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# IP Law Update

## **Summer** 2017

Welcome to the summer 2017 edition of the Withers & Rogers IP Law Update. This e-newsletter provides a round-up of our articles covering some of the most significant intellectual property cases that have been decided in the UK and Europe in the past year.

It is a year on from the tumultuous summer of 2016 in which the UK narrowly voted to leave the European Union. Now that the famous "Article 50" has been triggered, negotiations between the UK and the EU have started with both sides hoping for an amicable divorce. On the ground, however, nothing much has changed in the day-to-day business of IP litigation.

Likewise the Unitary Patent project continues to rumble away, getting ever closer despite various spanners being thrown in the works. The latest of these is a legal challenge brought in the German Constitutional Court. The UPC Preparatory Committee now expects the so-called "sunrise" period to begin in early 2018 and to last 6-8 months before the system comes fully into effect.

As is often the case, the pharmaceutical and telecommunications industries account for much of the case law we've reported on over the last year. The Supreme Court judgment in the *Eli Lilly v Actavis* saga is the most far-reaching decision for some time and could have implications for companies in all sectors. In this publication you will also find the courts have clarified the always prickly issue of how to interpret numerical ranges, and have commented on how to determine licensing terms that are fair, reasonable and non-discriminatory, known as "FRAND".

An overview of the trade mark cases we have reported shows that the huge increase in internet shopping is having a knock-on effect on the use, and sometimes abuse, of trade marks. This trend seems likely to continue.

I hope you find this issue of our IP Law Update interesting and informative. If you have any questions please do not hesitate to contact me or your usual W&R contact.

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## Inside...

# Patent Cases

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## Sound Plausible? How much data does your patent application really need to include?

**By Helen Henderson**

*T 488/16*

A recent decision by the EPO to revoke Bristol-Myers Squibb's European patent for the blockbuster anti-cancer drug dasatinib (Sprycel®) caused ripples through the pharmaceutical industry. The reasoning behind this decision has now been published by the EPO and provides some useful guidance as to what is required to establish that a technical effect is plausibly achieved.

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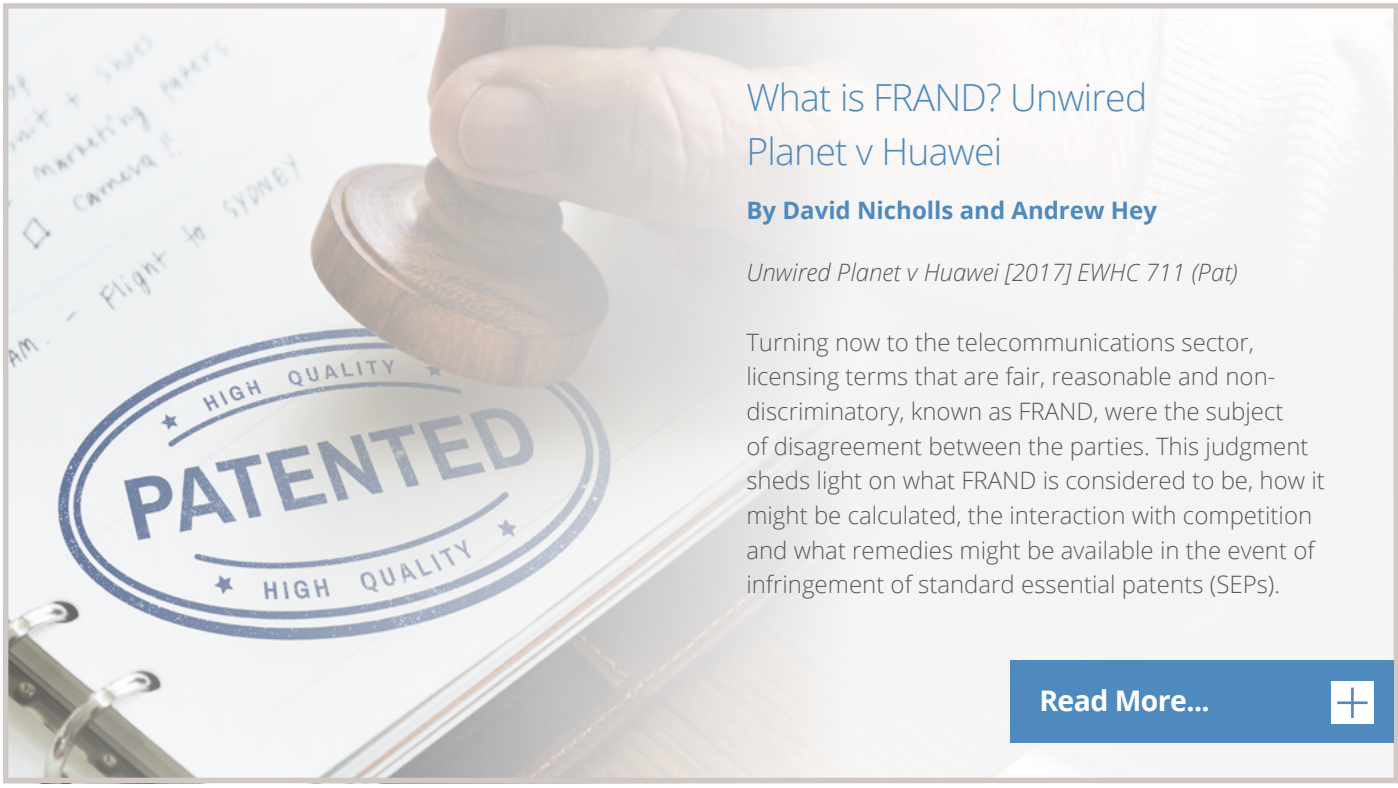


