - b. attending the regular “Four Presidents” meetings and extending an invitation to the IPO CEO and senior colleagues to attend Council meetings annually;
 - c. making persuasive representations in the Patent Practice Working Group (PPWG) and the Marks and Designs Forum (MDF), and at topic-specific IPO meetings such as on substantive patent law harmonisation (SPLH);
 - d. engaging directly with the EPO President and the President of the EPO Boards of Appeal as well enhancing existing relationships with other EPO staff and through the Standing Advisory Council of the European Patent Office (SACEPO).
5. To shape IP policy, law and practice which support innovative industry by providing persuasive and timely briefings and submissions which are authoritative and of a high quality.
6. To enhance synergies with other IP stakeholders by:
 - a. holding regular consultation/alignment meetings with the Confederation of British Industry (CBI), and representing CBI at BusinessEurope IP working groups; and
 - b. continuing close engagement with CIPA, CITMA and other stakeholders as appropriate; and
 - c. building, deploying and managing a communications strategy to bring focus and cohesion to the outward-facing engagement of the Federation.
7. To broaden the breadth and influence of the IP Federation by promoting membership of the Federation and its committees.
8. The Governance Committee to:
 - a. submit an annual report to the Council;
 - b. prepare succession plans for President, Vice President and Governance Committee members;
 - c. write internal policies to be agreed by the Council as required; and
 - d. ensure the Articles of Association are compatible with the evolving needs of the IP Federation including the need to meet, collaborate and make decisions remotely.

IP Federation archive made available to the public

Readers may be interested in a brief account by the same author of the Federation's first 100 years, which they can find in the December 2020 issue of IP Federation Review under the title "Snippets from the archives".

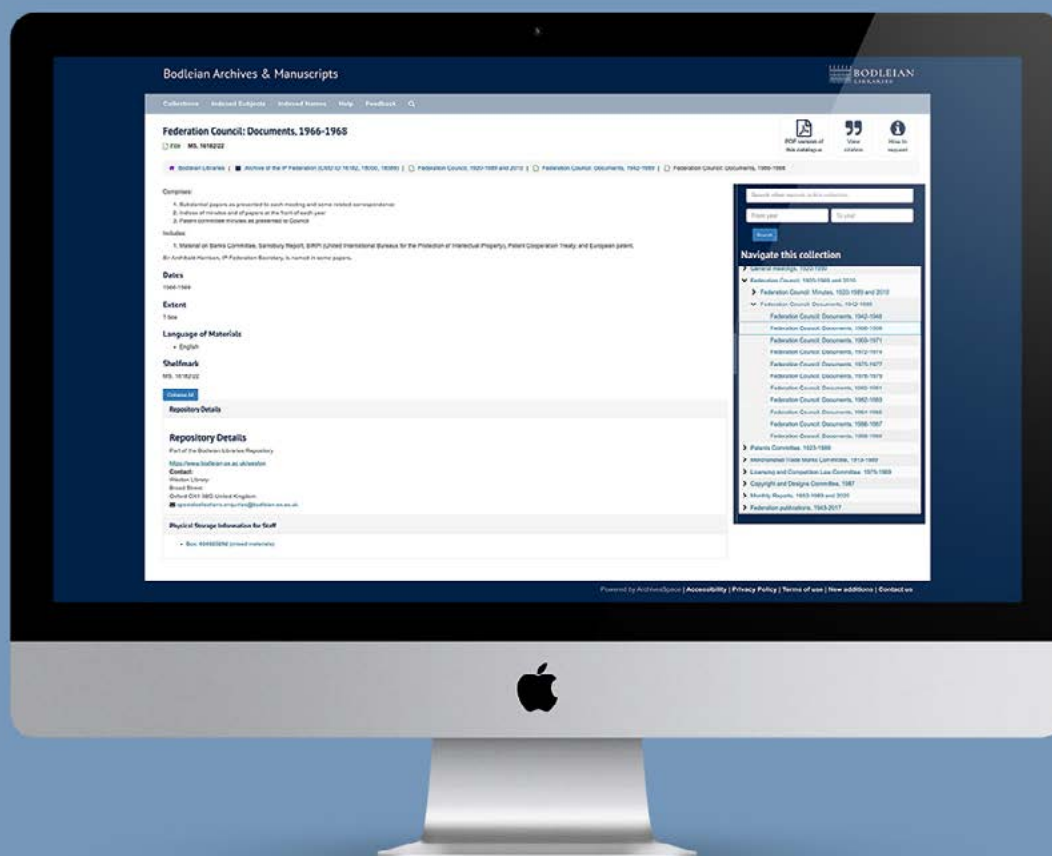
Legal scholars, business historians, and others now have access to a wealth of previously unavailable material showing how business reacted to and lobbied on IP law from 1920 to 1989.

Until recently, the archive of the IP Federation was stored in a warehouse in Chatham, save for a few items retained in the IP Federation office. Operating under the IP Federation's document retention and destruction policy, Council deemed the archive as suitable for donation to a scholarly library subject to a "30-year rule". As a result, since mid-2021, this material has been publicly available in the Weston Library in Oxford, which houses the "special collections" of the Bodleian, the main research library of the University. Legal scholars and business historians have access to a wealth of material from the foundation of the Federation in 1920 up to the end of 1989.

The IP Federation chose to approach Oxford University for various reasons, including because it has a longstanding Intellectual Property Rights Centre. Dev Gangjee, currently Professor of Intellectual Property Law at Oxford, supported the case for the acceptance of the archive by the Bodleian, and a senior archivist, Lucy McCann, worked with the IP Federation to organise the selection and receipt of the material. The material is sorted into 67 academic archive boxes, each approximately 7 cm deep, made of acid-free cardboard. There are boxes containing, from the early years of the Federation, wonderful well-preserved minute books with gold lettering on the spine and highly legible manuscript entries. Loose papers are grouped chronologically in acid-free cardboard folders within boxes.

Coincidentally, the activities of the Federation since the end of 1989 have been written up and published professionally through approximately annual reviews, now all on the internet at <https://www.ipfederation.com/ip-federation-review/>. The first review was published in 1990 as REVIEW of trends and events under the Federation's previous brand of "TMPDF" (standing for the contemporary legal name, "Trade Marks Patents and Designs Federation"). The present IP Federation Review is the 29th in the series. Therefore, the Oxford archive joins up chronologically with what was already publicly available, so that scholars have the opportunity of studying business's views on IP matters from the foundation of the Federation in 1920 to the present day – although in principle a further donation in due course of post-1989 material would allow them to form a more complete view.

The original Memorandum of Association of the Federation stated that its first "object" was, in IP matters, to promote the interests of "traders in the British Empire and Foreign Countries" – i.e., translated to the present day, national and international business. (It has never been the Federation's role to represent the legal professions.) To achieve this object, the Federation has always taken a highly commercially-informed policy view of IP law, a focus that makes the Oxford archive of especial interest.



