

Maastricht University *Leading in Learning!*

IP Law in the Digital Single Market
Patent Law I

Prof. Dick van Engelen
24 September 2018

Maastricht University *Leading in Learning!*

Patent Law 1

- Legal framework
- Subject-matter
- Exceptions to patentability
- Requirements
- Scope of protection

Maastricht University *Leading in Learning!*

LEGAL FRAMEWORK

Maastricht University *Leading in Learning!*

Patent Law - Legal Framework

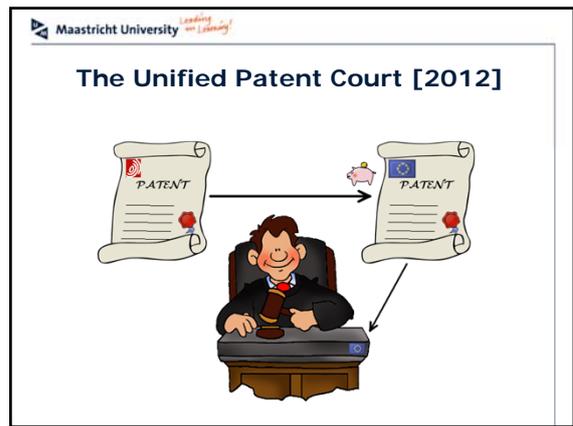
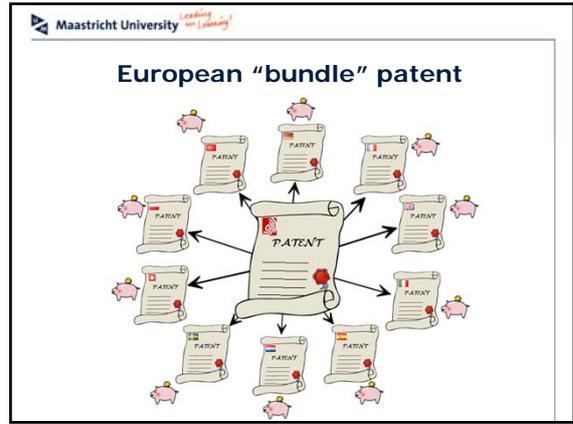
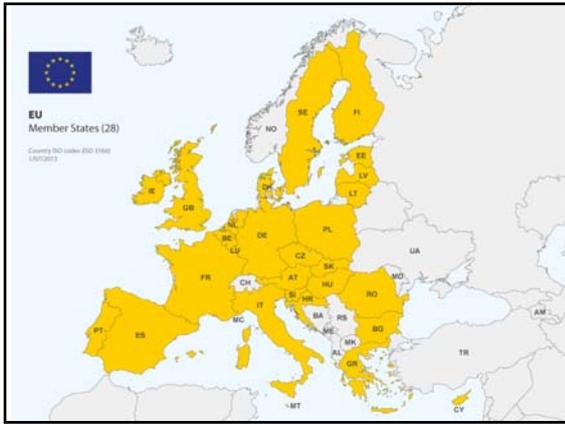
- TRIPs Agreement – WTO
 - Trade Related Aspects of IP Rights
- European Patent Convention
 - EU plus other countries
- EU law
 - Biotech directive
 - TRIPs law = EU law

Maastricht University *Leading in Learning!*

TRIPs Agreement (WTO)
164 member states

EPC

■ Member states (38)	Albania	Luxembourg
	Austria	Malta
	Belgium	Monaco
	Bulgaria	Former Yugoslav Republic of Macedonia
	Croatia	Netherlands
	Cyprus	Norway
	Czech Republic	Poland
	Denmark	Portugal
	Estonia	Romania
	Finland	San Marino
	France	Serbia
	Germany	Slovakia
	Greece	Slovenia
	Hungary	Spain
	Iceland	Sweden
	Ireland	Switzerland
	Italy	Turkey
	Latvia	United Kingdom
	Liechtenstein	
	Lithuania	
■ Extension states (2)		
	Bosnia-Herzegovina	
	Montenegro	
■ Validation states (1)		
	Morocco	





