



ADVANCING INDUSTRY'S VIEW ON INTELLECTUAL PROPERTY SINCE 1920

TRENDS & EVENTS

Intellectual Property:
Current Events and
Future Prospects

December 2014



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 forty-one IP-intensive members 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. [For a list of full members see back cover.]

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 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 all developments at national, European and international levels across all fields of intellectual property. The Federation 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 BUSINESS EUROPE, 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 Organisation (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 Intellectual Property Court Users' Committee (IPCUC), the UK user committee of the Patents Court, and is on the IPO's list of consultees in relation to references to the Court of Justice of the European Union (CJEU).

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 Institute of Trade Mark Attorneys (ITMA) and the Intellectual Property Institute (IPI); it 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 agrees 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 seat on council, as well as 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 which follows.

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Intellectual Property: Current Events and Future Prospects

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PRESIDENT'S INTRODUCTION

It is with great pleasure that I am able to introduce the December 2014 edition of *Trends and Events*, the annual journal of the IP Federation. The contributions you will read are prepared by member representatives of our Federation who put in an inordinate amount of time and effort in support of the Federation and its aims. The IP Federation can, however, only run smoothly through the diligence and hard work of our Secretariat of two (David England and Gilly Webb).

Intellectual Property (IP) is the lifeblood of innovative business. There continues to be a growing realisation of the importance and value of IP on the global stage. Unsurprisingly, it continues to be an extraordinarily busy and interesting time for us in the dynamic world of business IP.

In the UK, the Intellectual Property Bill 2013-2014 became the Intellectual Property Act 2014, and we are pleased that the enormous lobbying efforts put in by IP Federation members was not only acknowledged as being of great value to the debate, but also led directly to a significant improvement of the wording of the law.

The issue of EU Patent Reform and the Unified Patent Court (UPC) continued to be a lively area for lobbying through 2014, and the issues of obtaining clarification and seeking ways for our members' knowledgeable voices to be heard, were at the forefront of many IP Federation Council discussions. We were invited to, and spoke at, the Trier hearing on the Rules of Procedure, and we have continued to voice our concerns both to those in the UK IPO charged with bringing the UPC and the Unitary Patent into being, as well as those working with the Preparatory Committees and with the Rules of Procedure.

The EU Commission in 2014 has also moved forward with a Trade Secrets Directive and with starting off a consultation into Patents and Standards. The IP Federation took its lobbying on Trade Secrets to Brussels to meet with the Commission in what has become an annual visit, providing an opportunity for an informed exchange of views, welcomed by both sides. During the 2014 visit, we also took the opportunity to meet with some of the new MEPs, and we will aim to develop a useful dialogue with those in Brussels, whether in the Commission or in Parliament, on the increasing number of EU-wide IPR initiatives.

In the wider sphere, and with a longer timeframe in mind, we continue to support the package of harmonisation proposals under evaluation by the Tegernsee group, and by other international bodies, but will continue to resist attempts to split up this proposed package to put forward individual proposals on a piecemeal basis.

Looking ahead, I expect 2015 to be an interesting year for IP Policy in the UK, with a General Election bringing the uncertainty of whether there will be continuation, or a change, of legislative direction. We will also come closer to seeing whether the Unified Patent Court and the Unitary Patent will actually become reality and what forms they will take, but much more importantly what costs will be set for industry to meet. Whatever comes to pass, the IP Federation will continue to bring a practical, commercial viewpoint to bear that is balanced and reasonable and representative of the needs of industry, whether large or small.

Finally, I would like to thank the following contributors to this edition for giving up their valuable time to pass on their expertise:

- Ruth Barcock
- David England
- Bobby Mukherjee
- Scott Roberts
- Tony Rollins
- Gill Smith

and also our Solicitor Associates:

- Mark Ridgway of Allen & Overy
- Alan Johnson of Bristows
- Kate Swaine, Alice Stagg and Rebecca Ward of Wragge Lawrence Graham

Carol Arnold, IP Federation President, 31 December 2014

IP FEDERATION

The Federation's activities

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

<http://www.ipfederation.com>

The policy papers on the website represent the views of the innovative and influential companies which are members of the Federation. Members are consulted on their views and opinions and encouraged to debate and explore issues of practice and policy. Only after consensus is achieved are external bodies informed of the collective views of industry via the Federation.

The policy papers are also submitted to the relevant third party consultative bodies, e.g. the Standing Advisory Committee before the European Patent Office (SACEPO), and the Patent Practice Working Group (PPWG), at the:

- European Patent Office (EPO)
- Office of Harmonization for the Internal Market (OHIM)
- World Intellectual Property Organization (WIPO) and
- UK Intellectual Property Office (IPO)

as well as, in appropriate cases:

- BUSINESSEUROPE
- the European Commission
- ministers and
- judges.

Policy papers 2014

Policy papers submitted in 2014 are as follows:

PP 1/14 Intellectual Property Bill 2013-14: criminal sanctions for Unregistered Design Rights

IP Federation position on the potential introduction of criminal sanctions for Unregistered Design Rights (UDRs)

PP 2/14 IP Federation comments on the proposed EU trade secrets directive
IP Federation comments on the proposed EU trade secrets directive

PP 3/14 Response to consultation on

simplifying and modernising the examination system for qualifying as a patent attorney

IP Federation response to IPReg consultation on simplifying and modernising the examination system for qualifying as a patent attorney

PP 4/14 IP Federation comments on the compromise text for the EU trade secrets directive

IP Federation comments on the compromise text for the proposed EU trade secrets directive

PP 5/14 IPReg Competency Frameworks - Patents and Trade Marks

IP Federation comments on the IPReg draft Competency Frameworks for patents and trade marks

PP 6/14 Substantive Patent Law Harmonisation [SPLH]

Plea for continued efforts to find common ground for international agreement on a number of substantive aspects of patent law, including the prior art to be considered in relation to novelty, the principle that the patent on a given invention should be awarded to the first inventor to file and a grace period

PP 7/14 IP Federation comments on other appropriate qualifications under Article 48(2) UPCA

Unified Patent Court Agreement: IP Federation response to the consultation on the proposals by the Legal Working Group of the Preparatory Committee on the draft European Patent Litigation Certificate (EPLC) closing on 25 July 2014

PP 8/14 IP Federation note to the UPC Preparatory Committee

IP Federation note to the Preparatory Committee on the Draft Rules of Procedure of the Unified Patent Court on:

- Rule 14 - language
- Rules 37 and 118 - bifurcation and grant of injunctions
- Rules 19, 336 and 340 - general case management / joinder of actions
- Rules 101 and 113 - timings
- Rule 220.2 - procedural appeals

PP 9/14 IP Federation submissions on draft UPC legislation

IP Federation response to the IPO's Technical Review and Call for Evidence on draft secondary legislation implementing the Unified Patent Court Agreement (UPCA) closing on 2 September 2014

PP 10/14 UK Government consultation on timing of repeal of section 52 of the Copyright, Designs and Patents Act

Response to UK consultation on timing of repeal of section 52 of the Copyright, Designs and Patents Act (CDPA)

PP 11/14 Proposal to amend the marking provisions for registered designs

Proposal to amend the marking provisions for registered designs to provide for the marking of products with a relevant internet link (virtual marking)

PP 12/14 Unified Patent Court IT system and confidentiality issues

Concerns amongst IP Federation members regarding the broad issue of information security within the Unified Patent Court (UPC) system

The Federation's campaigns

An important point to understand is that in general IP lobbying and influencing is a long term activity - especially as we do not tend to get involved in short-term single issue items of a sectoral nature. However, some of the more specific campaigns in which the Federation has lobbied and enjoyed various key successes in 2014 are set out below. These are all cases of success or partial success in which the Federation had a role.

1. With techUK and others, the IP Federation campaigned successfully for the adoption of new secondary legislation into the UK in respect of introducing a narrow private copying exception.
2. The IP Federation's valuable input was publicly recognised by the Government IP Minister and other key stakeholders during the Parliamentary debate stages of the UK IP Bill 2013-2014, which passed into law in 2014. We publicly supported the need for IP reform (as proposed by the UK Government), and we welcomed the introduction of virtual marking provisions into law, as applied to patents. We managed to maintain the fundamental principle of reciprocity in respect of the unregistered design right qualification (UDR) criteria in the 2014 Act, and we stopped the possible proposal to extend criminal sanctions to UDR infringements. As a result of our sustained campaigning during the passage of the UK IP Bill 2013-2014, appropriate safeguards were further introduced into the Act in respect of the criminal sanctions provisions, as applied to registered design infringements.
3. We have lobbied successfully for improvements in the latest draft Unified Patent Court rules of procedure (17th version), including specific improvements to the rules relating to representation and privilege, bifurcation and grant of injunctions, procedural appeals, evidence, and general case management. In this regard, the IP Federation have raised various issues vital to UK industry at the Trier public oral hearing (26 November 2014) on the UPC draft rules of procedure.
4. We have strongly supported the proposed European Commission initiative to improve protection for trade secrets in Europe, by introducing a directive that would require all EU member states to meet a minimum standard for protection of trade secrets. We have engaged successfully with key stakeholders in Europe to support the general thrust of the proposed Directive and to help secure further specific improvements to the proposed Directive, in the interests of Industry.
5. We have had real impact in advocating the value of the collaborative search and examination proposal by the world's five major Intellectual Property Offices, with the relatively recent positive development of Japan adding its support to this proposal.
6. Last year, we urged the UK Government to intervene in Court of Justice case C-364/13 (International Stem Cell Corporation) and to argue that cells capable of commencing the process of development of a human being but which do not have the capacity to develop into a human

being should not be considered as included in the term "human embryos". The Government duly intervened, and in December 2014 a judgment was issued along the lines that the Federation argued.