## What is FRAND? Unwired Planet v Huawei

**By David Nicholls and Andrew Hey**

*Unwired Planet v Huawei [2017] EWHC 711 (Pat)*

Turning now to the telecommunications sector, licensing terms that are fair, reasonable and non-discriminatory, known as FRAND, were the subject of disagreement between the parties. This judgment sheds light on what FRAND is considered to be, how it might be calculated, the interaction with competition and what remedies might be available in the event of infringement of standard essential patents (SEPs).

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# Patent Cases

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## Eli Lilly reigns Supreme

**By Elizabeth Swan and Nicholas Jones**

*Eli Lilly and Company v Actavis UK Limited and others [2017] UKSC 48*

It is not often that a Supreme Court decision on IP comes along, and even less often one that has very significant things to say about the way we determine the scope of patent claims. This decision is relevant to all sectors and brings forth a new approach to considering claim scope, which is arguably more akin to the US "doctrine of equivalents" than to previous UK case law. It also sets out clear rules on when the prosecution history can legitimately be used to guide claim interpretation. If there is only one decision you read this year, I recommend you make it this one!

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## Court of Appeal provides clarification "about" numerical values

**By Bruce Dean**

*Napp Pharmaceutical Holdings Limited v Dr Reddy's Laboratories (UK) Ltd & Anor [2016] EWCA Civ 1053*

The interpretation of numerical values is, of course, critical for patent infringement and has been the subject of many court cases. In this case it was up to the court to interpret the term "about 10%". The Court of Appeal agreed with the High Court that in this case it was appropriate to interpret the figure to the nearest whole number, such that the term "about 10%" covers values in the range of 9% to 11%. This is a useful guide for claim interpretation and should be borne in mind by those drafting patent applications.

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# Supplementary Protection Certificates

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## SPCs can be used for compounds hidden within generic claims

**By Andrew Evitt**

*Sandoz Ltd & Anor v G.D. Searle LLC & Anor [2017] EWHC 987*

SPCs have, understandably, been the subject of a lot of case law. The many rulings from the CJEU can make confusing reading. Here the High Court has good news for SPC owners in confirming that an SPC is allowable for a compound that is not specifically identified in a patent but (a) where there is a generic claim that covers the product and (b) where the product embodies the technical advance of the claim.

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# Trade Marks

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## Cartier v BSkyB – Court of Appeal confirms website blocking orders for trade mark infringement

**By Mark Caddle**

*Cartier International and Others vs BSkyB and Others [2016] EWCA Civ 658*

The rise in internet shopping over the last few years has been phenomenal. In this important case the Court of Appeal clarified the obligations of internet service providers (ISPs) when it comes to trade mark infringement. The outcome provides welcome news for trade mark owners with the possibility of obtaining website-blocking orders as a means for preventing the infringement of their brands online.

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## Adwords and honest concurrent use: Victoria Plum v Victorian Plumbing

**By Charles King**

*Victoria Plum Ltd v Victorian Plumbing Ltd [2016] EWHC 2911*

This was a trade mark case in which the issues of keyword advertising and honest concurrent use were intertwined. Victoria Plum and Victorian Plumbing are both companies that sell bathrooms. The two brands had co-existed for over a decade, until the attractions of pay-per-click advertising brought matters to a head. The case highlights the fact that the 'honesty' of trade mark use can apparently differ between the online and offline environments.