2013, *Daichi* decision

1. TRIPs = commercial aspects



2013, *Daichi* decision

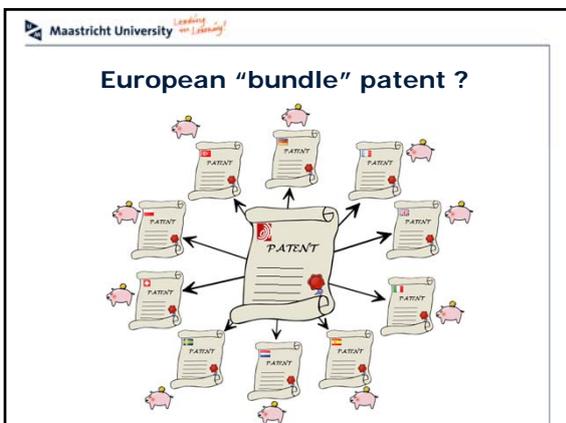
1. TRIPs = commercial aspects
2. Community patent legislation is no longer relevant



2013, *Daichi* decision

1. TRIPs = commercial aspects
2. Community patent legislation is no longer relevant

➔ **TRIPs patent law is now EU law !**



European Patent Convention

("EPC")

Maastricht University *Leading in Learning!*

Article 2 EPC

(1) Patents granted under this Convention shall be called European patents.

Maastricht University *Leading in Learning!*

Article 2 EPC

(2) The European patent shall, in each of the Contracting States for which it is granted, have the effect of and be subject to the same conditions as a national patent granted by that State, **unless this Convention provides otherwise.**

Maastricht University *Leading in Learning!*

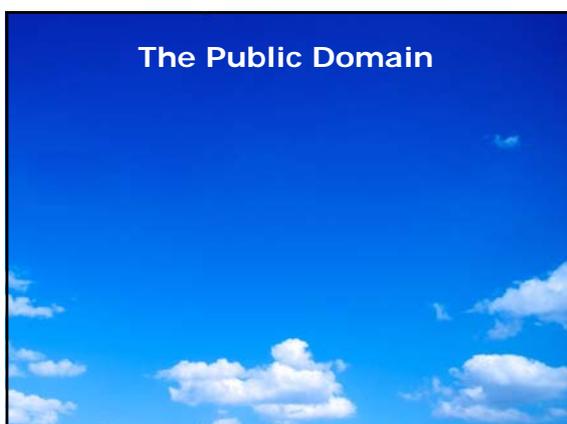
Patent Law 1

- **Legal framework**
- Subject-matter
- Exceptions to patentability
- Requirements
- Scope of protection

Maastricht University *Leading in Learning!*

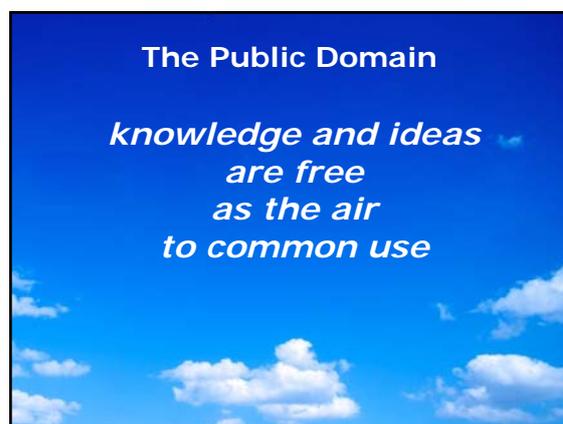
SUBJECT MATTER

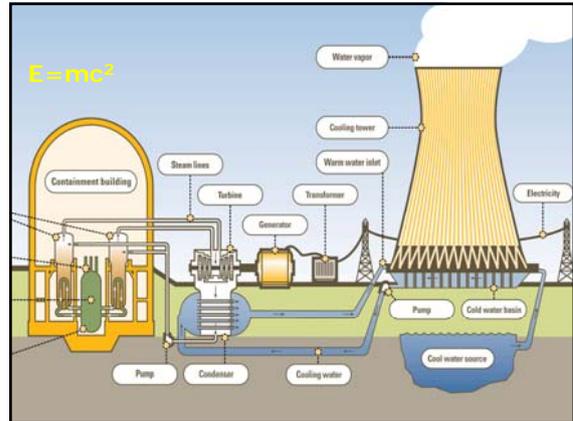
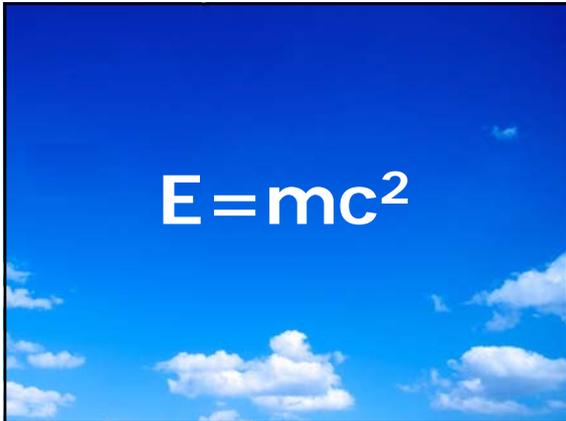
The Public Domain