7. The IP Federation applied this year to be added to the list of accredited non-governmental organisations before WIPO. Our application proved to be successful. The decision to grant permanent observer status to the IP Federation in this regard was taken by the Assemblies of the WIPO Member States at their annual session in September / October 2014.

Work in progress

Work in progress includes the following campaigns:

- a) for improved patent search quality, in the interests both of patentees and potential infringers of patents;
- b) for the retention of an iterative examination process at the EPO;
- c) for the UK to remain involved in the process for establishing the unitary patent package in the European Union;
- d) for the draft Rules of Procedure of the Unified Patent Court (UPC) to be adopted, subject to certain amendments;
- e) for harmonisation of substantive patent law and renewed efforts to find common ground for international agreement on a number of aspects;
- f) for resistance to widespread imposition of criminal penalties in IP cases, particularly in the field of infringement of registered and unregistered designs;
- g) for retention of the present reciprocity provisions on the unregistered design right (UDR) in the Copyright, Designs and Patents Act 1988, which offer UK manufacturers protection from unfair competition, encourage reciprocity and support UK innovation;
- h) for the marking provisions for regis-

tered designs in the UK to amend to provide for the marking of products with a relevant internet link (virtual marking), as is the case with patents under the Intellectual Property Act 2014;

- i) for the adoption of the proposed EU trade secrets Directive, as long as the draft is improved in certain areas; and
- j) for an improved process for filing observations at the Court of Justice of the European Union (CJEU), to allow UK organisations to participate fully.

See also the Activities tab on the IP Federation website for the latest news.

Benefits of being in the Federation

As set out on the 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
- Regular alerting service, newsletters and policy papers.

Social networking

As well as having its own website, the Federation has a web presence through social networking sites, with a page on Facebook, a profile on LinkedIn and most recently a Twitter feed - @ipfederation. Over the last year, we have doubled the number of people who follow us on Twitter and now have well over two hundred followers, including some notable figures in the IP world, and this is the easiest way to be notified of any new policy papers and other news items on our website.

David England, 22 December 2014

COMPETITION

Progress on the EU Trade Secrets Directive

Introduction

2014 has seen significant progress in relation to the EU's legislative efforts on trade secrets. Since the December 2013 edition of *Trends and Events* went to press, we have seen: (i) the publication of the Commission's initial proposal for legislation;¹ (ii) negotiations within the Council of the European Union resulting in an agreed compromise text for the Directive;² and (iii) early exchanges of views and draft opinions within the European Parliament.³

However, much remains to be done as the proposed Directive continues its progress through the European Parliament. In particular, the potential impact of the Directive on labour law has prompted heated debate within the parliamentary committees. As such, there is a significant risk that, through the influence of European parliamentary groupings, the final Directive will be less desirable than businesses originally hoped. Whilst the IP Federation was very successful in ensuring that its views were taken on board within the EU Council discussions, it remains to be seen whether business's concerns will carry the same weight in future.

The Commission's original proposal

As for the substance of the proposed Directive, when it was originally published by the Commission in late November 2013, it was met with general approval by business, including by the IP Federation. Key points from the proposal can be summarised as follows:

- Consistent with the IP Federation's position (although going against the majority of responses to the Commission's consultation), the Commission

proposed legislation in the form of a Directive.

- The foundation of the proposal was a "common definition of trade secrets"⁴ (something the Commission felt had previously been lacking, including in the UK). This tracked wording from Article 39 of TRIPs and potentially covered a broad range of confidential information, consistent with that which is protected under English law.
- A further important definition was that of "infringing goods",⁵ which covered those goods "whose design, quality, manufacturing process or marketing significantly benefits from trade secrets unlawfully acquired, used or disclosed". This potentially allowed upstream trade secret misuse to attach to the goods themselves, making it possible to take action to, for example, prevent the importation of such goods into the EU (a strengthening of the current position).
- In terms of what would constitute an unlawful act in relation to a trade secret, the Directive dealt with this by reference to acts of "unlawful acquisition"⁶ and, separately, acts involving "unlawful use or disclosure"⁷.
- The provisions on "unlawful acquisition" were largely aimed at espionage-type activities. For example, the draft specified that acquisition by "unauthorised access to or copying of documents",

⁴ In Article 2(1). The definition specifies that information will be a "trade secret" if it: "(a) is secret in the sense that it is not, as a body or in the precise configuration and assembly of its components, generally known among or readily accessible to persons within the circles that normally deal with the kind of information in question; (b) has commercial value because it is secret; [AND] (c) has been subject to reasonable steps under the circumstances, by the person lawfully in control of the information, to keep it secret."

⁵ In Article 2(4).

⁶ In Article 3(2).

⁷ In Articles 3(3)–3(5).

¹ COM (2013) 813 final (see:<http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=COM:2013:0813:FIN:EN:PDF>)

² See: <http://register.consilium.europa.eu/doc/srv?l=EN&f=ST%209870%202014%20INIT>

³ Exchanges of views took place within the JURI committee on 13 October and 10 November 2014. Draft reports from ITRE and IMCO committees are available on the relevant committees' web pages.

"theft", "bribery" or "deception" was unlawful. However, more generally, it was also specified that it would be unlawful to acquire trade secrets by "breach or inducement to breach a confidentiality agreement or any other duty to maintain secrecy" or "any other conduct which, under the circumstances, is considered contrary to honest commercial practices".

- The provisions on "unlawful use and disclosure", meanwhile, covered acts that would breach confidentiality agreements or other obligations to maintain secrecy. In addition, they covered circumstances where "... at the time of use or disclosure, [the person] knew or should, under the circumstances, have known that the trade secret was obtained from another person who was using or disclosing the trade secret unlawfully ...". Downstream users of confidential information were therefore potentially caught. Further, there was a provision in relation to the "conscious and deliberate production, offering or placing on the market of infringing goods, or import, export or storage of infringing goods for those purposes".
- In relation to remedies, the proposal effectively provided a scaled down version of the IP Enforcement Directive.⁸ It allowed for interim and final remedies, including injunctions against use and disclosure of trade secrets, as well as against the production, offering for sale, use, import and export of infringing goods. Precautionary seizures of suspected infringing goods were also catered for. The proposal sought to plug various gaps in national court procedures, regarding the protection of confidentiality during proceedings (the Commission had identified this as an obstacle to effective enforcement).⁹ However, some tools were notably absent, such as pre-action disclosure, search orders, *ex parte*

proceedings and "loser pays" provisions (despite being included in the IP Enforcement Directive and in some national laws).

- In keeping with the Enforcement Directive, there was also an emphasis on the need for remedies to be effective and dissuasive, yet also proportionate.¹⁰ In this regard, judicial authorities were given a series of factors to take into account when deciding on interim or final remedies.¹¹ Further, there were specific safeguards against abusive litigation, with sanctions against claims that were "manifestly unfounded...in bad faith with the purpose of unfairly delaying or restricting the respondent's access to the market or otherwise intimidating or harassing the respondent".¹² The proposal also specified numerous ways by which trade secrets could be acquired lawfully (e.g. reverse engineering, independent discovery), as well as circumstances in which they could be lawfully used (e.g. whistleblowing, legitimate free speech etc.).¹³
- Finally, there was also a new limitation period for bringing claims of "not more than two years after the date on which the applicant became aware, or had reason to become aware, of the last fact giving rise to the action".¹⁴

The proposed Directive did not, however, deal with jurisdictional issues, meaning that the Brussels Regulation will continue to apply to civil claims for breach of confidence. In this regard, the proposal did not stray into the territory of the criminal law, which was welcome news (the IP Federation had counselled against

⁸ Most Member States taking the view, as the Commission clearly does, that the IP Enforcement Directive does not apply to trade secrets.

⁹ In Article 8.

¹⁰ In Articles 5(2) and 6(1).

¹¹ In Articles 10(2) and 12(1). The factors include the value of the trade secret; the measures taken to protect the trade secret; the conduct of the respondent; the impact of the unlawful use/disclosure; the legitimate interests of the parties and the impact of granting or rejecting the measures; the legitimate interests of third parties; and the public interest and the safeguarding of fundamental rights, including freedom of information and expression.

¹² In Article 6(2).

¹³ In Article 4.

¹⁴ In Article 7.

this in our response to the Commission's consultation).

Discussions at the EU Council

Overall, the IP Federation and its members were happy with the approach taken, although we proposed a number of points of refinement in policy paper PP02/14. Indeed, many of the points we raised were successfully incorporated in the text of the compromise proposal arrived at by the EU Council. In particular:

- We argued that the Directive should only seek to provide minimum standards of protection, thereby allowing Member States to continue to provide higher levels of protection. This was duly catered for in an express amendment to Article 1 of the draft.
- We urged clarification of recital 8 to ensure that it remained consistent with the definition of "trade secret" in TRIPs, ensuring that trade secret protection was not unintentionally undermined in relation to employees. The recital was subsequently amended.
- We argued that the requirement for acts of acquisition, use or disclosure of trade secrets to be carried out "*intentionally or with gross negligence*" in order for them to be unlawful was unnecessary and confusing, given that intent is not necessary under English law and "gross negligence" is a problematic concept. This requirement was subsequently removed.
- We argued that the provisions in Article 3(2) requiring "*theft*", "*deception*" etc. were unclear and/or unduly complicated in several respects. These provisions were then dropped in favour of more general wording.
- We argued that the 2 year limitation period in Article 7 was too short and would cause unnecessary litigation. This was subsequently amended to 6 years.
- We supported the argument that Article 8 (relating to the protection of confidentiality during court proceedings) should be retained, despite opposition from elsewhere in Europe.

