THE INTELLECTUAL PROPERTY REVIEW

EIGHTH EDITION

Editor
Dominick A Conde

THE LAWREVIEWS

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Editor
Dominick A Conde

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PREFACE

While there has been a push to provide uniform and harmonised intellectual property coverage worldwide, it seems at every turn there are events that pull that goal further away. Thus, there remain significant differences and gaps in intellectual property coverage globally. This is exacerbated by the increase in international trade where practitioners need to know the law in many individual countries, and they also need to understand the differences between those countries.

While jurisdictional differences can be anticipated and addressed, these differences are further magnified by the geopolitical turmoil that persists worldwide. As was the case the previous year, the United Kingdom's Brexit vote and potential departure from the European Union continue to leave a cloud over establishing a Unified Patent Court in Europe. That uncertainty continues in part because even as of 3 April 2019, there has been no Brexit deal and, adding to the uncertainty, Germany has not ratified the UPC. Whether the UPC will ever come to fruition is debatable. Another example is the trade 'wars' between the United States and China. One of the principal disputes is that the US has accused China of misusing US intellectual property rights and has implemented tariffs in an effort to convince China to stop those alleged misuses. While those negotiations are ongoing, the trade dispute has heightened tensions between the countries and lessened efforts at worldwide cooperation on intellectual property matters.

To aid practitioners who are navigating this ever changing landscape of global intellectual property, we now present the eighth edition of *The Intellectual Property Review*. In this edition, we present 24 chapters that provide an overview of the forms of intellectual property coverage available in each particular jurisdiction, along with an update of its most recent developments. Each chapter is written and assembled by leading practitioners in that jurisdiction. While all involved have striven to make this review both accurate and comprehensive, we must note that it is necessarily a summary and overview, and we strongly recommend that the reader seek the advice of experienced advisers for any specific intellectual property matter. Contact information for the authors of each chapter is provided at the end of this review.

Dominick A Conde
Venable LLP
New York
May 2019

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Chapter 22

UNITED KINGDOM

Gordon Harris, Andrew Maggs and Ailsa Carter[1]

I FORMS OF INTELLECTUAL PROPERTY PROTECTION

i Patents

A patent may be granted covering the United Kingdom for an invention that is new, involves an inventive step, is capable of industrial application, and is not otherwise excluded from patentability. The term of protection is 20 years from the application date, unless a supplementary protection certificate (SPC) is granted (which may extend the term), renewal fees are not paid (in which case the patent may lapse sooner) or the patent is declared invalid.

An application for a patent conferring protection in the UK can either be made to the UK Intellectual Property Office (UKIPO), for a GB patent, or to the European Patent Office (EPO) for a European Patent designating the UK. Alternatively, either can be designated as part of a Patent Cooperation Treaty (PCT) application.

On 26 April 2018, the UK ratified the Agreement on a Unified Patent Court (the UPC Agreement). However at the time of writing, it is unclear whether the UK will remain within the proposed Unified Patent Court (UPC) or unitary patent systems if and when they become operational: this will depend, at least in part, upon the legal arrangements governing the UK's relationship with the EU.

ii Supplementary protection certificates

A supplementary protection certificate (SPC) is a form of intellectual property that extends the patent term in respect of pharmaceutical or plant protection products in qualifying circumstances.

The term of the SPC is intended to compensate, to some degree, for the period elapsing between the filing of an application for a patent for a new medicinal or plant protection product and the grant of authorisation to place the medicinal product or plant protection product on the market. The duration of protection is the term that elapsed between those dates, reduced by a period of five years, subject to a maximum period of protection of five years.

iii Designs

In the UK, designs may be protected by a mixture of registered and unregistered rights, which vary in their subsistence, scope and duration.

1 Gordon Harris is a partner and Andrew Maggs and Ailsa Carter are principal associates at Gowling WLG.

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Registered designs – UK and EU

Designs that are new and have individual character can be registered with the UKIPO, for the UK, or with the European Union Intellectual Property Office (EUIPO), for the EU (which, at the time of writing, includes the UK).

Three-dimensional and two-dimensional designs can all be protected. However, computer programs, features of an article that have a technical function or that interconnect with other parts of the article and are necessary for the article to perform its function, and designs that are contrary to public policy are not registrable.

Registered designs are monopoly rights (which can be enforced without copying having occurred). The term of protection is 25 years provided that renewal fees are paid.

Unregistered designs

The UK unregistered design right (UDR) protects the shape and configuration of the whole or part of an article (external or internal) that is original, recorded in a design document or the subject of an article made to the design, and created by a qualifying person.

The UDR will not subsist in a method or principle of construction, the shape or configuration of an article that 'must fit' another, or the appearance of an article that 'must match' another. The UDR does not protect 2D designs such as ornamentation or surface decoration (which may be protected by copyright).

The UDR arises automatically. The term of protection is the lesser of: 15 years from first recording in a design document or first making to the design; or 10 years from first making the article available for sale or hire (dates calculated from the end of the relevant calendar year). The owner has exclusive rights to reproduce the design for commercial purposes. During the final five years of the term licences of right are available. If the terms are not agreed, they will be settled by the Comptroller General of Patents, Designs and Trademarks.

The EU unregistered Community design right has a broader scope of protection than the UDR, protecting 3D and 2D designs. EU protection lasts for a period of three years from the date on which the relevant design is first made available to the public and pan-European relief is available. At the time of writing, the UK is a member of the EU and where qualification criteria are met EU unregistered Community design right arises covering the UK.

iv Copyright

Copyright may subsist, *inter alia*, in original literary, dramatic, musical and artistic works, sound recordings, films and broadcasts and typographical arrangements of published editions, provided the work qualifies by its author's nationality or domicile or by the place of first publication of the work. Protection arises automatically when works are recorded in writing or some other form.

Copyright in literary, dramatic, musical or artistic works generally lasts for 70 years from the end of the calendar year in which the author dies. For some literary works, including computer generated works, databases, tables and compilations, and for sound recordings and broadcasts, protection will last for 50 years from the end of the calendar year in which they are created.

Copyright is infringed if the work, or a substantial part of it (assessed qualitatively), is copied, not if another work is created independently.