The Public Domain

*knowledge and ideas
are free
as the air
to common use*





Maastricht University *Leading in Learning!*

TECHNOLOGY:
THE APPLICATION
OF KNOWLEDGE

Maastricht University *Leading in Learning!*

TRIPS

Maastricht University *Leading in Learning!*

Subject Matter – article 27(1) TRIPs

Patents shall be available for any inventions, whether products or processes, in all fields of technology, provided that they are new, involve an inventive step and are capable of industrial application.

Maastricht University *Leading in Learning!*

Subject Matter – article 52(1) EPC

European patents shall be granted for any inventions, in all fields of technology, provided that they are new, involve an inventive step and are susceptible of industrial application.

Maastricht University *Leading in Learning!*

Patent Law 1

- Legal framework
- Subject-matter
- Exceptions to patentability
- Requirements
- Scope of protection

Maastricht University *Leading in Learning!*

EXCEPTIONS TO PATENTABILITY

Maastricht University *Leading in Learning!*

TRIPS

Maastricht University *Leading in Learning!*

Subject Matter – article 27(2) TRIPs

Members may exclude from patentability inventions, the prevention within their territory of the commercial exploitation of which is necessary **to protect ordre public or morality**, including to protect human, animal or plant life or health or to avoid serious prejudice to the environment [...].

Maastricht University *Leading in Learning!*

Subject Matter – article 27(3) TRIPs

Members may also exclude from patentability:

(a) diagnostic, therapeutic and surgical methods for the treatment of humans or animals;

Maastricht University *Leading in Learning!*

Subject Matter – article 27(3) TRIPs

[...]

(b) plants and animals other than micro-organisms, and essentially biological processes for the production of plants or animals other than non-biological and microbiological processes.

Maastricht University *Leading in Learning!*

European Patent Convention

("EPC")

Maastricht University *Leading in Learning!*

Subject Matter – article 27(1) TRIPs

Patents shall be available for **any inventions**, whether products or processes, in all fields of technology, provided that they are new, involve an inventive step and are capable of industrial application.

Maastricht University *Leading in Learning!*

Subject Matter – article 52(2) EPC

The following in particular **shall not be regarded as inventions** within the meaning of paragraph 1:
[...]

Maastricht University *Leading in Learning!*

Subject Matter – article 52(2) EPC

- a) discoveries, scientific theories and mathematical methods;
- b) aesthetic creations;
- c) schemes, rules and methods for performing mental acts, playing games or doing business, and programs for computers;
- d) presentations of information.

Maastricht University *Leading in Learning!*

Subject Matter – article 52(3) EPC

Paragraph 2 shall exclude the patentability of the subject-matter or activities referred to therein only to the extent to which a European patent application or European patent relates to such subject-matter or activities **as such**.

Maastricht University *Leading in Learning!*

Patent Law 1

- **Legal framework**
- **Subject-matter**
- **Exceptions to patentability**
- Requirements
- Scope of protection

Maastricht University *Leading in Learning!*

REQUIREMENTS

Maastricht University *Leading in Learning!*

27(1) TRIPs & 52(1) EPC

1. new
2. involve an inventive step
[“non-obvious”]
3. capable of industrial application
[“useful”].

Maastricht University *Leading in Learning!*

29 TRIPs & 83 EPC

4. Enabling disclosure

Maastricht University *Leading in Learning!*

NOVELTY

Maastricht University *Leading in Learning!*

Novelty – article 54(1) EPC

An invention shall be considered to be new if it does not form part of **the state of the art**.

