

IP Law Update

November 2020

Important EPO News: *EPO changes oral proceedings regime to video only*
- *advantage for all parties involved*

EPO Prosecution Guide:

How to achieve a favorable scope of protection and broaden the scope of protection of early patent filings

EU Case Law News: *Supplementary Protection Certificate (SPC):*
- *how to argue against Royalty Pharma (C-650/17) and TEVA (C-217/17)*

The Start-Up Experts: WaHe-patent provides 360° IP services for early and grown up start-ups

WAGNER + HELBIG

Patentanwälte

Conseils en Propriété Intellectuelle

Intellectual Property Counselors

Germany – Switzerland

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Important EPO news:

EPO changes oral proceedings regime to video only

According to new EPC Rules *ex parte* and *inter partes* oral proceedings shall be held by video conference only triggered by the COVID 19 crisis:

We advocate this initiative as it

- saves travel cost*
- makes proceedings more efficient for law firms*
- makes it easier for clients to participate in hearing*
- is technically easy, reliable and convenient*
- EPO boards have proven to be capable of correct handling*

Attending the hearing in person remains a possible option in special cases

link: <https://www.epo.org/news-events/news/2020/20200519.html>

EPO Prosecution Guide:

How to achieve a favorable scope of protection and broaden the scope of protection of early patent filings for an IP value increase

- Pursue a reasonable scope of protection covering the basic invention and your product = *original inventive idea*
- Broaden out with more general terms said original inventive idea in 1st line divisional application = *general inventive idea*
- Broaden out scope of protection to cover competitor products in 2nd line divisional application = *offensive tool*

Supplementary Protection Certificate:

- how to successfully argue against Royalty Pharma and TEVA

TEVA (C-121/17) major message

- **Important Article:** Article 3(a) of Regulation No 469/2009 EU
- **Message:** “a product ... is ‘protected by a basic patent in force’ ... even if ... the ... product ... is not expressly mentioned in the claims of the basic patent, those claims relate necessarily and specifically to that product ...”

Supplementary Protection Certificate:

- how to successfully argue against Royalty Pharma and TEVA

Royalty Pharma (C-650/17) major message

- **Important Article:** Article 3(a) of Regulation No 469/2009 EU
- **Message:** “a product is protected by a basic patent ... if it corresponds to a general functional definition ... of the claims ... and necessarily comes within the scope of the invention ... but is not otherwise indicated in individualised form ... provided that it is specifically identifiable, in the light of all the information disclosed by that patent, by a person skilled in the art, based on that person’s general knowledge in the relevant field at the filing date or priority date of the basic patent and on the prior art at that date ...”
- “... a product is not protected by a basic patent ... , if, although it is covered by the functional definition ... in the claims ... If it was developed after the filing date of the application for the basic patent, following an independent inventive step ...”

SPC III/III

Supplementary Protection Certificate:

- how to successfully argue against Royalty Pharma and TEVA

The obstacles:

- Functional claim language with broad scope of protection
- Compound is not individualized in the description of basic patent

A successful line of argumentation:

- Align Marketing Authorization compound with disclosure
- Show hints to specific molecular changes in disclosure
- Back-up disclosure hints with scientific literature dated before priority date
- Emphasize state-of-the art, general knowledge and granting practice of priority time
- Request oral hearing with Examiner before PTO takes decision

WAGNER + HELBIG IP Counselors have successfully represented and counseled clients in pan-EU SPC cases

WaHe-patent the start-up IP expert of 1st choice

WAGNER + HELBIG provide 360° IP services for start-ups

We cover of all IP related areas: drafting, prosecution, contracts, trademarks, lean admin organization

Our service approach is based on direct communication and lean organization

WAGNER + HELBIG provide goal-oriented IP services for start-ups


Our patent drafting and prosecution is budget effective

Our IP services focus on start-up needs

Our IP services address investor and fund raising needs

We understand the venture and IPO language

WAGNER + HELBIG IP Counselors have successfully supported clients' on the IP side which led to >\$150 Mio venture financing and IPOs

The logo consists of the text 'Wa•He•patent' in a sans-serif font, with dots separating the words. It is positioned in the top left corner of the header image.

Wa•He•patent

The header image is a grayscale photograph of an industrial facility. On the left, a tall, thin chimney stack emits a thick plume of white steam or smoke that rises into the sky. In the background, there are rolling hills and a town. On the right side of the image, a large, dark, cylindrical industrial tank with two smaller tanks on top is visible.

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