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v Database rights

Databases can be protected in two ways; by copyright and by the sui generis database right.

Where there has been a substantial investment in obtaining, verifying or presenting the contents of a database the sui generis right will arise. Protection lasts for 15 years from the end of the calendar year in which the database was completed.

Where all or a substantial part of the contents of the database are extracted or reutilised without the owner's permission, database rights will be infringed.

vi Registered trademarks

A mark or sign may be registered as a trademark if it is capable of distinguishing the goods or services of one undertaking from those of another and of being represented on the register in a manner that enables the competent authorities and the public to determine the clear and precise subject matter of protection. It must also not be devoid of distinctive character nor consist exclusively of indicators that may designate the kind, quality, quantity or other characteristics of the goods or services, although it may be shown that the mark has acquired distinctiveness through use. Registered trademarks can include words, domain names, colours and the shape of goods or their packaging, as well as non-traditional marks such as sounds (although in practice, registration of non-traditional marks is difficult to obtain).

A mark can be registered for the UK (with the UKIPO); or as an EU Trademark (EUTM, formerly called a Community Trademark, with the EUIPO, for the EU). (At the time of writing, the UK is a member of the EU). A mark will be registered for specified goods and services listed in the classes of the International Classification of Goods and Services.

The proprietor of a mark has the exclusive right to use the registered mark in connection with the classes of goods or services for which it is registered. The mark may be enforced in respect of: (1) an identical mark for identical goods or services; (2) an identical or similar mark for identical or similar goods or services where such use has caused or is likely to cause confusion; and (3) if a mark has a reputation, in respect of an identical or similar sign for goods and services where the use causes detriment or leads to unfair advantage.

A mark may remain registered indefinitely provided that the renewal fees are paid.

vii Passing off

A claimant can bring a claim for passing off where:

a there is goodwill attached to his or her goods or services in the United Kingdom;

b there is a misrepresentation by the defendant leading or likely to lead the public to believe that the goods or services offered are the goods or services of the claimant or there is some other authorised link with the claimant; and

c the claimant suffers damage as a result.[2]

Passing off can be used as a way of protecting unregistered trademarks, names, logos or get-up from being misused by others wanting to trade off the claimant's goodwill.

2 *Reckitt & Colman Products v. Borden* [1990] UKHL 12; *Starbucks v. British Sky Broadcasting* [2015] UKSC 31.

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viii Confidential information and trade secrets

Confidential information is broadly defined as information that has the necessary quality of confidence that is disclosed in circumstances imparting an obligation of confidence.

Confidential information may be protected by non-disclosure agreements or confidentiality agreements. It is common for employers to request that their employees sign such agreements if they have access to confidential information.

While in theory it is possible to protect confidential information indefinitely, there may be limits on how long information will retain its confidential status. For example, non-disclosure and confidentiality agreements may be time-limited, the information may become available from non-confidential sources and information may be made available to other parties or the public in the course of litigation.

ix Plant varieties

A plant variety right may be available for a new, distinct, uniform and stable plant variety. 'New' is assessed by reference to sale or disposal.

A plant variety right entitles the holder to prevent anyone from producing or reproducing, conditioning for the purpose of propagation, offering for sale, selling, exporting, importing or stocking for any of those purposes, the qualifying variety. The term of protection is 30 years from the date of grant (for potatoes, trees and vines); or 25 years from the date of grant (all other cases). Protection is available for the UK (from the UK Plant Variety Rights Office) or for the EU (from the Community Plant Variety Office). (At the time of writing, the UK is a member of the EU).

II RECENT DEVELOPMENTS

i Recent notable patent case law

Doctrine of equivalents – Actavis v. Eli Lilly

In a landmark judgment, *Actavis v. Eli Lilly*,[3] the UK Supreme Court swept aside decades of jurisprudence on the assessment of the tort of patent infringement and introduced a doctrine of equivalents in the United Kingdom.

Standards essential patents and fair, reasonable and non-discriminatory terms

In *Unwired Planet v. Huawei*,[4] the High Court of England and Wales (Patents Court), having determined that patents owned by Unwired Planet were valid, infringed by Huawei and essential to the 3GPP telecommunications standard, determined licence terms that were 'fair, reasonable and non-discriminatory' (FRAND) between the parties. Although only selected UK patents were found valid and infringed, the FRAND licence determined was a global, portfolio licence. This is the first time a global portfolio licence has been determined by a court worldwide. Since Huawei had not been prepared to take a licence on terms found by the court to be FRAND, the High Court also developed new injunctive relief – a FRAND injunction, which would be discharged if Huawei entered into the FRAND licence, and with the parties having liberty to apply to the Court regarding the injunction at the end of

3 [2017] UKSC 46.

4 [2017] EWHC 2988; [2017] EWHC 1304.

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the licence term (in 2020, while the patents found valid, infringed and essential would be in force until 2028). The Court of Appeal has since confirmed the approach taken by the High Court.[5] A further appeal is listed to be heard by the Supreme Court in October 2019.

Dosage regimen patents

Patents to dosing regimens had a difficult year in the UK courts in 2017. In *Actavis v. ICOS*,[6] in three separate judgments, the Court of Appeal made clear the challenges facing patent claims in which the purported invention resides in a dosing regimen. If, by pursuing the clinical trials necessary for marketing authorisation, the claimed dosing regimen would be reached, the fact that at the outset the regimen eventually settled upon would have seemed surprising will not confer inventiveness. The Court of Appeal's approach was confirmed by the Supreme Court in 2019.[7]

Declaratory relief – Arrow declarations

In *Fujifilm v. AbbVie*,[8] the High Court of England and Wales (Patents Court) awarded, in a landmark judgment, a novel type of declaratory relief, known as an *Arrow* declaration,[9] to clear the route to market for a product facing a raft of pending patent applications incapable of challenge in the UK courts. The Court concluded that the administration of FKB's proposed products in the treatment of a particular medical indication by a particular dosing regimen would have been obvious at a particular date, and that the Court's declaration of this would serve a useful purpose in view of AbbVie's patent filing strategy and public statements. Declaratory relief of a similar nature was awarded for the second time in *Glaxo v Vectura*,[10] in December 2018.