The Federation Council and Committee minutes included in the archive were meticulously and informatively drafted, and supporting material was retained; so, the archive includes, for instance, official consultations and reports, correspondence with other representative organisations, and the final lobbying output of the Federation. It needs to be remembered that the archive was all created in pre-internet days, when a key service of the Federation to its members was to inform them of developments worldwide (regardless of whether these were within the scope of its lobbying). From 1952 to 1989, the Federation issued hard-copy monthly private newsletters based on material received from third parties. Not only the Federation documents in the archive but also many third-party documents will be the only copies in the public domain – or even the only copies in existence.

The user of the Oxford archive will be guided, first, by the library index <https://archives.bodleian.ox.ac.uk/repositories/2/resources/9593>. The listing of the contents of each box may merely be a general one specifying the range of dates of the material and identifying the IP issues of the time.

In some cases it identifies particularly intriguing historical items such as – in 1943, “Pamphlet ... being a detailed report by the [Federation’s] patents committee on matters arising out of wartime emergency legislation;” and ca 1970-1, “‘Paper by T[imothy] W[ade] Roberts for CIPA informals’ discussing ‘peripheral’ vs ‘central’ claiming (a key issue in the runup to the European Patent Convention ...).”

Often, the user of the archive will be greatly assisted by manual indexes assiduously created by past Federation secretaries and included in the boxes. Office computerisation began to resemble what we know today only around 1985. Therefore, manual indexing by topic was essential if the Secretary was to be able to retrieve any previous internal discussions of a particular topic, for instance when a new official consultation was started.

By making this material available, the IP Federation and the University of Oxford have, we believe, done a considerable public service.

Michael Jewess
Honorary Fellow of the Federation

The SPC Year in Review - Politics rather than Litigation

There have been no Court of Justice of the European Union (CJEU) referrals decided this year. The main activity on supplementary protection certificates (SPC) has been political with changes considered on a European Union level as part of the pharmaceutical legislation review and the much vaunted appearance of the Unified Patent Court (UPC) on the horizon at the end of the year.

On a legislative level the last changes made to the SPC Regulation were to introduce a manufacturing waiver. This manufacturing waiver properly kicks in at the beginning of July 2022 and only a handful of notifications (if that) have been made under the waiver at national patent offices. The process is fairly formalistic but initial experience is that generic manufacturers are not rushing ahead at the opportunities afforded to export European made generics. The only notification seen so far with details of an export market seeks to send product to Australia, another highly-advanced economy.

The opportunity to stockpile before European launch seems likely to prove more interesting, though limiting the location of where product can be stored to the country of manufacture will dampen use of the system. That said, generics have long

had processes in place to bring blockbuster products rapidly into major markets once exclusivities expire.

In complying with the waiver generics would do well to use the registered address for service for an SPC to ensure notification actually occurs.

The last extension of SPC rights occurred with the paediatric legislation providing the carrot of a six month extension to SPCs as a reward for completing a paediatric investigation plan.

On a legislative level the last changes made to the SPC Regulation were to introduce a manufacturing waiver.

A requirement for the reward is that there is a marketing authorisation (MA) present in all EU member states. Early beneficiaries of the extension sometimes had to scramble to achieve this when a product was authorised under the mutual recognition procedure. Now that most products receive centralised authorisations it would be rare to be in a situation where there is not an MA in an EU state.

The pharmaceutical legislation review is wide in scope in considering whether the rewards framework for orphan medicines and paediatric

medicines is achieving desired outcomes. Whether the current SPC extension requirements are sufficient is being considered. Might there, perhaps, be a requirement that a product be actively marketed in each member state to obtain the reward? It is not clear how this might be demonstrated as evidence would be needed from each member state, considerably complicating a procedure that currently relies on centrally available and applicable documentation.

By the time this column is written next year the Unified Patent Court might be in operation and the first Unitary Patents (UP) may have been granted. As a consequence the unavailability of unitary SPCs becomes acute. It is assumed that national SPCs may be obtained under a UP in the same way as under a European patent (EP) but such SPCs will fall within the inherent jurisdiction of the UPC by virtue of being based on a UP. The prosecution of those SPCs may also have varying outcomes, both as to grant and in terms of the product

description. Whilst the UPC deals with European patents, all having the same wording in the claims, it seems unsatisfactory that any SPCs that fall within their jurisdiction are very likely to have differences in their product descriptions, however slight, as a result of the individual grant of these rights by each national patent office.

European industry associations in the fields of pharmaceuticals, veterinary products and crop protection products are all in favour of setting up a virtual EU SPC office, perhaps attached to the European Patent Office (EPO), that would operate either on a Patent Cooperation Treaty (PCT) or European Patent Convention (EPC) model, and that this office could handle unitary SPC applications once appropriate legislation for them has been adopted. Under a PCT model the initial stage of national applications could be made, avoiding the wasteful duplication of supplying the same information to each national patent office. A non-binding opinion on allowability could be produced by examining divisions made up of national patent office examiners experienced in SPCs.

An application would then convert into a bundle of national applications for grant or continued prosecution. Under an EPC model the office would grant the SPC which would then turn into a bundle of national SPCs. There would need to be a route for references to the CJEU if the office has authority to grant SPCs.

This could be achieved either by a de novo appeal tribunal which can refer or a protocol on jurisdiction so that appeals from the office go to the courts of the country where the applicant is domiciled or, if that is outside the EU, to the country where the marketing authorisation holder is domiciled, since this will always be in the EU.

Under an EPC model the office would grant the SPC which would then turn into a bundle of national SPCs.

The year ahead will contain considerable advocacy opportunities in order to ensure any legislative proposals are efficient and deliver benefits both to European industry and society as a whole. SPCs have become a key incentive for pharmaceutical development and it is important to maintain and enhance their benefits to ensure new medical treatments are developed for patients.

James Horgan

Chair of the IP Federation
Unitary Patent and Unified
Patent Court working group



Patent Harmonisation Activities

There have been two main areas of activity concerning attempts to harmonise and improve the patent system in 2021: Substantive patent law harmonisation (SPLH) in conjunction with the B+ group of WIPO nations and procedural harmonisation before the IP5 group of Patent Offices.

SPLH

In my article for the IP Federation Review last year, I summarised the major points contained in the “Policy and Elements for a Possible Substantive Patent Harmonisation Package” submission (the Elements Paper) made by the Industry Trilateral (IT3, comprising American Intellectual Property Association, BusinessEurope, Intellectual Property Owners Association, and the Japan Intellectual Property Association) to the B+ group of WIPO nations (which was established to promote and facilitate progress on SPLH) in September 2020. This resulted in a number of questions from the B+ which the IT3 replied to at a meeting in May 2021. In addition, the B+ had requested the IT3 to produce a set of objective criteria to assist in clarifying the scope of prior user rights and the IT3 has done significant work on this in 2021. Finally, the IT3 agreed that the B+ Patent Offices should be free to publish the Elements Paper to aid in consultation and discussion on this important topic even though there are still items yet to be agreed upon by the IT3.

The questions from the B+ on the Elements Paper covered the major topics contained within it: grace period, conflicting applications and prior user rights (PUR). The major concerns were with the complexity of the paper and whether the Elements Paper provides sufficient safeguards to prevent the proposed system becoming a “first to publish system” (one of the stated objectives of the proposals put forward is that the new system should not become a first to publish one). The IT3 will consider the feedback from the B+ on these two issues further.