Maastricht University *Leading in Learning!*

Novelty – article 54(2) EPC

The state of the art shall be held to comprise **everything made available to the public** by means of a written or oral description, by use, or in any other way, before the date of filing of the European patent application.

Novelty – article 54(3) EPC

Additionally, the **content of European patent applications as filed**, the dates of filing of which are **prior to the date** referred to in paragraph 2 and which were published on or after that date, shall be considered as comprised in the state of the art.

Article 4A(1) Paris Convention

Any person who has duly filed an application for a patent [...] in one of the countries of the Union, or his successor in title, shall enjoy, for the purpose of filing in the other countries, a **right of priority** during the periods hereinafter fixed.

Article 4C(1) Paris Convention

The periods of priority referred to above shall be **twelve months for patents** and utility models, and six months for industrial designs and trademarks.

What not to do when considering filing a patent application

-  • **No publication** prior to filing
e.g. no article, press release, conference presentation/poster/proceedings or blog entry
-  • **No sale** of products incorporating the invention prior to filing
-  • **No lecture or presentation** prior to filing except under a **non-disclosure agreement (NDA)**
-  • **Seek professional advice soon!**
- **File before others do!**

NON-OBVIOUS

Inventive step - Article 56 EPC

An invention shall be considered as involving an inventive step if, having regard to the state of the art, it is **not obvious** to a **person skilled in the art**.

Maastricht University *Leading in Learning!*

"Person skilled in the art"

- an **ordinary practitioner** in a field of technology aware of what was **common general knowledge in the art** at the relevant date.
- be presumed to have had access to **everything in the "state of the art"**, in particular the documents cited in the search report, and to have had at his disposal the **normal means and capacity for routine work and experimentation**.

Maastricht University *Leading in Learning!*

Obvious

- that which does not go beyond the normal progress of technology but merely follows plainly or logically from the prior art, i.e. something which does not involve the exercise of any skill or ability beyond that to be expected of the person skilled in the art.



Maastricht University *Leading in Learning!*

INVENTIVE STEP TEST

PROBLEM SOLUTION APPROACH

Maastricht University *Leading in Learning!*

Problem solution approach

1. determining the "closest prior art",
 - Most promising springboard
2. establishing the "objective technical problem" to be solved, and

Maastricht University *Leading in Learning!*

Problem solution approach

3. considering whether or not the claimed invention, starting from the closest prior art and the objective technical problem, would have been obvious to the skilled person.
 - *Would as opposed to could*

Maastricht University *Leading in Learning!*

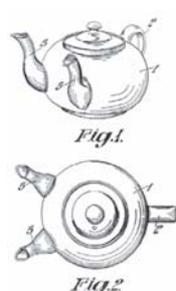
The invention



Maastricht University *Leading in Learning!*

Problem solution approach

- Prior art
 - Teapot with one spout
- Drawback of prior art
 - Time-consuming
- Problem to solve
 - Reduce filling time
- Solution
 - Provide a second spout
- Advantage of the invention
 - The time needed to fill multiple cups is reduced



Maastricht University *Leading in Learning!*

ENABLING DISCLOSURE

Maastricht University *Leading in Learning!*

Enabling disclosure – Article 29 TRIPs

Members shall require that an applicant for a patent shall disclose the invention in a manner sufficiently clear and complete for the invention to be carried out by a person skilled in the art and may require the applicant to indicate the best mode for carrying out the invention known to the inventor [...].