Plausibility, obviousness and insufficiency

Plausibility, a concept drawn from case law of the EPO[11], has in recent years been developing in the jurisprudence of England and Wales in the context of priority, obviousness, insufficiency and industrial applicability. In 2018, the UK Supreme Court considered its role in the test for insufficiency.[12] Guidance on the Supreme Court's test was given by the Patents Court in 2019.[13]

ii Unified Patent Court and unitary patent package

The proposed UPC and unitary patent system is discussed in Sections I, above, and IV and V, below. The UK ratified the UPC Agreement in 2018. However, at the time of writing, the timetable for the new system becoming operational, and the UK's continued involvement in it, remain uncertain.

5 *Unwired Planet v. Huawei* [2018] EWCA Civ 2344.
6 [2017] EWCA Civ 1671.
7 *Actavis v. ICOS* [2019] UKSC 15.
8 *Fujifilm Kyowa Kirin Biologics Company v. AbbVie Biotechnology* [2017] EWHC 395 (Pat).
9 *Arrow Generics Ltd v. Merck & Co Inc* [2007] EWHC 1900 (Pat).
10 [2018] EWHC 3414 (Pat).
11 *Exxon* (T 409/91); *AgrEvo* (T939/92).
12 *Warner-Lambert v. Generics* [2018] UKSC 56.
13 *Eli Lilly v. Genentech* [2019] EWHC 387 (Pat).

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iii Shape trademarks

In *Nestlé v. Cadbury*[14] the Court of Appeal ruled that the shape of a four-fingered Kit Kat bar (without a Kit Kat logo embossed on each finger) could not be registered as a UK trademark. Concerning an inherently non-distinctive mark, in demonstrating that the mark has acquired distinctiveness, it was not sufficient to show that consumers recognise the mark and associate it with the applicant's goods.

Similarly, in *The London Taxi Corporation v. Frazer-Nash*[15] the Court of Appeal confirmed a first instance decision that a trademark for the shape the iconic London 'black cab' was invalid for lack distinctive character. In particular, while recognisable, the shape was not shown to have acted as a designation of trade origin.

iv Actionable threats

On 1 October 2017, the Intellectual Property (Unjustified Threats) Act 2017 came into force, making amendments to the law prohibiting unjustified threats of infringement proceedings. The Act harmonises, across the different intellectual property rights the subject of a threats regime, what can and cannot be said without falling foul of the provisions restricting the making of unjustified threats.

Across the board, additional protection has been provided for professional advisers. Provided legal advisers comply with the requirements of the Act, their communications are now much less likely to be capable of amounting to a threat.

III OBTAINING PROTECTION

i Patentability

The Patents Act was enacted in the course of the United Kingdom's accession to the European Patent Convention. Certain sections of the Patents Act are expressed as framed so as to have, as nearly as practicable, the same effects in the United Kingdom as the corresponding provisions of the EPC, the Community Patent Convention and the PCT.

Pursuant to the EPC, European patents shall be granted for any inventions, in all fields of technology, provided:

a they are new, involve an inventive step and are susceptible of industrial application;
b patentability is not expressly excluded; and
c the application meets certain other requirements, namely, unity of invention, disclosure of invention and clear and concise claims supported by the description.

New

An invention shall be considered to be new ('novel') if it does not form part of the state of the art. The state of the art comprises everything made available to the public anywhere in the world 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. Additionally, the content of earlier filed

14 [2017] EWCA Civ 358.
15 [2017] EWCA Civ 1729.

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(but not yet published) patent applications (UK or EPC designating the United Kingdom) is considered as comprised in the state of the art. A patent (or application) lacks novelty (is 'anticipated') if the prior art provides an 'enabling disclosure' of what is claimed.[16]

Involves an inventive step

An invention shall be taken to involve an inventive step if it is not obvious to a person skilled in the art, having regard to any matter that forms part of the state of the art (earlier filed but not yet published patent applications are not included in the state of the art for this purpose). In *Conor v. Angiotech*,[17] the House of Lords (the predecessor to the UK Supreme Court) considered the issue of obviousness and approved the following statement of Kitchin J in *Generics v. Lundbeck*:[18]

> *The question of obviousness must be considered on the facts of each case. The court must consider the weight to be attached to any particular factor in the light of all the relevant circumstances. These may include such matters as the motive to find a solution to the problem the patent addresses, the number and extent of the possible avenues of research, the effort involved in pursuing them and the expectation of success.*

In *Hospira v. Genentech*,[19] the Court of Appeal noted that there is only one statutory question, namely whether the invention was obvious at the priority date. Whether the invention was obvious to try is merely one of many considerations that it may be appropriate for the Court to take into account in addressing the statutory question; it is not a substitute test for obviousness, and it must in any case be coupled with a reasonable or fair prospect of success.

Industrial application

An invention shall be taken to be capable of industrial application if it can be made or used in any kind of industry, including agriculture. The notion of industry is construed broadly.[20]

Exclusion from patentability

The following are declared not to be inventions (and are therefore not patentable):

a discoveries, scientific theories and mathematical methods;

b literary, dramatic, musical or artistic works or any other aesthetic creation; and

c schemes, rules or methods for performing a mental act, playing a game or doing business, or a program for a computer; and the presentation of information.

However, this only prevents patentability to the extent that the patent or application relates to the thing as such.

Patents also shall not be granted for the following:

a inventions the commercial exploitation of which would be contrary to public policy or morality;

16 *Synthon BV v. SmithKline Beecham plc* [2005] UKHL 59.

17 [2008] UKHL 49, [2008] RPC 28.

18 [2007] RPC 32.

19 [2016] EWCA Civ 780.

20 *Eli Lilly v. Human Genome Sciences* [2008] EWHC 1903 (Pat).