The objective criteria are intended to assist in determining the scope of prior user rights once these have accrued and to provide greater certainty for patent holders and third parties on these rights. The discussions include three main activities: (i) changes in the volume of the product produced from that which the third party produced when it established its prior user right, (ii) changes or modifications to the original embodiment produced by the third party and (iii) changes in the category or type of infringing act, for example importing a product rather than manufacturing it.

It is hoped that the IT3 can make progress on potential improvements to the Elements Paper and the objective criteria on the scope of PUR in the near future. The publication of the Elements Paper should also enable further feedback to be obtained from other stakeholders benefiting the process.

IP5 DISCUSSIONS ON PROCEDURAL HARMONISATION

A summary of the major points contained in the IT3 submission is provided below. It is very detailed, but that reflects the degree of effort, care and precision which the IT3 members have invested in its development over a considerable period of time.

Introduction

In February 2021 there were joint meetings of the IP5 (the Chinese, European, Japanese, Korean and US Patent Offices) with the IP5 Industry group (the IT3 plus Patent Public Advisory Committee (PPAC) and Korea Intellectual Property Association (KINPA)

concerning the Industry Consultation Group (in February), the Global Dossier Task Force (March) and a meeting with the IP5 Heads in June.

IP5 Industry Consultation Group (ICG) meeting:

Future IP5 Patent Harmonisation Expert Panel (PHEP) topics: IP5 Industry expressed its expectation for IP5 Offices to agree on electronic signature standards so that a global assignment form could be filed with electronic signatures. IP5 Industry also expressed their interest in the harmonisation of allowable features in drawings.

Measures taken by each IP5 Office that are beneficial to users: IP5 Industry representatives drew attention to specific and helpful measures implemented by individual Offices.

IP5 NET/AI Task Force: IP5 Offices provided an overview of the current status and next steps in the work of the IP5 NET/AI Task Force, highlighting that the Task Force members were currently evaluating possible project proposals from the IP5 Offices according to the Scoping Document, in order to develop an IP5 NET/AI roadmap for the endorsement by the IP5 Heads in June.

Global Dossier Task Force (GDTF) meeting:

Feedback on current Global Dossier services: IP5 Industry gave favourable feedback on their experiences with the existing Global Dossier services being provided by the IP5 Offices stressing the importance of completeness, timeliness and availability of Global Dossier.

Prioritisation of five Global Dossier tasks: IP5 Industry suggested demand-based prioritisation for the five Global Dossier tasks, indicating that XMLization and Inter-office Document Sharing are seen as two top priorities. IP5 Industry also expects progress in relation to Alerting, Legal Status and Applicant Name Standardisation but these are seen as long-term initiatives.

NET/AI Utilisation: Each IP5 Office provided an update of the AI tools used in their own procedures. IP5 Industry expressed its hope that AI tools, after being developed and applied in the IP5 Offices, would become accessible to users as well.

IP5 Heads/IP5 Industry Meeting:

The meeting was jointly chaired by JPO and JIPA.

Introductory remarks referred to a WIPO Green Event in Japan and its relevance to the Strategic Topic on the agenda.

1) Agenda Items:

- (PHEP) New Topics: It was announced by the Offices that the two topics, Global Assignment and Allowable Features in Drawings, were due to be approved at the formal closed Heads meeting the next day. KIPO and USPTO will take the lead on the Global Assignment project whilst the JPO will lead on the harmonisation of features in drawings.
- NET/AI: A Roadmap has been produced by the Offices that focuses on both legal and IT aspects (this has now been published on the IP5 website), the European Patent Office (EPO) indicated that this is the foundation for Offices to excel, Offices now have to put it into practice.

IP5 Industry reported that it is setting up its own task force to assist the Offices.

2) Strategic Topic

IP5 Cooperation in a post-pandemic era.

The IP5 Offices indicated that digitalisation transformation is key. Many Offices had introduced digital signatures during the pandemic but further work on this still needs to be done as well as introducing video interviews/hearings.

All seemed to be in agreement that there should be more study and discussion of the benefits of IP to society.

3) Next Meeting

The next IP5 Heads meeting will be organised by the EPO in collaboration with BusinessEurope in Munich the week of June 6–10th 2022. The EPO mentioned that the meeting would cover accessibility of IP system to users and generation of pro-IP culture as well as increasing IP visibility in general and how it can solve societal and economic issues.

Tony Rollins
Policy Advisor

The Unified Patent Court

In last year's IP Federation Review, it was reported that, despite 2020 being a turbulent year for the Unified Patent Court (UPC), progress appeared to have been made. This year, a much more positive statement can be made.

Progress has definitely been made, with the Preparatory Committee estimating that the UPC will start operations around mid-2022. Whilst that may be a little optimistic, next year's Review may be published as the doors of the UPC are finally opening.

Looking back, the year did not start off positively. The German Federal Constitutional Court was again faced with constitutional objections to the UPC. Two applications for preliminary injunctions were filed in December 2020 against the draft bill enabling Germany to ratify the UPC Agreement (UPCA) and the Protocol on Provisional Application (PAP-Protocol). However, in July, the Court rejected both applications stating that they were inadmissible. This was quickly followed by the German Federal President signing the ratification bill in August and, in September, Germany deposited its ratification instrument for the PAP-Protocol.

Most recently, in October, Slovenia deposited both its ratification instrument for the UPCA and the PAP-Protocol. However, despite this very considerable increase in pace, the starting gun has yet to be fired as there are two further steps that still need to be completed. Firstly, consent to the PAP-Protocol of just one more participating Member State is required before the start of the provisional application period (PAP), the final phase of the UPC's set-up, can begin. Austria might be that one country, since it submitted a draft law for the ratification of the PAP-Protocol in July. The second step is for Germany to deposit its ratification instrument for the UPCA.

One of the big undecided points is which, if any, city will replace London as the site of the central division seat dealing with chemistry and pharmaceutical cases. The Council of Ministers in Italy has officially proposed Milan, but there is no done-deal as yet, and cities in the Netherlands are also being discussed as possible candidates.

This year, a much more positive statement can be made.

So, when might the UPC open its doors? The Preparatory Committee has said that it might take from six to ten months to conclude all the work that needs to be done during the PAP, including recruitment of the judges. But, once the participating Member States are confident that the UPC can start in an orderly manner, Germany will deposit its instrument of ratification and the grand opening will take place on the first day of the fourth month following such deposit.

As noted already, the Preparatory Committee has stated that the UPC could start operations around mid-2022. Even if this slips a bit to the end of next year, companies should be shaking the dust from their plans of four years ago and reminding themselves what they should be doing to prepare.



Three of the key areas that companies should be considering are as follows:

1. Opt-outs of existing European patents (EPs), supplementary protection certificates (SPCs) and EP applications

Unless these rights are opted out of the system, both the UPC and the national courts of the Member States have jurisdiction over them. Opting out means that the UPC no longer does so and consequently a central invalidity attack cannot be launched before the UPC. However, it also means that an infringement action cannot then be brought before the UPC seeking an injunction covering all participating Member States (unless, that is, the opt-out is withdrawn).