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# Trade Marks

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## The final twist: Rubik's Cube trade mark declared invalid by EU Court

**By Mark Caddle**

*C-30/15 Simba Toys GmbH & Co. KG v EUIPO*

Interestingly the interplay between patents and trade marks was highlighted in this case where the CJEU confirmed that the technical function of a product is relevant for assessment of the essential characteristics of the shape. This meant that the way that the Rubik's cube works, with rotating internal elements, is relevant to the assessment of trade mark suitability.

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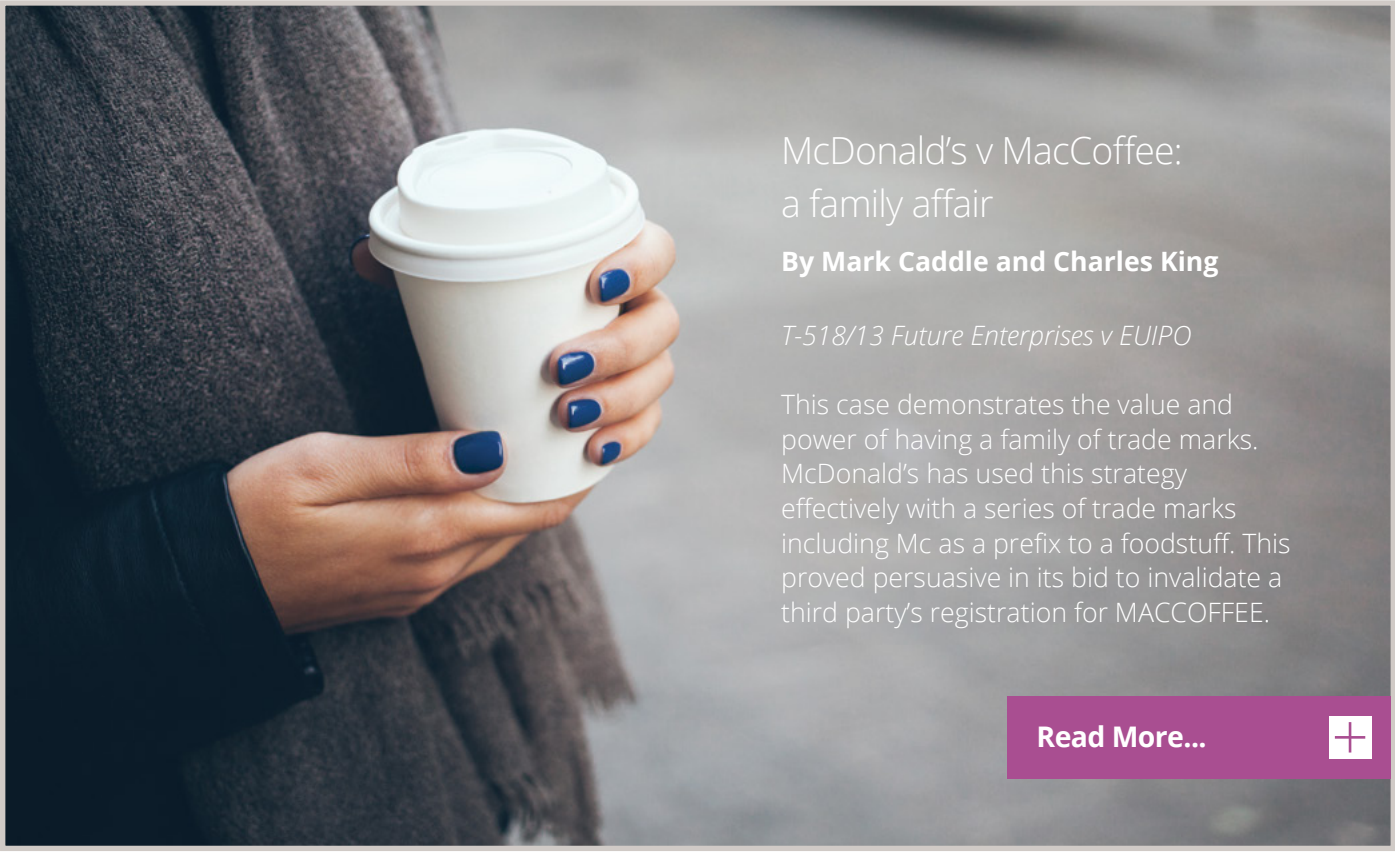

## McDonald's v MacCoffee: a family affair

**By Mark Caddle and Charles King**

*T-518/13 Future Enterprises v EUIPO*

This case demonstrates the value and power of having a family of trade marks. McDonald's has used this strategy effectively with a series of trade marks including Mc as a prefix to a foodstuff. This proved persuasive in its bid to invalidate a third party's registration for MACCOFFEE.

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