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b plant or animal varieties or essentially biological processes for the production of plants or animals (not including microbiological processes or the products thereof);

c methods for treatment of the human or animal body by surgery or therapy and diagnostic methods practised on the human or animal body (although this does not apply to products, in particular substances or compositions, for use in any of these methods);

d the human body, at various stages of its formation and development, and the simple discovery of one of its elements, including the sequence or partial sequence of a gene;

e processes for modifying the germline genetic identity of human beings;

f uses of human embryos for industrial or commercial purposes; and

g processes for modifying the genetic identity of animals, which are likely to cause them suffering without any substantial medical benefit to man or animal, and also animals resulting from such processes.

Other requirements for grant

A patent application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept.

The specification must disclose the invention clearly and completely enough for it to be performed by a person skilled in the art. It must be sufficient to allow the invention to be performed over the whole scope of the claim and without undue burden.[21]

The claims of a patent define the matter for which protection is sought. They must be clear and concise and be supported by the description.

ii Subject-specific case law

Methods of medical treatment and diagnostic methods

Methods of medical treatment and diagnostic methods are excluded from patentability. However, products, including substances, for use in such methods may be patented, including where the invention (and novelty) resides in the new use of a known product: purpose-limited product claims are permissible (i.e., claims in the form 'X for use in the treatment of Y').

Previously, for inventions residing in a second or subsequent use of a known medicament, claims in 'Swiss form' were permissible (i.e., 'use of X in the manufacture of a medicament for the treatment of Y') but following the decision of the EPO's Enlarged Board of Appeal in G2/08 (*Abbott Respiratory/dosage regimes*)[22] applicants may no longer claim second medical use inventions in the Swiss format. The changes introduced in 2010 made no change to practice regarding existing Swiss form claims already in force.

Patents with claims in Swiss form do not prevent (under the double patenting exclusion) the grant of a related application with claims in purpose-limited product format because the subject matter of such claims is considered different.[23] For the same reason, it is not possible to amend granted Swiss form patent claims to purpose-limited product format.

21 *Eli Lilly v. Human Genome Sciences* [2012] EWCA Civ 1185.

22 G2/08 [2010] 10 OJEPO 456 and UKIPO Practice Notice 26 May 2010.

23 T 1780/12.

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Plants and animals and essentially biological processes for their production

Inventions that concern plants or animals may be patentable if the invention is not confined to a particular plant or animal variety but can be granted if varieties may fall within the scope of the claims.[24]

Whether or not a (non-microbiological) process for the production of animals or plants is 'essentially biological' and therefore excluded from patentability has to be judged on the basis of the essence of the invention taking account the totality of the human intervention and its impact on the result achieved.[25]

Other biotechnological inventions

Finding biological material, such as a microorganism, occurring freely in nature is discovery, not an invention, and so is not patentable as such. However, biological material that is isolated from its natural environment or produced by means of a technical process may be the subject of an invention, even if the material occurred previously in nature. Where the invention resides in a whole or partial gene sequence, the industrial application of the sequence must be disclosed in the application as filed.[26]

In *Oliver Brüstle v. Greenpeace*[27] the CJEU ruled that a 'human embryo was: any human ovum after fertilisation; any non-fertilised human ovum into which the cell nucleus from a mature human cell has been transplanted; and any non-fertilised human ovum whose division and further development have been stimulated by parthenogenesis'. The exclusion covered the use of human embryos for purposes of scientific research; only use for therapeutic or diagnostic purposes that are applied to the human embryo and are useful to it being patentable. Further, patentability was excluded where the subject matter involved the prior destruction of human embryos or their use as base material.

Subsequently, in International *Stem Cell Corporation v. Comptroller General of Patents, Designs and Trade Marks*,[28] the CJEU ruled that an unfertilised human ovum whose division and further development have been stimulated by parthenogenesis does not constitute a 'human embryo', within the meaning of that provision, if, in the light of current scientific knowledge, it does not, in itself, have the inherent capacity of developing into a human being.

A claim to a product containing or consisting of biological information is construed as extending to all material (except excluded material) in which the product is incorporated and in which the genetic information is contained and performs its function.

Computer programs

A claimed invention involving the use of a computer program may be patentable if it involves a technical contribution.[29] The Court of Appeal has emphasised the need for each case to be considered by reference to its particular facts,[30] and that a solution to a technical problem can

24 G 1/98, G 2/12 and G 2/13.

25 UKIPO's Manual of Patent Practice, 76A.03.

26 UKIPO's Manual of Patent Practice, 76A.06, G 2/07, G 1/98.

27 [2011] EUECJ C-34/10.

28 [2014] EUECJ C-364/13.

29 UKIPO's Manual of Patent Practice, 1.

30 *Symbian Ltd's Application* [2009] RPC 1.

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be a relevant technical effect and would not be excluded, as technical character is provided from the problem itself.[31] In *HTC v. Apple*, Kitchin LJ noted the need to consider what the computer program in issue actually contributes.

IV ENFORCEMENT OF RIGHTS

This section provides a brief guide to how intellectual property rights may be asserted, focusing on patents. In the courts of the United Kingdom, issues of infringement and validity are almost always addressed together.

Pursuant to EU Directive 2004/48 on the enforcement of intellectual property rights (the IP Enforcement Directive), Member States shall provide for the measures, procedures and remedies necessary to ensure the enforcement of intellectual property rights. Such measures, procedures and remedies shall also be effective, proportionate and dissuasive and applied in such a manner as to avoid the creation of barriers to legitimate trade and to provide for safeguards against their abuse. The nature of available final and interim relief, as well as other aspects of litigation procedure, continues to evolve with the developing jurisprudence in respect of the IP Enforcement Directive, and also with developments in technology.

i Possible venues for enforcement

The United Kingdom has three jurisdictions: England and Wales, Scotland, and Northern Ireland. Each has its own legal system and procedures, the UK Supreme Court being the final court of appeal for all in civil cases. In the field of IP, legislated substantive law applies throughout the UK. The overwhelming majority of IP litigation in the UK takes place in the courts of England and Wales.