In 2017, a three-month sunrise period was being planned to allow companies to file their opt-out requests ahead of time. If the same period is allowed and the plan remains that the UPC opens in mid-2022, opt-outs could be filed as early as the end of Q1 2022. Opt-out requests will be filed through the UPC case management system which requires getting used to the system and putting in place the necessary mandates. More than that, however, an opt-out is only valid when it is performed by all the actual proprietors of the EPs and all holders of

existing SPCs, not the proprietors according to the register, nor exclusive licensees. So not only will owners and licensees have to consider which EPs and SPCs to opt-out, if any, but work may also need to be done to identify the rights holder or, if different designations of the EP are owned by more than one person, the rights holders.

2. Opt-ins for EP applications

A request has to be made for unitary effect before a bundle of national EPs is effectively turned into a Unitary Patent (UP). Such request can only be made where there is a granted EP and it has to be filed one month after the date of publication of the mention of grant in the European Patent Bulletin. However, the European Patent Office was, in 2017, preparing its own sunrise period to allow patent applicants to file applications for unitary effect ahead of time so that they had the opportunity to designate their EPs as UPs as the UPCA came into effect. If the same system is proposed, patent applicants should consider which of their applications are nearing grant and whether they want them granted as EPs or UPs.

The Preparatory Committee has stated that the UPC could start operations around mid-2022.

... Unified Patent Court continued

3. Licences

The UPCA provides that an exclusive licensee can bring an action before the Court under the same circumstances as the proprietor, provided that the proprietor is given prior notice and the licence agreement does not expressly preclude such action. However, the patent proprietor must be joined in any action where validity is contested. This rule applies to both UPs and EPs from the date the UPCA comes into effect.

It would therefore be wise to review existing licence agreements and to bear in mind this provision for future licences.

In practice, the UPC's IT system and the way in which users are able to interact with it will be crucial. So far this has had only limited visibility, but the IP Federation is reaching out to those developing the software to ensure that users' interests are taken into account as the systems are finalised.

Of course, with the UK not participating in the Unitary Patent system, it is inevitably devalued. The UK is a large economy and its absence will have a huge impact both for rights-holders and third parties. Despite this, the fact that we are about to see this project at last coming to fruition is very exciting.

Katharine Stephens
Partner, Bird & Bird LLP





The IP Federation working with the EPO in 2021

Over the last 12 months the European Patent Office (EPO) has accelerated its digital transformation consistent with its Strategic Plan 2023.

It is fair to say that the EPO is now a primarily digital workspace at every level of the organisation. This increased digitalisation has presented new opportunities for engagement, collaboration and communication without the obstacle of geography. The IP Federation has embraced this opportunity and continues to work closely with the EPO at many levels to bring the user perspective to EPO initiatives as they emerge and develop.

Changes abound at the EPO and continued advocacy for applicants and users remains the IP Federation's priority. The use of videoconferencing facilities for oral proceedings was on the agenda at the EPO this year. The Boards of Appeal issued their decision in G 1/21 in July, in which it ruled that oral proceedings before the Boards of Appeal can, during a period of general emergency impairing the parties' possibilities to attend in-person oral proceedings at the EPO premises, be held by videoconference even without the consent of the parties.

The status of mandatory oral proceedings at other procedural stages remains to be clarified. Meanwhile, the EPO announced an extension to the pilot for opposition oral proceedings by videoconference later in the year.

The EPO's ambition to process oppositions within a target period of 15 months put the topic of streamlining opposition proceedings on the agenda. Proposals for a streamlined opposition procedure were drawn up by the European Patent Institute (epi) and outlined to the Standing Advisory Committee of the EPO (SACEPO) in 2020. The proposals include strictly limiting the opportunities for written submissions by parties to discrete points in the procedure with fixed time limits (2 months in some cases). Wholesale revision of rules 79, 81 and 116 EPC are proposed, with submissions outside stipulated procedure being deemed *prima facie* inadmissible. The subject is still being considered by the EPO and SACEPO participants.

More procedural changes are imminent with the closure of the EPO's "CMS" online filing system and the introduction of a new "Online Filing 2.0" facility. A new central service for making and facilitating fee changes was announced in July, with the EPO embracing additional options for fee payment by credit card and bank transfer.

Significant case law developments this year include G 1/19 on the patentability of computer implemented simulations. The Enlarged Board concluded that simulations can solve a technical problem and that the well-established COMVIK¹ approach to assessing the technicality criteria for patentability apply. Notably, it is not decisive whether the system or process being simulated is technical. What is relevant is whether the simulation of the system or process contributes to the solution of a technical problem.



Changes abound at the EPO and continued advocacy for applicants and users remains the IP Federation's priority.

Industry and the professions are closely examining the decision to understand the implications for simulations and other computer implemented technology such as artificial intelligence.

Also issued by the Enlarged Board is the decision in G 4/19 endorsing the EPO's long-established practice for assessing double patenting. The Enlarged Board confirmed that a European patent application can be refused under Articles 97(2) and 125 EPC if it claims the same subject-matter as a European patent which has been granted to the same applicant and does not form part of the state of the art. This is

irrespective of whether the application was filed on the same date or earlier, is a divisional application, or claims the same priority date.

The IP Federation engages frequently with the EPO including directly with President Campinos, through SACEPO, and through work with BusinessEurope. Existing relationships are routinely solidified and new relationships forged to ensure the perspective of the industry is appropriately represented.

Scott Roberts
Immediate Past President
IP Federation

¹ Decision T 0641/00 (Two identities/COMVIK)

International Trade and Intellectual Property



The profound global challenges posed by the Covid-19 pandemic make successful outcomes from trade negotiations even more important.

A VISION IN SUPPORT OF THE UK GOVERNMENT'S TRADE STRATEGY

With the world on the cusp of a 4th Industrial Revolution promising emerging technologies such as Internet of Things, autonomous vehicles, quantum computing, AI and genomics, it is critical to get the IP aspects of trade deals right. In view of the speed of progress, any obstacles to innovation and IP will damage the UK's economy for decades. The profound global challenges posed by the Covid-19 pandemic make successful outcomes from trade negotiations even more important.

The IP Federation's vision is that the overarching UK strategy should actively promote trade, IP and innovation, and improve market competitiveness. The UK should aim to have an outward looking, prosperous and inclusive economy that actively promotes innovative business and sustainable jobs, and is strongly aligned with UK's ambitions to be a science superpower and innovative powerhouse on the global stage.

With the UK chairing the G7 and hosting the UN COP26 climate summit this year, there is a golden opportunity for the UK to lead on trade strategy for the global community.

IP FEDERATION TRADE WORKING GROUP (WG) AND STAKEHOLDER ENGAGEMENT

IP provisions are almost universal in trade agreements and setting standards for IP rights directly reduces trade barriers. Recognising this and the UK Government's trade strategy has meant that our Trade Working Group has been very active this year. We have been particularly active in engaging with the Department for International Trade (DIT) and UK Intellectual Property Office (UK IPO) in UK Government, formally and informally, to offer constructive ideas and comment based on our extensive knowledge of the role of the IP system in UK and overseas markets.