Maastricht University *Leading in Learning!*

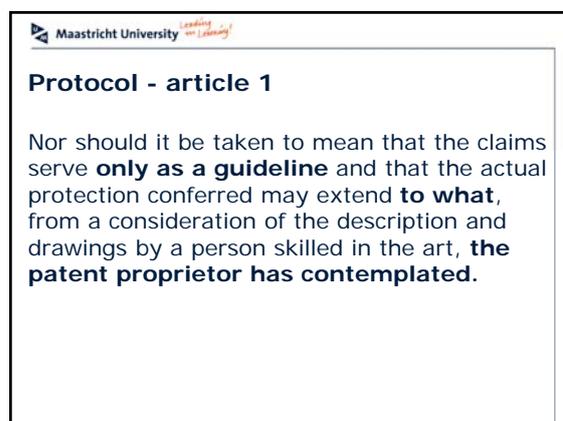
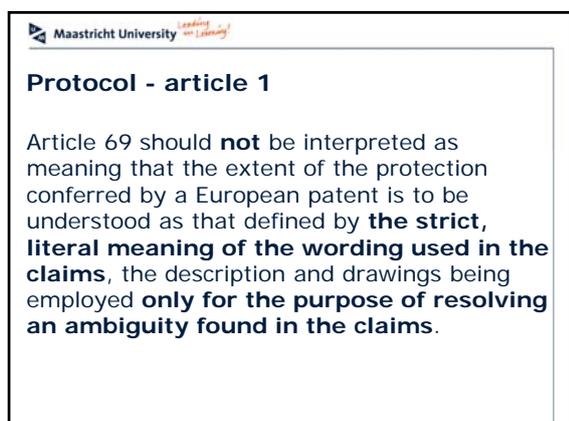
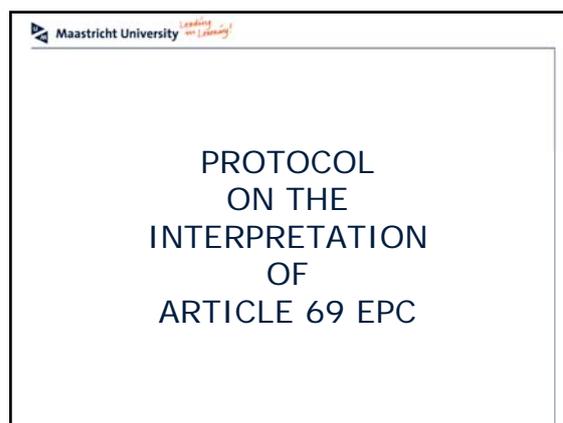
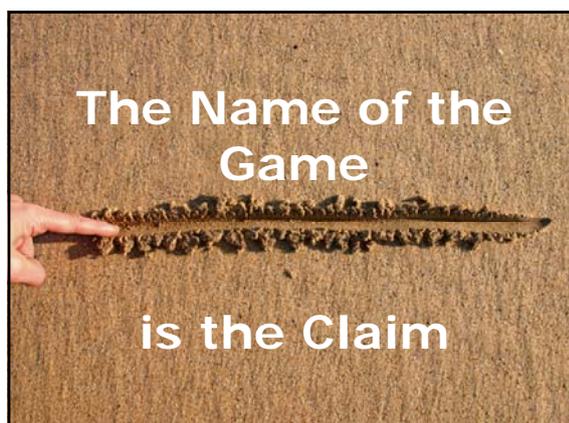
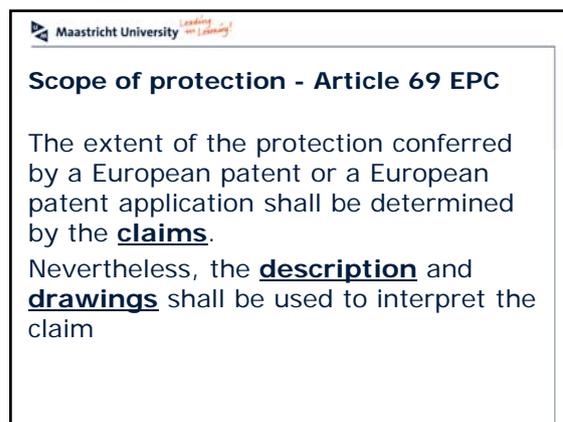
Enabling disclosure – Article 83 EPC

The European patent application shall disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art.

Maastricht University *Leading in Learning!*

Patent Law 1

- Legal framework
- Subject-matter
- Exceptions to patentability
- Requirements
- Scope of protection



Maastricht University *Leading in Learning!*

Protocol - article 1

On the contrary, it is to be interpreted as defining
a position between these extremes
 which combines
a fair protection for the patent proprietor
 with
a reasonable degree of legal certainty for third parties.

Maastricht University *Leading in Learning!*

Protocol - article 2

For the purpose of determining the extent of protection conferred by a European patent, due account shall be taken of any element which is equivalent to an element specified in the claims.