In England and Wales, the Intellectual Property Enterprise Court (IPEC) is the correct forum for less complex and smaller value IP claims. In the IPEC damages are capped at £500,000 (per claim number),[32] and recoverable costs are capped at £50,000 for the liability stage and £25,000 for the quantum stage. The IPEC procedure is distinct from that which is conventional under English legal practice, for example with less separation of argument and evidence. For more complex and valuable IP claims, the Patents Court hears claims concerning patents, SPCs, registered designs, plant varieties and semiconductor topography rights; other types of intellectual property dispute are heard in the General IP List. All of the courts and lists noted in this paragraph sit within the Business and Property Courts of the High Court of England and Wales.

Patent actions are heard in Scotland by the Court of Session, and in Northern Ireland by its High Court.

The Comptroller General of Patents at the UK Intellectual Property Office (UKIPO) has jurisdiction to adjudicate upon some patent-related issues and may issue opinions on the infringement and validity of patents.

If and when the UPC Agreement and associated EU Regulations come into force, owners of European patents designating Member States of the EU participating in the UPC system will (subject to opting-out) be able to enforce those European patents (but not national patents) in the UPC. New unitary patents will also be enforceable in the UPC. At the time

31 *HTC v. Apple* [2013] EWCA Civ 451.

32 *OOO Abbot v. Design & Display* [2014] EWHC 3234.

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of writing, the UPC is expected to have a central division (with its seat in Paris, and sections in London and Munich), local divisions in some Member States, and one or more regional divisions covering more than one Member State (e.g., a 'Nordic-Baltic' regional division for Estonia, Latvia, Lithuania and Sweden). Choice of venue will depend on relevant provisions of the UPC Agreement and the UPC's Rules of Procedure. Decisions in relation to European patents that are not 'opted-out' and all unitary patents will have effect across the Member States concerned in each case. At the time of writing, if the UPC Agreement enters into force, at the minimum the following contracting states will be within the new system: Austria, Belgium, Bulgaria, Denmark, Estonia, Finland France, Germany, Italy, Latvia, Lithuania, Luxembourg, Malta, the Netherlands, Portugal, Sweden and (depending on arrangements in respect of Brexit) the UK. For the term of the transition period (at least the first seven years), the current jurisdiction of the national courts of the participating countries in respect of European patents will continue in parallel. The remainder of this Section is concerned with the existing system, not the UPC.

ii Requirements for jurisdiction and venue

The UK courts described in Section IV.i, above, have exclusive jurisdiction in respect of actions for revocation of UK patents and UK designations of European patents but not actions for revocation of, or otherwise challenging the validity of, other national designations of European patents.

In respect of issues of infringement, jurisdiction may be founded by domicile or by the place where the harmful event occurred or may occur.[33] Where a claim of infringement is made, the defendant may challenge validity, so invoking the exclusive jurisdiction of the courts of the relevant designation. Accordingly, almost all litigation regarding issues of infringement and validity of a European patent takes place in the courts of the relevant designated country.

However in *Actavis v. Eli Lilly*,[34] Lilly was found to have conceded jurisdiction, in the course of pre-action correspondence, such that the Patents Court considered the claim to have been properly commenced and the Court to have jurisdiction to award a declaration of non-infringement covering designations of a European patent for several other EU Member States. In *Eli Lilly v. Genentech*,[35] the Civil Procedure Rules enabled Lilly to commence proceedings for declarations of non-infringement in respect of a UK designation of a European patent and several non-UK designations of the same patent by service on Genentech, Inc, in the United States. (Lilly also challenged the validity of the UK designation of Genentech's European patent, but not the non-UK designations.) In contrast, in *Parainan Pearl Shipping v. Kristian Gerhard Jebsen Skipsrederei*,[36] Parainan's attempt to commence proceedings against the Norwegian owners of several designations of a European patent for relief including declarations of non-infringement, by the employment of a different mechanism in the Civil Procedure Rules, was unsuccessful. This remains a developing area of the law.

33 At the time of writing, Regulation 1215/2012 on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters; Lugano Convention 2005; Civil Jurisdiction and Judgments Act 1982.

34 [2013] EWCA Civ 517; [2014] EWHC 1511 (Pat).

35 [2017] EWHC 3104 (Pat).

36 [2017] EWHC 2570 (Pat).

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iii Obtaining relevant evidence of infringement and discovery

In a civil claim, it is for the claimant to prove his or her case on the balance of probabilities. At the outset, the facts relied upon in support of the claim (or counterclaim) must provide reasonable grounds for making the claim. Without such grounds the claim may be struck out.

Disclosure

Discovery may be available in the course of litigation. (In unusual circumstances it may be available from a non-party.) A party discloses a document by stating that it exists. The party to whom disclosure is made is then entitled to inspect the document, except where it is no longer in the disclosing party's control or where the disclosing party has a right or duty to withhold inspection of it, for example because it is privileged. Confidentiality does not confer a right to withhold inspection, but the court may order disclosure of confidential documents on appropriate terms, for example to specified members of a 'confidentiality club'. The existence of a confidentiality club will reduce the likelihood that redaction of documents will be allowed.[37]

Increasingly, disclosure requirements are tailored on a case-by-case basis. In patent cases, provision of a product or process description by the alleged infringer usually enables standard disclosure to be dispensed with in relation to infringement. In relation to validity, disclosure is usually constrained to a term two years either side of the earliest claimed priority date. In the context of quantum (even before litigation commences) licence agreements concluded by one party (or prospective party) with a third party may be disclosable.[38] In every case, it is the court that orders the scope of disclosure, and there is no longer a *prima facie* rule of standard disclosure.[39]

Evidence

Fact evidence is usually submitted to the court in the form of written witness statements, which stand as the witness's evidence in chief. A witness's oral testimony is usually limited to cross-examination and re-examination.

The court assesses the teachings and scope of a patent through the eyes of 'the person skilled in the art'. He or she is the hypothetical person to whom the patent is addressed. The skilled person has imputed to him or her the 'common general knowledge', which is, essentially, standard technical background of the art in question.

Expert evidence is generally required to assist the court in adopting the mantle of the person skilled in the art and to determine the scope of the common general knowledge. Parties tend to retain their own expert, although they may be ordered to agree upon a single expert. Expert witnesses owe a duty to the court, which overrides any duty they have to the party and its team of legal advisers, and bear a personal responsibility for their evidence.[40] Expert evidence in chief is provided by way of a report, with opportunity to respond in writing to the report submitted by the other expert. Oral testimony is usually limited to cross-examination

37 *Aqua v. Fiserv* [2017] EWHC 1627 (Ch).