Unfortunately, our suggestion that the legislative process should not be rushed was ignored. Accordingly, an ambitious timetable was pursued, with an agreed Council compromise text being published in late May 2014. This was then picked up by the European Parliament in October 2014, following the parliamentary elections.

Present position and future timeline

Within the European Parliament, the JURI (Legal Affairs) Committee is responsible for reviewing and reporting on the proposed Directive, working from the original Commission draft. At the time of writing, two exchanges of views have taken place within JURI and draft opinions have also been produced by the ITRE (Industry, Research and Energy) and IMCO (Internal Market and Consumer Protection) committees.

A hearing is also due to take place on 20 January 2015, at which other views will no doubt be presented. However, it is already clear that interested parties, particularly those with socialist leanings, have been lobbying hard against various provisions of the Directive. This is reflected in particular in the draft report from ITRE, which tables no fewer than 49 separate amendments to the Directive (which consists of only 19 Articles in the first place). Many of these are dangerous from the point of view of business, since they could serve to undermine the protection of trade secrets in Europe.

The IP Federation has therefore been actively engaging with MEPs working on the Directive, to seek to persuade them of the dangers inherent in some of the amendments. The two main concerns raised, and the IP Federation's position on them, can be summarised as follows:

1. The definition of trade secret: The concern has been raised that the definition of "trade secret" is too broad and that this will lead to abusive litigation against SMEs and/or employees. There have accordingly been calls to narrow the scope of this definition. The IP Federation strongly resists this as we believe a broad definition is necessary for compliance with TRIPs and in order to protect the full range of information that is valuable to business. Further, we

believe the risk of abusive litigation is greatly overstated, since the Directive already contains ample safeguards to prevent this.

2. **Labour mobility:** Concerns have also been raised that the Directive will impact on the free movement of labour, where varying rules already exist under the national laws of the Member States. However, we believe this concern can be dealt with by a simple, clear statement to the effect that the Directive shall not affect national law relating to the right for employees to use information that they have learnt from their former employers. We make this suggestion because we believe the area of labour mobility is too controversial to legislate for at this stage, with a serious risk of making things worse. We also note that a majority of the

respondents to the Commission's consultation did not want EU legislation that provided uniform contractual rules for employees on non-compete and non-disclosure clauses (which is essentially what is at issue here).

A myriad of other concerns has also been raised. However, at this stage, our focus is on the major issues, where the damage to the Directive could be greatest. At the time of writing, the IP Federation is producing a position paper to present to the Rapporteur for the Directive summarising our views on these points. We hope that these will be taken on board in her draft report to the JURI committee in February, although we have warned that item 2 above will require some compromise within the European Parliament. Our efforts will continue.

Mark Ridgway, 31 December 2014

DESIGNS

The Intellectual Property Act 2014

Following a huge amount of debate and controversy, the Intellectual Property Bill 2013-14 finally received Royal Assent on 14 May 2014. The majority of the provisions of the new Act came into force on 1 October 2014, including the ones which make the most difference to those of us practising in the field of IP. They are, inevitably, the introduction of new criminal sanctions for certain types of infringement of registered designs and the definition of those qualifying for UK unregistered design right. The IP Federation was heavily involved in lobbying activities which led to satisfactory amendments being made to the wording of the relevant provisions being considered by the House of Commons during January and March.

Clause 3 – Qualification for UDR

The IP Federation successfully opposed changes to the Qualification provisions for Unregistered Design Right (UDR).

Clause 3 of the IP Bill 2013-14 sought to change the definition of "qualifying person", extending qualification for UDR to a much broader body of foreign claimant, whilst also liberalising the "first marketing" qualification route.

The IP Federation identified that these proposed amendments would not only extend UDR protection to companies previously excluded from protection, for the good policy reason that the national law of their own countries of registration did not offer comparable rights to UK companies, but would also strategically disadvantage UK manufacturing companies.

The IP Federation successfully lobbied to ensure that amendments were introduced into Section 3 of the Intellectual Property Act 2014 to protect the beneficial system of reciprocity and ensure that British businesses were not disadvantaged.

Clause 13 – Criminal Sanctions

In the face of huge pressure from ACID (Anti Copying in Design), it proved impossible for the IP Federation to persuade Parliament that it would be wrong to introduce criminal sanctions for infringement of registered designs. However, we were successful in three important respects relating to Clause 13.

Firstly, with the support of the IP judges and other leading IP professionals, we were able to secure agreement from Parliament that the wording of the statute

should state expressly that the sanctions should apply only to those who deliberately or intentionally infringed the registered design in question. On that basis, the word "intentionally" was inserted as a qualifier to the term "copy" so as to exclude unintentional or inadvertent copying from criminal liability. The hurdle to be cleared for establishing criminal liability is therefore set high - as we believe it should be.

Secondly, in order to further protect legitimate businesses, the IP Federation championed an amendment which ensures that designs which are not essentially identical to a registered design cannot give rise to criminal sanctions. Instead of wording which captures designs which are "substantially" the same as the registered design, the Act specifies that only designs which are the same as, or "differ only in immaterial detail" from, the design can give rise to the sanction.

Thirdly, ACID lobbied very hard to have criminal liability extended to UDRs as well as registered designs. The IP Federation produced papers and attended meetings with MPs and IPO officials to explain in detail why and how this would be

detrimental to UK businesses. As a result, formal proposals to introduce criminal sanctions for infringement of UDRs were rejected. However, we are aware that ACID remain determined to press for the introduction of criminal sanctions for UDRs, a position the IP Federation will continue to oppose.

The IP Federation welcomes the vast majority of the provisions of the IP Act. Many of the new provisions offer significant improvements to our laws and ways of working. If there is one disappointment, it is that the provisions allowing the marking of products with patent numbers on a website do not extend to the marking of products with registered design numbers in the same way. We believe wholeheartedly that this was a simple oversight which nobody spotted - not even the IP Federation! - until the opportunity to correct it had passed. We intend to press gently for corrective measures to be taken as soon as practically possible to allow products to be marked with registered design numbers on a website.

Gill Smith and Ruth Barcock, 4 November 2014

PATENTS

Should it be graced?

A review of the current Patent Harmonisation Initiatives

We are in a unique position where there are several patent harmonisation initiatives being pursued by the larger Patent Offices. There is an active industry participation in these activities and it is to be hoped that major changes that are beneficial to the users and the Offices result.

The Industry Trilateral (representatives from BUSINESSEUROPE, the Japan Intellectual Property Association (JIPA), the Intellectual Property Owners Association (IPO) and the American Intellectual Property Law Association (AIPLA)) have been meeting with the Trilateral Offices for over ten years in attempts to harmonise procedures to the joint benefit of the Offices and users. Two notable successes originating from ideas proposed by the Industry Trilateral are the

Common Application Format and the Common Citation Document.

Since 2008 the IP5 Offices (the EPO, JPO, KIPO, SIPO and USPTO) have been working progressively more closely together so that they have now subsumed most of the Industry Trilateral projects (including CAF, CCD and work on patent quality) and in addition have set up a classification working group (WG1), the Global Dossier and patent information working group (WG2), the work sharing and quality working group (WG3) and a Patent Harmonisation Expert Panel (PHEP) looking at potential procedural harmonisation topics. All three of the working groups and the PHEP should lead to major harmonisation advances to the benefits of users as well as the IP5 Offices themselves.

The Classification Working Group

WG1 is concerned with harmonising the classification systems of the Offices by expanding on the Cooperative Patent Classification System initiated between the USPTO and the EPO in 2010 by bringing in the other IP5 members as much as possible and revising the International Patent Classification where the classification schemes match.

Global Dossier

The Global Dossier project is a joint IP5 project with industry. The first joint taskforce meeting was held at the EPO in The Hague in January 2013. At the end of this meeting the industry representatives agreed that the Global Dossier taskforce should work towards a set of business services including an integrated online web portal / interface allowing users to access all available information about patents / applications in the offices; confidential information is to be limited to authorised persons. In addition, it was agreed that the Global Dossier should enable communication and collaboration between applicants and examiners and between examiners in different offices facilitating increased quality, harmonisation of office procedures, work sharing and acceleration of examination.

In relation to the passive (dossier information) component of the Global Dossier service, information is now available on the European Patent Register of Chinese equivalents of European Patent Applications. Access is also possible through the Register to the Chinese file wrapper (and a translation!) of that equivalent application. Korean and Japanese data are hoped to be available during the first quarter of 2015 and US data in the second quarter. The other IP5 Offices will prepare their own versions of the Global Dossier. The next stage of the Global Dossier is the active phase which will be concerned with real time access to information held by the IP5 Offices and hopefully some standardisation of the forms required by the Offices and how these can be submitted electronically.

Patent Harmonisation Expert Panel

The three topics proposed by industry representatives for consideration by the PHEP are unity of invention (lead EPO & SIPO), citation of prior art (lead KIPO &

USPTO) and written description / clarity / enablement / sufficiency requirements (lead JPO). Each group is preparing a comparative table / report and it is hoped that these can be analysed and proposals made at the IP5 Heads meeting in May 2015.

Substantive Patent Law Harmonisation

The Tegernsee process was an opportunity for the Trilateral Offices (and the UK, Danish, French and German Patent Offices) to look at more substantive matters of patent harmonisation, specifically grace periods, conflicting applications, prior user rights and the 18 month publication of all pending applications. Whilst there were significant differences in the preferred outcomes, depending on the nationality of the Office conducting the consultation, there was an overall desire for harmonisation and some flexibility expressed on this. At a meeting the Industry Trilateral held with the Trilateral Offices in September 2013, it was suggested by the Offices that harmonisation should be user driven and that a suitable forum for considering harmonisation further was the WIPO B+ group of nations. John Alty of the UK IPO is the current chair of the B+ group and a subgroup has been set up to work on these issues under his leadership. In the meantime, Industry Trilateral representatives are in detailed discussions to see if differences in their laws can be reconciled and a proposal acceptable to all agreed upon.