Maastricht University *Leading in Learning!*

Ministry of Silly Walks



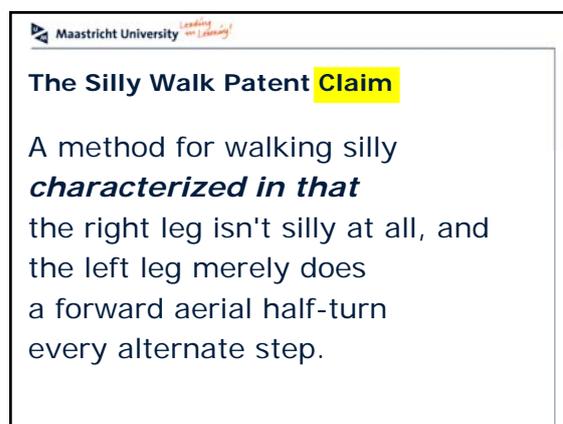
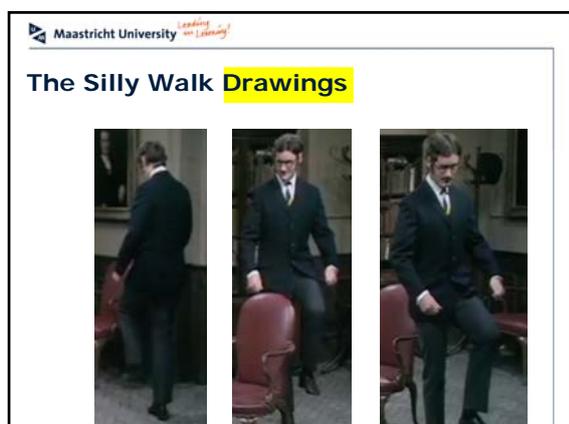
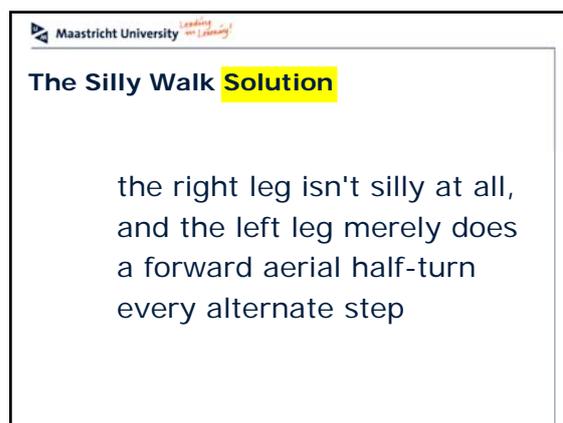
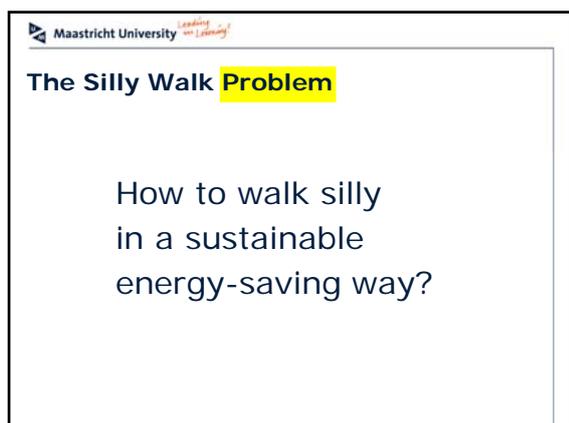
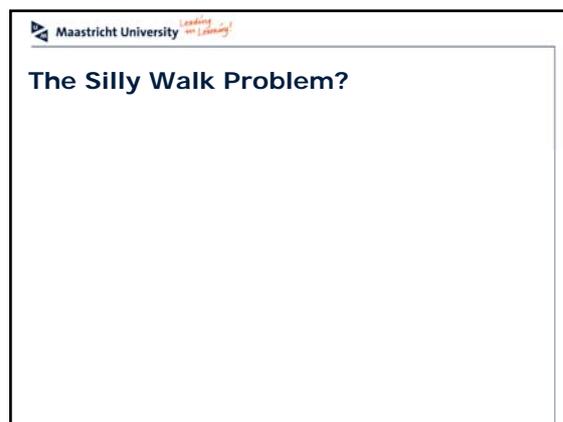
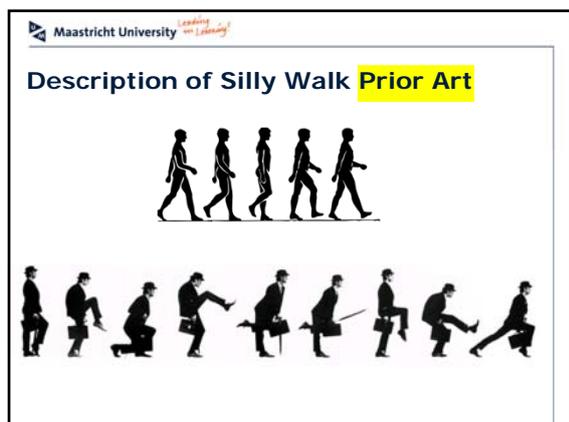
Maastricht University *Leading in Learning!*