38 *Big Bus Company v. Ticketogo* [2015] EWHC 1094 (Pat); *Smart Reamer Drilling Systems v. NOV Downhole Eurasia* [2018] EWHC 1265 (IPEC)

39 *Positec v. Husqvarna* [2016] EWHC 1061 (Pat); and from 1 January 2019 the disclosure pilot for the Business and Property Courts.

40 *Synthon v. Teva* [2015] EWHC 1395 (Pat).

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and re-examination. Cross-examination is considered by the courts to be an important tool by which expert evidence that is submitted to the court may be scrutinised.[41] 'Hot-tubbing' (the hearing of evidence from the experts of opposing parties concurrently) may be employed.[42]

Experiments

In appropriate cases, experiments may be ordered upon the application of a party that wishes to establish a fact by experimental proof.

Methods for obtaining evidence and information

In addition to the mechanisms discussed above, the Civil Procedure Rules provide a number of additional procedural mechanisms for obtaining further information in the course of litigation. The mechanisms available and employed may be relevant to any award or order subsequently made by the court.[43] In appropriate circumstances, the court will award a search and seizure order or an order that a person provide information on others involved in the supply of infringing goods, or both.

iv Trial decision-maker

For the intellectual property rights listed above, civil claims are heard and determined by a judge.

In the courts of England and Wales, IP claims are usually heard by specialist judges. In the Patents Court more complex patent cases tend to be allocated to Arnold J, Birss J or Henry Carr J – experienced patent judges who are also judges in the wider Chancery Division of the High Court. In the IPEC, patent cases tend to be heard by intellectual property specialist HHJ Hacon.

v Structure of the trial

Following the exchange of statements of case, the setting of case management directions and the conclusion of the steps ordered (for example, discovery and written evidence stages), the trial of the claim will be heard by the judge. At the hearing, the usual structure is that the claimant makes an opening statement, the parties cross-examine the witnesses relied upon by each other, and then each party makes a closing statement.

At the end of the hearing, the judge will either deliver his or her judgment or, more usually, he or she will retire to consider and write the judgment and reconvene the trial at a later date, when the judgment is handed down. An award of injunctive relief may be made with the substantive judgment or shortly afterwards following discussion between the parties or further consideration by the court.

Almost always, the trial is 'split', which means that the substantive legal claim is decided (as described above) and only where a claim is successful will the monetary relief claimed be considered. This consideration takes the form of a second stage to the litigation, involving further directions and a further trial on a damages inquiry or an account of profits, which may run in parallel with any appeal of the main judgment.

41 *Accord v. Medac* [2016] EWHC 24 (Pat).

42 *Unwired Planet v. Huawei* [2017] EWHC 711 (Pat); [2017] EWHC 2988 (Pat).

43 *Magnesium Elektron v. Neo Chemicals* [2017] EWHC 2957 (Pat).

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vi Infringement

Infringing acts

It is a direct infringement of a patent to do any of the following in the UK without the consent of the patent proprietor:[44]

a where the invention is a product, make, dispose of, offer to dispose of, use or import the product or keep it whether for disposal or otherwise;

b where the invention is a process, use the process or offer it for use in the United Kingdom with the knowledge, or when it is obvious to a reasonable person in the circumstances, that its use there without the consent of the proprietor would be an infringement of the patent; and

c where the invention is a process, dispose of, offer to dispose of, use or import any product obtained directly by means of that process or keep any such product whether for disposal or otherwise.

In *Actavis v. Eli Lilly*,[45] the UK Supreme Court ruled that the assessment of infringement is a two-stage process asking first whether the variant infringes any of the claims of the patent as a matter of normal interpretation and, if not, then second, whether the variant nonetheless infringes because it varies from the invention in a way or ways that is or are immaterial. The Supreme Court also provided guidance on when an equivalent might infringe, which has since been interpreted by the Court of Appeal in *Icescape v. Ice-World*.[46]

It is a contributory infringement of a patent to supply or offer to supply in the United Kingdom a person other than a licensee or other person entitled to work the invention with any of the means, relating to an essential element of the invention, for putting the invention into effect. In order to infringe in this way the alleged infringer must know, or it must be obvious to a reasonable person in the circumstances, that the means he or she has supplied are suitable for putting, and are intended to put, the invention into effect in the United Kingdom.[47]

Further, a defendant will be liable as a joint tortfeasor if he or she has assisted in the commission of the tort by another person pursuant to a common design with that person to do an act that is, or turns out to be, tortious.[48]

vii Defences

Statutory exceptions to infringement

An act that would constitute an infringement of the patent will not do so if:

a it is done privately and for purposes that are not commercial;

b it is done for experimental purposes relating to the subject matter of the invention;

c it consists of the preparation in a pharmacy of a medicine for an individual in accordance with a prescription;

d it consists of use on a ship or an aircraft temporarily in the territorial sea or air space of the UK; or

44 Section 60(1) of the Patents Act 1977.

45 2017] UKSC 46.

46 [2018] EWCA Civ 2219.

47 Section 60(2) of the Patents Act 1977.

48 *Sea Shepherd v. Fish & Fish* [2015] UKSC 10.

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e it consists of a specified use by a farmer of the product of his or her harvest or an animal purchased with the consent of the patent proprietor.

Invalidity

An alleged infringer may counterclaim that the patent is invalid and seek an order for revocation of it. The grounds for revocation are:

a the invention is not a patentable invention;

b the specification of the patent does not disclose the invention clearly and completely enough for it to be performed by a person skilled in the art;

c the matter disclosed in the specification of the patent extends beyond that disclosed in the relevant application as filed; and

d the protection conferred by the patent has been extended by an amendment that should not have been allowed.

A person found to be entitled to be granted the patent may additionally seek its revocation on the basis that it was granted to someone who was not entitled to it, provided the application is filed within the legislated time limits.

