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“How to invalidate patents now and in the future”

Presented by

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Specific Legal Issues

1. Added matter

- “Directly and Unambiguously Disclosed” (Common application to priority entitlement/novelty/added matter)
- EPO becoming more lenient?
 - US Bar/EPO Liaison Council meeting; EPO Symposium Round Table
 - Literal support not required (T667/08 and updated GL; H-IV, 2.3)
 - What is disclosed to skilled person vs. the structure of the original claims (T2619/11)

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1. Added matter

- A gap between the first and second instance in the EPO?
- Different standard across different technologies?
- Narrowing scope of generic small molecule claims (selection within Markush group definitions)

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2. Inventive step

- Does the problem and solution fit all circumstances?
- Reformulating the problem
- The emphasis on technical effect – data is king
 - Plausibility, T1329/04 and later cases
- Overly broad claims - sufficiency/Lack of inventive step (or both?)

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3. Current EPO issues

- Clarity
 - To what extent, if at all, can clarity affect validity (EBA referral G3/14)?
- Priority Right Non-entitlement (Evans and T62/05)
- Toxic Divisionals (T1496/11)?
 - The theory of partial priority entitlement (G2/98 and recent T1222/11)

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Practical/Procedural Issues

4. Speed of procedure

- Should the EPO up staff so that cases can be dealt with in 12 months?
- EPO Opposition timing data for A61K cases.
- Conflict between speed of EPO and UPC

5. Evidence & case law

- Evidence in the EPO
 - cross examination, expert testimony
- Power of Advocacy
 - very significant in EPO oral proceedings; opportunity to change the ED/OD/TBA's mind
- Case law in UPC
- EPO law on validity applied by the UPC: Art.65(2) UPCA applying Art.138(1) EPC