We continue to support the UK Government's aim of securing the best possible terms in free trade agreements (FTAs) with Australia, New Zealand, the US, Canada, and others and in acceding to the Comprehensive and Progressive Agreement for Trans-Pacific Partnership (CPTPP).

IP FEDERATION ASKS

It is essential that trade policy in general, and negotiating objectives with individual countries and regions in particular, are developed in close collaboration with industry. Corporates play a key role in supporting the growth of small innovative business and the network of our world class universities and academia. This vital contribution provided by large businesses should be recognised, celebrated and incentivised in the UK trade policy and its implementation.

The IP Federation urges the UK Government to be ambitious in exporting the UK's world class IP system in all its FTAs, recognising the crucial relationship between world-leading innovation and a system of IP rights which is robust, balanced, understood and enforceable. We welcome the Government's explicit assurances in its published strategic approaches to various FTAs (Australia, New Zealand) and in regard to accession to the CPTPP, of its intention to secure patents, trade marks and designs provisions that are consistent with the UK's existing international obligations, including continued membership of the non-EU European Patent Convention. We continue to encourage also that some issues are better dealt with in multilateral agreements than in bilateral FTAs, and we look forward to the UK taking an active role in the World Trade Organisation and the World Intellectual Property Organisation.

... *International Trade and Intellectual Property continued*

UPDATE ON TRADE AGREEMENTS

In the last (centenary) IP Federation Review 2020, we reported the successful completion of the Japan–UK free trade agreement (heavily based on the Japan–EU one) with strong IP provisions. Since then, the EU–UK Trade and Cooperation agreement has been signed on 30 December 2020, with positive IP provisions. The Government continues to progress its trade negotiations with energy with many other nations and regions including the US, Australia, New Zealand, Canada, and the CPTPP.

UK–AUSTRALIA NEGOTIATIONS

These negotiations started from scratch. An agreement in principle (AIP) was reached in June 2021. We welcome the inclusion of strong IP and innovation chapters in the AIP, and we continue to monitor closely developments as a full text is finalised. Its agreed IP provisions will likely set an important precedent for other deals.

The agreement is expected to be signed in the autumn. Thereafter, there will be Parliamentary scrutiny including under the Trade & Agriculture Committee and the Constitutional Reform and Governance Act 2010 (“CRAG”).

UK–NEW ZEALAND NEGOTIATIONS

These negotiations are apparently at an advanced stage, with an expectation that an agreement will be reached by the end of this year. We are closely monitoring developments in this regard.

UK’s application has been given the “green light”, and so, negotiations will follow.

UK’S ACCESSION TO THE CPTPP

The UK has applied to accede to the CPTPP, with an ambitious aim to reach a deal with the CPTPP member states by the end of next year (2022). UK’s application has been given the “green light”, and so, negotiations will follow. The Japan’s economy minister (Japan: Chair

of the CPTPP) announced that the first meeting for UK’s CPTPP inclusion would be held soon.

The interaction between UK–CPTPP (based on existing CPTPP text) and bilateral negotiations involving CPTPP member states covering different key areas such as intellectual property will be important.



UK-US NEGOTIATIONS

Recently, there was a comment made by the UK Prime Minister in Washington D.C. that, while the ambition for a comprehensive UK–US FTA continues to be there, the US does not currently have capacity for it.

**OTHER: FUTURE NEGOTIATIONS
(CANADA, MEXICO, INDIA)**

IP Federation has responded recently to the call for input on trade with India, detailing specific issues and relevant provisions which a prospective UK–India FTA should contain to address them.



... International Trade and Intellectual Property continued

Work is now being undertaken by the Government to develop a mandate based on stakeholder responses, by the end of November 2021.

We continue to follow the developments on Canada, Mexico (amongst others). Through CBI, we have advocated 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 have further urged the UK Government to consult us if they are minded in negotiations with Canada, Mexico to adopt stronger criminal sanctions than those that currently exist in the UK.

EXHAUSTION

A separate IP Federation working group was established to respond to the recent UK IPO consultation in this complex, important area.

FINAL REMARKS

The global trade IP world is fast changing, and we have a golden opportunity to engage and help shape it positively. That is what we are doing, and we are seeing positive results. The IP Federation looks forward to continuing to support the UK Government in achieving desired outcomes from current and future trade negotiations which will be so crucial for innovative British business, to help make the maximum contribution to the Government's ambitions as a global hub for innovation and a science and technology superpower.

Watch this space!

Dr Bobby Mukherjee

Chair of the IP Federation Trade Working Group

27 September 2021





Exhaustion — phew!

The UK's future regime for the exhaustion of intellectual property rights

It is an old joke, and a truism, in the IP community that thinking through the exhaustion of intellectual property rights (IPRs) is, well, exhausting. This is because the subject itself is so complex, the implications so far-reaching, and perspectives so diverse, that analysis and discussion can too easily descend down a metaphorical rabbit hole.

It is unsurprising, then, that considering and responding in August 2021 to the UK government's consultation on the UK's future regime for the exhaustion of IPRs took up a great deal of time, thought and energy. For new readers, who might be wondering what "exhaustion of IPRs" even means, the government's consultation document explains it in the following terms:

"The right to take legal action against infringement is constrained by a system known as exhaustion of IP rights. Once a good has been placed on the market in a specific territory by, or with the consent of, the rights holder, the IP rights that protect this good are considered to be "exhausted". This means that the right to take legal action against infringement has been lost."

Once the IPRs protecting good have been exhausted, they can legitimately be moved across territorial borders, in what is known as "parallel trade". So far, so much jargon, you might think. But the regime that any

nation implements to regulate this parallel trade can have huge impacts, positive or negative, for business and commerce of all sorts, for consumers, and for national economies as a whole. It's a big deal, which is why getting it right is so important.

The consultation document invited views on four possible exhaustion regimes. It is worth being clear that they only relate to the UK's own exhaustion regime: none of them has any impact on the regimes which the UK's trading partners choose to apply to parallel imports from the UK into their territories. Taking each in turn in the order they were presented in the consultation:

"UNILATERAL EEA OR UK+ EXHAUSTION"

This is the "do nothing" option and would maintain the current regime, which came into force on 1 January 2021. This means that parallel imports from the European Economic Area (EEA) into the UK would continue to be allowed, while parallel exports from the UK to

the EEA could be prohibited. In discussion, IP Federation members noted that the UK+ system, by maintaining the status quo, entails the least disruption for business. We also recognised that under a UK+ regime, UK consumers and businesses would retain certain benefits they had while the UK was part of the EU. For example, UK consumers could benefit from prices that are as competitive as any in Europe. And UK manufacturers could take comfort that, should they need to, they could achieve supply chain resilience by sourcing their IP-protected input materials (e.g. IP-protected components) from parallel import channels around Europe. On the other hand, it was questioned whether, given the short time since the UK left the EU, the current position can truly be regarded as a status quo. On that view, if there is divergence in IP laws between the UK and the EU, there might be problems for rights owners in the future if a UK+ system is adopted.

But one of the strengths of the IP Federation lies in its cross-sectoral membership, which can bring a wide range of perspectives; another is its ability to engage in open, evidence-based discussion, and agree constructive ways forward, even when members' views do differ..

