



## **The IP Federation's activities**

### ***The IP Federation's campaigns***

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

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

committees and working groups - notably the Diversity and Inclusion working group. Our approach to consultations, e.g. exhaustion and standard essential patents (SEPs) shows that we are inclusive and encourage diversity of thought in our inputs.

8. Our 2021 edition of the annual *IP Federation Review* received very positive feedback, demonstrating excellent work from across the membership, including the various committees and working groups, especially the newly established Communications Working Groups.
9. On the exhaustion of rights consultation, we provided a strong submission on a complex topic covering the range of members' views, and briefed the All-Party Parliamentary Group for IP. The outcome was that UK Government announced on 18 January 2022 that it had decided against moving to a new International exhaustion regime, representative of the majority view of our membership.
10. The IP Federation has been lobbying for the United Kingdom to adopt a broader text and data mining (TDM) exception to copyright infringement. On 12 June 2022, the Government published its response to the consultation on Artificial Intelligence (AI) and Intellectual Property (IP). Following this consultation, the Government has accepted the need to create a new data mining exception for copyright and database rights. This will make it easier to analyse material for machine learning, research and innovation.
11. The IP Federation has been campaigning for a number of years for intellectual property judgments to be excluded from the scope of the Hague Convention on the Recognition and Enforcement of Foreign Judgments. On 12 July 2022, the European Council adopted a decision on the accession of the EU to the 'Convention on the recognition and enforcement of foreign judgments in civil or commercial matters'. Article 2 states that this convention shall not apply to a number of matters, notably intellectual property.
12. The Intellectual Property Regulation Board (IPReg) recently consulted on proposals for changes to their regulatory arrangements. They singled out our organisation in their summary of responses published on 21 July 2022, in connection with the relationship between in-house patent attorneys and their employers, saying that they will be discussing the application of the new arrangements with the IP Federation, to make sure everything works as it should.
13. Over a long sustained period spanning various IP Federation presidencies, we have strongly supported the Unified Patent Court (UPC) system. This is finally coming to fruition, with the adoption of the court's Rules of Procedure and its Table of Fees, which enter into force on 1 September 2022, and progress made on the appointment of judges. Other actions included adoption of the Organisational Rules of the UPC's Patent Mediation and Arbitration Centre, and confirmation the locations of the local and regional divisions of the Court of First Instance.

### ***IP Federation statement on the Russian invasion of Ukraine***

The IP Federation strongly condemns the Russian invasion of Ukraine.

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

#### **UK IPO Statement**

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

#### **UK Government sanctions on Russia**

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

#### **UK Government Export Support Service (ESS)**

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

#### **Ukrainian Intellectual Property Institute (UIPI)**

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

#### **European Patent Office (EPO)**

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

#### **WIPO and EUIPO**

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

#### **Intellectual Property Regulation Board (IPReg)**

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

#### **Chartered Institute of Patent Attorneys (CIPA)**

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

### ***Reviewing the designs framework – call for views***

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

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

### ***Plausibility – Enlarged Board of Appeal case 2/21***

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

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

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

1. Should an exception to the principle of free evaluation of evidence (see e.g. G 3/97, Reasons 5, and G 1/12, Reasons 31) be accepted in that post-published evidence must be disregarded on the ground that

the proof of the effect rests **exclusively** on the post-published evidence?

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

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

***The IP Federation has moved***

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

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

Our phone number and e-mail remain the same.

***IP Federation President's reception 8 July 2022***

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



***Referrals to the Enlarged Board of Appeal – G 1/22 and G 2/22  
(Entitlement to priority)***

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

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

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

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

### ***Retained EU Law (Revocation and Reform) Bill***

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

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

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

### ***Benefits of being in the IP Federation***

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

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

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

### ***Social networking***

As well as having its own website, the Federation has web presence through social networking sites, with a page on Facebook, a profile on LinkedIn and a Twitter account - @ipfederation. We now have a thousand followers,

including some notable figures in the IP world. This is the easiest way to be notified of any new policy papers and other news items on our website.

David England, IP Federation Secretary