It is the view of the IP Federation, and probably the other industry federations across Europe, that agreement has to be reached on all four issues and not, for example, simply on a grace period.

The IP Federation position paper (PP06/14) on the four issues is summarised below.

Grace period

The Federation is in favour of introducing a grace period during which the disclosure of an invention by the inventor will not invalidate a subsequent patent application for the invention, provided that certain conditions¹⁵ are met, as

¹⁵ In relation to the conditions, the position expressed does not represent the view of all members, but represents the view of the majority.

outlined below:

- 1) The benefit of grace should only be given to the inventor's own earlier disclosure. Information disclosed by a third party should not be graced relative to the inventor's patent application, except where the information disclosed by the third party is a straightforward reproduction of all or part of the inventor's disclosure.
- 2) The grace period should be for twelve months before the priority date of the corresponding patent application.
- 3) A declaration / statement should be made at the time of filing a corresponding patent application which should itemise the inventor's own disclosures and any other known disclosures that should be graced. This declaration will be essential to interested third parties, patent examiners and the courts when assessing the scope and validity of the patent.
- 4) The onus must be on the inventor / applicant to justify any claim for grace in respect of any prior disclosure.

No rights from the graced disclosure

A graced disclosure will be part of the prior art as regards patent applications of later date by third parties, but should not establish any right to prevent the use or development of products or processes by others.

A patent application for the invention in the graced disclosure should not have any right over an application for an independently made invention of earlier priority date, even where this date is within the grace period.

Prior user rights

In first to file systems, prior user rights are essential to safeguard the interests of those who have invented and made preparations to manufacture or use a product or process, without applying for a patent on it. (Prior user rights should be mandatory, not optional, and should permit the prior user to develop his/her product, process and/or manufacturing capacity.) Prior use might start within the grace period.

Co-pending applications

The Federation does not support double patenting, whether the two applications are from the same or different applicants. A simple novelty approach as between co-pending applications is the fair way to ensure there is no double patenting.

Mandatory 18 month publication for unclassified applications

The Federation considers that publication of applications at 18 months from their priority dates should be a very important feature of a harmonisation treaty. 18 month publication ensures that "submarine" applications do not remain unpublished for several years following filing.

Tony Rollins, 17 December 2014

EU Patent Reform

In 2014, as in 2013, the unitary patent and Unified Patent Court (UPC) dossier has been among the Federation's highest priorities, following the long-awaited agreement between the European Parliament and Council in late 2012 which resulted in the unitary patent and language Regulations being adopted in December 2012, and signature of the UPC Agreement on 19 February 2013.

In 2013, the main focus of the Federation's work was on the UPC Rules of Procedure, for example PP15/13 commenting upon the 15th draft. The 16th

draft published in March 2014 accommodated some, but not all of the Federation's concerns. In response (despite closure of the formal consultation process) the Federation submitted PP 8/14 on 1 September 2014 to the Preparatory Committee dealing mainly with:

- Rule 14 - language
- Rules 37 and 118 - bifurcation and grant of injunctions
- Rules 19, 336 and 340 - general case management / joinder of actions

- Rules 101 and 113 - timings
- Rule 220.2 - procedural appeals.

The Federation's points on language, bifurcation and procedural appeals have all been accepted by the Rules Committee. Concerns remain, however, about the lack of any dispute management powers (including powers to transfer actions between divisions, or between branches of the central division) and timings (length of proceedings and length of oral hearings in important cases). The Federation was invited to the hearing on the Rules of Procedure in Trier on 26 November, and Bobby Mukherjee and Alan Johnson attended. They intervened on each of the five issues mentioned above, expressing support for those changes made to the 17th draft which were in line with the Federation's position (first second and fifth points above), and reiterating its position on the third and fourth points.

In addition, the Federation responded to two consultations on the UPC during 2014.

The first was PP 7/14, submitted on 24 July 2014 in response to the consultation on the proposals by the Legal Working Group of the Preparatory Committee on the draft European Patent Litigation Certificate (EPLC), closing on 25 July 2014.

The second was PP 9/14 submitted on 2 September 2014 in response to the IPO's Technical Review and Call for Evidence on draft secondary legislation implementing the Unified Patent Court Agreement (UPCA) closing on 2 September 2014.

A delegation from the Federation also met with the UK IPO (Sean Dennehey et al) to discuss concerns about the ambiguities of Article 83 UPCA (transitional provisions). This issue has arisen again in sharp focus as a point of critical importance due to the inadequacies of the drafting of this key provision which determines the treatment of every single European patent in force when the system goes live. In short order, the key points are:

- Will the opt-out be effective, or will the UPC retain non-exclusive competence, including to revoke patents centrally?

- If patents are not opted out, what will be the effect on the ability to enforce in the UPC "torpedo" actions brought nationally under Article 83(1)?

The Federation's position is that these issues must be resolved, and that the first issue should be a "red-line" which should be clarified before the UK ratifies.

The most striking development during the year when looked at overall, has been the slowing down of the timetable toward a start-date. When the UPCA was signed (February 2013), the Commission optimistically stated that the new system would be up and running in early 2014. The (then newly-formed) Preparatory Committee put back this date to early 2015. Since then it has adjusted the date to not before the end of 2015. Recent pronouncements suggest an intention to have the system ready to start by April 2016.

One reason for the slower than hoped for progress is the IT system. Latest estimates are that it will be put out for tender in February 2015, and the contract placed in July 2015 with a view to the system being supplied ready for use by 1 January 2016. It is widely believed, however, that this timetable is optimistic, and this is one of the reasons why late 2016 is generally regarded as the earliest likely date for the system to go live, and that 2017 may be more realistic.

Another reason for uncertainty as to timing of the start date is the progress on ratification by the UK and Germany (both ratifications are mandatory for the system to start - the other mandatory country, France, ratified in March 2014). Early indications were that the UK would ratify (if not deposit its instrument of ratification) before the General Election in April 2015. However, this target has been put back, in large measure by the requirement to negotiate and agree a hosting agreement for the UPC. This, it is understood, will have to be a multilateral agreement rather than a bilateral one, and will add an uncertain amount of delay. Potentially more serious, however, is the position of Germany. It is understood that Germany is unlikely to ratify until proper costings for the system are available.

Another source of delay is the EPO. Whilst proposals on fees for unitary patents were expected in May 2014, nothing has emerged, and rumours suggest that it may be at least June 2015 before any proposals are forthcoming. If so, this will cause enormous problems for companies attempting to set budgets including unitary patent protection. Likewise, nothing has been said about the distribution key allocating fees among participating states. This, it may be recalled, was one of the two main stumbling blocks which caused the (then) Community Patent system to fail in 2004, despite political agreement under the so-called "Greek Compromise" of March 2003. There is even a possibility, therefore, of history repeating itself. At best, this may take very many more months to resolve, and it is possible that June 2015 may be optimistic.

Likewise, there is no news on Court fees, although there is more hope that some news may be forthcoming in early 2015. When opt-out fees will be announced and the order of magnitude these may be set at is not yet known.

It had also been hoped 12 months ago that by now some news would be available about the identity of the body of UPC judges. Expressions of interest were received from 1300 candidates in November 2013. In September 2014, the candidates received notification of the Preparatory Committee's view on their suitability, but there is no public list of those who received a positive indication, still less that a process for their appointment has begun. One very difficult issue (difficult constitutionally for some countries) is the question of part time legal judges who also continue in private practice. This issue needs to be resolved, but it is unclear how it can be.

The training of judges is another issue about which the Federation has expressed concerns. It appears that at least a number of judges (perhaps about 25) will be required from countries which currently have little or no patent litigation, and these judges will be given training in basic patent law by ERA. The course offered is a relatively simple six day course.

There is no news as yet about training of

candidate judges in language skills.

As we reported last year, there also remains one other major obstacle in the way of the whole dossier, which is what has become known as the "second Spanish challenge" (strictly two challenges - one to each of Regulations 1257/2012 and 1260/2012). The thrust of the challenges is that the Commission has over-stepped its authority in delegating powers to the EPO (in breach of what is known as the *Meroni* principle) and that the Regulations lack legal basis. On this second point, it is notable that one argument espoused by the Commission as to why the infamous Articles 6-8 were required was indeed to give proper legal basis to the Regulations. With their deletion (at David Cameron's insistence so as to avoid increased CJEU interference in patent law) the legal basis clearly became more shaky. The replacement provisions were described in a meeting of the European Parliament's Legal Affairs Committee which took place behind closed doors as "sub-sub-sub optimal", but in public the position taken by all EU officials and politicians is that the legal basis is adequate. Hence the Commission's position is that the second Spanish challenge will fail. Further, could it really be that the CJEU would strike down as unlawful a dossier which has taken 50 years to agree, whatever the legal merits of the challenge? A preliminary positive clue to the Court's decision was received on 18 November 2014 when the Advocate General's opinion was released, advising the Court that the Spanish challenges should be rejected on all counts. Hence, the most probable outcome would seem to be that the challenge will fail, and what will be most interesting is whether in the process (as many suspect) the CJEU will take the opportunity to assert that it has just as much right to review and interpret patent law as it had when Articles 6-8 were present. If so, this will send further shudders down the spine of industry, given the CJEU's dubious track record in areas such as trade mark law. The decision itself is expected to be handed down in spring or early summer 2015.