“NATIONAL EXHAUSTION”

Under this regime, the IPRs in goods would be exhausted in the UK only if they were first put on the market in the UK. This means businesses would not be able to parallel import goods from outside the UK. IP Federation members saw how this could incentivise innovative and creative business in the UK. This is because national exhaustion is closely consistent with a strong IP system, which in turn provides the best incentive for value-adding, innovative and creative businesses, which in turn benefits consumers and the economy. This may be particularly true for “home grown” UK businesses, often SMEs, which must be permitted to protect and benefit from sales in their home market. A national exhaustion system would also enable IP rights owners to continue to ensure that only high-quality, genuine products are supplied to UK consumers. Members acknowledged, however, that any adoption of a national exhaustion regime would be subject to a potential issue under the Northern Ireland Protocol issue.

“INTERNATIONAL EXHAUSTION”

In this case, the IPRs in goods would be exhausted in the UK once they had been legitimately put on the market anywhere in the world. Although the IP Federation has historically opposed international exhaustion, in discussion it was recognised that for companies that develop complex products with component parts that are subject to IP licensing arrangements, not all of which are owned by the manufacturers of the component parts, an international exhaustion regime may greatly simplify the ability to secure a supply chain to provide goods to consumers in the UK. An alternative view was that supply chain management can be addressed through contractual arrangements, and that supply chain management should not prevail over the importance of strong IPRs for the UK. Further, there was an argument that

any limitations on international supply chains (if that arises) would have the effect of stimulating domestic supply from within the UK, which would be to the benefit of the UK economy.

It can also be argued that an international exhaustion regime would be damaging to the UK economy, in particular to UK-based businesses seeking to expand into or retain sales in foreign markets.

“MIXED REGIME”

This option would see different exhaustion regimes applied to different goods, sectors or IPRs. The IP Federation’s members generally felt this would not be a desirable approach, in view of the additional complexity it would entail.

In its response to the consultation, the IP Federation noted that, given the very different options for exhaustion being considered by the government, the outcome of the consultation is extremely important to the IP landscape in the UK, and hence to the future health and prosperity of the UK economy. The response also made clear that there was a degree of divergence of view among IP Federation members. This might have militated against making a response at all. But one of the strengths of the IP Federation lies in its cross-sectoral membership, which can bring a wide range of perspectives; another is its ability to engage in open, evidence-based discussion, and agree constructive ways forward, even when members' views do differ. We also hope that by making a response, we will have helped the UK government make proposals which take better account of the needs of innovative British industry. And of course the IP Federation looks forward to commenting on those proposals in due course.

Sean Dennehey
Consultant to the IP Federation

The Data Opportunity

The increasing ability of computers to learn, identify complex patterns and empower humans to make better decisions creates a huge social and economic opportunity.

Organisations are using artificial intelligence (AI) to become more efficient and to tackle previously insurmountable problems like climate change and disease. The AI revolution will have an impact across the whole of society, with AI serving as a powerful tool for the people and the organisations that have access to it. As a society, we do have the opportunity to tackle some of society's most pressing issues. AI and data present us with that opportunity.

That opportunity is out of reach for many. Organisations need access to data to be able to employ AI. However, access to large data sets and the skills to use data effectively is increasingly concentrated with a small group of companies and countries. Fewer than 100 companies worldwide now

collect more than 50 per cent of the data generated by online interactions,¹ and according to figures from LinkedIn around half of all people with technical AI skills work in the technology sector.

The intellectual property (IP) system has a role to play in enabling society to embrace the data opportunity. The IP Federation has urged the UK government to adopt a balanced commercial text and data mining copyright exception to enable organisations make use of the data that is lawfully accessible, such as the information that is made available online. Through supporting the creation of innovative data sharing solutions, such as privacy preserving technologies, the IP system can facilitate the sharing of sensitive data, and insights

from data that organisations may not wish to make publicly available.

Treating data like the new oil² only encourages data hoarding. Instead we should be valuing the outcomes you can achieve through data. With better access to data, together with today's available computing power and sophisticated algorithms, society has an opportunity to drive better outcomes for some of the biggest challenges we face, such as in healthcare and climate change. The value of collaboration, over and above organisations going it alone, has already been demonstrated by the open source movement. Sharing the building blocks of applications to foster collaboration can exponentially drive the creation of new solutions.



AI and data present us with opportunities to tackle some of society's most pressing issues

An open and more collaborative approach to the way we use data, with shared goals in mind, could see similar gains in the insights and outcomes we can achieve.

The IP Federation will be engaging in dialogue on the many upcoming consultations and reforms relating to data, both in the UK and Internationally.

Sonia Cooper
President, IP Federation

¹ Microsoft Corporate, External and Legal Affairs (CELA) Data Science analysis based on [similarweb.com](https://www.similarweb.com), [appfigures.com](https://www.appfigures.com) and [alexa.com](https://www.alexa.com)

² “The world’s most valuable resource is no longer oil, but data.” *The Economist*, 6 May 2017

Designing the Future

Following the UK's departure from the EU, holders of rights in designs have been busy ensuring continuity of rights and strategies for navigating the new scope of rights in the UK and the EU. As the dust settles from this flurry of activity, the future of design legislation in the EU is taking shape and the IP Federation has been active in presenting the view of UK industry.

For registered Community designs that were registered prior to the 1 January 2021, our members welcomed the smooth duplication of rights by the UK IPO in the form of the UK re-registered designs. For those registered Community designs which were still pending (and/or unpublished) on 1 January 2021, proprietors were faced with the choice of losing protection or registering them in the UK prior to the deadline of the end of September. Moreover, from the 1 January, designers are faced with the extra cost of registering protection in the UK in addition to the EU for all new designs.

Unregistered Community designs which were automatically protected in the UK prior to the 1 January 2021 continue to enjoy protection in the UK by means of the UK continuing unregistered design. For new designs, designers are faced with the choice of pursuing protection in the UK or the EU. The UK supplementary unregistered design arises from disclosures first made in the UK whereas unregistered Community designs arise from disclosures first made in the EU. It is possible that simultaneous disclosure in the UK and EU will give rise to both rights but this is an area of law that has yet to be clarified and causes uncertainty for designers.

So far there appear to be few issues with the new rights created post 1 January 2021 but some of the consequences (such as the issue of simultaneous disclosure discussed above) may not become apparent for several years.

Meanwhile, the EU commission has been busy reviewing the legislative framework for EU designs and the IP Federation has responded to both the Inception Impact Assessment and the more recent public consultation. One of the

main points emphasized by the IP Federation was that on very many measures, the EU design regime has been an unqualified success since its relatively recent inception. Thus the IP Federation believes that any changes to the regime to achieve the proposed objectives should, where possible, be achieved by improved guidance and cooperation between the offices rather than legislative interventions. This is particularly the case where the Commission is attempting to remedy an apparent perceived unclarity in the existing legislation as to what can be protected as a design.

The EU design regime has been an unqualified success since its relatively recent inception.

The IP Federation was supportive of legislative changes proposed to broaden the scope of design rights conferred to better fight against counterfeit goods. We also supported further harmonisation of national law in so far as this relates to introducing a repair clause into the Directive to complete the single market for spare parts.

