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New EPO Review of Patentability of Computer Programs

It is well known that the European Patent Convention (EPC) excludes patents for “computer programs as such”, and equally well known that the Courts and Patent Offices of Europe have failed to agree on how to apply this law, especially in view of the significant developments in computer technology and usage since the EPC started in 1978.

On 22 October 2008 the President of the EPO asked the EPO Enlarged Board of Appeal to review the case law and to answer a number of questions aimed at providing legal certainty to at least the EPO Examiners and Boards of Appeal. The questions, together with a detailed review of the case law, are available through the link given below.

In view of the increasing interest in computer-related inventions by chemical and life sciences companies, we introduce this referral to you now and will keep you updated.

→ [http://documents.epo.org/projects/babylon/eponet.nsf/0/B89D95BB305AAA8DC12574EC002C7CF6/\\$File/G308_en.pdf](http://documents.epo.org/projects/babylon/eponet.nsf/0/B89D95BB305AAA8DC12574EC002C7CF6/$File/G308_en.pdf)

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“Probability of Failure” Argument Not Persuasive in the Case of Major Intractable Diseases

In the recent Decision **T1127/06**, the influential Kinkeldey biotech EPO Board of Appeal 3.3.04 held that, in the case of serious widespread diseases where effective treatments have proved elusive despite a major research effort (here: Alzheimer’s disease), even the presence of a “non-negligible probability of failure” when trying the claimed invention will not displace a *prima facie* lack of inventive step (Reasons, section 13).

→ <http://legal.european-patent-office.org/dg3/pdf/t061127eu1.pdf>

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Recent EPO Decision Interpreting the word “Isolated”

In past issues of this Newsletter (April 2007; April 2008), we have considered the use of the word “isolated” in Europe in claims to new naturally-occurring molecules or materials. Where the term has not been defined, its interpretation can be problematic and may have to be consistent with other stated parameters of the “isolated” molecule/material (e.g. the Kinkeldey Board of Appeal’s erythropoietin Decision **T787/00**, Reasons, points 21 and 22).

In the recent decision **T1593/05**, the Kinkeldey Board was able to give a relatively generous interpretation to the phrase “isolated fibroblasts”, as “fibroblasts taken out of the context in which the cells naturally occur”.

→ <http://legal.european-patent-office.org/dg3/pdf/t051593eu1.pdf>

→ <http://legal.european-patent-office.org/dg3/pdf/t000787eu1.pdf>

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More European Patents/Applications Lost through Unclear Parameters

Continuing our popular series of European patents and applications lost because of unclear or insufficiently defined parameters in claim 1 (see the October 2005, December 2006 and July and October 2007 issues of this Newsletter), we offer the following further recent examples from decisions of the EPO Boards of Appeal:

- T1866/06** - Aqueous slurry delta pH arising from use of a latent acidifier in a soap
- T20/07** - Surface energy of a hydrophobic liquid handling structure in a disposable absorbent article
- T815/07** - Absorbent capacity of a portion of an absorbent article
- T955/07** - Extensional viscosity of a melt-drawable composition

→ <http://legal.european-patent-office.org/dg3/pdf/t061866eu1.pdf>

→ <http://legal.european-patent-office.org/dg3/pdf/t070020eu1.pdf>

→ <http://legal.european-patent-office.org/dg3/pdf/t070815eu1.pdf>

→ <http://legal.european-patent-office.org/dg3/pdf/t070955eu1.pdf>

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Patentee Not Allowed to Use PowerPoint in EPO Oral Proceedings

In the recent EPO Board of Appeal Decision **T1556/06**, it was held that Opposition Divisions have a broad discretion over how Oral Proceedings are conducted, and as a result it is not a procedural violation for the Opposition Division to refuse to allow a party (here: the patentee) to use PowerPoint at the Oral Proceedings, provided that this does not prevent oral presentation of the party's arguments.

The Board pointed out (Reasons, 5.2.6) that the content of a PowerPoint presentation should be announced in advance, so that usually it will be possible for a party to provide its oral presentation with the PowerPoint slides on paper, rather than projected. The Board considered that this approach was in line with Decision **T1110/03** (see the January 2005 issue of this Newsletter), which highlighted that PowerPoint slides strictly belong to the written phase of the procedure.

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Questions on the EU Biotech Directive Referred to the ECJ

In the Netherlands litigation by Monsanto over the importation of soybean meal into Europe (see the report of the parallel UK litigation *Monsanto v Cargill* in the April 2008 issue of this Newsletter), the Dutch Court has referred the following questions concerning the EU Biotech Directive 98/44/EC to the European Court of Justice (ECJ):

1. Does Article 9¹ of the Directive mean that the article can be invoked where (as here) the "product containing or consisting of genetic information" (DNA) is incorporated in a material (soybean meal) and does not perform its function at the time of the alleged infringement, but has (in the past) performed such a function (in the soy plant) or would possibly again be able to perform that function after it has been isolated from that material and inserted into the cell of an organism?
2. Assuming that the DNA sequence of claim 6 is present in the soybean meal imported into Europe by the defendants, and that the DNA is "incorporated" in the soybean meal for the purposes of Article 9, and that it no longer performs its function there, does the Directive prevent national legislation from conferring absolute protection on the DNA product regardless of whether the DNA "performs its function" ?
3. Does it make a difference to the answer to Question 2, that the patent was granted (in 1996) before the adoption of the Directive, and is the TRIPS Agreement, particularly Articles 27 and 30, relevant in answering these Questions?

The referral is pending before the ECJ as Case C-428/08. We will keep you informed of developments in this referral and the Monsanto litigation.

¹ Article 9 of the EU Biotech Directive 98/44/EC: "The protection conferred by a patent on a product containing or consisting of genetic information shall extend to all material, save as provided in Article 5(1) [i.e. human material], in which the product is incorporated and in which the genetic information is contained and performs its function."

→ http://curia.europa.eu/en/content/juris/index_form.htm

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