On the more positive side, further clarity has emerged in 2014 as to the number and location of UPC local and regional divisions which may be created. Local

divisions are expected in the UK, Germany, France, Italy, the Netherlands, Belgium, Denmark, Finland, Eire, and Austria. Regional divisions are expected to be formed by at least three groups of countries, namely: Sweden and the Baltic countries; the Czech Republic and Slovakia; and Romania, Bulgaria, Greece and Cyprus (and possibly Slovenia). Most of these divisions will designate English among their languages (even the German and French local divisions according to latest information). Germany is still proposing to have four local divisions, but despite lobbying, the UK appears likely to have only one. In total, therefore, there might therefore be 16 or more local and regional divisions, with all but one or two operating partly or exclusively in English,

in addition to the three parts of the central division. Since each division will need at least one panel of three judges, taken together with the Court of Appeal, which will sit in panels of five, and the inevitable requirement for multiple panels in each of the three central division seats, this suggests the need for upwards of 100 legal judges, and probably at least as many technical judges so as to cover different disciplines.

Finally, the Federation congratulates Tim Frain (Nokia) on his appointment to the expert panel advising the Preparatory Committee. The other representative of European industry is Udo Meyer (Germany).

Alan Johnson, 8 December 2014

European Patent Office update

The Federation has engaged with the European Patent Office (EPO) throughout 2014 to provide input on matters relating to implementing and ancillary regulations to the European Patent Convention (EPC) and to procedures of the EPO. The Federation represents the Confederation of British Industry (CBI) (as a member of BUSINESSEUROPE) on the Standing Advisory Committee of the EPO (SACEPO) through which the EPO undertakes user consultation in the development of the European patent system. In addition, the Federation maintains ongoing working relationships with EPO representatives including meetings with the President and Directors throughout the year.

Procedural Developments

The end of handwritten amendments

2014 saw the introduction of a number of procedural changes at the EPO that generally reflect a move towards a less paper-based way of working. The changes were led by a discontinuation of the EPO practice of accepting handwritten amendments to documents replacing parts of a European patent application (OJ EPO 2014, 603). The implementing regulations have always required that the description, claims and abstract of a patent application (and amendments) are typed or printed (Rule 49(8) and Rule 50(1) EPC), though it had been accepted practice to admit handwritten amend-

ments, in particular in oral proceedings. The new strict application of Rules 49(8) and 50(1) EPC came hand-in-hand with a promise of more support for applicants at oral proceedings to ensure compliance. Such support was to include: kiosk PCs; improved Wi-Fi; printing facilities; administrative support to users when typed amendments must be prepared; support for downloading, formatting A and B publications and for inserting amendments and producing clean copies; a possibility to file submissions electronically including the possibility to file submissions via e-mail during all oral proceedings (not only videoconference). As 2014 progressed it became clear that the support was in fact limited to the provision of communal computers and printers. It has been the experience of Federation members that preparing typed amendments at oral proceedings is overly burdensome and can actually lead to mistakes. The EPO response has been to informally temper the requirement by encouraging EPO staff to continue to accept handwritten amendments during oral proceedings subject to filing formal typed amendments soon after, though even this is inconsistently applied by the EPO and applicants are currently left with the extra burden. The Federation continues to advance the concerns of applicants and representatives for whom this change has become an unacceptable hurdle in

addition to all other challenges to be expected at oral proceedings.

Early certainty from search

According to the EPO, the average time to receive an EPO search (for European and International applications) is 15 months. In the spring of 2014 the EPO announced a new initiative, "early certainty from search", through which the EPO aims to reduce the average time to receive a search to 6 months for all European first-filed applications and for international applications using the EPO as search authority and being filed at the EPO as receiving office. The initiative is understood to have been implemented in July 2014 and the EPO has acknowledged that it has required a change in the priorities of EPO examiners. Examiners are now being encouraged to focus on new searches (for applications received from July) leading to an inevitable backlog of applications awaiting search just before implementation of the new initiative. The initiative is also supplemented by a new procedure whereby examination of a European application is accelerated where "non-anonymous and substantiated" third party observations are received by the EPO. Notably, non-anonymous includes observations by a 'straw-person' and the degree of substantiation is merely a statement of a substantive issue along with an argument and/or evidence.

Attestation of the commencement of search and examination

The EPO has implemented a new procedure by which the commencement of search and examination is now indicated in the patent register. When a search or examination is started, an indicator with a start date is generated and made available in the public part of the file. After publication this information is open to file inspection via the Patent Register. Before publication it is available only to the applicant.

New electronic Case Management System

The EPO has been trialling a new online file handling system, the Case Management System (CMS), for some time, and 2014 saw the system launched for general use (OJ EPO 2014, A97). The system is entirely web-based (requiring no special

software installation) though is currently limited to the filing of European applications, entry into the European phase for international applications, subsequently filed documents (such as responses to examination reports) and the filing of a notice of opposition. CMS cannot be used for filing documents in respect of appeal proceedings. Further, patent applications filed using CMS cannot be initially received at a national office, as may be necessary to satisfy security requirements (e.g. Section 22 of the UK Patents Act). The EPO's increasing investment in, and promotion of, CMS brings into question the future of the existing EPO online filing software for which many users are trained and experienced. There would be a considerable cost for applicants and their formalities departments to transfer to new online filing software. It is currently not clear whether EPO online filing software is to be phased out and, if so, when.

PCT direct

From 1 November 2014 the EPO has offered a new facility linking first filings at the EPO (European patent applications) with subsequent PCT applications having the EPO as search authority. The facility, known as "PCT direct", allows applicants filing the subsequent PCT application to also file submissions (amendments and/or arguments) in the form of a reply to the search opinion of the former application. The EPO will then take these submissions into account when preparing the international search report, offering a new opportunity to emphasise any differences between the former European and subsequent PCT applications. On the whole, PCT direct is welcomed as a further opportunity to achieve a positive opinion in the international phase, though it is noted that the EPO has previously neglected to consider differences between (especially the claims of) former European and subsequent PCT applications which would have led to the same result.

Wi-Fi at EPO premises

It has long been the experience of Federation members that access to Wi-Fi facilities at the EPO has been sporadic and often impossible. Even where a Wi-Fi connection can be established, the connection is restricted and prevents communication with corporate networks over

VPN connections and the like. With the new emphasis on typed amendments at oral proceedings the need for network access has only increased. The Federation worked with the EPO during 2014 to request the implementation of a more effective and appropriate Wi-Fi offering for applicants and representatives on EPO premises, and from October 2014 a new Wi-Fi service has been provided at the EPO in Munich and The Hague. The new service involves tokens issued by the EPO and allows seemingly unfettered internet access including VPN access to corporate networks.

Payments to the EPO

From 1 April 2014 the EPO abolished the administrative fee for insufficient funds in a deposit account (as part of the revision of the arrangements for deposit accounts, OJ EPO 2014, A26). The abolition of the administrative fee means that deposit account holders are no longer able to assure payments are made to the EPO when there are insufficient funds in a deposit account. The EPO indicated that this change is occasioned because the administrative fee overlapped with fees for further processing, though it is noted that the process and provisions for further processing are wholly different and unrelated to the process and provisions for executing a payment per se. Following the abolition of the administrative fee it is very difficult to make instantaneous payments to the EPO, except perhaps for applicants holding a German bank account. Further, since it is not possible to readily query the exact balance of a deposit account in real-time, applicants cannot be certain of whether an account has adequate funds. To temper these concerns the EPO has indicated that they will, in future, accept new methods of payment including direct debiting from Euro bank accounts using SEPA (Single European Payment Area) and payment by credit card. It is noted, however, that payment by credit card will only be possible via the new case management system (CMS).

Symposium on Article 123(2) EPC

In February 2014 the EPO hosted a Symposium dedicated to the EPO's practice in the application of Article 123(2) EPC. The symposium was attended by representatives of the Federation who contributed

across a number of technical fields to identify inconsistencies in the EPO's approach and to highlight particularly problematic applications of the provisions, especially in the field of chemistry. Examples of problems were shown to arise in relation to selections from lists, combining from dependent claims, and deleting options which might lead to a charge of singling out new matter. The approach of the EPO in some cases can drive patent attorneys to draft longer, and thus more expensive, specifications. The EPO was receptive to the feedback and indicated an interest in amending the Guidelines for Examination, which they subsequently did in the 2014 revision. Already the 2013 revision of the Guidelines was clarified to emphasise that Article 123(2) EPC does not require literal support of the amendment in the application as filed. From 2014, further amendments were made to Section H of the guidelines. Section H-IV 2.3 was amended to recite:

When assessing the conformity of the amended claims to the requirements of Art. 123(2), the focus should be placed on what is really disclosed to the skilled person by the documents as filed as directed to a technical audience. In particular, the examiner should avoid disproportionately focusing on the structure of the claims as filed to the detriment of the subject-matter that the skilled person would directly and unambiguously derive from the application as a whole.

Section H-V 3.2.1 was amended to recite:

These conditions should be understood as a help for assessing, in the particular case of an intermediate generalization, if the amendment fulfils the requirements of Art. 123(2). In any case it has to be assured that the skilled person is not presented with information which is not directly and unambiguously derivable from the originally filed application, even when account is taken of matter which is implicit to a person skilled in the art using his common general knowledge.

Section H-III 2.1 was amended to recite:

When filing amendments, the applicant must identify them and indicate the basis for them in the application as filed. This requirement should be understood as an opportunity for the applicant to provide convincing arguments to the division as to why the amendment(s) is/are directly and unambiguously derivable from the application as filed. These arguments will be

taken into account by the division for the assessment of Art. 123(2). They are particularly important for the outcome of the division's assessment where literal support for the amendment(s) is not present in the application as filed.

These amendments to the guidelines are seen as a positive step though it remains to be seen if they lead to any improvement in consistency of application of Article 123(2) EPC by the Boards of Appeal.