As regards clarifying the interlink between design and copyright protection, the IP Federation has advocated for ensuring a demarcation between design rights and copyright to, for example, avoid copyright extending to technical subject matter. The design regime includes important safeguards to ensure that advances in technical function are excluded (and therefore remain in the purview of patent law with all of its requirements, such as those of novelty and inventive step). Such safeguards are not



The IP Federation has voiced its support for other measures that will clearly enhance the ease of use and reduce user's costs.

necessarily explicit in copyright legislation and recent evolution of EU copyright law has led to questions over whether subject matter that was intended to be protected by unregistered Community designs would necessarily already be protected by the much longer-lasting copyright.

The IP Federation has voiced its support for other measures that will clearly enhance the ease of use and reduce user's costs. These include streamlining and simplifying procedures to facilitate the simple filing of all design types, including in multiple form, and the adjustment of fee structures. This is also the case for the proposals regarding enhanced interoperability of design protection systems in the EU.

In all of its submissions, the IP Federation has been keen to reiterate its opposition to any changes that would lead to protection of technical function by designs.

Looking forward to 2022, we anticipate the draft legislation from the Commission regarding the proposed changes to EU design law and will look for further opportunities to present the views of UK industry on the proposals. Moreover we anticipate that the UK IPO will begin to look at the evolution of the UK designs regime and the IP Federation hopes to be a key partner in designing the future.

Danny Keenan

Copyright and Design Committee Chair

Trade Marks 2021:

Interesting times for brands

This year has been an interesting one for trade marks. The boom in online trade, and the need to put our everyday lives on hold, has meant that trade marks are as important as ever.

COURTS AND TRIBUNALS

The Courts – the beating heart of the law - have not stopped moving in 2021 as the pandemic continues. For the most part cases have continued, with the IP courts and the lawyers that serve them working together to keep momentum, hopefully minimising the backlog reported in other areas of the law. Litigation in general has become electronic-first, and even full trial hearings have moved online.

Is the court showing an exciting ability to learn and adapt? The Business and Property Court (the Chancery division – which is the English forum for IP cases), has found that electronic litigation works very well indeed. This has led to new guidance this Autumn, that online hearings will be the default position for all short hearings “for the foreseeable future” – with bundles and other papers to be prepared electronically unless specifically requested by the judge – happily, “to assist the courts of the Business and Property Courts to deal with their business as efficiently as possible”.

IP work – intangible by nature – is in theory perfectly suited to the ethereal online world, and this has proved to be the case in hearings throughout the year. While not appropriate in every case, it is absolutely clear from the last year that there is a real efficiency to electronic litigation.

This efficiency should help to cut through some of the costly parts of litigation, make courts more responsive, and the cost and time savings will benefit litigants directly.

IMPLEMENTING BREXIT

For many of us, the most striking thing about 2021 starting was that 2020 was ending – and with it, suddenly so was the Brexit implementation period.

So then, 2021 was the year of the birth of an entirely new raft of UK rights, including the cloned rights created from EUTMs that were registered before the completion of Brexit (officially termed a “Comparable Trade Mark (EU)”). Overnight, the UK Intellectual Property Office (UK IPO) flipped the switch on their database; and new provisions of the Trade Marks Act 1994 came into effect.

Brand owners would be astute to keep an eye out for developments on that front over at least the next year. Those new provisions and transitional provisions are complicated, and mainly untested. Many consider that some of them would benefit from clarification by a court; while others are clear, but poorly understood. A part of this question was before the Court in *Lifestyle Equities v Copyrights Group* [2021] EWHC 1212 (Ch), considering the UK’s jurisdiction to grant injunctions in the EU where cases were pending before Brexit. The Court found that it undoubtedly did have jurisdiction over infringements in the EU in such cases, and that there was at least an (unresolved) argument that it had the ability to make an extraterritorial injunction into the EU in those circumstances. It is hoped that courts will continue to indicate how this new law will be applied.

It is reassuring too, that the UK IPO is also working hard to ensure that the Brexit legislation is implemented fairly in the UK. For example, having identified an inconsistency between the Opposition practice of the UK and EU offices, the UK IPO is developing practice guidance to address any disparity suffered where this could cause unfairness.



We truly do live in interesting times.

CASE LAW

Amid all those major practical developments, case law marched on in 2021. There have been many interesting points of practical significance, as the edges of trade mark law continue to develop.

The big registered trade mark decision of the year has been the Court of Appeal decision in *Sky v SkyKick* [2021] EWCA 1121. Widely reported, this decision takes a detailed look at the public policy relating to bad faith as applied to terms used in trade mark specification, and provides important filing practice guidance to benefit applicants, that wide terms may be justified where they are a fair description of services. Unless overturned if there is a further appeal to the Supreme Court, this should help to streamline trade mark applications. Further developments are expected over the next year.


Beyond trade mark infringement itself, there have been several interesting passing off decisions this year, helping to define the limits and benefits of unregistered rights. In Spring 2021, supermarket giant Lidl faced off against artisan butcher Philip Warren, who had accused Lidl of passing off with a demand put as high as £47 Million. On the evidence, the court found that passing off was not established, with Philip Warren's claim deemed speculative, and ill-founded (*Philip Warren v Lidl* [2021] EWHC 1097 (Ch.)). While that shows how difficult a case in passing off can be if not well conceived, common law rights are still important. This was demonstrated in the Autumn: A dispute between two people offering holistic psychic services over the mark "ARCHANGEL ALCHEMY" ended in surprise for the claimant, who apparently did not foresee that her own claim for trade mark infringement would fail,

... Trade Marks 2021 continued

leaving her open to a finding that she was liable for passing off against the successful defendant (*Stone v Wenman* [2021] EWHC 2546 (IPEC)).

It has also been a strong year for Protected Designations of Origin (PDOs), with the CJEU decision in *Champagne v Champanillo* (C-783/19, 9 September 2021) clarifying that PDOs extend to services as well as products. What is more, the test of ‘evocation’ is not just a similarity test, but considers all the circumstances of what image would be triggered in the mind of a person confronted with the sign.

As well as Champagne, Prosecco has seen success in the English Courts in two recent decisions: not only successfully defending an appeal from the IPO concerning the use of a similar ‘Nosecco’ brand last year; but also securing injunctive relief and delivery up from the court in respect of infringing flavoured “personal lubricants” this year (*Prosecco v Viator Health Limited* (2021) unreported).



For many of us, the most striking thing about 2021 starting was that 2020 was ending – and with it, suddenly so was the Brexit implementation period.

And so the law continues to develop; the UK continues to be an important forum on the international stage; and the courts continue their work with a renewed drive for efficiency.

We truly do live in interesting times.

Tristan Sherliker

Senior Associate, Solicitor Advocate,
Bird & Bird LLP



The TRIPS Waiver

If you work in an industry that uses Intellectual Property of any kind, it's probable that you have heard of the TRIPS waiver proposals. If you read newspapers or news websites, it's probable that you have heard of the TRIPS waiver proposals.