Other defences

An act is only capable of infringing a patent if it is done without the consent of the proprietor. Consent, or licence, may be express or implied and may form the basis for a defence. In some (unusual) situations, licences of right or compulsory licences are available.

Where the patentee has already consented to the marketing of the goods within the scope of the claimed invention in the UK or the European Economic Area (EEA), the doctrine of exhaustion prevents subsequent enforcement of a patent in the UK in respect of the imported goods.

viii Time to first-instance decision

The time to trial has tended to depend upon the conduct of the parties, the complexity of the case and the diary of the court. The Patents Court intends to list trials within 12 months of commencement of the action, and parties are expected to start to consider potential trial dates as soon as reasonably practicable, which may be very soon after the proceedings are commenced.[49] Where considered appropriate by the court, a trial can take place considerably sooner than this, for example, in *Napp v. Dr Reddy's*[50] the trial hearing took place approximately four months after the litigation commenced, the full substantive judgment was handed down shortly afterwards and the second instance decision was given within six months of the litigation commencing.

A 'shorter trial scheme' (STS) is available in the Chancery Division of the High Court, including the Patents Court. For suitable cases, the STS packages a more streamlined procedure than is usually adopted with the intent of trial being listed within eight months of the case management conference and judgment being returned within six weeks.

49 *Celltrion v. Biogen* [2016] EWHC 188 (Pat).

50 *Napp v. Dr Reddy's & Sandoz* [2016] EWCA Civ 1053; [2016] EWHC 1517 (Pat).

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Interim relief can be obtained in a matter of hours in urgent cases, although more usually interim hearings take place within a few days or weeks of the application being filed and served.

ix Remedies

If a patent is found to be infringed, or where a litigant's claim is otherwise successful, a range of remedies may be available. These include the following.

Injunctions

Following a finding of patent infringement (and validity), the court will usually award a 'final' injunction, although the position in relation to standard essential patents and second medical use patents is more complex and the outcome, in each case, likely to be more dependent upon the relevant facts.

Injunctive relief may be available at an interim stage where the patentee shows an arguable case of infringement and that a later monetary remedy would not adequately compensate the patentee for the harm caused by the ongoing (alleged) infringement. The court considers the 'balance of harm' likely to be suffered by the respective parties before deciding whether to award interim relief and if so the terms of the order. For non-final injunctions, the patentee is usually required to provide a cross-undertaking as to damages. According to the CJEU's decision in *Solvay v. Honeywell*,[51] the UK courts may be able to grant interim injunctions on a pan-European basis.

Injunctions are usually prohibitory in nature although mandatory injunctions are possible. In keeping with the developing jurisprudence of the CJEU in respect of the IP Enforcement Directive, the proportionality and effectiveness of the relief are relevant factors in the court's assessment as to whether to grant the relief sought.

Blocking orders

Since the decision of the High Court in *Twentieth Century Fox v. BT*,[52] website blocking orders have been granted to music and film copyright owners to impede access to websites that are predominantly used to share copyright infringing content. In 2014, in *Cartier v. B Sky B*,[53] similar relief was awarded with respect to websites that advertise and sell trademark-infringing products. The High Court decision was upheld by the Court of Appeal in July 2016[54] and should now be considered settled law, although aspects of the Court of Appeal judgment (principally as to who should bear the costs of implementing the blocking orders) have been appealed to the Supreme Court (at the time of writing, the judgment is awaited).

In March 2017, in *The Football Association Premier League v. BT*,[55] the High Court permitted a new form of blocking order, against particular ISP addresses, directed at inhibiting unauthorised live streaming of broadcast events (in this case, of Premier League football matches).

51 Case C-616/10, 12 July 2012.

52 [2011] EWHC 1981 (Ch).

53 [2014] EWHC 3354 (Ch).

54 [2016] EWCA Civ 658.

55 [2017] EWHC 480 (Ch).

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Delivery up

The court can order that infringing articles be delivered up to a party. This is commonly to facilitate destruction or prevent resale.

Damages or an account of profits

Damages compensate for loss and are intended to restore the patentee to the position they would have been in had no wrong been done to him or her. They may be calculated according to the damage caused to the patentee's profits by the infringement or in accordance with a 'reasonable royalty'. In an account of profits, the profits made by the infringer from the infringement of the patent are awarded to the patentee. The court may order the infringer to give some financial disclosure, so that the patentee may make an informed decision as to which remedy to pursue (not both). Neither remedy will be available against an 'innocent' infringer, although few infringers are found to be 'innocent'.

Declarations

The court can order declarations. Declarations can be, for example: of validity or contested validity, which can impact the award of legal costs in future challenges; of infringement or non-infringement; of essentiality to a technical standard;[56] and that aspects of a party's product or process were obvious at a relevant date, which can create a squeeze between infringement and validity and may be of assistance to parties in 'clearing the way' in some circumstances.[57]

Orders for dissemination and publication

The courts can also order a party to publicise the result of a case at its own expense.

Costs

Generally, the unsuccessful party to litigation is ordered to pay the costs of the successful party. However, in deciding what order to make about costs, the court will have regard to all the circumstances, including the conduct of all the parties, whether a party has succeeded on part of its case even if not wholly successful, and any admissible offer to settle made by a party that is drawn to the court's attention.

Where it falls to the court to assess the amount of payable costs, the usual basis for assessment is the 'standard' basis, pursuant to which the court will only allow costs that are considered to be proportionate to the matters in issue and to have been reasonably incurred. This tends to lead to 60–70 per cent recovery by the compensated party of its legal costs. However, cases in the IPEC are subject to capped costs recovery (as noted above), and in the High Court, the court's budgeting rules can lead to costs that are not approved by the court in the context of the costs management regime being considered disproportionate. Further, the Civil Procedure Rules provide, in Part 36, a mechanism intended to encourage settlement of civil disputes by imposing costs consequences where a compliant offer is not bettered, and where applicable this can impact costs recovery in any particular case.

56 *Nokia v. Interdigital* [2007] EWHC 3077 (Pat).

57 *Fujifilm v. Abbvie* [2017] EWHC 395 (Pat).