Changes to the Implementing Regulations to the EPC

This year saw a number of changes to the implementing regulations to the EPC.

Rules 36 and 38 EPC - divisionals

Changes to the rules relating to the filing of divisional applications came into force on 1 April 2014. The requirements for filing a divisional application are now only that the earlier application is pending. There is an additional fee for the filing of divisional applications of a second or subsequent generation patent application (new Rule 38(4) EPC and Article 2(1b) of the rules relating to fees).

Rule 6 EPC - reduction of fees

Changes to the rule relating to the filing of translations and the reduction of fees came into force on 1 April 2014. The new Rule 6 EPC provides only for a reduction of the filing fee and the examination fee, and such a reduction is now only available to SMEs, natural persons, non-profit organisations, universities and public research organisations. The reduction itself in Rule 14(1) of the rules relating to fees is increased from 20% to 30%.

Rule 103 EPC - reimbursement of appeal fees

Changes to the provisions for the reimbursement of appeal fees came into force on 1 April 2014. The new Rule 103 EPC provides for the reimbursement of 50% of the appeal fee when an appeal is withdrawn after the filing of a statement of grounds of appeal or expiry of the four-month period for filing that statement, provided that the withdrawal occurs: at least 4 weeks before a date of oral proceedings (where oral proceedings are scheduled); or where oral proceedings are not scheduled, before the expiry of the period set by the board for filing

observations; or where there is no invitation to file observations, before the decision is issued.

Rule 164 EPC - unity

Changes to the provisions relating to searches for applications considered by the EPO to lack unity came into force on 1 November 2014. The rule change affects PCT applications entering the European regional phase whose first examination report or supplementary search report was not drawn up by 1 November 2014. Where the EPO was the search authority for an application, the EPO will invite the applicant to have additional inventions searched if it identifies a lack of unity in the supplementary search carried out on regional phase entry. Where the EPO was not the search authority for an application, if the EPO notices at the start of examination that some of the claims relate to subject matter not searched during the international phase, the EPO will invite the applicant to have this subject matter searched.

Proposed change to Rules 125 and 126 EPC - notifications

The EPO is finalising its proposal to change the provisions relating to notification in Rules 125 and 126 EPC to cover the use of private postal services and to extend the "10 day rule" of Rule 126(2) EPC to electronic notifications. The EPO has also confirmed that failed electronic notification would not be followed by public notification without first attempting written notification. The timeframe for introduction of the change is not yet clear.

Proposed change to Rule 147 EPC - preservation of files

In September 2014 the EPO outlined proposed changes to Rule 147 relating to the preservation of files. Currently, the EPO scans printed materials for patent applications and incorporates scanned copies in an electronic filing system. This file system is used to provide the online register. Under Rule 147(3) EPC documents incorporated in an electronic file are considered to be 'originals'. The paper versions (referred to, by the EPO, as 'blueprints') are, therefore, no longer 'originals' when scanned. Blueprints are currently retained by the EPO for the maximum retention period of 30 years.

The EPO proposes to amend Rule 147 to reduce the time period for retaining the blueprints, with a proposal to reduce this to 2 years. While scanned documents may be considered 'originals' under Rule 147 EPC, the practical reality is that scanning is not infallible, and there can always be

a prospect of referring to blueprints where scanned documents are illegible or corrupted. In this regard a change to a 2 year retention period would seem to be far too short.

Scott Roberts, 7 November 2014

TRADE MARKS

Trade marks update

This update summarises the main trade mark judgments of the Court of Justice of the European Union from the last twelve months. Although perhaps none is radical, certain provide useful legal and practical guidance, whilst others lay the ground for potentially interesting national decisions.

The judgments have been classified into four broad categories: (i) those relating to exotic marks; (ii) two decisions with important practical consequences for brand owners; (iii) two judgments which consider "unfair advantage taking"; and finally (iv) two decisions considering the admissibility of evidence submitted out of time to OHIM.

Exotic Marks

Technology giant Apple applied for a German 3D mark showing the layout of its retail store¹⁶.

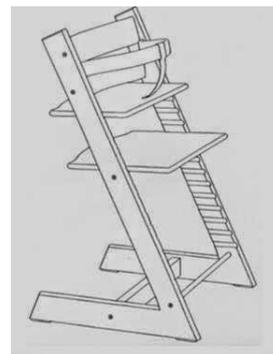


Apple had obtained an equivalent US mark, but the German registry rejected its application. Apple accordingly applied to the CJEU for a preliminary ruling on the issue. The CJEU held that a mark for the layout of a retail store is, in principle, registrable, provided that it distinguishes the goods of one undertaking from those of another, for example because the depicted layout departs significantly from the norm or customs of the economic sector concerned. Such a

¹⁶ Apple Inc v. Deutsches Patent- und Markenamt [2014] EUECJ C-421/13,

mark can be registered both for the goods sold by the retailer and for services that do not form an integral part of the offer for sale of those goods, such as educational services, if demonstrations or seminars will be given in the store.

A 3D mark was also at issue in the dispute between the children's furniture manufacturers Stokke and Hauck, namely Stokke's mark for its "Tripp Trapp" highchair¹⁷.



In the underlying proceedings in Holland, the first instance court had found that "the attractive appearance of the chair gave it a substantial value and that its shape was determined by the very nature of the product - a safe, comfortable, reliable children's chair". It therefore found the mark invalid pursuant to Article 3(1)(e) of the old trade marks directive¹⁸, which establishes that certain signs are not registrable as marks, including those which consist exclusively of any shape which results from the nature of the goods themselves or which gives substantial value to the goods. The case was referred to the CJEU.

¹⁷ Hauck GmbH & Co KG v Stokke A/S [2014] EUECJ C-205/13

¹⁸ Directive 89/104/EEC. Repealed by Directive 2008/95/EC which contains an equivalent provision.

Amongst other findings, the CJEU held that the prohibition against signs which consist exclusively of a shape which results from the nature of the goods themselves was relatively broad. In particular, it was not limited only to “natural” products (said to be those which have no substitute) and “regulated” products (or those whose shape is prescribed by legal standards). It could also cover a sign “which consists exclusively of a product with one or more essential characteristics which are inherent to the generic function or functions of that product and which consumers may be looking for in the products of competitors”. It will be interesting to see how this is applied by the Dutch courts, but it would seem that the Tripp Trapp’s essential characteristics are inherent to its functions of being a reliable, safe and comfortable children’s chair.

The third decision relates to a colour mark¹⁹. DSGV, a German bank, owns a German contourless red colour mark in respect of various retail banking services, which it obtained in 2006, having submitted evidence to the German registry showing that its mark (i.e. the colour red for retail banking services) had a degree of acceptance of 67.9% in the trade circles concerned. It brought infringement actions against Oberbank, another German bank, and Santander, who responded with counterclaims for invalidity. Santander is, of course, well known in Spain and the UK for having a red logo, but is a comparatively new entrant to the German market. DSGV, on the other hand, has been operating in Germany since the 1960s.

The German Federal Court referred various questions to the CJEU. First, German law required applicants for colour marks to show that - by the time of the proceedings - at least 70% of the relevant consumers recognised the colour as being the sign of the undertaking in question. The CJEU, siding with the arguments of the UK government, the Commission and DSGV, but against those of the Spanish and Polish governments, held that such a pre-condition for registration is unacceptable, even if

¹⁹ Oberbank and others v. Deutscher Sparkassen- und Giroverband eV [2014] EUECJ C-217/13 and C-218/13

national registries may refer to opinion surveys where they have had particular difficulty in assessing the distinctive character of a mark. Secondly, Article 3(3) of the Trade Marks Directive²⁰ allows Member States to exercise an option to allow applicants to rely on evidence of acquired distinctiveness obtained after the filing date of the mark. The UK has exercised this option. Germany, however, has not. The CJEU held that the relevant date for assessing acquired distinctiveness in such states, is therefore, the date of filing of the trade mark. For DSGV, this means acquired distinctiveness will be assessed as at 2002.

Decisions with Practical Relevance to Brand Owners

Martin Blomqvist v. Rolex SA²¹ is significant for all brand owners threatened by counterfeiters. It confirms that Customs officials may seize any counterfeit goods sold to a customer in a Member State, even where the customer has bought the goods for his or her personal use and where the seller was not directly advertising to customers based in the EU. Mr Blomqvist, a Danish resident, purchased a watch described as a Rolex from a Chinese online shop. The watch was shipped from Hong Kong and seized by Danish Customs. Rolex demanded the destruction of the counterfeit watch but Mr Blomqvist refused to consent, claiming that he had purchased it legally. As Mr Blomqvist had bought the watch for personal use, he was not liable for copyright or trade mark infringement under local law.

The CJEU did not agree. It held that where goods are sold to a resident in a Member State through an online sales website in a non-member country, the rights holder will enjoy the protection afforded under EU law to those goods at the point when they enter the territory of the Member State merely by virtue of their acquisition. It is not necessary, in addition, for the goods to have been the subject, prior to the sale, of an offer for sale or advertising targeting consumers based in that state.

A second case provides a useful reminder of the need for trade mark owners to guard against their marks becoming

²⁰ Directive 2008/95/EC

²¹ [2014] EUECJ C-98/13

generic²². The claimant produced and sold its baking mix to bakers under the mark "KORNSPITZ". These bakers rarely made it known to consumers that the sign used to designate the product was a registered trade mark. The defendant, a competitor, applied to revoke it, on the ground that "Kornspitz" was a common name for the product, namely an oblong bread roll with points at both ends.