If you are generally interested in the COVID-19 response and concerned about global access to vaccinations and when the pandemic may be brought under control then it's also probable that you have heard of the TRIPS waiver proposals! This article aims to explain what TRIPS is, what the waiver proposals are, and the likely timelines for discussion and implementation. It can be a deeply divisive topic and so we will refrain from opinion and restrict ourselves to the facts.

As part of harmonisation of IP rights across the world, in 1994 the TRIPS agreement was signed.

The IP Federation is a cross industry body representing companies from many sectors, including pharmaceuticals, telecoms, engineering and data management. The common thread between all members is that they are innovative, and rely on a cost effective, high quality IP framework to succeed in their industry, a view shared by many nations. As part of harmonisation of IP rights across the world, in 1994 the TRIPS agreement was signed. This is a WTO agreement on the Trade Related aspects of Intellectual Property Rights that introduced intellectual property law into the treaty framework of the global trading system for the first time.


The TRIPS agreement establishes minimum international guarantees for the availability, protection and enforcement of IP rights. It includes such "basics" as the availability of patents for inventions in all areas of technology (subject to other patentability requirements) and that the term of a patent must be at least 20 years. It also provides that a patent should be

exclusive, and any exceptions to this exclusivity should be narrowly limited. Although TRIPS provides a minimum set of standards, provided that these standards are met the mechanics of how IP is protected remains a matter for domestic legislation – leading to many jurisdictional differences in how patents are granted and enforced. As TRIPS is a WTO treaty, non-compliance with any of the minimum standards, such as a reduction in copyright term below 50 years by one Member, would enable another Member to use the WTO's dispute settlement system.

A waiver to TRIPS would enable countries to legislate their individual domestic IP regimes to below these minimum standards with no violation of International Law. For example a Member country could choose not to grant monopoly rights to patentable inventions, or to allow copying of registered design rights without infringement. Provided this was in line with the boundaries of the waiver it would be acceptable.

The currently proposed waiver was submitted by India and South Africa in October 2020, asking for a waiver from TRIPS for "all health products and technologies including diagnostics, therapeutics, vaccines, medical devices and personal protective equipment for the prevention, treatment or containment of COVID-19"...

WTO members would, under the proposal, have the discretion to forego "implementation, application and enforcement of the provisions of the TRIPS agreement relating to copyright, industrial design, patents and protection of undisclosed information (including regulatory test data and trade secrets)."

An abstract graphic featuring a complex network of white lines and dots on a dark blue background. The lines connect various points, creating a web-like structure that fills the upper and right portions of the page. The dots are of varying sizes and are positioned at the intersections of the lines.

The common thread between all members in that they are innovative, and rely on a cost effective, high quality IP framework to succeed in their industry, a view shared by many nations.

The TRIPS agreement establishes minimum international guarantees for the availability, protection and enforcement of IP rights.

Any decision on whether a waiver is implemented is taken at the Ministerial Conference, the highest decision making body of the WTO. It is customary for a full consensus of all 164 Member countries to be required for decisions on waivers, however a vote could be forced if there is no agreement and a three quarters majority would be sufficient to pass.

The debate around the potential waiver exploded in May 2021 when the Office of the U.S. Trade Representative announced U.S. government support for waiving IP protection for COVID-19 vaccines, and indicating that the U.S. government would actively participate in text-based negotiations at the WTO.

As a result Members agreed to enter into text based negotiations in June, discussing a slightly revised waiver proposal and a separate proposal submitted by the EU which calls for limiting export restrictions, supporting the expansion of vaccine production, and facilitating the use of current compulsory licensing provisions already in TRIPS. Updates on discussions can be found on the WTO website, from which it appears that positions are still divergent. The 12th Ministerial Conference is taking place at the end of November 2021, and advocates for the waiver are hopeful that a decision will be taken there.

Even if this were to happen, that won't be the end of the story. Should a waiver be passed there is no obligation for any individual country to implement changes in their IP law – this will be determined by each Member and is likely to result in an array of different IP provisions in jurisdictions around the world. This is of course already the case to some extent, but with the requirement for a minimum level of protection and standardisation removed one could speculate that some countries will seize the opportunity to legislate in a way that drives the removal of IP protections; particularly the disclosure of valuable know-how and trade secrets. Even if a waiver is limited temporally, once disclosed this protection is lost permanently.

A waiver to TRIPS would enable countries to legislate their individual domestic IP regimes to below these minimum standards with no violation of International Law.

The outcome of the discussions will depend in large part whether vaccine access becomes more balanced across the world regardless of whether a country is designated low, middle or high income. This will require manufacturers and governments to work together to facilitate the smoothing of supply chains and ensure equitable access to vaccine supply. 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



IP Federation biographies 2021–2022

The President is assisted by the Vice-President and Immediate Past President, and the day-to-day running of the IP Federation is in the hands of the Company Secretary and Office Manager.

SONIA COOPER, 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 responsible for IP policy in Europe at Microsoft and works 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".



SCOTT ROBERTS, IMMEDIATE PAST PRESIDENT

Scott is a UK Chartered Patent Attorney and European patent attorney with 20 years of experience in patents gained in both industry and private practice. Scott joined the patent profession after 10 years' experience as a software engineer and a period lecturing in computer science. He has worked in-house at both British Telecommunications and IBM specialising in computing and telecommunications technologies. Scott has represented both BT and IBM at the IP Federation since 2008 and chaired the IP Federation patent committee from 2016 to 2019.

Scott is a member of the Standing Advisory Committee of the European Patent Office (SACEPO) and also sits on the SACEPO working party on rules. In addition to these roles, Scott is a member of the UK Government Department for International Trade's IP thematic working group. He also represents UK industry at the BusinessEurope patents working group. Since 2009 he has been a member of the Examination Committee of the European Qualifying Examination (EQE) for professional representatives. He is also a co-author of the CIPA European Patents Handbook.

Originally from South Wales, he now lives in the South of England with his wife and three children where he tutors maths, science and computing. He volunteers at a local NHS trust where he works with nurses to address the challenges in their professional practice. In his down-time he can be found indulging in dystopian literature.

He was President of the IP Federation from 2020 to 2021.

MATTHEW HITCHING, VICE-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.

...Biographies continued

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 2021

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 below.

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.

AGCO Ltd

Airbus

Arm Ltd

AstraZeneca plc

BAE Systems plc

BP p.l.c.

Babcock International Ltd

British Telecommunications plc

British-American Tobacco Co Ltd

Canon Europe Ltd.

Caterpillar U.K. Ltd

Cummins Ltd.

Dyson Technology Ltd

Eisai Europe Limited

Eli Lilly & Company Ltd

Ericsson Limited

GE Healthcare

GlaxoSmithKline plc

HP Inc UK Limited

Hitachi Europe Ltd

IBM UK Ltd

Johnson Matthey PLC

Merck Sharp & Dohme (UK) Ltd

Microsoft Limited

NEC Europe

Nokia Technologies (UK) Limited

Ocado Group plc

Pfizer Ltd

Philips Electronics UK Ltd

Pilkington Group Ltd

Procter & Gamble Ltd

Reckitt Benckiser Group plc

Renishaw plc

Rolls-Royce plc

Shell International Ltd

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UCB Pharma plc

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