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x Appellate review

Decisions of the Comptroller General of Patents and interim decisions of the IPEC may be appealed to the Patents Court. Decisions of the Patents Court and final decisions of the IPEC may be appealed to the Court of Appeal. Decisions of the Court of Appeal relating to important issues of legal principle may be appealed to the Supreme Court. Experienced specialist patents judges Floyd LJ and Lord Kitchin sit in the Court of Appeal and UK Supreme Court, respectively.

In order to appeal, the party wishing to do so needs permission from the court that has issued the decision in question, or from the court to which it wishes to appeal. Permission is granted if the court considers that the appeal has a real prospect of success or if there is some other compelling reason why it should be heard.

Generally, only errors of law may be appealed. The Supreme Court has instructed appellate courts not to interfere with findings of fact unless compelled to do so. Generally, new evidence is not admissible at the appeal stage.

xi Alternatives to litigation

Alternative dispute resolution (ADR) methods include arbitration and mediation. The Arbitration Act 1996 governs the law relating to arbitration with its seat in England and Wales or Northern Ireland. ADR can enable flexibility in procedure and privacy.

V TRENDS AND OUTLOOK

i Brexit

In June 2016, the UK population voted in a referendum to leave the European Union. At the time of writing, it is unclear when Brexit will occur or what the legal structure will be framing the United Kingdom's relationship with the European Union after Brexit. Following Brexit, the present systems of protection and enforcement in respect of intellectual property rights of national (UK) scope would broadly speaking remain in their current form. This is the case for GB patents and UK designations of European patents, supplementary protection certificates, UK trademarks, UK registered and unregistered designs, copyright and neighbouring rights, and trade secrets. For EU-wide rights obtained or arising under an EU regime, following Brexit (or the expiry of any agreed transition period) the EU would no longer consider the right to cover the UK or the UK to be within the EU-wide regime. This would apply to EU trademarks, Community registered designs and unregistered Community design rights. However, national legislation would mitigate the effects of this in the UK. Essentially, the UK would extract (automatically and without a fee) from each EU-wide right a UK right of the same scope that could be enforced in the UK courts as a national right. A new 'supplementary unregistered design right' would be created replicating, for the UK, the scope of protection presently arising under the unregistered Community designs regime. The UK would continue to recognise the EEA regional exhaustion regime, at least in the short term. However from the perspective of the countries remaining in the EEA, the UK would be outside their regional exhaustion regime.

ii Unitary patent and Unified Patent Court

The UPC Agreement was signed by 25 participating Member States of the EU in 2013, including the United Kingdom.

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With the implementation of the UPC Agreement and associated legislation, European patents that are not 'opted-out' of the UPC system, and granted unitary patents, will fall within the exclusive jurisdiction of the UPC. Where a claim for infringement or validity is brought in the UPC, the Court's decision will cover the Member States of all designations of the European patent (or unitary patent) that fall within the court's remit (i.e., the EP designations of all participating Member States that have ratified the agreement at the relevant time). Applicants to the EPO for patent protection will be able to seek unitary protection (a unitary patent) covering those EU Member States that have deposited an instrument of ratification or accession at the date of grant of the European patent.

However, a legal challenge in the Federal Constitutional Court in Germany, and the uncertainties presented by Brexit, mean that at the time of writing it is not clear when the new system will become operational.

iii Proposed changes to trade secrets and copyright law in the EU

The EU legislature has enacted the reform of copyright law across the European Union. The changes, which will come into force in 2021, are intended to improve cross-border accessibility to copyright content and related services, and enhance the portability of online content that would allow users to transport content from one device to another without the risk of infringement.

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Appendix 1

ABOUT THE AUTHORS

GORDON HARRIS

Gowling WLG

Gordon Harris is the co-head of intellectual property at Gowling WLG. He conducts litigation in all UK and European courts for clients seeking to protect their IP, or those who have been accused of infringing other people's rights. He is known as a fighter who will explore every avenue to get the right result, including going to the Supreme Court to change over 100 years of patent law in order to ensure the right outcome for a client.

Gordon has conducted ground-breaking cases on designs and brands in the European Court of Justice and contested the validity of patents in the European Patent Office.

Gordon has over 25 years' experience in IP and is involved in law reform and development through various committees and organisations, all of which allows him to provide decisive commercial advice to clients and to help them to decide the best avenue to take in any given case.

As a qualified mediator accredited by CEDR and the World Intellectual Property Organization, Gordon also pursues alternative dispute resolution both on behalf of clients and as a mediator.

ANDREW MAGGS

Gowling WLG

Andrew Maggs is a principal associate in the intellectual property team at Gowling WLG. He has over 10 years of experience conducting patent litigation, principally for US technology companies, with particular emphasis on wired and wireless telecommunications. His work often involves advising on multi-jurisdiction disputes, including where parallel litigation is ongoing in the United Kingdom, the United States, Germany and before the European Patent Office.

As well as advising on legal, tactical and technical considerations, Andrew has extensive experience advising on issues relating to standards-essential patents, including seeking declarations of essentiality, obligations to standards-setting organisations, and the relationship between patents and antitrust law, in particular the implications of the Court of Justice's decision in *Huawei v. ZTE*.

Andrew helped to establish Gowling WLG's Guangzhou office and has experience assisting clients to resolve their technology disputes in China.

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AILSA CARTER

Gowling WLG

Ailsa Carter is a principal associate professional support lawyer in the intellectual property team at Gowling WLG. She focuses on the development of knowledge, the production of material for publication and the training of fee earners in the intellectual property team. Ailsa has particular experience advising and representing clients in the pharmaceutical, biotech and consumer products sectors, including in litigation and wider disputes concerning patents, confidential information and trademarks. She has collaborated with lawyers in many other jurisdictions, coordinating and assisting in the context of multi-jurisdictional disputes and projects involving litigation outside the United Kingdom.

GOWLING WLG

4 More London Riverside
London SE1 2AU
United Kingdom
Tel: +44 370 903 1000
Fax: +44 370 904 1099
gordon.harris@gowlingwlg.com
andrew.maggs@gowlingwlg.com
george.sevier@gowlingwlg.com
ailsa.carter@gowlingwlg.com
www.gowlingwlg.com

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