Under Article 12(2)(a) of the Trade Marks Directive²³, a mark can be revoked when it has become the common name for a product or service as a result of the acts or inactivity of the proprietor. The key issue was whose view matters - that of traders or the end users? The CJEU held that whilst the view of traders was important, the view of the end user of a product was decisive. Further, the court found that if a trade mark owner does not encourage sellers to make more use of the mark in marketing a product, this may be interpreted as "inactivity". Finally, it is irrelevant when assessing if a mark has become generic, whether there are alternative names for the product or service in question.

The CJEU noted that the concept of "inactivity" encompassed all activity, or inactivity, by which the trade mark owner showed that he is not sufficiently vigilant as regards the preservation of the distinctive character of his mark. Whilst each case will depend on its facts, it was stated that "inactivity" goes further than deciding not to sue for infringement.

Unfair Advantage Taking

Environmental Manufacturing LLP v OHIM and Société Elmar Wolf²⁴ involved a figurative mark representing a wolf's head for waste processing machines. The proprietor of figurative marks for "WOLF jardin" and "Outils WOLF" opposed the application. The Board of Appeal agreed that the mark applied for might dilute the unique image of the earlier marks and take unfair advantage of their distinctive character or reputation. On appeal, the claimant argued the other side had not shown sufficient proof of a change (or

serious likelihood of such change) in the economic behaviour of the average consumer of the goods protected by the earlier mark. The CJEU held that detriment "cannot be established" without such proof. Even if actual detriment does not need to be proved, at a minimum "the serious risk of such detriment" must be demonstrated. Showing such a risk cannot be done on the basis of "mere suppositions", but must be, in line with previous cases²⁵, "founded on an analysis of the probabilities and by taking account of the normal practice in the relevant commercial sector as well as all other circumstances of the case". The CJEU set aside the judgment of the General Court and referred the matter back to it.

A second case focussed on an exception to unfair advantage taking, namely where the alleged infringer has "due cause" for its behaviour²⁶.

Red Bull is the owner in the Benelux countries of the word and figurative mark "Red Bull Krating - Daeng", registered on 11 July 1983, for various goods including non-alcoholic drinks. Mr de Vries is the proprietor in the Benelux countries of: (i) the word and figurative mark "The Bulldog" registered on 14 July 1983; (ii) the word mark "The Bulldog" registered on 23 December 1999; and (iii) the word and figurative mark "The Bulldog Energy Drink" registered on 15 June 2000. It was common ground that Mr de Vries had used the sign "The Bulldog" in relation to hotel, restaurant and café goods and services, including the sale of drinks, before the Red Bull mark had acquired its reputation. Red Bull brought an action in Holland, seeking to prevent Mr de Vries from producing and marketing energy drinks labelled "The Bulldog" or otherwise with the word "Bull".

Did Mr de Vries have "due cause" for his use of "The Bulldog", given his earlier use? The CJEU held that the concept of "due cause" was not limited only to objectively overriding reasons. The referring court must take into account: (i) how the defendant's sign has been accepted

²² Backaldrin Österreich The Kornspitz Company v Pfahnl Backmittel GmbH [2014] EUECJ C-409/12

²³ Directive 2008/95/EC

²⁴ [2013] EUECJ C-383/12

²⁵ e.g. Citigroup and Citibank v. OHIM [2008] ECR II-669.

²⁶ Leidseplein Beheer BV and Hendrikus de Vries v Red Bull GmbH and Red Bull Nederland BV [2014] EUECJ C-65/12

by, and what its reputation is with, the relevant public; (ii) the degree of proximity between the goods and services for which the sign was originally used and the product for which the mark with a reputation was registered; and (iii) the economic and commercial significance of the use for that product of the sign which is similar to that mark. The CJEU commented that Mr de Vries's sale of energy drinks might not be an attempt to take advantage of Red Bull but might be a genuine extension of his brand.

Late Filing of Evidence

The CJEU considered late filed evidence in two cases. In the first, it admitted late evidence of genuine use of the mark. The trade mark owner had filed some initial evidence within time, and when doing so, had offered to provide the further information which it then sought to rely on (out of time) following OHIM's

rejection of its application²⁷. On the other hand, in *Rintisch v OHIM*²⁸, the CJEU ruled that although OHIM does have discretion to admit late-filed evidence, in the circumstances, the additional evidence was inadmissible. Mr Rintisch had filed an application of opposition on the basis of earlier registered rights. After the Board of Appeal found his initial evidence was insufficient, he tried to submit further documents. He had, however, been in possession of the additional documents six months before the expiry of the time limit and had not explained why he had withheld them.

Kate Swaine, Alice Stagg and Rebecca Ward, Wragge Lawrence Graham & Co LLP, 7 November 2014

²⁷ *Centrotherm Systemtechnik GmbH v OHIM and Centrotherm Clean Solutions GmbH* [2013] EUECJ C-609/11

²⁸ [2013] EUECJ C-121/12

UK ISSUES

The UK Intellectual Property Office

The IP attachés initiative

An important initiative by the IPO a couple of years ago was the appointment of IP attachés to support UK businesses in China, India, Brazil, and Singapore (for South East Asia). The IP attaché network is managed and funded by the Intellectual Property Office (IPO) and supported in country by the Foreign & Commonwealth Office and UK Trade & Investment (UKTI).

In an evaluation of the IP Attaché Programme this year, it was confirmed that the IP attachés provide a focal point in host countries for supporting UK businesses with IP-related issues. They also promote UK government interests and work with local intellectual property right enforcement agencies. They help to build IPO relations with the governments of host countries, and to understand and actively engage with IP policy makers.

The attachés help businesses navigate the complex IP landscape in their individual markets, building knowledge in the IP community, supporting UKTI in advising businesses, and helping support individual business cases where possible. This support is highly valued by business users

and UKTI alike with 79% of business users rating their interactions with the attachés as valuable. This is particularly true as no similar source of centralised expertise was previously available. UK businesses are able to make decisions more confidently and better protect their IP with the attachés in place, and in many cases money, jobs and time have been undeniably saved or protected - and in some cases revenue is even going up.

The main area for improvement the review revealed is around communicating the attachés' remit. As the programme succeeds in many areas, stakeholders want more. Providing a clearer understanding of what the attaché network is and what it can and cannot do will clarify for service users and government colleagues what they can expect and what services must be obtained elsewhere. As such, key recommendations are:

1. Communicating the exact attaché remit will help alleviate frustrations.

Clearly understanding the programme scope and aims is key to user satisfaction. Knowing exactly what is

within the remit of the Attaché Programme is essential as expectations of the programme are high and sometimes unrealistic.

2. Feeling informed makes people value the programme more.

Ensuring information is communicated proactively, in a timely manner would make stakeholders feel even more positively about the programme (and its capabilities). Not having to chase the attachés for responses or information is highly important. Providing prepared information could also cut out the attaché as a 'middle man' between UKTI colleagues and UK businesses, in terms of providing commercial answers - and would likely save time for the attaché as well.

3. A clear schedule of market IP 'updates' would help alleviate the sense that the programme is reactive.

Giving IPO colleagues a structured reporting style to help develop their knowledge, covering specific market and industry advances, developments and resolutions of issues is desired.

Although many businesses and policy representatives openly acknowledge and appreciate receipt of newsletters from the Chinese attaché, proactive information sharing even from China isn't always cutting through. Some feel the attachés only make contact if responding to particular issues being brought to them by IPO colleagues.

4. The IPO should also consider whether expanding services in a single market or offering an additional market for coverage is feasible at this time, as it would certainly be welcome.

A schedule of new market rollouts or additional hires would help service users anticipate changes and upcoming support.

5. Finally, in terms of succession planning, the IPO needs to have a plan in place for when the individual attachés move on.

Any handover should be proactively

addressed with service users. Bridging gaps, for example with dual attachés (current and new) in market in transition periods, and making proactive introductions would help address any potential concerns.

Patent reform

Patent reform is often a euphemism for a liberalising agenda - aimed at weakening IP rights, and undermining enforcement measures.

In Europe policy makers have a somewhat schizophrenic take on IP. In their eyes, patents sit uneasily alongside academic, theoretical, unsubstantiated competition principles. On the one hand, EU lawmakers trumpet the introduction of the wonderful new unitary patent system - aimed at making patenting and enforcement cheaper and more efficient across the EU. At the same time the European Commission frowns when you actually go to court and enforce your patents, seeing it as some kind of abusive, anti-competitive behaviour. This is what we are experiencing in the telecoms sector right now. There are influences in Brussels that even regard traditional patent licensing as a 'dirty business'. Yet again other parts of the Commission have projects on "valorising" IP, optimising value extraction from patents.

Fortunately, in the UK the IPO recognises the value of IP and licensing and has been involved in some excellent research work to understand the contribution IP licensing makes to the UK economy. We would urge the IPO to carry this pro-IP, pro-innovation message to Brussels. In Europe, as we contemplate patent reform for the 21st century, we still have an uphill struggle to promote the value of IP, patents and licensing - vital components of the innovation and growth agenda.

Transitional provisions for the repeal of section 52 of the CDPA

The repeal of section 52 of the Copyright Designs and Patents Act 1988 will remove a permitted act in law which reduces the term of copyright protection for artistic works that have been industrially manufactured. The Government ran a consultation from 15 September to 27 October 2014 to hear views on when to implement the repeal of section 52 of the Copyright, Designs and Patents Act (CDPA) 1988. This consultation gathered evidence on the

potential impact of the government's proposal to implement the repeal on 6 April 2018.

In our policy paper PP10/14, we indicated that the potential impact on UK Industry of the repeal of section 52 CDPA remains to be seen. The IP Federation commends the IPO on launching this consultation at this stage, and urges that any further proposed changes in this area are subject to a consultation process involving users of the IP system. It is crucially important for businesses (large and small) to be made aware of the proposed transitional provisions in good time in advance of the new law coming into effect (through targeted IP awareness workshops and education campaigns, for example), and for the subject provisions to be sufficiently clear so that users can understand the effect of the proposed legislative changes and operate competitively with sufficient certainty in a complex business landscape of IP rights.