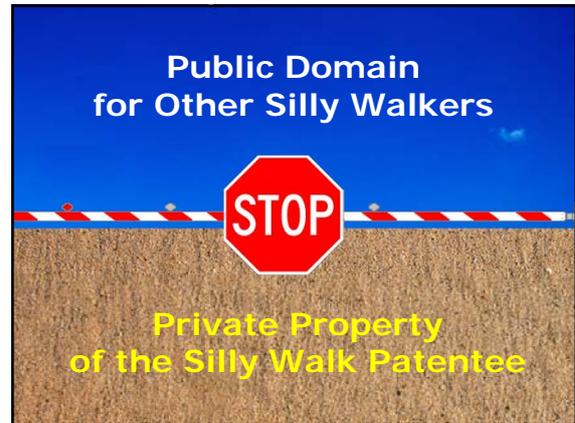
The Silly Walk Patent

Maastricht University *Leading in Learning!*

The Patent

1. Description
2. Drawings
3. Claims





Maastricht University *Leading in Learning!*

Article 69 European Patent Convention

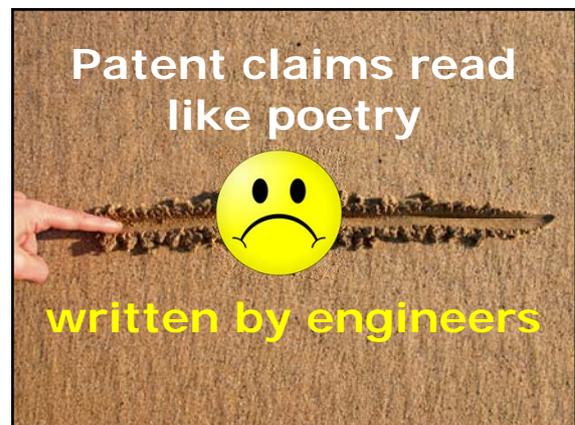
The protection shall be determined by the **claims**.

The **description** and **drawings** shall be used to interpret the claims.

Maastricht University *Leading in Learning!*

The Silly Walk Patent Claim

A method for walking silly *characterized in that* the right leg isn't silly at all, and the left leg merely does a forward aerial half-turn every alternate step.





Maastricht University *Leading in Learning!*

Infringing the Silly Walk Patent

.... with a "funny walk" ?

Maastricht University *Leading in Learning!*

Infringing the Silly Walk Patent

Maastricht University *Leading in Learning!*

The Silly Walk Patent Claim

A method for walking silly *characterized in that* the right leg isn't silly at all, and the left leg merely does a forward aerial half-turn every alternate step.

Maastricht University *Leading in Learning!*

What if?

Maastricht University *Leading in Learning!*

B does the opposite

A method for walking silly *characterized in that* the ~~right~~ left leg isn't silly at all, and the ~~left~~ right leg merely does a forward aerial half-turn every alternate step.

Maastricht University *Leading in Learning!*

Article 69 European Patent Convention

The protection shall be determined by the **claims**.

The **description** and **drawings** shall be used to **interpret the claims**.



Maastricht University *Leading in Learning!*

Interpretation Protocol

Balance between:

1. **Fair** protection to the patentee
2. **Reasonable** certainty 3rd parties

Maastricht University *Leading in Learning!*

"the inventive idea"

A method for walking silly **characterized in that** ~~the right leg isn't silly at all, and the left a leg merely~~ does a forward aerial half-turn every alternate step.

Maastricht University *Leading in Learning!*

Patent Law 1

- Legal framework
- Subject-matter
- Exceptions to patentability
- Requirements
- Scope of protection