Proposal to amend the marking provisions for registered designs

The IP Federation continues participation in the PPWG (the Patent Practice Working Group) and Marks & Designs Forum (MDF), and has been involved in extensive discussions on the bringing into force of the Intellectual Property Act 2014. On 1 October 2014 section 15 of the Act came into force to introduce a new measure as to how proprietors could mark patented products. Section 15 of the Intellectual Property Act 2014 amends section 62(1) of the Patents Act 1977 to provide for the marking of products with a relevant internet link. The internet link references a

posting on the internet where details of the relevant patents are listed. The internet link must be accessible to the public free of charge and must clearly associate the product with the relevant patent numbers.

As we indicate in our policy paper PP11/14, the IP Federation welcomes the changes introduced by section 15 of the Intellectual Property Act 2014 on the marking of patented products and would like these new measures extended to registered designs.

Extending the new marking provisions introduced by section 15 of the Intellectual Property Act 2014 to registered designs would benefit all those working in the design industry. Indeed, until the virtual marking provisions recently brought in for patents are extended to registered designs, the accepted benefits of virtual patent marking cannot be realised by IP owners and third parties because manufacturers will still need to mark their products with respect to registered designs, and third parties will need to look for information in separate places. The economic benefits of virtual marking will not be realised until the burden of physical marking is completely removed. Furthermore it would be extremely beneficial if proprietors could refer to a single internet link which lists details of all the relevant registered rights, patents and/or registered designs, pertaining to a particular product. A further advantage is that the introduction of these provisions would also simplify marking across territories.

David England, 5 December 2014

Future shape of education and training for the IP profession

At the end of 2013, the Intellectual Property Regulation Board (IPReg) put together draft Competency Frameworks for patents and trade marks for consideration and comment by the relevant professions in the UK, and launched a formal consultation on simplifying and modernising the examination system for qualifying as a UK patent attorney.

Comment on IPReg draft Competency Frameworks – Patents and Trade Marks

The draft Competency Frameworks were

published by the IPReg to encourage their use by the IP profession, with a view to providing a framework for training and development within the UK profession. So far, there has been no formal consultation on Competency Frameworks, nor have any plans been put forward by IPReg to make these draft Competency Frameworks (as published) compulsory.

In response (see policy paper PP05/14 – 19 May 2014), the IP Federation strongly supports IPReg's move to provide a clear

statement of skills and competency requirements for the training and qualification, and continued development, of patent and trade mark attorneys within the UK profession. Drawing from a unique in-house business IP perspective, the IP Federation recommends broadly having six core competency areas: - (a) technical skills, (b) building relationships, (c) trusted independent adviser, (d) people and team skills, (e) project management, and (f) personal skills.

IPReg Formal Consultation – Examination System for Qualification as a UK Patent Attorney

Launched in November 2013 for response in March 2014, this IPReg consultation was for simplifying and modernising the examination system for qualifying as a UK patent attorney.

The consultation proposed to remove stand-alone Foundation level examinations in favour of accredited Foundation courses as the only route into the profession and to withdraw P3 (Drafting) and P4 (Amendment) UK examinations, requiring instead that candidates pass the European Qualifying Examination (EQE) drafting and amendment papers or the EQE as a whole before entry on to the register.

The IP Federation response (policy paper PP03/14 - 17 March 2014) makes clear that the proposal to abandon the Foundation level examinations is misguided. The IP Federation objects to the proposal to abolish papers P3 and P4. Implementation of either of these proposals, in our view, may have a serious impact on diversity within the UK patent attorney profession; and in the case of the proposed abolition

of P3 and P4, we have a specific concern that IPReg would be removing crucial elements of its ability to fulfil its own regulatory objectives. The IP Federation response encourages IPReg to withdraw these proposals, and instead review the qualification system within the UK in a holistic manner, defining the purposes of the UK qualification to enable potential future changes to be made that are consistent with the needs of the public, the needs of the profession, and indeed IPReg's own objectives as defined by the Legal Services Board.

In our response, we further urge IPReg to reconsider the proposed minimum time service before qualification and the proposed STEM degree requirement.

Outcome of the Consultation

At the time of writing, IPReg has not yet published its response to stakeholders' submissions. This is eagerly awaited.

Conclusion

Following the launch of the consultation, the IP Federation has worked actively with IPReg and CIPA to raise awareness in this area (via webinar), so as to encourage the wider much-needed debate on education and training within the profession. Ultimately, our common aspiration is to establish a new blueprint for qualification as a patent attorney which is truly fit for purpose for business and for future generations to come. With this in mind, our policy paper (PP03/14) has been submitted and widely disseminated, and it is hoped that all the issues identified by us will be taken into account and addressed by IPReg.

Dr Bobby Mukherjee, 14 November 2014

IP FEDERATION BIOGRAPHIES

Carol Arnold, President

Carol is a UK Chartered Patent Attorney; a European Patent Attorney, and also an Associate Member of the Institution of Chemical Engineers. She has over 30 years of experience in patents, having joined the patent profession directly after gaining a degree in Environmental Chemical Engineering from the University of Exeter. Carol has represented Shell on the Council of the IP Federation since 2008, and in the past few years has also served as Chair of the IP Federation patent committee.



Carol has worked on a range of subject areas in the oil products, refining, pharmaceuticals, chemicals and agrochemicals sectors, and has lived and worked in both the UK and the Netherlands.

In life outside Shell, Carol is a Trustee of the charity Through the Roof, with particular responsibility for Wheels for the World (which restores and distributes wheelchairs and mobility aids overseas).

Carol also enjoys spending time with friends and family, travelling, playing field hockey and singing.

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' 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.

Gilly Webb, Administrative Assistant

Gilly Webb joined the IP Federation as a part-time Admin Assistant in June 2012.

She was born in Dorset but now resides in London. Gilly has three grown up children. She has been sitting as a magistrate for the past seven years in Central London, which she says she finds extremely humbling and rewarding.

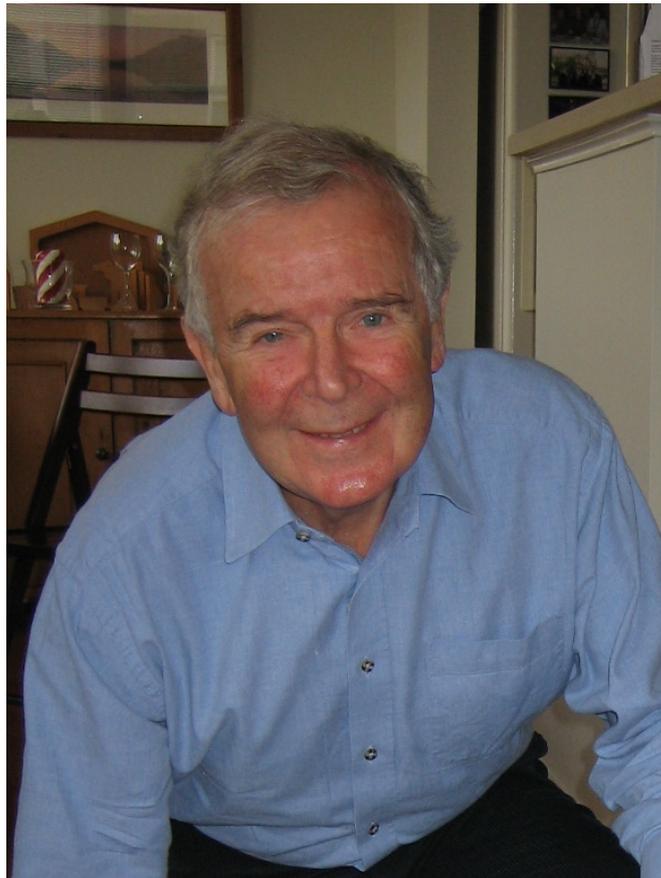


Some years ago Gilly did a law degree. One element of the degree was Intellectual Property which left her with a continuing interest in the subject. She enjoys travelling and two of her favourite locations are Cambodia and Vietnam. She takes an active interest in current affairs.



Presidents of the IP Federation (formerly the Trade Marks, Patents and Designs Federation)

1920-1930	Mr Gerard Clay
1930-1935	Mr John McDowell
1935-1947	Mr J. James
1947-1957	Mr W. W. Wigginton
1957-1966	Mr L. A. Ellwood
1966-1971	Mr Fyfe Gillies
1971-1973	Mr M. F. Coop
1973-1975	Mr J. M. Aubrey
1975-1977	Dr J. T. Tyson
1977-1979	Dr H. Aspden
1979-1981	Mr Ralph Walter
1981-1983	Mr D. O. Lewis
1983-1985	Dr J. L. Beton
1985-1987	Mr P. Orton
1987-1989	Mr T. N. Gibson
1989-1991	Mr D. H. Tatham
1991-1993	Dr R. F. Fawcett
1993-1995	Mr G. W. White
1995-1997	Mr F. N. Blakemore
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1999-2001	Mr J. M. Pollaro
2001-2003	Mr R. G. Broadie
2003-2005	Dr Michael Jewess
2005-2007	Dr Mike Barlow
2007-2008	Mr Tim Frain
2008-2010	Dr Roger Burt
2010-2012	Mr James Hayles
2012-2014	Dr Bobby Mukherjee
2014-	Mrs Carol Arnold



Dr Dick Fawcett, 1936-2014
President of TMPDF, 1991-1993



IP Federation members 2014

The IP Federation represents the views of UK industry in both IPR policy and practice matters within the EU, the UK 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.

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